

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

Mailed: August 27, 2012

Opposition No. 91205076

Mr. Winston A. Rosa

v.

Rafael Robert Vargas

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On August 13, 2012, following the Board's order requiring the parties to conduct their mandatory discovery conference with the Board, opposer, Winston A. Rosa, *pro se*, applicant, Rafael Robert Vargas, *pro se*, 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 and sets forth the Board's orders (see pages 5 and 9, *infra*) and the current status of the proceeding.

Conference Summary

- *The Parties' Pleadings*

At the outset, the Board discussed the applied-for mark, the services identified in the published application, and the apparent bases for opposer's claim or claims against

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applicant. Specifically, the Board noted that while opposer refers to Section 2(e)(4) of the Trademark Act on the ESTTA (electronic filing system) cover sheet of the notice of opposition as a basis for the opposition, that is, opposer has included a claim that the term "FULANITO" is "primarily merely a surname," there are no factual allegations in the attached document to support that claim. In view thereof, the notice of opposition, as currently drafted, fails to set forth a claim for which relief can be granted under Section 2(e)(4). See Fed. R. Civ. 12(b)(6); Trademark Rule 2.116(a). As a practical matter, the Board also noted that the pending application, in contrast, does not include any description of the mark or other indication that would indicate that the term is perceived as a surname. Based on these issues, the Board suggested that opposer review whether he should include a claim under Section 2(e)(4) in the notice of opposition.

Additionally, the Board noted that opposer states that he "created" the musical group "Fulanito," that he is listed on a copyright for a song performed by "Fulanito," and that Mr. Rosa is also filing an application for the same mark (application Serial No. 85561870). In view thereof, it appears that opposer is claiming that he is the owner of the mark FULANITO, and that applicant is not the owner. However, opposer's current pleading does not directly set

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forth an allegation or allegations that he is the owner of the mark FULANITO.

Based on the foregoing, the Board concluded that the notice of opposition fails to state a claim for which relief may be granted. However, the Board stated that opposer would be allowed time to submit an amended notice of opposition, and that applicant would be allowed to submit an amended answer.

- *Form of Opposer's Notice of Opposition*

Under Rule 8(a) of the Federal Rules of Civil Procedure, applicable to this proceeding under Trademark Rule 2.116(a), a plaintiff's initial pleading should allege such facts as would, *if proved at trial*, establish that the plaintiff (opposer here) is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, that is, *it has a real interest or personal stake in the outcome of the case*; and (2) a valid ground exists for opposing registration of the applied-for mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). *See also Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); and TBMP § 503.02 (3d. ed. rev. 2012). For instance, a sufficient pleading of the ground of priority and likelihood of confusion must include

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allegations of priority of use and the likelihood that consumers would be confused, mistaken or deceived by contemporaneous use of the parties' marks in the marketplace. See Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752 (Fed. Cir. 1998) and *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).¹

Additionally, a proper notice of opposition that is legally sufficient under Federal Rules of Civil Procedure must also comply with Fed. R. Civ. P. 10(b), which requires that pleadings must be set forth in numbered paragraphs and each paragraph should contain a single allegation. "All averments of a claim or defense shall be made in numbered paragraphs, the contents of each of which shall be limited as far as practicable to a statement of a single set of circumstances" See Fed. R. Civ. P. 10(b); and Trademark Rule 2.116(a). In other words, the notice of opposition must set forth short and plain, numbered statements showing why opposer believes he will be damaged if applicant obtains a registration for the applied-for mark, and state the ground or grounds for the opposition. See Fed. R. Civ. P.

¹ An opposer relying on common law rights he claims in an unregistered mark must prove at trial both the distinctiveness of the pleaded mark and priority of use. See *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (distinctiveness may be inherent or acquired).

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8(e)(1); and Trademark Rule 2.104(a).²

As discussed during the conference, opposer's claim or claims are unclear, that is, they are legally insufficient because the current allegations do not provide adequate notice to applicant or to the Board as to why registration to applicant of the involved mark should be denied.

