

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

Mailed: March 27, 2014

Opposition No. 91214530

American Latex Corp.

v.

ThinkBug LLC

Jennifer Krisp, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held their required discovery and settlement conference on March 26, 2014. *See* TBMP § 401.01 (2013). Pursuant to applicant's request, the Board attorney participated in the conference. Participating were opposer's counsel Douglas H. Morseburg, Esq., James Lin on behalf of applicant, appearing pro se, and the assigned interlocutory attorney.

The Board apprised the parties of some general procedural rules and guidelines that govern *inter partes* proceedings, including the Board's liberal granting of motions to suspend for settlement efforts, the requirement that initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) be served prior to or with the service of discovery requests (*see* Trademark Rule 2.120(a)(3)), the requirement that a party serve initial disclosures prior to filing a motion for summary judgment (*see* Trademark Rule 2.127(e)(1)), and

the provision limiting circumstances under which disclosures are to be filed with the Board (*see* Trademark Rule 2.120(j)).

The Board's Standard Protective Order is automatically applicable to this proceeding pursuant to Trademark Rule 2.116(g). The order is referenced in the institution order, and is available in its entirety at a link on the Board's web page. Although they are not required to do so, the parties may elect to exchange executed copies of the order. If the parties wish to modify the order in any manner, they must file a motion for the Board's approval of the modification(s). Moreover, as a pro se party, applicant would need to secure the services of legal counsel in order to access any information or materials that are properly designated as "trade secret" or "highly confidential."

Once this proceeding has been finally determined, the Board has no further jurisdiction over the parties; thus, according to the terms of the protective order, within 30 days following termination, the parties and their attorneys must return to each disclosing party any protected information and documents disclosed or produced during the proceeding. In the alternative, the disclosing party or its attorney may provide a written request that such materials be destroyed rather than returned.

Turning to the pleadings, the Board noted that the notice of opposition sufficiently sets forth opposer's standing, as well as the grounds of priority and likelihood of confusion pursuant to Trademark Act Section 2(d).

Opposer's pleaded registrations are not currently of record. Opposer carries the burden of proof on the elements of the claim.

The parties stipulated to the exchange of service copies of motions, papers and other filings by electronic transmission (email) pursuant to Trademark Rule 2.119(b)(6). Regarding how this method of service has an impact on response times, the parties are directed to TBMP § 113.05 (2013). Specifically, the five-day period added to certain response times, as allowed under Trademark Rule 2.119(c), will not apply. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013). The parties agreed to send emails with a return receipt request, and/or to acknowledge the receipt of emails, so as to alleviate the potential for unreceived email communications.

The parties agreed to serve discovery document productions via email if they are not large in size, and via CDROM if the production is voluminous. They also agreed to appropriately identify all documents produced.

The parties were encouraged to consider stipulating to the presentation of testimony by affidavit or declaration, as appropriate, inasmuch as this, and similar procedural efficiencies, will save time, expense and other resources. Also, any settlement stipulation should be in accordance with the applicable rules. *See* TBMP § 605.03(a) (2013).

The Board explained the availability and features of the "accelerated case resolution" ("ACR") process, and referred counsel to the Board's web

page's "ACR & ADR" links, as well as TBMP §§ 528.05(a), 702.04 and 705 (2013), for further detailed information. The parties are encouraged to stipulate to seek resolution through the ACR process, inasmuch as this opposition appears to be suitable for expedited determination. In general, if the parties can stipulate to some factual issues, expect to proceed without expert testimony and with the testimony of only one or two witnesses, do not anticipate taking multiple depositions, and expect that the overall record will not be extensive, resolution of the opposition without a 6-month discovery period, and full trial periods, may be attainable. The Board suggested that the parties might opt to utilize a shortened discovery period, as well as a cross-motion for summary judgment approach, as is set forth as an example under the "TTAB ACR Options" website subheading.

In the event that the parties agree to an ACR schedule, procedural stipulations, and any stipulations of fact, they should file these and telephone the interlocutory attorney as well (at 571-272-9183).

#### Schedule

Initial disclosure, discovery and trial dates remain as set in the Board's January 17, 2014 order instituting this proceeding.