

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

Mailed: April 22, 2011

Opposition No. 91199391

PSYBAR LLC

v.

DAVID MAHONY, PH.D, ABPP

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

On April 22, 2011, at 4:00 p.m. Eastern Time, the Board held a conference including John Jossart, representing opposer, and applicant David Mahony, representing himself.

***Topics discussed***

1. Standardized protective order

The Board's standard protective order, a copy of which may be found on the Board's home page, is in place in this case and governs the exchange of confidential and proprietary information and materials. The Board informed the parties that they may substitute a stipulated protective agreement (signed by both parties) but that the Board does not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order. The parties may also sign the stipulated protective order and enter it into the record. Parties do so in order to make it clear that they have a contract which survives the proceeding and which provides a remedy in

court for breach of contract, if any occurs, after the conclusion of the Board proceeding. However, the parties are not required to sign the standard protective order and it is in effect for purposes of this proceeding. Applicant is aware that, as an individual representing himself, he may not have access in the event a certain level of designation is made with respect to any of opposer's discovery responses.

2. Email service

The option for service by email, as allowed by Trademark Rule 2.116(b), was discussed.<sup>1</sup> The parties elected to retain traditional services methods but to provide courtesy email copies and/or email notifications that something has been served. The service requirements are otherwise discussed at Trademark Rule 2.119 and TBMP §113 (2d ed. rev. 2004).

3. The pleadings and the scope of discovery

Opposer clearly stated a claim of priority of use and likelihood of confusion under Trademark Act §2(d). Applicant denied the essential allegations of the complaint and asserted affirmative defenses.

Opposer checked the box in the ESTTA cover form identifying a claim of false suggestion of a connection under Trademark Act §2(a). However, opposer did not assert any allegations in support

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<sup>1</sup> The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First Class Mail) are not available for email service.

of such a claim. The Board allowed opposer time to replead and discussed aspects of a potential §2(a) claim. The schedule, as reset later in this order, reflects a present suspension except with respect to anticipated amended pleadings. If opposer elects not to amend its pleading, it should clearly inform applicant by the due date for the amended notice of opposition. In this latter case, the pleadings of record will remain operative.

**A. Priority**

Should opposer introduce evidence that it is the owner of the pleaded registration and such pleaded registration are valid and subsisting (*i.e.*, current status), priority will not be an issue in this case, absent a compulsory counterclaim.<sup>2</sup> See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer may use printouts from the USPTO databases (*i.e.*, TARR) to introduce the registrations at trial (or on a motion for summary judgment<sup>3</sup>).<sup>4</sup> See *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009).

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<sup>2</sup> Where, as here, a pleaded registration is more than five years old, the grounds for any compulsory counterclaim are limited. Trademark Act §14.

<sup>3</sup> Any evidence introduced on summary judgment is of record for purposes of the summary judgment motion only.

<sup>4</sup> The Board also addressed the practice allowed by Trademark Rule 2.122(d)(1) of submitting copies of the pleaded registrations with the complaint (notice of opposition). The easiest method is to use printouts from USPTO databases and attach such printouts to the complaint. TARR is a status database and, if it reflects the correct ownership, also serves as a title record. If there has been an assignment which is not reflected in the TARR record, and such assignment has been recorded with the Office, a printout from AOTW (Trademark Assignments on the Web) is also appropriate to establish title. When a plaintiff attaches the pleaded registrations to the complaint, the pleaded registrations are of record for all purposes during the proceeding and need not be introduced again at trial or on a summary judgment motion. Inputting the registration numbers into the ESTTA fields when filing the complaint,

**B. Likelihood of confusion**

As to the claim under Trademark Act §2(d), 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). See also TMEP §1207 (7th ed. rev. Oct. 2010). The parties should easily ascertain which *Dupont* factors are relevant and further concentrate discovery on those factors. See also *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (need only consider those factors which are relevant). Information about the various *Dupont* factors may also assist the parties in crafting a mutually agreeable settlement, or, at the very least, make trial more efficient.

Discovery concerning applicant's use, and the nature of such use, of his mark is appropriate.

**C. Affirmative defenses**

Applicant's affirmative defenses at paragraph Nos. 6-29 and 34 of his answer are directed to the DuPont likelihood of confusion factors. As such, they are considered only as amplifications of applicant's denials of the allegations of the complaint. At paragraph Nos. 30-32 of his answer, applicant affirmatively asserts estoppel and laches.<sup>5</sup> At paragraph Nos. 35-36, applicant affirmatively asserts acquiescence. Applicant asserts specific

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which retrieves some of the information for the ESTTA filing form, is insufficient. See *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537 (TTAB 2010).

<sup>5</sup> Estoppel here is read in connection with laches (i.e., estoppel by laches).

facts in connection with these affirmative defenses. However, the affirmative defenses of laches and acquiescence are not available in an opposition proceeding. See *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572. 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Bausch & Lomb, Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008); and *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007). Consequently, as asserted, these defenses also amplify applicant's denials in his answer. Collectively, all of applicant's affirmative defenses serve to apprise opposer with greater particularity of at least some of the positions which applicant may take in the defense of his right to registration. Consequently, they are not stricken.

**D. *Discovery on other matters***

The parties may serve discovery requests on other matters to ascertain whether there may be additional grounds for the opposition or grounds for a compulsory counterclaim. However, if initial responses do not indicate the existence of such grounds, there should be no further discovery (or only limited discovery for purposes relevant to the proceeding) sought on the matter.

**E. *The potential claim of false suggestion of connection***

To plead a claim under Trademark Act § 2(a) of false suggestion of a connection, an opposer must assert (and eventually prove) that the applicant's mark points "uniquely and unmistakably to the identity or persona of the 'person' or 'institution'

asserting the claim." See *Internet, Inc. v. Corporation for Nat'l Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996).