ORDER: In view of the deficiencies in the notice of opposition, the Board finds that the notice of opposition is insufficient. Accordingly, opposer is allowed until **THIRTY DAYS from the mailing date of this order, that is, until September 26, 2012,** to file an amended notice of opposition that is in compliance with the standards set forth above, failing which the notice of opposition may be dismissed. See Fed. R. Civ. P. 12(b)(6); and Trademark Rule 2.116(a). See, e.g., *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); and TBMP § 503.03 (3d ed. rev. 2012).

- *Settlement Discussions; Related Proceedings*

The parties advised the Board that they had not yet conducted settlement discussions, and that there are no

² As regards any amended pleading, opposer is reminded that under Rule 11 of the Federal Rules of Civil Procedure, opposer is certifying 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.

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other related cases between the parties either at the Board or in state or Federal court.³

- *Accelerated Case Resolution (ACR)*

The Board referred the parties to its ACR procedure in this proceeding and to the Board's website regarding ACR (see <http://www.uspto.gov/trademarks/process/appeal/acrognoticerule.pdf>).

- *Possible Stipulations*

There are various 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:

- To serve on the other party any documents filed with the Board by electronic mail under Trademark Rule 2.119(b)(6).
- 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

³ The parties are requested to inform the Board should any related proceedings commence either between the parties or with third parties concerning the mark involved in this proceeding.

⁴ Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules

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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 (3d ed. rev. 2012).

- *Other Important Issues that the Parties Should Note*

The parties are reminded that the Board's standard protective order applies to this proceeding and may be modified by the parties in writing; 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; and that, ***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.***

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 (3d ed. rev. 2012).

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/06-197.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). Parties are obligated to *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 Bd.** Initial disclosures have to be in writing and signed and served on the other party.

- *Electronic and Other Evidence*

The parties are reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.⁵

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*,

ORDER: Proceeding Suspended; Trial Dates are Reset

This proceeding is **SUSPENDED** pending the time allowed by the Board to each party to submit a revised pleading, and shall resume on **October 27, 2012**, without further notice or order from the Board. See Trademark Rule 2.117(a). In addition, trial dates, including the due dates for the amended notice of opposition and amended answer, are reset as shown below:

Time to File Amended Notice of Opposition	9/26/2012
Time to File Amended Answer	10/26/2012
Proceeding Resumes	10/27/2012
Discovery Opens	10/27/2012
Initial Disclosures Due	11/26/2012
Expert Disclosures Due	3/26/2013
Discovery Closes	4/25/2013
Plaintiff's Pretrial Disclosures Due	6/9/2013
Plaintiff's 30-day Trial Period Ends	7/24/2013
Defendant's Pretrial Disclosures Due	8/8/2013
Defendant's 30-day Trial Period Ends	9/22/2013
Plaintiff's Rebuttal Disclosures Due	10/7/2013
Plaintiff's 15-day Rebuttal Period Ends	11/6/2013

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits,

et al., 497 F.Supp.2d 627, 639 (E.D.Pa. 2007) (addressing law firm's failure to preserve temporary electronic files). See also *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)).

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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.

Although the Board has previously provided the following information to the parties via email, given the complexity of the issues involved in this proceeding, the Board finds it appropriate to provide the information again to both parties.

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, 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 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

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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. Consequently, copies of all papers which opposer/applicant may file in this proceeding (including for opposer, the amended notice of opposition required herein) must be accompanied by "proof of service" of a copy on the adverse party or the adverse party's counsel if one is appointed.⁶

"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. This written statement should take the form of a "certificate of service" which should read as follows, and be signed and dated:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was

⁶ It is noted that on July 5, 2012, applicant submitted a certificate of service for his answer as required by the Board's order dated June 27, 2012.

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served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

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

Correspondence Address

It is each party's responsibility to ensure that the Board⁷ has a current correspondence address for that party. See TBMP § 117.07 (3d ed. rev. 2012) (If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party).

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⁷ When an *inter partes* proceeding is not pending before the Board, a registrant must maintain a current address with the Trademark Office.