

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

RK

Mailed: May 5, 2016

Opposition No. **91226199**

Societe des Produits Nestle S.A.

v.

Cecilia Farell

Yong Oh (Richard) Kim, 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 May 2, 2016. Board participation was requested by Applicant. Andrea Anderson, Esq., of Holland & Hart LLP appeared on behalf of Opposer and Cecilia Farell appeared *pro se*.

Introductory Remarks

At the outset of the conference, the Board informed the parties that a spirit of cooperation and good faith dealing were expected from the parties during the duration of this proceeding and that any points of contention that may arise during the course of the proceeding should be handled through direct communication between the parties and in a spirit of good faith. **The parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties**

have failed to previously conduct at least one telephone conference to resolve the issue.

The Board also noted that telephone conferences with a Board attorney are available as necessary but that both parties would need to be on the call to discuss any substantive matter and that *ex parte* communications with the Board are generally inappropriate.

The parties are instructed to file appearances of counsel and change of correspondence forms as necessary, preferably via ESTTA, the Board's electronic filing system.

Prior Communications and Disputes

Aside from a cease and desist letter from Opposer to Applicant and the scheduling of this conference, the parties have not had any prior communications of note. The Board inquired as to the parties' interest in settling this matter. The parties confirmed they were open to settlement discussions. To encourage and facilitate a potential settlement of this matter, proceedings herein are **SUSPENDED through JUNE 2, 2016**, for settlement discussions.

The Board then inquired as to whether the parties were involved in any other disputes with each other involving the subject mark to which the parties responded in the negative. Applicant further confirmed that her mark was not the subject of any third-party dispute.

Pleadings

In reviewing the notice of opposition, Opposer confirmed that it was only asserting claims of priority and likelihood of confusion and dilution based on the two pleaded registrations as well as common law use. As to Opposer's pleading of the likelihood of confusion claim, however, the Board noted the absence of any allegation concerning the parties' goods and how they contribute to any likelihood of confusion and inquired as to whether Opposer's claim of likely confusion rests largely on the putative similarities of the parties' marks. Opposer denied that it did. The Board, therefore, ordered Opposer to further plead the factual basis of its likelihood of confusion claim so as to provide sufficient notice to Applicant. *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570, 127 S.Ct. 1955, 1974 (2007) (“[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice”).

The amended notice of opposition shall be served and filed no later than MAY 16, 2016. Applicant's answer¹ to the amended notice of opposition shall be served and filed no later than JUNE 13, 2016.

Discovery and Stipulations

The parties were advised that the Board's standard protective order is operative in these proceedings, made applicable by operation of Trademark Rule 2.116(g) and available at <http://www.uspto.gov/trademarks/process/>

¹ Applicant is strongly advised to review the guidance provided at the end of this order concerning the pleading of an answer.

[appeal/guidelines/stndagmnt.jsp](#). Should the parties wish to modify the Board's standard protective order, the parties may negotiate any changes and file a copy of the proposed protective order for Board approval. If the parties wish to acknowledge their obligations under the standard protective order in writing, the parties are referred to the form found at <http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp>.

The parties did not offer or otherwise suggest any potential discovery or testimonial stipulations. The Board encourages the parties to consider ways in which to potentially limit and simplify discovery and testimony through reciprocal disclosures, stipulations of fact, and/or agreements. For instance, the parties may consider greater use of reciprocal disclosures and less use of formal discovery or streamlining their discovery by limiting the number of depositions,² interrogatories, document production requests and admission requests. The parties may also consider simplifying the introduction of evidence into the record such as by stipulating to the authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

Applicant declined to accept service of papers by email. However, the parties agreed to send, via e-mail, courtesy copies of any papers served to the following email addresses:

² Pursuant to Fed. R. Civ. P. 30(a), made applicable to Board proceedings by Trademark Rule 2.116, a party may not seek more than ten discovery depositions without a prior stipulation between the parties or leave of the Board.

To Opposer: docket@hollandhart.com
 aanderson@hollandhart.com
 ejcooper@hollandhart.com
 mamoore@hollandhart.com

To Applicant: uspto@legal-sherpa.com
 tresurchest@aol.com

The parties were advised that the five day grace period afforded them under Trademark Rule 2.119(c) would apply so long as one of the prescribed methods of service³ is utilized and, to that end, were reminded to specify the method of service in the certificate of service.

Alternative Dispute Resolution and Accelerated Case Resolution

The Board informed the parties that mediation and arbitration are outside resources available to the parties to facilitate settlement discussions. Although the Board will not refer the parties to any particular arbitrator or mediator, the Board would be amenable to suspending these proceedings should the parties choose these alternatives to aid in settlement.

Accelerated Case Resolution (ACR) was also discussed as a way to expeditiously obtain a final determination of these proceedings without the time and expense of a full trial. A proceeding that is ideally suited for ACR is one in which the parties anticipate being able to stipulate to many facts, or in which each party expects to rely on the testimony of only one or two witnesses and the overall record will not be extensive.

