

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

wbc

Mailed: June 8, 2016

Opposition No. 91226892

Campari America LLC

v.

Skyfish, LLC

Wendy Boldt Cohen, 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 June 7, 2016.¹ Participating in the conference were Opposer's attorney, Joel Feldman, Applicant's attorney,² Joel Henry and Board interlocutory attorney, Wendy Boldt Cohen.

The Board reminds the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is

¹ Opposer requested Board participation on April 25, 2016.

The Board's order of May 9, 2016 regarding a request for oral hearing, for which a request has not been made, is hereby vacated.

² The Board notes the appearance of Applicant's attorney by virtue of his submission of Applicant's answer on April 19, 2016. *See Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1216 (TTAB 2012) (law firm that filed motion to dismiss recognized as counsel of record for respondent); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1613 n.1 (TTAB 1991) (appearance made by filing motion on behalf of respondent). Applicant's attorney was reminded to correct its correspondence address. Applicant confirmed it will correct the correspondence address promptly.

online at <http://www.uspto.gov>. The Board reminds the parties that they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminds the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties indicated that they have engaged in substantive settlement negotiations and are currently negotiating settlement terms. To that end, the parties moved to suspend these proceedings for sixty days which the Board hereby **grants**.

The Board discussed accelerated case resolution (ACR) and urged the parties to discuss it further at a later date. The parties noted that they are interested in ACR and plan to discuss it after receipt of the Board's order. Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of this proceeding, including: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration. The parties are directed to review the Board's website regarding ACR and TBMP §§ 528.05(a)(2) and 702.04. If the parties later agree to pursue ACR, they should notify the

interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

Stipulations/Filings

The parties agreed to service by e-mail only to the emails noted on the record, with Trademark Rule 2.119(b)(6) being applicable to such service. The parties were reminded that by making this stipulation, the parties may not avail themselves of the additional five days contemplated by Trademark Rule 2.119(c) afforded to parties when service is made by first-class or express mail. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, 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"). 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.

Pleadings

The Board has reviewed the pleadings in this case. In the notice of opposition, Opposer has adequately pleaded its standing. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (3d ed. rev.2 2013); *see also King Candy Co. v. Eunice King's Kitchen*,

Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). That is, the statements in paragraphs 1-8 of the notice of opposition allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. *See Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Likelihood of Confusion³

Opposer adequately set forth a claim of likelihood of confusion with its alleged prior common law use and registrations for the mark SKYY under Trademark Act § 2(d), 15 U.S.C. § 1052(d), in paragraphs 9-15 of the notice of opposition. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); TMEP § 1207.01 *et seq.* To the extent opposer relies on its registrations, priority will not be an issue in this case because Opposer included with its notice of opposition, status and title copies of its pleaded registrations. *See Trademark Rule 2.122(d)(2); King Candy Co.*, 182 USPQ 108.

³ A mark may be refused registration under Section 2(d) of the Lanham Act where it: [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

See 15 U.S.C. § 1052(d). To allege a valid ground of cancellation under Section 2(d), petitioner need only allege it has priority of use and that respondent's mark so resembles petitioner's marks as to be likely to cause confusion. *See Lanham Act* § 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Dilution⁴

With respect to the dilution claim set for in paragraphs 16-21 of the notice of opposition, Opposer has alleged its SKYY mark became famous before Applicant used or applied to register its SKYYFISH mark; that Applicant's mark is likely to dilute the distinctive quality of Opposer's mark; and that Applicant's use and registration of its mark will likely lessen of Opposer's allegedly famous mark to identify and distinguish Opposer's mark from others. This claim is sufficiently pleaded under Trademark Act § 43(c).⁵ See *Research in Motion Ltd.*, 102 USPQ2d at 1197; *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000); see also *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001).

In its answer Applicant denied the salient allegations of the notice of opposition.

The Board thanks the parties for their participation. As noted, proceedings are suspended for sixty days for settlement negotiations. Because the parties

⁴ Dilution under Section 43(c) of the Act, 15 U.S.C. § 1125(c) requires the following elements: (1) whether the opposer's mark is famous; (2) whether the opposer's mark became famous prior to the date of the application to register the applicant's mark; and (3) whether the applicant's mark is likely to blur the distinctiveness of the opposer's famous mark. *Research in Motion Ltd. v. Defining Presences Marketing Group Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012).

⁵ "Fame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

are negotiating for a possible settlement of this case, proceedings herein are suspended until August 6, 2016, subject to the right of either party to request resumption at any time. *See* Trademark Rule 2.117(c).

If there is no word from either party concerning the progress of their negotiations, proceedings shall resume on August 7, 2016, without further notice or order from the Board, upon the schedule set out below:

Discovery Opens	8/8/2016
Initial Disclosures Due	9/7/2016
Expert Disclosures Due	1/5/2017
Discovery Closes	2/4/2017
Plaintiff's Pretrial Disclosures	3/21/2017
Plaintiff's 30-day Trial Period Ends	5/5/2017
Defendant's Pretrial Disclosures	5/20/2017
Defendant's 30-day Trial Period Ends	7/4/2017
Plaintiff's Rebuttal Disclosures	7/19/2017
Plaintiff's 15-day Rebuttal Period Ends	8/18/2017

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.