

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

Mailed: March 13, 2013

Opposition No. 91204473

Pickin' Cotton
Communications, LLC

v.

Edmund Frette S.A.R.L.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On March 13, 2013, opposer, Pickin' Cotton Communications, LLC, *pro se* (represented by Matt Fogarty, M.D., CFO), applicant, Edmund Frette S.A.R.L. (represented by Jeffrey Kaufman and Beth Chapman of Oblon Spivak McClelland Maier & Neustadt LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a). This order summarizes the significant points addressed during the conference, *clarifies* and sets forth the Board's orders issued during the conference (see pp. 2, 3 and 5-6, *infra*), and resets the trial schedule in this proceeding.

Conference Summary

At the outset, the Board discussed the purpose of the discovery conference under Fed. R. Civ. P. 26(f). The parties then informed the Board that they had not yet

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engaged in any settlement discussions and that there is one related proceeding, Cancellation No. 92055507.¹ The parties are **ORDERED** to promptly advise the Board should a civil action between the parties be instituted so that the Board can determine whether suspension is appropriate.

- *Opposer's Notice of Opposition*

The Board discussed the following topics with respect to the notice of opposition:

(1) The Board noted that the notice of opposition fails to set forth any allegations in support of a claim of deceptiveness under Section 2(a) of the Trademark Act. It is also noted that, in its order dated January 30, 2013, the Board ordered stricken opposer's claim under Section 2(a) (deceptiveness) because no elements of the claim are set forth in the notice of opposition. Said order stands, however, *if* under the following principles opposer believes it has a plausible claim under Section 2(a), opposer is allowed until **TWENTY DAYS** from the mailing date of this order to submit an amended pleading setting forth a sufficient claim of deceptiveness.²

For information purposes only, the Board's primary

¹ Opposition No. 91202323, *Edmund Frette S.A.R.L. v. Pickin' Cotton Communications, LLC*, was dismissed with prejudice on March 29, 2012.

² This is an addition to the Board's order issued during the subject conference.

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reviewing court, the Court of Appeals for the Federal Circuit, has articulated the following test for whether a mark consists of or comprises deceptive matter under Section 2(a), namely, (i) is the term misdescriptive of the character, quality, function, composition or use of the recited goods or services; (ii) if so, are prospective purchasers likely to believe that the description actually describes the goods or services; and (iii) if so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase. *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987) (refusing registration of LOVEE LAMB for "automatic seat covers" for goods made only of synthetic fibers).

(2) Opposer's dilution claim is also insufficient insofar as opposer has failed to allege that *its mark became famous prior to the filing date of applicant's application (request for extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a))*.³ *Cf. NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ 1718 (TTAB 1998) (extending dilution statute to Section 44 application wherein applicant must state that it has a bona fide intention to use the mark). Accordingly, opposer's dilution

³ This identification of the missing element in opposer's claim is a correction to the Board's discussion during the subject conference.

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claim is also stricken for failure to state a claim for relief may be granted. See Fed. R. Civ. P. 12(f). Opposer is allowed **TWENTY DAYS** to amend its pleading to include a sufficient claim of dilution.

However, opposer is reminded that a plaintiff alleging dilution must meet a more stringent test for fame than that applied in the traditional analysis of fame under Section 2(d). See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001) ("A mark may have acquired sufficient public recognition and renown to demonstrate that it is a strong mark for likelihood of confusion purposes without meeting the stringent requirements to establish that it is a famous mark for dilution purposes [citation omitted] ... Therefore, we will refer to "public recognition and renown" when we are discussing fame in the context of likelihood of confusion.").

With respect to the foregoing orders, opposer is reminded that under Rule 11 of the Federal Rules of Civil Procedure, opposer will be certifying in any amended pleading that all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law.

See Fed. R. Civ. P. 11; Trademark Rule 2.116(a).

(3) Although the ESTTA cover sheet indicates that Dr. Fogarty is the "CFO" of opposer, opposer executed the notice

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of opposition as "representative." As discussed, in any future filing with the Board, opposer is directed to indicate the title of the individual executing the submission on behalf of opposer. See 37 C.F.R. § 11.14 (e) ("Any individual may appear in a trademark matter for (1) a firm of which he or she is a member, (2) a partnership of which he or she is a partner, or (3) a corporation or association of which he or she is an officer and which he or she is authorized to present ...").

- *Applicant's Answer, Affirmative Defense and Counterclaim*

With respect to applicant's affirmative defense, the Board referred opposer to *CSC Holdings, LLC v. SAS Optimhome*, 99 USPQ2d 1959 (TTAB 2011) (for an opposition to a Section 66(a) application, the ESTTA cover sheet constitutes the entirety of the complaint). See also TBMP § 110.09(b) (October 2012) and cases cited therein.

In summary, opposer is allowed until **TWENTY DAYS** from the mailing date of this order to submit an amended pleading comprising its claim of likelihood of confusion and sufficient claims of dilution and/or deceptiveness, if applicable, failing which this proceeding shall move forward solely on opposer's claim of likelihood of confusion and on applicant's counterclaim based on fraud and non-use. Should opposer file an amended pleading, applicant is allowed until

FORTY DAYS from the mailing date of this order to file an amended answer/counterclaim.

