UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

EJW

Mailed: September 24, 2015

Opposition No. 91222795

Consorzio Tutela Vini Emilia

v.

Molinos IP S.A.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On September 21, 2015, Opposer (represented by Paolo Strino of Gibbons PC), Applicant (represented by Janice Housey of Symbus Law Group LLC), 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. With respect to settlement, the parties explained that they had not yet conducted

any settlement discussions. 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 three claims, namely, that the marks are primarily geographically deceptively misdescriptive under Trademark Act Section 2(e)(3), that the marks are deceptive under Section 2(a), and likelihood of confusion. All three claims are sufficiently pleaded. The Board also noted that Opposer submitted information on its pleaded certification mark from the USPTO TSDR database, as well as information regarding the region of Emilia in Italy. The Board reminded Opposer that only the printouts regarding its registration are considered evidence of record in the proceeding.

The Board also noted that Applicant admitted that it does not produce and does not intend to produce wine in the geographic area of Emilia in Italy.

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;[1]
- 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 (2015).

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.*

[1] 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 (2015).

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** 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 are also reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.[2] *It is also recommended* that the parties promptly discuss the exchange of electronically stored information ("ESI") should such a need arise during discovery.

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[2] "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).

Accelerated Case Resolution (ACR)

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

http:// www.uspto.gov/trademarks/process/appeal/index.jsp.

Trial dates remain as set in the Board's last order mailed July 14, 2015.

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[3] 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).