

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 20, 2008

Opposition No. 91169740

SPRINT COMMUNICATIONS COMPANY L.P.

v.

CINGULAR WIRELESS II. L.L.C.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with opposer's consented motion dated April 26, 2007, the parties agreed that the first 30-day testimony period would be reset to close on June 27, 2007. Thus, the period opened once on Tuesday, May 29, 2007. The Board, in its suspension order of July 20, 2007, also granted opposer's consented motion of May 30, 2007 to reset the first testimony period to close on July 11, 2007. This case now comes up on the following motions and matters:

1. Opposer's fully briefed motion, filed June 25, 2007, to compel more complete responses from applicant to opposer's interrogatory Nos. 5, 18 and 20 and document request Nos. 3, 4, 7, and 23 and to extend the testimony periods.
2. Opposer's fully briefed motion, filed July 6, 2007, for leave to amend its notice of opposition to add a claim, in the alternative, that applicant's mark is merely descriptive.

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3. Applicant's fully briefed motion, filed July 16, 2007, for involuntary dismissal.
4. The parties' stipulated protective agreement.

The stipulated protective agreement is noted and entered.

The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Opposer's motion to compel is denied as untimely.

In support of its motion, opposer argues that the parties agreed discovery responses would be due on June 13, 2007; that it received applicant's responses on June 15, 2007;¹ that such responses did not include produced documents; that it attempted to resolve the dispute; and that interrogatory Nos. 5, 18 and 20 and document request Nos. 3, 4, 7, and 23 remain in dispute.

¹ The date opposer received applicant's responses is somewhat unclear. Sometimes opposer references June 13 and other times opposer references June 15. It may be that responses were received on two different days. However, because the dates are so close, their difference does not change the Board's determinations made in this order.

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Opposer requests that the testimony periods be reset upon the Board's consideration of the motion to compel.

In response, applicant objects to opposer's motion as untimely. Applicant argues that no dispute remains with respect to the identified discovery requests. Applicant also expresses its belief that opposer brought the motion to compel as a delaying tactic and contests any resetting of the testimony periods.

A motion to compel must be filed prior to the commencement of the first testimony period as originally set or reset. See Trademark Rule 2.120(e)(1); and TBMP §523.03 (2d ed. rev. 2004). Cf. TBMP §528.02 for an explanation of "as originally set or reset."

Opposer's motion to compel, being filed after the first testimony period opened once on Tuesday, May 29, 2007, is denied as untimely.²

The Board notes that, in any event, the requests identified as in dispute appear to be resolved. Applicant states it attempted to respond to the merits of interrogatory No. 5 despite a typographical error; applicant states, in response to interrogatory No. 18, that it located additional examples of representative advertising and produced such examples to opposer; applicant, in response to interrogatory No. 20. believes it

² Where responses are outstanding to any party's discovery requests, the most prudent course of action is to seek an extension (or suspension) of the testimony periods prior to the opening of the first testimony period.

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directed opposer to specific page numbers of the NAD case documents; applicant explained, in response to document request Nos. 3 and 7, that it does not maintain archived or historical records but has located representative examples and produced such examples to opposer; applicant has clarified, in response to document request No. 4, that it believes the documents opposer seeks do not exist; and applicant has clarified that there are no privileged documents responsive to applicant's discovery requests and, thus, there is not need for a privilege log.

Opposer's motion to reset the testimony periods is granted.

Opposer's motion to reset the testimony periods, brought contemporaneously with its motion to compel, is granted. See Fed. R. Civ. P. 6(b)(1)(A). The Board agrees that this case has been delayed. The Board also acknowledges that at least some of the delay has been due to the Board's workload. Opposer may have believed it brought a timely motion to compel based on the consented motion to extend dates filed May 30, 2007. (Though, as indicated above, there was a one-day miscalculation.) Consequently, resetting the trial dates is appropriate. Such resetting is incorporated into the scheduling section of the this order, *infra*.

Applicant's motion for involuntary dismissal is premature.

Inasmuch as the Board has granted opposer's request to reset the testimony periods, applicant's motion for involuntary

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dismissal is premature. Accordingly, no further consideration is given thereto.

Opposer's motion for leave to amend its notice of opposition is granted.

