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: June 16, 2014

Opposition No. 91215737

Olin Corporation

v.

International Watchman, Inc.

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 Friday, June 13, 2014. Applicant filed its request for Board participation in the discovery conference via ESTTA on May 21, 2014. Participating in the conference were Joel R. Samuels, Atty., as counsel for opposer, and Michael W. Vary, Atty., as counsel for applicant.[1]

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

1. 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

[1] Also participating in the teleconference was Kristen M. Hoover, Atty. for applicant.

same parties are not involved together in any other proceedings. However, applicant stated it is involved in other Board proceedings involving the same mark and contemplates filing a motion to consolidate in the future. Although identity of the parties is a factor considered by the Board in determining whether to order consolidation, it is not always necessary. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). However, the Board seldom suspends a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application, and asserting unrelated claims, absent the consent of the other parties. *Id.* at 1551.

2. Email Service

The parties stipulated to accept service of papers by email, and that opposer may be served at the following email address: bwheelock@hdp.com, and that applicant may be served at the following email address: kmh@mccarthylebit.com.[2] 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.

[2] The parties may also provide courtesy copies to each other via the other email addresses listed in the Board's electronic file.

3. The 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. The parties were informed that they could substitute a stipulated protective agreement (signed by both parties). Opposer may wish to propose some changes to the standard protective order and will provide a redlined version to applicant's counsel if this case does not settle in the near future.

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.

5. Review of Pleadings

Some discussion was held regarding the pleadings. Noted on the ESTTA coversheet were claims based on Trademark Act § 2(a) false suggestion of a connection, and § 2(e)(1) that the mark is descriptive or deceptively misdescriptive. Upon review of the pleadings the Board noted that there also appears to be a claim at paragraph 14 of the notice of opposition alleging lack of bona fide intent to use the mark in commerce.

For a proper § 2(a) claim of false suggestion of a connection, a plaintiff must allege facts from which it may be inferred that its mark is famous and points uniquely and unmistakably to itself, as an entity -- i.e., that its mark is its identity or "persona" -- and that purchasers would assume that goods bearing the mark are connected with plaintiff.[3] *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Thus for a claim of false suggestion of a connection, plaintiff must plead (and prove) the following:

1. Defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;

[3] Although there is no claim of § 2(a) deceptiveness here, such a claim must allege deceptiveness as to the nature or meaning of the mark in relation to the services. *See e.g., In re Budge Manufacturing Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

2. defendant's mark would be recognized as such;
3. plaintiff is not connected with the activities performed by the defendant under the mark; and,
4. plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used in connection with its services, a connection with the plaintiff would be presumed.

Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752, 754 (TTAB 1985), *citing Buffett v. Chi Chi's*, 226 USPQ 428, 429 (TTAB 1985).

From reviewing the pleadings, the Board noted that the parties appear to recognize that there may be an issue as to whether opposer may assert under Trademark Act § 2(a) a claim of false suggestion of connection. In *Jeweler's Vigilance IV* the Federal Circuit found that a *trade association* could bring a false suggestion claim, and opposer in this proceeding is not a trade association. *See Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). But, at issue here, is whether opposer as a third party could assert proprietary rights on behalf of a another entity, in this case NATO, in order to allege a Section 2(a) claim. The Board did not strike the claim at this time.

The distinction between claims of descriptiveness and deceptive misdescriptiveness under Trademark Act § 2(e)(1) is that the two claims involve proof of contrary facts (description and misdescription) and the latter claim also requires proof of an additional element. Specifically, proof of deceptive misdescriptiveness requires evidence that consumers would believe a misdescription. *See* Trademark Act § 2(e)(1).

As to the lack of bona fide intent to use the mark in commerce, opposer has the burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark at the time it filed its application, but this pleading at paragraph 14 of the notice of opposition is sufficient.

Portions of Applicant's answer are more in the nature of an argumentative brief. An answer should admit or deny each allegation, which was done here, and the Board also will not strike any of the answer at this time.

Both parties have attached exhibits to the pleadings, other than status and title copies. The Board will not strike exhibits submitted with pleadings since they are clearly contemplated by Trademark Rules 2.105(c), 2.113(c), and 2.122(c). However, except for status and title copies or current printouts from the USPTO's electronic database records containing status and title information of a plaintiff's pleaded registrations filed by the plaintiff with its complaint pursuant to Trademark Rule 2.122(d)(1), exhibits attached to pleadings are not evidence on behalf of the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period. 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.

6. Discovery

The parties were directed to TBMP § 414 (3d ed. rev. 2 2013) regarding the discoverability of various categories of information in Board proceedings. The Board suggested to the parties that they could in the future adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, or admission requests, and to stipulate to the authenticity of documents. The parties declined to stipulate to limitations to discovery, and did not contemplate that there would be any significant electronically stored information at this stage of the proceeding.

7. Initial Disclosures

The time for making the initial disclosures required by Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii) is reset below. Pursuant to the Board's rules, neither the exchange of discovery requests nor the filing of a motion for summary judgment, can occur until the parties have made their initial disclosures, as required by Fed. R. Civ. P. 26(f).

The Board clarified 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.

8. Suspend for Settlement

The parties agreed to suspend for 30 days while they continued settlement negotiations between them. The motion for suspension is **granted**.

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set forth below.

Proceedings Resume	7/13/2014
Initial Disclosures Due	8/12/2014
Expert Disclosures Due	12/10/2014
Discovery Closes	1/9/2015
Plaintiff's Pretrial Disclosures Due	2/23/2015
Plaintiff's 30-day Trial Period Ends	4/9/2015
Defendant's Pretrial Disclosures Due	4/24/2015
Defendant's 30-day Trial Period Ends	6/8/2015
Plaintiff's Rebuttal Disclosures Due	6/23/2015
Plaintiff's 15-day Rebuttal Period Ends	7/23/2015

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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