

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

EJW

Mailed: October 7, 2014

Opposition No. 91217625

Big Front Door, LLC dba  
big front door

v.

Elliot H. Cohen

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

On October 7, 2014, opposer (represented by Drew Smith of Holley & Menker, P.A.), applicant (represented by Daniel Latter of the Marquee Law Group APC), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a). This order sets forth a summary of the significant points addressed during the conference and the parties' stipulation.

Conference Summary

At the outset, the Board inquired as to whether the parties had engaged in any settlement discussions and whether there are any related proceedings. The parties informed the Board that there is no related Federal court case or Board proceeding and that there have been no settlement discussions. The parties were reminded to file a consented motion to suspend or to extend the trial schedule should they decide to engage in settlement negotiations.

The parties were required to promptly advise the Board should a civil action between the parties or other Board proceeding be instituted so that the Board can determine whether suspension or consolidation is appropriate.

Pleadings

- *Notice of Opposition*

The Board advised the parties that Opposer has sufficiently pleaded standing and a claim of likelihood of confusion under Trademark Act Section 2(d). Specifically, Opposer's allegation of ownership and prior use of its pleaded BFD marks and its allegation of a colorable, non-frivolous claim of likelihood of confusion suffice, if proven, to establish Opposer's standing. *See United Rum Merchants Ltd. v. Distillers Corp. (S.A.) Ltd.*, 9 USPQ2d 1481, 1482 (TTAB 1988).<sup>1</sup> However, Opposer's claim under Section 2(a) for false suggestion of a connection is insufficient insofar as it fails to set forth the following allegations:

- (1) that applicant's mark is the same or a close approximation of opposer's previously used name or identity;
- (2) that applicant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to opposer;
- (3) that opposer is not connected with the goods that are sold or will be sold by applicant under his mark; and
- (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods, a connection with opposer would be presumed. *See L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956

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<sup>1</sup> Although not required here, it is well settled that standing is also properly alleged by setting forth allegations stating that the plaintiff's applications have been provisionally refused based on the defendant's prior pending application. *See Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

(TTAB 2007); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

In view thereof, Opposer's claim under Section 2(a) is hereby *stricken* with leave to replead. *See* Fed. R. Civ. P. 12(f). Opposer is allowed until **October 22, 2014**, to file and serve on applicant an amended pleading containing a sufficient claim under Trademark Act Section 2(a), if any.<sup>2</sup>

- *Answer*

While Applicant has denied many of the allegations in the notice of opposition, the Board noted that applicant admits that he has not used the mark prior to or after the filing of the application and that the marks are confusingly similar (answer, paragraph 13). In view thereof, because the issue of priority is the only remaining issue, the Board recommended that the parties consider using the Board's Accelerated Case Resolution procedures in this matter (see *infra*).

Insofar as Applicant's allegations regarding the asserted applicability of concurrent use provisions to this proceeding were unclear, affirmative defenses numbers two and five are *stricken*, with leave to replead (see footnote 2, *supra*). *See* Fed. R. Civ. P. 12(f). Applicant is allowed until **November 7, 2014**, to file and serve an amended pleading upon Opposer.<sup>3</sup>

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<sup>2</sup> As regards any amended pleading, Opposer is reminded that under Rule 11 of the Federal Rules of Civil Procedure, Opposer is certifying that all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. *See* Fed. R. Civ. P. 11.

<sup>3</sup> Applicant is referred to TBMP §§ 1101 *et seq.*

Accelerated Case Resolution (“ACR”)

The Board recommended that the parties consider using ACR to resolve this matter. The Board explained that the parties would submit to the Board a stipulation that cross-motions for summary judgment and accompanying evidentiary submissions would substitute for a trial record and traditional briefs at final hearing, that the parties would forego trial, and that the Board may make determinations of genuine disputes of material fact on the basis of the final record and may issue a final ruling based thereon in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence. However, other approaches have been adopted by parties that realize the efficiencies sought through the ACR process and should, therefore, be considered as falling under the ACR umbrella. *See, e.g., Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007), in which the parties stipulated to 13 paragraphs of facts, including applicant’s dates of first use, channels of trade for applicant, extent and manner of applicant’s use, recognition by others of applicant’s use, as well as the dates, nature and extent of descriptive use by the opposer’s parent; and the parties stipulated to the admissibility of business records, government documents, marketing materials and internet printouts.<sup>4</sup>

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<sup>4</sup> By way of example only, the parties may view ACR related stipulations and orders in the following cases: 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history).

Information concerning use of ACR in Board proceedings is available online at [http:// www.uspto.gov/trademarks/process/appeal/index.jsp](http://www.uspto.gov/trademarks/process/appeal/index.jsp).

The parties are allowed until **NOVEMBER 7, 2014** (the date on which initial disclosures are due) from the mailing date of this order to file a stipulation to have this proceeding decided by ACR, failing which the proceeding will move forward on the schedule set forth in the Board's July 30, 2014 institution order, commencing with the initial disclosures due date.<sup>5</sup>

### Stipulations

Various stipulations may be agreed to by the parties, either during the course of the conference or during the pendency of the proceeding. By way of example, the parties may agree or stipulate *in writing* to the following measures to facilitate the progress of this proceeding:

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;<sup>6</sup>

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<sup>5</sup> Should the parties decide to use ACR, the remaining schedule in the proceeding will be reset.

<sup>6</sup> Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. *See* TBMP §§ 403.01 and 501.02 (2014).

- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- Testimony affidavits of witnesses may be submitted instead of testimony depositions;
- That documents are deemed authenticated; and/or
- That a notice of reliance can be filed after the testimony periods are closed.

See TBMP §§ 403.01, 501, 704.03(b) and 705 (2014).

***The parties agreed to service by email of filings with the Board or other papers in the proceeding.***

Standard Protective Agreement

The Board also reminded the parties that the Board's standard protective agreement applies to this proceeding and may be modified by the parties in writing.

*Should the parties modify the standard agreement, the Board requests that the parties identify which clause or provision has been modified.*

Initial Disclosures

***Until the party seeking to serve discovery or to file a motion for summary judgment has served its initial disclosures, discovery may not be served, nor may a summary judgment motion be filed.***

Should the parties seek additional information on initial disclosures, they may obtain additional information regarding initial disclosures at the following sources:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf)

and to <http://edocket.access.gpo.gov/2006/pdf/06-197.pdf>, or to

[http://www.uspto.gov/trademarks/process/appeal/RULES01\\_17\\_06.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf). See

Notice of Final Rulemaking (“Miscellaneous Changes to Trademark Trial and Appeal Board Rules”) in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006) (pages 2498 and 2501).

#### Evidence

The parties are also reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.<sup>7</sup> *It is also recommended* that the parties promptly discuss the exchange of electronically stored information (“ESI”) should such a need arise during discovery.

#### Trial Schedule

Trial dates remain as previously set on July 30, 2014.

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<sup>7</sup> “While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request.” *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D.Pa. 2007) (addressing law firm’s failure to preserve temporary electronic files). See also *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) (“ESI must be produced in Board proceedings where appropriate, notwithstanding the Board's limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings” (internal citations omitted)).