With respect to a §2(a) claim which may be asserted, discovery should focus on the factors set out in *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985): 1) whether applicant's mark is the same or a close approximation of opposer's previously used name or identity; 2) whether applicant's mark would be recognized as the same as, or a close approximation of, the name or identity previously used by opposer; 3) that opposer is not connected with the activities performed by applicant under the mark; and 4) whether opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods, a connection with opposer would be presumed. See also *Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1654); and *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1423-24 (TTAB 2008).

4. Initial disclosures

Initial disclosures (due on the reset schedule found later in this order) are: the identity of witnesses likely to have discoverable information and the description and location of documents and things having or containing relevant information.

More particularly, and as provided for by Fed. R. Civ. P.

26(a)(1)(A)(i) & (ii), those disclosures are:

(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.

The parties may serve initial disclosures before the due date. A party seeking discovery, or a party filing a motion for summary judgment, must serve initial disclosures before serving discovery or a summary judgment motion. The parties may mutually agree to waive initial disclosures.

#### 5. Settlement

The Board encourages settlement of its proceedings and, in fact, the majority of the Board's cases are settled by the parties to their mutual agreement. Although cases settle in many ways, typical settlements involved amendments to limit the identification of goods, including limitations on channels of trade or class of purchasers. The parties also usually stipulate to the disposition of the case (e.g., the opposition is dismissed without prejudice contingent upon entry of the amendment). The Board is generous in granting consented extensions of the schedule and periods of suspension to accommodate any settlement discussions in which the parties engage.

#### 6. Accelerated Case Resolution

The Board also offers an accelerated case resolution (ACR) procedure. Both parties must stipulate to an ACR proceeding. The

parties are referred to the TTAB homepage for more information. If the parties become interested in pursuing ACR at a later date, they are to contact the Board for further discussion and administration.<sup>6</sup>

**General information**

1. Nature of an opposition proceeding

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

The TTAB Decisions Summaries chart, found at the Board's home page is a good reference for examples of fully litigated

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<sup>6</sup> In general, the Board will work with the parties up to the opening of the first testimony to structure an ACR proceeding. The Board also hopes to have a selection of standard options available in the near future.

proceedings (that is, from the filing of the complaint to final decision).<sup>7</sup>

The parties are reminded that the Board is an administrative tribunal empowered to determine the right to register only. See TBMP §102.01 (2d ed. rev. 2004).

## 2. Representation

Applicant is permitted to represent himself. However, it should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, 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 may provide information as to procedure. Any person may call the Board at any time with questions concerning procedural matters or seeking general information about Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties.

## 3. On-line resources

The Board's home page (from [www.uspto.gov](http://www.uspto.gov)) has links to several useful resources. As noted earlier, information is

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<sup>7</sup> All Board proceedings are public in nature.

available about accelerated case resolution (ACR). There are links for frequently asked questions; to a chart summarizing the 2007 rules changes; to the 2007 Final Rules Changes published in the Federal Register; to the standardized protective order; and to the Board's manual of procedure ("TBMP").<sup>8</sup> Sections 100 and 400-800 of the TBMP may be of most interest. Section 400, which is the subject of many of the 2007 rules changes, describes discovery tools. Those are discovery depositions and written discovery (*i.e.*, interrogatory requests, document and production requests, and admissions requests). Section 414 is an extensive, but not exhaustive guideline of what is generally considered discoverable in Board proceedings. However, in light of the 2007 rules changes, §414(7) is no longer operative.

The Trademark Basics page (from [www.uspto.gov](http://www.uspto.gov)) has a link to the Trademark Manual of Examining Procedure ("TMEP"). As mentioned earlier, many of the likelihood of confusion factors discussed by the Court in *In re E.I. Dupont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) are found at TMEP §1207.

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<sup>8</sup> It is anticipated that a revised version (updated to November 2010) of the TBMP will be made available in the next month. The parties should check periodically for this invaluable resource.

Other useful databases include the ESTTA filing system<sup>9</sup> for Board filings and TTABVUE for status and prosecution history. As addressed earlier, all Board records are public and any person may view any proceeding using the search tools available at TTABVUE. If problems are encountered with the electronic databases, please phone 571-272-8500 and ask to be put through to a Board computer specialist. If available, provide the ESTTA tracking number.

**The schedule**

The Board allowed opposer time, on the schedule set below, to amend its notice of opposition to assert a claim under Trademark Act §2(a). Time is also set for applicant to file an answer to any amended notice of opposition. The Board, in its discussion of the potential §2(a) claim, provided resources for

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<sup>9</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 once the transaction is completed.

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 (go to next page)*

*I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:*

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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.

The certificate of mailing must be signed and dated.

opposer to review in ascertaining whether it will amend to assert such a claim. Except with respect to the potential amended pleadings, proceedings are suspended and dates are reset as follows:

Amended notice of opposition due <sup>10</sup>	5/23/2011
Answer to amended notice of opposition (if any) due	6/23/2011
Discovery Opens	6/23/2011
Initial Disclosures Due	7/23/2011
Expert Disclosures Due	11/20/2011
Discovery Closes	12/20/2011
Plaintiff's Pretrial Disclosures	2/3/2012
Plaintiff's 30-day Trial Period Ends	3/19/2012
Defendant's Pretrial Disclosures	4/3/2012
Defendant's 30-day Trial Period Ends	5/18/2012
Plaintiff's Rebuttal Disclosures	6/2/2012
Plaintiff's 15-day Rebuttal Period Ends	7/2/2012

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 Rule 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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<sup>10</sup> If opposer elects not to amend its notice of opposition, opposer is to so inform applicant by this date.