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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91187963
Party	Defendant Flores, Karlo
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Date	03/11/2009
Attachments	karlo flores.pdf ( 15 pages )(853129 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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Chocoladefabriken Lindt & Sprungli AG  
Opposer,

Opposition No. 91187963  
Trademark: 73% INTENSE DARK  
Serial No.: 77258474

vs.

Karlo Flores dba KFM Foods International  
Applicant.

\_\_\_\_\_ X

**FILED VIA ESTTA**

**APPLICANT’S REPLY BRIEF IN FURTHER SUPPORT OF ITS  
MOTION TO DISMISS FOR LACK OF SERVICE**

Applicant, Karlo Flores d/b/a KFM Foods International (“Applicant” or “KFM”), a citizen of Canada, by and through his undersigned counsel, respectfully submits this Reply Brief in Further Support of its Motion to dismiss the Notice of Opposition pursuant to 37 C.F.R. §2.119 and Fed. R. Civ. P. 12(b)(5) filed by Opposer Chocoladefabriken Lindt & Sprungli AG (“Opposer” or “Lindt”).

Opposer argues in opposition to Applicant’s motion that the Board’s two-fold service requirement of actual service and proof of service was complied with in this case. *See* Opposer’s Brief in Response to Applicant’s Motion to Dismiss for Lack of Service (“Opposer’s Opposition Brief”) at 2, 4. Regarding “actual service,” Opposer argues that it actually served Applicant by sending its Notice of Opposition to Applicant’s Vancouver, Canada address. *See id.* at 5. It argues further that “the Trademark Rules do not define ‘address of record’” and that “Applicant’s Vancouver, Canada address is very much ‘of record’ in the Office[,]” because it is listed as “the address for the ‘owner of record.’” *See id.*

I. **ARGUMENT**

A. **Opposer Failed to Serve Applicant at Its “Address of Record” as it is Found in the Trademark Applications and Registrations Retrieval (TARR) System**

Opposer continues to state that “Applicant’s only support for [its conclusion that Baker and Rannells, PA is the “address of record in the Office”] is that this address is listed on the USPTO’s TARR Report.” *See id.* Applicant submits that it needs nothing further than the USPTO TARR Report to determine an “address of record” in the USPTO. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242 (Aug. 1, 2007)(to be codified at 37 C.F.R. pt. 2)(hereinafter, the “New Trademark Rules”)(also available on the Board’s website at <http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>). According to the New Trademark Rules, the TARR system is where one can determine the appropriate “address of record”:

**“[...] Whether a plaintiff should serve the owner directly, an attorney, or a domestic representative depends on what Office records provide as the correspondence address.**

**“To determine the correspondence address of record for an applicant or registrant, the plaintiff must check the Trademark Applications and Registrations Retrieval (TARR) system** at the following web address: <http://tarr.uspto.gov>. (This system also is accessible via links from the Office’s main Web site). A plaintiff in an opposition...proceeding need only serve a copy of its notice of opposition...to the correspondence address of record. [...] For questions about correspondence address information in TARR...plaintiffs may contact the Board’s customer service representatives at the main telephone number for the Board [.]

“A plaintiff in an opposition...is not required to serve a copy of its notice of opposition...to any address other than the address listed in the TARR system.”

*Id.* at 42243 (emphasis added) (a copy of relevant pages of the Federal Register is annexed hereto as Exhibit “A”).

**B. Parties to Proceedings Before the Board are Expected to Know the New Trademark Rules**

Opposer has not explained why it did not comply with the Board's requirement that service of a Notice of Opposition be made on the Baker and Rannells Firm as it is listed as the "address of record" in the Board. Instead of admitting that it did not comply with the requirements of 37 C.F.R. §2.101(a), it calls its failure to serve the Baker and Rannells Firm a "minor oversight" that should be overlooked because it actually served Applicant at its address in Vancouver, Canada. *See* Opposer's Opposition Brief at 6-7. Compliance with the service requirements of the New Trademark Rules is not something that should be "excused." Applicant and Opposer—both seasoned trademark lawyers—are on notice of the New Trademark Rules and have been on notice of the New Trademark Rules since August 1, 2007. Collectively, we are expected to adhere to them. Clearly, Opposer did not adhere to the requirement that service of the Notice of Opposition be made on the "address of record" in the TARR system of the USPTO. As noted in Applicant's initial motion brief, there is no ambiguity in the TARR system report as to who is designated as being the "address of record" in the Office. Assuming, *arguendo*, that there was some ambiguity as to who or what was so designated, Opposer's counsel could have called the Board and inquired. Opposer's Opposition Brief makes no claim of having inquired of the Board before sending its Notice of Opposition and filing the same via ESTTA.

