

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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July 30, 2020

Opposition No. 91247072

*The Round Table Franchise Corporation*

*v.*

*Round Pie 01 LLC*

**Geoffrey M. McNutt, Interlocutory Attorney:**

This case comes up for consideration of Applicant's March 4, 2020, fully-briefed motion to strike certain portions of Opposer's notice of reliance.<sup>1</sup>

**I. Standard for Motion to Strike**

It has long been the policy of the Board not to read trial testimony or review other trial evidence prior to final decision. Accordingly, the Board does not consider substantive objections to evidence, or determine the probative value of evidence, prior to final hearing.<sup>2</sup> *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1263 (TTAB 2003)

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<sup>1</sup> In its motion, Applicant refers to Opposer's second, third, and fourth notices of reliance. In fact, Opposer submitted a single notice of reliance (11 TTABVUE). The subsequent docket entries are not additional notices of reliance, but rather the materials submitted by Opposer under its first the notice of reliance.

<sup>2</sup> Substantive objections to evidence submitted by means of a notice of reliance generally should not be raised by motion to strike, unless the ground for objection is one that could be cured if raised promptly by motion to strike. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 532 and 707.02(c) (June 2020). Such substantive objections should be raised in the objecting party's brief on the case. *Id.* The Board will

(substantive evidentiary issues are deferred until final decision); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992) (“Board does not read testimony and consider substantive objections to evidence, or determine the probative value of evidence, prior to final hearing”); *M-Tek Inc. v. CVP Sys Inc.*, 17 USPQ2d 1070, 1073 (TTAB 1990) (Board will not rule on objections pertaining to admissibility prior to final decision). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 502.01, 532, 707.02(c), and 703.03(c) (June 2020).

## II. Analysis & Determination

In its motion, Applicant raises both substantive objections (e.g., that the proffered materials are irrelevant or immaterial) and the procedural objection that in the notice of reliance Opposer failed to sufficiently “indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding” as required by Trademark Rule 2.122(g), 37 C.F.R. § 2.122(g). In reviewing Opposer’s description of relevance of the proffered materials under Trademark Rule 2.122(g), the Board has given no consideration to Opposer’s statement, which it repeats in connection with several exhibits, that the proffered materials are relevant to numerous issues, including ...”<sup>3</sup> The explanation that the materials are relevant to “numerous issues” clearly is inadequate on its face. Therefore, the Board will consider only whatever specific explanations of relevance Opposer provided after the word “including.”

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consider such substantive objections at final hearing, provided the objecting party raises (or renews) its objection in its trial brief. *See* TBMP §§ 532 and 707.02(c).

<sup>3</sup> 11 TTABVUE 4–5.

- **Exhibits G, H, and I**

These exhibits are Trademark Status and Document Retrieval (“TSDR”) database printouts of three of Opposer’s registrations, each of which issued during this proceeding from an application that Opposer pleaded ownership of in the Notice of Opposition.<sup>4</sup> The proffered registrations are: (1) Registration No. 5789840, which issued on June 25, 2019, from application Serial No. 88142513; (2) Registration No. 5789894, which issued on June 25, 2019, from application Serial No. 88204921; and (3) Registration No. 5857068, which issued on September 10, 2019, from application Serial No. 88327341.

Applicant moves to strike the proffered registrations on the grounds that they are irrelevant and immaterial because they issued from applications filed after the filing date of Applicant’s involved application, and that Opposer’s statement in the notice of reliance regarding the relevancy of the exhibits is insufficient.<sup>5</sup>

Applicant’s objections that the proffered registrations are irrelevant and immaterial are substantive objections. *See* TBMP §§ 532 and 707.02(c). Accordingly, determination of the motion to strike Exhibits G, H, and I on these grounds is **deferred** until final decision. Provided Applicant renews its objections in its trial

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<sup>4</sup> *See* Notice of Reliance (11 TTABVUE 2-4) and Exs. G, H, and I (14 TTABVUE 175-186).

The applications are pleaded in paragraph 4 of the Notice of Opposition (1 TTABVUE 5), and in the ESTTA cover sheet (1 TTABVUE 3-5), the content of which is read in conjunction with an attached notice of opposition as an integral component thereof. *See PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005).

