

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WF/VV

October 13, 2021

Opposition No. 91264041

*Hangzhou Hikvision Digital Technology Co.,
Ltd.*

v.

*Cargotec Patenter AB and HIAB AB (by way
of assignment)*

Winston Folmar, Interlocutory Attorney:

1. Joinder of Party as a result of Assignment

It has come to the Board's attention that the involved Application Serial No. 88462408 has been assigned to Hiab AB pursuant to an assignment recorded with the Assignment Recordation Branch of the Office on April 27, 2021 (Reel/Frame: 7272/0066). *See Life Zone, Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) (Board will not add or substitute an opposition applicant without motion and submission of either proof of name change assignment or proof of recordation of same with the USPTO).

When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate. *NSM Resources Corp. v. Microsoft Corp.*, 113

USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate when assignment of pleaded mark was executed one year after proceeding commenced). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 512.01 (June 2021). When the assignment is recorded in the Assignment Recordation Branch of the USPTO, the assignee may be substituted as a party if: the assignment occurred prior to the commencement of the proceeding, the assignor is no longer in existence, the other party raises no objections to substitution, or the discovery and testimony periods have closed.

Inasmuch as the assignment has been recorded and the assignment occurred after the commencement of this proceeding, the Board sua sponte elects to join Hiab AB as a party defendant to this proceeding. *See* 37 C.F.R. § 3.71(d); 37 C.F.R. § 3.73(b). The caption and the Board's records shall be updated accordingly.

2. Motion to Extend

Applicant's consented motion, filed October 6, 2021, to extend time to file an answer to the notice of opposition, and to extend conference, disclosure, discovery and trial dates, is granted.¹ 16 TTABVUE. *See* Trademark Rule 2.127(a). However, the parties should note that **Status Reports will be required for future motions to suspend or extend.**

¹ When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates. Trademark Rule 2.121(d).

The Board retains discretion to condition the approval of a consented or stipulated motion to suspend on the party or parties providing necessary information about the status of settlement talks, discovery activities, or trial activities, as may be appropriate. *See* Trademark Rule 2.117(c); TBMP §§ 509.02 and 605.02.

Due to the number of extensions approved in this proceeding, the Board imposes a condition on the approval of all future motions to suspend or extend for settlement. Specifically, to establish good cause for all future motions to suspend or extend, the parties must include in the motion a status report on the parties' settlement efforts. While the rule does not require a great deal of specificity, the report must set forth, at minimum, the issues that have been resolved, the issues that remain to be resolved or that remain for trial, and a proposed timetable for resolution of the remaining issues. Appropriately designated confidential information or materials may be filed under seal pursuant to Trademark Rule 2.126(c). *See* TBMP § 605.02. **Absent the required status report, a motion to suspend or extend may be denied, even if consented to by the parties.** If the Board denies such a motion, dates may remain as previously set. *See* TBMP § 509.01(a).

Due to this requirement, **the parties may no longer use the ESTTA “Consent Motions” forms to submit motions to extend or suspend dates for settlement.** Rather, the parties must select the “Opposition, Cancellation or Concurrent Use (general filings)” option, the “Scheduling Motions” option, then the “Motion to Suspend for Settlement Discussions” form to which the parties may attach the motion

they prepared. **The motion must set forth both the required status report and a proposed trial schedule.**

The requirement to use the general filings ESTTA form is limited to consent motions based on settlement discussions, and does not prohibit the use of ESTTA consent forms for other filings.

Answer is due by **DECEMBER 7, 2021**. An answer must be filed through ESTTA, the Board's Electronic System for Trademark Trials and Appeals. *See* Trademark Rule 2.106(b)(1).

The conference, disclosure, discovery and trial dates are reset in accordance with Applicant's motion as follows:

Deadline for Discovery Conference	1/6/2022
Discovery Opens	1/6/2022
Initial Disclosures Due	2/5/2022
Expert Disclosures Due	6/5/2022
Discovery Closes	7/5/2022
Plaintiff's Pretrial Disclosures Due	8/19/2022
Plaintiff's 30-day Trial Period Ends	10/3/2022
Defendant's Pretrial Disclosures Due	10/18/2022
Defendant's 30-day Trial Period Ends	12/2/2022
Plaintiff's Rebuttal Disclosures Due	12/17/2022
Plaintiff's 15-day Rebuttal Period Ends	1/16/2023
Plaintiff's Opening Brief Due	3/17/2023
Defendant's Brief Due	4/16/2023
Plaintiff's Reply Brief Due	5/1/2023
Request for Oral Hearing (optional) Due	5/11/2023

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.² The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

² To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.