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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91263671
Party	Defendant Wolfgang Joop
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Attachments	Applicant JOOP Motion to Amend ID and Reset Dates.pdf(175276 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WOLFGANG PUCK and WOLFGANG PUCK LICENSING LLC, Opposers, v. WOLFGANG JOOP Applicant	Proceeding No. 9163671 Mark: THE WOLFGANG Serial No. 79263615

APPLICANT'S MOTION TO AMEND APPLICATION AND RESET EXPERT DISCLOSURE DEADLINE AND CORRESPONDING DISCOVERY AND TRIAL DATES

Applicant, Wolfgang Joop, hereby respectfully moves that the Board (1) amend the application at issue by limiting the services identified, and (2) reset the current expert disclosure deadline set out in the Scheduling Order dated October 23, 2020 (Docket #9) for a period of 90 days from the Board's decision on Applicant's motion to amend, and thus, resetting the remaining discovery and trial dates accordingly, all pursuant to 37 C.F.R. §§ 2.133(a), 2.117(c) and 2.121(a). The grounds for Applicant's motion are as follows: (1) Amending the application at issue by limiting the services identified narrows the issues to be tried in the case; (2) the outcome of the motion to amend directly impacts the nature of the expert survey and report that Applicant will provide in this case; (3) Applicant needs time to have its expert conduct a survey after the decision is made as to the identification of services in the application at issue; (4) Applicant needs more than 30 extra days in order to complete the remainder of fact discovery to be accomplished with the current deadline being June 22, 2021; and, (5) there is no prejudice to Opposer as a result of either the amendment to the application or the limited extra time requested, but Applicant will be prejudiced if the additional time is not granted.

Applicant's counsel sought consent to each of these requests (amendment of the application and a 90 day extension of time), but consent was not provided. Although opposing counsel was willing to allow Applicant a 30 day extension of time to submit its expert report, that amount of time is insufficient for the reasons stated herein.

ARGUMENT

Rule 2.133(a) states that, "An application subject to an opposition may not be amended in substance [], except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, *or upon motion granted by the Board*." (emphasis added). In this regard, "the Board has jurisdiction over the application and will determine the propriety of the amendment." TBMP § 212.07 (Amendment During Opposition); see TBMP § 514 (Motion to Amend Application or Registration).

In addition, Rule 2.117(c) states that, "Proceedings may [] be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board... [and] the Board retains discretion to condition approval on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate." Further, the "resetting of the closing date for discovery will result in the rescheduling of pretrial disclosure deadlines and testimony periods without action by any party. 37 C.F.R. § 2.121(a). And, the expert disclosure deadline must always be scheduled prior to the close of discovery. 37 C.F.R. § 2.120(a)(2)(iv). In this case, Applicant is not seeking suspension, but rather a 90 day extension of the existing trial schedule beginning with the deadline for expert disclosures. The Board has discretion to grant this motion and good cause is shown to support that decision.

1. Applicant's Motion to Amend the Application.

Applicant moves the Board to allow amendment of the application at issue, Application Serial No. 79263615, to limit the services originally identified as follows, shown by redline of the proposed deleted portions:

> International Class 042: ~~Design of restaurants, namely,~~ **interior and architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design.**
>
> International Class 043: ~~Services for providing food and drink, namely, food and drink catering, bar and restaurant services;~~ **providing temporary accommodation; hotel services**; ~~bar and restaurant services~~.

The resulting services would be identified as, "interior and architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design," in International Class 042; and, "providing temporary accommodation; hotel services," in International Class 043.

"The Board, in its discretion, may grant a motion to amend an application or registration that is the subject of an *inter partes* proceeding, even if the other party or parties do not consent thereto." TBMP § 514.03 (Amendment Without Consent); *see Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (noting principle that an acceptable amendment to the identification may be permitted despite opposer's objection if amendment limits identification and applicant consents to entry of judgment on the question of likelihood of confusion as to the broader identification); *see also, e.g., Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods).

