

THIS OPINION IS NOT A PRECEDENT
OF THE TTAB

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

Butler

Mailed: November 2, 2009

Opposition No. 91118482

Opposition No. 91118950

Opposition No. 91155075

Opposition No. 91182937

GENERAL MILLS, INC. and GENERAL
MILLS IP HOLDINGS II, LLC

v.

FAGE-DAIRY PROCESSING INDUSTRY S.A.

Before Quinn, Kuhlke and Mermelstein, Administrative Trademark
Judges.

By the Board:

Applicant seeks to register numerous marks that are the
subjects of applications which are involved in this consolidated
proceeding as set forth below:

- TOTAL SHEEPS' YOGHURT and design for "set yoghurt -
made from ewes' milk and yoghurt culture"¹ is the subject matter
of Opposition No. 91118482 which commenced on June 12, 2000.

- TOTAL OARE and design for "strained yoghurt made from
fresh cow milk, cream and yoghurt culture"² is the subject matter
of Opposition No. 91118950 which commenced on June 12, 2000.

¹ Application Serial No. 75597291, filed on November 30, 1998, claiming a *bona fide* intent to use the mark in commerce.

- TOTAL TZATZIKI AUTHENTIC GREEK and design for "tzatiziki, made of cucumbers, yogurt, garlic, herbs and spices; and dairy products, namely, yoghurt" and "sauces, spices and food flavorings, not of essential oils"³ is the subject matter of Opposition No. 91155075 which commenced on May 17, 2002. TOTAL LIGHT THE AUTHENTIC GREEK STRAINED YOGHURT and design, TOTAL WITH GREEK HONEY THE AUTHENTIC GREEK STRAINED YOGHURT and design, TOTAL 2% and design, TOTAL CHERRY THE AUTHENTIC GREEK STRAINED YOGHURT, all for "dairy products, namely, yoghurt"⁴ are also the subject matters of Opposition No. 91155075.

- FAGE TOTAL ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL 5% ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL 2% ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL 0% ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL WITH HONEY ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL WITH STRAWBERRY ALL NATURAL GREEK STRAINED YOGHURT and design, FAGE TOTAL 2% WITH HONEY ALL NATURAL GREEK STRAINED YOGHURT and design, and FAGE TOTAL WITH CHERRY ALL NATURAL GREEK STRAINED YOGHURT and design, all for "dairy

² Application Serial No. 75597292, filed on November 30, 1998, claiming a *bona fide* intent to use the mark in commerce.

³ Application Serial No. 76016809, filed April 4, 2000, claiming a date of first use anywhere and a date of first use in commerce of July, 1998.

⁴ Respectively, application Serial Nos. 76016810 (claiming a date of first use anywhere and a date of first use in commerce of September, 1998), 76016811 (claiming a date of first use anywhere and a date of first use in commerce of July, 1998), 76016812 (claiming a date of first use anywhere and a date of first use in commerce of April, 1998) and 76016813 (claiming a date of first use anywhere and a date of first use in commerce of November, 2000), were all filed on April 4, 2000.

products, namely yoghurt"⁵ are the subject matters of Opposition No. 91182937 which commenced on March 12, 2008.

In accordance with the amended consolidated notice of opposition (filed January 3, 2007) and the parties' stipulations (filed July 8, 2008 and December 12, 2008), opposer⁶ asserts two grounds for the notice of opposition. Those are: 1) that applicant's marks so resemble opposer's previously used and registered TOTAL marks as to be likely to cause confusion, mistake or to deceive; and 2) that applicant's marks dilute the distinctive quality of opposer's marks. Opposer's pleaded registered marks are TOTAL for "wheat flakes"⁷ and TOTAL for "breakfast cereal."⁸ In its answer (filed May 9, 2007), applicant denies the salient allegations of the amended consolidated notice of opposition.⁹

⁵ Application Serial Nos. 77037793, 77037808, 77037835, 77037851, 77037869, 77037897, 77037905, and 77037924, each filed on November 6, 2006, and each claiming a *bona fide* intent to use the mark in commerce.

⁶ The Board recognizes that there are two opposers but refers to the position of plaintiff in the singular in this order.

⁷ Registration No. 0724897, issued on December 5, 1961, claiming a date of first use anywhere and a date of first use in commerce of February 23, 1961. Second renewal.

⁸ Registration No. 1394264, issued on May 20, 1986, claiming a date of first use anywhere and a date of first use in commerce of February 23, 1961. First renewal.

⁹ In accordance with the parties' stipulation of July 8, 2008 (paragraph No. 7), applicant withdrew its counterclaim to cancel each of opposer's pleaded registrations. See applicant's answer to the amended notice of opposition, filed May 9, 2007, which includes applicant's counterclaim asserting abandonment only. After withdrawing the counterclaim, applicant, on November 11, 2008, moved for leave to amend the withdrawn counterclaim with respect to pleaded Registration No. 1119067 only to reassert abandonment. On December 8, 2008, the parties filed a stipulation, discussed later in this order, which included a withdrawal of applicant's motion to amend its counterclaim and a

The discovery period closed on November 1, 2008. In an order dated April 1, 2009, the Board reset the trial dates, scheduling opposer's thirty-day testimony period to close on June 1, 2009 (opening on May 3, 2009). This case now comes up on the following motions:

1. applicant's fully briefed motion for summary judgment in its favor, filed on April 27, 2009, on A) opposer's dilution claim only and, separately, B) under the law of the case doctrine;
2. opposer's fully briefed motion, filed June 1, 2009, for sanctions pursuant to Fed. R. Civ. P. 11;
3. applicant's fully briefed motions, filed July 13, 2009 and July 23, 2009, to strike certain evidence introduced by opposer in its response to applicant's summary judgment motion.

Before turning to the motions, the Board addresses some preliminary matters.

Opposer's standing

In accordance with the parties' stipulation regarding pleadings and amendments (paragraph No. 9), filed July 8, 2008, "[a]pplicant acknowledges and agrees that Opposers have standing to maintain the proceeding in Opposition I and II."¹⁰

In view thereof, opposer's standing is established for all purposes in these proceedings.

dismissal of the consolidated opposition with respect to pleaded Registration No. 1119067. Accordingly, there are no counterclaims present in this case.
¹⁰ As defined in paragraph No. 1 of their stipulation, the parties identify collectively Opposition Nos. 91118482, 9118950 and 91155075 as "Opposition I." Such proceedings were, by the time the parties filed their stipulation, consolidated with Opposition No. 91118482 as the "parent" case. The parties identify Opposition No. 91182937 as "Opposition II." In an order dated August 18, 2008, the Board joined this latter opposition to the existing consolidated proceeding.

