

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

CME

Mailed: June 5, 2013

Cancellation No. 92057061

Giftboard, Inc.

v.

Andrey A. Agapov

**Christen M. English, Interlocutory Attorney:**

On June 5, 2013, at petitioner's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2). Douglas Burda appeared on petitioner's behalf, Matthew Swyers appeared on respondent's behalf and assigned Interlocutory Attorney Christen English participated on the Board's behalf.

During the teleconference, the parties agreed to accept formal service of *all* papers by e-mail pursuant to Trademark Rule 2.119(b)(6). Petitioner's e-mail address for service is douglas@burda.co and respondent's e-mail address for service is mswyers@TheTrademarkCompany.com. The parties are not aware of any related proceedings, marks or third party disputes.

The parties have not engaged in settlement discussions, but indicated a willingness to do so. The Board strongly

Cancellation No. 92057061

encourages the parties to work together to amicably resolve this proceeding, if possible.

The Board addressed petitioner's petition for cancellation pointing out that the claims of fraud and that the registration is *void ab initio* are insufficiently pled. Fraud must be pled with particularity, though an intent to deceive may be averred generally. See *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1088 (TTAB 2010) (citing Fed. R. Civ. P. 9(b)). Petitioner's claims of fraud are not sufficiently supported by sufficient facts as required by Fed. R. Civ. P. 9(b). Petitioner's fraud claim appears to be grounded in the assertion that respondent's specimen of use submitted in support of the involved registration does not demonstrate use of the involved mark. However, the sufficiency of respondent's specimen is an examination issue and not a basis for asserting a ground for cancellation. See, e.g. *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270, 1273 n.6 (TTAB 1992); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989). Moreover, simply because respondent's specimen allegedly does not demonstrate use of the involved mark does not mean that respondent was not using the mark in some other manner at the time it filed the underlying use-based application. Similarly the *void ab initio* claim should be amended to clarify that the basis for the claim is

Cancellation No. 92057061

respondent's alleged failure to use the involved mark as of the filing date of the underlying use-based application. See Trademark Trial and Appeal Board Manual § 309.03(c) (3d ed. rev. 2012).

Petitioner is allowed until **June 26, 2013** in which to file an amended petition for cancellation and respondent is allowed until **July 16, 2013** in which to file an answer to any amended petition for cancellation.

The Board also discussed ways to streamline the case by using Accelerated Case Resolution ("ACR") or ACR-like efficiencies such as the possibility of the parties making greater reciprocal disclosures than required by Fed. R. Civ. P. 26(a)(1) and taking testimony by declaration, subject to the right of either party to cross examine, if desired. If the parties wish to further explore ACR, the following materials may be helpful:

[http://www.uspto.gov/trademarks/process/appeal/Accelerated\\_Case\\_Resolution\\_ACR\\_notice\\_from\\_TTAB\\_webpage\\_12\\_22\\_11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf);

[http://www.uspto.gov/trademarks/process/appeal/Accelerated\\_Case\\_Resolution\\_\(ACR\)\\_FAQ\\_updates\\_12\\_22\\_11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_(ACR)_FAQ_updates_12_22_11.doc); and

[http://www.uspto.gov/trademarks/process/appeal/ACR\\_Case\\_List\\_\(10-23-12\).doc](http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_(10-23-12).doc).

In addition, the Board recommended that the parties read the Board's recent decision in *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774 (TTAB 2013) approving an ACR stipulation.

Cancellation No. 92057061

The Board's standard protective order is applicable herein by operation of Trademark Rule 2.116(g) and available here:

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

The parties are encouraged to acknowledge their obligations under the protective order in writing, and may utilize the following form:

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

The parties were reminded that neither discovery requests nor motions for summary judgment may be served until after initial disclosures are made.

Finally, the Board indicated that it is available for future telephone conferences to resolve contested matters, address scheduling issues, assist the parties in developing stipulations of fact or negotiating an ACR plan, and to address other issues, as necessary, to move this case forward efficiently.

Dates in this proceeding are reset as follows:

Deadline to file an Amended Complaint	6/26/2013
Time to Answer any Amended Complaint	7/16/2013
Deadline for Discovery Conference	<b>COMPLETED</b>
Discovery Opens	8/15/2013
Initial Disclosures Due	9/14/2013
Expert Disclosures Due	1/12/2014
Discovery Closes	2/11/2014
Plaintiff's Pretrial Disclosures	3/28/2014

Cancellation No. 92057061

Plaintiff's 30-day Trial Period Ends	5/12/2014
Defendant's Pretrial Disclosures	5/27/2014
Defendant's 30-day Trial Period Ends	7/11/2014
Plaintiff's Rebuttal Disclosures	7/26/2014
Plaintiff's 15-day Rebuttal Period Ends	8/25/2014

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 will be set only upon request filed as provided by Trademark Rule 2.129.

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