

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

GMM

Mailed: August 8, 2015

Opposition No. 91221951

Geoffrey, LLC

v.

Hair Are Us, Inc.

David Mermelstein, Administrative Trademark Judge:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(g)(1)–(2), the parties to this case conducted a discovery conference with Board participation. The parties agreed to hold the telephonic discovery conference with Board participation at 10:00 a.m. EDT on Thursday, July 30, 2015. Timothy Pecsénye and Megan Spitz appeared as counsel for Opposer and Harry Tapias appeared as counsel for Applicant. Pursuant to the parties' request, David Mermelstein, Administrative Trademark Judge, and Geoffrey McNutt, Board Interlocutory Attorney, participated in the conference.

During the discovery conference, the parties advised the Board that there have been no substantive settlement discussions prior to the telephone conference. The parties further advised that there are no related Board proceedings or federal district court actions concerning issues related to this case. The Board urges the

parties to consider settlement early in the case to maximize the savings of time and resources for both the parties and the Board.

Pleadings

The Board reviewed the pleadings. Opposer has asserted claims of likelihood of confusion, and dilution. Opposer's allegations regarding its standing and its asserted claims appear to be sufficiently pleaded, except that Opposer's reference to Section 43(a) of the Trademark Act in paragraph 21 of the notice of opposition is improper because the Board is not authorized to decide questions of infringement or unfair competition. *See Andersen Corp. v. Therm-O-Shield International, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (Board may not entertain any claim based on Section 43(a) of the Trademark Act); TBMP §102.01 (2015). Opposer is not required to amend its pleading, however, because paragraph 21 also properly references Section 2(d) of the Trademark Act as a ground for opposition.

The Board then reviewed Applicant's answer to Opposer's notice of opposition and found that Applicant has denied the salient allegations in the notice of opposition. Applicant also asserts the following affirmative defenses: (1) Applicant's applied-for mark is not likely to cause confusion (§§ 27–31); (2) Opposer's purported mark is a generic phrase (§ 32); and (3) Applicant's applied-for mark is not likely to dilute Opposer's marks (§ 33). Although not properly considered affirmative defenses, the Board construes Applicant's §§ 27–31 and 33 as amplifications of Applicant's denial of the corresponding allegations in the notice of opposition and thus sees no harm in allowing these "defenses" to remain since they provide

Opposer more complete notice of Applicant's position regarding Opposer's asserted claims.

On the other hand, the Board finds improper Applicant's affirmative defense alleging that Opposer's mark is generic. (§ 32) A defense that attacks the validity of a registration pleaded by Opposer must be raised as a counterclaim. Trademark Rule 2.106(b)(2)(i)–(ii); TBMP § 311.02(b). The Board therefore strikes Applicant's affirmative defense of genericness. If it wishes to do so, Applicant is allowed **twenty days** from the mailing date of this order to submit an amended answer and counterclaim specifying which of Opposer's pleaded registrations are the subject of the counterclaim.¹

Finally, the Board advised the parties that any motion for leave to amend a pleading to add a new claim or defense must be filed promptly after the facts supporting the new claim or defense are discovered.

Board's Standard Protective Order

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies.² Additionally, the Board stated that if the parties wish to modify the Board's standard protective order, they may attempt to do so by filing a motion for Board approval. The Board further reminded the

¹ The fee for a counterclaim is \$300 per class for each registration to be cancelled.

² A Board opposition is a public proceeding. Accordingly, the parties should designate as confidential only those parts of their filings which genuinely comprise non-public information protected under the standard order. When a document containing confidential information is filed, the filer must also submit a redacted copy of the filing for the public file.

parties of their obligation to produce a privilege log in accordance with Fed. R. Civ. P. 26(b)(5) when information otherwise discoverable is withheld notwithstanding the protective order.

The Board further advised the parties that under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no authority to enforce the protective order. According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties and their attorneys must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although it may be desirable to do so. It is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007). Thus, the parties and their attorneys may find it advisable to sign a stipulated protective order, so that it is clear that they are bound by it; that they have created a contract which will survive the proceeding; and that there may be a remedy for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any determination of whether the agreement

establishes contractual rights or is enforceable outside of the Board proceeding is for an appropriate tribunal to decide should such matter come before it. *Id.*

Discovery and Motion Practice

The Board then noted that the exchange of discovery requests may not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f), nor may a party file a motion for summary judgment until it has made its initial disclosures, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board.

The parties are limited to seventy-five interrogatories, including subparts. *See* Trademark Rule 2.120(d)(1); TBMP Section 405.03. There is no rule limiting the number of document requests or requests for admission that a party may serve, but the parties are reminded that each party “has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case.” TBMP § 408.01. The Board may limit excessive or inappropriate discovery upon a motion for a protective order.

