

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

Mailed: November 3, 2015

Opposition No. 91222962

Heart of Success, Inc.

v.

Angel Quintana

**George C. Pologeorgis,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the parties to this proceeding conducted a discovery conference with Board participation.¹

The parties agreed to hold the telephonic discovery conference with Board participation at 2 p.m. Eastern time on Tuesday, November 3, 2015. The conference was held as scheduled among Francine D. Ward, as counsel for Opposer, Anthony M. Verna III, as counsel for Applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

This order memorializes what transpired during the conference.

¹ Applicant requested Board participation in the parties' discovery conference by telephone on October 22, 2015.

Settlement and Related Board or District Court Actions

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

Pleadings

The Board reviewed the pleadings and indicated that Opposer has alleged a claim of likelihood of confusion under Section 2(d) of the Trademark Act as the sole ground for opposition. The Board finds that Opposer's allegations regarding its standing, as well as its asserted claim of likelihood of confusion, are sufficiently pleaded.²

On September 22, 2015, Applicant filed an answer which denies the salient allegations set forth in Opposer's amended pleading filed on September 11, 2015.

During the telephone conference, the parties stipulated that the marks at issue are identical for likelihood of confusion purposes. Accordingly, the parties should refrain from propounding any discovery regarding the similarities of the parties' respective marks.

² The Board noted that Opposer attached certain exhibits to its amended notice of opposition filed on September 11, 2015. The Board advised that these exhibits are not evidence of record and, to the extent Opposer wishes to rely on these exhibits as evidence, Opposer must submit this evidence during its assigned testimony period under appropriate Board rules. To the extent Opposer is required to authenticate these documents, Opposer may do so by stipulation of the parties or through witness testimony during Opposer's assigned testimony period.

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. Additionally, if the parties wish to modify the Board's standard protective order, they may do so by filing a motion for Board approval.

Further, under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. 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, however, 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, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it

is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court 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 a court to decide should such matter come before it. *Id.*

Discovery and Motion Practice

The Board then noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). 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 Section 408.01.

Additionally, the Board advised the parties that if either party plans to file a motion to compel discovery, the moving party must first contact the Board by telephone (with the adverse party on the line) so that the Board can ascertain whether the moving party has demonstrated a good faith effort in resolving the discovery dispute before filing its motion.³ The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the

³ The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. *See* TBMP Section 408.01.

parties, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board.

The Board also provided the parties instruction 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 following information:

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) and (ii). The parties **should not** file their respective initial disclosures with the Board.

The Board also noted that, to the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend proceedings for the sole purpose of allowing the parties to take discovery of a designated expert 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 37 CFR § 2.121(e), however, does not substitute for issuance of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). Further, 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.

Service of Papers

The parties declined to stipulate to accept service of papers by e-mail. Accordingly, service of all papers in this matter should be made by first-class mail,

however, the parties may serve courtesy email copies of their respective filings, as well as any written discovery.

Additionally, it is recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA. The parties should not file consented motions to extend time prior to the deadline for initial disclosures by employing the "consented motion forms" in ESSTA. Instead, the parties should use the "general filing forms" option.

Finally, the Board advised the parties of the Board's accelerated case resolution ("ACR") process. While the parties declined to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, if appropriate.⁴

Trial Schedule

Trial dates remain as reset by Board order dated September 17, 2015.

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

⁴ Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at the Board's website. *See* <http://www.uspto.gov/trademarks/process/appeal/index.jsp>

The Board would like to thank counsel for their professional decorum and cooperation during the discovery conference.