<sup>5</sup> 15 TTABVUE 3.

brief, the relevance and probative weight of these materials are matters to be determined at final hearing, when the Board reviews the evidence.<sup>6</sup>

Regarding Applicant's objection that Opposer's statement regarding the relevance of the proffered registrations is insufficient, in the notice of reliance, Opposer states that the registrations (and others) are "relevant to ... [Opposer's] ownership of the registrations and the incontestable status of certain registrations."<sup>7</sup> In view of the fact that the only ground for opposition is likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), Opposer's statement that the proffered registrations are relevant to Opposer's ownership of the registrations is sufficient. Accordingly, Applicant's motion to strike the proffered registrations on the ground that Opposer's statement regarding their relevance is insufficient is **denied**.

- **Exhibit J**

The proffered exhibit is a TSDR printout of Opposer's Registration No. 5868413, which issued from an application filed by Opposer after it filed the notice of opposition.<sup>8</sup> Applicant's objections that the proffered registration are irrelevant and immaterial are substantive objections. Accordingly, determination of the motion to

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<sup>6</sup> The parties are reminded that where an opposer pleads a pending application in the notice of opposition, it may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration, provided the registration issued before the opposer's testimony period closes. *See Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012); *UMG Recordings, Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009).

<sup>7</sup> 11 TTABVUE 4.

<sup>8</sup> 14 TTABVUE 187–190.

Opposer never amended its notice of opposition to plead ownership of the application or resulting registration.

strike Exhibit J is **deferred** until final decision. Provided Applicant renews its objections in its trial brief, the relevance and probative weight of these materials are matters to be determined at final hearing.

- **Exhibit L**

Exhibit L consists of documents from an opposition between Opposer and a third-party, which Opposer states are “relevant to demonstrate examples of [its] enforcement efforts[.]”<sup>9</sup> In its motion to strike, Applicant contends that these documents, or at least many of them, are “unnecessary, cumulative, irrelevant and immaterial to this proceeding.”<sup>10</sup> Applicant’s objections are substantive, and would require reading the proffered evidence. Accordingly, determination of the motion to strike Exhibit L is **deferred** until final decision. Provided Applicant renews its objections in its trial brief, the relevance and probative weight of these materials are matters to be determined at final hearing.

- **Exhibits Q–S**

Exhibits Q–S consist of documents from the USPTO files of Applicant’s previously-filed and abandoned applications for ROUND PIE marks.<sup>11</sup>

Applicant moves to strike these materials on the grounds that they are irrelevant,<sup>12</sup> and because Opposer’s statement in the notice of reliance regarding the

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<sup>9</sup> 11 TTABVUE 4 and 14 TTABVUE 212–353.

<sup>10</sup> 15 TTABVUE 4.

<sup>11</sup> 14 TTABVUE 187-190.

<sup>12</sup> 15 TTABVUE 4–5.

relevancy of the exhibits is insufficient.<sup>13</sup> Opposer's states in the notice of reliance that Exhibits Q–S are relevant, inter alia, to “the descriptiveness of the term ‘PIE’ in applicant’s mark.”<sup>14</sup> This statement is sufficient for purposes of Trademark Rule 2.122(g). Accordingly, Applicant’s motion to strike the exhibits on the ground that Opposer’s statement regarding their relevance is insufficient is **denied**.

Applicant’s further objections to the exhibits on the ground of relevance is substantive in nature, and therefore determination of the motion to strike Exhibits Q–S on this ground is **deferred** until final decision, provided Applicant renews its objection in its trial brief.<sup>15</sup>

- **Exhibits M–P and U–X**

Exhibits M–P are copies of dictionary definitions of the word “pie”; Exhibits U and V are copies of printouts from Applicant’s Facebook page and Applicant’s profiles from the webpage SILive.com; and Exhibits W and X are certain responses by Applicant to Opposer’s first set of interrogatories and first set of request for admission.<sup>16</sup> Applicant moves to strike these materials on the ground that Opposer’s statement in the notice of reliance regarding the relevancy of the exhibits is insufficient.<sup>17</sup>

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<sup>13</sup> *Id.* at 5.

<sup>14</sup> 11 TTABVUE 4.

<sup>15</sup> When comparing marks for purposes of an analysis of likelihood of confusion, the Board may consider the descriptiveness of a component of a mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re Natl. Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *see also M2 Software Inc. v. M2 Commc’ns Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948–49 (Fed. Cir. 2006).

<sup>16</sup> 11 TTABVUE 4 and 14 TTABVUE 467–484.

<sup>17</sup> 15 TTABVUE 5.

