

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

Mailed: January 13, 2012

Opposition No. 91201218

Redbox Automated Retail, LLC

v.

Stanley Lee Barnes dba Red Box
Tickets USA, LLC

Cheryl S. Goodman, 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 reconvened discovery conference at 11:00 am (EST)/10:00 am (CST) on Wednesday, January 11, 2012 with Board participation.¹

Participating in the conference were James Muraff and Kathleen Blouin, counsel for opposer, and Stanley Lee Barnes, applicant. Present for the Board was the above-identified interlocutory attorney. This order memorializes generally what transpired at the conference.

The Board first considered pending contested motions.

Motion to Dismiss

Applicant sought to dismiss the opposition because

¹ Board participation was requested via telephone by opposer on January 3, 2012.

opposer attempted "to cause default and set aside and delay application" [sic] in bad faith due to opposer's counsel's failure to confirm the deadline for discovery conference when applicant called opposer's counsel on December 20, 2011. Opposer opposed the motion, pointing out that opposer did contact applicant and that the parties conducted a discovery conference on December 29, 2011, although the conference was not completed.

At the teleconference, the Board deemed the motion to dismiss moot, in view of the parties' holding of the discovery conference (although not completed) on December 29, 2011.

Motion to Extend

Opposer sought to extend the discovery conference deadline and all other dates because opposer failed to hold the discovery conference by the scheduled December 21, 2011 date due to the parties' attempt to settle the matter, due to the "holiday season", and due to the fact that counsel was on vacation between December 19, 2011 through December 23, 2011.

Applicant orally responded to the motion at the teleconference, indicating his objection to an extension.

The Board found the motion to extend lacked good cause, and denied the motion inasmuch as settlement is one purpose of the discovery conference and counsel had ample time

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between November 21, 2011 through December 21, 2011 to schedule the conference. Moreover, the fact that the parties held the conference out of time is not a basis for extending the dates.

Motion to Amend Protective Order

Opposer orally requested amendment to the standard protective order to allow access by opposer's in-house counsel to applicant's trade secret and commercially sensitive information. The Board declined to rule on the oral motion, advising opposer to file a motion, specifically addressing the issue of in-house counsel's role in competitive decision-making. See TBMP Section 412.02(b) (3d ed. 2011).

Suspension

The parties agreed to a thirty day suspension of these proceedings in a further attempt to settle the matter.

General Information

Service of Papers

Trademark Rule 2.119 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. "Proof of such service must be made before the paper will be considered by the Office."

Trademark Rule 2.119(a). Service is the responsibility of

the party filing the paper, and any paper filed should include "proof of service" with its filing. "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., first class mail); (3) the person being served and the address used to effect service; and (4) the date of service.²

Applicant has not served many of its filings in this case on opposer's counsel as required by Trademark Rule 2.119 (see e.g., "answer" filed November 23, 2011 and "motion to dismiss" filed December 21, 2011). Applicant is directed to comply with Trademark Rule 2.119 in all future filings with the Board.

Electronic filing recommended

It is recommended that the Board's electronic filing system ESTTA be used for all papers filed with the Board. The parties should note that the consent motions to extend and suspend form in ESTTA should not be used until after the initial disclosure deadline has passed as the forms will not calculate the discovery, disclosure and trial schedule

² Suggested format for certificate of service:
I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).

Signature

properly. The parties should use the general form motion option, and file a disclosure, discovery and trial schedule generated by the parties.³

E-mail service, stipulation

The parties did stipulate to e-mail service in the discovery conference. It was noted that no additional response time is provided for papers served electronically. The parties are directed to adjust their spam filters to accept e-mail from their adversary and the Board and to inform the Board and the adverse party of any changes in e-mail or correspondence (mailing) addresses.

Standard protective order

The Board advised the parties of the imposition of the Board's standard protective order at the commencement of these proceedings and that pro se parties are limited in their access to information designated as trade secret and commercially sensitive under the Board's standard protective order. See TBMP Section 412 (3d ed. 2011) for more information regarding the Board's protective order.⁴ Should the parties desire to modify the protective order, they should file such modified protective order (signed)

³ Please read the alerts on ESTTA for further information. If the automated motion does not provide the parties with the desired dates, a general motion option should be used with the desired trial schedule set forth in an attachment.

