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: January 21, 2016

Opposition No. 91223663

Salt Life, LLC

v.

Vincent Giovannetti

George C. Pologeorgis,
Administrative Trademark Judge:

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 1:00 p.m. Eastern time on Thursday, January 21, 2016. The conference was held as scheduled among J. Parks Workman, as counsel for Opposer, Anthony M. Verna III, as counsel for Applicant, and the above-signed Administrative Trademark Judge.

This order memorializes what transpired during the conference.

[1] Applicant requested Board participation in the parties' discovery conference via telephone on January 19, 2016.

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 or state court actions concerning issues related to this case.

Board's Jurisdiction

The Board is an administrative tribunal that is empowered solely to determine the right to register and which has no authority to determine the right to use a mark or any infringement or unfair competition issues and no injunctive authority. *See* TBMP § 102.01 (2015). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, document requests, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. As the plaintiff, Opposer has the burden of establishing its asserted claims at trial by a preponderance of the evidence. *See ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007); *Genesco Inc. v. Martz,* 66 USPQ2d 1260 (TTAB 2003).

Pleadings

The Board reviewed the pleadings and indicated that Opposer, in its amended notice of opposition filed on October 8, 2015, has alleged claims of likelihood of confusion under Section 2(d) of the Trademark Act and dilution as grounds for

opposition. The Board finds that Opposer's allegations regarding its standing, as well as its asserted claims of likelihood of confusion and dilution, are sufficiently pleaded.

On November 9, 2015, Applicant filed his answer to Opposer's amended pleading which denies the salient allegations set forth in Opposer's amended notice of opposition.

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. Because the Board's standard protective order is automatically imposed on this proceeding, the parties are precluded from objecting to any discovery on the ground of confidentiality.

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. The Board also advised the parties how the amended Federal Rules of Civil Procedure, which became effective December 1, 2015, will affect Board proceedings, particularly discovery. The Board recommended that the parties review the amended rules, as well as the accompanying advisory notes to the amended rules.

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.[2] The Board also advised that a motion to compel must be filed prior to the commencement of Opposer's assigned testimony period, as originally set or as reset. *See* Trademark Rule 2.120(e).

The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board. Further, a party may move for summary judgment only on a pleaded claim or defense. Moreover, as with a motion to compel, a motion for summary judgment must be filed prior to the opening of Opposer's assigned testimony period, as originally set or reset. *See* Trademark Rule 2.127(e).

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[2] 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.

Initial Disclosures

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.

Expert Witness Disclosures

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.

Testimony

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial,

periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.[3] *See* Trademark Rules 2.122 and 2.123; *see generally* Chapter 700 of the TBMP.

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, Priority Mail Express, or overnight courier; however, the parties also agreed to 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 did not or could not stipulate to pursue ACR at

[3] The parties are advised that, if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence by way of a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

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 January 5, 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. 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.

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

[4] Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at the Board's website. *See* http://www.uspto.gov/sites/default/files/trademarks/process/appeal/Accelerated_Case_Resolution__ACR__notice_from_TTAB_webpage_12_22_11.pdf