

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

wbc

Mailed: September 23, 2015

Opposition Nos. 91222824 (parent)  
91222914

Jordan Older

v.

Qualtrics, LLC

**Wendy Boldt Cohen, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on September 22, 2015.<sup>1</sup> Participating in the conference were Opposer, Jordan Older,<sup>2</sup> Applicant's attorneys, Scott Sinor and Jessie Pellant, and Board interlocutory attorney Wendy Boldt Cohen.

*Consolidation*

As a preliminary matter, Applicant filed motions to consolidate these proceedings, in each proceeding on September 15, 2015. Opposer was given time during the call to respond to those motions and objected thereto. After

---

<sup>1</sup> Opposer requested Board participation on September 8, 2015.

<sup>2</sup> The Board reminded the parties that a party may act in its own behalf in a proceeding before the Board, or an attorney or other authorized representative may represent the party. *See* Trademark Rule 11.14(e) ("Any individual may appear in a trademark matter for: (1) A firm of which he or she is a member, (2) A partnership of which he or she is a partner, or (3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.").

Opposition Nos. 91222824 and 91222914

considering the parties' comments, because the same parties are involved in Opposition Nos. 91222824 and 91222914 each concerning the same or similar marks, Applicant's motion is **granted**. The above-captioned proceedings are hereby consolidated. *See* Fed. R. Civ. P. 42(a); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 & n.1 (TTAB 1993); TBMP § 511 (2015). Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See* Fed. R. Civ. P. 42(a); TBMP § 511 (2015); *see, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delay. The newly consolidated proceedings may be presented on the same record and briefs. The record will be maintained in Opposition No. 91222824 as the "parent" case. Except as otherwise noted herein, the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as such in the case caption as set forth above. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by

Opposition Nos. 91222824 and 91222914

the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See* 9A Wright, Miller, Kane & Marcus, *Fed. Prac. & Proc. Civ.* § 2382 (3d ed. 2012).

To the extent Applicant is required to file an amended answer in these proceedings (see discussion below), Applicant should file its answer to the notices of opposition, *separately* in each proceeding by the date indicated in the schedule below. Thereafter, all motions and papers should be filed in the parent case.

*Discovery Conference*

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov>. The Board reminds the parties that they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminded the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties indicated that they have not engaged in settlement negotiation but will do so after the conference call. The parties are reminded that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

The Board discussed accelerated case resolution (ACR) and urged the parties to discuss it further at a later date. Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of this proceeding, including: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration. The parties are directed to review the Board's website regarding ACR and TBMP §§ 528.05(a)(2) and 702.04. If the parties later agree to pursue ACR, they should notify the interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

*Stipulations/Filings*

The parties agreed to service pursuant to Trademark Rule 2.119(b)(4). Because the parties have stipulated to accept service by first class or express mail, with a courtesy by email to the parties' email addresses of record, the parties may take advantage of the five additional days for service provided under Trademark Rule 2.119(c).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at: <http://estta.uspto.gov>. Throughout this proceeding, the parties should review

Opposition Nos. 91222824 and 91222914

the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"). The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure.

The Board has reviewed the pleadings in this case.

*Notices of Opposition*

In the notices of opposition, Opposer, appearing *pro se*, has adequately pleaded his standing. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (2014). That is, the statements in the notices of opposition allege facts which, if proven, would show a personal interest in the outcome of each proceeding and a reasonable basis for a belief of damages. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In each notice of opposition, Opposer alleges that he owns Registration Nos. 4742690 and 4738030 and application Serial No. 96427515 for the mark VOCALIZE; that he began use of the term VOCALIZE on the internet in 1998; that “no one else had ever had a website named Vocalize or used the term Vocalize for a service before that time”; that Applicant is interested in using the VOCALIZE mark; and that Applicant’s mark will confuse customers and will

dilute the distinctive quality of Opposer's mark. In view thereof, Opposer has adequately set forth a claim of likelihood of confusion<sup>3</sup> under Trademark Act § 2(d), 15 U.S.C. § 1052(d).<sup>4</sup> *See In re E. I. du Pont de Nemours*, 177 USPQ 563; *King Candy Co.*, 182 USPQ 108; TMEP § 1207.01 *et seq.* Likelihood of confusion is the only ground properly pleaded in the notices of opposition.

