

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

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Mailed: June 28, 2011

Opposition No. **91199529**

Hunter Boot Limited

v.

Georgia Pellegrini Media  
Group, LLC

**Yong Oh (Richard) Kim, 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 1:00 p.m. EST, on June 27, 2011. Board participation was telephonically requested by applicant. Tali L. Alban, Esq. of Kilpatrick Townsend and Stockton LLC appeared as counsel for opposer and Georgia Pellegrini and Kristian Russell appeared on behalf of applicant. Interlocutory Attorney Richard Kim participated on behalf of the Board.

**Introductory Remarks**

The Board noted that the present conference was being conducted pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2). The Board informed the parties that a spirit of cooperation and good faith dealing were

expected from the parties during the duration of this proceeding and that any points of contention that may arise during the course of the proceeding should be handled through direct communication between the parties and in a spirit of good faith. The parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the issue.

The Board further informed the parties that telephone conferences with a Board attorney are available as necessary but that both parties would need to be on the call to discuss any substantive matter and that *ex parte* communications with the Board are generally inappropriate.

The parties were instructed to file appearances of counsel and change of correspondence forms as necessary.

**Prior Communications and Disputes**

The parties indicated that they have communicated with each other prior to the discovery conference to discuss settlement and that they are interested in further discussions to try to amicably resolve this matter. However, opposer was against any suspension of proceedings to accommodate settlement discussions at this time.

The Board inquired as to whether the parties were involved in any other dispute between the parties and whether applicant was involved in a dispute with any other

third-party concerning the mark involved in this matter. The parties responded in the negative.

**Pleadings**

The Board and the parties discussed each of the pleadings that were filed in this matter. Opposer confirmed that it was asserting claims of priority and likelihood of confusion in its notice of opposition based on three pleaded registrations, i.e., Registration Nos. 1550244, 2740877 and 3876340. **As to the '340 registration, opposer noted that it was only relying on its Class 25 goods in support of its priority and likelihood of confusion claims.** The Board also noted that the copies of opposer's pleaded registrations attached to the complaint were not in evidence as they failed to meet the requirements of Trademark Rule 2.122(d).

The Board then inquired as to the dilution claim. However, opposer was unaware that it had also pleaded a claim of dilution. After reviewing the complaint, the Board pointed out to counsel that opposer did indeed assert a claim of dilution but that such a claim was legally insufficient as opposer had failed to allege that its marks are famous and that they became famous prior to the constructive use date of the involved intent to use application, i.e., the filing date of the involved application. *See Trek Bicycle Corp. v. Style Trek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); and *Toro Co. v. ToroHead*

*Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001). In view thereof, **opposer is granted leave to amend its notice of opposition to either properly plead its claim of dilution or to strike the claim from the pleading, with dates to be reset at the conclusion of this order, including applicant's time to answer.**

As to applicant's pleading, the Board noted that the answer conformed to the pleading requirements of Rule 8 of the Federal Rules of Civil Procedure. The Board further pointed out that the first and third affirmative defenses were not true affirmative defenses but rather denials of opposer's claims that served to put opposer on notice of applicant's position. The Board, therefore, declined to strike them from the pleading.

**Discovery, Disclosures and Stipulations**

The parties were advised that the Board's standard protective order is operative in this proceeding, made applicable by operation of Trademark Rule 2.116(g) and available here:

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

If one or both of the parties wish to modify the Board's standard protective order, they could do so by filing a motion for Board approval along with a copy of the proposed protective order.

The Board then inquired as to whether the parties have considered service by email. The parties had not considered this method of service but **agreed that service under Trademark Rule 2.119 would be made by email and agreed to waive the five-day grace period for response provided under Trademark Rule 2.119(c). Service by email is to be made at [tlalban@kilpatricktownsend.com](mailto:tlalban@kilpatricktownsend.com) and [aschlette@kilpatricktownsend.com](mailto:aschlette@kilpatricktownsend.com) for opposer and [georgia@georgiapellegrini.com](mailto:georgia@georgiapellegrini.com) for applicant.**

As to any reciprocal disclosures, stipulations of fact, and agreements to potentially limit and simplify discovery and testimony, the parties indicated that they were not interested in additional disclosures, limitations to discovery and simplification of testimony at this stage of the proceeding.