The parties' December 12, 2008 stipulation

In an order dated March 31, 2009, the Board granted the parties' December 12, 2008 stipulated dismissal whereby opposer dismissed with prejudice its claims against applicant premised only on Registration No. 1119067 in exchange for applicant withdrawing its motion to amend its counterclaim to assert abandonment (a counterclaim which had previously been withdrawn)¹¹ with respect to such registration. In accordance with paragraph No. 3 of the stipulation, opposer explained that the stipulation was made to avoid collateral litigation based on its Registration No. 1119067 and the parties expressly stated that "[t]his stipulation does not apply to claims premised on Registration Nos. 724,897 and 1,394,264." The Board, in its March 31, 2009 order, recognized the agreement between the parties explicitly acknowledged that this proceeding remained viable with respect to Registration Nos. 0724897 and 1394264: "[t]he stipulation expressly states that it does not apply to opposers' claims based on its pleaded Registration Nos. 724897 and 1394264." The Board dismissed with prejudice the consolidated opposition "... insofar as it is premised on opposers' pleaded Registration No. 1119067."

¹¹ See paragraph No. 7 of the parties' July 8, 2008 stipulation regarding pleadings and amendments, entered by order of the Board dated August 18, 2008.

Background

As the Board observed in its April 1, 2009 order, this case has a long and increasingly acrimonious history, which continues despite numerous admonitions from the Board. The "parent" opposition commenced over ten years ago, on June 12, 2000 and ample discovery has taken place. Over the course of this proceeding, the pleadings have been amended several times; opposer's motion for partial summary judgment was denied (see the Board's order dated June 2, 2008); applicant's multiple discovery motions were denied (see the Board's orders dated December 12, 2007¹² and April 1, 2009¹³); opposer's motion for a protective

¹² In the December 12, 2007 order, the Board observed as follows: "The record shows a continuing inability of the parties to work toward a resolution of this dispute. Applicant appears to be unable to respond to Board orders or opposer's motions in a timely fashion, that is, without an extension of time." (The Board then informed applicant it would not consider applicant's untimely reply brief.)

Also before the Board at that time was opposer's motion for a protective order. Such motion, which was granted, sought protection from applicant's deposition requests of opposer's top executives and trademark counsel. Applicant's then-pending motion to compel certain discovery was denied on the basis that applicant's motion, having been filed after opposer's motion for summary judgment, was untimely. The Board noted that, notwithstanding the timing of the motion to compel, opposer had produced documents and made people available for deposition and that opposer's objections to the discovery requests were well-taken. Applicant's motion for 56(f) discovery was also denied because applicant failed to identify the discovery "needs" that were relevant to the issues raised in opposer's motion for partial summary judgment. The Board commented, "Ironically, these issues and the underlying facts are all within applicant's control and do not require discovery from opposers."

¹³ The Board denied applicant's motion to compel for failure to make a good faith effort to resolve the dispute. Briefly, opposer had served written discovery responses and produced documents in 2006 in response to applicant's written discovery requests. By correspondence dated December 9, 2008, applicant informed opposer that it believed opposer should supplement document production with respect to documents since 2006 and produce documents in response to requests for which applicant contended opposer had never produced documents. Opposer stated this was the first time it was made aware that

order against applicant's discovery abuses was granted (see the Board's order dated December 12, 2007); and applicant's petition to the Commissioner, complaining that the Board erred in its December 12, 2007 order which granted opposer's motion for a protective order and denied both applicant's then-pending motion to compel and then-pending motion for Fed. R. Civ. P. 56(f) discovery, was denied.¹⁴

In its April 1, 2009 order, the Board informed the parties that they were expected to move forward to trial. Notwithstanding this instruction, and as noted earlier, applicant, after opposer served its pretrial disclosures and just prior to the opening of opposer's main testimony period, moved for summary judgment. Applicant's motion for summary judgment, as discussed in more detail later in this order, occasioned the

applicant sought additional and supplemental production and informed applicant, on December 12, 2009, that it would produce documents prior to Christmas. Notwithstanding this information, applicant filed its motion to compel on December 15, 2009. Opposer produced supplemental and additional documents on December 24, 2009. Opposer noted that, over the course of this proceeding, it has produced over 41,000 documents in response to applicant's 539 document requests; answered over 90 interrogatories and 142 admissions requests; and that applicant has taken seven depositions of opposer's personnel as well as three depositions of third parties.

Applicant also sought the continued deposition of opposer's witness, David Clark, on the basis that he was unprepared. As the record indicated, Mr. Clark had been scheduled to testify for two days. After half a day of testimony, applicant's attorney refused to proceed and departed to catch an airplane flight. The Board reviewed the transcript of Mr. Clark's deposition and found that he had prepared for the deposition and answered the questions asked. The Board also found that the objections made by opposer's attorney were not improper and were not "speaking" objections. The Board found that applicant's abrupt termination of the two-day deposition after half a day of questioning was not warranted.

¹⁴ The Commissioner's order, among other things, noted that applicant had not taken any depositions at the time it filed its petition. The order also characterized as "absurd" applicant's argument on petition concerning the Board's use of the term "further" in its December 12, 2007 order.

filing of opposer's motion for Rule 11 sanctions. In addition, applicant brought two separate motions to strike opposer's evidence. All motions are accompanied by exhibits resulting in an unnecessarily voluminous record directed only to those motions which are presently ripe for consideration.

There is no doubt that applicant's actions have caused, and continue to cause delay in this case and burden the Board's judicial resources.

The parties' arguments on applicant's motion for summary judgment¹⁵

Applicant seeks judgment in its favor based on two separate theories. Under the first theory, applicant argues that, because opposer stipulated to the dismissal with prejudice of all claims based on Registration No. 1119067 for the mark TOTAL for multi-vitamins and iron supplements, there is a final judgment for such mark, for such goods, on opposer's claims of likelihood of confusion and dilution, and such final judgment is the law of the case. Applicant argues that opposer consistently has taken the position that its cereal is the equivalent of a multi-vitamin and iron supplement.¹⁶ Thus, applicant contends, it is entitled to

¹⁵ Applicant submitted its complete summary judgment motion and all exhibits under seal. When a party submits confidential materials under seal, it is also to submit a copy for the public record, with only confidential data redacted. Trademark Rule 2.126(d); and TBMP 412.04 (2d ed. rev. 2004). Applicant has not submitted the redacted copies. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to do so.