Notwithstanding the foregoing, Opposer has not numbered the paragraphs in its notices of opposition. *See* TBMP § 309.03(a)(2) ("All averments should be made in numbered paragraphs"). Inasmuch as Opposer has separated each paragraph and the contents of each paragraph appears to be limited, as practicable, to a statement of a single set of circumstances thereby allowing Applicant to separately admit or deny each paragraph, the Board accepts the notices of opposition and does not herein require Opposer to replead. *See* Fed. R. Civ. P. 10(b); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974).

### *Answers*

---

<sup>3</sup> A mark may be refused registration under Section 2(d) of the Lanham Act where it: [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

*See* 15 U.S.C. § 1052(d). To allege a valid ground of opposition under Section 2(d), an opposer need only allege it has priority of use and that the applicant's mark so resembles opposer's marks as to be likely to cause confusion. *See* Lanham Act § 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

<sup>4</sup> To the extent Opposer relies on his registrations, priority will not be an issue in this case if Opposer properly makes of record status and title copies of his pleaded registrations. *See* Trademark Rule 2.122(d)(2); *King Candy Co.*, 182 USPQ 108.

In each of its answers, Applicant included arguments regarding the merits of the allegations in the notices of opposition and did not, as to *each* allegation contained in the complaint, specifically admit or deny each allegation. A defendant should not argue the merits of the allegations in a complaint in its answer. *See* Trademark Rule 2.106(b)(1); TBMP § 311.02(a).

Applicant admits Opposer has obtained the pleaded registrations and filed the pleaded application; admits Opposer has applied for a Utah state trademark registration no. 9294372-0190; and denies Opposer has used its mark in Utah or that Opposer's date of first use is in 1998. However, Applicant has neither admitted nor denied the remainder of the allegations contained in Opposer's notices of opposition. *See* TBMP § 311.01(a). Inasmuch as Opposer has failed to specify whether it denies or admits the remainder of the salient allegations in the Applicant's notices of opposition, the Board gives Opposer until **October 25, 2015** to file amended answers, separately in each opposition proceeding, which specifically denies and/or admits each of the allegations made in Applicant's notices of opposition.<sup>5</sup>

---

<sup>5</sup> Inasmuch as Applicant has failed to number each of its paragraphs, in its amended answers, Opposer may repeat Applicant's language therein, followed by Opposer's admission or denial of said language, so as to clearly identify the language subject to the admission or denial.

The Board also makes the following observations. In its original answers, Applicant's first affirmative defense claims Opposer has failed to state a claim for which relief can be granted. For the reasons already noted herein, Opposer has adequately pleaded its standing and its claim of likelihood of confusion.

In Applicant's second affirmative defense, it attempts to reserve the right to raise additional defenses at a later date which is not an affirmative defense inasmuch as it attempts to "[reserve] the right to amend the Affirmative Defenses as necessary." This merely paraphrases Fed. R. Civ. P. 15 and does not include an affirmative defense.

*Pro Se Information*

Opposer has indicated that he intends to represent himself in this proceeding. While Patent and Trademark Rule 10.14 permits any person to represent himself, persons who are not acquainted with the technicalities of the procedural and substantive law involved in Board *inter partes* proceedings are advised to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, Opposer is advised that, under Patent and Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

*See also* Fed. R. Civ. P. 11(b); TBMP § 527.02.

Opposer is reminded that Trademark Rules 2.119(a) and (b) require that every submission filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the submission will be considered by the Board. Consequently, copies of all submissions which the parties may subsequently file in this proceeding must be

Opposition Nos. 91222824 and 91222914

accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

*Schedule*

Dates are reset as follows:

Time to Answer each Notice of Opposition	<b>10/25/2015</b>
Discovery Opens	<b>11/24/2015</b>
Initial Disclosures Due	<b>12/24/2015</b>
Expert Disclosures Due	<b>4/22/2016</b>
Discovery Closes	<b>5/22/2016</b>
Plaintiff's Pretrial Disclosures	<b>7/6/2016</b>
Plaintiff's 30-day Trial Period Ends	<b>8/20/2016</b>
Defendant's Pretrial Disclosures	<b>9/4/2016</b>
Defendant's 30-day Trial Period Ends	<b>10/19/2016</b>
Plaintiff's Rebuttal Disclosures	<b>11/3/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/3/2016</b>

The Board thanks the parties for their participation.