Regarding the latter, Opposer claims that the mere filing of its Notice of Opposition via ESTTA meets the Board's requirement for "proof of service." *See id.* at 3. Opposer continues that "the ESTTA-generated certificate of service reads, 'The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record [*sic*] by First Class Mail on this date.'" *Id.* As noted earlier, the "address of record" is not Applicant's address in

Vancouver, Canada. Thus, Opposer has not met the Board's requirement for adequate proof of service within the opposition period.<sup>1</sup>

Additionally, Opposer also claims that there is some "ambiguity" between Sections 2.101(a) and 2.119 of the New Trademark Rules that would allow Opposer to have "served Applicant at an address of record in the Office" which was not technically the "address of record." *See id.* at 6, fn.2. These sections of the New Trademark Rules are not in conflict with one another. Rather, Section 2.119(a) states that "[e]very paper filed in the [USPTO]...must be on the other parties[,]" and Section 2.101(a) states that "[t]he notice must include proof of service on the applicant, or its attorney...at the correspondence address of record in the Office, as detailed in §§2.101(b) and 2.119." *See* TMBP §§2.119(a) and 2.101(b). The reference back to Section 2.119 requires that the Notice be made to the "correspondence address of record" (which can be found *via* TARR)—nothing more, nothing less.

To be sure, "[u]nder the amended trademark rules, an opposer...will file its complaint with the Board and is required to concurrently serve a copy of its complaint (notice of opposition...), including any exhibits, on the owner of record, or when applicable the attorney or domestic representative designated in the defending application or registration." *See* New Trademark Rules, *supra*, 72 Fed. Reg. 42242 (annexed hereto as Exhibit "A"). This requirement is not to be read in the disjunctive. It is not an "either/or" proposition.<sup>2</sup> The owner of the application either receives the Notice of Opposition or its attorney or domestic representative. In

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<sup>1</sup> On September 9, 2008, Opposer sought a ninety (90) day extension of time to oppose for good cause to investigate its claims. *See* Exhibit "B" hereto (annexing copy of the Extension Request and the Board's Order granting the same). It should be noted that Opposer waited until the very last day of the opposition period, *i.e.*, December 10, 2008, before filing its Notice of Opposition. Therefore, a timely amendment of Opposer's Notice could have only been done on the day of filing—and not on January 26, 2009—when Opposer finally sent the Notice to the appropriate "address of record."

<sup>2</sup> Opposer seems not to suggest that it is either as it admits that its failure to serve the Notice of Opposition on Applicant's attorneys within the opposition period was a "minor oversight."

order to find out where to send the Notice of Opposition, opposers are cautioned by the New Trademark Rules to consult the TARR system and call the Board when in doubt.

Lastly, Opposer argues that the Board should analogize the facts of the instant opposition proceeding to a cancellation proceeding matter “[i]n light of the paucity of authority on this point.” *See* Opposer’s Opposition Brief at 8. While it is true that there has not been much in the way of case law on this subject, Applicant submits that the publication and dissemination of the New Trademark Rules is likely to prevent many, if not, most “oversights” such that there is not likely to be much in the way of case law on this subject. Further, the Board gave an additional reminder/cautionary advice to Opposer when it granted its 90-day request for an extension:

“The USPTO has issued new rules pertaining to TTAB proceedings. **Parties are urged to familiarize themselves with the new rules.**

[...]

**The notice of final rulemaking and a chart summarizing the changes contained in the notice are available for viewing on the TTAB webpage:**

**[www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf)**

**[www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)**

*See* Exhibit “B” hereto (emphasis added). As noted from the above-cited quotation, the Board’s Order granting its 90-day request for an extension provided a hyperlink to find the New Trademark Rules (e.g., the Federal Register sections describing the changes) and a helpful chart describing said changes. Ignoring such rules should and must be at the filer’s peril.