In this case, by narrowing the identification of services, the question of likelihood of confusion becomes narrower and more focused. Opposer's mark, WOLFGANG PUCK, U.S. Trademark Registration No. 1,901,065, on which Opposer bases this opposition proceeding, covers "restaurant services". If the amendment that Applicant seeks is approved by the Board, then the legal analysis will be simplified to a comparison of the marks as used for hotel/temporary accommodation services and interior/architecture design services versus restaurant services, instead of the additional aspect of comparing the marks as used for restaurant services. The scope of the application at issue is limited by the amendment sought, with such amendment sought pre-trial. *See, Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (applicant willing to accept judgment with respect to broader identification of goods); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980) (where applicant was willing to accept judgment with respect to the broader identification of goods); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224, 1229 (TTAB 1993) (where applicant consented to entry of judgment against itself with respect to a geographically unrestricted registration).

Applicant asserts that it is at least entitled to a registration with the particular restriction set out above. Applicant does not object to accepting judgment with respect to the broader identification of services if amendment of the application allows registration for those limited services. Accordingly, the Board should grant Applicant's motion to amend this application under the limitations set out above that in essence delete reference to restaurant services, the services covered by Opposer's primary asserted registration.

2. Applicant's Motion to Reset Dates: Applicant's Ability to Obtain Expert Survey Depends Directly on the Outcome of Applicant's Motion to Amend.

The outcome of the motion to amend the identification of services directly impacts the nature of the expert survey and report that Applicant will provide in this case. In order for Applicant's expert to conduct a proper survey, the proper universe needs to be determined. In doing so, an initial question that needs to be answered is what products or services consumers are buying.

A more poignant and relevant survey can be conducted in this case if the services are limited as specifically set out above (by deleting reference to restaurant and restaurant-type services). This determination should be made before Applicant spends the money for the survey. Criteria widely adopted by the courts in trademark cases include identifying the "universe" or total pool from which survey respondents are selected. The foundation of this undertaking of formulating clear, precise and appropriate questions must emanate from knowing the products, or in this case the services, that are the focus of the survey – not just the marks.

Efficiencies of scale will reduce the Board's resources as well in narrowing the issues going forward in the case. Even in terms of an ultimate likelihood of confusion analysis conducted by the Board, the issues are narrowed if taken into consideration after amendment of Applicant's application. Accordingly, it makes sense to decide the issue of amending the application prior to Applicant moving forward with an expert survey.

Applicant is prepared to meet the expert disclosure requirements of providing the identity and curriculum vitae of the expert that it has retained on the deadline to do so, which is Sunday, May 23rd, but can be disclosed on Monday, May 24th because of the deadline falling on

a weekend. However, it is illogical to require that expert to conduct a survey about likelihood of confusion prior to the Board's decision on Applicant's motion to amend the identification of services because by the very nature of the survey, the expert will need to define the category of services at issue. That might change from the current description to a narrower description, directly resulting in changing the formulation of the survey.

3. Applicant's Motion to Reset Dates: The Time to Complete Fact Discovery Needs to be Extended for Document Review and Depositions.

In addition to the good cause shown above for extending the deadline for expert reports, Applicant needs more than 30 days in order to complete fact discovery with the current deadline being June 22, 2021. A lot of fact discovery has already been completed. There is no absence of prosecution of the case. However, there is a significant amount yet to be conducted. Specifically, the timeline of fact discovery activity is as follows:

- On January 27, 2021, Opposer served interrogatories, document requests, and requests for admission on Applicant.
- On February 26, 2021, Applicant's responses were timely served.
- On March 8, 2021, Opposer sought a meet-and-confer to discuss Applicant's discovery responses.
- On March 17, 2021, without waiving any objections and without admitting any actual deficiencies, but rather because motion practice is more expensive than taking the time to supplement and address as many alleged deficiencies as possible and in a spirit of cooperation, Applicant served supplemental discovery responses to the interrogatories and documents.

