

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

DUNN

Mailed: December 1, 2011

Cancellation No. 92054551

Andrey Pinsky

v.

Douglas Burda

Elizabeth A. Dunn, Attorney (571-272-4267):

On November 29, 2011, at the request of both parties, the Board participated in the discovery conference. The participants were Andrey Pinsky, petitioner acting pro se, Douglas Burda, respondent acting pro se, and Elizabeth Dunn, attorney for the Board.

As stated, discovery conferences may not be recorded. Inasmuch as the conference lasted more than an hour, this order only summarizes the main topics discussed. To the extent that each party accused the other of misrepresentations and other unethical conduct, the parties are advised to read this order carefully with respect to how such concerns may be addressed to the Board, the care with which such accusations

should be made, and the Board's unwillingness to tolerate anything but strict compliance with its rules.

REPRESENTATION

The petition to cancel identifies petitioner as a Canadian attorney and respondent as a U.S. attorney. The amended answer admits that respondent is a U.S. attorney and alleges the affirmative defense (§14) that "petitioner lacks standing to practice before the [Office]." Patent and Trademark Rule 11.14(e) provides "Any individual may appear in a trademark or other non-patent matter in his or her own behalf."¹ Petitioner's occupation as a Canadian attorney does not preclude his self-representation in this proceeding. The Office's rules regarding recognition of Canadian attorneys applies only to those attorneys representing a third party. See Patent and Trademark Rule 11.14(e) ("No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client.") (emphasis added). Accordingly, the Board sua sponte strikes the affirmative

¹ While Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matter. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

defense that petitioner lacks standing to practice before the Board.

COMMUNICATION

In view of the mutual complaints about difficulties in communication, the parties are ordered to list a phone number at which he can be reached or a message left, and which is checked for messages on a daily basis, on all papers hereafter filed with Board. If the number changes, the party immediately must notify the Board in writing of an alternate phone number. In addition, the parties must respond to messages regarding this proceeding, whether left by the Board or the other side, by the end of the next business day. Before moving for Board action on the basis that this order has not been followed, a second message must be left, and a second response period must pass. While, as discussed, the Board will allow certain disputes to be resolved by oral motion, any motion to the Board regarding the failure to promptly respond to a phone message must be made in writing and accompanied by an affidavit or declaration pursuant to Trademark Rule 2.20.

Based on the strong preference expressed by each party for conflicting modes of electronic communication, as well as the acrimony displayed by the parties, the parties may only utilize facsimile or email service of if they file a

signed stipulation agreeing to such service with the Board. Absent such filing, service may be made ONLY by those alternate means set forth in Trademark Rule 2.119. Any paper filed which lacks proper proof of service will be given no consideration.

RELATED PROCEEDINGS

Neither party owns a pending application for a related mark. The parties are aware of no related proceedings before the Board or in any court. As set forth in the institution order, the parties must notify the Board promptly if they become parties to another Board proceeding or civil action which involve related marks which overlap with this case, and this obligation continues for the duration of this proceeding.

SETTLEMENT

While the Board may facilitate settlement by adjusting the schedule, the Board does not actively promote settlement, which remains wholly the choice of the parties. As explained, only 2% of all Board proceedings result in a final decision on the merits, and a substantial portion of the 98% of proceedings which terminate earlier do so as a result of an agreement between the parties. The discussion of settlement of this proceeding ended when petitioner treated respondent's

overtures as admissions that respondent would be unable to maintain the registration and was unethical in defending his registration. As the Board noted, the accusation is unwarranted.

If interest in settlement occurs at a later point in this proceeding, and the parties wish to avoid the expense of trial preparation unless it is necessary, the parties should stipulate in writing to suspension of this proceeding. Absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations did not justify party's inaction or delay).

PLEADINGS

The petition to cancel claims priority of use and likelihood of confusion between petitioner's common law mark CONCEPT LAW and respondent's mark KONCEPT, the subject of Registration No. 85176628, both for legal services. On October 31, 2011 applicant filed its answer, and then on November 14, 2011, applicant filed an amended answer which denied the salient allegations of the petition to cancel. The amended answer is accepted. See Fed. R. Civ. P. 15(a)(1)(A) ("A party may amend its pleading once as a matter of course within 21 days after serving it").