### **C. Opposer’s Reliance on *Equine Touch* is Misplaced**

Toward that end, the New Trademark Rules also clearly specify why it is proper to serve the owner of record in a cancellation proceeding (as opposed to the “correspondence address of

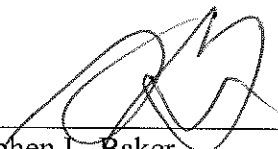
record” in an opposition proceeding). *See* New Trademark Rules, 72 Fed. Reg. at 42243 (“A plaintiff filing a petition for cancellation must serve the owner of the registration, according to Office records, or the domestic representative of the owner[.] A plaintiff filing a petition for cancellation is not expected to serve any attorney who may have represented the registrant before the Office in the prosecution of the application that resulted in issuance of the registrant.”). Hence, the respective rules for cancellation proceedings and opposition proceedings are vastly different such that any supposed reliance on *Equine Touch Found., Inc. v. Equinology, Inc.*, 2009 TTAB LEXIS 25, (Cancellation No. 92050044)(T.T.A.B. Feb. 10, 2009) by Opposer here is misplaced.

## II. CONCLUSION

For all of the above-stated reasons and those noted in Applicant’s initial Motion Brief, Applicant respectfully submits that its Motion to Dismiss for Lack of Service be granted in its entirety.

BAKER and RANNELLS, PA

Dated: March 11, 2009



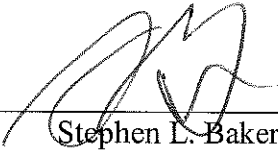
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing APPLICANT'S REPLY BRIEF IN FURTHER SUPPORT OF ITS MOTION TO DISMISS FOR LACK OF SERVICE in *Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores d/b/a KFM Foods International*, Opposition No. 91187963 was served on counsel for Opposer, this 11 day of March, 2009, by sending same via First Class Mail, postage prepaid, to:

Jason K. Schmitz  
Christopher Mackey  
Mayer Brown LLP  
P.O. Box 2828  
Chicago, IL 60690-2828

  
\_\_\_\_\_  
Stephen L. Baker



# **Exhibit “A”**

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Part 2**

[Docket No.: PTO-T-2005-014]

RIN 0651-AB56

**Miscellaneous Changes to Trademark Trial and Appeal Board Rules****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is amending the Trademark Rules of Practice (trademark rules) to require plaintiffs in Trademark Trial and Appeal Board (Board) inter partes proceedings to serve on defendants their complaints or claims; to utilize in Board inter partes proceedings a modified form of the disclosure practices included in the Federal Rules of Civil Procedure; and to delete the option of making submissions to the Board in CD-ROM form. In addition, certain amendments are being made to clarify rules, conform the rules to current practice, and correct typographical errors or deviations from standard terminology.

**DATES:** *Effective Date:* This rule is effective November 1, 2007 except the amendments for the following rules are effective August 31, 2007: 2.105(a); 2.113(a), and removal of (e); 2.116(g); 2.118; 2.119(b)(6); 2.120(d)(1); 2.122(d)(1); 2.126(a)(6), removal of (b) and redesignation of (c) and (d) as (b) and (c); 2.127(a) and (c); 2.129(a); 2.133(a) and (b); 2.142(e)(1); 2.173(a); and 2.176.

*Applicability to pending cases:* The amendment to rule 2.116(g), which makes the Board standard protective order applicable in all inter partes cases applies to all cases pending before the Board as of the effective date of that amendment, except for cases in which the Board's standard protective order, or some other protective order, has already been applied or approved by the Board. The following amendments also apply to all cases pending before the Board as of their effective date: 2.105(a); 2.113(a), and removal of (e); 2.118; 2.119(b)(6); 2.120(d)(1); 2.126(a)(6), removal of (b) and redesignation of (c) and (d) as (b) and (c); 2.127(a) and (c); 2.133(a) and (b); 2.173(a); and 2.176. All other amendments to the rules apply in cases commenced on or after the effective dates of the respective amendments.

**FOR FURTHER INFORMATION CONTACT:** Gerard F. Rogers, Trademark Trial and Appeal Board, by telephone at (571)

272-4299, by mail addressed to Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA, 22313-1451, attention Gerard F. Rogers, or by facsimile to (571) 273-0059, marked to the attention of Gerard F. Rogers.

Information may also be obtained via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for the full text of the notice of proposed rule making that preceded this final rule, and the full text of comments received in response to the notice of proposed rule making.

