

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

EJW

Mailed: August 28, 2014

Cancellation No. 92058411

Luxco, Inc.

v.

Opici IP Holdings, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On August 27, 2014, the parties, represented by Andy Gilfoil (of Husch Blackwell LLP) for Petitioner and John Rannells and Jason DeFrancesco (of Baker and Rannells PA) for Respondent, and Elizabeth Winter, the assigned Interlocutory Attorney, held a teleconference to discuss Respondent's motion (filed August 6, 2014) for clarification of the Board's order mailed on July 29, 2014. This order summarizes the conference and sets forth a revised scheduling order. *See* Trademark Rule 2.120(i)(1); and TBMP § 502.06(a) (2014).

Respondent seeks clarification from the Board regarding the implications of the Board's order, which dismissed without prejudice Respondent's counterclaims and allowed Respondent thirty days to file amended counterclaims. Specifically, Respondent asks whether it is able to conduct discovery regarding issues related to abandonment and, upon a sufficient

showing, whether it will be permitted leave to amend its petition to include abandonment claims. Petitioner opposes the motion, arguing that to the extent said motion is one for reconsideration or one to extend the deadline for submitting an amended counterclaim, there is no basis for such relief. Petitioner also argued that Respondent's motion amounts to a request for an advisory opinion.

To the extent Respondent requested an advisory opinion on whether certain discovery would be acceptable or on whether it can file an amended answer to include abandonment counterclaims at a later date, Respondent's motion was *denied*. It is not the Board's practice to entertain motions *in limine* or to make prospective or hypothetical evidentiary rulings. *See Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995).

That being said, the Board reminded Respondent that there was no ruling in the July 29, 2014 order regarding discovery, nor did the Board state that Respondent could only amend its pleading during the time period allowed in the order. Rather, under the Trademark Rules and applicable Federal Rules of Civil Procedure, Respondent is allowed to take discovery on any non-privileged matter that is relevant to any party's claim or defense. *See Fed. R. Civ. P. 26(b)(1)*. Further, the general scope of discovery is broad, and a party may take discovery not only as to matters specifically raised in the pleadings, but also as to any matter which may serve as the basis for an additional claim, defense or counterclaim. *See id*; and TBMP § 402.01 (2014). *See also*

See J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577, 579 (TTAB 1975) (allowing interrogatories designed to elicit information concerning possible abandonment which, if revealed, may provide basis for counterclaim). As to the potential amended pleading, under applicable rules, Respondent may file a motion for leave to amend when appropriate. *See* Fed. R. Civ. P. 15(a); and Trademark Rule 2.114(b)(2)(i) (“If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned.”).

Trial Schedule Revised

The parties advised the Board that they had already conducted their discovery conference in accordance with the schedule set forth in the Board’s institution order. Further, both parties have served discovery on the adverse party (Petitioner on April 29, 2014¹; Respondent on August 27, 2014) in accordance with the Board’s scheduling order mailed on February 26, 2014, which indicated that discovery opened on April 27, 2014. Additionally, Respondent’s counsel has advised the Board that Respondent will not file an amended pleading on or before the August 28, 2014 deadline set forth in the Board’s July 29, 2014 order. In view of the foregoing, and because

¹ Insofar as Petitioner filed a motion to dismiss Respondent’s counterclaims on March 28, 2014, and the Board suspends proceedings upon the filing of a motion to dismiss, the better practice would have been to wait to serve discovery until after the Board had considered Petitioner’s motion.

Respondent's counterclaims were dismissed (without prejudice), the trial schedule is revised as follows:

Expert Disclosures Due	12/26/2014
Discovery Closes	1/25/2015
Plaintiff's Pretrial Disclosures Due	3/11/2015
Plaintiff's 30-day Trial Period Ends	4/25/2015
Defendant's Pretrial Disclosures Due	5/10/2015
Defendant's 30-day Trial Period Ends	6/24/2015
Plaintiff's Rebuttal Disclosures Due	7/9/2015
Plaintiff's 15-day Rebuttal Period Ends	8/8/2015

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

