

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

Mailed: January 21, 2012

Cancellation No. 92053501

Christian M. Ziebarth

v.

Del Taco, LLC

Cheryl S. Goodman, Interlocutory Attorney:

This case now comes up on respondent's motion, filed September 22, 2011, to compel discovery (Interrogatory nos. 1-15, document requests nos. 1-26) and to test the sufficiency of petitioner's responses to its requests for admissions nos. 1-72. Petitioner has objected to the relevancy of these requests. The motion is fully briefed.

Petitioner argues that respondent has not made a good faith effort to resolve the dispute because it did not provide any authority in its letter to petitioner to support its discovery requests.

However, the Board finds that respondent's counsel's statement of good faith effort in the motion, coupled with the correspondence between the parties attached as exhibits, establishes an extremely minimal good faith effort to resolve the dispute.

The Board now turns to the motion.

**Cancellation No. 92053501**

Respondent argues that the disputed discovery requests and requests for admissions seek information regarding adoption, selection and use of the pleaded mark, planned manufacturing, marketing, locations, channels of trade, target markets, target consumer bases and funding channels, as well as whether information and documents exist on these matters, all of which are "relevant to the issue of whether Petitioner did indeed have a bona fide intent to use the mark NAUGLES in commerce when he filed his [trademark] application." Respondent asserts that this information goes to the question of standing, which is based on petitioner's ownership of a pending trademark application. Respondent further asserts that these discovery requests and requests for admissions go to potential equitable defenses such as unclean hands.

Petitioner argues that its relevance objections are proper and that discovery requests and requests for admissions aimed at petitioner's use or intent-to-use his applied for NAUGLES mark are outside the scope of discovery with regard to the abandonment claim, irrelevant to standing, and have no bearing on a potential equitable defenses. Petitioner further asserts that standing has been established by petitioner's ownership of a federal trademark application which has been refused registration based on respondent's NAUGLES mark. Lastly, petitioner argues that

**Cancellation No. 92053501**

respondent has cited to no authority that the equitable defense of unclean hands is proper in a cancellation action based on the ground of abandonment.

In reply, respondent argues that the information it seeks in discovery is necessary to determine and plead appropriate equitable defenses such as fraud and unclean hands. Respondent further argues that seeking discovery on petitioner's lack of bona fide intent to use its applied for trademark is proper as the Board has "previously recognized a petitioner's lack of standing as a valid defense to a cancellation where the petitioner did not [sic] have a lack of bona fide intent to use the mark at the time of filing an application."

Petitioner has pleaded the refusal of his applied for trademark NAUGLES, with respondent's registration cited as the blocking registration, as a basis for standing. The fact that petitioner's intent-to-use application was refused registration based on likelihood of confusion with the mark in respondent's pleaded registration does not preclude respondent from challenging petitioner's assertion in that application that he has a bona fide intent to use his pleaded mark in commerce. *See Kaplan v. Brady*, 98 USPQ2d 1830 (TTAB 2011). Because petitioner bears the ultimate

**Cancellation No. 92053501**

burden of proof on the standing issue<sup>1</sup>, petitioner may be required to go beyond the mere pendency of his applications and establish his entitlement to file the application upon which his standing claim is based. *Id.* Accordingly, respondent's discovery and requests for admissions which seek information which may relate to the question of petitioner's bona fide intent to use the applied for mark NAUGLES (e.g., adoption, selection, use or intended use) are relevant to petitioner's standing).

In view thereof, the motion to compel is granted with respect to interrogatory nos. 1-15; document request nos. 1-26. The motion to test the sufficiency of admissions is granted with respect to request for admission nos. 1-67.

By some of the discovery requests, respondent seeks discovery to develop potential equitable defenses such as unclean hands. However, where the ground for cancellation is abandonment, equitable defenses such as unclean hands, laches, and bad faith are not available in view of the overriding public interest in removing abandoned registrations from the register. *American Vitamin Products*

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<sup>1</sup> A claim that petitioner lacks standing is an argument that may be advanced without first pleading it as an affirmative defense. *See Amanda Blackhorse, Marcus Briggs, Phillip Gover, Jillian Pappan, and Courtney Tsotigh v. Pro Football, Inc.* 98 U.S.P.Q.2d 1633, 1637 (TTAB 2011) (lack of standing is not an affirmative defense but is an element of petitioner's claim); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1788 n.2 (TTAB 2008) (lack of standing is not a true affirmative defense). Standing is an essential elements of the prima facie case which petitioner

**Cancellation No. 92053501**

*Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992).

Accordingly, the motion to test the sufficiency of admissions is denied with respect to request for admission nos. 68-72 inasmuch as these requests go to potential unavailable equitable defenses. These requests are therefore not relevant.

Petitioner is allowed until THIRTY DAYS from the mailing date of this order to serve supplemental written responses to interrogatory nos. 1-15 and document requests nos. 1-26, produce responsive documents or make them available for inspection and copying, and to provide supplemental responses to requests for admissions nos. 1-67.

Proceedings are resumed.

Dates are reset as follows:

Expert Disclosures Due	2/17/12
Discovery Closes	3/18/12
Plaintiff's Pretrial Disclosures	5/2/12
Plaintiff's 30-day Trial Period Ends	6/16/12
Defendant's Pretrial Disclosures	7/1/12
Defendant's 30-day Trial Period Ends	8/15/12
Plaintiff's Rebuttal Disclosures	8/30/12
Plaintiff's 15-day Rebuttal Period Ends	9/29/12

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.

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must establish. That is, petitioner must prove its standing as a threshold matter in order to be heard on its substantive claims.

**Cancellation No. 92053501**

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.