

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 3, 2015

Opposition No. 91220956

Sanjay Agarwal

v.

Unique Photo, Inc.

Robert H. Coggins,
Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the Board conducted a discovery conference in this proceeding at 9:00 a.m. EDT on June 2, 2015. Board participation was requested by Opposer. During the conference, Opposer was represented by Bruce Sales and Daniel Laine, and participating for the Board was the above-signed Interlocutory Attorney.

Although Applicant, an individual, did not personally participate in the conference, three representatives of Applicant's corporation (Zlatin Zlatev, Legal Advisor; Raj Bahl, Managing Director; and Sumit Agarwal, General Manager of Aegis Vision Limited) were, under the circumstances of this case, allowed to listen to the conference. The Board explained that while a party may represent himself, individuals who are not attorneys generally

are not recognized to practice before the Board. Patent and Trademark Rule 11.14(b). While U.S. attorneys are permitted to represent others before the Board (*see* Patent and Trademark Rules 11.1 and 11.14(a)), foreign attorneys who reside and practice in a foreign country other than Canada and who are not members in good standing of the bar of the highest court of a state in the United States may not practice before the Board unless they establish that they meet the requirements of Patent and Trademark Rule 11.14. 5 U.S.C. §§ 500(b) and (d). Any such attorney who attempts to represent a party in a trademark matter should be advised that he or she must file a written application for reciprocal recognition with the Office of Enrollment and Discipline and pay the fee required by 37 C.F.R. § 1.21(a)(1)(i); that the application must be filed and granted prior to representing a party before the USPTO; and that the application must include proof that the attorney or agent is in good standing with the foreign patent or trademark office in the country in which the attorney or agent resides, that the attorney or agent is possessed of good moral character and reputation, and that the USPTO Director has recognized that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys. 37 C.F.R. §§11.14(c) and (f). *See* TMEP §§ 602.03 *et seq.*

Inasmuch as Messrs. Zlatev, Bahl, and (Sumit) Agarwal did not meet any of the qualifications or exceptions for representing Applicant before the Board, they were not allowed to conduct business during the conference;

however, they were permitted to listen to the general and specific information discussed by the other conference participants.

Familiarity with the Board

Opposer stated that it is familiar with *inter partes* proceedings before the Board.

Similar Proceedings

Opposer stated that it is not involved in any other Board proceeding or civil litigation involving the subject or pleaded marks.

Nature of Board Proceedings

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, disclosures, discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, 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.

Representation

Applicant is permitted to represent himself. However, it should be noted that while Patent and Trademark Rule 11.14 permits a person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney (as defined by Patent and Trademark Rule 11.1) who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties.

Resources

The Board pointed to the electronic resources, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, available on the Board's home page at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab.html>. Sections 400-800 of the TBMP will be of the most interest to the parties: Chapter 400 describes disclosures, written discovery, and discovery depositions; Chapter 500 describes motions practice; Chapter 600 describes settlement; and Chapter 700 describes trial procedure and introduction of evidence. Other information is available on the Board's home page, including links to the trademark statute, the Board's standard

protective order, Accelerated Case Resolution options, and the Office's FOIA page for access to Board case summaries.

Both parties have used the ESTTA filing system (<http://estta.uspto.gov>) and appear to be familiar with it. Addresses can be changed easily and consented motions can be filed in ESTTA, usually generating an immediate, automatic order granting the motion.

TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) contains the record for the proceeding. It is recommended that the parties periodically check the database to make sure they have received all orders and copies of all filings. Board records are public and any person may look at the filings in any proceeding.

Settlement

Opposer stated that the parties had not yet had settlement discussions due to the difficulty of communicating directly with Applicant. Opposer is open to and has ideas for achieving settlement; and, to that end, Opposer suggested that one of Applicant's unofficial representatives contact Opposer after the conference. Mr. Zlatev agreed to contact Mr. Sales once the Board conference ended.

Opposer was reminded that the Board is generous with periods of extension or suspension to facilitate settlement discussions. After the deadline for initial disclosures has passed, the parties may use the "consent motions" option in ESTTA to automatically obtain a consented extension or suspension of time, if further time is needed. Prior to the deadline for initial

disclosures, the parties should use the ESTTA “general filings” option and attach a proposed schedule with the desired new deadlines.

Service of papers

Opposer was reminded of its obligation to serve each paper filed with the Board. The Board stated that, as a practical matter, parties located outside the United States must meet the service requirement through Trademark Rule 2.119(b)(5) or (b)(6). *See* TBMP § 113.04. At present, Applicant must effect service upon Opposer via transmission by overnight courier.

