

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

Mailed: February 24, 2010

Opposition No. 92051860

La Montre Hermes S.A.

v.

Michael Akkawi

**Linda Skoro, 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 at 11:00 am EST, on February 23, 2010. Board participation had been requested by respondent. Both parties were represented: Mr. Milton Oliver for respondent and Mr. Andrew Baum for petitioner, and the above-signed participated for the Board.

Counsel for petitioner stated his client was not involved in any other litigation surrounding this mark and counsel for respondent indicated he had not had an opportunity to yet meet with his client, so would inform the Board if he later learns his client is involved in any trademark-related litigation.

The parties stipulated to email service of all filings. The Board notes that when calculating response time, the

agreement to email service alone does not include the five days allowed for delivery by the U.S. Postal Service under Trademark Rule. 2.119(c).

The Board advised the parties as to how it reads the pleadings and the issue presented in the petition for cancellation is likelihood of confusion under Section 2(d) of the Act. Petitioner clarified that its claim of a likelihood of confusion is not only based on its claimed registration, but also on common law rights in marks containing many formatives of the term CAPE COD.

The parties were informed of their burdens of proof regarding priority. The Board noted that respondent's original answer was informal and Mr. Oliver stated that he had just filed a formal answer ten minutes earlier and provided the Board with the ESTTA number: 333619. Thus the issues are joined.

Regarding the issue of priority, the Board wants to point out that the fundamental issue to be decided by the Board is the right to registration, or in this case, continued registration of the trademarks. Registration depends on actual use of the words as a trademark or service mark.<sup>1</sup> Thus, any proof of priority will need to show use of

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<sup>1</sup> A trademark is defined as "any word, name, symbol, or device, or any combination thereof used...to identify and distinguish his or her goods [or services] ... from those manufactured or sold by others ... , or from the services of others and to indicate the

the words as a mark, not just a tradename. The words must be used in connection with the sale of the goods.

Mr. Oliver inquired into the nature of initial disclosures. The Board indicated that it was primarily to provide a starting point for discovery, namely identify any witnesses they know may be appearing as witnesses, identify documents they expect to rely upon. Mr. Baum clarified that it basically follows Fed. R. Civ. P. 26(a)(1) in identifying persons, the categories of documents and their location and any potential third-party witnesses. Further to this point, the parties may want to consult the notice of proposed rule making issued by the Board on January 17, 2006, in volume 71 Federal Register at 2501, which provides a good list of potential items for disclosure. This document is available on the Office web site.<sup>2</sup> Also available on the web site is the Board's manual of practice and procedure (TBMP) as well as the trademark rules of practice.<sup>3</sup> Chapter 400 of the manual discusses discovery and, in particular, section 414 provides selected discovery guidelines of items that have

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source of the services [or goods], even if that source is unknown." 15 U.S.C. § 1127.

<sup>2</sup> The web site address is [www.uspto.gov](http://www.uspto.gov). On the left side of the menu select Trademarks; from the drop down menu selection #7 - TTAB. The 5<sup>th</sup> item in the Rules/Laws box is the proposed rule making notice.

<sup>3</sup> From the TTAB selection, the manual is the 2<sup>nd</sup> item in the policy/procedures box. The Trademark rules of practice can be found off the main Trademark drop down menu, item number 17 "laws and rules" and is the 1<sup>st</sup> item in the laws and regulations box.

been allowed or disallowed by the Board over the years. You will also want to read Chapter 700 in the manual which sets out how evidence is to be introduced.

The Board wants to take this opportunity to remind the parties that the standard protective agreement is already in place to protect any confidential documents needed to be disclosed, and that it can be modified, should the parties so choose. The standard order is also on the web site.<sup>4</sup>

The parties were reminded that initial disclosures are due in thirty days, by March 26, 2010; and, as they are undoubtedly aware, the Board expects cooperation between the parties and to call each other before filing papers with the Board in order to discuss any impasse.

There were no further questions and the conference was concluded. The full trial schedule remains as set in the institution order.

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<sup>4</sup> The 3<sup>rd</sup> item in the "Standard Documents and Guidelines" box.