

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

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Mailed: April 26, 2012

Opposition No. 91203884

Ennis, Inc.

v.

Joel L. Beling

**Elizabeth A. Dunn, Attorney (571-272-4267):**

On April 24, 2012, at the request of applicant, an Australian citizen acting pro se, the Board participated in the parties' discovery conference. The participants were Tom Jacks, attorney for opposer, Joel Beling, applicant, and Elizabeth Dunn, attorney for the Board.

Phone conferences may not be recorded. This order is not comprehensive but summarizes the main topics discussed.

PLEADINGS

Based on his Australian registration, Mr. Beling applied under Trademark Act Sec. 44(e) to register the mark shown below for a wide range of goods in International Class 16 and 28, and International Class 41 services.

Beling's App. Serial No. 85324443 filed May 18, 2011	Ennis, Inc.'s Reg. No. 3372884 issued January 22, 2008
COLOR WARS	

Opposer Ennis Inc. claims priority of use and likelihood of confusion between applicant's mark as used with the listed Int. Cl. 16 and 41 goods and services, and opposer's registered mark, shown above, for "printing services." Applicant's answer denies the salient allegations of the notice of opposition. If opposer proves ownership of a valid and subsisting registration for its pleaded mark, there is no issue with respect to opposer's priority. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

The predecessor to the Board's primary reviewing court established a list of factors to be considered when testing for likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). As discussed, if the parties lack access to a law library or legal research service, the USPTO website offers research options in the form of a searchable database of Board final decisions. On the Board's webpage, clicking "TTAB Final Decisions" brings the user to a search page where date parameters and a key word (such as confusion) may be entered.

The search will produce a listing of the Board final decisions which use that term within the specified period. By clicking on the proceeding number in the list, the user may read the full decision.

In addition, the Board's webpage offers the Trademark Rules of Practice, and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (3rd ed. 2011), which has detailed information regarding Board proceedings and how the Trademark Rules are applied.

#### RELATED PROCEEDINGS

During the conference the Board learned that Mr. Beling seeks cancellation of Ennis Inc.'s pleaded Registration No. 3372884 on the ground that it is merely descriptive, generic, or incapable of functioning as a trademark as used in connection with opposer's services (Cancellation No. 92055374). Opposer is ordered to notify the Board in writing when its answer has been filed in the cancellation, at which time the Board will consolidate proceedings.

As set forth in the institution order, the parties must notify the Board promptly if they become parties to another Board proceeding or civil action which involves related

marks which overlap with this case, and this obligation continues for the duration of this proceeding.<sup>1</sup>

#### SETTLEMENT

While the Board may facilitate settlement by suspending the trial schedule, the Board does not actively promote settlement, which remains wholly the choice of the parties. If interest in settlement occurs at a later point in this proceeding, and the parties wish to avoid the expense of trial preparation unless it is necessary, the parties should stipulate in writing to suspension of this proceeding. Absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations did not justify party's inaction or delay).

#### LEGAL REPRESENTATION STRONGLY ENCOURAGED

While U.S. Patent and Trademark Office Rule 11.14 permits any person to represent himself, it is generally 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

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<sup>1</sup> As explained during the conference, proceedings in which opposer pleads the same registration pleaded here are not related to this opposition for the purposes of consolidation.

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. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

#### ACR

The parties are not interested in adopting ACR (accelerated case resolution) procedures at this time. Different ACR options are explained on the TTAB page at the USPTO website. As discussed, in addition to approving adoption of ACR (accelerated case resolution) procedures, the Board will entertain any stipulations designed to save the parties time and money, such as stipulating to facts, agreeing to a shortened schedule of disclosure, discovery, and trial, and/or stipulating as to the admissibility of evidence. However, in the absence of written agreements filed with the Board, disclosures, discovery and the submission of trial evidence must comport with the relevant Trademark Rules as well as the relevant rules of civil procedure.

#### STIPULATION

The parties stipulated that email service would be accepted.

The parties stipulated that, to the extent possible, responsive documents would be forwarded to the other side (in lieu of being made available for inspection at the possessing party's place of business) in electronic form, and where such electronic production was not possible, the parties would confer on how the time and expense of alternate production could be minimized.

#### DISCLOSURES, DISCOVERY, TRIAL EVIDENCE

An opposition before the Board is similar to a civil action in a federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accord with the applicable rules.

During the conference the Board denied applicant's request to restrict the scope of discovery to applicant's activities in the United States. Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to a party's bona fide intent to use the mark. TBMP §414<sup>^</sup> (3<sup>rd</sup> ed. 2011).

The Board also denied applicant's request for a modification of the Board's standard protective order governing access to confidential information, which automatically is in effect for all Board proceedings. Applicant sought to make all information related to the Australian company through which he does business a trade secret so that it would be disclosed only to opposer's attorney, and the Board. As discussed, how and under what conditions applicant uses its mark is information central to the pleaded issues of this case, and the public has an interest in access to the Board's proceeding files, including, to the widest extent possible, the information upon which the Board relies in making its ultimate determination of registrability. See *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633 (TTAB 2011) ("the Board advised respondent to be circumspect and to limit the 'confidential' designation only

to information that is truly confidential or commercially sensitive.").

The parties also were advised that the submission of documents designated confidential pursuant to the protective order and barred from public view must be accompanied by the separate filing of a redacted version of the same document which remains available to the public. TBMP §412 (3<sup>rd</sup> ed. 2011).

The Board advised the parties that oral deposition of witnesses, including experts, is not possible for witnesses located outside the United States, and that the Board's rules require deposition by written questions. Both depositions by written questions and the disclosure of an expert have special procedures to be followed. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §401.03 and 404 (3<sup>rd</sup> ed. 2011).

DATES REMAIN THE SAME

The schedule set forth the Board's February 16, 2012 institution and trial order remains in effect.

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