

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

MBA

Mailed: March 22, 2012

Opposition No. 91201995

Mendias & Milton, LLC

v.

Fitfast, LLC

Michael B. Adlin, Interlocutory Attorney:

On March 20, 2012, at opposer's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2). Deborah L. Lively appeared on opposer's behalf, applicant appeared pro se through its "founder," Duke Richman, who asserted that he is authorized to act on applicant's behalf, and the interlocutory attorney assigned to this proceeding participated on the Board's behalf.

Applicant indicated that it does not currently have concrete plans to hire an attorney to represent it. The Board advised applicant that it is generally recommended that parties retain experienced trademark practitioners to represent them in Board proceedings.¹ The Board also

¹ Information for parties representing themselves pro se is provided at the end of this order.

indicated that applicant will be expected and required to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in 37 C.F.R. § 2.119, regardless of whether or when applicant retains counsel. During the teleconference, the parties agreed to accept service of papers by e-mail, pursuant to Trademark Rule 2.119(b)(6). The parties are not aware of any related proceedings, marks or third party disputes.

The parties have not had substantive discussions thus far, and have not discussed settlement. The parties are strongly encouraged to work together to resolve this proceeding, including by exchanging information and/or documents informally, so as to better evaluate their respective claims and defenses prior to the case advancing to discovery or trial. At the end of the teleconference, the parties agreed to suspend this proceeding for 30 days for the purpose of exploring settlement.

The parties discussed the pleadings, including opposer's claims of priority and likelihood of confusion and dilution. The Board noted that opposer has pleaded ownership of a registration, and assuming that opposer properly introduces the registration into evidence, because applicant has not counterclaimed to cancel opposer's pleaded registration, it appears that priority may not be at issue at trial. Trademark Rule 2.122(d)(1); Penguin Books Ltd. v.

Eberhard, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). While applicant claims in its answer that confusion is unlikely because the parties operate in distinct geographic territories, the Board pointed out that this is not a concurrent use proceeding, and that opposer owns an unrestricted registration, just as applicant seeks an unrestricted registration. The Board also informed the parties that opposer's dilution claim is inadequate because opposer has not alleged that its mark became famous prior to applicant's priority date. See, Toro Co. v. ToroHead Inc., 61 USPQ2d 1164, 1174 and n. 9 (TTAB 2001).

In any event, whether or not opposer perfects its dilution claim and whether or not priority is ultimately at issue, it is clear that this case is quite straightforward, and the relevant facts appear quite limited. Therefore, the Board reminded the parties of their 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). The Board also 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. See, Miscellaneous Changes to Trademark Trial

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and Appeal Board Rules, 71 Fed. Reg. 2498 (January 17, 2006). The parties agreed to consider these possibilities.

On a related note, the Board indicated that this case appears particularly appropriate for Accelerated Case Resolution ("ACR"). While the parties were not willing to agree to ACR during the teleconference, they agreed to also consider resolving this case by ACR, and are directed to:

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf)

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_(ACR)_FAQ_updates_12_22_11.doc)

[http://www.uspto.gov/trademarks/process/appeal/ACR Case List 01 9 11\).do
c](http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_01_9_11).doc)

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

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

The parties 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>

Finally, the parties were reminded that although discovery is open pursuant to the schedule set forth in the Board's order of February 3, 2012, neither discovery

requests nor motions for summary judgment may be served until after initial disclosures are made. In any event, proceedings herein are suspended for 30 days for the purpose of settlement negotiations, and disclosure, conferencing, discovery, trial and other dates are reset as follows:

Proceedings Resume	April 23, 2012
Initial Disclosures Due	April 23, 2012
Expert Disclosures Due	August 21, 2012
Discovery Closes	September 20, 2012
Plaintiff's Pretrial Disclosures	November 4, 2012
Plaintiff's 30-day Trial Period Ends	December 19, 2012
Defendant's Pretrial Disclosures	January 3, 2013
Defendant's 30-day Trial Period Ends	February 17, 2013
Plaintiff's Rebuttal Disclosures	March 4, 2013
Plaintiff's 15-day Rebuttal Period Ends	April 3, 2013

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.

Pro Se Information

Applicant is reminded that it 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 govern the conduct of this opposition proceeding. The parties should note that Patent and Trademark Rule 10.14 permits any person or legal entity to represent itself 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 it will have to familiarize itself with the rules governing 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). 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. Finally, the Board's manual of procedure will be helpful.

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 parties must pay particular attention to Trademark Rule 2.119. That rule 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. The party filing the paper must include "proof of service" of the copy. "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., e-mail, first class mail); (3) the person being served and the address used to effect service; and (4) the date of service. Also, the parties should note that any paper they are required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

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

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
