

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

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Mailed: December 16, 2012

Opposition No. 91206789

BBK Tobacco & Foods, LLP

v.

Don'Juan Gross

Yong Oh (Richard) Kim, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on December 6, 2012. Board participation was requested by applicant. Michael Sneberger, Esq.,¹ as General Counsel, appeared on behalf of opposer and Don'Juan Gross appeared *pro se*.

Introductory Remarks

At the outset of the conference, the Board informed the parties that a spirit of cooperation and good faith dealing were expected from the parties during the duration of this proceeding and that any points of contention that may arise

¹ Attorney Sneberger informed the Board during the conference that counsel of record, Rosalind Young, is no longer employed by opposer. Accordingly, opposer's correspondence information has been updated to reflect Michael Sneberger as the attorney of record for opposer.

during the course of the proceeding should be handled through direct communication between the parties and in a spirit of good faith. **The parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the issue.**

The parties were informed that telephone conferences with a Board attorney are available as necessary but that both parties would need to be on the call to discuss any substantive matter and that *ex parte* (i.e., single party) communications with the Board are generally inappropriate.

The parties were instructed to file appearances of counsel and change of correspondence forms as necessary.

Prior Communications and Disputes

The parties have confirmed that they have been in settlement discussions and that applicant is currently preparing a counter-proposal for opposer's review. While the parties are currently at a distance in regards to their relative positions, the parties are optimistic that a settlement can be reached.

The Board inquired as to whether the parties were involved in any other disputes involving the subject marks either with each other or with a third party to which the parties answered in the negative.

Pleadings

The Board and the parties discussed the claims in opposer's notice of opposition and applicant's answer thereto. **Opposer confirmed that it was solely asserting a claim of priority and likelihood of confusion in its notice of opposition.** As to the answer, the Board noted that applicant has admitted priority. Applicant expressed his surprise that he had done so but was unable to explain the reasons therefor since he did not have the pleadings readily available during the conference and did not have immediate access to the Internet.² **The Board informed applicant that priority currently stands admitted** and advised applicant to review the pleadings and the Board's Manual of Procedure (TBMP) and to serve and file any motions as necessary should he believe that the admission was in error.

The Board further informed the parties that the pleadings allege an incorrect filing date for involved application Serial No. 85588301, i.e., May 22, 2012, rather than the actual filing date of April 3, 2012. *See Notice of Opposition*, ¶ 1 and corresponding response in applicant's

² Applicant appeared for the discovery conference while in the process of picking up his daughter. Due to the distraction, ambient noise and the battery discharge that led to applicant missing a portion of the conference while he attempted to recharge his battery and reconnect to the conference, it is highly recommended that should a future conference occur, applicant agree to a time when he will be able to participate in the conference without distraction and from a more quiet setting.

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Answer. The parties were unable to explain the discrepancy and confirmed that the allegation of May 22, 2012, was in error. In view thereof, ¶ 1 of the Notice of Opposition as well as of the Answer are deemed amended to reflect April 3, 2012, as the filing date of application Serial No. 85588301.

Discovery

The parties were advised that the Board's standard protective order is operative in this proceeding, made applicable by operation of Trademark Rule 2.116(g) and available at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>.

If the parties wish to modify the Board's standard protective order, they could do so by filing a motion for Board approval along with a copy of the proposed protective order.

The Board then inquired as to whether the parties had given any consideration to reciprocal disclosures, stipulations of fact, and/or agreements to potentially limit and simplify discovery and testimony. The parties indicated that they had not but would consider doing so as appropriate. To that end, the Board informed the parties that greater use of reciprocal disclosures and less use of formal discovery was encouraged by the Board and that the parties could consider streamlining their discovery by

limiting the number of depositions,³ interrogatories, document production requests and admission requests.

The parties may also consider simplifying the introduction of evidence into the record such as stipulating to the authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

The parties declined to stipulate to accept service of papers by e-mail thereby retaining the five-day grace period under Trademark Rule 2.119(c) but the parties did agree to send via email courtesy copies of any papers served.

Courtesy copies are to be sent to legal@hbiin.com for opposer and to donjuangross@gmail.com for applicant.

Alternative Dispute Resolution and Accelerated Case Resolution

The Board informed the parties that mediation and arbitration are outside resources available to the parties to facilitate settlement discussions. Although the Board will not refer the parties to any particular arbitrator or mediator, the Board would be amenable to suspending proceedings should the parties choose these alternatives to aid in settlement.

³ Pursuant to Fed. R. Civ. P. 30(a), made applicable to Board proceedings by Trademark Rule 2.116, a party that seeks more than ten discovery depositions without prior stipulation by the parties to do so must obtain leave of the Board.

Accelerated Case Resolution (ACR) was also discussed and encouraged in view of the single claim alleged by opposer and the admission of priority by applicant. As the parties were not familiar with ACR, they declined to opt for the procedure at this juncture of the proceedings but were open to ACR pending further research and consideration. To facilitate the parties' consideration, they are referred to the following for additional information on the procedure:

<http://www.uspto.gov/trademarks/process/appeal/acrognoticerule.pdf>

[http://www.uspto.gov/trademarks/process/appeal/accelerated case resolution acr faq.doc](http://www.uspto.gov/trademarks/process/appeal/accelerated%20case%20resolution%20acr%20faq.doc)

Conclusion

As noted by the Board during the conference, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

Discovery is **OPEN** and dates are **RESET** as follows, beginning with the deadline for initial disclosures:

Initial Disclosures Due	1/8/2013
Expert Disclosures Due	5/8/2013
Discovery Closes	6/7/2013
Plaintiff's Pretrial Disclosures Due	7/22/2013
Plaintiff's 30-day Trial Period Ends	9/5/2013
Defendant's Pretrial Disclosures Due	9/20/2013
Defendant's 30-day Trial Period Ends	11/4/2013

Plaintiff's Rebuttal Disclosures Due
Plaintiff's 15-day Rebuttal Period Ends

11/19/2013
12/19/2013

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.

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