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

MBA

Mailed: December 9, 2011

Opposition No. 91201905

Robert Dabrowski d/b/a Candia Vinyards

v.

The Wine Group LLC

Michael B. Adlin, Interlocutory Attorney:

On December 7, 2011, at opposer's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (a)(2). Scott A. Daniels appeared on opposer's behalf, Paul W. Reidl appeared on applicant's behalf and the interlocutory attorney responsible for this proceeding participated on the Board's behalf.

During the conference, the parties indicated that they are unaware of any related proceedings, marks or third party disputes. The parties have not initiated detailed settlement discussions, but both expressed a willingness and intention to at least discuss settlement. The parties agreed to accept service of papers by e-mail under Trademark Rule 2.119(b)(6), but absent a subsequent agreement to the contrary, agreed that papers must also be served by first-class mail.

The parties discussed the pleadings in this case. Opposer confirmed that its only pleaded ground for opposition is priority and likelihood of confusion. That is, the references to Section 43(a) in the body of opposer's pleading and the ESTTA coversheet therefor are not intended to state a claim beyond priority and likelihood of confusion. For its part, applicant was unaware of any authority supporting its pleading of "fraud" as an "affirmative defense."[1] Applicant was unwilling during the teleconference to discuss the specific facts supporting its defense of "analogous use priority over Opposer," but indicated that those facts include "contacting distributors" and are "typical" of those which have been found to support a claim of use analogous to trademark use.

The Board pointed out that because opposer relies on a single mark, which the parties agree is identical to applicant's involved mark, there is no dispute that the goods identified in the parties' applications are similar or identical, opposer has only one claim, and the relevant facts appear to be quite limited, this is an extraordinarily uncomplicated, run-of-the-mill case. In fact, it appears,

[1] Applicant may wish to review In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Even if fraud was properly pleaded affirmative defense, and proved, it is unclear how it would make a difference, as opposer's priority claim is based solely on use, not its pending, pleaded application.

and the parties do not dispute, that this case will turn primarily or entirely on the issue of priority.[2]

Accordingly, the Board strongly suggested that this case appears particularly well-suited for accelerated case resolution ("ACR") or other methods to increase the efficiency of this proceeding. The parties were encouraged to consider this possibility throughout the case, and both agreed to do so, with opposer expressing particular interest. The Board's ACR procedures, which are extremely flexible, are addressed here:

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/ACR_Case_List_01_9_11).doc

The Board also discussed the parties' option to stipulate to limits on discovery, abbreviated procedures for submission of evidence and other ways to expedite resolution of this case. See, Target Brands Inc. v. Hughes, 85 USPQ2d 1676 (TTAB 2007). While opposer expressed great interest in limiting discovery in time and/or scope, applicant was unwilling to commit to limitations during the conference.

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[2] It appears that applicant may attempt to rely on use analogous to trademark use for priority purposes, i.e. that it may attempt to prove a priority date earlier than the filing date of its involved application. It also appears that opposer may attempt to prove a priority date earlier than the date of first use in commerce set forth in its pleaded application. Opposer may wish to review Hydro-Dynamics Inc. v. George Putnam & Co. Inc. 811 F.2d 1470, 1473, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

Applicant is reminded that it may very well obtain the same information, or even more information, from informal information sharing rather than formal discovery. Similarly, the Board discussed the possibility of the parties making greater reciprocal disclosures than required by Fed. R. Civ. P. 26(a)(1), in lieu of formal discovery, especially given applicant's desire to probe whether opposer has made bona fide, token or any other use of its pleaded mark. See, "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 71 Fed. Reg. 2498 (January 17, 2006). The parties also indicated a willingness to consider this option. The parties should seriously consider the cost and time savings these options would yield, without impacting either party's rights.

The Board's standard protective order, made applicable herein by operation of Trademark Rule 2.116(g), is available here:

http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp

The parties and their counsel are encouraged to acknowledge their obligations under the protective order in writing, and may utilize the following form:

http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp

The parties were reminded that neither discovery requests nor motions for summary judgment may be served until after initial disclosures are made. For the time being, disclosure, discovery, trial and other dates remain as set in the Board's order of October 4, 2011.

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.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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