Pleadings

Upon review of the notice of opposition, the Board noted that Opposer had sufficiently pleaded its standing and a single ground for opposition, namely, priority and likelihood of confusion. The Board noted that Opposer’s pleaded registrations were not currently of record; as a result, priority is still at issue. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Upon review of the answer, the Board noted that Applicant had fairly and clearly met the allegations in the notice of opposition. The Board construed the paragraphs of Applicant’s affirmative defenses as amplifications of Applicant’s denial of the allegations in the notice of opposition. Applicant is reminded that he must include his telephone number on each filing. *See* TBMP § 106.02.

Discovery

Opposer was reminded that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.¹

The Board's Standardized Protective Order

The Board reminded Opposer that the Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. Trademark Rule 2.116(g). The Board stated that Applicant, as a party representing himself, may not have access to certain material given a level of higher designation of confidentiality should it be used by Opposer. The Board reminded Opposer that parties may substitute a stipulated protective agreement (signed by both parties), but that the Board generally does not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order. *See* TBMP § 412.02. Opposer stated that it does not intend to use a substitute protective order.

Scope of discovery

The Board briefly mentioned the use of interrogatories, requests for admission, requests for production of documents and things, and depositions as discovery devices. Under the current pleadings, discovery should focus on priority and likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). The parties should easily

¹ Of course, not all subject matters discussed in § 414 will be applicable to the single ground alleged in the present case. *See* "scope of discovery" discussion, *infra*.

ascertain which *du Pont* factors are relevant and further concentrate discovery on those factors. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (need only consider those factors which are relevant). Information about the various *du Pont* factors may also assist the parties in crafting a mutually agreeable settlement.

The Board noted that inasmuch as Applicant is a foreign resident, Opposer should review TBMP §§ 404.03(b) and (d) if it wishes to take the deposition of Applicant. The Board asked Opposer to consider efficiencies with any prospective deposition of Applicant, such as deposition by video-conference or telephone.

Although priority is still at issue, the Board mentioned that priority could easily be removed as an issue - as to those marks and respective goods and services covered in the pleaded registrations - by Opposer's making its registrations of record during the appropriate time (i.e., upon summary judgment or during its testimony period); however, introduction of the registrations would not remove priority as an issue for Opposer's alleged common law rights, should Opposer wish to also rely thereon.

Electronically stored information

In general, production of electronically stored information ("ESI") is not an issue in Board cases, likely due to the Board's limited jurisdiction to determine only the right to a registration and due to the public nature of

trademarks. However, if the parties anticipate or encounter a problem, they should work together to resolve the matter.

Initial disclosures

Initial disclosures are: 1) the identity of witnesses likely to have discoverable information and 2) the description and location of documents and things having or containing relevant information. More particularly, and as provided for by Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii), those disclosures are:

(i) the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;

(ii) a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

The current deadline for initial disclosures is July 4, 2015. Disclosures should not be filed with the Board except under specific, limited circumstances. *See* Trademark Rule 2.120(j)(8). The Board reminds the parties that discovery may not be served, or a motion for summary judgment filed, until the serving or moving party has made initial disclosures (except that a summary judgment motion may be filed prior to initial disclosures only in connection with limited circumstances which do not appear to be at issue in this case). *See* TBMP § 528.02.

Accelerated Case Resolution (ACR)

The Board mentioned the possibility of accelerated case resolution (ACR), and stated that this case appears to be a good candidate for ACR; however, Opposer was not inclined to pursue ACR at this time. If the parties agree to pursue ACR or other efficiencies, the parties are to contact the Board for further discussion and administration. The parties were referred to TBMP § 702.04 and to the “ACR & ADR” section of the Board’s home page for more information on ACR.

Schedule

Dates remain as previously reset. For the parties’ convenience, the current schedule is reproduced below.

<u>Discovery Opens</u>	<u>6/4/2015</u>
<u>Initial Disclosures Due</u>	<u>7/4/2015</u>
<u>Expert Disclosures Due</u>	<u>11/1/2015</u>
<u>Discovery Closes</u>	<u>12/1/2015</u>
<u>Plaintiff's Pretrial Disclosures</u>	<u>1/15/2016</u>
<u>Plaintiff's 30-day Trial Period Ends</u>	<u>2/29/2016</u>
<u>Defendant's Pretrial Disclosures</u>	<u>3/15/2016</u>
<u>Defendant's 30-day Trial Period Ends</u>	<u>4/29/2016</u>
<u>Plaintiff's Rebuttal Disclosures</u>	<u>5/14/2016</u>
<u>Plaintiff's 15-day Rebuttal Period Ends</u>	<u>6/13/2016</u>

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

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(b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.