**SUPPLEMENTARY INFORMATION:** The amended rules will increase the efficiency of the processes for commencing inter partes cases, and take account of the Board's deployment in recent years of electronic filing options and the increased availability and use of facsimile and e-mail as methods of communication between parties involved in inter partes cases. Also, the amended rules will increase the efficiency by which discovery and pretrial information is exchanged between parties to inter partes cases, by adopting a modified form of the disclosure practice that is uniformly followed in the federal district courts. These practices have been found in the courts to enhance settlement prospects and to lead to earlier settlement of cases; and for cases that do not settle, disclosure has been found to promote greater exchange of information, leading to increased procedural fairness and a greater likelihood that cases eventually determined on their merits are determined on a fairly created record. The amendments also include minor modifications necessary to make corrections or updates to certain rules and conform those rules to current practice.

As of November 1, 2007, the following notice originally published in the USPTO Official Gazette on January 15, 1994, at 1159 TMOG 14, will no longer have effect: "Notice Regarding Inapplicability of December 1, 1993 Changes in Federal Rules of Civil Procedure to TTAB Cases."

**I. Commencement of Proceedings**

Plaintiffs in Board proceedings include an opposer that files a notice of opposition against an application, a petitioner that files a petition for cancellation of a registration, and a concurrent use applicant whose concurrent use application sets forth details about the concurrent use applicant's claim of entitlement to a concurrent use registration. The former process by which a plaintiff in a Board proceeding filed notice of its complaint

(or claim of right to a concurrent use registration) required the plaintiff to prepare as many copies of its complaint (or claim of right, i.e., concurrent use application) as there would be defendants in the action. The plaintiff would then file the requisite copies with the original, for subsequent forwarding by the Board to the defendant or defendants. Occasionally, before the Board could forward the copies to the defendant or defendants, the plaintiff would engage in additional correspondence with the Board, to provide the Board with updated correspondence address information the plaintiff had uncovered in its investigation of the adverse applications, registrations or marks, particularly in cancellation and concurrent use proceedings.

Under the amended trademark rules, the initiation of a Board proceeding will be more efficient, because a plaintiff will serve copies directly on defendants. Use of a direct service approach recognizes that plaintiffs and defendants often are in contact before the plaintiff files its complaint or claim, and also recognizes that continuation of direct communication is vital both for promoting possible settlement of claims and for ensuring cooperation and procedural efficiency in the early stages of a proceeding.

In recent years, the Board has deployed its ESTTA system, the Electronic System for Trademark Trials and Appeals, so that virtually all filings can be submitted electronically. In addition, more and more parties to Board proceedings are choosing to utilize fax or e-mail options for communicating with each other during an inter partes proceeding, either in lieu of using the mail or in combination with use of the mail.

Under the amended trademark rules, an opposer or petitioner will file its complaint with the Board and is required to concurrently serve a copy of its complaint (notice of opposition or petition for cancellation), including any exhibits, on the owner of record, or when applicable the attorney or domestic representative designated in the defending application or registration, or in assignment records regarding the application or registration. A concurrent use applicant, however, will not have to serve copies of its application on any defending applicant, registrant or common law mark owner until notification of commencement of the concurrent use proceeding is issued by the Board, as discussed below.

A plaintiff filing a notice of opposition must serve the owner of the application, according to Office records,

or the attorney or domestic representative of the owner, if Office records designate that an attorney or domestic representative should receive correspondence for the owner of the application. A plaintiff filing a petition for cancellation must serve the owner of the registration, according to Office records, or the domestic representative of the owner, if Office records designate that a domestic representative should receive correspondence for the owner of the registration. A plaintiff filing a petition for cancellation is not expected to serve any attorney who may have represented the registrant before the Office in the prosecution of the application that resulted in issuance of the registration. (It is noted, however, that an attorney who was designated as a domestic representative during prosecution of an application is considered by the Office to continue in such role unless the appointment as domestic representative was revoked or a different domestic representative was subsequently appointed.) Whether a plaintiff should serve the owner directly, an attorney, or a domestic representative depends on what Office records provide as the correspondence address.

