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

Brown

Mailed: November 14, 2008

Opposition No. 91186158

Anheuser-Busch, Incorporated

v.

Janice M. Kruse

Brian D. Brown, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference at 3:00 p.m. EST, on November 12, 2008. Board participation was requested via telephone by counsel for opposer on October 23, 2008. During the conference, opposer was represented by attorneys Gary A. Pierson and Jenny Birmingham; attending on behalf of applicant were Janice Kruse; and participating for the Board was the above-signed interlocutory attorney along with Al Drost, Administrative Trademark Judge. The Board commends the parties for their professionalism, collegiality as well as attentiveness throughout the conference and remains hopeful that the parties will conduct themselves in that manner for the duration of the proceeding.

At the onset, the Board noted that applicant is currently proceeding in this matter without legal representation. While Patent and Trademark Rule 10.14 permits any person to represent his or herself, the Board repeatedly reminded applicant during the conference that it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office, however, cannot aid in the selection of an attorney, and strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.[1] It is therefore recommended that applicant, at the very least, obtain a copy of the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and is available for a fee from U.S. Government Printing Office on the World Wide Web at http://bookstore.gpo.gov.

Turning to the objectives of the conference and the request for the Board to participate, the parties seemed primarily interested in familiarizing themselves with the

[1] The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is also available on the World Wide Web at http://www.uspto.gov.

application of the new rules governing inter partes proceedings and how the Board planned to handle certain issues in light of the new rules. In that regard, the Board provided the parties with an overview of the opposition proceeding, briefly discussing the Board's jurisdiction while also highlighting many of the new rules governing inter partes proceedings.

For example, the Board advised the parties of the automatic imposition of the Board's standard protective order in this case pursuant to Trademark Rule 2.116(g) and stated that if the parties wished to modify the Board's standard protective order, they should do so by filing a motion for Board approval.[2] In addition and throughout the conference, the Board encouraged the parties to engage in future discussions amongst themselves in order to facilitate settlement of this case or at a minimum, to streamline discovery by stipulating to certain facts where appropriate. The Board also encouraged the parties to use the Board's online filing system, ESTTA, for all future filings and as this case was instituted after November 1, 2007, the parties should use the appropriate form on ESTTA to file an

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[2] The standard protective order can be viewed using the following web address: http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm

extension or suspension requests or submit them via first class mail.

In turn, the parties advised the Board that they had been in direct communication with one another on one previous occasion and had engaged in discussions regarding the possibility of settlement. At that point, the parties further informed the Board that there are no related Board proceedings, federal district court actions, or third-party litigation concerning the pending trademark application or federal registrations that opposer pleaded ownership of in its notice of opposition.

Reviewing the pleadings, the Board observed that opposer has asserted likelihood of confusion under Section 2(d) and dilution under Section 43(c) as grounds for opposition. Applicant, as in her answer, continued to deny that opposer would be damaged by registration of her mark and offered arguments as to why confusion as to source and dilution were not likely to occur in this instance. In that regard, applicant referenced for example, purported "survey" evidence she had obtained, the differences between the respective goods and services, as well as the presence of a design element in her mark.

While not addressing the merits of the claims, the Board noted that for likelihood of confusion purposes, marks are to be viewed in their entireties and that the Board is

not bound by the trademark examining attorney's decision to approve a mark for publication in the Official Gazette. As a reminder, in testing for likelihood of confusion, the Board will consider those relevant factors, when of record, as set forth in cases such as *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973). Applicant was also asked by counsel for opposer to clarify the statement on pages 7-8 of her answer that a phrase in the involved mark was a "descriptive metaphor."

With respect to discovery, the parties did not stipulate that there was a likelihood of confusion under Section 2(d) nor dilution under Section 43(c). However, the Board advised both parties that if they do not settle and resort to either ACR or insist upon a full trial of the issues, that they make every effort to resolve all discovery issues in a considerate, reasonable and equitable way. The Board also reminded the parties of their corresponding duties to act in good faith to meet and confer on discovery issues and to supplement their respective discovery responses where appropriate.

The Board also cautioned the parties that pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP")§ 528.07(b)(2nd ed. rev. 2004), a party may not defend against a motion for summary judgment by asserting the existence of a material fact as to both an unpleaded

claim or defense. In order to do so, the party must move to amend its pleading or without objection from the other party, the Board in certain circumstances will deem the pleading amended. Given the nature of the pleadings, the Board recommended that the parties consider limiting discovery in a full trial to only those issues that are in dispute.

Towards the end of the conference, the Board briefly discussed using Accelerated Case Resolution ("ACR") as an alternative method to resolve this matter. The Board highlighted the benefits of ACR including the opportunity for the parties to obtain a final determination of this proceeding without the time and expense typically involved in a full trial. Should the parties agree to ACR, they should promptly file a communication with the Board indicating their intention, and the above-signed interlocutory attorney may then issue an order delineating the limits on any remaining discovery activities as well as the schedule for submitting their briefs.

In addition, the Board discussed using Alternate Dispute Resolution (ADR) as another means of settling the issues raised in this case. As explained to the parties, the techniques used in ADR may produce an earlier, mutually agreeable solution or at the very least, help to narrow the scope of discovery or the issues designated for trial. Like

ACR, ADR can potentially save time and money. Thus, the Board provided the names of organizations that can make alternate dispute services available to the parties and offered to provide additional information about those organizations upon request. If the parties decide to pursue ADR, the Board would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and with what result. Such a statement from the parties is not required, but would be helpful to the Board in processing the value of ADR in future Board proceedings.

As the parties indicated during the conference that they had previously communicated with one another, the Board advised the parties that when mutually agreed upon, service of papers by e-mail is also now permitted under Trademark Rule 2.119(b)(6). Consequently, the parties agreed to accept service of papers by e-mail and for the record, the parties confirmed their current e-mail addresses with each other as well as with the Board. Accordingly, service of any paper in this proceeding may be made on counsel for opposer at gary.pierson@huschblackwell.com, and on applicant at jforchrist@mchsi.com. However, with service by e-mail, the parties will not have the additional five (5) days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail.

Given their expressed desire to further discuss settlement, the parties agreed at the end of the conference to confer once again without the Board's intervention and to suspend proceedings for ***sixty*** (***60***) ***days*** while they consider resolving the matter in lieu of trial. Consistent therewith, the parties are advised that the Board will look favorably upon a motion to extend or suspend, filed for good cause, should the parties require additional time to discuss or negotiate settlement.

In view of the agreed upon suspension between the parties and in the interest of settlement, proceedings herein are suspended, subject to the right of either party to request resumption at any time per Trademark Rule 2.117(c). At this point, dates are hereby reset as follows:

Discovery Opens	**1/14/2009**
Initial Disclosures Due	**2/13/2009**
Expert Disclosures Due	**6/13/2009**
Discovery Closes	**7/13/2009**
Plaintiff's Pretrial Disclosures	**8/27/2009**
Plaintiff's 30-day Trial Period Ends	**10/11/2009**
Defendant's Pretrial Disclosures	**10/26/2009**
Defendant's 30-day Trial Period Ends	**12/10/2009**
Plaintiff's Rebuttal Disclosures	**12/25/2009**
Plaintiff's 15-day Rebuttal Period Ends	**1/24/2010**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. *See* 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.l29.

Finally, if during the suspension period, either of the parties or opposer’s attorneys should have a change of address, the Board should be so informed.