¹⁶ As examples, applicant points out that, in 1979, opposer submitted a cereal box as a specimen in support of its application that matured into Registration No. 1119067 and, in 2003, again submitted a cereal box in support of its

judgment in its favor with respect to opposer's current claims premised on its TOTAL marks for cereal.

Secondly, applicant argues that opposer abandoned its TOTAL mark outside of Class 29;¹⁷ that there is a "flood" of third-party uses of the term TOTAL for grocery items; and that the TOTAL brand has suffered a sharp sales decline, low unaided consumer awareness, and other factors resulting in a weak brand equity. Applicant argues that opposer has no evidence of consumer awareness of its mark prior to 1998, the year the Opposition I applications were filed, and that, in 2005, the year prior to the year the Opposition II applications were filed, opposer's cereal brand polled at a certain percentage of unaided awareness among cereal users, which is unpersuasive of the fame (for dilution purposes) of opposer's mark. Applicant contends that opposer's policing efforts have failed, pointing to certain opposition proceedings against BALLY TOTAL FITNESS and subsequent activities by Bally and opposer. Applicant, referencing specific information under seal, argues that opposer's commitment to its brand has declined and is not strong. As a consequence of these factors, applicant argues that opposer's TOTAL mark has not achieved the fame required among general consumers to support its dilution claim. Applicant also argues that the parties' marks

renewal. According to applicant, these sworn submissions constitute an admission that TOTAL cereal is a vitamin or the equivalent of a vitamin.

¹⁷ The Board notes in passing that the cereal goods identified in opposer's pleaded registrations are classified in Class 30. Consequently, applicant's

are different and that neither party is aware of any instance of actual confusion during the parties' simultaneous use of their respective marks since 1998.¹⁸

Applicant submits the declaration of its attorney, Virginia R. Richard, and accompanying exhibits, and the declaration of its chief executive officer, Athanassios Filippou, and accompanying exhibits, in support of its motion for summary judgment. Mr. Filippou states, among other things, that applicant "... strongly disagrees with Opposers' claim that their TOTAL mark for vitamin-fortified cereal is famous."

In response, opposer expresses its belief that applicant's motion was brought for the improper purpose of delaying a decision on the case given that it was filed days prior to the opening of opposer's main testimony period. Opposer argues that applicant's advocacy of the law of the case doctrine is without merit and warrants sanctions¹⁹ because the parties' stipulation

reference to Class 29 does not make sense and the Board assumes applicant meant to reference Class 30.

¹⁸ Inasmuch as applicant has withdrawn all counterclaims, its arguments concerning opposer's "policy of abandonment of the mark TOTAL" are improper. Accordingly, no consideration is given thereto for the purpose of establishing the absence of any genuine issues of material fact with respect to the abandonment of opposer's marks. To the extent applicant is using the term "abandonment" as an exaggeration of the circumstances of opposer's purported lack of fame, the Board has considered applicant's argument, according it an appropriate weight in view of the parties' respective burdens and the evidentiary record on summary judgment.

¹⁹ Opposer states that it served a motion for sanctions under Rule 11 in order to comply with the safe harbor provision of the rule. Subsequent to the service of the motion, and after the expiration of the safe harbor period, opposer filed its Rule 11 motion. Such motion is addressed later in this order. Contrary to applicant's contention, opposer's meritorious Rule 11 motion is not a second brief in response to applicant's summary judgment motion.

dismissing the opposition as premised on Registration No. 1119067 expressly reserves opposer's claims with respect to its other registrations. Opposer argues that the law of the case doctrine does not apply in view of the circumstances of this case. More specifically, opposer points out that the Board recognized the earlier dismissal was limited; that there was no decision on the merits of any claim; and that the parties did not intend to foreclose future litigation of the remaining issues when they entered into their stipulated agreement to dismiss the opposition with respect to Registration No. 1119067 (as explicitly stated by the parties). Opposer argues that applicant is contractually estopped from pursuing its law of the case argument because it entered into the stipulation, agreeing to its limited purpose. Opposer argues that applicant is judicially estopped from pursuing its law of the case argument because 1) applicant's current position directly contradicts its position taken in the stipulation, 2) the Board accepted applicant's earlier position by adopting the stipulation, and 3) unless estopped, applicant would derive an unfair advantage by presenting arguments it previously agreed it would not make (which induced opposer to drop its claims based on its Registration No. 1119067).

With respect to dilution, opposer argues that its TOTAL cereal has been heavily marketed since 1961; that the record is

replete with evidence (sales,²⁰ marketing, and near universal public recognition)²¹ that supports the fame of its TOTAL mark; that its TOTAL brand is one of the most prominent brands of cereal in the country; and that applicant ignores opposer's overwhelming evidence of fame by making misrepresentations of the documents, gross omissions of the evidence, and "cherry picking" snippets from opposer's business records. While opposer acknowledges it has reduced advertising expenditures in recent years as it retools its advertising message, opposer affirms it is committed to its TOTAL brand. Opposer indicates that it has used all available media to market its brand (including, print, radio, television, internet, and in-store); that some of its promotional campaigns are iconic;²² that its TOTAL cereal is sold in virtually every grocery store in the country;²³ and that, given the share of the ready-to-eat cereal category and the highly fractured nature of cereal brands, TOTAL is a "blockbuster" brand. Opposer argues that applicant's reference to an unaided awareness score is of little value; that an

²⁰ While specific sales numbers were submitted under seal, opposer states for the public record that its sales, since 1961, "must be measured in the billions of dollars."

²¹ Opposer provides the sales and marketing figures under seal. Opposer appropriately has filed redacted versions of all submissions under seal.

²² Opposer points to radio promotions in the 1980's by Paul Harvey and to its "stacking bowls" commercials and advertisements that ran from 1983-2005. Opposer states that the "stacking bowls" campaign was the subject matter of a 1989 Saturday Night Live parody by Phil Hartman.

