

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

Mailed: June 22, 2010

Cancellation No. 92052344

The Unlimited/Alaska Hats &  
Apparel

v.

Arabica Funding, Inc.

**George C. Pologeorgis, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the parties to this proceeding conducted a discovery conference with Board participation.<sup>1</sup>

The parties agreed to hold the telephonic discovery conference with Board participation at 11:00 a.m. Eastern time on Monday, June 21, 2010. The conference was held as scheduled among Roger W. Zak, as corporate representative of *pro se* petitioner, Heather Redmond, as counsel for respondent, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

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<sup>1</sup>An ESTTA request for Board participation in the discovery conference was received from respondent's counsel on June 2, 2010.

This order memorializes what transpired during the conference.

During the discovery conference, the parties advised the Board that no settlement discussions were conducted prior to the conference. Additionally, petitioner's corporate representative stated that, at the current time, petitioner wished to proceed *pro se* in this proceeding without representation by counsel. The Board advised petitioner's corporate representative that inasmuch as petitioner wished to proceed without legal representation at this juncture, petitioner would be required to familiarize itself with all Board procedures, rules and regulations governing this case.

The parties further advised that there are no related Board proceedings, federal district court actions, or third-party litigation concerning the parties' respective applications.

The Board reviewed the pleadings herein and indicated that petitioner has apparently alleged the following claims: (1) a claim of priority and likelihood of confusion under Trademark Act Section 2(d) and (2) a claim of dilution under Trademark Act 43(c). The Board noted that petitioner has not properly pleaded either of its asserted claims. Specifically, although petitioner has properly alleged its standing and priority of use, petitioner has nonetheless failed to allege affirmatively

that the involved marks are similar and the involved goods and services are related and, in view thereof, confusion amongst the relevant consumer base is likely if registrant's registration would continue to exist. Indeed, in order to properly state a claim of likelihood of confusion, plaintiff must plead that (1) the plaintiff's mark, as applied to its goods or services, so resembles the defendant's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. See Fed. R. Civ. P. 8; and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). With respect to the dilution claim, petitioner has failed to allege affirmatively that its mark is famous and that such fame was acquired prior to any commercial use of respondent's mark. See *Panavision Int'l L.P. v. Toeppen*, 141 F.2d 1316, 1324 (9<sup>th</sup> Cir. 1998); *Papa John's Int'l, Inc. v. Rezco*, 446 F. Supp.2d 801, 808 (N.D. Ill. 2006); *ACI Int'l. Inc. v. Adidas-Salomon AG*, 359 F. Supp.2d 918, 922 (C.D. Cal. 2005); cf. *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001) and *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003).

In view thereof, petitioner is allowed the time set forth below in which to file and serve an amended petition to cancel which properly sets forth its intended claims of priority and likelihood of confusion and dilution, failing which the amended petition may be dismissed.

The Board also reviewed respondent's answer to petitioner's originally-filed petition to cancel. The Board noted that respondent's asserted affirmative defenses of laches, estoppel and unclean hands were vague, conclusory and lack specificity inasmuch as respondent did not also provide a factual foundation for such affirmative defenses. Further, the Board noted that respondent's affirmative defense of failure to state a claim upon which relief may be granted is not a true affirmative defense. Moreover, the Board further noted that any affirmative defense which collaterally attacks petitioner's pleaded application would be impermissible. The Board advised respondent that it should be mindful of the foregoing when answering or otherwise responding to petitioner's amended petition to cancel, as ordered herein.

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval. Moreover, the Board noted that inasmuch as petitioner is currently representing itself *pro se* in this case, it would be unable to view documents produced by respondent that have been designated "Highly Confidential - For Attorneys Eyes Only." The Board

advised, however, that petitioner could contest the appropriateness of the "Highly Confidential - For Attorneys Eyes Only" designation by seeking an *in camera* inspection by the Board of such documents designated "FOR ATTORNEYS EYES ONLY" by respondent.

Furthermore, the Board noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). Additionally, the Board advised the parties that if either party plans to file a motion to compel discovery, the moving party must first contact the Board by telephone so that the Board can ascertain whether the moving party has demonstrated a good faith effort in resolving the discovery dispute before filing its motion. The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties.

The Board also provided the parties instruction as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a).

Moreover, the parties agreed to accept service of papers by e-mail, and that petitioner may be served at the following email address: [lureofak@mtaonline.net](mailto:lureofak@mtaonline.net) and that respondent may be served at both of the following email addresses: [Redmond.heather@dorsey.com](mailto:Redmond.heather@dorsey.com) and [bianchi-rossi.deanna@dorsey.com](mailto:bianchi-rossi.deanna@dorsey.com) The Board noted that since the

parties have agreed to service by email, the parties may no longer avail themselves of the additional 5 days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail.

Additionally, the Board recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA.

As noted above, petitioner's pleaded claims are deficient. Accordingly, petitioner is allowed twenty days from the mailing date of this order in which to file and serve and amended petition to cancel which properly sets forth its claims of priority and likelihood of confusion and dilution, failing which the petition may be dismissed. In turn, respondent is allowed twenty days from the date indicated on petitioner's certificate of service of the amended petition to cancel in which to file and serve its answer or otherwise respond to the amended petition to cancel.

Trial dates are reset as follows:

Discovery Opens	8/14/2010
Initial Disclosures Due	9/13/2010
Expert Disclosures Due	1/11/2011
Discovery Closes	2/10/2011
Plaintiff's Pretrial Disclosures	3/27/2011
Plaintiff's 30-day Trial Period Ends	5/11/2011
Defendant's Pretrial Disclosures	5/26/2011
Defendant's 30-day Trial Period	7/10/2011

Ends	
Plaintiff's Rebuttal	
Disclosures	7/25/2011
Plaintiff's 15-day Rebuttal	
Period Ends	8/24/2011

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.

#### **General Information**

The Board is an administrative tribunal empowered to determine only the right to register. See TBMP Section 102.01 (2d ed. rev. 2004). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, document requests, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case.

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and

the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

**Pro Se Information**

Petitioner is reminded that it will be expected to comply with all applicable rules and Board practices during the remainder of this case. 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 cancellation proceeding. Petitioner should note that Patent and Trademark Rule 10.14 permits any person or legal entity to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If petitioner does not retain counsel, then petitioner will have to familiarize itself with the rules governing this proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law

libraries, and may be available at some public libraries. Finally, the Board's manual of procedure will be helpful.

On the World Wide Web, petitioner may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

Petitioner must pay particular attention to Trademark Rule 2.119. That rule requires a party filing any paper with the Board during the course of a proceeding to serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (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.

Also, petitioner should note that any paper it is required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

Files of TTAB proceedings can now be examined using TTAB Vue, accessible at <http://ttabvue.uspto.gov>. After

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entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

The first revision of the second edition (March 2004) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at

[www.uspto.gov/web/offices/dcom/ttab/tbmp/](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/)

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