

UNITED STATES PATENT AND TRADEMARK OFFICE  
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RSC

June 21, 2021

Opposition No. 91263671

*Wolfgang Puck and Wolfgang Puck Licensing  
LLC*

*v.*

*Wolfgang Joop*

**Rebecca Stempien Coyle, Interlocutory Attorney:**

On June 15, 2021, the Board held a conference with the parties to address contested scheduling issues related to the oral deposition of Applicant, scheduled for June 22, 2021. On June 17, 2021, the Board held a further conference with the parties to address additional contested issues related to Applicant's deposition and to resolve Applicant's May 21, 2021 motion to amend his application and reset dates.<sup>1</sup> Participating in the conferences were Robert Chapman, counsel for Opposers and Julie Katz, counsel for Applicant. Interlocutory Attorney Rebecca Stempien Coyle participated on behalf of the Board.

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<sup>1</sup> 12 TTABVUE. The Board afforded Applicant the opportunity to present an oral reply in support of his motion during the conference.

### **1. Parties' Stipulation Regarding Applicant's Deposition**

Applicant resides in Germany. The discovery deposition of a party taken in a foreign country must be taken on written questions, unless the Board, on motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral deposition. Trademark Rule 2.120(c); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 404.03(b) (2021).

During the conference the parties agreed that Applicant's deposition would proceed orally on June 22, 2021, beginning at 8:00am Pacific Time (5:00pm CEST), and continuing until 1:00pm Pacific Time (10:00pm CEST). This time frame includes opportunities for Applicant to take breaks during the course of his deposition, and accordingly may not result in five hours of examination. If Applicant's deposition is not completed within this time, the deposition will continue on June 23, 2021, beginning at 8:00am Pacific Time and continuing until 1:00pm Pacific Time. If upon conclusion of the deposition on June 23, 2021, Opposers have not conducted seven hours of examination and Applicant's deposition is not completed within this time, Applicant's deposition will continue on June 24 or 25, 2021, or some other mutually agreeable date.

The parties further agreed that Ms. Judith Vescher may be present in the same room as Applicant during his deposition, solely to assist Applicant with any physical or technical issues.

The Board appreciates the parties' cooperation in reaching an agreement on conducting Applicant's deposition orally. The discussions regarding the discovery

deposition of Applicant are indicative of issues that may arise during the testimony period. The Board encourages the parties to review the Board's manual regarding testimony, including testimony depositions of a foreign party and the stipulations available to the parties to streamline evidentiary issues during trial. *See* TBMP §§ 703 and 705.

## **2. Applicant's May 21, 2021 Motion**

Through his motion, Applicant seeks to amend the identification of services in his application and reset dates in the proceeding, beginning with expert disclosures.

### **a. Proposed Amendment to the Application**

By the proposed amendment, Applicant seeks to amend the identification of services in International Classes 42 and 43 as follows (proposed deletions indicated in strikethrough):

#### **International Class 42**

**From:** ~~Design of restaurants, namely,~~ interior and architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design

**To:** interior and architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design

#### **International Class 43**

**From:** ~~Services for providing food and drink, namely, food and drink catering, bar and restaurant services;~~ providing temporary accommodation; hotel services; ~~bar and restaurant services~~

**To:** providing temporary accommodation; hotel services

“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.” Trademark Rule 2.133(a). Generally, an unconsented motion to amend an application is deferred until final decision or until the case is decided upon summary judgment, unless (1) the proposed amendment limits the identification of goods or recitation of services, (2) the applicant consents to the entry of judgment as to the broader identification of goods or recitation of services, and (3) the applicant makes a prima facie showing that the amendment serves to change the nature and character of the goods and services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the opposition against the application based on the original identification of goods or recitation of services. *Johnson & Johnson v. Stryker*, 109 USPQ2d 1077, 1078-79 (TTAB 2013); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (proposed amendment not approved where applicant did not consent to entry of judgment as to the broader recitation of services); *see also* TBMP § 514.01.

