

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

MBA

Mailed: September 30, 2009

Opposition No. 91190654

OMS Investments, Inc.

v.

Hidden Creations

Michael B. Adlin, Interlocutory Attorney:

On September 30, 2009, at applicant's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (a)(2). Kathryn Bartow appeared on opposer's behalf and applicant's sole proprietor Gail Smith appeared pro se on applicant's behalf. Interlocutory Attorney Michael Adlin participated on the Board's behalf.

Applicant indicated that it would continue to represent itself in this proceeding. The Board advised applicant that it is generally recommended that parties retain experienced trademark practitioners to represent them in Board proceedings.¹ The Board also indicated that applicant would

¹ Information for parties representing themselves pro se is included at the end of this order.

be expected to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in 37 C.F.R. § 2.119.

The parties agreed to accept service of papers by e-mail. Specifically, the parties agreed that opposer shall be served via e-mail at kbartow@manatt.com and patrademarks@manatt.com and applicant shall be served via e-mail at gailhiddencreations@comcast.net and hiddencreations@comcast.net.

The parties indicated that although they have not yet discussed the substance issues in this proceeding, opposer made a settlement proposal in May 2009 which was and remains unacceptable to applicant. The Board strongly encouraged the parties to continue exploring settlement. The parties are not aware of any related proceedings, marks or third party disputes.

During the discussion of the pleadings in this case, opposer confirmed that its grounds for opposition are priority and likelihood of confusion and dilution only, and applicant confirmed that it denies all salient allegations in the notice of opposition. While applicant suggested at one point during the teleconference that priority may not be at issue in this proceeding, further discussion revealed that applicant continues to deny that opposer has priority,

at least at this time. Either party may seek leave to amend its pleading. Fed. R. Civ. P. 15; Trademark Rule 2.107.

Because the parties agreed that this case is limited only to the issues of priority and likelihood of confusion and dilution, the Board raised the possibility of utilizing its accelerated case resolution ("ACR") procedures, as well as the parties' option to stipulate to limits on discovery, abbreviated procedures for submission of evidence and other ways to expedite resolution of this case. See, Target Brands Inc. v. Hughes, 85 USPQ2d 1676 (TTAB 2007). The Board also discussed the possibility of the parties making greater reciprocal disclosures than required by Fed. R. Civ. P. 26(a)(1), in lieu of formal discovery. See, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 71 Fed. Reg. 2498 (January 17, 2006). The parties are encouraged to consider pursuing these possibilities, and to discuss these issues amongst themselves in the near future.

The Board explained the intent and operation of its standard protective order, made applicable herein by operation of Trademark Rule 2.116(g) and available here:

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

The parties are encouraged to acknowledge their obligations under the protective order in writing, and may utilize the following form:

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

The parties were reminded that although discovery is soon to open pursuant to the schedule set forth in the Board's order of July 30, 2009, neither discovery requests nor motions for summary judgment may be served until after initial disclosures are made. The deadline for initial disclosures is November 3, 2009. All other dates also remain as set in the Board's order of July 30, 2009.

Pro Se Information

Applicant is reminded that it will be expected to comply with all applicable rules and Board practices during the remainder of this case. 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. Applicant should note that Patent and Trademark Rule 10.14 permits any person or legal entity to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If applicant does not retain counsel, then it will have to familiarize itself with the rules governing this proceeding. 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 law libraries, and may be available at some public libraries. Finally, the Board's manual of procedure will be helpful.

On the World Wide Web, applicant may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

Applicant must pay particular attention to Trademark Rule 2.119. That rule requires a party filing any paper with the Board during the course of a proceeding to 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. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served; (2) the method of service (e.g., e-mail, first class mail); (3) the person being served and the address used to effect service; and (4) the date of service. Also, applicant 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 Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

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Files of TTAB proceedings can now be examined using TTABVue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

The first revision of the second edition (March 2004) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.
