

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

Mailed: September 23, 2013

Opposition No. 91211312

GrubHub, Inc

v.

So Within Reach, 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.¹

The parties agreed to hold the telephonic discovery conference with Board participation at 11:30 a.m. EDT on Monday, September 23, 2013. The conference was held as scheduled among Steven L. Baron, as counsel for opposer, Robert B. Reach and Matthew Bagley, as corporate representatives of *pro se* applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

¹ A request for Board participation in the discovery conference was received from applicant on August 12, 2013 via the Board's ESTTA filing system.

This order memorializes what transpired during the conference.

During the discovery conference, the parties advised the Board that they have conducted bilateral settlement discussions prior to the conference and request that these proceedings be suspended for sixty days to afford the parties time to concentrate on their settlement efforts.² Additionally, Mr. Reach, applicant's corporate representative stated that, at the current time, applicant wishes to proceed *pro se* in this proceeding without representation by counsel. The Board advised Mr. Reach and Mr. Bagley that inasmuch as applicant wishes to proceed without legal representation at this juncture, applicant would be required to familiarize itself with all Board procedures, rules and regulations governing this case.

The parties further advised that there are no related Board proceedings, federal district court actions, or third-party litigation concerning the parties' respective applications.

The Board then reviewed the pleadings and indicated that opposer has alleged the claim of priority and likelihood of confusion as the sole ground for opposition. Following a review of opposer's pleading, the Board finds that opposer has set forth sufficient allegations to allege its standing and its ground for opposition.

The Board further noted that applicant has filed an answer to the notice of opposition, and has asserted several affirmative defenses, including that

² During the telephone conference, the Board approved the parties' request to suspend for settlement to the extent noted *infra*.

opposer's pleading fails to state a claim upon which relief may be granted. The Board advised applicant that the failure to state a claim defense is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claims rather than a statement of a defense to a properly pleaded claim. In view thereof, this asserted defense will not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Notwithstanding, inasmuch as the Board has found that opposer's standing and ground for opposition are sufficiently pleaded, this affirmative defense is stricken from applicant's answer. With regard to the remaining affirmative defenses, the Board construes these defenses as mere amplifications of applicant's denials to the corresponding allegations in the notice of opposition and the Board sees no harm in allowing these defenses to remain since they provide opposer more complete notice of applicant's position regarding opposer's asserted claim.

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. Moreover, the Board noted that inasmuch as applicant is currently representing itself *pro se* in this case, it would be unable to view documents produced by opposer that have been designated "Highly Confidential – For

Attorneys Eyes Only”, i.e., Trade Secrets/Commercially Sensitive. The Board advised, however, that applicant could contest the appropriateness of the “Highly Confidential – For Attorneys Eyes Only” designation by seeking an *in camera* inspection by the Board of such documents designated “FOR ATTORNEYS EYES ONLY” by opposer.

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 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.*

Furthermore, the Board 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 (3d ed. rev. 2 2013).

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.³ 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:

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

³ 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 (3d ed. rev. 2 2013).

purpose of allowing the parties to take discovery of a designated expert witness.

Moreover, the parties agreed to accept service of papers by e-mail, except for service of responses to written discovery requests which may be served by first-class mail via hard copy. For all service of papers other than responses to written discovery requests, opposer indicated that it may be served at the following email addresses: sbaron@mandellmenkes.com; nharris@mandellmenkes.com; and emorris@mandellmenkes.com and that applicant may be served at the following email addresses: robby.reach@gmail.com and matthew.bagley@bagleyconsultingllc.com The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional 5 days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class of express mail.

Additionally, the Board recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA. The Board further noted that 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.⁴

Trial Schedule

As noted above, the parties requested that these proceedings be suspended for sixty days to allow the parties to pursue settlement. The request is granted. In view thereof, proceedings are suspended for settlement up to, and including, **November 23, 2013**, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

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 out below.

Proceedings resume:	November 24, 2013
Initial Disclosures Due	12/24/2013
Expert Disclosures Due	4/23/2014
Discovery Closes	5/23/2014
Plaintiff's Pretrial Disclosures Due	7/7/2014
Plaintiff's 30-day Trial Period Ends	8/21/2014
Defendant's Pretrial Disclosures Due	9/5/2014
Defendant's 30-day Trial Period Ends	10/20/2014
Plaintiff's Rebuttal Disclosures Due	11/4/2014
Plaintiff's 15-day Rebuttal Period Ends	12/4/2014

⁴ 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>

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.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

The Board would like to thank opposer's counsel and applicant's corporate representatives for their professional decorum during the discovery conference .