³ Currently, Trademark Rule 2.119(c) applies to service made by first-class mail, Priority Mail Express®, or overnight courier.

Although neither of the parties expressed an interest in this procedure at this point in the proceedings, the parties are, nevertheless, encouraged to remain open to the procedure, particularly if the parties believe they can simplify these proceedings through the use of factual and evidentiary stipulations. As mentioned during the conference, the parties must mutually agree to ACR as the procedure cannot be instituted unilaterally and there is no procedural mechanism by which an unwilling party can be compelled to engage in ACR. To facilitate the parties' consideration, they are referred to the following for additional information on the procedure:

<http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf>

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution (ACR) FAQ updates 12 22 11.doc)

Conclusion

As noted by the Board during the conference, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

To summarize, **Opposer's amended notice of opposition is due MAY 16, 2016, Applicant's answer to the amended notice of opposition is due JUNE 13, 2016, and proceedings are otherwise SUSPENDED through JUNE 2, 2016, for settlement discussions.** Should the parties

fail to reach an agreement, proceedings herein will resume on **JUNE 3, 2016**, under the following schedule:

Proceedings Resume	6/3/2016
Discovery Opens	6/13/2016
Initial Disclosures Due	7/13/2016
Expert Disclosures Due	11/10/2016
Discovery Closes	12/10/2016
Plaintiff's Pretrial Disclosures Due	1/24/2017
Plaintiff's 30-day Trial Period Ends	3/10/2017
Defendant's Pretrial Disclosures Due	3/25/2017
Defendant's 30-day Trial Period Ends	5/9/2017
Plaintiff's Rebuttal Disclosures Due	5/24/2017
Plaintiff's 15-day Rebuttal Period Ends	6/23/2017

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 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

The record does not reflect that Applicant is represented by legal counsel in this proceeding. While Patent and Trademark Rule 11.14(e) permits any person to represent himself/herself, it is generally 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.

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this proceeding. The Trademark Act, the Trademark Rules of Practice, and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) are all available on the TTAB page of the USPTO website at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. This web page also includes information on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and other relevant topics.

Applicant is reminded that Trademark Rules 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 adversary), and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers that the parties may subsequently file in this proceeding must be accompanied by “proof of service” of a copy on the other party or the other party’s counsel.

“Proof of service” usually consists of a signed, dated statement stating: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and

(4) the date of service. For future reference, a suggested format for the certificate of service is provided below:

I hereby certify that a true and complete copy of the foregoing ***(insert title of submission)*** has been served on ***(insert name of opposing counsel or party)*** by mailing said copy on ***(insert date of mailing)***, via First Class Mail, postage prepaid ***(or insert other appropriate method of delivery)*** to:

(set out name and address of opposing counsel or party)

Signature

See TBMP § 113.

Applicant should further note that any paper she is required to file with the Board should not take the form of a letter; proper format should be utilized. The form of submissions is governed by Trademark Rule 2.126. *See also* TBMP § 106.03. In particular, “[a] paper submission must be printed in at least 11-point type and double-spaced, with the text on one side only of each sheet” and text “in an electronic submission must be in at least 11-point type and double-spaced.” Trademark Rule 2.126(a)(1) and 2.126(b).

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be received by the Board by the due

date, unless one of the filing procedures set forth in Trademark Rules 2.197 and 2.198 is utilized.

In submitting an answer, Applicant is referred to Rule 8(b) of the Federal Rules of Civil Procedure, made applicable to this proceeding by Trademark Rule 2.116(a). Fed. R. Civ. P. 8(b) provides:

(b) **Defenses; Admissions and Denials**

- (1) ***In General.*** In responding to a pleading, a party must:
 - (A) state in short and plain terms its defenses to each claim asserted against it; and
 - (B) admit or deny the allegations asserted against it by an opposing party.
- (2) ***Denials – Responding to the Substance.*** A denial must fairly respond to the substance of the allegation.
- (3) ***General and Specific Denials.*** A party that intends in good faith to deny all the allegations of a pleading – including the jurisdictional grounds – may do so by a general denial. A party that does not intend to deny all the allegations must either specifically deny designated allegations or generally deny all except those specifically admitted.
- (4) ***Denying Part of an Allegation.*** A party that intends in good faith to deny only part of an allegation must admit the part that is true and deny the rest.
- (5) ***Lacking Knowledge or Information.*** A party that lacks knowledge or information sufficient to form a belief about the truth of an allegation must so state, and the statement has the effect of a denial.
- (6) ***Effect of Failing to Deny.*** An allegation – other than one relating to the amount of damages – is admitted if a responsive pleading is required and the allegation is not denied. If a responsive pleading is not required, an allegation is considered denied or avoided.

In accordance with Fed. R. Civ. P. 8(b), it is incumbent on Applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph. If Applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, she should so state and this will have the effect of a denial.

Files of TTAB proceedings can be examined using TTABVue, accessible at <http://ttabvue.uspto.gov/ttabvue>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

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