

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: September 3, 2014

Opposition No. 91216907

Benefit Cosmetics LLC

v.

Anastasia Beverly Hills, Inc.

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 August 29, 2014. *See* TBMP § 401.01 (2014). Pursuant to applicant's request, the Board attorney assigned to this proceeding participated in the conference. Participating were opposer's counsel David Donahue, applicant's counsel Joel Feldman, and the Board 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, and the requirement that initial disclosures be served prior to or concurrently with serving discovery requests, absent modification of this requirement (*see* Fed. R. Civ. P. 26(a)(1); Trademark Rule 2.120(a)(3)).

The Board's Standard Protective Order is automatically applicable in this proceeding, and the parties must file for the Board's approval any modification(s) thereto pursuant to Trademark Rule 2.116(g). It is not necessary for the parties to sign a copy, although counsel indicated that they anticipate doing so. Counsel indicated that they are considering a modification to the standard order for the Board's approval.¹

The Board noted that the notice of opposition sufficiently sets forth allegations of opposer's standing, as well as the following grounds: 1) the mark is merely descriptive, under Trademark Act Section 2(e)(1); 2) the mark is functional, under Trademark Act Section 2(e)(5); and 3) the mark is merely informational and does not function as a trademark to indicate the source of applicant's goods, under Trademark Act Sections 1, 2 and 45. The Board noted that the exhibits submitted with the notice of opposition are not evidence in this proceeding unless they are properly identified and introduced in evidence. *See* Trademark Rule 2.122(c); TBMP § 317 (2014).

The parties stipulated to the exchange of service copies of all motions and papers filed with the Board, as well as discovery requests and responses, by electronic transmission (email) pursuant to Trademark Rule 2.119(b)(6). The Board noted that Trademark Rule 2.119(c), which allows for an

¹ 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

additional five days in which to take action, does not apply under such stipulation. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2014); TBMP § 113.05, 502.02(b) (2014).

Mr. Donahue expressed a preference for the exchange of electronically stored information in TIFF format so as to preserve all metadata associated with such documents, and to exchange Excel® documents, and other documents on a case-by-case basis, in their native format. The parties did not enter into a specific stipulation, but did stipulate to address the issue again on a case-by-case basis.

The parties stipulated that trial testimony may be by affidavit or declaration, and that the parties shall have the right to live cross-examination. Counsel will further discuss any anticipated deadlines and timeframes for providing such testimony and cross-examination.

The Board explained the availability and some features of the “accelerated case resolution” (“ACR”) process. The Board noted that under an agreed-upon schedule for briefing of cross-motions for summary judgment, the parties can opt to seek resolution of the opposition on the merits without a full 6-month discovery period and/or without full trial periods. The parties did not so stipulate, but may give the option consideration, as appropriate. The Board’s web page’s “ACR & ADR” links, as well as TBMP §§ 528.05(a) and 702.04 (2014), include further detailed information regarding ACR.

attorney may provide a written request that such materials be destroyed rather than returned.

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Disclosure, discovery, and trial dates remain as set forth in the institution order.