

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

DUNN

Mailed: July 30, 2012

Opposition No. 91205223

Artemide S.P.A.

v.

Certa Products Ltd.

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

As discussed below and summarized at the end of this order, the parties stipulate to ACR (accelerated case resolution) procedures for this opposition.

On July 27, 2012, pursuant to a request by opposer, the Board participated in the parties' discovery conference by phone. The participants were Maria Savio, attorney for opposer, a joint stock company of Italy, Samuel Foo, Director of applicant, a limited liability company of Canada acting pro se¹, and Elizabeth Dunn, Board attorney.

¹ While Patent and Trademark Rule 10.14 permits any person to represent itself, 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 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.

At the beginning of the conference, the parties advised the Board there were no pending civil actions or other Board proceedings between the parties.²

REVIEW OF PLEADINGS

Opposer pleads priority and likelihood of confusion between applicant's mark (shown below)



for International Class 11 goods based on Sec. 1(b) and Sec. 44(d) priority (application Serial No 85444984³) and

² The parties are ordered to promptly notify the Board of the commencement of any related proceedings between the parties.

³ Application Serial No. 85444984 lists:
(Based on Intent to Use)

electric light bulbs; lamp bulbs; lamp whose light can be turned in all directions; led light assemblies for street lights, signs, commercial lighting, automobiles, buildings, and other architectural uses; led light bulbs; led lighting fixtures for indoor and outdoor lighting applications; lighting fixtures for use in parking decks and garages; lighting fixtures for use in parking lots and walkways; lighting tubes; luminaires, using light emitting diodes (leds) as a light source, for street or roadway lighting; solar light fixtures, namely, indoor and outdoor solar powered lighting units and fixtures; solar-powered all-weather lights; wall lights
(based on 44(d) priority application)

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opposer's marks ARTEMIDE and ARTEMIDE ARCHITECTURAL, also for International Class 11 goods and the subject of three pleaded registrations.⁴

Applicant's unserved motion filed June 29, 2012 to extend its time to answer is granted and the answer filed July 2, 2012 is accepted. However, no consideration will be given to any paper subsequently filed in this proceeding which lacks proof of service as required by Trademark Rule 2.119. While applicant's answer fails to admit or deny each numbered allegation, it is a general denial of the

outdoor solar powered lighting units and fixtures; solar-powered all-weather lights; wall lights.

⁴ Registration No. 1334169 for ARTEMIDE lists:
International Class: 11

Electric Lights and Lighting Fixtures Therefor.

Registration No. 2349855 for ARTEMIDE ARCHITECTURAL lists:
International Class: 11

Electric candelabras, electric lighting fixtures, flashlights, fluorescent lighting tubes, klieg lights, lamp reflectors, lamp shades, lamps, filaments for electric lamps, gas lamps, oil lamps, chemically activated light sticks, electric lightbulbs, electric track lighting units, electric night lights, pen lights, searchlights chandeliers.

Registration No. 3731640 for ARTEMIDE lists:
International Class: 11

Lighting apparatus and installations for the interior and exterior use, namely lamps, chandeliers, wall lights, floor lamps.

International Class: 20
Furniture, mirrors, picture frames.

International Class: 42
Services of project studies and design, provided by professionals including engineers, architects and designers, namely, consulting services in the field of architectural design and lighting design.

claims of the notice of opposition, and held legally sufficient.⁵

However, applicant's answer indicates some confusion as to the issues before the Board. That is, applicant denies likelihood of confusion based on the differences in the actual channels of trade for the goods of the two parties. An opposition does not determine the common law rights of applicant, but only whether applicant is entitled to federal registration of the mark as shown in the application and as used on the goods described in the application. 3 McCarthy on Trademarks and Unfair Competition 20:15 (4th ed. updated May 2012).

The question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed. Id;

⁵ Pursuant to Trademark Rule 2.122(d)(1), opposer's pleaded registrations submitted with notice of opposition now are evidence of record. In contrast, opposer's other attachments comprising the Wikipedia entries for ARTEMIS and ARTEMIDE and the attachments submitted with applicant's answer will be given no consideration. See Trademark Rule 2.122(c) ("Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.").

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Octocom Sys., Inc. v. Houston Computers Servs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (citations omitted). In addition, in the absence of express limitations in the identification of goods, the Board will presume that the goods move through all reasonable trade channels for such goods to all usual classes of consumers for such goods. *Centraz Industries Inc. v. Spartan Chemical Company, Inc.*, 77 USPQ2d 1698, 1700 (TTAB 2006). That is, opposer's unrestricted goods are presumed to encompass applicant's restricted goods. Registration will be denied if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application. *Hewlett-Packard Development Co. v. Vudu Inc.*, 92 USPQ2d 1630, 1633 fn 4 (TTAB 2009).

