

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

Mailed: February 20, 2014

Opposition No. 91213694

Shopology, LLC

v.

Shopology, 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 2:00 p.m. Eastern time on Thursday, February 20, 2014. The conference was held as scheduled among Rachel Weiss, as counsel for opposer, Noriess Beauvais, as corporate representative of 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.

¹ Applicant requested Board participation in the parties' discovery conference via telephone on February 8, 2014.

During the discovery conference, the parties advised the Board that no settlement discussions were conducted prior to the conference. Additionally, applicant stated that, at the current time, it wishes to proceed *pro se* in this proceeding without representation by counsel. The Board advised applicant that inasmuch as it wished to proceed without legal representation at this juncture, applicant would be required to familiarize themselves with all Board procedures, rules and regulations governing this case.

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 herein and indicated that opposer has alleged priority of use and likelihood of confusion under Section 2(d) of the Trademark Act as the sole ground for opposition. The Board found that opposer's allegations regarding its standing, as well as its claim of priority and likelihood of confusion, 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 therein. The Board further noted that applicant, in its answer, provided arguments more in the nature of a brief on the case in addition to its admissions and denials to the allegations set forth in the notice of opposition . The Board construes these arguments as mere amplifications of applicant's admissions and denials and sees no harm in allowing them to remain in

applicant's answer particularly since they provide opposer more complete notice of applicants' position regarding opposer's asserted claim.

Finally, during the telephone conference, the parties stipulated that the marks at issue are identical for likelihood of confusion purposes. In view of such stipulation, the parties should refrain from propounding discovery concerning the similarity of the marks at issue 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. Moreover, the Board noted that inasmuch as applicant is 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." 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.*

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 (3d ed. rev. 3 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.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

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 (3d ed. rev. 2 2013).

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.

Service of Papers

Moreover, the parties agreed to accept service of papers by e-mail, except for service of responses to document requests which may be served by first-class mail via hard copy. For all service of papers other than responses to document requests, opposer indicated that it may be served at the following email addresses: tmducket@leasonellis.com; schwimmer@leasonellis.com; and weiss@leasonellis.com and that applicant may be served at the following email address: noriessbeauvais@yahoo.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, 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.³

Trial Schedule

Discovery is now open. Trial dates are reset as follows:

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| Initial Disclosures Due | 3/22/2014 |
| Expert Disclosures Due | 7/20/2014 |
| Discovery Closes | 8/19/2014 |
| Plaintiff's Pretrial Disclosures Due | 10/3/2014 |
| Plaintiff's 30-day Trial Period Ends | 11/17/2014 |
| Defendant's Pretrial Disclosures Due | 12/2/2014 |
| Defendant's 30-day Trial Period Ends | 1/16/2015 |
| Plaintiff's Rebuttal Disclosures Due | 1/31/2015 |
| Plaintiff's 15-day Rebuttal Period Ends | 3/2/2015 |

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>

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 opposer's counsel and applicant's corporate representative for their professional decorum during the discovery conference.

Pro Se Information

As noted above, applicant intends to represent itself in this proceeding. While Patent and Trademark Rule 11.14 permits any person to represent itself, 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, applicant should note that Trademark Rule 2.119(a) and (b) 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 applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service.

It is recommended that applicant obtain a copy of the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and is available for a fee from U.S. Government Printing Office on the World Wide Web at <http://bookstore.gpo.gov>.

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, whether or not they are represented by counsel.⁴

⁴ The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is also available on the World Wide Web at <http://www.uspto.gov>.