

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

Mailed: September 17, 2013

Opposition No. 91210665

Julius Sämann Ltd.

v.

Brand Builders Group Inc.

Cheryl S. Goodman, 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 September 11, 2013, with Board participation.

Participating in the conference were Roberta Bren and Beth Chapman, counsel for opposer, and for applicant, Andrew Ziegler pro se.¹ Present for the Board was the above-identified Interlocutory Attorney.

This order memorializes what generally transpired during the conference.

Standard Protective Agreement

The Board advised the parties of the imposition of the Board's standard protective agreement for confidential

¹ Also listening in was counsel G. Kevin Townsend, who did not make an appearance in this case. Opposer requested Board participation by telephone on August 30, 2013.

information and that any modified protective agreements should be filed with the Board. Pro se applicant was advised that he does not have access to information designated as trade secret or commercially sensitive and that he may be required to hire outside counsel to review information designated as such.² The parties discussed the possibility of modifying the Board's standard protective agreement. If the parties do modify the agreement, they should file a copy with the Board.

First class mail with courtesy e-mail Service

The parties' agreed to service by first class mail, with courtesy copies sent by e-mail.³

Disclosures

The Board provided the parties with general information regarding the nature of the parties' initial disclosures under Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii), expert disclosures, see Fed. R. Civ. P. 26(a)(2), and pretrial disclosures, see Fed. R. Civ. P. 26(a)(3). The parties are also directed to the Board's Manual of Procedure, TBMP, Sections 400 and 700, third edition revised for more information and to the Board's website,

² Applicant is directed to the Board's website with respect to the protective agreement, and to TBMP Section 412 (3d ed. rev.2 2013) for additional information.

³ The parties should adjust their spam filters so that communications from the Board (uspto.gov) and the adverse party, with respect to e-mail courtesy copies, are received.

with regard to providing more extensive initial disclosures.⁴ The parties should note that initial disclosures need not be filed with the Board unless they are filed in connection with a discovery motion, motion for summary judgment or notice of reliance.

The Board advised the parties that a motion for summary judgment cannot be filed prior to service of initial disclosures unless it is based on issue or claim preclusion or lack of jurisdiction of the Board. The parties are further advised that disclosures are subject to supplementation as set forth under Fed. R. Civ. P. 26.

Initial disclosures can only be waived by stipulation of the parties filed and approved by the Board.

Formal Discovery

The parties were advised that formal discovery (i.e., interrogatory requests, requests for production, depositions, requests for admissions) may be taken only after service of initial disclosures.⁵ The parties were advised that initial disclosures could be served sooner

⁴ Information regarding disclosures can be located in the Board Manual of Procedure (TBMP) at Chapters 401.02, 401.03 and Chapter 702. If the parties are interested in making more extensive disclosures, the parties are referred to the Miscellaneous Changes to TTAB Rules, January 17, 2006, located at <http://www.uspto.gov/trademarks/process/appeal/index.jsp> under "Rules/Laws."

⁵ For more information regarding formal discovery, the parties are directed to TBMP Chapter 400.

than the deadline set forth in the most recent scheduling order and that initial disclosures could be served concurrently with formal discovery.

Pleadings

The Board found opposer's notice of opposition and applicant's answer sufficient.

ESTTA Filings

The parties are advised that ESTTA is preferred for filing papers in the Board proceeding. As stated in the conference, the consent suspension and extension motion forms available on ESTTA should only be used after the deadline for initial disclosures has passed. In addition, the parties should carefully check that the dates generated in ESTTA are what they intend when using the automated forms.

Accelerated Case Resolution

The Board informed the parties regarding the possibilities to streamline the proceeding and save time and expense by considering Accelerated Case Resolution ("ACR"). Additionally, the parties are advised that ACR like efficiencies may streamline the case and save time and expense. Such efficiencies, whether used in the context of an ACR case or not, may include limiting discovery, shortening the discovery period, and taking advantage of

stipulations with respect to facts and evidence as well as using testimonial affidavits. The Board further advised the parties that such stipulations should be filed with the Board and, if the parties agree to an abbreviated schedule for discovery or trial, such agreement also should be filed with the Board so that a revised discovery and briefing schedule can issue.

