

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

Mailed: June 8, 2011
Opposition No. 91199186
Showtime Networks Inc.

v.

DMA International LLC

Jennifer Krisp, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a timely discovery and settlement conference on June 7, 2011. At applicant's request, a member of the Board participated in the conference. Participating were opposer's counsel Mallory Levitt, Amy Chen on behalf of applicant pro se,¹ and the assigned interlocutory attorney.

The Board apprised the parties of various procedural rules and guidelines that govern this proceeding, including the obligation to serve initial disclosures prior to serving written discovery requests [Trademark Rule 2.120(a)(3)], that initial disclosures are not to be filed with the Board [Trademark Rule 2.120(j)], the automatic applicability of the Board's Standard Protective Order [Trademark Rule 2.116(g)],

¹ Ms. Chen clarified that she is Owner and Member of applicant company.

and applicant's potential need to secure legal counsel in order to access any information or documents that are appropriately designated under said Protective Order as "trade secret" or "highly confidential." The Board advised the parties to review the Protective Order, and to file in this proceeding a signed copy of any procedural or substantive stipulations into which they enter and/or any modified protective order upon which they agree.

Turning to the pleadings, inasmuch as opposer, on the ESTTA-generated filing form, identified false suggestion of a connection under Trademark Act Section 2(a) as a ground for opposition, the Board noted that this ground is not sufficiently pleaded. In particular, Section 2(a) provides, in relevant part, that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (a) consists of or comprises ... matter which may ... falsely suggest a connection with persons living or dead." The elements of this claim that an opposer must plead (and later prove at trial) must include allegations that:

- 1) the mark sought to be registered is the same as, or a close approximation of, the name of or identity of a person or institution;
- 2) the mark would be recognized as such because it points uniquely and unmistakably to that person;
- 3) the person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and

4) the prior user's name or identity is of sufficient fame or reputation that a connection with such person or institution would be presumed when applicant's mark is used on its goods or services.

See, e.g., In re Peter S. Herrick P.A., 91 USPQ2d 1505, 1507 (TTAB 2009); *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *see also* TBMP § 503.03(c)(3) (3d ed. 2011), and cases cited therein.

The Board liberally grants leave to amend a defective pleading. *See* TBMP § 503.03 (3d ed. 2011). Accordingly, opposer is allowed until thirty (30) days from the date of today's conference in which to file an amended pleading, failing which the opposition will proceed on the Trademark Act Section 2(d) and Section 43(c) grounds only. In the event that opposer files an amended pleading, applicant is allowed until thirty (30) days from the date of service thereof in which to file its answer thereto.

Opposer's counsel indicated that it anticipates providing to applicant a forthcoming settlement proposal.

The Board briefly explained the availability of and features of the "accelerated case resolution" ("ACR") process, and referred the parties to the "ACR & ADR" link, and "Stakeholder Suggestions for ACR" link, both of which were recently posted on Board's web page, as well as *Federal Register*, Volume 72, for further information about, and recent cases that have been heard under the ACR process. The Board

directed the parties to file a motion, or to telephone the assigned interlocutory attorney, in the event that this proceeding does not settle and they stipulate to pursue resolution by ACR.

Schedule

The parties stipulated to a suspension period of thirty (30) days in order to pursue settlement. Said stipulation is hereby granted. Proceedings are suspended, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c). Proceedings shall resume, without further order of the Board, upon the following schedule:

Initial Disclosures Due	8/6/2011
Expert Disclosures Due	12/4/2011
Discovery Closes	1/3/2012
Plaintiff's Pretrial Disclosures due	2/17/2012
Plaintiff's 30-day Trial Period Ends	4/2/2012
Defendant's Pretrial Disclosures due	4/17/2012
Defendant's 30-day Trial Period Ends	6/1/2012
Plaintiff's Rebuttal Disclosures due	6/16/2012
Plaintiff's 15-day Rebuttal Period Ends	7/16/2012

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.

Information for pro se parties

While Patent and Trademark Rule 11.14 permits any person to represent itself, it is strongly 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 cannot aid in the selection of an attorney.

Trademark Rule 2.119(a) and (b) require that every motion, brief and paper filed in the Patent and Trademark Office in a proceeding before the Board must 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. The Certificate of Service, or statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service. The Board may decline to consider any filing that does not comply with this service requirement.

In general, strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil

Procedure, is required of all parties before the Board, whether or not they are represented by counsel

The Board referred the parties to the Trademark Rules of Procedure, and to the newly revised Board's Manual of Procedure (TBMP) (available at www.uspto.gov), with respect to the conduct of inter partes proceedings.