

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: July 9, 2014

Opposition No. 91212004

PRL USA Holdings, Inc.

v.

Xingtang Ren

**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 case conducted a discovery conference with Board participation.¹

The parties agreed to hold the telephonic discovery conference with Board participation at 9 a.m. Eastern time on Tuesday, July 8, 2014. The conference was held as scheduled among Daniel I. Schloss, as counsel for opposer, George G. Wang, 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.

During the discovery conference, the parties advised that they have not conducted settlement negotiations prior the telephone conference.

¹ Opposer requested Board participation in the parties' discovery conference via telephone on June 21, 2014.

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 in this matter and indicated that opposer, in its notice of opposition, has alleged priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, as well as dilution and lack of a *bona fide* intent to use the mark, 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 to opposer's notice of opposition and noted that applicant has denied the salient allegations asserted therein. The Board further noted that applicant, in his answer, asserted various affirmative defenses. The Board construes applicant's Affirmative Defense Nos. 1, 3, 4, and 5 as a mere amplifications of applicant's denials and sees no harm in allowing them to remain in applicant's answer particularly since it provides opposer more complete notice of applicant's position regarding opposer's asserted claims. The Board finds, however, that applicant's Affirmative Defense Nos. 2, 6, and 7 constitute an impermissible collateral attack on opposer's pleaded registrations and, therefore, applicant's Affirmative Defense Nos. 2, 6, and 7 are stricken from applicant's answer. The Board additionally noted that applicant asserted counterclaims against each of opposer's pleaded Registration Nos. 276855, 1363459, 1468420. The Board advised applicant that he had not

submitted the proper fee for the counterclaims. During the telephone conference, applicant's counsel advised that applicant wishes to withdraw the asserted counterclaims. Accordingly, applicant's counterclaims will be given no further consideration in this proceeding.

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 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 (2014). 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 (2014).

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.² 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

² 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 (2014).

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.

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 (2014).

Service of Papers

The parties agreed to accept service of papers by e-mail, except for service of documents pursuant to document requests that exceed 10 megabytes in size. In such circumstances, the parties have agreed to serve such document production by first-class mail via hard copy. For service of papers other than responses to document requests that exceed 10 megabytes, opposer indicated that it may be served at the following email address: schlossd@gtlaw.com; and that applicant may be served at the following email address: georgewang@bei-ocean.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 or express mail. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013).

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 opposer declined to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, by stipulation only, if appropriate.³

Trial Schedule

Discovery is now open. Trial dates for this proceeding are reset as follows:⁴

Initial Disclosures Due	8/8/2014
Expert Disclosures Due	12/6/2014
Discovery Closes	1/5/2015
Plaintiff's Pretrial Disclosures Due	2/19/2015
Plaintiff's 30-day Trial Period Ends	4/5/2015
Defendant's Pretrial Disclosures Due	4/20/2015
Defendant's 30-day Trial Period Ends	6/4/2015
Plaintiff's Rebuttal Disclosures Due	6/19/2015
Plaintiff's 15-day Rebuttal Period Ends	7/19/2015

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.

³ 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>

⁴ With regard to the trial schedule for this case, the Board’s April 19, 2014 and June 30, 2014, orders are hereby vacated. The trial schedule set forth in this order is now the operative schedule for this case.

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.