²³ Opposer provides a figure for the number of American households that purchased TOTAL from the late 1990's to the early 2000's.

independent study conducted in 2008 confirms its own consumer awareness surveys (made over time) of its TOTAL cereal brand;²⁴ that applicant's expert did not offer any studies or figures in contradiction; and that Brandweek has consistently recognized TOTAL since 1997 as one of the top brands in America. Opposer indicates that the cereal category faces increasing competition but, even though sales of its TOTAL cereal have been lower recently, TOTAL remains extraordinarily successful and opposer's commitment to its brand has never wavered. Opposer explains that it enforces its rights in its TOTAL mark; that its more recent focus is for its TOTAL cereal to be the only food product using TOTAL as a brand name; that it is not necessarily concerned with uses on non-food products or uses of "total" or "totally" as a descriptive term on food items; and that applicant has not provided a single third-party use of TOTAL by itself as a mark for any product. Opposer indicates that Bally's witness testified that Bally's does not sell its BALLY'S TOTAL FITNESS products in grocery stores and that its product sales have been minimal. Based on all the evidence of record, opposer argues that the fame of its TOTAL mark is established for dilution purposes and, that, at a minimum, there is ample evidence from which a trier of fact could find that TOTAL is a famous mark.

²⁴ Opposer indicates that its awareness surveys in the record post-date 2000. However, according to opposer, such surveys remain compelling and highly relevant evidence of fame at least as of 1998 (the filing date of applicant's earlier applications) in view of the consistently high sales and advertising numbers through the 1990's.

Opposer also argues that the parties' marks are very or substantially similar; that its TOTAL mark is distinctive; that opposer has made substantially exclusive use of the TOTAL mark for food, beverages and related goods; that the TOTAL mark has a high degree of consumer recognition; that applicant's intent to create an association with opposer's mark should be inferred;²⁵ and that evidence of actual dilution is not required. Opposer argues that applicant's opinion that opposer's mark is not famous itself creates a dispute for summary judgment purposes in view of the contrary evidence of record showing the fame of opposer's mark.

Opposer's response is supported by the declaration of its attorney, Craig S. Coleman, and accompanying exhibits, and by the declaration of David V. Clark, opposer's vice president of marketing for adult cereals, and accompanying exhibits.

In reply,²⁶ applicant argues that the stipulated dismissal with respect to one registration is a final adjudication with respect to all registrations because opposer registered the same goods, using the same box as specimens, in two classes (Class 5 for multi-vitamins and Class 30 for cereal), thus taking the position that they are the same product; opposer withdrew its

²⁵ In support of this contention, opposer notes that, after Opposition I commenced, applicant filed the applications which are the subject matter of Opposition II, attempting to reduce the prominence of the term TOTAL by reducing its size on the label.

²⁶ Applicant appropriately filed a redacted copy of its confidential reply brief.

claims with respect to multi-vitamins, thus conceding its claims with respect to cereal; and opposer cannot now create an artificial distinction between cereal and multi-vitamins.

Applicant argues that opposer does not dispute any facts relating to applicant's use and success of its mark or dispute any of the evidence of record of third-party use; and that opposer's mark is not famous for dilution purposes. Applicant argues that opposer failed to meet its burden of proof of introducing competent evidence that TOTAL is a famous mark; that niche fame is not recognized; and that the other factors to consider with respect to a dilution claim weigh in favor of applicant. Applicant emphasizes that its opinion of the fame of opposer's mark is a factor to be considered by the Board and that it had no intention of creating an association with opposer's mark. Applicant, referencing opposer's arguments concerning the nature of third-party uses, contends that opposer admitted its mark is descriptive.

Applicant's motions to strike evidence

Before turning to the summary judgment determination, the Board considers, summarily, applicant's two motions to strike.²⁷

²⁷ Applicant filed both its motions to strike under seal and did not file any redacted copies for the public record (except entry No. 162, the declaration of Sanjana Chopra in support of its applicant's reply on its first motion to strike). As discussed earlier, redacted copies must be filed. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to do so.

Opposer's responses were also filed under seal without the submission of redacted copies for the public record. Opposer is allowed until **THIRTY DAYS** from the mailing date of this order in which to submit redacted copies for the public record.

At the outset, opposer has shown that it supplemented its discovery responses on September 12, 2008 (in time for the scheduled deposition of Mr. Clark, which took place on September 25, 2009) and December 23, 2008 (including figures through fiscal mid-year 2009 for sales and advertising); that it made Mr. Clark available for a deposition which applicant terminated prematurely; and that it supplemented its discovery responses on June 1, 2009 (with respect to sales and advertising) for its fiscal year 2009, noting that June 1 was the day after opposer's fiscal year closed, on May 31, 2009. With respect to this latter supplementation, the Board notes that opposer was under no obligation to provide such supplementation because the filing by applicant on April 27, 2009 of its summary judgment motion occasioned the suspension of proceedings herein.

As to applicant's argument that opposer willfully withheld information and documents because it did not supplement its discovery responses, the Board notes that supplementation and correction is required where the original responses were incomplete in some material aspect. See Wright, Miller & Marcus, 8 Fed. Prac. & Pro. Civ.2d §2049.1 (2009). In this case, there is no evidence or determination that opposer's discovery responses as originally served in and prior to 2006 were incomplete. Instead, the record indicates that opposer periodically updated its responses to applicant's discovery

requests due to the passage of time and the preparation for trial, which was to open this past May. The Board notes that three years or more have elapsed since the 2006 and prior responses. The supplementation made after 2006 was not made because opposer willfully withheld any information or documents responsive to applicant's discovery requests. Consequently, it cannot form a basis for improper conduct justifying preclusion of the introduction of such evidence on summary judgment or at trial.

In view thereof, the Board finds that opposer has met its discovery obligations in this consolidated case.

1. Applicant's first motion to strike (filed July 13, 2009)

Applicant's motion to strike paragraph Nos. 3, 7, and 10 of Mr. Clark's declaration is denied. As noted above, opposer has shown that it updated its discovery responses.

Applicant's motion to strike Exhibits A (a Twitter conversation printout) and B to Mr. Clark's declaration is denied, and applicant's hearsay and relevance objections are overruled. Again, as discussed above, opposer has shown that it provided the documents referenced to applicant. Contrary to applicant's position, Mr. Clark averred that the information he was making and the exhibit A that he was submitting were of his own knowledge, that he was the person who searched Twitter, and the approximate time he searched Twitter. Thus, Mr. Clark authenticated the submission. The Board is aware of the nature

of such evidence and will accord it appropriate probative weight. Exhibit B may be generally identified as a confidential report generated from one of opposer's databases. The report was filed under seal. As a corporate officer, Mr. Clark is charged with facts known to opposer. As with all declarations and affidavits submitted in connection with a summary judgment motion, or response thereto, the Board accords the statements made therein, and accompanying exhibits, appropriate probative weight.

