

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

Mailed: October 9, 2013

Cancellation No. 92057609

Ginger Ann Scherbarth

v.

Kathy L. Knapp

**Robert H. Coggins,
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 2:00 p.m. EDT on October 8, 2013. Board participation was requested by respondent Kathy L. Knapp, appearing *pro se*. Petitioner was represented by Stacy A. Cole, and participating for the Board was the above-signed Interlocutory Attorney.

Similar Proceedings

The Board asked if the parties were involved in any other Board proceeding (to determine whether consolidation was appropriate) or in litigation in any court (to determine whether suspension was appropriate). The Board was informed that the parties were not so involved.

Nature of Board Proceedings

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; disclosures; 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 accordance with the applicable rules.

Representation

Respondent is permitted to represent herself. However, it should be noted that while Patent and Trademark Rule 11.14 permits any person to represent herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a cancellation proceeding to secure the services of an attorney who is familiar with such matters. The Patent and

Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure. Any person may call the Board at any time with questions concerning procedural matters or general information about Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties.

Resources

The Board pointed to the resources (including the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") and the Trademark Rules of Practice) available on its website at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Sections 400-800 of the TBMP will be of the most interest to the parties going forward. Chapter 400 describes disclosures, written discovery, and discovery depositions; Chapter 500 describes motions practice; and Chapter 700 describes trial procedure and introduction of evidence.

Both parties have used the ESTTA filing system (<http://estta.uspto.gov>) and are familiar with it. Briefly, when one files using ESTTA, a pre-populated cover sheet is generated; filings may be attached in a pdf format; an ESTTA tracking number is generated upon successful completion of the filing. If a problem is encountered, call the Board at (571)

272-8500, ask to speak to one of the computer specialists, and provide the ESTTA tracking/confirmation number, if available. If a filing is due and ESTTA is down, use traditional mail and a certificate of mailing.¹ See TBMP § 110 (3d ed. rev.2 2013). The parties' addresses can be changed easily and consented motions can be filed, usually generating an immediate, automatic order granting the motion.

TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) contains the electronic record for the proceeding. It is recommended that the parties periodically check the database to make sure they have received all orders and copies of all filings. Other information is available on the TTAB's home page, including links to the rules of practice, the trademark statute, the Board's standard protective order, accelerated case resolution options, and the Office's FOIA page for access to Board case summaries. Board records are public records and any person may look at the filings in any proceeding.

Settlement

The parties were informed that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in substantive settlement negotiations. The ESTTA system will

¹ Information about the service requirement is provided later in this order.

automatically grant scheduling motions filed using the "consent motions" form wizard for settlement purposes for approximately 18 months. After that, consented scheduling motions will be reviewed by a paralegal. The parties may be required to provide additional information about the status and progress of any settlement discussions after 18 months. The parties may also upload a consented scheduling motion under the "general filings" option, embedding the agreed-upon schedule in the motion. Such motions will usually be acted on by a paralegal. Even though the parties may not receive an order on such motions as quickly as they would when using the ESTTA "consent motions" option, the Board generally grants consented motions to extend, reopen, or suspend. See TBMP §509.02 (3d ed. rev.2 2013). Thus, the parties may, and should, rely on their agreed-to schedule while waiting for the Board's order.

In this case, the parties have had direct communication about settlement. The parties agreed that settlement is possible; however, it appeared that their respective settlement positions are far apart. The parties discussed some settlement options in the presence of the Board, but, inasmuch as the parties may consider the specifics confidential, they are not recorded in this order. In view of the distance between the parties' respective positions, petitioner did not want to suspend proceedings for settlement

at this point. The conduct of some discovery may help the parties identify issues that will eventually lead to achieving a mutually agreeable settlement.

Email service

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all papers filed with the Board.

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was

served upon [insert party upon whom served] by forwarding said copy via email, by agreement, to: [insert name and email address].

The certificate of service must be signed and dated. See TBMP § 113 (3d ed. rev.2 2013).

The parties agreed to email service with, at first -to ensure the receiving party's email system is reliable for electronic service- a courtesy telephone call by the serving party to the receiving party to alert the receiving party to the service. Once each party's email system is determined to be reliable, then the parties need not provide a courtesy telephone call. Respondent's two email addresses for service are kathyknapp2@yahoo.com and kknapp@anoviaconsulting.com, and petitioner's email address for service is scole@graydon.com. The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First-Class Mail) are not available for email service. See *McDonald's Corp. v. Cambridge Overseas Dev. Inc.*, 106 USPQ2d 1339 (TTAB 2013); and TMBP §113.05 (3d ed. rev.2 2013).

Pleadings

Upon review of the petition for cancellation, the Board noted that petitioner had sufficiently alleged her standing and the ground of priority and likelihood of confusion. The Board also noted that none of petitioner's exhibits attached to the petition was in evidence. Trademark Rule 2.122(c).

Upon review of the answer, the Board noted that respondent's answer fairly and clearly met the allegations in the petition. However, the Board advised the parties that respondent's first affirmative defense would not be construed as a separate motion under Fed. R. Civ. P. 12(b)(6) to dismiss for failure to state a claim on which relief can be granted, and, inasmuch as it was determined that the petition sufficiently alleged petitioner's standing and a ground for cancellation, this defense was stricken. The second and third affirmative defenses (encompassing laches, estoppel, and acquiescence) were also stricken as insufficiently pled. Respondent was allowed until October 29, 2013, in which to file an amended answer that properly pleads the affirmative defenses of laches, estoppel, and/or acquiescence; failing which, this proceeding will continue under the original answer as stricken (i.e., no motion to dismiss and no affirmative defense of laches, estoppel, or acquiescence).

