

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

EJW

Mailed: March 15, 2016

Opposition No. 91225592

*Broadcom Corporation*

*v.*

*TesSol, Inc.*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

On March 9, 2016, Opposer (represented by Susan Natland and Craig Summers of Knobbe Martens Olson & Bear LLP), Applicant, *pro se* (represented by Craig Andrews), 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, the Board's order regarding Applicant's pleading, and resets the trial schedule in this proceeding.

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 or Board case. Regarding settlement, the parties stated that Opposer had made a settlement offer prior to the

filing of the opposition. The Board reminded the parties to file a consented motion to suspend should settlement negotiations continue.

The parties are 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 claim of likelihood of confusion and informed the parties that not only is the claim sufficient, but also that priority in connection with Opposer's CONNECTING EVERYTHING marks is not at issue in this proceeding insofar as Opposer has attached to the notice of opposition proof of ownership and current status of its three pleaded registrations.

With respect to the answer, Applicant has denied the salient allegations in the notice of opposition, except that Applicant admits that it has not used the applied-for mark in U.S. commerce. Applicant has also set forth numerous "affirmative defenses," which are largely amplifications of its denials of Opposer's allegations. The Board instructed Applicant as follows:

- (1) The evidence incorporated in and attached to Applicant's answer will not be considered by the Board. Except for information on the opposer's pleaded marks, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c).

- (2) Although in its introduction to its affirmative defenses and amplifications Applicant asserts that “Applicant is not collaterally attacking the validity of Opposer’s pleaded registrations” (4 TTABVUE 5), the Board finds that Applicant has effectively attacked Opposer’s registrations in paragraphs 16 and 18, which allege, respectively, that Opposer’s pleaded marks are not appropriately used in commerce and that Opposer’s pleaded mark[s] are a deceptively misdescriptive and self-laudatory term. Under Trademark Rule 2.106(b)(2), an attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration. In view thereof, to the extent these affirmative defenses attack Opposer’s registrations, they are hereby *stricken* and will not be considered. *See* Fed. R. Civ. P. 12(f). In any event, as regards the contention that Opposer’s pleaded marks are deceptively misdescriptive and self-laudatory, inasmuch as Opposer’s pleaded registrations are more than five years old, such allegations do not serve as a basis for cancellation. *See* Section 14(1) of the Trademark Act, 15 U.S.C. § 1064(1). *See also Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1747 n.1 (TTAB 1989) (a petition to cancel a registered mark on the basis that it was merely descriptive and lacked secondary meaning must be filed within five years from the date of the registration of the mark).
- (3) Applicant asserts that Opposer’s claim is barred by the doctrine of unclean hands and, in support thereof, sets forth numerous assertions in paragraphs

25, 26, 27, and 28 of its answer. In those paragraphs, Applicant alleges essentially that Opposer submitted a specimen of use that it does not actually use in commerce and, thus, the specimen submitted to the USPTO and Opposer's assertion of use in commerce were improper; that Opposer's assertion of rights to all combinations of the terms "CONNECT" and "THING" is inequitable conduct; that Opposer is trying to intimidate Applicant by misrepresenting its mark as "famous"; and that Opposer is engaged in trademark misuse in the form of trademark bullying against Applicant, especially because the USPTO has already determined that there is no likelihood of confusion as to the parties' marks and the parties' goods are dissimilar and are marketed to different customers. None of Applicant's allegations constitute a sufficient defense of unclean hands. The Board shall address each set of allegations *seriatim*.

- Paragraph 25

In paragraph 25, Applicant is effectively attacking the validity of Opposer's registration by asserting that Opposer submitted a specimen of use with the underlying application(s) that does not actually demonstrate how its mark is used in commerce and/or that Opposer was not using the mark in commerce at the time Opposer filed its underlying application(s). An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration. Trademark Rule 2.106(b)(2)(ii).

Moreover, to the extent Applicant is alleging that Opposer's specimen of use submitted with its underlying application(s) was "improper," whether a specimen of use was acceptable is an *ex parte* examination issue which does not provide a basis for an *inter partes* claim. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation); and *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the adequacy of specimens is solely a matter of *ex parte* examination). Second, to the extent Applicant is asserting that Opposer knowingly submitted a specimen of use that was not in use in commerce and, therefore, that Opposer improperly alleged use in commerce, Applicant is implying a claim based on fraud, not unclean hands. Any fraud claim must be asserted in a counterclaim and must comply with the requirements set forth in *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). *See also* Fed. R. Civ. P. 9(b).

- Paragraphs 26 and 27

Applicant's allegations in paragraphs 26 and 27 pertain to Opposer's assertions in its demand letter to Applicant stating that Applicant should not use any mark comprising the terms "connect" or "thing," and that its CONNECTING EVERYTHING marks are well-known or famous. Opposer's assertions do not constitute a basis for a finding (at trial) of unclean hands.

Rather, they merely indicate that Opposer was attempting to protect its rights in its registered mark and that Opposer believes specifically that facts related to the likelihood of confusion factors<sup>1</sup> of fame and similarity support its contention that there is a likelihood of confusion between the parties' marks. The Board has previously determined that a similar unclean hands defense is insufficient:

Insofar as respondent asserts that petitioner ... [has] misused petitioner's registrations to violate the antitrust laws and law of unfair competition, there is nothing in respondent's proposed pleading to suggest that petitioner has done anything other than seek to protect its rights in its registered marks, and preclude the registration of what it believes to be a confusingly similar mark, a right which every trademark owner possesses under the Lanham Act.

*Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992) (internal citations omitted).

*See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.4 (TTAB 2002) ("To the extent that this defense is intended as an equitable "unclean hands" defense based on opposer's allegedly overzealous enforcement of its trademark rights, we find that applicant has failed to make out the defense.").

In contrast, "unclean hands" arises in connection with a plaintiff's misconduct related to (i) its use of the mark, such as intentional misuse of the trademark registration symbol to deceive consumers (*see Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007)), or to (ii) its attempt to acquire a registration, such as when a specific misrepresentation of fact was

---

<sup>1</sup> *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

assertedly made which caused the Examining Attorney to allow publication of the opposer's mark (see *Phonak Holding AG v. Resound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000)). See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001). Additionally, the alleged misconduct must be related to the present claim. See *Warnaco Inc. v. Adventure Knits, Inc.*, 210 USPQ 307 (TTAB 1981); *Tony Lama Company, Inc. v. Anthony Di Stefano*, 206 USPQ 176, 179 (TTAB 1980); and *VIP Foods, Inc. v. V.I.P. Food Products*, 200 USPQ 105, 113 (TTAB 1978).

- Paragraph 28

With respect to paragraph 28, Applicant's allegations of "trademark misuse" in the nature of "trademark bullying" are akin to allegations of unfair competition or anti-competitive conduct, rather than "unclean hands." The Board does not consider such issues. Rather, the Board is an administrative tribunal empowered to determine only the right to register. Trademark Act § 17, 15 U.S.C. § 1067. See, e.g., *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269, 1270 n.2 (TTAB 1999) (no jurisdiction over unfair competition claims); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 252 (TTAB 1977) (determination of whether opposer is guilty of unfair business practices is not within the province of the Board); TBMP § 102.01 (2015). Furthermore, the "defense" of "trademark bullying" does not exist. Trademark owners are

entitled to protect rights in their registered trademarks by seeking to preclude registration of what they believe to be confusingly similar marks. *See Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265, 268 (TTAB 1977). The fact that Opposer has opposed registration of unrelated third-party marks and Applicant's applied-for mark based on its pleaded marks merely indicates that Opposer actively polices those marks. Finally, as regards Applicant's contention that the issue of likelihood of confusion has already been determined by the Office, it is well-settled that the Board is not bound by the decision of the Examining Attorney regarding the registrability of Applicant's mark. This is particularly true in an *inter partes* proceeding such as this where generally there is more evidence than was before the Examining Attorney on the issue of likelihood of confusion. *See McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

In view of the foregoing, Applicant's allegations of "unclean hands" are insufficient to support that affirmative defense. Accordingly, paragraphs 25, 26, 27, and 28 are hereby *stricken*. *See* Fed. R. Civ. P. 12(f). However, the Board often allows parties an opportunity to file an amended pleading that meets the applicable standard. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993); and TBMP § 503.03 (2015). Accordingly, Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to submit an amended pleading in accordance with the discussion herein.

As regards any amended pleading, Applicant is reminded that under Rule 11 of the Federal Rules of Civil Procedure, Applicant is certifying that all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. *See Fed. R. Civ. P. 11.*

### Settlement Proposal

The parties discussed Opposer's previous proposal to limit Applicant's identification of goods as a means to resolve this matter. The parties expressed their respective concerns regarding the current identification and proposed changes thereto, and agreed to continue to discuss possible modification of the identification.

### 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 exchanged 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;<sup>2</sup>

---

<sup>2</sup> 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

- 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 via email courtesy copies of documents filed with the Board.**

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.*

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.***

---

agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. *See* TBMP §§ 403.01 and 501.02 (2015).

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](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](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.<sup>3</sup> *It is also recommended* that the parties promptly discuss the exchange of electronically stored information (“ESI”) should such a need arise during discovery.

### Accelerated Case Resolution (ACR)

The Board recommended that the parties consider ACR in this case. 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

---

<sup>3</sup> “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).

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.<sup>4</sup> Information concerning use of ACR in Board proceedings is available online at the following URL:

[http:// www.uspto.gov/trademarks/process/appeal/index.jsp](http://www.uspto.gov/trademarks/process/appeal/index.jsp).

#### Trial Schedule

Insofar as Applicant is allowed thirty days from the mailing date of this order to submit an amended answer, the trial schedule in this proceeding is reset as shown in the following schedule:

---

<sup>4</sup> 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).

<b>Time to File Amended Answer (if any)</b>	<b>4/14/2016</b>
<b>Discovery Opens</b>	<b>4/14/2016</b>
<b>Initial Disclosures Due</b>	<b>5/14/2016</b>
<b>Expert Disclosures Due</b>	<b>9/11/2016</b>
<b>Discovery Closes</b>	<b>10/11/2016</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>11/25/2016</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>1/9/2017</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>1/24/2017</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>3/10/2017</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>3/25/2017</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>4/24/2017</b>

**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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