To determine the correspondence address of record for an applicant or registrant, the plaintiff must check the Trademark Applications and Registrations Retrieval (TARR) system at the following web address: <http://tarr.uspto.gov>. (This system also is accessible via links from the Office's main Web site.) A plaintiff in an opposition or cancellation proceeding need only serve a copy of its notice of opposition or petition for cancellation to the correspondence address of record. The TARR display of information about a particular application or registration also includes an active link to assignment (including changes of name) information, if any exists in the Office's assignments database. For questions about correspondence address information in TARR, or about assignment records and determining the current owner of an application or registration, plaintiffs may contact the Board's customer service representatives at the main telephone number for the Board, listed on the Web site <http://www.uspto.gov/main/contacts.htm>.

A plaintiff in an opposition or cancellation is not required to serve a copy of its notice of opposition or petition for cancellation to any address other than the address listed in the TARR system. A plaintiff may wish to serve a courtesy copy on any party at any address the plaintiff may have reason to believe is more current than

the address for that party listed in Office records. A plaintiff may wish to serve a courtesy copy on any party the plaintiff believes has an ownership interest in the relevant application or registration (e.g., an assignee or survivor of merger that had not recorded the document of transfer in the Office but was known to the plaintiff) at the correspondence address known to the plaintiff. It is generally in a plaintiff's interest to have the real party in interest apprised of the existence of the Board opposition or cancellation proceeding, so that any judgment eventually obtained will be binding on the correct party.

As for service obligations of a concurrent use applicant (i.e., the plaintiff in a concurrent use proceeding), current practice requires such party to provide, for forwarding by the Board, as many copies of its application as are necessary to forward one to each person or entity listed in the concurrent use application as an exception to the concurrent use applicant's rights (i.e., excepted parties, the defendants in the concurrent use proceeding). Existing practice requires the concurrent use applicant to provide correspondence address information for excepted parties, even if the excepted parties do not own applications or registrations for marks listed in the TARR system. The amended trademark rules continue the requirement that the concurrent use applicant provide correspondence address information for excepted parties. The new rules dispense with the requirement that the concurrent use applicant file copies of its claim of right to a concurrent use registration, i.e., copies of its concurrent use application, for service by the Board on each excepted party. Under the amended trademark rules, the concurrent use applicant must promptly serve a copy of its application on each of the excepted parties following its receipt of a notice from the Board that the concurrent use proceeding has been instituted.

All plaintiffs, including concurrent use applicants, bear the same service obligations. Specifically, they must serve copies by one of the methods provided in Trademark Rule 2.119, 37 CFR 2.119. Plaintiffs are neither required nor expected to follow the provisions of Rules 4, 4.1 or 5 of the Federal Rules of Civil Procedure or, for defendants located outside the United States, any international convention regarding service of process. The parties may agree to use e-mail to communicate with each other and for forwarding of service copies. A plaintiff, however, may not serve its complaint or concurrent use application on a

defendant by e-mail unless the defendant has agreed with the plaintiff to accept such service, notwithstanding that the defendant may have authorized the Office to communicate with it by e-mail.

If a service copy is returned to plaintiff as undeliverable, plaintiff must notify the Board within ten (10) days of receipt of the returned service copy, or of any notice indicating that the service copy could not be delivered. Notification to the Board of failure of service may be provided by any means available for filing pleadings, motions, etc., keeping in mind that business with the Office is generally to be conducted in writing. Therefore, notice of failure of service may be provided, for example, by written notice mailed to the Board, or by appropriate filing through ESTTA. A plaintiff is under no obligation to search for current correspondence address information for, or investigate the whereabouts of, any defendant the plaintiff is unable to serve. However, notice to the Board of failure of service must include, if known, any new address information for the defendant whose service copy was returned to the plaintiff or reported to be undeliverable. For example, if a service copy returned by the United States Postal Service because of an expired forwarding order nonetheless lists the addressee's new address, then that must be reported to the Board. Similarly, if the plaintiff whose attempt at service has been unsuccessful discovers a new address for a defendant through independent means or voluntary investigation, then it must report the results of its investigation in its notice to the Board of the failure of service. In any case in which a plaintiff notifies the Board that a service copy sent to a defendant was returned or not delivered, including any case in which the notification includes a new address for the defendant discovered by or reported to the plaintiff, the Board will effect service.

