

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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DUNN

Mailed: April 10, 2015

Opposition No. 91220510

*EIR NYC LLC*

*v.*

*Jason Coleman and Jason Anfield*

**Elizabeth A. Dunn, Attorney (571-272-4267):**

On April 9, 2015, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were Luke DeMarte, attorney for Opposer, Nicholas Wells, attorney for Applicants, and Elizabeth Dunn, attorney for the Board.<sup>1</sup> Opposer requested the Board's participation in the conference to discuss whether adoption of ACR (accelerated case resolution) procedures would be appropriate in this proceeding.

At the beginning of the conference, the Board informed the parties that phone conferences may not be recorded, but an order summarizing the discussion would issue. The parties confirmed that there had been no prior communications between the parties, except as necessary to schedule the conference.

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<sup>1</sup> TTAB attorneys Geoffrey McNutt and Michael Webster, and Opposer attorney Michelle Kouba, also attended the conference.

## RELATED PROCEEDINGS

As set forth in the institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding, or a civil action, which involve related marks or issues of law or fact which overlap with this case.

## SETTLEMENT

Unlike the federal courts, the Board does not take an active role in promoting settlement. As discussed, because its jurisdiction is limited to registrability determinations, the Board's role in settlement is limited. The Board has no authority to enforce settlement provisions regarding the use of marks.

The Board is liberal in granting stipulations to suspend proceedings to allow settlement discussions, and is available to discuss whether prospective amendments to the opposed application or subject registration would be acceptable. Stipulations to suspend the proceeding should be filed promptly because, absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *See Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (“[I]t is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay.”).

## PLEADED CLAIM

Opposer pleads priority of use and likelihood of confusion between the parties' marks as used on their respective goods. Applicant filed an answer denying the salient allegations of the notice of opposition.

Applicant's App. Serial No. 86335393 alleges bona fide intent to use	Opposer's App. Serial No. 86496296 alleges December 2012 first use dates
SURF MUD	SURF MUD
concealers for skin, face and body; cosmetic preparations for protecting the skin from the sun's rays; cosmetic sun-protecting preparations; cosmetic sunscreen preparations; waterproof sunscreen	non-medicated skin care preparations

Inasmuch as the marks are identical and the goods are related, the parties agreed that this proceeding likely will turn on the single issue of priority of use.

#### ACR (ACCELERATED CASE RESOLUTION) PROCEDURES

Inasmuch as this case goes forward only as to a very limited issue, the Board recommends adoption of ACR (accelerated case resolution) procedures. *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1266 fn9 (TTAB 2008) (“ACR is a procedure akin to summary judgment in which parties can receive a determination of the claims and defenses in their case promptly, but without the uncertainty and delay typically presented by standard summary judgment practice. In order to take advantage of ACR, the parties must stipulate that, in lieu of trial, the Board can resolve any material issues of fact ... After the briefs are filed, the Board will issue a decision within fifty days, which will be judicially reviewable as set out in 37 CFR §2.145.”).

The Board informed the parties of basic information regarding the use of ACR procedures to expedite this proceeding, and the availability of ACR options set

forth on the TTAB's webpage at [www.uspto.gov](http://www.uspto.gov), and reviewed some common provisions. A sample ACR agreement is attached.

The parties may sign and file the agreement, or, if the parties wish to revisit the issue of ACR after they exchange initial disclosures and/or discovery responses, they should call Board Attorney Elizabeth Dunn. In addition, the Board will entertain any stipulations designed to save the parties time and money, such as stipulating to facts, agreeing to a shortened schedule of disclosure, discovery, and trial, and stipulating as to the admissibility of evidence.

#### ARRANGEMENTS FOR DISCLOSURE, DISCOVERY AND TRIAL

The scope of the pleadings determines the scope of discovery. See Fed. R. Civ. P. 26(b)(1) ("Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense...").

The parties are encouraged to reduce discovery expenses by expanding initial disclosures, and the parties are expected to promptly respond to discovery requests, and to consult Chapter 400 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2014) before refusing to provide any requested information.

Since the parties are located in different countries, the parties are urged to confer early in discovery on the scheduling of any depositions, to give as much notice as possible of planned depositions, to list the subjects for deposition in some detail, and to bring up any issues which could result in a witness refusing to answer in advance of the depositions. As discussed, the Board attorney listed at the top of the order is available by phone to confer with the parties on contested discovery issues.

The parties remain free to stipulate to an abbreviated schedule or alternate forms of evidence. Absent such stipulation, the Board's current schedule and rules define applicable deadlines and evidentiary requirements.

**SCHEDULE REMAINS AS SET**

Absent an agreement by the parties to change the schedule, the schedule set forth in the Board's February 4, 2015 institution and trial order remains in effect.

Opposition No. 91220510

Opposition/Cancellation No.

Plaintiff [insert name]

v.