The Board informed the parties of the options to use third party mediation or arbitration, at the parties' expense, to resolve the dispute.

Telephone Conferences

The parties were advised of the availability of telephone conferences with the assigned Interlocutory Attorney to resolve contested matters.

Reconvene for additional discovery conference topics

The parties were directed to reconvene to discuss the additional discovery conference topics for which the Board would not be present.

Suspension for Settlement

The parties were not interested in suspension for settlement discussions.

Pro Se Information

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and

Trademark Office, and many of the Federal Rules of Civil Procedure and Federal Rules of Evidence govern the conduct of this opposition proceeding. Applicant should note that Patent and Trademark Rule 11.14 permits any person or legal entity to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If applicant does not retain counsel to represent him, then applicant will have to familiarize himself with the rules governing this proceeding. On the World Wide Web, applicant may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries, and may be available at some public libraries or online.

The Trademark Rules are also located at <http://www.uspto.gov/trademarks/process/index.jsp>, left hand side under "Laws & Regulations." Finally, the Board's manual of procedure (TBMP) will be helpful. The third edition revised (2013) of the Trademark Trial and Appeal

Board Manual of Procedure (TBMP) has been posted on the USPTO web site at http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp.

Files of TTAB proceedings can now be examined using TTABVue, accessible at <http://ttabvue.uspto.gov/ttabvue/>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

Disclosed Assistance of Counsel

Pro se applicant has been assisted by counsel G. Kevin Townsend in filing his answer. Upon questioning by the Board as to his role, Mr. Townsend indicated he provided copies of answers to applicant as examples and applicant then drafted the answer, which was reviewed by Mr. Townsend prior to submission, and to which Mr. Townsend attached a certificate of service. The Board presumes Mr. Townsend also edits the submissions. Mr. Townsend also stated that he will be providing some legal counseling to applicant; however he is not providing full legal representation, and will not be making an appearance in this case.⁶

⁶ "Unbundled legal services, also known as discrete task legal services or limited scope legal assistance, "is a practice in which the lawyer and client agree that the lawyer will provide some, but not all, of the work involved in traditional full service representation." Hon. Fern Fisher-Brandveen & Rochelle

While the Board may afford more generous treatment to pro se litigants with regard to their filings, that latitude is designed to compensate for the absence of attorney involvement. If attorney involvement is present, as is the case here, then the more liberal construction to which pro se litigants are typically entitled with regard to their pleadings and motions would not be warranted.

Any pleadings of applicant prepared with the assistance of counsel should so state, and such pleadings should be filed in ESTTA by applicant, not Mr. Townsend.

Klempner, *Unbundled Legal Services: Untying the Bundle in New York State*, 29 *Fordham Urb. L.J.* 1107, 1108 (2002). Proponents of unbundled legal services have touted its benefits, including increased access to justice for the poor, efficiency in pro se matters, enfranchisement of clients and opportunities for attorneys. *Id.* at 1107-1114. However, with these benefits come complex ethical dilemmas for the legal community. See generally James. M. McCauley, *Current Ethical and Unauthorized Practice Issues Relating to Endeavors to Assist Pro Se Litigants*, *Virginia Lawyer*, December 2002, at 43. The ethics of unbundled legal services is most often questioned when attorneys engage in ghostwriting. Fisher-Brandveen, 29 *Fordham Urb. L.J.* at 1116." *Delso v. Trustees For Retirement Plan For Hourly Employees of Merck & Co., Inc.*, Civil Action No. 04-3009 (AET) 2007 WL 766349 (D.N.J. March 6, 2007).