Additionally, a proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must comply with all applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP § 514.01. In particular, while an applicant may amend to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. *See* Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

The Board **DENIED** the proposed amendment to International Class 42 as improper because the deletion of the limiting language “design of restaurants, namely,” broadens the scope of the identification.

In regard to the proposed amendment to International Class 43, the Board stated that although the amendment is limiting in nature and Applicant “does not object to accepting judgment with respect to the broader identification”,<sup>2</sup> Applicant failed to make a *prima facie* showing that the amendment serves to change the nature and character of the services or to restrict their channels of trade and customers in such a manner that the proposed amendment presents a substantially different issue for trial. Accordingly, the Board **DEFERRED** consideration of the proposed amendment to International Class 43 until final decision or the case is decided upon summary judgment. *See* TBMP § 514.01.

**b. Extension of Time**

Applicant also seeks to reset dates in this proceeding. Applicant contends additional time is necessary for his expert to conduct a proper survey, both due to conflicts in the expert’s schedule and the need for a prior decision on Applicant’s motion to amend. Applicant further maintains more time is needed for fact discovery to allow the parties sufficient time to conduct depositions and review transcripts and other discovery responses, and Opposers would not be prejudiced by the requested extension.

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<sup>2</sup> 12 TTABVUE 5.

In response, Opposers contend Applicant's own lack of diligence by failing to serve discovery in the first three month of the discovery period or agreeing to an earlier date for his deposition, and repeated delays in the proceeding, are insufficient to support the requested extension of time.

The standard for allowing an extension of a prescribed period prior to the expiration of that period as originally set, or as reset, is good cause. *See Fed. R. Civ. P. 6(b)(1); Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1177 (TTAB 2018). Generally, the Board is liberal in granting extensions of time before the specified period has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See Am. Vitamin Prods., Inc. v. Dowbrands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992).

The Board found good cause for granting a limited extension. Accordingly, the motion to extend is **GRANTED, in part**, such that expert disclosures are due July 19, 2021,<sup>3</sup> and discovery closes September 3, 2021.

During the conference Opposers' counsel requested an order prohibiting Applicant's expert from utilizing, in the drafting of his own report, Opposers' previously-disclosed expert report. Applicant's counsel represented during the conference that his expert was not intended, at this time, as a rebuttal expert. Opposers' request is well-taken. Accordingly, Applicant may not share Opposers' expert's report with his own expert in advance of service of Applicant's expert's report.

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<sup>3</sup> The Board notes Opposers filed a notice of designation of experts on May 21, 2021. 11 TTABVUE.

### 3. Proceedings Resumed

Both parties in this proceeding have disclosed experts. Upon disclosure of an expert, the Board, on its own initiative, may issue an order regarding expert discovery. Trademark Rule 2.120(a)(2)(iii); TBMP § 401.03. In view of the resetting of the schedule below, the Board will not, at this time, suspend proceedings for expert discovery or otherwise issue an order regarding expert discovery. Notwithstanding, and upon further consideration, the parties must notify the Board in writing by **August 2, 2021** if they intend to use a rebuttal expert and the Board will reset dates at that time, as appropriate, including a date by which to serve rebuttal expert reports.

Proceedings are **resumed** and dates are reset as follows:

Expert Disclosures Due	7/19/2021
Discovery Closes	9/3/2021
Plaintiff's Pretrial Disclosures Due	10/18/2021
Plaintiff's 30-day Trial Period Ends	12/2/2021
Defendant's Pretrial Disclosures Due	12/17/2021
Defendant's 30-day Trial Period Ends	1/31/2022
Plaintiff's Rebuttal Disclosures Due	2/15/2022
Plaintiff's 15-day Rebuttal Period Ends	3/17/2022
Plaintiff's Opening Brief Due	5/16/2022
Defendant's Brief Due	6/15/2022
Plaintiff's Reply Brief Due	6/30/2022
Request for Oral Hearing (optional) Due	7/10/2022

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

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).