

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: April 22, 2014

Opposition No. 91215106

Margaritaville Enterprises, LLC

v.

Happy Hour Ninja

Jennifer Krisp, Interlocutory Attorney:

The parties held their required discovery and settlement conference on April 21, 2014, pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2). *See* TBMP § 401.01 (2013). Pursuant to opposer's request filed April 7, 2014, a Board attorney participated in the conference. Participating were Joel R. Feldman, opposer's counsel; David Alexander McWhorter, appearing pro se on behalf of applicant; and the Board's assigned interlocutory attorney.

The Board apprised applicant of his options with respect to legal representation. Regarding the Standard Protective Order (SPO) which is automatically applicable in this proceeding, under the terms thereof, applicant would need to secure legal counsel to access any information or documents which are properly designated by opposer as "trade secret" or "commercially sensitive."

Also with respect to the SPO, the parties must file for the Board's approval any modification(s) thereto (*see* Trademark Rule 2.116(g)), and the parties may wish to exchange an executed copy of the order. 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.

The Board advised 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, and the requirement that initial disclosures be served prior to or concurrently with the service of discovery requests absent modification of this requirement (*see* Fed. R. Civ. P. 26(a)(1); Trademark Rule 2.120(a)(3)).

The Board noted that in the notice of opposition, opposer sufficiently sets forth its standing, as well as one ground for opposition, namely, priority and likelihood of confusion pursuant to Trademark Act Section 2(d).

In his answer, applicant inappropriately responded to only paragraphs 16 through 24 of the notice of opposition. Applicant is allowed until twenty (20) days from the mailing date of this order in which to file an amended

answer which answers paragraphs 1 through 15, inclusive. For the required format of all filings, the Board referred applicant to Trademark Rule 2.126, and for the format of an answer, referred applicant to Fed. R. Civ. P. 8(b), Trademark Rule 2.106(b)(1), and TBMP § 311.02 (2013). The Board further advised applicant that with the exception of a registration made of record pursuant to Trademark Rule 2.122(d)(1), exhibits to pleadings are not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the assigned period for the taking of testimony. *See* Trademark Rule 2.122(c).

The parties stipulated to the exchange of service copies of motions, papers and other Board filings by electronic mail 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 review TBMP § 113.05 (2013). 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 (TTAB 2013).

If this proceeding does not settle, the Board expects that the parties will conduct discovery in accordance with Trademark Rule 2.120; the Board referred to TBMP Chapter 400, generally. In particular, TBMP § 414 (2013) sets forth certain selected discovery guidelines, as well as examples pertinent to the discoverability of various matters. Furthermore, the Board noted that any settlement-related filing and/or stipulation should be filed with the

Board in accordance with the applicable rules, and referred the parties to TBMP Chapter 600, generally. Also, any amendment(s) to a party's application must comply with all rules which were applicable during the examination of the opposed application (*see, e.g.*, Trademark Rules 2.71 and 2.72).

The parties agreed to exchange discovery in .pdf format by email, thumb drive, CD, or in hard copy.

The Board explained the availability and features of the accelerated case resolution ("ACR") process, and noted that this proceeding is suitable for expedited determination inasmuch as it involves one ground, and the application is based on Trademark Act Section 1(b), factors which suggest that the record will not be voluminous and that neither party will employ expert testimony. Resolution of this proceeding without a full 6-month discovery period and full trial periods should be achievable. The Board referred the parties to the Board's web page's "ACR & ADR" links, as well as TBMP §§ 528.05(a) and 702.04 (2013), which include detailed information and examples of cases.

In the event that the parties stipulate to utilize the ACR option, they should file their proposed discovery and briefing schedule with the Board, and telephone the Board attorney.

Schedule

The dates for initial disclosures, discovery and trial periods remain as set in the February 25, 2014 institution order.

Information for pro se party

While Patent and Trademark Rule 11.14 permits any entity to represent itself, it is strongly advisable for persons who are 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, and as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to purely procedure matters.

Any party who does not retain counsel should become familiar with the rules governing this proceeding, and may access useful legal resources, such as the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, from the Board's web page at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Furthermore, many Federal Rules of Civil Procedure govern the conduct of this proceeding. Also available on the Board's web page are links to TTABVUE, where one can view filings, proceeding history and status at <http://ttabvue.uspto.gov/ttabvue>, and to ESTTA, the Board's electronic filing system at <http://estta.uspto.gov>. All parties are strongly encouraged to use ESTTA to submit filings.

Trademark Rules 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 on 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. The statement should take the form of a certificate of service which must be signed and dated, and may read as follows (*see* TBMP § 113.03 (2013)):

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

The Board's February 25, 2014 order instituting this proceeding also contains information regarding the parties' obligations, as well as the manner in which this proceeding shall be conducted.