

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

Mailed: March 8, 2011

Opposition No. 91198059

Skin Sense, Inc.

v.

Susan A. Surico

**M. Catherine Faint,  
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), a telephonic discovery conference with Board participation was held at 3:00 p.m. EST on Monday, March 07, 2011.<sup>1</sup> The conference was held among Howard A. Jacobson, Atty., as counsel and officer for opposer, Susan A. Surico, appearing pro se as applicant, and Board Interlocutory Attorney Catherine Faint.

Applicant had previously advised that the parties had not discussed settlement prior to the discovery conference, and that there are no related Board proceedings, federal district court actions, or third-party litigation concerning the parties' respective applications/registration.

The Board noted applicant is representing herself, and applicant may do so. However, it should also be noted that while Patent and Trademark Rule 10.14 permits any person to

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<sup>1</sup> A request for Board participation in the discovery conference was received on February 24, 2011.

represent herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure.

***Requirement for Service of Papers***

The service requirements are set forth in Trademark Rule 2.119. Trademark Rule 2.119 requires that every paper filed in the Patent and Trademark Office in a proceeding before the Board be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which either party may subsequently file in this proceeding, including the amended notice of opposition and applicant's amended answer, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by

its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer [or applicant] by forwarding said copy, via email to: [insert name and address].

The certificate of service must be signed and dated. See also TBMP § 113 (2d ed. rev. 2004).

***Email Service***

The parties stipulated to accept service of papers by email, and that opposer may be served at the following email address: [howard@skinsense.com](mailto:howard@skinsense.com), and that applicant may be served at the following email address: [susansurico@yahoo.com](mailto:susansurico@yahoo.com). The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional 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.<sup>2</sup>

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<sup>2</sup> Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with

***Discovery***

The Board directed the parties to the TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at

<http://www.uspto.gov/trademarks/process/appeal/usingtbmp.pdf>.

The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should be aware that amendments to the Trademark Rules were made in the last few years which are not reflected in the TBMP, so the parties should also look to the Trademark Rules for specific guidance. TBMP § 414 (2d ed. rev. 2004) provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

***Board's Standard Protective Order***

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion

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sufficient postage as first-class mail in an envelope addressed to:

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

The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

for Board approval. The Board noted that inasmuch as applicant is representing herself *pro se* in this case, she would be unable to view documents produced by opposer that have been designated "Highly Confidential - For Attorneys Eyes Only." The Board advised, however, that applicant could contest the appropriateness of the "Highly Confidential - For Attorneys Eyes Only" designation by seeking an *in camera* inspection by the Board of such documents designated "FOR ATTORNEYS EYES ONLY" by opposer.

***Initial Disclosures***

The Board also provided the parties instruction as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). Initial disclosures are the witnesses, documents and things having or containing relevant information. Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii):

- (i) the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;
- (ii) a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Furthermore, the Board noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). The

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The certificate of mailing must be signed and dated.

Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties.

***Review of the Pleadings***

Upon review of the pleadings, the Board noted that the notice of opposition has a claim based on Trademark Act Section 2(d) or likelihood of confusion. The ESTTA cover sheet also indicated claims based on Trademark Act Section 2(a), false suggestion of a connection, and deceptiveness.<sup>3</sup>

The Board noted the Section 2(a) claims should be withdrawn or repleaded. For a proper Section 2(a) false suggestion of a connection claim, an opposer must allege that its mark is famous, and allege facts from which it may be inferred that its registered mark points uniquely to opposer, as an entity. That is, that the registered mark is opposer's identity or "persona" -- and that purchasers would assume that goods bearing applicant's mark are connected with opposer. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Similarly, a claim of deceptiveness under Section 2(a) must be deceptiveness as to the nature or meaning of the mark in relation to the goods. See e.g., *In re Budge Manufacturing Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). The notice of opposition has no allegations as to how the use of the mark by defendant would be deceptive in relation to the goods, and there is nothing

that would allege plausibility or materiality of Section 2(a) false suggestion or deceptiveness claims.

As to the Section 2(d) claim, it appears that, should opposer introduce evidence of ownership and evidence that its registration is valid and subsisting, priority will not be an issue in this case (absent compulsory counterclaims to cancel the pleaded registration).<sup>4</sup> See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Applicant should be mindful when filing its amended answer<sup>5</sup> that an answer must comply with the requirements set forth in Fed. R. Civ. P. 8 (b). Fed. R. Civ. P. 8(b) provides, in part:

In responding to a pleading, a party must:

- (A) state in short and plain terms its defenses to each claim asserted against it; and
- (B) admit or deny the allegations asserted against it by an opposing party.

In accordance with Fed. R. Civ. P. 8(b) it is incumbent on applicant to answer the complaint by admitting or denying the allegations contained in each numbered paragraph, or to state that it is without sufficient information to admit or

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<sup>3</sup> Opposer should note that the Board will not award attorney fees or other expenses. See Trademark Rule 2.127(f).

<sup>4</sup> Opposer is directed to Trademark Rule 2.122(d)(1), as amended. The Rule now permits an opposer to introduce, at the appropriate times, a current printout of information from the electronic database records of the USPTO showing current status and title of any pleaded registration.

<sup>5</sup> Applicant's original answer did not include a certificate of service. Applicant must include a certificate of service with all future papers filed with the Board.

deny the allegations. For example of "Paragraph 1. Denied. Paragraph 2. Denied." Further, the Board stated in the teleconference, if applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it should so state and this will have the effect of a denial.

***Motion to Amend Pleadings***

Opposer moved to file an amended notice of opposition to cure any defects in its pleaded Section 2(a) claims. The motion was granted. Opposer will be allowed time to file its amended notice of opposition as set out below. Applicant will be given time to file an amended answer in response as noted below.

The parties are directed to review TBMP Section 414 (2d ed. rev. 2004) regarding the discoverability of various categories of information in Board proceedings.<sup>6</sup> Based on the pleadings, the Board identified that discovery topics should be focused on the likelihood of confusion factors, *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). Also, it is anticipated that discovery concerning priority, if any, will be limited.

The Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including

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<sup>6</sup> The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. Each party and/or its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. See TBMP § 408.01 (2d ed. rev. 2004).

agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests.

The parties declined to limit the scope of discovery at this time, although they may decide to limit discovery or pursue ACR after further discussions and amendment of the pleadings.

***Availability of ACR***

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("ACR") procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board's website.<sup>7</sup> Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. See Trademark Rule 2.120(a)(2). Possible use of the ACR procedure was further discussed in conjunction with amendment to the pleadings.

***Schedule***

Opposer is allowed until **THIRTY DAYS** from the date of the teleconference in which to file its amended notice of opposition in line with this order. Applicant is allowed until

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<sup>7</sup> Information about the Board's ACR procedure may be viewed at: <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>.

**THIRTY DAYS** from the date of service of the amended notice of opposition to file an amended answer or otherwise respond to the amended pleading.

Discovery and trial dates are reset as set out below.

Discovery Opens	5/17/2011
Initial Disclosures Due	6/16/2011
Expert Disclosures Due	10/14/2011
Discovery Closes	11/13/2011
Plaintiff's Pretrial Disclosures	12/28/2011
Plaintiff's 30-day Trial Period Ends	2/11/2012
Defendant's Pretrial Disclosures	2/26/2012
Defendant's 30-day Trial Period Ends	4/11/2012
Plaintiff's Rebuttal Disclosures	4/26/2012
Plaintiff's 15-day Rebuttal Period Ends	5/26/2012

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. 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.

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