

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: August 15, 2014

Cancellation No. **92058143**

Van de Wall B.V.

v.

D-Minor, Inc.

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 on August 11, 2014.¹ Board participation was requested by motion of petitioner filed via ESTTA, the Board's electronic filing system. Kurosh Nasser, Esq., and Babatunde Williams, Esq., of Law Offices of Kurosh Nasser PLLC appeared on behalf of petitioner and Leslie A. Thompson, Esq., of Leslie A. Thompson & Associates appeared on behalf of respondent.

Introductory Remarks

At the outset of the conference, the parties were informed that a spirit of cooperation and good faith dealing were expected during the duration of this proceeding and that any points of contention that may arise during the

¹ Petitioner's change of correspondence (filed May 16, 2014) is noted and has been entered.

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 each of the discovery requests in dispute.**

The parties were informed 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 and that *ex parte* communications with the Board are generally inappropriate.

The parties are instructed to file appearances of counsel and change of correspondence forms as necessary, preferably through ESTTA.

Prior Communications and Disputes

Aside from the scheduling of this conference, the parties have had prior settlement discussions without success. In discussing the possibility of renewed discussions, it became apparent to the Board that the parties were not close to a resolution and that additional time for the purpose of settlement would prove fruitless. The parties, however, are encouraged to revisit the question of settlement at a later time.

The Board inquired as to whether the parties were involved in any other disputes involving the subject marks either with each other or with a third party to which the parties responded in the negative.

Pleadings

The Board and the parties discussed the claims in the amended petition for cancellation and respondent's answer thereto. **Petitioner confirmed that it was solely asserting a claim of priority and likelihood of confusion and abandonment in its pleading.**

As for respondent's answer, the Board noted that respondent's responses to ¶¶ 16, 22, and 23 failed to comply with the general rules of pleading found in Fed. R. Civ. P. 8 and **ordered respondent to replead its responses to those paragraphs.**

As to respondent's putative "affirmative defenses,"² the Board noted that ¶¶ 1A and 2A are not affirmative defenses as standing is part of petitioner's case and, therefore, petitioner's burden to prove. *See Lipton Industries V. Ralston Purina*, 670 F.2d 1024, 1028, 213 USPQ 185, 189 (CCPA 1982). As the "defenses" are superfluous, the Board ordered **¶¶ 1A and 2A stricken**. The Board noted that ¶¶ 3A and 7A are simply amplifications of respondent's denial and allowed the paragraphs to stand. The Board inquired as to the basis for ¶ 5A to which respondent consented to striking the paragraph. **¶ 5A is therefore stricken**. The Board also inquired as to the factual basis of the numerous affirmative defenses cited in ¶ 6A. In response, respondent requested leave to further consider and

² Since respondent has restarted the numbering of the "affirmative defenses" from 1, to avoid confusion with the numbered paragraphs in the petition for cancellation, the Board will refer herein to the affirmative defense paragraphs as ¶ 1A, ¶ 2A, etc.

potentially replead the defenses. The Board granted respondent's request and allowed respondent until **SEPTEMBER 3, 2014, to replead its answer.**

Discovery and Stipulations

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.

As the parties' prior communications have been limited and considering that discovery has yet to open, the parties had not given consideration to discovery or testimonial stipulations. However, in view of the apparent difficulties in communicating between the parties and in the interest of minimizing issues based on non-receipt of properly served papers, the Board **ordered the parties to serve courtesy copies of all papers to the following confirmed email addresses:**

Petitioner: babatunde@kurosh.net & mail@kurosh.net

Respondent: lat@thompsoniplaw.com

To be clear, the parties will retain the five day grace period afforded the parties under Trademark Rule 2.119(c) so long as one of the prescribed

methods of service is utilized in conjunction with the courtesy service of the paper by email.

As mentioned by the Board during the conference, the parties are encouraged to consider ways in which to potentially limit and simplify discovery and testimony through reciprocal disclosures, stipulations of fact, and/or agreements. For instance, the parties may consider greater use of reciprocal disclosures and less use of formal discovery or streamlining their discovery by limiting the number of depositions,³ 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.

Alternative Dispute Resolution and Accelerated Case Resolution

The Board informed the parties that mediation and arbitration are outside resources available to the parties should they decide to avail themselves of such. Although the Board will not refer the parties to any particular arbitrator or mediator, the Board is amenable to suspending proceedings should the parties choose these alternatives to aid in settlement.

³ 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.

Accelerated Case Resolution (ACR) was also discussed and the parties were encouraged to further explore this option during the course of this proceeding. To facilitate such consideration, the parties are referred to the following for additional information on the procedure:

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

http://www.uspto.gov/trademarks/process/appeal/accelerated_case_resolution_acr_faq.doc

Conclusion

As noted by the Board during the conference, 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.

Dates are **RESET** as follows:

Amended Answer Due	9/3/2014
Discovery Opens	9/3/2014
Initial Disclosures Due	10/3/2014
Expert Disclosures Due	1/31/2015
Discovery Closes	3/2/2015
Plaintiff's Pretrial Disclosures Due	4/16/2015
Plaintiff's 30-day Trial Period Ends	5/31/2015
Defendant's Pretrial Disclosures Due	6/15/2015
Defendant's 30-day Trial Period Ends	7/30/2015
Plaintiff's Rebuttal Disclosures Due	8/14/2015
Plaintiff's 15-day Rebuttal Period Ends	9/13/2015

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party

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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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