

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: September 7, 2007

Opposition No. 92045271

Wiscon Corp.

v.

Cantine Caputo S.p.A.

Jyll S. Taylor, Administrative Trademark Judge:

On April 10, 2007, the Board issued an order suspending this proceeding in view of the withdrawal of respondent's counsel, and allowing respondent 30 days in which to either appoint a new attorney or state that it would represent itself. When respondent failed to respond within the time provided, the Board issued an order, on June 1, 2007, allowing respondent 30 days to show cause why judgment should not be entered against it based on respondent's apparent loss of interest in the case.

This case now comes up for consideration of respondent's motion, filed June 29, 2007, for a one-month extension of time to respond to that order. The motion was filed by an attorney who had been contacted by but was not then representing respondent. The request was filed "[i]n

the interest of preserving [respondent's] rights," but did not include any other justification or explanation.

Petitioner, on July 18, 2007, filed a combined opposition to respondent's motion, and motion for entry of default judgment. In its submission, petitioner argues that respondent's "problems with hiring and retaining Counsel date back to December 30, 2005 and have been its excuse for complete inaction on this proceeding since then."

Petitioner asserts that because respondent's June 29, 2007 request for extension was not served in violation of Trademark Rule 2.119(a), and that because respondent has still not retained counsel, respondent "has still not shown enough interest in the case" Petitioner further argues that respondent has failed to establish good cause for the requested extension, and that respondent's actions have resulted in an unacceptable delay in consideration of petitioner's pending motion to compel, filed December 13, 2006. Petitioner requests that respondent's request for extension be denied and that default judgment be granted in petitioner's favor.

On July 19, 2007, respondent filed a letter, signed by Mario Caputo and in apparent response to the show cause order, stating that it

has not lost interest in this case and is looking for a new attorney to represent itself. The name of the new attorney appointed by us will be communicated to United State (sic) Patent and

Trademark Office by August 1st. In the meantime, [respondent] will represent itself.

This letter was apparently not served on petitioner.

As a preliminary matter, although respondent's filings have not been served on petitioner, the purpose of the Board's service requirement is to ensure that parties receive adequate notice of filings and matters at issue in a proceeding. Here, petitioner's response of July 18, 2007 makes clear that it received notice of respondent's request for extension. Accordingly, we will consider respondent's request for extension, but in the future, respondent must comply with Trademark Rule 2.119, and the Board will not consider any filings which do not comply.

Turning to respondent's request for extension, the standard for allowing an extension of a prescribed period prior to the expiration of the period is "good cause." Fed. R. Civ. P. 6(b); TBMP § 509 (2d ed. Rev. 2004). Generally, "the Board is liberal in granting extensions of time before the period to act 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." American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313, 1315 (TTAB 1992).

Respondent has established good cause for the requested extension. It is clear from the June 29, 2007 filing that respondent made efforts to obtain representation, and

therefore that it has not been negligent and has not acted in bad faith. While it appears that respondent did not ultimately reach an agreement with an attorney regarding representation, there is no requirement that parties in Board proceedings be represented. TBMP § 114.01 (2d ed. rev. 2004). Moreover, the delay in appointing new counsel was due in large part to respondent's counsel's initial failure to comply with the rules governing withdrawal of counsel in proceedings before the Board and the ensuing delay and, on this record, the Board does not find that opposer has been substantially prejudiced by the short delay.

In view thereof, respondent's request for extension of time to respond to the Board's order of June 1, 2007, is hereby **GRANTED**.¹ The Board would ordinarily reset respondent's time to respond to the show cause order, however, it is clear from the filings that respondent has not lost interest in this case, had difficulty obtaining new counsel, and is now representing itself in this proceeding.

Proceedings herein are therefore resumed, solely for the purpose of considering petitioner's motion, filed December 13, 2006, to compel.² Respondent is allowed until

¹ Consequently, petitioner's motion for default judgment is moot.

² The suspension does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel.

FORTY-FIVE DAYS from the mailing date of this order to file its response to the motion to compel. If no response is filed within the time provided, petitioner's motion to compel may be granted as conceded. Additionally, the Board is not inclined to extend respondent's time for responding to petitioner's outstanding discovery requests based upon the need to obtain new counsel.

INFORMATION FOR PRO SE PARTIES

Because it appears that respondent will be representing itself in this proceeding, it should note the following. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. Respondent should note that Patent and Trademark Rule 10.14 permits any person to represent itself in a Board proceeding, though it is generally advisable for a person unfamiliar with the above-referenced rules to secure the services of an attorney familiar with such matters.

At a minimum, respondent is advised to designate a domestic representative upon whom proceeding correspondence may be served. The mere appointment of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under Trademark Rule 10.14.

If respondent does not retain counsel, then respondent, through its representative,³ will have to familiarize itself with the rules governing this proceeding. **Strict compliance with the Trademark Rules and all other applicable rules is expected of all parties, even those representing themselves.**

The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure are likely to be found at most United States law libraries, and may be available at some public libraries. Most of the information, as well as the Board's Manual of Procedure, may be accessed via the Internet at www.uspto.gov.

One rule that respondent must pay particular attention to is Trademark Rule 2.119. That rule requires that a party filing any paper with the Board during the course of a proceeding must serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. With the paper that is filed with the Board, the party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement

³ As previously noted, respondent is being represented by Mario Caputo. No title, e.g., President, Chief Executive Officer, for Mr. Caputo has been given. Respondent should include Mr. Caputo's title in future filings.

Cancellation No. 92045271

attesting to the following matters: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service.⁴

Also, respondent should note that any paper it is required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Patent and Trademark Rules 2.197 and 2.198 is utilized. These rules are in part one of Title 37 of the previously-discussed Code of Federal Regulations.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to

⁴ While not required, the parties are urged to agree to email service of papers to avoid delays inherent in overseas mailing. Additionally, respondent is advised to make its email address of record. In this regard, changes to a party's correspondence address can be made via ESTTA, the Board's electronic filing system, which may be accessed via the Internet at www.uspto.gov.

Cancellation No. 92045271

supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>
