

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

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Mailed: August 10, 2012

Cancellation No. **92055558**

Economy Rent-A-Car, Inc.

v.

Emmanouil Kokologiannis and
Sons, Societe Anonyme of
Trade, Hotels and Tourism S.A.

Yong Oh (Richard) Kim, 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 10:30 AM EDT, on August 9, 2012. Board participation was requested by respondent. Samuel Littlepage, Esq., of Dickinson Wright PLLC appeared as counsel for petitioner and John Moetteli, Esq.,¹ and Sharon Gobat, Esq.,² of Da Vinci Partners LLC appeared as counsel for respondent. Interlocutory Attorney Richard Kim participated on behalf of the Board.³

Introductory Remarks

¹ Member of the DC bar.

² Member of the MA bar.

The Board noted that the present conference was being conducted pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2). The Board informed the parties that a spirit of cooperation and good faith dealing were expected from the parties during the duration of this proceeding and that any points of contention that may arise during the course of the proceeding should be handled through direct communication between the parties and in a spirit of good faith. **The parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the issue.**

The Board further informed the parties that telephone conferences with a Board attorney are available as necessary but that both parties would need to be on the call to discuss any substantive matter as *ex parte* communications with the Board are generally inappropriate.

The parties were instructed to file appearances of counsel and change of correspondence forms as necessary.

Prior Communications and Disputes

³ Respondent's motion (filed July 18, 2012) to remove two of its e-mail addresses from its correspondence address of record is noted and the Board's records have been updated accordingly.

The parties confirmed that they have had prior communications to discuss settlement and to prepare for the present discovery conference. The parties further noted that settlement discussions are currently "dead" but that the parties remain open to future settlement discussions as more information is gathered through discovery.

The parties have not made any informal proffers of proof regarding any of the claims, defenses or allegations in the pleadings and do not currently have any plans to do so.

The Board then inquired as to whether the parties were involved in any other dispute between the parties and whether the parties were involved in a dispute with any other third-party concerning the marks involved in this matter, to which the parties responded in the negative.

Pleadings

The Board and the parties discussed each of the pleadings that were filed in this matter. Petitioner's counsel confirmed that petitioner was solely asserting claims of priority and likelihood of confusion and abandonment in its petition for cancellation. However, and as pointed out by respondent in its answer, petitioner notes that the registration referenced in paragraphs 4, 5 and 6 of the petition is incorrect and should refer to involved

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Registration No. 3256667 rather than 3356667 and that reference to the latter was simply a clerical error.

As to respondent's answer, the Board noted that the first part of the answer conforms to the pleading requirements of Fed. R. Civ. P. 8(b). However, in respondent's "Affirmative Defenses" section of its pleading, the Board noted that many of the paragraphs do not relate to an affirmative defense, are argumentative and, in any event, are no longer relevant in view of petitioner's clarification regarding the incorrectly identified registration. The Board further noted that where a true affirmative defense is identified, the mere recitation of the defense, without any indication of the grounds therefor, is insufficient. See, e.g., *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987). This shortcoming is compounded where the applicability of the affirmative defense to this proceeding is in question. For instance, the defense of laches is not available against a claim of abandonment. *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1991). Yet, respondent has asserted laches, among other equitable defenses, without any indication of the basis therefor or the claim against which it is asserted.

In view thereof and in the interest of clarity, the parties agreed that petitioner would serve respondent with

an amended copy of the petition which corrects the clerical error no later than **AUGUST 10, 2012**. The Board ordered respondent to replead its answer in response to the amended petition no later than **AUGUST 24, 2012**, with an eye towards cleaning up and limiting the "Affirmative Defenses" portion of its answer to those that are relevant and upon which there are grounds to assert them.

Discovery

The parties were advised that the Board's standard protective order is operative in this proceeding, made applicable by operation of Trademark Rule 2.116(g) and available at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

If the parties wish to modify the Board's standard protective order, they could do so by filing a motion for Board approval along with a copy of the proposed protective order.

The Board then inquired as to whether the parties had given any consideration to reciprocal disclosures, stipulations of fact, and/or agreements to potentially limit and simplify discovery and testimony. The parties indicated that they had not but would consider doing so as appropriate. To that end, the Board informed the parties that greater use of reciprocal disclosures and less use of formal discovery was encouraged by the Board and that the

parties could consider streamlining their discovery by limiting the number of depositions,⁴ interrogatories, document production requests and admission requests.

The parties may also consider simplifying the introduction of evidence into the record such as stipulating to the authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

The parties did stipulate to accept service of papers by e-mail⁵ with a confirmation of such service sent by fax and a hard copy of the papers sent by mail.⁶ The parties further agreed that the five day grace period afforded the parties under Trademark Rule 2.119(c) would remain applicable and would also encompass respondent's service utilizing foreign priority mail.

The parties also stipulated that in responding to document requests, true and correct photocopies of all responsive documents will be served by mail with the

⁴ Pursuant to Fed. R. Civ. P. 30(a), made applicable to Board proceedings by Trademark Rule 2.116, a party that seeks more than ten discovery depositions without prior stipulation by the parties to do so must obtain leave of the Board.

⁵ Service is to be made at slittlepage@dickinsonwright.com, nmeyer@dickinsonwright.com and trademark@dickinsonwright.com for petitioner, and at gobat@davincipartners.com, moetteli@davincipartners.com and secretary@davincipartners.com for respondent.

⁶ Respondent has agreed to utilize non-domestic priority mail for its mailings.

originals to remain in the producing party's custody and maintained by the producing party as they are usually kept in the ordinary course of business. Access to the original documents will be granted at the location where they are normally held.

Alternative Dispute Resolution and Accelerated Case Resolution

The parties notified the Board that the Board's Accelerated Case Resolution (ACR) procedure was previously discussed but ultimately declined. The parties are invited to review additional information concerning ACR at the following links should the parties reconsider this option:

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

[http://www.uspto.gov/trademarks/process/appeal/accelerated case resolution acr faq.doc](http://www.uspto.gov/trademarks/process/appeal/accelerated%20case%20resolution%20acr%20faq.doc)

Mediation and arbitration were also discussed and the parties were informed that the Board would be amenable to suspending proceedings should the parties avail themselves of these options. The parties are reminded that the Board does not provide such services and will not make referrals to third-parties who do provide such services.

Conclusion

As noted by the Board during the teleconference, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur

until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

Notwithstanding the aforementioned deadlines for the amended pleadings, dates remain as last reset on June 7, 2012. That schedule is reproduced below for the convenience of the parties:

Discovery Opens	8/10/2012
Initial Disclosures Due	9/9/2012
Expert Disclosures Due	1/7/2013
Discovery Closes	2/6/2013
Plaintiff's Pretrial Disclosures Due	3/23/2013
Plaintiff's 30-day Trial Period Ends	5/7/2013
Defendant's Pretrial Disclosures Due	5/22/2013
Defendant's 30-day Trial Period Ends	7/6/2013
Plaintiff's Rebuttal Disclosures Due	7/21/2013
Plaintiff's 15-day Rebuttal Period Ends	8/20/2013

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 Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.

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