The Board will, after a notice of opposition or petition for cancellation is filed, or after a concurrent use application is published for opposition and found free of any opposition, send notice to all parties to the proceeding, noting the filing of the complaint, or publication of the concurrent use application. The notice will set the due date for an answer, and the discovery and trial schedule. Notification from the Board may be sent by e-mail when a party has provided an e-mail address. A party providing an e-mail address includes a plaintiff providing an e-mail address when filing any paper by ESTTA or with a complaint delivered by other means, an applicant that

authorized the Office to communicate with it by e-mail when it filed its application, and any registrant whose registration file record includes such authorization. In any proceeding, an undelivered notice from the Board of the commencement of a proceeding may result in notice by publication in the Official Gazette, available via the Office's Web site (<http://www.uspto.gov>).

## II. Adoption of a Disclosure Model

In 1993, significant amendments to the Federal Rules of Civil Procedure (federal rules) implemented a system requiring parties litigating in the federal courts to, among other things, disclose certain information and/or documents and things without waiting for discovery requests, and to meet and confer to discuss settlement options and plans for disclosure and discovery if settlement were not possible (disclosure regime). Individual district courts were permitted to opt out of this disclosure regime.

In 2000, the federal rules were further amended, eliminating the option for individual courts to opt out of the most significant changes of the disclosure regime.

By notice issued January 15, 1994 (and published in the Official Gazette at 1159 TMOG 14), the Office announced the Board would not follow many of the 1993 changes to the federal rules, including the disclosure regime established by the amended rules. This notice specifically stated, "the Office's Public Advisory Committee for Trademark Affairs has recommended that incorporation of the [1993] amendments [related to conferencing and disclosure] in Board practice be deferred until the Office can evaluate the effects of the amendments on civil actions."

The Office subsequently amended the Trademark Rules of Practice in 1998. The original notice of amendment issued September 29, 1998 (and was published at 1214 TMOG 145); and a correction notice issued October 20, 1998 (and was published at 1215 TMOG 64). While the Office did not adopt a disclosure regime for Board inter partes cases as an element of these amendments, the Office noted that the Board would continue to monitor recurring procedural issues in Board cases and that in the future the Office might propose and adopt additional changes to practice.

In accordance with the recommendation of the Public Advisory Committee for Trademark Affairs, and to evaluate the effects of the 1993 and 2000 amendments on civil actions, the Office

reviewed an empirical study and numerous other available articles and reports on the subject of the disclosure regime followed in the courts. The empirical study reported that the new disclosure regime has been successful in the courts:

In general, initial disclosure appears to be having its intended effects. Among those attorneys who believed there was an impact, the effects were most often of the type intended by the drafters of the 1993 amendments. Far more attorneys reported that initial disclosure decreased litigation expense, time from filing to disposition, the amount of discovery, and the number of discovery disputes than said it increased them. At the same time, many more attorneys said initial disclosure increased overall procedural fairness, the fairness of the case outcome, and the prospects of settlement than said it decreased them.

Thomas E. Willging, Donna Stienstra, John Shapard & Dean Miletich, *An Empirical Study of Discovery and Disclosure Practice Under the 1993 Federal Rule Amendments*, 39 B.C.L. Rev. 525, 534–35 (May 1998).

The Office concluded from its review of the empirical study and other materials that use of a modified disclosure regime in Board proceedings, will increase the possibility of parties settling a Board proceeding and doing so sooner. In addition, even if parties do not settle the case, disclosure will promote more efficient discovery and trial, reduce incidents of unfair surprise, and increase the likelihood of fair disposition of the parties' claims and defenses. In large part, disclosure will serve as a substitute for a certain amount of traditional discovery and will provide a more efficient means for exchange of information that otherwise would require the parties to serve traditional discovery requests and responses thereto.

Following many consultations with the Trademark Public Advisory Committee (successor to the Public Advisory Committee for Trademark Affairs) or subcommittees thereof, the Office proposed adoption of a disclosure regime for Board inter partes proceedings, in a Notice of Proposed Rule Making (NPRM) at 71 Fed. Reg. 2498 (January 17, 2006). The NPRM and comments received in response thereto are available for viewing at the <http://www.regulations.gov> web portal.

One subject related to the adoption of a disclosure regime and covered in the NPRM is the applicability of the Board's standard order for protecting confidential or otherwise sensitive information and documents. By notice published in the Office's Official Gazette (O.G.) on June 20, 2000 (1235

TMOG 70), the Office noted the Board's adoption of that standard order. The O.G. notice explained that the standard order was promulgated in response to many public requests for such an order and explained that the standard order could be adopted by parties as published or with modifications. The O.G. notice also noted that the Board could impose the order in appropriate cases. In fact, since publication of the O.G. notice, it has become quite routine for the Board to impose the order in any inter partes proceeding in which the efficient conduct of discovery is hampered by the parties' inability to agree on a protective order.

