

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: June 19, 2015

Opposition No. 91221006 (parent)
Opposition No. 91221007

Clasado Inc.

v.

EpitoGenesis, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On June 19, 2015, Opposer (represented by Martin Schiffmiller of Kirschstein Israel Schiffmiller & Pieroni PC), Applicant, *pro se*, and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding these proceedings 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. Opposer advised the Board that there were settlement discussions with Applicant's prior attorney, but that the parties did not resolve the matter. The parties informed the Board that there is no related Federal court case, but there is a related Board

proceeding, Opposition No. 91221980. The parties were reminded to file a consented motion to suspend should they decide to engage in settlement negotiations.

The parties were also 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

The Board noted Opposer's claim of likelihood of confusion as to its pleaded trademark "BI²MUNO and design" for a variety of pharmaceutical and veterinary products in the nature of a dietary supplements and nutritional additives, and Applicant's applied-for marks, B-MUNE and BE-IMMUNE, for "nutraceuticals for boosting the immune system, dietary supplements, pharmaceutical preparations for treating and preventing infectious diseases, cancer, allergies and autoimmune diseases." The Board also mentioned that priority is no longer an issue because Opposer submitted proof of status and title for its pleaded registration. *See King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation").

Regarding Applicant's affirmative defenses, the First Affirmative Defense, *i.e.*, failure to state a claim, was *stricken* because the notices of opposition do set forth a claim upon which relief may be granted. *See The Wet Seal, Inc. v. FD Management*,

Inc., 82 USPQ2d 1629, 1639-40 n.21 (TTAB 2007) (it is sufficient to generally plead likelihood of confusion claim). *See also* Fed. R. Civ. P. 12(f). Moreover, a motion to dismiss was not filed with the answers, as stated in the answers. As to Applicant's Second Affirmative Defense, *i.e.*, that Opposer's claims are barred by the equitable defenses of laches, acquiescence,¹ waiver,² and estoppel, said defenses are generally not available in opposition proceedings;³ and Applicant has not set forth any allegations to support the conclusory allegation regarding those defenses. Further, Applicant has not filed a counterclaim for fraud against Opposer's registration. In view thereof, Applicant's reference to fraud is improper. *See* Trademark Rule 2.106(b)(2)(ii). In view of the foregoing, the Second Affirmative Defense was also *stricken*. *See* Fed. R. Civ. P. 12(f).

¹ With respect to an opposition, the affirmative act involved for acquiescence or estoppel must lead the defending party to believe that the potential opposer will not oppose *registration* of the mark at issue. *See DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993) ("it is well settled that [a]cquiescence and estoppel require some affirmative act by opposer which led applicant to reasonably believe that opposer would not oppose applicant's registration of its mark").

² By "the doctrine of waiver," the Board assumes that Applicant is attempting to assert a defense based on "estoppel by agreement" or "contractual estoppel," *i.e.*, that a prior agreement between the parties estops Opposer from filing the present opposition. *See, e.g., M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001), and cases cited therein.

³ *See, e.g., National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904 (TTAB 2005); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 n.3 (TTAB 1999) (the U.S. Court of Appeals for the Federal Circuit has held that in trademark opposition and cancellation proceedings, laches begins to run when the mark in question is published for registration).

Nonetheless, Applicant is allowed until **THIRTY DAYS** from the date of this conference to submit an amended answer comprising, if relevant, well-pleaded equitable defenses of laches, acquiescence, waiver, and/or estoppel. As regards any amended pleading, Applicant is reminded that under Rule 11 of the Federal Rules of Civil Procedure, Applicant is certifying⁴ 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.

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:

- Emailed service of papers filed with the Board and between the parties;
- 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;⁵

⁴ The U.S. Supreme Court has held that the Rule 11 certification standard for a party is the same as that for an attorney. *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.*, 498 U.S. 533, 547 (1991) (*cited in Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210 (TTAB 2001).

⁵ 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

- 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 serve copies by email of any submissions to the Board and of any papers exchanged between the parties or served on the adverse party.

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.

agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. See TBMP §§ 403.01 and 501.02 (2014).

The Board also discussed the parties' obligation to provide "core information" in initial disclosures, that is, the names of persons with discoverable information and the type of information that the disclosing party may use to support its claims or defenses. The purpose is to avoid unnecessary discovery on basic information such as dates of first use of a party's mark, customers, channels of trade, how the mark is used, evidence of actual confusion, and the like, that is *reasonably available* to the disclosing party (see January 17, 2006 publication regarding the proposed rules; Federal Register, Vol. 71, No. 10 [71 FR (page) 2498]) [see http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf (page 2501)]. Specifically, the parties are obligated to *identify the names of individuals* who might who have extensive knowledge and might testify to support claims or defenses, and *the location and type of documents* that the disclosing party may use to support its claims or defenses.

The parties are reminded that initial disclosures are not to be filed with the Board, but the Board must be notified that the parties have exchanged disclosures of expert witnesses later in proceeding. Initial disclosures have to be *in writing and signed and served* on the other party.

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 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. 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 were also reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.⁶ *It is also recommended* that the parties promptly discuss the exchange of electronically stored information (“ESI”) should such a need arise during discovery.

Accelerated Case Resolution (ACR)

The Board recommended that the parties consider using ACR procedures in this matter.

If the parties decide to use ACR, 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

⁶ “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)).

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.⁷ Information concerning use of ACR in Board proceedings is available online at the following URL:

[http:// www.uspto.gov/trademarks/process/appeal/index.jsp](http://www.uspto.gov/trademarks/process/appeal/index.jsp).

Trial Dates Reset

As discussed, Applicant is allowed to submit an amended answer in this proceeding no later than **THIRTY DAYS** from the date of the discovery conference. In view thereof, trial dates, including the opening of the discovery period, are reset as shown in the following schedule:

Time to File Amended Answer	7/19/2015
Discovery Opens	7/19/2015
Initial Disclosures Due	8/18/2015

⁷ By way of example only, the parties may view ACR related stipulations and orders in the following cases: 91214266 (see nos. 5, 7 and 13); 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history). The parties are directed also to review *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015).

Expert Disclosures Due	12/16/2015
Discovery Closes	1/15/2016
Plaintiff's Pretrial Disclosures Due	2/29/2016
Plaintiff's 30-day Trial Period Ends	4/14/2016
Defendant's Pretrial Disclosures Due	4/29/2016
Defendant's 30-day Trial Period Ends	6/13/2016
Plaintiff's Rebuttal Disclosures Due	6/28/2016
Plaintiff's 15-day Rebuttal Period Ends	7/28/2016

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