Applicant's motion to strike exhibit Nos. 25-34 to Mr. Coleman's declaration is denied. As applicant now appears to concede in its reply brief, the excerpts from Brandweek are admissible as printed publications within the meaning of Trademark Rule 2.122(e).²⁸

2. Applicant's second motion to strike (filed July 23, 2009)

Applicant seeks to strike the report introduced under seal by opposer that is based on an independent survey conducted by opposer in 2008 on the basis that it is irrelevant and does not meet the admissibility standards of an expert report. The record reflects that applicant took the discovery deposition of opposer's expert. A copy of the transcript is of record.

²⁸ Applicant's request that it be allowed now to submit additional excerpts from Brandweek that applicant argues "were deliberately omitted" is denied as untimely. Applicant's opportunity to submit any additional excerpts expired on June 21, 2009 when the time to file its reply brief to its summary judgment motion expired.

Applicant presents numerous complaints in support of its motion including the competency of the expert; the use of an outside vendor to conduct the actual survey; the nature and selection of the universe and the purported involvement of opposer's attorney in defining the universe; the nature of the screening questions; the sample size; lack of control; incorrect and confusing instructions; and the results. Applicant also points out that the survey, taken in 2008, post dates the operative dates (1998 and 2006) by which opposer must prove fame for dilution purposes, thus making the survey irrelevant.

In response, opposer argues that the survey results are relevant to this proceeding to corroborate the historical fame of opposer's TOTAL mark for dilution purposes and to prove the current fame for likelihood of confusion purposes (the latter claim is not before the Board on applicant's summary judgment motion), and is probative of past consumer attitudes. Opposer argues that applicant's objections have no merit. Opposer contends that its expert is competent and his experience confirms his competence. Opposer contends that any flaws in the survey that may be found with respect to applicant's specific complaints go to the probative value of the survey, not to its admissibility. Opposer opines that applicant brought the second motion to strike as a way to submit additional argument akin to a second reply brief with respect to its summary judgment motion.

There is no such thing as a perfect survey. The questioning of a survey expert can focus strongly on "the road not taken." Thus, while technical deficiencies may reduce a survey's weight, they will not usually prevent the survey from being introduced into evidence. J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition, §§32:170 and 178 (4th ed. 2009). Attorney cooperation with a survey professional is essential to produce relevant, usable data. The attorney must be able to tell the survey director what the legal issues are and assist in framing relevant questions. *Id.* at §32.166. Thus, the interaction between the expert and opposer's attorney complained of by applicant was not improper and is not grounds for striking the expert report.

The Board does not find the survey report to be so deficient so as to warrant its exclusion. Accordingly, applicant's motion to strike is denied.²⁹

Applicant's summary judgment motion

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the

²⁹ Similarly, applicant's request to preclude the prospective trial testimony of opposer's expert is denied.

non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

1. Applicant's "law of the case" basis for summary judgment

Under law of the case doctrine, a determination of law once made will be treated as correct throughout all subsequent stages of the proceeding except when the issue is raised in a higher court. Barron's Law Dictionary, 265-266 (2d ed. 1984). Thus, a trial court will decline to reconsider its own earlier ruling in subsequent trial proceedings. *Id.* Actual decision of an issue is required and the law of the case doctrine does not reach a matter that was not decided. See *Toro Co. v. White Consol. Indus., Inc.*, 383 F.3d 1326, 72 USPQ2d 1449 (Fed. Cir. 2004); and Wright, Miller & Cooper, 18B Fed. Prac. & Pro. Juris. 2d §4478 (2009). A consent decree generally does not involve a decision by the court. See 18B Fed. Prac. & Pro. Juris. 2d §4478. Where it is recognized that an issue remains open, the law of the case doctrine does not apply. *Id.*

Here, its is clear that the law of the case doctrine does not apply because the parties' agreed, as explicitly stated in their December 12, 2008 filing, that "[t]his stipulation does not apply to claims premised on Registration Nos. 724,897 and

1,394,264." In its March 31, 2009 order, the Board recognized the parties' explicit agreement that the claims premised on Registration Nos. 724,897 and 1,394,264 remain open.

In view thereof, as a matter of law, applicant is not entitled to summary judgment in its favor on its law of the case theory.

The Board comments in passing that applicant's argument that opposer effectively admitted that "multi-vitamins and supplements" are the same goods as "cereal" and "wheat flakes" is without merit. The goods are distinctly stated and are classified in different international classes. As the parties' are aware, considerations with respect to any pleaded registrations or registrations and applications that are the subject matter of Board proceedings are made based on the goods or services as identified. See *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

2. Applicant's motion for summary judgment based on opposer's dilution claim only

In an opposition proceeding, considerations in a dilution analysis include whether the claimed mark is famous; whether it became famous prior to the filing date of applicant's application; and whether applicant's mark is likely to cause dilution by blurring or tarnishment of the distinctiveness of opposer's pleaded mark. Trademark Act §43(c). See also J.

Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition §24:100 (4th ed. 2009), and cases referenced therein.

Given the procedural posture of this case, applicant's argument that opposer has not proved its fame for dilution purposes, and thus has not proved its dilution claim, is premature. On this summary judgment motion, the burden is on applicant to establish an absence of any genuine issues of material fact with respect to opposer's dilution claim. Opposer, in responding to applicant motion, need only establish that a triable issue of fact exists in connection with its dilution claim. Opposer is not under a burden at this time to prove its claim. As emphasized earlier, all doubts concerning the existence of particular factual issues being in dispute must be resolved in the light most favorable to opposer as the non-moving party.

There is no doubt that, on this voluminous record which includes contradictory statements, explanations, and hard evidence, genuine issues of material fact exist with respect to the fame of opposer's TOTAL mark for dilution purposes. Moreover, in view of the evidence presented by both parties on this summary judgment motion (some of which is likely to be introduced at trial), it is clear that this case is not suitable for disposition on summary judgment. This is so because an adjudication of the claims will require inferences to be drawn from the evidence based on a preponderance of the evidence. The

Board notes that, while the parties perfunctorily addressed other elements considered in a dilution claim, genuine issues of material fact remain with respect to such elements, including (but not limited to) whether opposer has made substantially exclusive use of its TOTAL mark.

Accordingly, applicant's motion for summary judgment in its favor on opposer's dilution claim is denied.

