

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

BUO

Mailed: April 19, 2016

Opposition No. 91224067

Larry Paletz

v.

Tielsa GmbH

Benjamin U. Okeke, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a timely discovery and settlement conference on Friday, April 15, 2016. See TBMP § 401.01 (2014). At Opposer's request, a member of the Board participated in the conference. Participating were Opposer, Larry Paletz, appearing *pro se*,¹ Applicant's counsel, Daniela Fuessel, and Board interlocutory attorney, Benjamin U. Okeke.

The Board apprised the parties of the general procedural rules and guidelines that govern *inter partes* proceedings, including the Board's liberal granting of motions to

¹ Mr. Paletz indicated that he did not foresee retaining counsel for this matter at the present time. However, Mr. Paletz is again encouraged to seek counsel. If Mr. Paletz later retains counsel, an appearance should promptly be filed with the Board, indicating the new correspondence information for the retained counsel.

suspend for settlement efforts, and the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests (*see* Trademark Rule 2.120(a)(3)). The Board also advised Opposer that he is well-advised to retain experienced trademark counsel to represent him in Board proceedings. In any event, both parties will be expected to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in Trademark Rule 2.119, regardless of whether they are represented by counsel.

The parties indicated that there is no other pending litigation between them, or any third parties, concerning this mark in federal court or before the Board. The parties had not engaged in settlement talks prior to this call, but were directed to promptly schedule a call to discuss settlement possibilities and other issues.

Standard Protective Order

The Board informed the parties of the automatic imposition of the Board's standard protective order in this case. Trademark Rule 2.116(g). The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

The Board also informed the parties of the unique issue raised by confidential documents designated "for attorney's eyes only" in a proceeding involving *pro se* parties: if Opposer elects to move forward in this proceeding representing himself, Opposer may be precluded from receipt of discovery documents so designated. However, the parties are cautioned that designation of any confidential documents should be in good faith, and only when necessary to protect matter that is in fact confidential.

If the parties wish to add or modify any provisions of the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

Pleadings

The Board reviewed the pleadings with the parties:

A. Notice of Opposition²

Larry Paletz (“Opposer”) opposes registration of the mark TIELSA, in standard characters, in Application Serial No. 79143534, filed by Tielsa GmbH (“Applicant”), for use in connection with various electronic, medical, furniture, and building products in International Classes 9, 10, 19 and 20, and sinks and other appliances in International Class 11; and for use with computer and medical services in International Classes 38 and 44.³

Opposer’s ESTTA-generated coversheet indicates a claim of likelihood of confusion under Trademark Section 2(d), 15 U.S.C. § 1052(d), as grounds for opposition of the involved application.

Opposer has sufficiently pleaded his standing to bring this action by pleading prior use and common law rights in the mark “tielsa THE EXCLUSIVE KITCHEN” for use

² Opposer has filed three notices of opposition in this proceeding, the most recent being filed January 27, 2016 on consent of the parties. Accordingly, Opposer’s consented motion for leave to file a third amended pleading in this proceeding is **GRANTED**, and Opposer’s third proposed amended pleading is now his operative pleading in this matter.

³ Filed September 11, 2013, as a request for an extension of protection of an international registration to the United States under Trademark Act Section 66(a), 15 U.S.C. § 1141(a) (“Madrid Protocol”). The foreign registration upon which registrant based its underlying application is OHIM Registration No. 1194384.

with “[f]urniture, kitchen furniture, bathroom furniture, [and] accessories for furniture.” 13 TTABVUE 36, ¶ 58.⁴ In other words, Opposer has established a reasonable belief of damage by asserting proprietary rights and current ownership of a mark that is the same or similar to the applied for mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) (plaintiff may show standing based on common law rights in mark that is distinctive, inherently or otherwise); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (standing based on common law use of mark).