Defendant [insert name]

**AGREEMENT FOR ACCELERATED CASE RESOLUTION**  
(U.S. parties, both represented by counsel, no counterclaim)

The parties, in order to obtain a decision on the merits of their claims and defenses on an expedited basis, agree to the following ACR (accelerated case resolution) procedures, as indicated by the signatures of the parties' attorneys. The terms are binding from the date of signature. The dates listed herein run from the date the Board approves this agreement.

**COMMUNICATIONS**

The parties will provide each other with a current phone number and email address, and will regularly check both phone and email for messages related to this proceeding.

The parties will use ESTTA for Board filings.

The parties will serve each other by email.

Upon the Board's initiative, the parties may use email to the assigned Board attorney for scheduling phone conferences with the Board or submitting papers necessary to facilitate a phone conference. Email shall NOT be used for Board filings.

The parties will modify this ACR agreement by stipulation.

Where stipulation is not feasible, and this has been confirmed by communication between the parties, the parties will use email or phone to request a phone conference with the Board to resolve contested matters, providing the Board with two options for scheduling the conference.

As necessary, the Board may reset the schedule set forth in this order to reflect motions practice or extensions, but whenever possible, the Board will rule on motions at the conference with the parties, without a change in the schedule. The Board's oral rulings will be followed by a summary order.

#### DISCOVERY CONFERENCE

If the discovery conference was not conducted separately, the discussion which led to the filing of this ACR agreement is the substitute for the discovery conference.

#### DISCLOSURES

Within TEN DAYS, the parties will serve initial disclosures.

The parties agree that no expert testimony or reports will be offered, so no expert disclosures will be scheduled.

The parties waive pretrial disclosures.

#### DISCOVERY SCHEDULE

Within TWENTY DAYS, the parties will serve each other with a proposed stipulation of facts. Inasmuch as this serves the same purposes as requests for admission, the parties agree no requests for admission will be served.

Within THIRTY DAYS, the parties will serve each other with discovery requests. There shall be no more than twenty-five each of interrogatories and requests for the production of documents.

Within FORTY-FIVE DAYS, the parties will serve discovery responses.

Within SIXTY DAYS, the parties will serve notice of, and take, no more than two discovery depositions, and discovery will close.

Within SIXTY DAYS, the parties will serve any motions to compel, requesting a conference with the Board as indicated above.

Within SEVENTY-FIVE DAYS, the parties will file the joint stipulation of facts.

#### TRIAL AND BRIEFING

The parties agree to forego trial, and stipulate that they will file ACR briefs with accompanying evidence on the schedule set forth below, and these filings will be treated as the final record and briefs.

No notice of reliance is necessary, and the parties may submit material usually filed with a notice of reliance (pleaded registrations, third party registrations, written disclosures or disclosed documents, discovery responses, documents produced in discovery, Internet evidence, printed publications and official records), by submitting the evidence with the ACR brief.

The parties reserve the right to object to evidence on substantive grounds such as competency, relevancy or materiality, or the weight to be accorded particular items of evidence.

The parties agree to forego motions to strike and will raise evidentiary issues in their ACR briefs.

The parties may submit declarations or affidavits in lieu of testimony depositions, subject to the right of the other party to seek cross-examination.

Failure to seek cross-examination does not preclude the other party from arguing in its ACR brief that the declaration or affidavit is inconsistent, lacks corroborative detail, or otherwise merits little evidentiary weight.

Where oral depositions are conducted, the parties may participate by electronic means (the witness must appear in person for administration of the oath).

#### TRIAL AND BRIEFING SCHEDULE

Plaintiff's notices of deposition served	Within FIFTEEN DAYS of close of discovery
Plaintiff's trial depositions conducted:	Within TWENTY DAYS of the close of discovery
Plaintiff's ACR brief and evidence, including transcripts, filed	Within THIRTY DAYS of the close of discovery
Defendant's notices of deposition served	Within FIFTEEN DAYS of service of plaintiff's ACR brief and evidence
Defendant's trial depositions conducted	Within TWENTY DAYS of service of plaintiff's ACR brief and evidence
Defendant's ACR brief and evidence, including transcripts, filed	Within THIRTY DAYS of service of plaintiff's ACR brief and evidence

Plaintiff's notices of deposition served	Within FIVE DAYS of service of defendant's ACR brief and evidence
Plaintiff's rebuttal depositions conducted	Within TEN DAYS of service of defendant's ACR brief and evidence
Plaintiff's ACR reply brief and evidence, including transcripts, filed	Within FIFTEEN DAYS of service of defendant's ACR brief and evidence

The parties may request an oral hearing pursuant to Trademark Rule 2.129(a).

**DECISION**

The parties agree that the Board will expedite determination of this matter, generally issuing a final decision on the merits within fifty days of the due date for the reply brief or the oral hearing (if one has been requested), and will decide it in accordance with the evidentiary burden at trial, that is, by preponderance of the evidence. The Board will decide disputed facts as part of the final decision.

**APPEAL**

The Board's decision in this ACR proceeding is final, and judicially reviewable as set forth in Trademark Rule 2.145.

_____ Attorney for plaintiff Signature and date	_____ Attorney for defendant Signature and date
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