Opposer's Rule 11 motion

Opposer seeks sanctions under Fed. R. Civ. P. 11 against applicant on the basis that applicant's summary judgment motion is substantively frivolous as based on law of the case doctrine and, further, was filed for the purposes of delay and harassment. Specifically, opposer seeks entry of judgment against applicant. Alternatively, opposer asks for sanctions which include: 1) barring applicant from filing any further motions before the commencement of trial, 2) allowing any document produced by opposer to be considered authentic and to be admissible into evidence if submitted during the testimony periods, and 3) establishing as fact that opposer's registrations are valid and subsisting.³⁰

³⁰ Although applicant characterizes these potential sanctions as "housekeeping" matters, they are available to be imposed as sanctions, if the Board determines that doing so is appropriate. A sanction imposed under Rule 11 is to be sufficient to deter repetition of the conduct found to be improper. See Fed. R. Civ. P. 11(c)(2).

Opposer reviews the history of this proceeding,³¹ and points out that applicant has a pattern of filing frivolous, ill-conceived and meritless motions on the eve of trial and at other times to occasion suspension of proceedings or to delay forward progress of proceedings, and that the Board has admonished applicant several times concerning its conduct. Opposer states that applicant's filings were often made notwithstanding existing stipulations on certain topics. Opposer states that it has begun preparation for the opening of its first testimony period twice in this case and spent considerable resources in April preparing for its testimony period which was scheduled to open on May 3, 2009.³² Opposer expresses its belief that applicant has abused motions practice to avoid trial and that applicant's summary judgment motion is the latest example of its abuse of motions practice.

In support of its motion, opposer argues that applicant's summary judgment based on law of the case doctrine was brought for the improper purpose of causing unnecessary delay to the case and is not warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing

³¹ Much of the history of this case is discussed in the "Background" section of this order, *supra*, and is not repeated in any detail here.

³² Opposer also indicates that it sought basic agreements to streamline trial including: 1) a stipulation to use third-party discovery depositions to avoid the cost and imposition of retaking the depositions of the deposed third parties, 2) a stipulation as to the authenticity of documents produced by either party, and 3) an assurance that documents will be served by email or overnight delivery to avoid delays. According to opposer, applicant either would not agree or did not respond to opposer's inquiries.

law. More particularly, opposer argues that applicant's position with respect to law of the case doctrine ignores the Board's March 31, 2009 order expressly preserving opposer's claims based on its Registration Nos. 0724897 and 1394264; further ignores the Board's April 1, 2009 order wherein the Board reaffirmed the remaining claims stating, "The claims remaining in this case are priority of use and likelihood of confusion and dilution.

Opposer relies on two pleaded registrations"; and that no order of the Board can be read as a basis to dismiss the claims that both the parties and the Board expressly reserved. Opposer argues that neither the stipulation nor any order of the Board decided any issue regarding likelihood of confusion or dilution involving opposer's TOTAL mark for multi-vitamins; that the December 12, 2008 stipulation never conceded anything as to the merits of the underlying claim based on the multi-vitamin mark;³³ and that applicant wrongly asserts that the dismissal amounts to a decision of a substantive issue. Opposer distinguishes the cases relied upon by applicant. Opposer points out that issues are not actually litigated in stipulations or consent judgments and, absent the parties' clear expression of intent to foreclose

³³ Opposer points out that the December 12, 2008 stipulation, withdrawing the opposition as premised on Registration No. 1119067 in exchange for applicant withdrawing its motion to amend its counterclaim with respect to such registration, expressly states that "[o]pposers do not agree with the allegations set forth in Applicant's motion papers"; further states that the stipulation was entered to avoid "collateral litigation on Applicant's counterclaim"; and, as mentioned before, expressly states that "[t]he stipulation does not apply to claims premised on Registration Nos. 724,897 and 1,394,264."

the issue from future litigation, there is no decision on any such issues. Opposer contends that applicant's assertion that opposer admitted anything through the stipulation is a misrepresentation of the record and highlights certain correspondence from opposer's attorney to applicant's attorney in support of its position.³⁴ Opposer contends that a relevant issue for trial will be the close relationship of cereal and yogurt; that, notwithstanding any attributes its cereal may have of multi-vitamins, its asserted TOTAL marks are registered for cereal and wheat flakes; and that any claim by applicant that opposer's TOTAL marks for cereal and wheat flakes must be treated the same as its TOTAL mark for multi-vitamins is without factual foundation and ignores evidence regarding the association between cereal and yogurt. Opposer also expresses its belief that applicant's inclusion of opposer's dilution claim as a second basis for applicant's summary judgment motion does not negate the showing that applicant's motion was brought for an improper purpose because the motion could have been brought earlier on dilution and because applicant's motion is

³⁴ Some examples of the correspondence from opposer's attorney referenced by opposer are as follows: "General Mills has no doubt that it would prevail here if forced to litigate whether it has abandoned the use of Total on vitamins, including its marketing of its cereal as a vitamin. However, in this case, the issue would amount to little more than a sideshow wasting the parties' and the Board's time." (Letter dated December 10, 2008.) "General Mills stipulates to voluntary dismissal simply to bring eight years of litigation to a final resolution on the merits of the real issues in dispute: whether Fage's marks are likely to cause confusion or to dilute General Mills' marks." *Id.*

contrary to the standards governing consideration of summary judgment motions.

Opposer's motion is accompanied by the declaration of its attorney and accompanying exhibits. Opposer's motion also evidences a certificate of service dated May 14, 2009. Thus, the filing of the motion with the Board on June 5, 2009 complies with Fed. R. Civ. P. 11(c)(1)(A), also known as the "safe harbor" provision.³⁵

In response,³⁶ applicant argues that its summary judgment motion was timely filed, was well-grounded and meticulously supported and that a disagreement about the application of the law does not form the basis for a Rule 11 motion. Applicant reviews certain aspects of the case history for this consolidated opposition, arguing that opposer has caused delay to this case; that opposer neglected the case for six years; that opposer undertook questionable prosecution after 2006;³⁷ and that

³⁵ Opposer did not act improperly by mentioning in its June 1, 2009 response to applicant's summary judgment motion that it had served a Rule 11 motion on applicant and that it intended to file the Rule 11 motion after the expiration of the safe harbor period if applicant's summary judgment motion was not withdrawn. Inasmuch as the Rule 11 motion was served and filed as a result of the summary judgment motion, it is not unexpected to observe an overlap in some of the facts, arguments and case cites. The Board is able to distinguish the standards applicable to each motion and the core elements attributable to each motion.