Although the notice sufficiently asserts an allegation of standing, the notice of opposition as currently written is generally improper in form and, due to its unclear narrative nature, deprives Applicant and the Board of the ability to expeditiously identify the issues raised in this matter. *See Fed. R. Civ. P. 12(e)*. Further, it does not contain sufficiently concise allegations supported by factual background to appropriately plead Opposer’s purported likelihood of confusion claim.⁵ Accordingly, Opposer

⁴ Citations to the record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record include the TTABVUE docket entry number and the TTABVUE page number.

⁵ To state a claim of likelihood of confusion under Trademark Act Section 2(d), Opposer must merely allege facts from which it may be inferred that Applicants’ applied-for mark so resembles Opposer’s previously used or registered marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the Applicant and Opposer. *See* 15 U.S.C. § 1052(d); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01.

Opposer also advances allegations regarding Applicant’s use of the mark in commerce. However, Opposer is reminded that unlike applications filed under Section 1, an Applicant under Section 66(a) is not required to use its mark in United States commerce (or declare that the mark is in such use) at any time prior to registration. *See* Trademark Act Section 68(a)(3), 15 U.S.C. § 1141(a)(3); *cf.* Trademark Act Section 66(a), 15 U.S.C. 1141(a) (requiring a declaration of “*bona fide* intention to use the mark in commerce”). Nonetheless, once a registration issues, it is treated much the same as any other registration on the Principal Register. Trademark Act Section 69(b); 15 U.S.C. § 1141(b) (extension of

is directed to promptly file an amended notice of opposition that conforms to the Board's rules regarding the form of pleadings and sufficiently pleads its claim(s), *i.e.* to file a complaint that contains "sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face."⁶ *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Therefore, Opposer should not take this as an invitation to write a thesis or trial brief on its case, but to simply and concisely state the factual basis for its claims, sufficiently pleading the basis of one or more cognizable grounds for opposition.

- *Format*

A complaint need not follow a particular format, as long as it meets the requirements of Trademark Rule 2.126(a) for paper submissions and includes the necessary information.⁷ The complaint should include the following information:

- a) **Heading:** The complaint should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD."

protection under the Madrid Protocol has the same force and effect as a registration on the Principal Register).

⁶ In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556.

⁷ A party using ESTTA can complete and submit a notice of opposition or petition for cancellation over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a filing. Opposer is encouraged to open the link titled "short and plain statement of the claim" found during the filing process within the online filing system on the page entitled "Pleading."

- b) **Identification of subject application or registration:** The heading should be followed by information identifying the application or registration that is the subject of the complaint with the wording “Serial No._____.”
- c) **Name of proceeding:** The application number should be followed by the name of the proceeding (e.g., “*Larry Paletz v. Tielsa GmbH*”) and the wording “Opposition No. _____.”
- d) **Title of Paper:** The title should describe the nature of the paper (e.g., “Notice of Opposition” or “Petition to Cancel”).
- e) **Plaintiff information:** The complaint should also include plaintiff's name, entity type (e.g., individual, partnership, corporation, association, etc.), and business address; the names of the partners, if the plaintiff is a partnership, or the state or country of incorporation, if the plaintiff is a corporation.
- f) **Substance of complaint:** As discussed, the complaint must also include a pleading of the substance (i.e., standing and grounds) of the complaint. *See* TBMP § 309.03.
- g) **Signature:** The complaint must be signed and include a description of the capacity in which the signing individual signs, e.g., attorney for plaintiff, plaintiff (if plaintiff is an individual), partner of plaintiff (if plaintiff is a partnership), officer of plaintiff identified by title (if plaintiff is a corporation), etc. *See* TBMP § 309.02(b).

A notice of opposition must include (1) a short and plain statement of the reason(s) why Opposer believes it would be damaged by the registration of the opposed mark (i.e., Opposer's standing to maintain the proceeding – *see* TBMP §§ 303.03 and 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition. *See* Trademark Rule 2.104(a); *Young v. AGB Corp.* 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) (standing and grounds are distinct inquiries; allegation of “economic damage” while relevant to standing does not constitute a ground).

A pleading should include enough detail to give the defendant fair notice of the basis for each claim. *See Twombly*, 550 U.S. at 570. The elements of each claim should be stated simply, concisely, and directly, and taken together “state a claim to relief that is plausible on its face.” *See Iqbal*, 556 U.S. 662; TBMP § 503.02.