SUSPENSION FOR SETTLEMENT

Prior to the conference, opposer made an unsuccessful offer to settle this proceeding. During the conference applicant stated that it was not averse to settlement on different terms and believed a potential avenue was restriction of the identification of goods, if such restriction could be made so as to not disrupt current marketing plans. Opposer indicated that it remained interested in settlement, but based on August vacation

plans for opposer's officers located in Italy, opposer would not be able to consider any proposed amendments to the application or other settlement offers until late August. The Board is available to consult on whether proposed amendments to the identification of good would comply with the trademark rules regarding such amendments.⁶ The parties agreed to suspend this proceeding for settlement until October 12, 2012.

ACR (ACCELERATED CASE RESOLUTION)

In the event settlement efforts are unsuccessful, the parties agree and stipulate that this proceeding will employ ACR procedures. More specifically, in view the limited number of disputed issues in the proceeding, the parties will waive the disclosure, discovery and trial model set forth in the May 21, 2012 institution order. Instead, the parties will exchange information and submit evidence and briefs on the schedule below, and in lieu of trial, the Board can resolve any genuine disputes of material fact. After the evidence and briefs are filed, the Board will expedite determination of this matter and render a final decision in accordance with the evidentiary

⁶ The Trademark Rules and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (3rd ed., rev. 2012) are available in searchable form from the TTAB's page on the United States Patent and Trademark Office website.

burden at trial, that is, by preponderance of the evidence, within fifty days. The final decision will be judicially reviewable as set out in Trademark Rule §2.145.⁷

As discussed, because opposer submitted status and title copies of its pleaded registrations, priority of use is not an issue in this proceeding. Ownership of the pleaded registrations also establishes opposer's standing to bring its claims. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue is the likelihood of confusion between the parties' marks as used on their respective goods.

At opposer's suggestion, in lieu of disclosure and discovery, or submission of a stipulation of facts, the parties will exchange no more than 25 requests for admission on the abbreviated schedule set forth below. As explained during the conference, while they are served as part of discovery, requests for admission are not a traditional discovery device. Rather, requests for admission are particularly useful for determining, prior to

⁷ As shown by the Board's institution and trial order, even with the almost three month suspension period, the Board will render a decision in this case a year earlier than if the traditional schedule was followed.

trial, which facts are not in dispute, thereby narrowing the matters that must be tried.

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. See TBMP §407.03(b) (3rd ed., rev. 2012). An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. Any matter admitted is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission. See Fed. R. Civ. P. 36(b); Texas Department of Transportation v. Tucker, 95 USPQ2d 1241 (TTAB 2010) (admission conclusively establishes matter that is the subject of request for admission, subsequent argument to the contrary in response brief insufficient to raise genuine issue of material fact). Anything not admitted remains subject to proof.

Following this exchange to clarify the issues to be proven, the Board will meet again with the parties and ascertain if any discovery is necessary, or the parties are prepared to go forward with the submission of evidence and trial briefs on the disputed issues. At that time, the parties will enter stipulations regarding the admissibility

of trial evidence as well as the trial and briefing schedule. As discussed, while many trademark disputes are resolved on documentary evidence, testimony also may be submitted in the form of a transcript provided by a court reporter who was present at the formal deposition. Before the parties meet with the Board, they should consider how they intend to present the evidence in support of their case, and the type of stipulations which will streamline that process. At a minimum, the parties should expect to stipulate as to the admissibility of documents and submission of testimony via sworn statements in lieu of deposition.⁸

STIPULATIONS

1. The parties stipulate to suspension for settlement until October 12, 2012.
2. The parties stipulate to waive disclosure, discovery and trial under the Board's rules and to conduct this opposition under ACR procedures.
3. The parties stipulate, in lieu of disclosure and discovery, or the submission of a stipulation of facts, to exchange and respond to no more than 25 requests for admission.
4. The parties stipulate to meet with the Board to discuss the need for any additional clarification and to enter trial and briefing stipulations.

⁸ The parties may wish to review the ACR CASE LIST on the Board's webpage. With the proceeding number provided in the case summary, the parties may use TTABVUE to look through the electronic case file for samples of useful stipulations.

5. The parties stipulate that, in lieu of trial, the Board will resolve any genuine disputes of material fact.

6. The parties stipulate to the schedule set forth below.

NEW SCHEDULE:

Proceedings remain suspended for settlement:	October 12, 2012
Requests for admission are served:	October 26, 2012
Responses to requests for admissions are served:	November 9, 2012
Conference with the Board:	November 14, 2012 (2PM EST)

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