

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wbc

Mailed: April 19, 2017

Opposition No. 91219631

Meeshaa Inc., dba Diamond Essence

v.

Anaya Gems, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes before the Board on Opposer's motion to strike (filed December 26, 2016) Applicant's December 14 and 19, 2016 responses¹ to Opposer's November 8, 2016 motion for summary judgment. The motion to strike is fully briefed.²

As an initial matter, Applicant's response to the motion to strike was filed February 8, 2017. A brief in response to a motion, except a motion for summary judgment, must be filed within twenty days from the date of service of the motion. Trademark Rule 2.127(a). If a brief in opposition to a motion, or a reply brief in support of the motion, is not timely filed, it may be stricken, or given

¹ Applicant argues that it attempted to file its response to the motion for summary judgment on December 14, 2016 but inadvertently omitted certain pages of its response. On December 19, 2016, Applicant submitted the missing pages of its response.

² The Board has considered the parties' submissions. The parties' arguments are set forth in their respective briefs and will not be summarized herein except as necessary to explain the Board's order. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

no consideration, by the Board. *See, e.g., Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 620 (TTAB 1986). Whether the Board decides to grant a motion as conceded or consider the motion on its merits is a matter of discretion. *See, e.g., DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1947 n.3 (TTAB 2008); *Consolidated Foods Corp.*, 229 USPQ at 620.

Inasmuch as Applicant's response to Opposer's December 26, 2016 motion to strike was filed in excess of twenty days from the date of service of the motion, the Board, in its discretion, will give the response no consideration.³ Notwithstanding the foregoing, it is clear Applicant does not concede the motion to strike. The Board, in its discretion, may also decline to treat an uncontested motion as conceded and may grant or deny the motion on its merits. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003). Accordingly, the Board declines to consider the motion to strike as conceded and will consider the motion on its merits.

Opposer seeks to strike Applicant's response and cross-motion for summary judgment arguing the filing is untimely and should not be considered by the

³ The Board further notes that Applicant's response was improperly served because it was not served by email as required by the Board's amended rules. Pursuant to Trademark Rule 2.119(b), service of submissions filed with the Board and any paper served on a party not required to be filed with the Board, must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances. Failure to comply with the Board's service requirements may result in the Board not considering the filing.

Board. When a motion for summary judgment is filed, a brief in response, or a motion under Fed. R. Civ. P. 56(d), must be filed within thirty days from the date of service of the motion. *See* TBMP § 528.02. As noted, an untimely brief filed in response to a motion may be stricken, or given no consideration, by the Board in its discretion. *See, e.g., Consolidated Foods Corp.*, 229 USPQ at 620.

Here, Opposer's motion for summary judgment was filed November 8, 2016 and Applicant's response thereto was originally filed December 14, 2016 and resubmitted on December 19, 2016 along with pages that were missing from the December 14, 2016 filing. By either date (December 14 or 19, 2016), Applicant's response was filed later than thirty days from the date of service of Opposer's motion for summary judgment. In short, Applicant's response is untimely.

However, in this instance, because of the potentially dispositive nature of the motion for summary judgment, the Board, in its discretion, will consider the late filed combined response and cross-motion for summary judgment. *See, e.g., Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1149 n.1 (TTAB 2003). In view thereof, Opposer's motion to strike is **denied**.

It has not escaped the Board's notice that Applicant has filed late responses to both the motion for summary judgment and the motion to strike. Applicant, represented by counsel, is advised that the Board will look with disfavor upon any further failure to comply with deadlines set by the Board or the Trademark Rules of Practice.

The Board suspended briefing for the motion for summary judgment pending disposition of the motion to strike and finds it advisable to reset the parties response times for the pending motions for summary judgment. The Board encourages parties to file combined responses/replies because it reduces the number of filings and enables the Board to more efficiently determine motions. For this reason, the Board finds that granting Opposer additional time to file a *combined* response and reply brief does not contravene Trademark Rule 2.127(e), which provides that the deadline to file a reply brief will not be extended.

In view thereof, Opposer's combined response⁴ and reply⁵ is due by **May 19, 2017**. Applicant's reply brief for its cross-motion for summary judgment, if any, is due pursuant to Trademark Rule 2.127.

Proceedings remain suspended pending disposition of the pending motions for summary judgment.

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:

⁴ To Applicant's December 19, 2016 cross-motion for summary judgment.

⁵ If any, to the November 8, 2016 motion for summary judgment.

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- 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/RulesChart_12_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.