All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances. *See* Fed. R. Civ. P. 10(b); *Isle of Aloe, Inc. v. Aloe Creme Labs., Inc.*, 180 USPQ 794, 794 (TTAB 1974) (while paragraphs were numbered, none of the paragraphs were limited to a statement of a single set of circumstances). Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded, *e.g.* “LIKELIHOOD OF CONFUSION.” *See* Fed. R. Civ. P. 10(b); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) (“claims must be separately stated We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground”).

A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint. *See* Fed. R. Civ. P. 10(b) and (c).

Evidentiary matters (such as pictures or specimen of use of the mark on the goods claimed, sales records, internet articles, or promotional materials, as included in the present notice of opposition as exhibits) should not be pleaded in a complaint. They are matters for proof, not for pleading. *See McCormick & Co. v. Hygrade Food Prods.*

Corp., 124 USPQ 16, 17 (TTAB 1959). With two exceptions not applicable here, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading the exhibits are attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c). Therefore, the exhibits attached to the amended notice of opposition have been given no consideration.

For a discussion of the grounds for opposition and cancellation, *see* TBMP § 309.03(c) and J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:13 *et. seq.* and §§ 20:52 *et. seq.* (4th ed. 2012), for oppositions and cancellations, respectively.

Opposer is allowed **TWENTY DAYS** from the mailing date of this order to file an amended notice of opposition repleading his claim of likelihood of confusion as appropriate. *See* Fed. R. Civ. P. 15(a); TBMP § 507. If Opposer fails to appropriately amend his notice of opposition within the time allowed, the claim of likelihood of confusion may be stricken, and the notice of opposition dismissed with prejudice.

If Opposer does file an amended pleading pursuant to this order, Applicant is allowed **TWENTY DAYS** from the service of Opposer's amended pleading in which to file an amended answer.

Stipulations/Filings

The parties agreed to service of submissions by email.⁸ The following email addresses are of record:

Submissions may be served on Opposer at the following email addresses:

lifegoodinca@outlook.com; lpaletz@wellmann.com.

Submissions may be served on Applicant at the following email address:

dfuessel@fuessel-law.com.

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

Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

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, available online at: <http://www.law.cornell.edu/rules/frcp/>.

⁸ The parties do not retain the additional five days for response allowed under Trademark Rule 2.119(c).

Accelerated Case Resolution (ACR)

The Board briefly explained the availability and features of the “accelerated case resolution” (“ACR”) process. The parties are encouraged to discuss a modified proceeding and schedule that may be more time and cost efficient. In modifying the proceeding the parties may seek to:

- 1) stipulate to facts, *e.g.* the similarity of certain goods, similarity of the marks, etc.;
- 2) limit the number of interrogatories, document requests, and depositions allowed during the proceeding;
- 3) stipulate to the amount of days after service of responses to document requests that the responding party would have to actually produce and serve any responsive documents;
- 4) stipulate that discovery depositions may be taken by telephone or video conference;
- 5) stipulate that the parties may submit declarations or affidavits in lieu of oral testimony at trial; or
- 6) stipulate that the parties forego trial and oral hearing and submit summary judgment briefs accompanied by any evidence, which may be submitted in the form of declarations or affidavits, and stipulate that the Board may resolve any genuine disputes of material fact and issue a final ruling based on the parties’ ACR submissions.

The parties are directed to review the Board’s website regarding ACR at:

http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp; and

http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution__ACR__notice_from_TTAB_webpage_12_22_11.pdf.

If the parties agree to pursue ACR after exchange of disclosures or discovery (or wish to further discuss their options), they should notify the interlocutory attorney, preferably within **SIXTY DAYS** from the opening of the discovery period.

Contested Motions

The parties are reminded that uncooperative behavior during the discovery process will not be well-taken. *See HighBeam Mktg. LLC v. Highbeam Research LLC*, 85 USPQ2d 1902 (TTAB 2008); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving discovery issues). The Board requires the parties to make a good-faith effort to resolve all discovery issues prior to filing a motion to compel seeking relief from the Board.⁹ *See* TBMP § 408.01(c).

