

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

Mailed: December 16, 2010

Opposition No. 91191601

THE LARYNGEAL MASK COMPANY LIMITED

v.

ANIBAL DE OLIVEIRA FORTUNA

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the scheduling order dated May 20, 2010, the discovery period closed on August 11, 2010. On September 30, 2010, applicant filed a motion to reopen the discovery period so that his admissions requests, served on opposer on August 31, 2010, could be deemed timely-served. Opposer filed a response in opposition to such motion; applicant filed a reply thereto which included several new requests; and opposer filed a response to the additional requests in applicant's reply.

Applicant's motion to reopen discovery for a limited purpose

In support of his motion to reopen the discovery period for a limited purpose, applicant argues that he was confused by opposer's discovery requests, which applicant believes were extensive; and that applicant lives in Brazil and misunderstood the dates as using the European notation, adopted by Brazil, where the day is written before the month, and believed that the close of discovery was November 8, 2010. Applicant seeks the

limited reopening of the discovery period in order to obtain responses to his late-served admissions requests.

In response, opposer argues that applicant has not demonstrated excusable neglect, the standard required to be shown to reopen an expired period. Opposer contends that applicant's explanation concerning his misunderstanding of the dates is not plausible because the schedule contains dates such as "9/25/10" which should have put applicant on notice that the U.S. convention for dates was operative because there are not twenty-five months in a year. Opposer also argues that applicant is acting in bad faith because he has failed to take any discovery and because he has stated his plans to call no witnesses; that reopening discovery will needlessly lengthen the proceeding; and that opposer is prejudiced by this delay and the additional resources required to respond to the discovery requests. Opposer contends that any reopening of discovery is futile because applicant did not serve his initial disclosures and is, consequently, precluded from seeking any discovery.

In reply, applicant again asks for the reopening "in order to provide Opposer time to legally accept and ANSWER TO THE FIRST AND ONLY Applicant's request for Admission to Opposer."¹ Opposer further explains that he was also confused by the "successive changes in the date table." Applicant states that his admissions

¹ Although applicant admits he mailed his answers to opposer's third request for admissions on September 13, 2010 instead of September 10, 2010, applicant does not ask for any relief with respect to the late-served admissions.

requests would provide important evidence for his defense. Applicant has not addressed why he did not make his initial disclosures or otherwise indicated that he has served his initial disclosures.

Trademark Rule 2.120(a)(3) provides in relevant part that "[a] party must make its initial disclosures prior to seeking discovery."² See also *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010). Thus, because applicant has not served his initial disclosures on opposer, applicant may not take discovery. Accordingly, applicant's motion to reopen discovery for a limited purpose is denied.³

Applicant's request that evidence be entered

Applicant, for the first time in his reply on his motion to reopen, asks the Board to acknowledge certain evidence in the nature of an article titled "Practice Guidelines for Management of the Difficult Airway." The article was published in May 2003 in the publication Anesthesiology, V. 98, No. 5.

² Initial disclosures required in Board cases are: (i) the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment; and (ii) a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment. Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii).

³ Inasmuch as the ability to take discovery is contingent upon the requirement for service of initial disclosures under Trademark Rule 2.120(a)(3), and has not been met here, the Board need not consider whether applicant has shown excusable neglect so as to reopen the discovery period for the stated, limited purpose.

In response to the new matter presented by applicant, opposer moves to strike the request to seek admission of evidence as untimely on the basis that it was not introduced during applicant's assigned testimony period, and improper because it was not introduced by way of a notice of reliance.⁴

A party may not take testimony or submit evidence except during its assigned testimony (e.g., trial) period.⁵ Trademark Rule 2.121(a). In accordance with the schedule in the Board's order of October 5, 2010, applicant's thirty-day testimony period was set to close on February 13, 2011 (opening on January 15, 2011).

Accordingly, applicant's submission of the article is premature and cannot be entered as evidence in this case at this time. Opposer's motion to strike is granted without prejudice. That is, for the reasons stated above, applicant's submission is not entered as evidence at this time. However, applicant may submit the article under a notice of reliance during his assigned testimony period which, in view of the suspension discussed below, may be reset at for a different time. Applicant is referred to TBMP § 704.08 for information concerning introduction of printed publications during the assigned testimony period.

⁴ Opposer also characterizes applicant's reply as including a motion to compel responses to the late-served admissions requests. However, the Board does not interpret applicant's reply in such a manner.

⁵ A certain exception, not at issue here, exists with respect to a plaintiff's pleaded registration. See Trademark Rule 2.122(d)(1).

Proceedings are suspended

Proceedings herein are suspended pending disposition of opposer's motion for summary judgment, filed October 29, 2010. Applicant filed a response on December 10, 2010. A reply, if any, is due in accordance with Trademark Rule 2.127(e)(1) and based on the December 10th response date. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

Information about Board proceedings

The Board notes that applicant is representing himself. The following procedural information is provided to assist applicant in better understanding procedural requirements.

NATURE OF BOARD PROCEEDINGS

Applicant is advised that an inter partes proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then

filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.⁶

REQUIREMENT FOR SERVICE OF PAPERS

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made.⁷ Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

⁶ As applicant is now aware, the printed publication he seeks to enter cannot be made part of the evidentiary record at this time because it must be introduced during applicant's testimony period in the proper manner.

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. *See also* TBMP § 113 (2d ed. rev. 2004).

OPTION OF E-MAIL SERVICE

The parties may agree to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic transmission when mutually agreed upon by the parties."). Should the parties decide to continue using traditional service options, the parties may consider agreeing at least to courtesy email notification when any paper is served.⁸

THE BOARD'S STANDARDIZED PROTECTIVE ORDER IS IN PLACE

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may substitute a stipulated protective agreement (signed by both parties). However, the Board will not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

REPRESENTATION

⁷ The Board notes that applicant included a certificate of service with his filings and appears aware of this requirement.

⁸ Where the parties agree to service by email, the additional five days to for responding is not available. See Trademark Rule 2.119(c); and TBMP § 113 (2d ed. rev. 2004).

The Board notes applicant is representing himself. Applicant may do so. However, it should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure.

ELECTRONIC RESOURCES

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, www.uspto.gov. The TTAB homepage provides electronic access to the Board's standardized protective order, a chart of the new rules and the text of the new rules (effective August 31, 2007 and November 1, 2007), and answers to frequently asked questions. Other useful databases include the ESTTA filing system for Board filings and TTABVUE for status and prosecution history.

The Board's records are public records. Thus, applicant may use the TTABVUE database to view other cases to get an idea of the course of Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.