In the disclosure regime established by this final rule, the Board's standard protective order is applicable in all cases. The Board's notice of the institution of a proceeding will advise parties that the standard protective order applies and that it is available on the Office's Web site or, by request made to the Board, in hard copy form. The applicability of this standard protective order does not make all submissions confidential. Parties must utilize its provisions to protect confidential information. Neither does the applicability of the standard order preclude a party, when appropriate, from moving for a protective order under applicable trademark or federal rules, when the standard order does not cover the extant circumstances or is viewed by the moving party as providing insufficient protection. As under current practice, parties are free to agree to modify the standard protective order. It should be routine for parties to discuss possible modification in the disclosure/discovery/settlement conference (discovery conference) that is a part of the disclosure regime established by this final rule. Absent a stipulation to vary the terms of the standard protective order, approved by the Board, or an order by the Board granting a party's motion to use an alternative order, the parties must abide by the standard order.

### A. The Schedule for Cases Under the Disclosure Model

The Board's notice of the commencement of the proceeding (commonly referred to as the institution order) will set forth disclosure, discovery and trial-related deadlines, as illustrated below.

The institution order will set forth specific dates for the various phases in a case. Since each deadline or phase is measured from the date of the institution order, the parentheticals explain the total number of days, as

# **Exhibit “B”**

ESTTA Tracking number: **ESTTA235428**

Filing date: **09/09/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: **Flores, Karlo**  
Application Serial Number: **77258474**  
Application Filing Date: **08/17/2007**  
Mark: **73% INTENSE DARK**  
Date of Publication **08/12/2008**

**First 90 Day Request for Extension of Time to Oppose for Good Cause**

Pursuant to 37 C.F.R. Section 2.102, Chocoladefabriken Lindt & Spr&uuml;ngli AG, Seestra&szlig;e 204, Kilchberg, CH-8802, SWITZERLAND, a corporation organized under the laws of Switzerland, respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown.

Potential opposer believes that good cause is established for this request by:

- The potential opposer needs additional time to investigate the claim

The time within which to file a notice of opposition is set to expire on 09/11/2008. Chocoladefabriken Lindt & Spr&uuml;ngli AG respectfully requests that the time period within which to file an opposition be extended until 12/10/2008.

Respectfully submitted,

/jks/

09/09/2008

**Jason K. Schmitz**

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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: September 9, 2008

Serial No.: 77258474  
ESTTA TRACKING NO: ESTTA235428

The request to extend time to oppose is granted until  
12/10/2008 on behalf of potential opposer **Chocoladefabriken  
Lindt & Sprüngli AG**

Please do not hesitate to contact the Trademark Trial and  
Appeal Board at (571)272-8500 if you have any questions  
relating to this extension.

**New Developments at the Trademark Trial and Appeal Board**

TTAB forms for electronic filing of extensions of time to  
oppose, notices of opposition, petition for cancellation, notice  
of ex parte appeal, and inter partes filings are now available  
at <http://estta.uspto.gov>. Images of TTAB proceeding files can  
be viewed using TTABVue at <http://ttabvue.uspto.gov>.

**TRADEMARK TRIAL AND APPEAL BOARD RULE CHANGES**

The USPTO has issued new rules pertaining to TTAB  
proceedings. Parties are urged to familiarize themselves  
with the new rules.

Among other changes, for any notice of opposition filed on  
or after November 1, 2007, the new rules require an opposer  
to provide proof of service of the notice of opposition  
upon the applicant at the time the notice of opposition is  
filed. Trademark Rule 2.101. (Parallel amendments to  
Trademark Rule 2.111 require a petitioner to include proof  
of service of the petition for cancellation.) Service may

be made by any of the means set out in Trademark Rule 2.119(b). A certificate of service is adequate proof of service; service by a process server is not necessary. A notice of opposition (or petition for cancellation) filed without a certificate of service will not be instituted.

The notice of final rulemaking and a chart summarizing the changes contained in the notice are available for viewing on the TTAB web page:

[www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf)

[www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)