By its original notice of opposition, opposer asserts that applicant's mark is deceptive within the meaning of Trademark Act §2(a) and is deceptively misdescriptive within the meaning of Trademark Act §2(e)(1).

Opposer seeks to add a claim that applicant's mark is merely descriptive. According to opposer, its amendment is prompted by applicant's discovery responses (received June 13, 2007). Opposer argues that applicant is not prejudiced because the discovery period may be reopened to allow discovery on the new claim.

In response, applicant argues that opposer's motion to amend the pleadings amounts to another delay tactic. Applicant points out that it was involved in an earlier proceeding with opposer's parent company³ and the documents opposer now relies upon for its proposed amendment to the pleadings were provided to opposer's parent company. Thus, it is applicant's position that opposer has had the information it now relies upon for its asserted new claim since January 2006 and, consequently, has delayed in asserting the new claim. Applicant argues that it is unduly prejudiced if the amendment is permitted because it could have

³ This was a proceeding before the National Advertising Division of the Council of Better Business Bureaus, Inc. (NAD).

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taken discovery on the proposed new claim during the discovery period and a resetting of the discovery period solely for the new claim will add delay to this opposition and further delay registration of applicant's mark.

In reply, opposer argues that the documents and information of record in the NAD case were not of record in this opposition proceeding until applicant offered them in its discovery responses. Opposer also argues that applicant "only recently" relies on the position that its trademark was adopted for the same reasons that it was previously used as an advertising slogan and that it applicant intends to defend on statements "to the effect" that its trademark "is not misdescriptive because it is descriptive."

As a general policy, leave to amend a pleading must be freely given when justice so requires. See Fed. R. Civ. P. 15(a). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See TBMP §507.02 (2d ed. rev. 2004). The question of whether an adverse party would be prejudiced by allowance of the amended pleading in a Board case is largely dependent on the timing of the motion to amend. For example, the Board will liberally grant such motions when the proceedings are still in the pre-trial stage. *Id.* In order to avoid any prejudice to the adverse party when a motion

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for leave to amend is granted, the Board may, in its discretion, reopen the discovery period to allow *the adverse party* to take discovery on the matters raised in the amended pleading.

In view of the late exchange of discovery responses, it appears opposer was not aware that it may have grounds for an additional claim until it received applicant's discovery responses. While applicant points out that opposer and applicant's parent were involved in the NAD case, there is no indication that opposer, as a subsidiary, was provided with the information made available to its parent as a result of the NAD litigation. Often, and in many ways, subsidiaries operate independent of their parent corporations. While the delay to this case is regrettable, the Board has set schedule, *infra*, that should reduce further delay and minimize prejudice to applicant. Moreover, a complete adjudication of the dispute between the parties serves judicial economy.

In view thereof, opposer's motion for leave to amend the notice of opposition is granted. Opposer's amended notice of opposition, filed July 6, 2007, is now the operative notice of opposition.

The schedule is reset.

Applicant is allowed until **TWENTY DAYS** from the mailing date of this order to file its answer to the amended notice of opposition.

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Discovery is reopened only for applicant solely with respect to the newly asserted claim that applicant's mark is merely descriptive. Applicant's discovery schedule is set out below and trial dates are also reset.

THE PERIOD FOR DISCOVERY TO CLOSE: (Discovery is open only for applicant solely on the new claim.)	May 1, 2008
30-day testimony period for party in position of plaintiff to close	July 30, 2008
30-day testimony period for party in position of defendant to close:	September 28, 2008
15-day rebuttal testimony period to close:	November 12, 2008

While an ample discovery period has been reset, the Board does not believe that substantial discovery is necessitated by the new claim. This is so because opposer relies on applicant's discovery responses as a basis for the new claim, not on its own information or documents.

Again, the parties are reminded that, even though a discovery period has been reset, the first testimony period opened once in this case. Thus, no summary judgment motions or motions to compel may be filed.⁴ The parties are urged to stay on the schedule set in this order, though, of course, they may settle their dispute at any time.

⁴ Even though no motions to compel may be filed, opposer is not relieved of a prospective duty to serve substantive responses to any discovery requests applicant may serve as permitted in this order.

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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. Trademark Rule 2.125.

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

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