

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: August 1, 2014

Opposition No. 91213825

Paramount Farms International LLC

v.

Wonderfully Raw Gourmet Delights,
LLC

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

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), a telephonic discovery conference with Board participation was held on Tuesday, July 29, 2014. Applicant made its request for Board participation in the discovery conference via ESTTA on June 24, 2014. Participating in the conference were Michael M. Vasseghi, Atty., as counsel for opposer, and Wendy Peterson, Atty., as counsel for applicant.

This order memorializes what transpired during the conference as well as providing additional guidance for both parties.

1. No Related Proceedings

The Board asked if the parties were involved in any other Board proceeding (to determine whether consolidation was appropriate) or in litigation in court (to determine whether suspension was appropriate). The same parties

are not involved together in any other proceedings. The parties have discussed settlement, but have not been able to reach an agreement.

2. Courtesy copies

The parties discussed the email service option now available under Trademark Rule 2.119(b)(6) (“Electronic transmission when mutually agreed upon by the parties.”). The parties did not agree to service by email, although they agreed to send courtesy copies of all motions/papers via email to the other party.

3. The Board’s Standard Protective Order

The Board advised the parties that the Board’s standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties were informed that they could substitute a stipulated protective agreement (signed by both parties), if they wish to do so. The parties will discuss a possible substitute protective order off-line and if agreed, will file it with the Board.

4. Accelerated Case Resolution

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 the more detailed information about ACR at the Board’s website at

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

Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of the proceeding, including permitting the Board to resolve issues of fact at summary judgment. The parties may also enter stipulations to any of the following:

- abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them;
- limiting the number or types of discovery requests or the subject matter thereof;
- limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration.

Applicant's counsel was willing to stipulate to ACR, but opposer's counsel needed additional time to consider the option and to discuss it with his client. The parties will give ACR further consideration. Mr. Vasseghi will send an email to Catherine.Faint@uspto.gov by Friday, August 29, 2014 regarding whether a teleconference regarding ACR should be scheduled.

5. Review of Pleadings/Discovery

The Board had previously reviewed the notice of opposition in its order of May 25, 2014. Opposer's claims are based on priority and likelihood of confusion and dilution. Opposer has claimed ownership of eight registrations for WONDERFUL or WONDERFUL-formative marks, but those registrations have not yet been made of record.

Applicant has answered the notice of opposition including "affirmative defenses" that are more in the nature of amplifications of its denials. *See Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 (TTAB

2009) (applicant's "affirmative defenses" amplified its denials of opposer's allegations regarding likelihood of confusion); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were arguments in support of denial of claim rather than true affirmative defenses and were treated as such). Also applicant has attached exhibits to its answer. While a party may attach exhibits to the pleadings, such exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, or on motion for summary judgment, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c) and (d); *see also* TBMP §§ 317 and 528.05.

The Board notes that at this stage of the proceeding, the Board looks only to whether claims have been adequately pleaded, and not to the sufficiency of the evidence which may be introduced in support of those claims. The parties are reminded that the Board is an administrative tribunal that determines the registrability of trademarks. If the case should progress so far, the parties should be mindful when submitting trial evidence to the Board that the better practice is to focus on supporting, only to the extent required by the pertinent burden of proof, the facts to be established.

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.

There was some discussion of ways to possibly streamline discovery. The parties **stipulated** that electronically stored information (ESI), if there is any in this case, will be provided in PDF format with the right to seek native format for the ESI if required.

5. Initial Disclosures

Pursuant to the Board's rules, neither the exchange of discovery requests nor the filing of a motion for summary judgment, except on the basis of res judicata or lack of Board jurisdiction, can occur until the parties have made their initial disclosures, as required by Fed. R. Civ. P. 26(f). Initial disclosures are not usually filed with the Board.

In this case the Board's May 25, 2014 institution order re-set discovery to open on July 30, 2014, and although the discovery conference is being held on July 29, 2014, discovery does not open until the date set in that order, and initial disclosures are due August 29, 2014.

The Board clarifies that under Trademark Rule 2.120(a)(3), "A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board." Thus once an individual party

has made its initial disclosures it may serve discovery, even if the other party has not yet served its initial disclosures. The Board views this as a means to aid settlement discussions between the parties.

6. Schedule

Dates remain as set in the Board's May 25, 2014 order, as copied below.

| | |
|-----------------------------------------|------------|
| Discovery Opens | 7/30/2014 |
| Initial Disclosures Due | 8/29/2014 |
| Expert Disclosures Due | 12/27/2014 |
| Discovery Closes | 1/26/2015 |
| Plaintiff's Pretrial Disclosures Due | 3/12/2015 |
| Plaintiff's 30-day Trial Period Ends | 4/26/2015 |
| Defendant's Pretrial Disclosures Due | 5/11/2015 |
| Defendant's 30-day Trial Period Ends | 6/25/2015 |
| Plaintiff's Rebuttal Disclosures Due | 7/10/2015 |
| Plaintiff's 15-day Rebuttal Period Ends | 8/9/2015 |

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.

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.

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