Possible Stipulations

The parties agreed that they would serve documents filed with the Board or otherwise on the adverse party by U.S. mail, but that a courtesy copy of any such document would be sent by email. Applicant requested that opposer email documents to both Jeffrey Kaufman and to Beth Chapman (jk Kaufman@oblon.com, Bchapman@oblon.com).

There are various other stipulations to which the parties may agree during the pendency of the proceeding. By way of example, the parties may agree or stipulate *in writing* to the following measures to facilitate the progress of this proceeding:

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;⁴

⁴ Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. See TBMP §§ 403.01 and 501.02 (October 2012).

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- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- Testimony affidavits of witnesses may be submitted instead of testimony depositions;
- That documents are deemed authenticated; and/or
- That a notice of reliance can be filed after the testimony periods are closed.

See TBMP §§ 403.01, 501, 704.03(b) and 705 (October 2012).

Initial Disclosures

The next deadline after pleading are closed is the due date for initial disclosures. Should the parties seek additional information on initial disclosures, they may obtain additional information at the following sources:

http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf and to [http://edocket.access.gpo.gov/2006/pdf/06-](http://edocket.access.gpo.gov/2006/pdf/06-197.pdf)

197.pdf, or to

http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf. See Notice of Final Rulemaking ("Miscellaneous

Changes to Trademark Trial and Appeal Board Rules") in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 2498, 2501 (January 17, 2006). As discussed,

parties are obligated to provide "core information", that is, identify the names of individuals who might have extensive knowledge and might testify to support claims or defenses, and the location and type of documents that the disclosing party may use to support its claims or defenses.

Initial disclosures **SHOULD NOT** be filed with the Board. Initial disclosures have to be in writing and signed and served on the other party.

Electronic and Other Evidence Issues

The parties were reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.⁵ Additionally, the Board has held that electronically-stored information (ESI) must be produced unless the data is not reasonably accessible because of undue burden or cost.⁶

⁵ "While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request." *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D.Pa. 2007) (addressing law firm's failure to preserve temporary electronic files).

⁶ See *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) ("ESI must be produced in Board proceedings where appropriate, notwithstanding the Board's limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings" (internal citations omitted). However, a "party need not provide discovery of [ESI] from sources that the party identifies as not reasonably accessible because of undue burden or cost." See TBMP § 404.02 (October 2012).

Other Important Issues

The parties were reminded that the Board's standard protective order applies to this proceeding and may be modified by the parties in writing; and that a motion for summary judgment may not be filed, nor may any discovery be served until the party seeking to serve discovery has served its initial disclosures. The Board requested that the parties discuss and modify as needed the standard protective agreement insofar as opposer is not represented by counsel.

Additionally, *should the parties seek to engage in settlement negotiations, a consented motion to suspend should be filed in order to keep the trial schedule from moving forward.*

Accelerated Case Resolution (ACR)

In view of the issues before the Board in this proceeding, the Board refers the parties to its ACR procedure and to the Board's website regarding ACR (see [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)).

Trial Dates Reset

As discussed, opposer is allowed until **TWENTY DAYS** from the mailing date of this order to file an amended notice of opposition that comprises (in addition to its likelihood of confusion claim) sufficient claims of dilution and/or deceptiveness. Additionally, as discussed, applicant is allowed until **FORTY DAYS** from the mailing date of this order to file an amended answer, as needed. The discovery period shall open on the same date that applicant's amended answer is due, if any. In view of the foregoing, trial dates are reset as shown below:

Amended Notice of Opp. Due, if any	April 2, 2013
Amended Answer/Counterclaim, if any	April 22, 2013
Discovery Opens	April 22, 2013
Initial Disclosures Due	May 22, 2013
Expert Disclosures Due	September 19, 2013
Discovery Closes	October 19, 2013
Plaintiff's Pretrial Disclosures Due	December 3, 2013
30-day testimony period for plaintiff's testimony to close	January 17, 2014
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 1, 2014
30-day testimony period for defendant and plaintiff in the counterclaim to close	March 18, 2014
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 2, 2014
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	May 17, 2014

Counterclaim Plaintiff's Rebuttal Disclosures Due	June 1, 2014
15-day rebuttal period for plaintiff in the counterclaim to close	July 1, 2014
Brief for plaintiff due	August 30, 2014
Brief for defendant and plaintiff in the counterclaim due	September 29, 2014
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	October 29, 2014
Reply brief, if any, for plaintiff in the counterclaim due	November 13, 2014

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. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

The following information is provided to opposer as a courtesy:

Nature of an Opposition Proceeding

An *inter partes* proceeding 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,

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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 accordance with the applicable rules.**

Legal Representation Is Strongly Encouraged

It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent him or herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation 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.

It is recommended that applicant obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's trademarks page:

<http://www.uspto.gov/main/trademarks.htm>. The Board's main

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webpage, <http://www.uspto.gov/web/offices/dcom/ttab/>, includes information on the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to The Trademark Trial and Appeal Board Manual of Procedure (the TBMP). Further, all Board proceedings and other information regarding the Trademark Trial and Appeal Board may be accessed at the following URLs:

<http://ttabvue.uspto.gov/ttabvue/> and

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

Requirement for Service on Adverse Party of All Papers Filed

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 on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

All Parties Must Comply with Board Deadlines

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).

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is

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expected of all parties before the Board, whether or not they are represented by counsel.

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