

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 26, 2008

Cancellation No. 92049490

Roman Bratasiuk

v.

Clarendon Hills Distribution
(S) Pte. Ltd.

Frances S. Wolfson, 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 disclosure/discovery/settlement conference ("discovery conference") at 2:00 p.m. EST, on August 19, 2008. Board participation was requested by respondent's counsel on August 8, 2008. During the conference, petitioner was represented by Ralph C. Francis, Esq.; respondent was represented by Mary Margaret L. O'Donnell, Esq. and Darren Handler, Esq. Participating for the Board was the above-signed interlocutory attorney along with Peter Cataldo, Administrative Trademark Judge and Cindy Greenbaum, Managing Interlocutory Attorney.

This order memorializes what transpired during the conference. At the outset of the conference, the parties confirmed that they were not involved in other litigation or

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Board proceedings involving petitioner's pleaded mark or respondent's mark in the United States, but are involved in pending overseas litigation and/or administrative proceedings involving the marks.

In accordance with standard Board procedure for conducting a discovery conference, the Board reviewed with the parties the nature of and basis for petitioner's claims; the possibility of settlement; and arrangements relating to disclosures, discovery and introduction of evidence at trial.

Nature of and Basis for Claims and Defenses

This case is brought against registration for the mark CLARENDON HILLS for "wine."¹ Petitioner alleges prior use of the mark CLARENDON HILLS for "wine" and ownership of an application for CLARENDON HILLS for wine (trademark application serial no. 78959167), which has been refused on the basis of respondent's registration.

As grounds for the petition, petitioner alleges a priority and a likelihood of confusion between the parties' marks, a false suggestion of connection between petitioner and respondent caused by the registration;² that respondent

¹ Registration No. 3034382; filed March 10, 2004; registered December 27, 2005, based on respondent's allegation of first use: January 1, 1991, and first use in commerce: October 1, 1995.

² While the complaint indicates this claim has been brought under Section 2(d) of the Trademark Act, petitioner confirmed that it is bringing this claim under Section 2(a).

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is not the owner of the mark; that respondent's use of the mark was not bona fide; and that respondent obtained the registration by fraud. Respondent's answer denies all salient allegations and presents acquiescence, laches, waiver and estoppel as affirmative defenses, contending that petitioner knew respondent was filing for the registration of the mark in respondent's name and helped respondent obtain the registration.

Possibility of Settlement

The parties indicated that they have not previously been engaged in settlement negotiations, but that they would like to explore the possibility of settlement. In view thereof, following the conference, the parties continued to stay on the line after the Board disconnected to further discuss settlement, and the Board has herein suspended proceedings to allow the parties to continue their negotiations.

Arrangements Relating to Disclosures, Discovery and Introduction of Evidence at Trial

The parties agreed to exchange initial disclosures during their settlement period to facilitate discovery and possible settlement. They each agreed to produce information pertinent to the issues of ownership and priority of the mark CLARENDON HILLS, which they agreed were the essential issues in the case, the issue of likelihood of confusion probably not being in controversy. They agreed

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that in the event settlement reaches an impasse, they would strongly consider the use of stipulations to streamline the discovery process, such as stipulations of facts not in dispute and stipulations for introducing information at trial that has been obtained through disclosure or discovery; and that they would consider the use of affidavit authentication of documents produced during discovery. If feasible, they would consider utilizing the Board's ACR (Accelerated Case Resolution) procedures. The Board briefly advised the parties on this option.

The Board suggested the parties agree to accept service of papers by e-mail, but the parties indicated that they did not desire to avail themselves of this option.

The parties made significant progress on the terms of the protective agreement that they agreed to abide by, modifying the Board's standard protective agreement in the following areas, with the Board's approval:

1. Two tiers of confidentiality were substituted for the Board's standard three-tier approach;
2. Disclosure of information under "attorney's eyes only" would be disclosed to outside attorneys, but not in-house attorneys;
3. Inadvertent disclosure of protected or privileged information would not waive the protection or privilege; and

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4. After termination, materials produced under the terms of the agreement would be destroyed by the receiving party.

The parties agreed to modify the agreement in accordance with the above, and submit it to the Board for final approval following its execution (the Board recommends that the parties themselves sign the agreement so as to create a contract between them that survives this proceeding).

Schedule

Because the parties are negotiating for a possible settlement of this case, proceedings herein are suspended until six months from the mailing date of this action, subject to the right of either party to request resumption at any time prior thereto. See Trademark Rule 2.117(c).

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Discovery Opens	5/10/09
Initial Disclosures Due	6/9/09
Expert Disclosures Due	10/7/09
Discovery Closes	11/6/09
Plaintiff's Pretrial Disclosures	12/21/09
Plaintiff's 30-day Trial Period Ends	2/4/10
Defendant's Pretrial Disclosures	2/19/10
Defendant's 30-day Trial Period Ends	4/5/10
Plaintiff's Rebuttal Disclosures	4/20/10

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Plaintiff's 15-day Rebuttal Period
Ends

5/20/10

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

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.