

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

Butler/Faint

Mailed: March 14, 2017

Opposition No. 91228850

Lacoste Alligator S.A.

v.

Rich C. Young

By the Trademark Trial and Appeal Board:

On February 15, 2017, Opposer filed a motion to compel initial disclosures.¹ The certificate of service indicates the motion was served on Applicant by email on the same day. By order dated March 1, 2017, the Board suspended proceedings pending disposition of the motion and ordered that “[t]he parties should not file any paper which is not germane to the motion.” On March 7, 2017, Applicant filed a request for a six-month extension of time to respond to Opposer’s motion. Applicant’s submission was filed in paper form and includes 1) a copy of a “Voluntary Amendment” filed through TEAS with an Internet Transmission Date of February 13, 2017; and 2) a copy of an ESTTA form denying an extension of time to file an opposition (“potential opposition”). Applicant’s March 7th submission does not show proof of service on Opposer.

¹ Initial disclosures were due January 16, 2017. 8 TTABVUE 5. Opposer’s motion is timely-filed. Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1) (“A motion to compel initial disclosures must be filed within thirty days after the deadline therefor.”).

Applicant's filing is not acceptable and will not be considered because 1) it was not submitted through ESTTA as required by the TTAB's amended rules of practice, effective January 14, 2017; and 2) it is not accompanied by a certificate of service, as required by the TTAB's rules of practice.

1. All submissions must be filed electronically through ESTTA.

Effective January 14, 2017, Trademark Rule 2.126(a), 37 C.F.R. § 2.126(a), was amended to state that submissions must be made to the Board via ESTTA. Using ESTTA, a party completes and submits forms, with attachments and/or exhibits, to the Board over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a form. Available forms and instructions can be found at: <http://estta.uspto.gov>. For more information regarding ESTTA, see TBMP § 110 (Jan. 2017).²

Trademark Rule 2.126(b), 37 C.F.R. § 2.126(b), which is applicable to all Board proceedings as of January 14, 2017, regardless of the date of institution of the proceeding, states, in pertinent part (emphasis added):

In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (*see* §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a *written explanation* of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered.

See also MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69983 (Oct. 7, 2017).

² The TBMP is available at the TTAB's home page at www.uspto.gov. Under "Quick Links," select "TTAB" from the "Trademarks" column.

The submission does not include a written explanation that ESTTA was unavailable due to technical problems or that extraordinary circumstances prevented filing through ESTTA.

Applicant appears to have mistakenly attempted to file by ESTTA a request for an extension of time to oppose (a potential opposition) his own application, but the filing was denied as untimely. It appears that Applicant selected an incorrect option in ESTTA because there would be no reason for an applicant to oppose its own application and thus delay registration of the mark.

Applicant also filed, through TEAS, a “Voluntary Amendment” to extend time by “6 months for response [sic] the opposer motion action.” Applicant’s March 7th submission in paper form includes a copy of the TEAS filing. The TEAS filing was made before Opposer filed its motion to compel and cannot be considered a request to extend time to respond to the motion to compel. Instead, Applicant’s TEAS filing appears to be a request to extend his time to respond to the opposition proceeding in general.³ Regardless, a TEAS filing is improper once an application is involved in an opposition proceeding as all submissions with the TTAB must be made through ESTTA. 37 C.F.R § 2.126(a); TBMP § 110.01. If Applicant should make any future filings through ESTTA, he should use the proceeding number 91228850, rather than the application Serial Number.

Accordingly, the submission in paper form is not accepted and will be given no consideration.

³ It is unclear why Applicant would seek a general extension as discovery has already commenced in this proceeding.

2. All submissions and correspondence between the parties must be served by email.

As of January 14, 2017, service must be by email. In addition, Trademark Rule 2.119, 37 C.F.R. § 2.119, requires service upon the other party of all submissions to the Board, and that submissions and correspondence include proof of service:

(a) Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, including notices of appeal to the courts, must be served upon the other party or parties. Proof of such service must be made before the submission will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of submissions filed with the Board and any other papers served on a party not required to be filed with the Board, must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and must be made by email, unless otherwise stipulated, or if the serving party can show by written explanation accompanying the submission or paper, or in a subsequent amended certificate of service, that service by email was attempted but could not be made due to technical problems or extraordinary circumstances, then service may be made in any of the following ways...

An example of a certificate of service may be found at TBMP § 113.03.

Here, Applicant did not include a certificate of service with his submission to the Board. It is noted in passing that Applicant was reminded of his obligation to serve his adversary in the November 16, 2016 order. 8 TTABVUE 4.

For the reasons stated, Applicant's communication will not be considered.

3. Opposer's motion to compel initial disclosures.

Turning to Opposer's February 15, 2017 motion to compel Applicant's initial disclosures, no response is of record.

Opposer's motion is hereby **granted as conceded**. Trademark Rules 2.120(e) and 2.127(a).

In view thereof, Applicant is hereby ordered to serve initial disclosures no later than **TWENTY DAYS from the mailing date of this order**. See TBMP § 401.02.

Applicant should note that a party that fails to provide its initial disclosures will be barred from propounding discovery requests, and may not file a motion to compel to obtain responses to improperly propounded discovery requests. Trademark Rule 2.120(a)(3); see also *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (denying motion to reopen discovery period and finding no excusable neglect where counsel's failure to serve initial disclosures was characterized as "oversight"); *MySpace, Inc. v. Mitchell*, 91 USPQ2d 1060, 1060 (TTAB 2009) (defendant's motion to compel denied because defendant had not made the required initial disclosures).

In the event Applicant fails to serve his initial disclosures as ordered herein, Opposer's remedy lies in a motion for sanctions pursuant to Trademark Rule 2.120(g), which sanctions may include judgment.

4. Proceedings are resumed.

Proceedings are resumed. Dates are reset as set out below.

| | |
|---|-------------------|
| Expert Disclosures Due | 7/19/2017 |
| Discovery Closes | 8/18/2017 |
| Plaintiff's Pretrial Disclosures Due | 10/2/2017 |
| Plaintiff's 30-day Trial Period Ends | 11/16/2017 |
| Defendant's Pretrial Disclosures Due | 12/1/2017 |
| Defendant's 30-day Trial Period Ends | 1/15/2018 |
| Plaintiff's Rebuttal Disclosures Due | 1/30/2018 |
| Plaintiff's 15-day Rebuttal Period Ends | 3/1/2018 |

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).

AMENDED TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE BECAME 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.