³⁶ Applicant filed its response on June 22, 2009 under seal. On June 26, 2009, applicant appropriately filed a redacted version for the public record.

³⁷ Applicant references opposer's November 2, 2006 motion to amend the pleading to assert dilution under the Trademark Dilution Revision Act ("TDRA"), which became effective only one month earlier on October 6, 2006; opposer's January 2, 2007 motion to amend the pleading to assert fraud with respect to certain applications and subsequent withdrawal of the claim in accordance with the parties' stipulation regarding pleadings and amendments, filed July 7, 2008 (and in which opposer consented to amendments to the

opposer, in its summary judgment response, falsely claimed both that it used its mark on multi-vitamins and that it provided applicant with documents showing such use.³⁸ Applicant argues that it did not delay in bringing its summary judgment motion because proceedings had been suspended until April 1, 2009 pending disposition of applicant's December 15, 2008 motion to compel. Applicant contends that, contrary to opposer's argument, it referenced the two different dates by which opposer must establish fame (1998 and 2006 for Opposition I and Opposition II applications, respectively).³⁹ Applicant provides a discussion of *res judicata*, collateral estoppel and law of the case doctrine, citing specific cases, and contends that stipulated dismissals constitute a judgment on the merits and are entitled

identification of goods for certain applications and applicant stipulated to opposer's standing); opposer's motion for a protective order, filed June 5, 2007 (which was granted by the Board); and opposer's motion for partial summary judgment, filed June 22, 2007, on its fraud claim, which was denied by the Board. The Board comments at this time that it finds no "questionable prosecution" in bringing a motion to amend a pleading shortly after the basis for a claim became legally available (TDRA) or in negotiating with an adversary with the result that certain agreements are made between the parties. Moreover, there is no indication that either opposer's motion for a protective order or motion for summary judgment were "questionable" or could be characterized as "questionable prosecution."

³⁸ The Board has made determinations with respect to applicant's discovery disputes in other orders. There is no reason to revisit the circumstances that gave rise to such determinations. Similarly, in view of opposer's withdrawal of its multi-vitamin registration as a basis for the oppositions, applicant's withdrawal of all its abandonment counterclaims, and applicant's withdrawal of its motion to amend its counterclaim to reassert abandonment against opposer's multi-vitamin registration, applicant's lengthy, substantive arguments on these matters are not before the Board and will be given no further consideration.

³⁹ This continued argument appears to arise from some confusion over the evidence submitted on summary judgment as it applies to the operative dates for opposer's dilution claims and the controversy over opposer's survey expert. The Board understands what the operative dates are, each parties'

to preclusive effect. Applicant argues that opposer misunderstands applicant's law of the case arguments and that opposer made a strategic error in "hastily dismissing all claims with prejudice based on Registration No. 1119067," explaining that applicant now seeks to apply the Board's earlier dismissal to opposer's remaining claims based on opposer's purported admissions that its TOTAL cereal and mutli-vitamins are equivalent. Applicant contends that its motion for summary judgment on opposer's dilution claim was appropriate and exhaustively supported.

In reply, opposer argues that its motion for Rule 11 sanctions should be granted because 1) applicant's law of the case argument is not "warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law" and 2) applicant's motion for summary judgment was presented for the improper purpose to "cause unnecessary delay or needless increase in the cost of litigation." Opposer emphasizes that this is not a simple disagreement about the application of law or conflicting legal authorities; that there is no basis under law of the case doctrine to conclude the parties' stipulated dismissal as to Registration No. 1119067 constituted a final judgment on the merits on the issues of likelihood of confusion and dilution; and that applicant's position that the law of the case can apply to

burden on summary judgment, the nature of the evidence submitted, why it was

issues that are not actually decided lacks support and contradicts the body of law presented to the Board by both parties. Opposer distinguishes the cases referenced by applicant, pointing out that many do not apply the law of the case doctrine; that claim preclusion is not applicable to the facts of this case; that none of the cases wherein there were stipulated dismissals involved dismissal of fewer than all of the claims; and that applicant's references to Fed. R. Civ. P. 41 cases are irrelevant because the Rule is applicable only where all of the claims to an action are dismissed.⁴⁰ Opposer references 18 Moore's Federal Practice Civil §134.20 (Matthew Bender 3d ed. 2009) for the explanation that "issue preclusion limits relitigation of an issue after final judgment" while "law of the case doctrine limits relitigation of an issue once it has been decided." However, the latter "is concerned with the extent to which the law applied in decisions at various stages of the same litigation becomes the governing principle in later stages." *Id.* Opposer argues that applicant has failed to cite any relevant cases supporting its application of law of the case to issues that were not actually decided - and were explicitly reserved - in the parties' stipulation and that applicant has failed to explain how opposer's multi-vitamin registration can be

submitted, and the purpose for which it was submitted.

⁴⁰ See Wright & Miller, 9 Fed. Prac. & Pro. Civ.3d §2362 (2009); and 8 Moore's Federal Practice Civil §41.21 (Matthew Bender 3d ed. 2009). The latter treatise was referenced by opposer.

construed to negate confusion and dilution with respect to opposer's cereal and wheat flakes registrations.

Rule 11(b) provides, in part, as follows:

(b) By presenting to the court ... a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that, to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,—

(1) it is not being presented for any improper purpose, such as to harass or cause unnecessary delay or needless increase in the cost of litigation;

(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law.

The purpose of Rule 11 is to deter baseless filings in the tribunal. *See Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 393 (1990). If the Board concludes that Rule 11 has been violated, it may impose appropriate sanctions. As noted earlier in this order, any sanctions imposed under Rule 11 are to be sufficient to deter repetition of the conduct found to be violative of the Rule. Fed. R. Civ. P. 11(c)(2); *see also* Advisory Committee Notes (1983 and 1993).

Board practice allows a summary judgment motion to be filed prior to the opening of the first testimony period. *See* Trademark Rule 2.127(e); and TBMP §528.02 (2d ed. rev. 2004). Thus, the timing of applicant's summary judgment is not improper *per se*. However, one of the bases upon which opposer seeks sanctions is that the timing of applicant's motion, which was days before opposer's main testimony period was to open and after

opposer served its pretrial disclosures, is part of a pattern of delay tactics by applicant that has emerged in this case. The Board agrees.

Accordingly, opposer's motion for Rule 11 sanctions on the basis that applicant's motion for summary judgment was presented for the improper purpose to "cause unnecessary delay or needless increase in the cost of litigation" is granted.

