

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: October 28, 2014

Opposition No. 91209687

*Prometheus Global Media LLC*

v.

*ABC-Clio, LLC*

**George C. Pologeorgis,  
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the parties to this proceeding conducted a discovery conference with Board participation.

The parties agreed to hold the telephonic discovery conference with Board participation at 1 p.m. EDT on Tuesday, October 28, 2014. The conference was held as scheduled among Gene S. Winter and Tatyana Voloshchuk, as counsel for Opposer, Kurt Koenig, as counsel for Applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

This order memorializes what transpired during the conference.

**Settlement and Related Board or District Court Actions**

During the discovery conference, the parties advised the Board that since the commencement of this proceeding the parties have diligently pursued

**Opposition No. 91209687**

settlement, but settlement has still not been reached. The parties further advised that there are no related Board proceedings or federal district court actions concerning issues related to this case.

**Pleadings**

The Board reviewed the pleadings and indicated that Opposer has alleged dilution, false suggestion of a connection and likelihood of confusion as grounds for opposition. The Board found that Opposer's allegations regarding its standing, as well as its asserted claims for opposition are sufficiently pleaded.

The Board then reviewed Applicant's answer and noted that Applicant has denied the salient allegations asserted in the notice of opposition. The Board further noted that Applicant, in its answer, asserted various affirmative defenses. With regard to Applicant's Affirmative Defenses No. 6, the Board construes this affirmative defense as a mere amplification of Applicant's denials to the corresponding allegations in the notice of opposition and sees no harm in allowing these defenses to remain since they provide Opposer more complete notice of Applicant's position regarding Opposer's asserted claims. With regard to Applicant's first affirmative defense that the notice of opposition fails to state a claim upon which relief may be granted, said defense is deemed moot in light of this order and, therefore, is stricken from Applicant's answer. Applicant also asserted the affirmative defense of laches and acquiescence. *See* Paragraphs 28 and 31 of Applicant's answer. The affirmative defenses of laches and acquiescence, however, are not available in an opposition proceeding. *See*

**Opposition No. 91209687**

*National Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Accordingly, Applicants' affirmative defenses of laches and acquiescence are hereby stricken from its answer. Additionally, Applicant has asserted the affirmative defenses of estoppel and waiver. See Paragraphs 29 and 30 of Applicant's answer. The Board finds these affirmative defenses fail to set forth any specific allegations of conduct on the part of Opposer that would constitute waiver or estoppel. Accordingly, as set forth below, the Board will allow Applicant time to amend its answer to state properly the aforementioned affirmative defenses. Finally, the Board finds that, absent a counterclaim (which has not been asserted by Applicant), Applicant's Affirmative Defense Nos. 7 and 8 constitute impermissible collateral attacks on Opposer's pleaded registrations and, therefore, Applicant's Affirmative Defense Nos. 7 and 8 are stricken from Applicant's answer.

**Board's Standard Protective Order**

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval.

Further, under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. According to the terms of the Board's

**Opposition No. 91209687**

protective order, within thirty days following termination of a proceeding, the parties and their attorneys must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although it may be desirable to do so.

It is unclear, however, whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007). Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. *Id.*

**Discovery and Motion Practice**

The Board then noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). The parties are limited to seventy-five interrogatories, including subparts. *See* Trademark Rule 2.120(d)(1); TBMP Section 405.03 (3d ed. rev. 2 2013). There is no rule limiting the number of document requests or requests for admission that a party may serve, but the parties are reminded that each party "has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case." TBMP Section 408.01.

Additionally, the Board advised the parties that if either party plans to file a motion to compel discovery, the moving party must first contact the Board by telephone (with the adverse party on the line) so that the Board can ascertain whether the moving party has demonstrated a good faith effort in resolving the discovery dispute before filing its motion.<sup>1</sup> The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board.

The Board also provided the parties instruction as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). In such disclosures, the parties should provide to each other

---

<sup>1</sup> The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. *See* TBMP Section 408.01.

**Opposition No. 91209687**

the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment [and] a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties should not file their respective initial disclosures with the Board.

The Board also noted that, to the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend proceedings for the sole purpose of allowing the parties to take discovery of a designated expert witness.

**Pretrial Disclosures**

Pretrial disclosures are governed by Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

## **Opposition No. 91209687**

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under 37 CFR § 2.121(e), however, does not substitute for issuance of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). Further, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.

For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

### **Service of Papers**

The parties declined to stipulate to accept service of papers by e-mail. Accordingly, service of all papers in this matter should be made by first-class mail, however, the parties are required to serve courtesy email copies of their respective filings, as well as any written discovery.

**Opposition No. 91209687**

Additionally, it is recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA. The parties should not file consented motions to extend time prior to the deadline for initial disclosures by employing the "consented motion forms" in ESSTA. Instead, the parties should use the "general filing forms" option.

Finally, the Board advised the parties of the Board's accelerated case resolution ("ACR") process. While the parties declined to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, if appropriate.<sup>2</sup>

**Trial Schedule**

At the conclusion of the discovery conference, the parties agreed to suspend this proceeding until January 15, 2015 to allow the parties to continue with their settlement discussions.

In view thereof, proceedings are suspended up to, and including, **January 15, 2015**, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c), and 2.127(a); and TBMP § 605.02.

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set forth below.

---

<sup>2</sup> Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at the Board's website. See <http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**Opposition No. 91209687**

Proceedings Resume:

**January 16, 2015**

Applicant is allowed until **February 5, 2015** in which to file and serve and amended answer which properly sets forth the affirmative defenses of estoppel and waiver, failing which these affirmative defenses will be stricken from Applicant's answer.

Remaining trial dates are reset as follows:

Initial Disclosures Due	<b>2/25/2015</b>
Expert Disclosures Due	<b>6/25/2015</b>
Discovery Closes	<b>7/25/2015</b>
Plaintiff's Pretrial Disclosures	<b>9/8/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>10/23/2015</b>
Defendant's Pretrial Disclosures	<b>11/7/2015</b>
Defendant's 30-day Trial Period Ends	<b>12/22/2015</b>
Plaintiff's Rebuttal Disclosures	<b>1/6/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>2/5/2016</b>

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.

The Board would like to thank counsel for their professional decorum and cooperation during the discovery conference.