Similarly, the parties should confer before filing any motion to extend or suspend these proceedings. If either party files an unconsented motion to extend or suspend in this case, the moving party must promptly contact the Board interlocutory attorney assigned to the case by telephone upon filing so that such motion can be resolved by telephone conference.

Schedule

The parties are reminded that the next significant due date is **May 25, 2016, when the parties' initial disclosures are due**. *See* Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) regarding required initial disclosures. Neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res*

⁹ Prior to filing any such motion to compel, the parties should first contact the assigned interlocutory attorney by telephone at 571-270-1524 to schedule a telephone conference. The parties should be prepared to discuss the "good faith effort" that has been made to resolve any discovery disputes prior to seeking the Board's intervention.

judicata or lack of Board jurisdiction) should occur until the parties have exchanged their initial disclosures as required by Fed. R. Civ. P. 26(f). *See* Trademark Rules 2.120(a)(3) and 2.127(e)(1).

The Board again thanks the parties for their participation in the conference. As a final matter, the Board reminds the parties of their duty to conduct themselves with decorum and courtesy and encourages open communication between the parties during this proceeding. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

Schedule

The remaining discovery, disclosure, and trial dates are reset as follows:

Initial Disclosures Due	5/25/2016
Expert Disclosures Due	9/22/2016
Discovery Closes	10/22/2016
Plaintiff's Pretrial Disclosures	12/6/2016
Plaintiff's 30-day Trial Period Ends	1/20/2017
Defendant's Pretrial Disclosures	2/4/2017
Defendant's 30-day Trial Period Ends	3/21/2017
Plaintiff's Rebuttal Disclosures	4/5/2017
Plaintiff's 15-day Rebuttal Period Ends	5/5/2017

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

PRO SE INFORMATION

A. Representation

The Board notes that Opposer currently represents himself *pro se*, *i.e.* without assistance from a licensed attorney. It should be noted that, while Patent and Trademark Rule 11.14 permits any party to represent itself, it is advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding 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, as the impartial decision maker, the Board may not provide legal advice, though it may provide general procedural information.

B. Nature of Board Proceedings

An opposition proceeding before the Board is similar in many ways to a civil action in a Federal district court. There are pleadings (notice of opposition, answers, and, sometimes, a counterclaim), a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. Unlike the case in a civil proceeding, the Board does not preside at the taking of testimony. Rather, all testimony is taken by deposition during the assigned testimony, or trial, periods, and the written transcripts, together with any exhibits, 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.

C. Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), the Trademark Act, and the Trademark Rules of Practice, all available on the USPTO website, www.uspto.gov. The TTAB homepage provides electronic access to the Board’s standard protective order, and answers to frequently asked questions. Other useful resources include the ESTTA filing system¹⁰ for Board filings and TTABVUE for status and prosecution history.

Compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

D. Service of Papers

Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or the other party itself, if unrepresented, and proof of such service must be made before the paper will be considered by the Board. Consequently,

¹⁰ Use of electronic filing with ESTTA — as the parties have done so far — is strongly encouraged. This electronic file system operates in real time and provides filers with confirmation that the filing has been received. When papers are filed through ESTTA the papers must still be served on the other party to the proceeding.

If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (EST).

While electronic filing is preferred, papers may also be filed by mail. The parties should refer to TBMP §§ 107-111 for information on filing by mail. If ESTTA filing is not possible for any reason, the filer should submit its papers by mail, with a certificate of mailing. *See* TBMP § 110 *et. seq.*

copies of all papers which the parties may file in this proceeding must be 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.

The following is an example of an acceptable Certificate of Service:

Certificate of Service

The undersigned certifies that a copy of the attached <describe filing> was served, by first class mail, upon opposer at the following address:

Daniela Fuessel
Fuessel Law
475 Washington Blvd
Los Angeles, CA 90292,

on <insert date>.

/Larry Paletz/