- On March 17, 2021, Applicant served documents to Opposer.
- Also on March 17, 2021, Applicant served on Opposer its interrogatories, document requests and requests for admissions.
- On March 31, 2021, Applicant served additional documents to Opposer.
- On April 17, 2021, Opposer's responses to Applicant's discovery requests were due.
- On May 17, 2021, with consent from Applicant for a 30 day extension of time beyond their original due date of April 17, 2021, such consent sought a few days before the deadline, Opposer served its responses and approximately 270 documents.

Now, Applicant needs additional time, beyond June 22nd, to review the discovery responses and documents that Opposer just produced this week and assess them for sufficiency. There needs to be time in order to work out deficiencies, if any.

In addition, neither party has taken depositions thought both parties intend to do so. Opposer is planning to take Applicant's deposition through video deposition services and that deposition was scheduled today for June 18, 2021, just four days before the close of discovery. Opposer has yet to serve an official Notice of Deposition as of the filing of this motion. Also, the parties have not yet agreed on a date for Applicant to depose both Opposer parties. It may be necessary to schedule those depositions in July because of Applicant's counsel's commitments in other cases that also occur in June.

A 90 day period of time from the Board's decision on Applicant's motion to amend the application should be sufficient for Applicant's expert witness to move forward. Likewise, a 90

day extension of discovery, including the expert disclosure deadline, should be sufficient for Applicant to take the Opposer's deposition(s), review deposition transcripts from depositions taken by the parties, submit its expert report, and get ready to then enter the testimony phase of the case. Importantly, Applicant's designated expert has several trials ongoing now and in the next 30 days. Accordingly, an extension of time in the amount of 90 days from the Board's decision on Applicant's motion to amend the application would also allow Applicant's expert the time he deserves to conduct their survey.

Applicant's motion to reset dates is not made for the purposes of undue delay or harassment. The motion is made so that Applicant can adequately prepare its case.

4. Applicant's Motion to Reset Dates: Opposer is Not Prejudiced by the Limited Extension of Time, but Applicant Is Severely Prejudiced by its Denial.

Opposer is not prejudiced by the Board's decision to grant Applicant's motion to reset dates. Under Fed. R. Civ. P. 26(e), Opposer not only has the opportunity to supplement their expert report disclosed under Rule 26(a)(2)(B), but they have an obligation to do so. TBMP § 408.03. That duty to supplement extends both to information included in the report and to information given during the expert's deposition. Opposer has the opportunity, particularly with an extension of time that Applicant seeks, to accomplish such supplementation if they choose to. There is no prejudice to Opposer's ability to present its case through expert report(s) by allowing Applicant additional time (more than 30 days) to present its expert report.

On the contrary, Applicant will be severely prejudiced in its ability to present its case in support of the registration of its mark. The parties have engaged in meaningful discovery exchanges so far, but there is still a lot of work to be completed. While all discovery imposes

some burden on the opposition, Applicant will not have the ability, nor the right, to determine how to develop and present its expert disclosure until the Board decides its motion to amend the application. At that time, Applicant will need 90 days to have a survey conducted and prepare its expert report.

CONCLUSION

For the reasons stated in Applicant's motion to amend and reset expert disclosures, and the corresponding discovery and trial dates, Applicant respectfully moves that the Board extend the deadline for expert disclosure to 90 days from its decision on Applicant's motion to amend and to reschedule the remainder of discovery and trial dates accordingly.

Dated: May 21, 2021 Respectfully submitted,

By: s/JAK/

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CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing APPLICANT'S MOTION TO AMEND APPLICATION AND RESET EXPERT DISCLOSURE DEADLINE AND CORRESPONDING DISCOVERY AND TRIAL DATES was served on May 21, 2021, via email addressed to the following:

Mr. Robert Chapman
Sauer & Wagner LLP
1801 Century Park East, Suite 1150
Los Angeles, CA 90067

s/JAK/
One of the Attorneys for Applicant

CERTICATE OF ELECTRONIC FILING

I hereby certify that on May 21, 2021, the foregoing APPLICANT'S MOTION TO AMEND APPLICATION AND RESET EXPERT DISCLOSURE DEADLINE AND CORRESPONDING DISCOVERY AND TRIAL DATES is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) at the uspto.gov website.

s/JAK/
One of the Attorneys for Applicant