

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

Mailed: October 17, 2013

Cancellation No. 92057518

The George Nelson Foundation

v.

Empire IP Holdings LLC

Cheryl S. Goodman, 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 on October 16, 2013, with Board participation.

Participating in the conference were counsel for petitioner, William Dorsey, and counsel for respondent Steven N. Fox.¹ Present for the Board was the above-identified Interlocutory Attorney.

This order memorializes what generally transpired during the conference.

Standard Protective Agreement

The Board advised the parties of the imposition of the Board's standard protective agreement for confidential

¹ Respondent requested Board participation via ESTTA on September 30, 2013.

information and that any modified protective agreements should be filed with the Board.

E-mail Service

The parties' agreed to service by by e-mail.²

Disclosures

The Board provided the parties with general information regarding the nature of the parties' initial disclosures under Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii), expert disclosures, see Fed. R. Civ. P. 26(a)(2), and pretrial disclosures, see Fed. R. Civ. P. 26(a)(3). The parties are also directed to the Board's Manual of Procedure, TBMP, Sections 400 and 700, third edition revised for more information and to the Board's website, with regard to providing more extensive initial disclosures.³ The parties should note that initial disclosures need not be filed with the Board unless they

² The parties should adjust their spam filters so that communications from the Board (uspto.gov) and the adverse party are received. The parties are not afforded any additional time for e-mail service.

³ Information regarding disclosures can be located in the Board Manual of Procedure (TBMP) at Chapters 401.02, 401.03 and Chapter 702. The third edition revised of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp. If the parties are interested in making more extensive disclosures, the parties are referred to the Miscellaneous Changes to TTAB Rules, January 17, 2006, located at <http://www.uspto.gov/trademarks/process/appeal/index.jsp> under "Rules/Laws."

are filed in connection with a discovery motion, motion for summary judgment or notice of reliance.

The Board advised the parties that a motion for summary judgment cannot be filed prior to service of initial disclosures.⁴

The parties are reminded that disclosures are subject to supplementation as set forth under Fed. R. Civ. P. 26.

Formal Discovery

The parties were advised that formal discovery (i.e., interrogatory requests, requests for production, depositions, requests for admissions) may be taken only after service of initial disclosures.⁵ The parties are informed that initial disclosures can be served sooner than the deadline as last reset and that initial disclosures can be served concurrently with formal discovery.

Pleadings

The Board found that the petition to cancel was deficient with regard to the fraud claim as petitioner failed to allege that petitioner had legal rights superior to applicant (respondent) and that applicant knew that petitioner had rights in the mark superior to applicant's,

⁴ Unless such motion is based on issue or claim preclusion or lack of jurisdiction of the Board.

⁵ For more information regarding formal discovery, the parties are directed to TBMP Chapter 400.

and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise.

The Board found that applicant's affirmative defenses, no. 2, "lacks standing" and no. 8 "will not suffer any damage," were insufficient and should be stricken, and that affirmative defenses nos. 4-7 were conclusory and insufficiently pleaded as they fail to provide petitioner with fair notice of the bases for the defenses. If petitioner sufficiently amends the fraud claim, then the defense of "failure to state a claim" also will be rendered insufficient on its face. The Board pointed out that equitable defenses are unavailable with respect to a fraud claim, and that even if laches and acquiescence are proven, if likelihood of confusion is inevitable, then these defenses are barred.

Petitioner is allowed until December 7, 2013 to file and serve an amended petition to cancel alleging a proper fraud claim.

Respondent is allowed until December 27, 2013 to file its answer thereto, omitting the insufficient affirmative defenses, and pleading the factual bases for affirmative defenses nos. 4-7.

ESTTA Filings

The parties are informed that ESTTA is preferred for filing papers in the Board proceeding. When using the consent suspension and extension motion forms available on ESTTA, the parties were reminded that these forms should only be used after the deadline for initial disclosures has passed. In addition, the parties should carefully check that the dates generated in ESTTA are what they intend when using the automated forms prior to submission.

Accelerated Case Resolution

The Board informed the parties regarding the possibilities to streamline the proceeding and save time and expense by considering Accelerated Case Resolution ("ACR"). Both parties must stipulate to proceed via ACR. Additionally, the parties are advised that ACR like efficiencies may streamline the case and save time and expense even if the parties decide not to proceed via ACR. Such efficiencies, whether used in the context of an ACR case or not, may include limiting discovery, shortening the discovery period, and taking advantage of stipulations with respect to facts and evidence as well as using testimonial affidavits or discovery depositions in lieu of testimonial depositions. The Board further advised the parties that such stipulations should be filed with the Board and, if

the parties agree to an abbreviated schedule for discovery or trial, such agreement also should be filed with the Board so that a revised discovery and briefing schedule can issue.

Information regarding ACR is available in Chapter 702.04(a)-(d) of the TBMP and is also available on the USPTO.gov website.⁶ Information regarding utilizing stipulations in non-ACR Board cases is located at TBMP Section 702.04(e).

Telephone Conferences

The parties were advised of the availability of telephone conferences with the assigned Interlocutory Attorney to resolve contested matters.

Dates in this proceeding

Dates in this proceeding are corrected as follows⁷:

| | |
|--------------------------------------|------------|
| Discovery Opens | 10/24/2013 |
| Initial Disclosures Due ⁸ | 12/07/2013 |
| Expert Disclosures Due | 3/23/2014 |
| Discovery Closes | 4/22/2014 |
| Plaintiff's Pretrial Disclosures Due | 6/6/2014 |
| Plaintiff's 30-day Trial Period Ends | 7/21/2014 |
| Defendant's Pretrial Disclosures Due | 8/5/2014 |
| Defendant's 30-day Trial Period Ends | 9/19/2014 |
| Plaintiff's Rebuttal Disclosures Due | 10/4/2014 |

⁶ The parties were informed of the options to use third party mediation or arbitration, at the parties' expense, to resolve the dispute.

⁷ The order of August 23, 2013, granting the parties' stipulated extension of thirty days, is corrected herein to reflect the intentions of the parties.

⁸ The parties agreed to extend the initial disclosure deadline by two weeks, with all other dates remaining as last reset.

Plaintiff's 15-day Rebuttal Period Ends

11/3/2014

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.