**Alternative Dispute Resolution and Accelerated Case Resolution**

Mediation and arbitration were discussed but neither party showed interest in turning to these alternatives for their settlement discussions. The parties were informed, however, that the Board would be amenable to suspend the current proceeding should they choose these alternatives to aid in settlement.

Accelerated Case Resolution (ACR) was also discussed. Should the parties be interested in ACR at a future time and

seek additional information, the parties are referred to the following links:

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

[http://www.uspto.gov/trademarks/process/appeal/accelerated\\_case\\_resolution\\_acr\\_faq.doc](http://www.uspto.gov/trademarks/process/appeal/accelerated_case_resolution_acr_faq.doc)

### **Initial Disclosures**

The parties were reminded that pursuant to the Board's recent rule amendments, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

### **Conclusion**

Shortly after the conclusion of the discovery conference, opposer informed the Board that its amended notice of opposition was ready to be filed. In view thereof, **opposer's amended notice of opposition is due by July 5, 2011, and applicant's answer to the amended notice of opposition is due by August 4, 2011.** The schedule is reset as follows::

Amended Notice of Opposition Due	7/5/2011
Applicant's Answer Due	8/4/2011
Discovery Opens	8/4/2011
Initial Disclosures Due	9/3/2011
Expert Disclosures Due	1/1/2012
Discovery Closes	1/31/2012
Plaintiff's Pretrial Disclosures Due	3/16/2012
Plaintiff's 30-day Trial Period Ends	4/30/2012
Defendant's Pretrial Disclosures Due	5/15/2012
Defendant's 30-day Trial Period Ends	6/29/2012

Plaintiff's Rebuttal Disclosures Due  
Plaintiff's 15-day Rebuttal Period Ends

7/14/2012  
8/13/2012

**Pro Se Information**

Applicant has indicated that it is not represented by legal counsel in this proceeding. The following information is routinely offered for the benefit of parties who are proceeding without the assistance of counsel.

While Patent and Trademark Rule 11.14(e) 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.

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 proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). There are other rules in part one of Title 37, relevant to filing of papers, meeting due dates, etc., that are also applicable to this case. 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.

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If opposer or applicant wishes to obtain a copy of Title 37 of the CFR, it may be ordered for a fee from the Government Printing Office, Washington, D.C. 20401, or from the U.S. Government Bookstore, using the following web address:

<http://bookstore.gpo.gov/index.jsp>. The parties may also refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website <http://www.uspto.gov/index.jsp>. The third edition (May 2011) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at

[http://www.uspto.gov/trademarks/process/appeal/Preface\\_TBMP.jsp](http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp). The Board's main webpage at <http://www.uspto.gov/trademarks/process/appeal/index.jsp> includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), and Frequently Asked Questions about Board proceedings.

Applicant is reminded that Trademark Rules 2.119(a) and (b) require that every 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 adversary), or on the party (or adversary) 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

that the parties may subsequently file in this proceeding must be accompanied by "proof of service" of a copy on the other party or the other party's counsel.

"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., by first class mail or by email), (3) the person being served and the address used to effect service, and (4) the date of service.

Applicant should further note that any paper it is required to file with the Board should not take the form of a letter; proper format should be utilized. The form of submissions is governed by Trademark Rule 2.126. See also TBMP § 106.03 (2d ed. rev. 2004). In particular, "a paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet" and text "in an electronic submission must be in at least 11-point type and double-spaced." Trademark Rule 2.126(a)(1) and 2.126(b).

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be

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received by the Board by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 and 2.198 is utilized.

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

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