This finding is further supported by the substance of the motion, in particular, applicant's motion for summary judgment as premised on law of the case doctrine. Applicant's misapplication of the doctrine, which is particularly egregious in light the parties' December 12, 2008 stipulated dismissal with prejudice of the opposition as premised on Registration No. 1119067 only and applicant's withdrawal of its motion to amend its counterclaim, cannot be ignored. The stipulation was very clear that opposer's claims were to go forward as premised on the two remaining, pleaded registrations. The Board, at least twice in its orders, recognized the explicit expression of the parties' agreement, without objection from applicant.

Accordingly, opposer's motion for Rule 11 sanctions is granted because applicant's law of the case argument is not "warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law."

Sanctions imposed

The Board believes that entry of default judgment, as sought by opposer, is too severe a remedy under Rule 11.⁴¹ In view of our findings that applicant violated Rule 11, as discussed above, the following sanctions are imposed:

- 1) applicant is prohibited from filing any further motions in this case;⁴²
- 2) applicant may not object to (or move to strike) opposer's evidence (for example, applicant may not assert that opposer's evidence constitutes hearsay, is not relevant, lacks foundation, or is not competent);⁴³ and
- 3) applicant may not take depositions upon written questions.⁴⁴ Instead, applicant must arrange for in-person depositions of its witnesses during its assigned testimony period. Opposer may elect to attend by telephone or teleconference or in person.

In view of applicant's egregious course of conduct, dilatory and unwarranted conduct and excessive filings, and as an alternative basis for sanctions, the Board incorporates the sanctions imposed under Rule 11, as stated above, under our inherent authority to impose sanctions. *See Carrini, Inc. v.*

⁴¹ The Board's reluctance to enter judgment against applicant should not be construed as condoning any of applicant's dilatory and excessive conduct throughout the history of this case. We are simply being mindful, however, that the purpose of Rule 11 sanctions is to deter repetition of applicant's conduct. We believe that the sanctions imposed do so.

⁴² Under this prohibition, applicant may not file a motion for reconsideration of this order.

⁴³ However, applicant may present arguments in its trial brief regarding the weight that may be attributed to opposer's evidence. In addition, this does not relieve opposer from submitting proper evidence and the Board will still review the evidence to be sure it is a proper submission and to ascertain that it is substantively proper (*i.e.*, that it is not hearsay, that it is relevant, etc.).

⁴⁴ The Board notes in passing that applicant is a foreign entity. Often times, the Board allows depositions upon written questions for a foreign party.

Carla Carini, S.r.L., 57 USPQ2d 1067, 1071 (TTAB 2000). The Board, under its inherent authority, further imposes the following sanctions and requirements, which also serve to progress the case to and through trial to final decision:⁴⁵

- 1) any document produced by opposer is deemed authentic and admissible into evidence if submitted by notice of reliance or through testimony (as appropriate) during opposer's testimony periods;
- 2) if either party intends to introduce evidence by the testimony of a third party already deposed during discovery, the introducing party is to introduce the discovery deposition in lieu of retaking the deposition for trial in order to avoid potential further delay, to contain costs, and to avoid the imposition of retaking such depositions; and
- 3) all future papers served and filed are to be served by email **and** by overnight delivery.⁴⁶

Applicant is expressly informed that it, and its attorneys, may be required to appear before the Board to explain any future conduct that the Board determines is dilatory, excessive in nature and outside the spirit of working cooperatively towards a disposition in this case.⁴⁷ See Trademark Rule 2.120(i)(2).

⁴⁵ In this regard, the Board notes, too, that it has the inherent authority to schedule its own docket. *Id.* See also *Opticians Ass'n of America v. Independent Opticians of America, Inc.*, 734 F.Supp. 1171, 14 USPQ2d 2021 (D. N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

⁴⁶ A separate email without attachments is to be sent by the serving party informing the served party that service by email **and** overnight delivery has been sent. This requirement is preventative because, as sometimes happens, the firewall for the party who is served may not accept certain emails with attachments. In addition, with overnight delivery, the served party will be able to contact the serving party quickly if delivery does not occur.

⁴⁷ Opposer may be invited to attend but will not be required to do so.

In addition, any blatant disregard by applicant of the sanctions imposed or requirements made above may result in entry of judgment against applicant.

Opposer's priority is established in this case

With its Opposition II notice of opposition, filed March 12, 2008 (Opposition No. 91182937), opposer included printouts from USPTO databases of its pleaded Registration Nos. 0774897 and 1349264. Such printouts indicate status (TARR) and ownership (Trademark Assignment Abstract of Title). Thus, the record establishes for Opposition II that opposer's pleaded registrations are valid and subsisting and are owned by applicant. See Trademark Rule 2.122(d)(1) as amended, effective November 1, 2007. The Board will not require opposer to submit separately any evidence establishing the status and title of its pleaded registrations for the Opposition I cases, but will consider the evidence submitted with the Opposition II complaint sufficient for all purposes remaining in this consolidated case.

Accordingly, the record establishes that opposer's pleaded registrations are valid and subsisting and are owned by applicant. Priority is no longer an issue in this case. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

The schedule

The parties have been ordered to submit redacted copies for the public record of certain filings made under seal. In order to prevent confusion in the docket entries, when a party files the required redacted copies, it is to enter such copy by referencing the docket entry number, e.g., "redacted copy of No. 138."⁴⁸

As discussed in this order, and based on the record, opposer's standing is established by stipulation of the parties, opposer's priority is established, and there are no counterclaims in this case. The claims for trial are likelihood of confusion and dilution.

Proceedings are resumed.⁴⁹ Trial dates are reset as follows:

Plaintiff's 30-day Trial Period	
Ends	12/15/2009
Defendant's Pretrial	
Disclosures	12/30/2009
Defendant's 30-day Trial Period	
Ends	2/13/2010
Plaintiff's Rebuttal	
Disclosures	2/28/2010
Plaintiff's 15-day Rebuttal	
Period Ends	3/30/2010

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on

⁴⁸ If the parties encounter any problems in entering the description of the filing, they are to call 571-272-8500 and ask for a TTAB computer specialist for assistance.

⁴⁹ As noted earlier in this order, opposer has already served its pretrial disclosures. However, if opposer finds that such pretrial disclosure need to

Opposition Nos. 91118482; 91118950; 91155075; and 91182937

the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

be amended or modified in view of the passage of time, opposer is allowed until November 10, 2009 to do so.