

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

CME

Mailed: February 28, 2017

Opposition No. 91219067 (parent)

*New Jersey Turnpike Authority*

*v.*

*Jersey Boardwalk Franchising Co., Inc.*

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Cancellation No. 92059657

*New Jersey Turnpike Authority*

*v.*

*Boardwalk Pizza, Inc.*

Christen M. English, Interlocutory Attorney:

These consolidated cases now come up on Opposer/Petitioner's motion, filed November 1, 2016 ("November 2016 Motion"), to strike Exhibits 2-10 of Applicant and Respondent's notice of reliance, filed October 19, 2016, and Opposer/Petitioner's motion, filed December 14, 2016 ("December 2016 Motion), to strike as untimely Applicant and Respondent's response to the November 2016 Motion.<sup>1</sup> The November 2016 motion is fully briefed. Applicant and Respondent did not respond to the December 2016 Motion.

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<sup>1</sup> The December 2016 Motion is combined with the reply brief that Opposer/Petitioner filed in support of its November 2016 Motion.

The Board first addresses the December 2016 Motion. Because Opposer/Petitioner served its motion on November 1, 2016 via first class mail,<sup>2</sup> a response brief was due on November 21, 2016. Trademark Rule 2.119(c) and Trademark Rule 2.127(a).<sup>3</sup> Accordingly, Applicant and Respondent's brief, filed November 29, 2016, is untimely. The December 2016 Motion is granted and Applicant and Respondent's response brief will be given no consideration.

Notwithstanding the foregoing, the Board exercises its discretion to consider the November 2016 Motion on its merits. The Board has carefully considered Opposer/Petitioner's arguments and does not recount the facts or arguments here, except as necessary to explain the decision.

***Exhibits 2-6***

Exhibits 2-4 of Applicant and Respondent's notice of reliance consist of briefs and accompanying exhibits that the parties filed in a civil action before the United States District Court for the District of New Jersey in support of and in opposition to a motion to dismiss. 27 TTABVUE 14-182. Exhibits 5 and 6 are the District Court's opinion and order regarding the motion. *Id.* at 183-192. In their notice of reliance, Applicant and Respondent request that the Board take judicial notice of

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<sup>2</sup> The certificate of service indicates that Opposer/Petitioner also served its motion via email, but it is not clear whether the parties stipulated to email service, and at the time Opposer/Petitioner filed its motion, Trademark Rule 2.119 permitted email service only upon mutual agreement of the parties.

<sup>3</sup> When Opposer/Petitioner's filed its motion, Trademark Rule 2.119 provided five additional days to the response period for papers served via first class mail. Effective January 14, 2017, Trademark Rule 2.119 was amended to require that all papers be served via email and Trademark Rule 2.127(a) was amended to provide a twenty-day response period for motions (other than motions for summary judgment). A summary of recent changes to the Trademark Rules is provided at the end of this order.

these documents. *Id.* at 3. Opposer/Petitioner argues that these exhibits should be stricken because they are not facts that can be judicially noticed and Applicant and Respondent have not otherwise specified the rule under which these exhibits are submitted. 28 TTABVUE 5-6.

The Board need not consider whether it is appropriate to take judicial notice of Exhibits 2-6. Trademark Rule 2.122(e) provides that official records may be introduced via notice of reliance. The briefs at Exhibits 2-4 bear headings identifying the civil action number and date the documents were filed with the District Court. Because Exhibits 2-4 reflect that the documents were received by the District Court, these documents constitute official records that may be submitted via notice of reliance. *Cf. Brooks v. Creative Arts by Calloway LLC*, 93 USPQ2d 1823, 1826 (TTAB 2010) (finding briefs not properly introduced under notice of reliance as official records because the documents did not reflect that they were received by the District Court or Court of Appeals). The opinion and order of the District Court at Exhibits 5-6 also are official records. *Hard Rock Cafe Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000) (Board decision on summary judgment in companion proceeding was properly submitted under notice of reliance as an official record under Trademark Rule 2.122(e)).

Notwithstanding the foregoing, the notice of reliance is deficient because Applicant and Respondent have not specified “the pages [of the exhibits] to be read” nor have they “indicate[d] generally the relevance of the evidence and associate[d] it with one or more issues in the proceeding.” Trademark Rule 2.122(e) and

Trademark Rule 2.122(g). These defects, however, are curable. Trademark Rule 2.122(g). Accordingly, Opposer/Petitioner's motion to strike is granted, with leave to cure. *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014). Applicant and Respondent are allowed until fifteen (15) days from the mailing date of this order to file an amended notice of reliance specifying the pages of Exhibits 2-6 to be read and generally explaining the relevance of the exhibits and the issues in these consolidated proceedings to which the exhibits relate, failing which Exhibits 2-6 will not be considered.<sup>4</sup> *Id.*; *Heaton Enters. of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1844 n.6 (TTAB 1988) (where registrant was given leave to amend notice of reliance to correct deficiencies but failed to do so, documents stricken). Applicant and Respondent should not resubmit Exhibits 2-6 with the amended notice of reliance. *FUJIFILM SonoSite*, 111 USPQ2d at 1237.

