

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

Mailed: July 27, 2010

Cancellation No. 92052260

Steven Westlake

v.

Edgar Alexander Barrera

Cheryl Goodman, 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 July 23, 2010 at 10:30 am (EDT) with Board participation.<sup>1</sup>

Participating in the conference were Mark Levy and Kevin Guyette, attorneys for petitioner, Steven Westlake, petitioner, and R. Emmett McAuliffe, attorney for respondent. Present for the Board was the above-identified interlocutory attorney.

This order memorializes what transpired during the conference.

The Board reminded the parties that a filing via the Board's electronic filing system, ESTTA, is an integrated filing, and therefore, papers filed via ESTTA must be filed

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and signed by counsel (which includes the ESTTA generated coversheet). See Trademark Rule 2.193.<sup>2</sup>

The Board reminded the parties that all papers filed with the Board must be served on the other side and should include a certificate of service as prima facie evidence of proof of service. Trademark Rule 2.119. The parties stipulated to e-mail service as the primary method of service. The Board advised the parties that no additional time is added to response periods when using e-mail service.

The Board advised the parties of the imposition of the Board's standard protective agreement for confidential information.<sup>3</sup> The Board indicated that the parties may wish to sign the protective agreement to create a contract which will survive the Board proceeding. See TBMP Section 412.03 (2d ed. rev. 2004). The parties were advised that if they

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<sup>1</sup> Respondent's request for Board participation in the discovery conference was made via ESTTA on July 1, 2010.

<sup>2</sup> The Trademark Rules of Practice, codified in part two of Title 37 of the Code of Federal Regulations, 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 Rules are available at the following web address:

<http://www.uspto.gov/trademarks/law/index.jsp>. For information on amended Rule 2.193 in particular see Changes in Requirements for Signature of Documents, Recognition of Representatives, and Establishing and Changing the Correspondence Address in Trademark Cases, (October 26, 2009) at the following web address:

<http://www.uspto.gov/trademarks/notices/index.jsp>. For general information regarding the nature of Board proceedings, see TBMP Section 102 (2d ed. rev 2004). The Board's manual of procedure ("TBMP") can be accessed at the following web address:

<http://www.uspto.gov/trademarks/process/appeal/usingtbmp.pdf>.

<sup>3</sup> The Board's "standard protective agreement" can be viewed using the following web address:

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seek to modify the standard protective agreement, they should file a motion with the Board.

The Board provided the parties with information regarding the nature of the parties' initial disclosures under Fed. R. Civ. P. 26(a)(1)(A) and (B), (Fed. R. Civ. P. 26(a)(1)(C)-(D) are not applicable), which provide for the exchange of basic information about witnesses who may be used to support claims and defenses (i.e., name, address and telephone number of individual with discoverable information along with the subject of the information) and documents (description, category and location which may be used to support claims and defenses, or copies of documents) and general information regarding expert disclosures (governed by Fed. R. Civ. P. 26(a)(2) with respect to testifying witnesses) and pretrial disclosures (governed by Fed. R. Civ. P. 26(a)(3)).<sup>4</sup> The parties were advised that if they seek to waive initial disclosures, they must file a stipulation with the Board. Disclosures are subject to supplementation as set forth under the federal rules of civil procedure.

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<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

<sup>4</sup> For further information regarding disclosures, see the Notice of Final Rulemaking Miscellaneous Changes to Trademark Trial and Appeal Board Rules (August 2007) viewable at the following web address:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf).

**Please note**, the TBMP manual does not include information regarding the 2007 rule changes.

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Notice of service of initial and pretrial disclosures need not be filed with the Board<sup>5</sup>, and generally, initial, expert, and pretrial disclosures are not to be filed with the Board unless they are submitted in connection with a discovery motion, motion for summary judgment, or notice of reliance. Additionally, discovery requests and responses thereto also should not be filed with the Board unless it is in connection with a discovery motion, motion for summary judgment or notice of reliance. The Board informed the parties that formal discovery (i.e., interrogatories, request for production, depositions, request for admissions) may be taken only after service of initial disclosures (unless initial disclosures are waived). Additionally, no summary judgment motion may be filed until after service of initial disclosures.<sup>6</sup>

With regard to the pleadings, the Board noted that no allegations regarding Section 2(a) false suggestion of a connection or deceptiveness claims were set forth in the pleading, although such claims were identified on the ESTTA coversheet. The Board also noted that allegations regarding petitioner's priority (with regard to the Section 2(d)

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<sup>5</sup> However, any party disclosing plans to use an expert must notify the Board that it has made the required disclosure so that the Board may suspend the proceeding to allow for expert discovery, as appropriate.

<sup>6</sup> However, traditional discovery may be served concurrently with the service of initial disclosures. The Board notes that both

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claim) were vague. The Board suggested that petitioner may wish to amend its pleading to clarify the nature of his claims.<sup>7</sup> Exhibits attached to the pleading are not evidence unless properly identified and introduced during the period for taking testimony. TBMP Section 317.

The parties were advised that consent suspension and extension motion forms are available on ESTTA. However, they should not be used until after the deadline for initial disclosures has passed.<sup>8</sup> Prior to that date, the parties should file any motion to extend or suspend in ESTTA as a general filing.<sup>9</sup>

The Board informed the parties of other options available to settle this dispute including third party mediation and arbitration, as well as the availability of accelerated case resolution at the Board, if appropriate. If the parties are interested in accelerated case resolution, they should notify the assigned interlocutory

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parties advised that they have already served interrogatory requests prior to service of initial disclosures.

<sup>7</sup> If the petition to cancel is amended it may be appropriate for the parties to reconvene the discovery conference to discuss any additional claims/defenses after the answer is filed.

<sup>8</sup> The Board recommended that the parties file papers via the Board's electronic filing system, ESTTA. The Board does not accept the filing of papers via e-mail or facsimile. Files of TTAB proceedings can now 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.

<sup>9</sup> In ESTTA, the parties should check the "What's New in ESTTA" alert for further information.

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attorney early in the discovery period so that a revised discovery and briefing schedule can issue.<sup>10</sup>

The Board informed the parties of opportunities to streamline discovery and trial and to save time and expense by providing additional reciprocal initial disclosures, or by stipulating to facts and to the authenticity of documents.<sup>11</sup> The Board further advised that such stipulations should be filed with the Board.

The parties indicated that they were not prepared to discuss settlement at this time.

The Board reminded the parties that if they were not prepared to discuss all the topics identified in the notice of institution<sup>12</sup> at the July 23, 2010 discovery conference, they should schedule a date to reconvene to discuss.

Discovery is now open. Dates remain as last reset (Board's order of May 11, 2010).

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<sup>10</sup> For more information regarding accelerated case resolution go to <http://www.uspto.gov/trademarks/process/appeal/index.jsp> and look for Accelerated Case Resolution, Accelerated Case Resolution FAQ and ACR case list.

<sup>11</sup> The parties were informed of the availability of telephone conferences with the assigned interlocutory attorney to resolve disputes between the parties or to expedite issuance of orders on certain matters.

<sup>12</sup> <http://ttabvueint.uspto.gov/ttabvue/v?pno=92052260&pty=CAN&eno=2>.