⁴ The standard protective order is viewable at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

with the Board. Should applicant desire access to information designated by opposer as trade secret and commercially sensitive with respect to opposer's discovery responses, he may hire outside counsel for this limited purpose. TBMP Section 412.

Notice of Opposition

The Board found opposer's dilution claim insufficient as opposer failed to allege fame of its mark prior to applicant's use of the mark. The claim is stricken; however opposer is granted leave to amend the pleading to replead this claim.

Answer

Applicant's answer is insufficient under Fed. R. Civ. P. 8(b).

To comply with Fed. R. Civ. P. 8(b), applicant should not argue the merits of the allegations in the complaint (notice of opposition) but rather should state, as to each of the allegations contained in the complaint in the numbered paragraphs, that the allegation is either admitted or denied. If applicant lacks knowledge or information sufficient to form a belief about the truth of an allegation, he may so state, and this statement will have the effect of a denial as to that allegation. The notice of opposition consists of 6 numbered paragraphs setting forth the basis of opposer's claim of damage, and the defendant's

admissions or denials should be made in numbered paragraphs corresponding to the 6 numbered paragraphs in the complaint. A complaint should also be signed, and can be signed electronically. See TBMP Section 311.01(b) and 311.02(a).

The time for filing an amended notice of opposition and answer thereto will be set forth below.

Disclosures

The Board reviewed the required disclosures in this case i.e., initial, expert and pretrial disclosures and advised the parties that formal discovery (e.g., depositions, request for production, requests for interrogatories, and requests for admissions) cannot occur until after service of initial disclosures.⁵ Additionally, a motion for summary judgment cannot be filed prior to service of initial disclosures unless it is based on preclusion or lack of jurisdiction of the Board. Initial disclosures need not be filed with the Board unless they are filed in connection with a discovery motion, motion for summary judgment or notice of reliance (if documents are provided as initial disclosures).⁶

⁵ Information regarding disclosures can be located in the Board Manual of Procedure (TBMP) at Chapters 401.02, 401.03 and Chapter 702. If the parties are interested in making more extensive disclosures, the parties are referred to the Miscellaneous Changes to TTAB Rules, January 17, 2006, located at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

⁶ Similarly expert disclosures and pretrial disclosures need not be filed with the Board unless the subject of a motion. The Board, however, should be notified if a party has made an expert

Other Options for Settlement/ACR

The Board advised the parties of other options available to settle this dispute including mediation and arbitration, discussing, in particular, the availability of Accelerated Case Resolution. Accelerated Case resolution materials and suggested "tracks" are available at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The parties are also referred to the TBMP Sections 528 and 702.04 regarding Accelerated Case Resolution.

Telephone Conferences with the Board

The Board advised the parties of the availability of conducting telephone conferences (with the interlocutory attorney) to expedite the resolution of disputes in the case.

Pro Se Information

Applicant is reminded that he 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 and Federal Rules of Evidence govern the conduct of this opposition proceeding.

disclosure so that the Board can consider whether suspension is necessary for expert discovery. TBMP Section 401.03.

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Applicant should note that Patent and Trademark Rule 11.14 permits any person or legal entity to represent him/herself 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 applicant will have to familiarize himself with the rules governing this proceeding. 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.

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 or online. The Trademark Rules are also located at <http://www.uspto.gov/trademarks/process/index.jsp>. Finally, the Board's manual of procedure (TBMP) will be helpful. The third edition (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.

Files of TTAB proceedings can now 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.

Proceedings herein are suspended for THIRTY DAYS from the January 11, 2012 discovery conference date for settlement. Opposer's amended notice of opposition will be due (filed and served) twenty days from resumption. Applicant's answer thereto will be due twenty days from the date of service by opposer of the amended notice of opposition.

Proceedings will automatically resume, without further notice from the Board on February 11, 2012 the schedule set forth below:

Initial Disclosures Due	3/12/12
Expert Disclosures Due	7/10/12
Discovery Closes	8/9/12
Plaintiff's Pretrial Disclosures	9/23/12
Plaintiff's 30-day Trial Period Ends	11/7/12
Defendant's Pretrial Disclosures	11/22/12
Defendant's 30-day Trial Period Ends	1/6/13
Plaintiff's Rebuttal Disclosures	1/21/13
Plaintiff's 15-day Rebuttal Period Ends	2/20/13

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.

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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.