

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

Mailed: November 15, 2016

Opposition No. 91229012

Robert Bosch GMBH

v.

Pivotal Software, Inc.

By the Trademark Trial and Appeal Board:

This case comes up on the following motions:

1. Opposer's motion for summary judgment, filed October 25, 2016;
2. Opposer's motion to suspend its time for serving responses to Applicant's discovery requests.¹

Motion for Summary Judgment

Opposer filed its motion for summary judgment on the pleaded ground of likelihood of confusion.² A party may not file a motion for summary judgment under Trademark Rule 2.127(e)(1) until that party has made its initial disclosures.³ *See*

¹ The motion to suspend was made both as part of the motion for summary judgment and as a separate motion filed November 1, 2016.

² The Board notes that Opposer's certificate of service does not reflect service on Applicant's counsel at its address of record in this proceeding. *See* Trademark Rule 2.119(a).

³ The exception is for a summary judgment motion asserting claim or issue preclusion or lack of jurisdiction by the Board. These grounds are not asserted in the motion for summary judgment.

Trademark Rule 2.127(e)(1); *see also*, *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 (TTAB 2009). The requirement that a party serve its initial disclosures prior to, or concurrently with, the filing of a motion for summary judgment cannot be waived. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010).

Inasmuch as Opposer filed its motion prior to the October 26, 2016 deadline for initial disclosures, and because the record does not indicate that Opposer has served such disclosures, the motion for summary judgment is **denied as premature**. *See Compagnie Gervais Danon*, 89 USPQ2d at 1255 n.7.

Motion to Suspend Time for Serving Discovery Responses

Opposer seeks to have the time for serving responses to Applicant's discovery requests suspended until 30 days after the Board's determination of the motion for summary judgment. Opposer has not provided the date of service for Applicant's discovery requests, so it is impossible to determine the intersection of the date Opposer's motion for summary judgment was filed and the due date for Opposer's discovery responses. Opposer's motion for summary judgment has been denied as premature, however, some uncertainty may have been caused by Opposer's filing of the premature motion for summary judgment.⁴

⁴ Contrary to Opposer's assertion in its motion, the filing of a motion for summary judgment does not mean the Board proceeding is "automatically" suspended. The Board will not normally suspend for an untimely motion for summary judgment. *See Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1135 (TTAB 2010) (mere filing of motion for summary judgment does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect), *clarified*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011) (however, entry of judgment as a sanction for a party's failure to abide by the Board's practice regarding suspension is not supported). *See also* TBMP §528.03.

Accordingly, Opposer's motion is **granted to the extent** that Opposer's due date for service of its discovery responses and initial disclosures is extended until 20 days from the mailing date of this order.

Dates otherwise remain as set in the Board's institution order of July 18, 2016.
