

**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: May 8, 2014

Opposition No. 91215167

Opposition No. 91215169

Caribou Coffee Company, Inc. and
Arabica Funding, Inc.

v.

Denali Co., LLC

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

On April 28 and May 2, 2014, applicant filed requests for Board participation in the discovery conference and motions to consolidate the above-captioned opposition proceedings.

Consolidation

The Board notes initially that applicant has filed its answer in each proceeding for which consolidation is sought.

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

It is noted that the parties to these proceedings are identical, and the issues are similar or related. Accordingly, the motion to consolidate is granted. Opposition Nos. 91215167 and 91215169 are hereby consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. **91215167** as the “parent case.” From this point on, only a single copy of all motions and papers should be filed, and each such motion or paper should be filed in the parent case only, but caption all consolidated proceeding numbers, listing the “parent case” first.¹

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised

¹ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

As it is early in the proceedings, and the cases are already set forth on the same discovery and trial schedule, the Board will not reset dates for the consolidated proceeding. Trial dates remain as set forth in the Board's institution orders of February 27, 2014, as copied below.

Discovery Conference

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on May 6, 2014 with Board participation. Participating in the conference were opposer's counsel, Heather Redmond, and applicant's counsel, G. Thomas Williams. This order memorializes what transpired during the conference as well as providing additional guidance for both parties.

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 Board was informed that the parties were not so involved. The parties also informed the Board that they have previously discussed settlement, but have not yet been able to resolve the matter.

1. *Email Service*

The parties stipulated to accept service of papers by email, that opposer² may be served at the following email address: Redmond.Heather@dorsey.com, and that applicant may be served at the

² Opposer's counsel was informed that an electronic change of address form needed to be entered in order to receive Board communications at her email address.

following email address: gtw@mcgarrybair.com.³ The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional five days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail. *See McDonald's Corp. v. Cambridge Overseas Development, Inc.*, 106 USPQ2d 1339 (TTAB 2013) (parties may not obtain additional five days for service under Trademark Rule 2.119(c) when they have agreed to electronic service).

2. ***Board's Standard Protective Order***

The Board advised the parties that the Board's standard protective order was in place in this case governing the exchange of confidential and proprietary information and materials.⁴

3. ***Pleadings/Scope of Discovery***

With regard to the pleadings, the Board noted that the notice of opposition alleges counts of priority and likelihood of confusion, and the answer denies the salient allegations in the complaint. Opposer has the burden of proof in this proceeding.

A likelihood of confusion determination under § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). There are 13 *duPont* factors, however, not all of the *duPont* factors are relevant or of similar weight in every case. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

³ Both parties have additional email addresses listed in the Board proceeding file, and additional service copies may also be served at those email addresses.

⁴ The order may be reviewed at the Board's website:
<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

In these proceedings opposer has made its registrations of record by attaching printouts of information from the USPTO electronic database showing their status and title, except for its application Serial No. 85792657, which has since registered. Opposer is considered to have given sufficient notice of its pending registration in the application, but the registration still needs to be made of record. *See* TBMP § 704.03(b)(1)(A). Similarly, applicant cited in its answer to one of its registrations, but has not made the registration of record. *See id.*

There was some discussion of ways to possibly streamline discovery, but the parties did not stipulate to any measures limiting discovery.

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.

4. ***Accelerated Case Resolution (“ACR”)***

The Board encourages settlement of matters between the parties, and the parties were to continue settlement discussions after conclusion of the discovery conference. While the Board does not conduct settlement conferences, there is an ACR procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board.

While ACR cannot be used on a claim-by-claim basis, it can take almost any form that the parties agree to that will move this proceeding forward in an efficient and expeditious manner. The simplest form of ACR would be similar to summary judgment whereby the parties would submit briefs with attached evidence, but would agree to allow the Board to resolve

any genuine disputes of material fact raised by the parties' filings or the record.

Alternatively, the parties may wish to consider ACR involving limited discovery or ACR-like efficiencies such as: stipulating to some or all of the facts, foregoing discovery in favor of greater reciprocal disclosures than required by Fed. R. Civ. P. 26(a)(1), limiting discovery in time and scope (i.e. 60-day discovery period with each party limited to 10 interrogatories, document requests and requests for admission and 1 deposition), and/or taking testimony by declaration, subject to the right of either party to cross examine, if desired. *See, e.g., Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to entire record of case including business records, public records, government documents, marketing materials and materials obtained from Internet as well as thirteen paragraphs of facts; parties agreed to reserve right to object to such facts and documents on bases of relevance, materiality and weight).

The Board's website has a list of cases showing stipulations the parties have adopted and where ACR was used. The parties are directed to the following materials which they may find helpful in crafting an ACR plan suitable for this proceeding:

1. ***General description of ACR:***

http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf;

2. ***FAQs on ACR:***

[http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_\(ACR\)_FAQ_updates_12_22_11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_(ACR)_FAQ_updates_12_22_11.doc);

3. ***List of cases employing ACR-like efficiencies:***

[http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_\(10-23-12\).doc](http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_(10-23-12).doc); and

4. *Potential ACR schedules:*

http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp.

The parties were interested in the ACR procedure, but needed more time to consider the matter and to continue their settlement negotiations. Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. *See* Trademark Rule 2.120(a)(2). The parties were encouraged to contact the assigned interlocutory attorney if they have any questions or would like assistance in developing an ACR plan.

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).

In this case the Board's institution orders set discovery to open on May 8, 2014, and although the discovery conference is being held on May 6, 2014, discovery does not open until the date set in the institution orders. 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.

Schedule

Dates for this consolidated proceeding remain as set in the institution orders, as copied below.:

Discovery Opens	5/8/2014
Initial Disclosures Due	6/7/2014
Expert Disclosures Due	10/5/2014
Discovery Closes	11/4/2014
Plaintiff's Pretrial Disclosures	12/19/2014
Plaintiff's 30-day Trial Period Ends	2/2/2015
Defendant's Pretrial Disclosures	2/17/2015
Defendant's 30-day Trial Period Ends	4/3/2015
Plaintiff's Rebuttal Disclosures	4/18/2015
Plaintiff's 15-day Rebuttal Period Ends	5/18/2015

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.