Opposer's statement in the notice of reliance that Exhibits M–P are relevant “to the descriptiveness of the term ‘PIE’ in applicant mark, and the shared dominant term ‘ROUND’ in [the] marks of both the applicant and opposer”<sup>18</sup> is sufficient. Likewise, Opposer's statement in the notice of reliance that Exhibits U and V are relevant to the relatedness of the parties' goods and services, similarity of consumers and trade channels, and dates of use and priority,<sup>19</sup> are sufficient for purposes of Trademark Rule 2.122(g). See *Apollo Med. Extrusion Techs, Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1847 (TTAB 2017) (statement that materials were relevant to, inter alia, Applicant's channels of trade and customers was acceptable), *on appeal*, 3:17-CV-02150 (S.D. Cal. October 19, 2017). Accordingly, Applicant's motion to strike Exhibits M–P and Exhibits U and V on the ground that Opposer's statements regarding their relevance are insufficient is **denied**.

Regarding the proffered excerpts of Applicant's discovery responses (Exs. W and X), Opposer states in the notice of reliance that the documents are relevant to “Applicant's use of the mark and likelihood of confusion.”<sup>20</sup>

To meet the requirement of Trademark Rule 2.122(g) that a notice of reliance must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding, the offering party should associate the materials with a specific factor relevant to a specific and pleaded claim or defense, or a specific fact relevant to determining a particular claim or defense. *Barclays Capital Inc. v. Tiger*

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<sup>18</sup> 11 TTABVUE 4.

<sup>19</sup> *Id.* at 5.

<sup>20</sup> 11 TTABVUE 5.

*Lily Ventures Ltd.*, 124 USPQ2d 1160, 1163–64 (TTAB 2017); *see also*. TBMP § 704.02 (“[I]f the claim is likelihood of confusion, the propounding party should associate the materials with a relevant likelihood of confusion factor.”). Further, if the same document is submitted to support more than one element of a claim or defense, or if a group of documents is submitted to support different elements, the propounding party should indicate the specific element(s) or fact(s) supported by the document or each document within the group. *Barclays*, 124 USPQ2d at 1164; TBMP § 704.02.

Opposer’s statement that Applicant’s discovery responses are relevant to likelihood of confusion is insufficient because Opposer has not associated each discovery response on which it intends to rely at trial with one or more specific likelihood of confusion factors. Accordingly, Applicant’s motion to strike Exhibits W and X is **granted** and the exhibits are **stricken**.

Failure to comply with Trademark Rule 2.122(g) is a curable defect. *See* Trademark Rule 2.122(g); *Barclays*, 124 USPQ2d at 1165. Further, Opposer’s testimony period need not be reopened to allow for such cure. *Barclays*, 124 USPQ2d at 1165. Accordingly, Opposer is allowed until **AUGUST 19, 2020**, to file and serve an amended notice of reliance in which it associates each of the proffered discovery responses with one or more specific likelihood of confusion factors, or other facts relevant to Opposer’s Section 2(d) claim, failing which the Exhibits W and X will remain stricken.<sup>21</sup> Opposer need only submit an amended notice of reliance; it need not re-submit the exhibits.

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<sup>21</sup> Opposer’s testimony period otherwise remains closed.



- **Opposer’s Submission of Confidential Documents**

Applicant objected to Opposer’s submission under seal of certain confidential documents on the grounds that the documents were not identified or served.<sup>22</sup> In response, Opposer states that the documents were served the same day that they were filed with the Board.<sup>23</sup> Applicant, in reply, acknowledged receipt of the documents.<sup>24</sup> Accordingly, this objection is **denied** without prejudice as moot.

### **III. Case Schedule**

In the motion to strike, Applicant also moved to suspend proceedings pending a determination of the motion to strike.<sup>25</sup> The motion to suspend is **granted**. Accordingly, proceedings are resumed and trial and briefing dates, are reset as shown below.

Opposer’s Amended Notice of Reliance Due	8/19/2020
Defendant’s Pretrial Disclosures Due	9/8/2020
Defendant’s 30-day Trial Period Ends	10/23/2020
Plaintiff’s Rebuttal Disclosures Due	11/7/2020
Plaintiff’s 15-day Rebuttal Period Ends	12/7/2020
Plaintiff’s Opening Brief Due	2/5/2021
Defendant’s Brief Due	3/7/2021
Plaintiff’s Reply Brief Due	3/22/2021
Request for Oral Hearing (optional) Due	4/1/2021

The Federal Rules of Evidence generally 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

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<sup>22</sup> 15 TTABVUE 5.

<sup>23</sup> 16 TTABVUE 6–7, 9–24.

<sup>24</sup> 17 TTABVUE 6.

<sup>25</sup> 15 TTABVUE 6.

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).