Additionally, the Board expects parties and their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not do so. *See* TBMP § 408.01. If either party plans to file a motion to compel discovery, the moving party must first confer with the other party in good faith to attempt to resolve or narrow the discovery dispute, and then must demonstrate its good-faith efforts as part of its motion to compel.

The Board also provided the parties instructions as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). In such disclosures, the parties should provide to each other

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 [and] 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.

Fed. R. Civ. P. 26(a)(1)(A)(i)–(ii). The parties should *not* file their respective initial disclosures (or any discovery) with the Board except as permitted under Trademark Rule 2.120(j)(8).

To the extent either party plans to use an expert witness, such party must make their expert witness disclosure by the set deadline, and provide the Board with notification that the party will be employing an expert. The Board, in its discretion, may suspend proceedings to allow the parties to take discovery of a designated expert witness or to allow a rebuttal witness.

Pretrial Disclosures

Pretrial disclosures are governed by Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under Trademark Rule 2.121(e), however, does not substitute for service of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). Additionally, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

The Board also encouraged the parties to cooperate and confer with one another in advance of trial with respect to the scheduling of testimony depositions.³

Finally, the Board advised the parties of the variety of options available to streamline the introduction of evidence at trial, including, for example, stipulations of fact, stipulations permitting trial testimony by means of written declaration (with

³ Because discovery and trial depositions can be taken anywhere in the United States (and sometimes abroad), they often require a substantial dedication of time and funds. The parties should attempt to schedule them in a way that is most convenient and economical for the witnesses and for both parties' counsel. It should be a very rare occasion when a deposition schedule becomes the subject of motions practice.

or without reserving the right to live cross-examination), and stipulations permitting the introduction of various documents (e.g., documents produced in response to document requests, business records, etc.) by notice of reliance.

Service of Papers

The parties agreed to accept service of papers by e-mail.⁴ Opposer indicated that it may be served at the following email addresses: pecsenye@blankrome.com, spitz@blankrome.com, and mhomyk@blankrome.com; and Applicant indicated it may be served at the following email addresses: harry.tapias@loigica.com, camilo.espinosa@loigica.com, and tiffany.disney@loigica.com. The Board noted that since the parties have agreed to service by email, they are not entitled to the additional five days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by mail. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013).

Additionally, it is strongly recommended that the parties file papers (including confidential filings) via ESTTA, the Board's electronic filing system.⁵ The parties

⁴ The Board also uses email when sending decisions, orders, or other notices to the parties. The Board will send email to the parties at the addresses they have provided, so it is essential that the parties promptly update their email and street addresses with any change. It is the parties' responsibility to take any necessary steps to ensure that papers from opposing counsel or the Board are not rejected by their spam filters. Where possible, it is strongly recommended that the Board's domain and that of opposing counsel be put on a "safe-senders list" of email which should not be rejected by a filter.

⁵ If the parties have questions about electronic filing or experience difficulties, they may call the Board's main number at (571) 272-8500 or (800) 786-9199 (toll free). The Board's Customer Service Representatives are available to assist filers from 8:30 a.m. until 5:00 pm Eastern time, Monday through Friday. Filers are urged to plan ahead and to attempt to file well before any deadline. The Board cannot guarantee that any technical problem will be resolved quickly, and deadlines will not normally be extended in such a case. If ESTTA filing is not possible for any reason, parties must file by mail. *See* TBMP § 110 (certificate of

should not file consented motions to extend time prior to the deadline for initial disclosures by employing the “consented motion forms” in ESTTA. Instead, the parties should use the “general filing forms” option.

Accelerated Case Resolution

Finally, the Board advised the parties of the Board’s Accelerated Case Resolution (“ACR”) process. As already noted, the Board allows the parties to stipulate to a variety of deviations from the Board’s rules in order to streamline discovery and testimony. Indeed, if the parties so stipulate, they could avoid a formal trial altogether and instead submit their case on filings similar to summary judgment motions, including declarations and documentary evidence. Although the Board may not decide disputed issues of fact when considering a motion for summary judgment,⁶ the parties may stipulate to the submission of such briefs and evidence in lieu of trial and agree that the Board may make any factual determinations based on such a record. If the parties agree to ACR relatively early in the proceeding, they could realize a very significant saving in time⁷ and cost. More information about the Board’s ACR options can be found on the Board’s

mailing procedures).

⁶ While Board litigants are permitted to move for summary judgment under Fed. R. Civ. P. 56, the parties are reminded that trademark disputes (including questions of likelihood of confusion and dilution) are often heavily fact-bound. As a result, the Board frequently denies motions for summary judgment. If the parties desire a resolution of the case short of a full trial, they are urged to consider ACR, rather than a motion for summary judgment.

⁷ Because ACR records are usually more compact than those presented on formal testimony and notices of reliance, the Board can usually render a final decision more quickly.

website.⁸ If the parties have questions about their ACR options, they are urged to contact Mr. McNutt, the assigned interlocutory attorney.

⁸ See <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.