### ***Exhibits 7-8***

Exhibit 7 to the notice of reliance consists of portions of the testimony deposition of John O'Hern, Chief Operating Officer and Deputy Executive Director of Opposer/Petitioner. Exhibit 8 is a portion of Exhibit JBF-2 to the O'Hern Deposition.<sup>5</sup> Testimony deposition transcripts should not be submitted under a

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<sup>4</sup> If Applicant and Respondent cure the defect in their notice of reliance, the Board's determination that Exhibits 2-6 are official records does not prevent Opposer/Petitioner from submitting arguments in its final brief regarding the weight (if any) that the Board should accord this evidence.

<sup>5</sup> Opposer/Petitioner argues that Exhibit 8 "is clearly labeled as confidential," and that Applicant and Respondent violated the standard protective order in failing to file the document under seal. Exhibit 8, however, appears to be an advertisement that by its nature would not be confidential. Opposer/Petitioner is allowed until fifteen days from the mailing date of this order to file a paper explaining why Exhibit 8 should be treated as confidential. If Opposer/Petitioner demonstrates that Exhibit 8 is truly a confidential document, the

notice of reliance. *See, e.g., Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009); *Paramount Pictures Corp. v. Romulan Invasions*, 7 USPQ2d 1897, 1898 n.2 (TTAB 1988); TBMP § 703.01(k). Moreover, Opposer/Petitioner filed a complete copy of the O'Hern Deposition and exhibits on July 21, 2016, and therefore, Applicant and Respondent need not – and should not – have filed excerpts from the deposition transcript.<sup>6</sup> Trademark Rule 2.122(a) (When evidence has been properly made of record, any party may rely on it for any purpose permitted by the Federal Rules of Evidence); *see also Entex Indus., Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.1 (TTAB 1982) (notice of reliance on exhibits introduced in connection with testimony superfluous). Accordingly, Opposer/Petitioner's motion is granted with respect to Exhibits 7 and 8, and these exhibits are stricken.

***Exhibits 9-10***

Exhibit 9 consists of excerpts from the discovery deposition of Paul DiMatteo, Chief Executive Officer of Applicant and President of Respondent. Exhibit 10 consists of excerpts from the discovery deposition of Laureen Parratt, Chief Financial Officer of Applicant and Vice President of Respondent. During its testimony period, Opposer/Petitioner submitted portions of the DiMatteo and

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Board will mark Applicant and Respondent's notice of reliance confidential and require Applicant and Respondent to file a public version of the notice of reliance with Exhibit 8 redacted. Otherwise, Exhibit 8 will remain publicly accessible.

<sup>6</sup> In their final brief, Applicant and Respondent may direct the Board's attention to specific sections of the O'Hern Deposition, if so desired. *See* Trademark Rule 2.142(b)(3) (explaining how to cite evidence in the record); *Turdin v. Trilobite Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Parratt discovery depositions. Opposer/Petitioner argues that Applicant and Respondent did not file Exhibits 9 and 10 pursuant to Trademark Rule 2.120(k)(4) “to make not misleading” those portions of the deposition transcripts that Opposer/Petitioner submitted, but rather filed the exhibits as “testimony in their own favor.” 28 TTABVUE 9.

When a party introduces portions of a discovery deposition transcript during its testimony period, the adverse party may submit “under notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party.” Trademark Rule 2.120(k)(4). The adverse party, however, must provide a written statement explaining why it needs to rely on each additional discovery deposition excerpt. *Id.* Applicant and Respondent have not provided any such explanation, but again, this defect is curable. Accordingly, Applicant and Respondent are allowed until fifteen (15) days from the mailing date of this order to file an amended notice of reliance explaining why they need to rely on Exhibits 9 and 10, failing which the Board may refuse to consider these exhibits at trial. *Id.* Applicant and Respondent should not resubmit Exhibits 9 and 10 with the amended notice of reliance.

Determining Opposer/Petitioner’s argument that the DiMatteo and Parratt deposition excerpts are not properly submitted under Trademark Rule 2.120(k)(4), but rather constitute improper trial testimony would require the Board to examine the substance of the deposition transcripts, which the Board will not do prior to final decision. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003)

(substantive evidentiary issues are deferred until final decision); TBMP § 707.02(c).

Accordingly, consideration of this argument is deferred until final decision.

Proceedings are resumed and dates are reset as follows:

Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	March 15, 2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	April 29, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	May 14, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	June 13, 2017
Brief for plaintiff due	August 12, 2017
Brief for defendant and plaintiff in the counterclaim due	September 11, 2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	October 11, 2017
Reply brief, if any, for plaintiff in the counterclaim due	October 26, 2017

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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**NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board’s home page on the uspto.gov website:  
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- A chart summarizing the affected rules and changes:  
<http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf>

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.



- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.

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