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

Mailed: February 25, 2014

Opposition No. 91214091
Opposition No. 91214147

Villanueva Holding Company LLC

v.

David Reynoso Urzua a/k/a David Reynozo

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 consolidated case conducted a discovery conference with Board participation.[1]

The parties agreed to hold the telephonic discovery conference with Board participation at 11:00 a.m. Eastern time on Monday, February 24, 2014. The conference was held as scheduled among John Tang, as counsel for opposer, Wendy Peterson, 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.

[1] Applicant requested Board participation in the parties' discovery conference via ESTTA filed in Opposition No. 91214091 on February 5, 2014.

During the discovery conference, the parties advised the Board that, prior to the conference, opposer presented a settlement offer to applicant, but applicant has yet to respond fully to the settlement offer.

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 each of the proceedings consolidated herein and indicated that opposer, for both proceedings, 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 in each opposition.

The Board then reviewed applicant's answers to each of opposer's notices of opposition and noted that applicant has denied the salient allegations asserted therein. The Board further noted that applicant, in its answers, asserted various affirmative defenses. With regard Affirmative Defense No. 1, the Board found that this affirmative defense was an improper collateral attack on opposer's pleaded application and, therefore, struck this affirmative defense from each of applicant's answers. The Board also struck Affirmative Defense No. 3 asserted in applicant's answer to the notice of opposition in Opposition No. 91214147 inasmuch as the affirmative defense

was not relevant to the issues raised in this consolidated case. With regard Affirmative Defense Nos. 2-4, and 6 asserted in applicant's answer in Opposition No. 91214091 and Affirmative Defense Nos. 2, 4 and 6 asserted in applicant's answer in Opposition No. 91214147, the Board finds that these affirmative defenses of unclean hands provide a sufficient factual basis for these defenses and, therefore, these affirmative defenses may remain in applicant's answers. Lastly, with regard to Affirmative Defense No. 5 asserted in each of applicant's answer, the Board construed this affirmative defense as a mere amplification of applicant's denials and sees no harm in allowing it to remain in applicant's answers particularly since it provides opposer more complete notice of applicant's' position regarding opposer's asserted claim.

Finally, during the telephone conference, the parties stipulated that the goods at issue are identical for likelihood of confusion purposes. In view of such stipulation, the parties should refrain from propounding discovery concerning the relatedness of the goods at issue in these consolidated proceedings.

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 (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

[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).

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 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 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 addresses: ipdocketing@strasburger.com; michelle.brockway@strasburger.com; john.tang@strasburger.com and teresa.wrye@strasburger.com; and that applicant may be served at the following email address: wsp@NJPLS.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

At the conclusion of the discovery conference, the parties agreed to suspend this proceeding for **forty-five (45) days** to pursue settlement negotiations.

Accordingly, these consolidated proceedings are suspended up to, and including, **April 10, 2014**, 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, these consolidated proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Consolidated proceedings resume:	**April 11, 2014**

Discovery is open upon resumption.

Initial Disclosures Due	**5/11/2014**
Expert Disclosures Due	**9/8/2014**
Discovery Closes	**10/8/2014**
Plaintiff's Pretrial Disclosures Due	**11/22/2014**
Plaintiff's 30-day Trial Period Ends	**1/6/2015**
Defendant's Pretrial Disclosures Due	**1/21/2015**
Defendant's 30-day Trial Period Ends	**3/7/2015**
Plaintiff's Rebuttal Disclosures Due	**3/22/2015**
Plaintiff's 15-day Rebuttal Period Ends	**4/21/2015**

[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.l25.

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.l29.

The Board would like to thank counsel for their professional decorum during the discovery conference.