Discovery

The parties were directed to TBMP § 414 (3d ed. rev.2 2013) for an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.²

A. The Board's Standardized Protective Order

² Not all subject matters discussed in § 414 will be applicable to the claims in this case.

The Board advised the parties that the Board's standard protective order was in place in this case governing the exchange of confidential and proprietary information and materials. Trademark Rule 2.116(g). The parties were informed that they could substitute a stipulated protective agreement (signed by both parties) but that the Board generally does not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order. See TBMP § 412.02 (3d ed. rev.2 2013).

Respondent was informed that, as a party representing herself, she may not have access to a certain level of higher designation of confidentiality (i.e., the trade secret/commercially sensitive designation), should it be used by petitioner. The parties were directed to the standardized protective order on the TTAB's home page.

B. Scope of discovery

The Board discussed the use and nature of interrogatories, requests for admission, requests for production of documents and things, and depositions as discovery devices. Under the current petition, discovery should focus on priority and likelihood of confusion. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177

USPQ 563 (CCPA 1973).³ The parties should easily ascertain which *du Pont* factors are relevant and further concentrate discovery on those factors. See *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (need only consider those factors which are relevant). Information about the various *du Pont* factors may also assist the parties in crafting a mutually agreeable settlement.

The parties may, of course, serve discovery requests on other matters to ascertain whether there may be additional grounds for cancellation (in petitioner's case) or for an affirmative defense (in respondent's case). However, if initial responses do not indicate the existence of any such grounds or defenses, discovery on those matters should not be pursued.

In view of the similarity of the parties' marks⁴, the Board discussed the possibility of limiting the use of interrogatories, requests for admission, requests for

³ The parties were advised that, in order for petitioner to prevail on her Section 2(d) claim, she must first prove by a preponderance of the evidence that she has a proprietary interest in her pleaded ANOVIA mark for business management consulting and advisory services and that she obtained that interest prior to the actual or constructive first use by respondent. *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Petitioner must also establish that there is a likelihood of confusion by a preponderance of the evidence. See *du Pont, supra*. See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

⁴ Respondent admitted in the answer (see para. 13) that the parties' ANOVIA marks are identical.

production of documents and things, and discovery depositions. While the parties anticipate that discovery can and will be narrowly focused in this proceeding, they did not (during the conference) want to put any limits on the use or timing of traditional discovery.

C. Electronically stored information

In general, production of electronically stored information ("ESI") is not an issue in Board cases, likely due to the Board's limited jurisdiction to determine only the right to a registration and the public nature of trademarks. However, if the parties anticipate or encounter a problem, they should work together to resolve the matter.

D. Initial disclosures

The parties were reminded of their obligation to make initial disclosures under Trademark Rule 2.120(a)(1) and Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii). Initial disclosures are: 1) the identity of witnesses likely to have discoverable information and 2) the description and location of documents and things having or containing relevant information. More particularly, and as provided for by Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii), those disclosures are:

(i) the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;

(ii) a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

The deadline for initial disclosures was reset to November 28, 2013. The Board discussed the possibility of more extensive disclosures of documents and tangible things in lieu of formal discovery, but the parties wanted to maintain traditional discovery and anticipated the normal use of requests for production of documents and things.

The parties were reminded that they must serve initial disclosures before serving discovery or a motion for summary judgment (except that a summary judgment motion may be filed on certain limited grounds before initial disclosure, but the exceptions do not appear to be in play in this proceeding). See TBMP § 528.02 (3d ed. rev.2 2013). The parties may serve initial disclosures before the due date.

Accelerated Case Resolution (ACR)

The Board discussed the possibility of accelerated case resolution (ACR). Petitioner expressed interest in pursuing ACR, but respondent did not. The Board stated that this case appears to be a good candidate for ACR and encouraged the parties to discuss ACR again once the pleadings are settled and after some discovery has been taken. If the parties can

agree to ACR, the parties are to contact the Board for further discussion and administration.

Both parties must stipulate to an ACR proceeding and that the Board may make findings of fact from the ACR record. The parties were referred to the TTAB homepage for more information, TTAB suggestions, and examples of stakeholder suggestions in ACR.

In general, the models for ACR may include: 1) conversion of a currently pending summary judgment motion - usually the parties elect ACR after the motion is fully briefed; 2) an approximation of a summary bench trial using ACR briefs and accompanying evidence, similar to summary judgment briefs and evidence - usually the parties elect ACR prior to presenting this ACR record and briefs; and 3) a stipulated record submitted with the trial brief, where the parties extensively use stipulations, with or without other evidence and with or without testimony - thus the parties are not required to forgo trial or the taking of testimonial depositions.

As the parties may perceive, there is substantial flexibility with ACR approaches in Board proceedings. The goal is to reduce the time and expense to the parties of a full trial. See TBMP § 702.04 (3d ed. rev.2 2013).

As the parties move forward in this proceeding, they should keep in mind that this case may have opportunities for other efficiencies. See TBMP § 702.04(e) (3d ed. rev.2 2013).

Schedule

Dates were reset on the following schedule.

Amended Answer Due, if Filed	10/29/2013
Deadline for Discovery Conference ⁵	11/13/2013
Discovery Opens	11/13/2013
Initial Disclosures Due	11/28/2013
Expert Disclosures Due	3/28/2014
Discovery Closes	4/27/2014
Plaintiff's Pretrial Disclosures	6/11/2014
Plaintiff's 30-day Trial Period Ends	7/26/2014
Defendant's Pretrial Disclosures	8/10/2014
Defendant's 30-day Trial Period Ends	9/24/2014
Plaintiff's Rebuttal Disclosures	10/9/2014
Plaintiff's 15-day Rebuttal Period Ends	11/8/2014

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.

⁵ Although a deadline is provided, the parties need not conduct a second conference unless the amended answer raises new defenses not discussed in the October 8th conference.