

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

Mailed: December 6, 2013

Opposition No. 91212870

Nelvana International Limited

v.

Henri R. Cayard

**M. Catherine Faint,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on Friday, December 6, 2013, between Jonathan D. Reichman, Atty., counsel for Nelvana International Limited, and Henri R. Cayard, appearing pro se.

The parties confirmed that there are no currently pending related Board proceedings, federal district court actions, or third-party litigation involving both parties. The parties indicated they had discussed settlement prior to the discovery conference. The parties indicated that they were familiar with the Board's electronic resources for filing papers electronically.

1. Legal Representation Strongly Recommended

As discussed, while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally

advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure.

Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006). If applicant decides to continue without counsel, he is urged to frequently consult the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) (3d ed. rev. 2 2013) and the Trademark rules of practice, which are available from the USPTO website at www.uspto.gov.

2. Requirement for Service of Papers

Applicant's answer did not show proof of service on opposer.¹ The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney,

and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via email to: [insert name and email address].

The certificate of service must be signed and dated. *See also* TBMP § 113.

3. *Email Service*

The parties stipulated to accept service of papers by email, and that opposer may be served at the following email

¹ Opposer may view the answer here:
<http://ttabvue.uspto.gov/ttabvue/v?pno=91212870&pty=OPP&eno=4>.

address: JReichman@kenyon.com,² and that applicant may be served at the following email address: HenriCayard@gmail.com. The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional five 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.

4. *Electronic Resources*

The Board has an electronic filing system that is different than the one used to file Trademark applications and updates to registrations. This system, named ESTTA, may be accessed via the Board's website: <http://estta.uspto.gov/>. To highlight some features of the system, when a filing is made, a pre-populated cover sheet is generated; filings then may be attached in a .PDF format; if the filing has successfully been completed, the filer will receive an ESTTA tracking number; if there are any problems, call the Board at 571-272-8500 and ask to be put through to one of the customer service specialists.

Addresses can be changed easily through an electronic form. Also, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.

² Opposer's counsel was informed that he must file a change of address form to enter this email address into the Board's electronic database.

Also available to the parties is the Board's TTABVue system which contains all of the Board's electronic files, including the one for this case. The parties may wish to conduct a status check of this case at least twice per month to be sure something is not missed. Most law firms already have a system for periodically checking status, and applicant may access TTABVue through the Board's website at:

<http://ttabvue.uspto.gov/ttabvue/>.

5. TBMP

The Board directed the parties to TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at:

http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp

The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should also look to the Trademark Rules for specific guidance. TBMP § 414 provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

6. Initial Disclosures

Initial disclosures are the witnesses, documents and things having or containing relevant information. Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii):

- (i) 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;
- (ii) 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.

The Board noted that discovery has not yet opened, and 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 Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties. See Trademark Rules 2.120(a)(3) and 2.127(e)(1). Initial disclosures do not need to be filed with the Board, only served on the other party.

7. Board's Standard Protective Order

The Board 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.

The Board noted that inasmuch as applicant is representing himself pro se in this case, he would be unable to view any documents produced by opposer that have been designated "Highly Confidential - For Attorneys Eyes Only." 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.

8. Review of the Pleadings

Upon review of the notice of opposition, the Board noted there are claims based on Trademark Act § 2(d) for priority and likelihood of confusion, and dilution based on Trademark Act § 43(c). Opposer has the burden of proof in this proceeding. A likelihood of confusion determination under § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). There are 13 *duPont* factors, however, not all of the *duPont* factors are relevant or of similar weight in every case. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Opposer has also pleaded dilution wherein opposer must prove, inter alia, that its mark is famous, and that it became famous prior to applicant's constructive use date. Opposer's pleading of the claims appears adequate. While applicant's response has sixteen numbered paragraphs, his answer is more in the nature of argument or a brief. Nonetheless, the Board construes applicant's answer as a general denial of the allegations in the notice of opposition.

9. *Limits on Discovery*

The Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests. The parties did not agree to limit discovery at this time, although the Board expressed its expectation that discovery would be straightforward and conducted reasonably in this case.

10. *Availability of ACR*

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("ACR") procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board's website:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. See Trademark Rule 2.120(a)(2). The parties were encouraged to consider the use of ACR in this proceeding.

11. Suspension for Settlement / Schedule

The parties made an oral consented motion to suspend for settlement discussions. The Board granted the motion to the extent that proceedings herein are suspended for three months so that the parties may discuss settlement, 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.³

Discovery Opens	3/6/2014
Initial Disclosures Due	4/5/2014
Expert Disclosures Due	8/3/2014
Discovery Closes	9/2/2014
Plaintiff's Pretrial Disclosures Due	10/17/2014
Plaintiff's 30-day Trial Period Ends	12/1/2014
Defendant's Pretrial Disclosures Due	12/16/2014
Defendant's 30-day Trial Period Ends	1/30/2015
Plaintiff's Rebuttal Disclosures Due	2/14/2015
Plaintiff's 15-day Rebuttal Period Ends	3/16/2015

³ Based on this schedule, initial disclosures are now due April 5, 2014.

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.
