

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

Baxley

Mailed: August 15, 2014

Opposition No. 91216725

Zenith-Mart Inc.

v.

Godswill H. Oletu DBA Zenithmart

Andrew P. Baxley, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a telephone conference with the parties on August 7, 2014, after Applicant had requested Board participation by in writing on July 29, 2014. Present during the conference were Opposer's attorney Adam S. Weiss, Applicant Godswill H. Oletu, and Board interlocutory attorney Andrew P. Baxley.

The Board is an administrative tribunal that is empowered solely to determine the right to register and which has no authority to determine the right to use a mark or any infringement or unfair competition issues. *See* TBMP § 102.01 (2014). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, document requests, and requests for admission

to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case.

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.¹

The Board encourages the parties to discuss settlement. To that end, the Board is generous in granting consented extensions of the schedule and periods of suspension to accommodate any settlement pursuits. Any party filing an unconsented motion to extend or suspend should notify the Board by telephone upon the filing thereof so that such motion can be resolved promptly by telephone conference. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a).

In addition, the parties may seek mediation, arbitration or some other means for resolving this case.² Information concerning Accelerated Case

¹ The parties are advised that, if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence at trial by way of a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

² Such procedure is similar to a motion for summary judgment; however, rather than merely determining whether there are genuine issues of material fact, the Board makes findings of fact in an ACR.

Resolution procedure (ACR) is available online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. If the parties wish to pursue ACR, they should inform the Board as soon as possible.

The parties are advised to refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>, and the Federal Rules of Civil Procedure, online at <http://www.law.cornell.edu/rules/frcp/>. Other useful databases include the Electronic System for Trademark Trials and Appeals (ESTTA)³ for filing submissions with the Board, TTABVUE for status and prosecution history, and TTAB Decisions for examples of fully litigated proceedings (that is, from the filing of the complaint to final decision). All of these databases are

³ Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received once the transaction is completed.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

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The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

accessible online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The Board expects all parties appearing before it to comply with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure.

Trademark Rules 2.119(a) and (b) state that every paper filed in this proceeding must be served upon 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. Consequently, copies of all papers which Applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made, e.g., by mail. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service. The Board will not consider any further submissions that are filed without proof of service upon the filing party's adversary at its correspondence address of record.

The Board's standard form protective order is in effect in this proceeding to govern the exchange of confidential information and materials. *See* Trademark Rule 2.116(f). The standard protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. The parties may substitute a stipulated protective agreement (signed by both parties and approved by the Board upon motion). In view of the existence of

the Board's standardized protective order, the Board will not become involved in a dispute over any substitution.

The parties indicated that there are no current settlement talks between them, and that there is no other litigation between them. The parties agreed to service by e-mail service. Accordingly, the five additional days to act that are conferred by Trademark Rule 2.119(c) are unavailable herein. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013). The parties' e-mail addresses of record are: aweiss@polsinelli.com, kesullivan@polsinelli.com, and uspt@polsinelli.com for Opposer, and oletu@oletu.com for Applicant.

The Board then reviewed the parties' pleadings. In the notice of opposition, Opposer pleads its standing and claims of priority/likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and nonuse under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). *See Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

To the extent that Opposer intends to allege abandonment based on three consecutive years nonuse, Applicant filed his use-based application less than a year ago. Because a use-based Applicant need not be using his mark until he files his use-based application, Opposer may not rely upon time that

precedes the application filing date in support of an abandonment claim. *Cf. Consolidated Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153 (TTAB 2002) (an intent-to-use applicant need not make use of its mark until it files a statement of use). To the extent that Opposer intends to allege abandonment based on cessation of use with no intent to resume use, Opposer has not alleged specific conduct subsequent to the use-based application filing date which provide a basis for that allegation. See *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007).

Applicant, in his answer, denied the salient allegations of the notice of opposition and set forth additional information concerning his intended defense herein. To the extent that Applicant refers to his additional application Serial No. 86228203 and Opposer's pleaded application Serial Nos. 86156478 and 86172398, those applications are not at issue in this proceeding. This proceeding is concerned solely with the registrability of the mark in involved application Serial No. 86067598.

Regarding discovery in this case,⁴ the marks at issue include identical wording, ZENITHMART, and are used on overlapping services in

⁴ Neither party may serve discovery requests nor file a motion for summary judgment, except on certain limited grounds not at issue in this case, until that party has served its initial disclosures. See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

International Class 45.⁵ Accordingly, discovery topics should be focused primarily on priority of use of the ZENITHMART mark on those services.

If either party files an unconsented motion to extend or suspend, the movant should telephone the Board attorney assigned to this case upon filing so that the Board attorney can schedule a telephone conference in connection with that motion. *See* Trademark Rule 2.120(i)(1); TBMP Section 502.06(a).

Dates remain as set in the Board notice instituting this proceeding. The Board thanks the parties for their participation.

⁵ 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. Each party and/or its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See* TBMP § 408.01. If the parties appear to be uncooperative in discovery, the Board will not hesitate to require a telephone conference prior to the filing of any motion to compel discovery.