Respondent asked whether he could file a motion to amend the answer to assert the affirmative defense that petitioner does not use the mark in commerce. Petitioner, as the party bearing the burden of proof in this proceeding, must demonstrate that he is the owner of superior rights to those of respondent with respect to the mark CONCEPT LAW for legal services. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Accordingly, petitioner must establish his rights as part of his case in chief, and the assertion that he lacks such rights is not an affirmative defense but an amplification of respondent's denial of the claim of likelihood of confusion. See *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1718 FN 2 (TTAB 2008).

Petitioner asked if there were any time limits on the ability to move to amend the pleadings. Subject to the movant demonstrating that the requested amendment is timely and not futile, the answer is no. *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008) ("The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.").

As discussed, if the parties lack access to a law library or legal research service, the USPTO website offers research

options in the form of a searchable database of Board final decisions. On the Board's webpage, clicking "TTAB Final Decisions" brings the user to a search page where date parameters and a key word (such as confusion or generic) may be entered. The search will produce a listing of the Board final decisions which use that term within the specified period. By clicking on the proceeding number in the list, the user may read the full decision.

STIPULATION FOR EXPANDED INITIAL DISCLOSURES

The parties agree to expand the initial disclosures required by Fed. R. Civ. P. 26(a) to include proof of the first date of use of their mark in commerce.

This stipulation is intended to save both parties time and money but does not replace or prevent discovery on the issue of first use if either party believes it necessary.

DISCLOSURES, DISCOVERY, TRIAL EVIDENCE

The parties did not agree to adopt ACR (accelerated case resolution) procedures or any other measures (in addition to the stipulation set forth above) to expedite this proceeding. As discussed, in addition to approving adoption of ACR (accelerated case resolution) procedures, the Board will entertain any stipulations designed to save the parties time and money, such as stipulating to facts, agreeing to a

shortened schedule of disclosure, discovery, and trial, and/or stipulating as to the admissibility of evidence. However, in the absence of written agreements filed with the Board, disclosures, discovery and the submissions of trial evidence must comport with the relevant Trademark Rules as well as the relevant rules of civil procedure.

As discussed in connection with communication, the parties may not avail themselves of electronic means of service of disclosures, discovery, or trial evidence absent a signed stipulation filed with the Board. The Board's standard protective order governs the disclosure of confidential information in this proceeding, and is available from the Office website. Once initial disclosures have been filed, a party may seek discovery. The parties are expected to cooperate in the exchange of disclosures and discovery.

An opposition before the Board 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, requests for production of documents and things, 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 accord with the applicable rules.

MOTIONS FOR SANCTIONS

As discussed, one party's opinion about the conduct or character of the other party is irrelevant to this proceeding and should not be expressed orally or in writing to the Board. If pertinent to a motion requesting specific action from the Board, specific actions by the other party should be described without comment. While a failure to produce proper disclosures or requested discoverable information generally is addressed by a motion to compel, more serious breaches of conduct or the Board's rules may be the subject of a motion for sanctions. The TBMP describes several bases for a motion for sanctions.

Fed. R. Civ. P. 11 certification standards apply to parties as well as attorneys. See *Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.*, 498 U.S. 533, 547, 111 S.Ct. 922, 112 L.Ed.2d 1140 (1991) and *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). Fed. R. Civ. P. 11(b) states: By presenting to the court a pleading, written motion, or other paper – whether by signing, filing, submitting, or later

advocating it – an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;
- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;
- (3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

Fed. R. Civ. P. 11(c)(2) provides a "safe harbor" provision allowing the party or attorney an opportunity to withdraw or correct a challenged submission. This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the challenged submission and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected. The Board will deny motions for Fed. R. Civ. P. 11 sanctions which fail to comply with this requirement.

ORAL MOTIONS OR RESPONSES

With the exception of motions for sanctions or failure to return phone calls (which must be in writing), the parties may request to bring oral motions on contested matters. If a written motion is filed, the responding party may request to

bring his response orally. Before requesting the Board to hear a contested motion by phone, the requesting party must contact the other party for available times and dates. In addition, even if the parties do not request it, the Board may order parties to appear by phone for a conference on a pending motion. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §502.06 (3rd ed. 2011).

EX PARTE COMMUNICATIONS

The availability of the Board to expedite the proceeding by deciding motions in a conference with the parties should not be mistaken for availability of the Board for ex parte communications. Parties may telephone the Board to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or any particular issue. The Board may not conduct research for the parties, recommend particular action, or suggest which rules are applicable to the party's circumstances. TBMP §105 (3rd ed. 2011).

DATES REMAIN THE SAME

The schedule set forth the Board's September 23, 2011 institution and trial order remains in effect.