

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

Mailed: May 9, 2014

Cancellation No. 92058763

John Wayne Enterprises, LLC

v.

Maria Mandarino and
Eugene Mandarino

**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 3:00 p.m. EDT on May 7, 2014. Board participation was requested by petitioner. During the conference, petitioner was represented by Lindsay J. Hulley; respondent Maria Mandarino appeared *pro se*; and participating for the Board was the above-signed Interlocutory Attorney.

Similar Proceedings and Consolidation

The Board asked if the parties were involved in any other Board proceeding (to determine whether consolidation or suspension was appropriate) or in litigation in any court (to determine whether suspension

was appropriate). The parties stated that they are not engaged in any other Board action or civil action involving the subject or pleaded mark.

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

Respondents are permitted to represent themselves, and their change of correspondence address (filed April 8, 2014) was noted. While Patent and Trademark Rule 11.14 permits a person to represent him/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. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties.

Joint Owners' Signature

Office records show that Maria Mandarino and Eugene Mandarino are individual, joint owners of the subject registration. Because the Mandarinos are not represented by an attorney or other permissible legal representative, they each must sign every paper (including the answer to the petition for cancellation) filed in this proceeding. *See, e.g.*, Trademark Rule 2.193(e)(2)(ii) (“In the case of joint applicants who are not represented by a qualified practitioner, all must sign.”); TMEP §611.06(a) (joint owners are individual parties, not a single entity, and when a document must be signed by someone with legal authority to bind joint owners, the document must be signed by all the owners); and §712.01 (each joint applicant not represented by a qualified practitioner must sign the response to an Office action.). *See also* TMEP §804.04 (a non-attorney who is authorized to verify facts on behalf of an applicant under Trademark Rule 2.33(a) is not necessarily entitled to sign responses to Office actions.... [S]ubmitting legal arguments in response to an examining attorney’s requirement or refusal of registration, constitutes representation of the applicant in a trademark matter. Under 5 U.S.C.

§500(d) and 37 C.F.R. §11.14(e), non-attorneys may not represent a party in a trademark proceeding before the USPTO).

Service of Papers

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.

The Board noted that Ms. Mandarino’s answer did not include a certificate of service, and reminded the parties that 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 [*insert method of service (e.g., first-class mail)*] to: [*insert name and address*].

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

The parties did not agree to email service, but instead agreed to traditional service with a courtesy copy sent by email. Petitioner's email addresses for courtesy copies are LHulley@rutan.com and trademarks@rutan.com. Respondents' email address for courtesy copies is bigrosies@comcast.net.

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, (571) 272-8500, ask to speak with a computer specialist, and provide the ESTTA tracking/confirmation number, if available. If something is due and ESTTA is down, use traditional mail and a certificate of mailing. *See* TBMP § 110 (3d ed. rev.2 2013). Addresses can be changed easily and consented motions can be filed in ESTTA, usually generating an immediate, automatic order granting the motion.

TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) contains the 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 usually get involved in substantive settlement negotiations. After initial disclosures, the ESTTA system will automatically grant scheduling motions filed using the "consent motions" form wizard for settlement purposes for approximately 12

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 12 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 will 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.

The parties stated that they held settlement discussions prior to the institution of this proceeding, and that their respective positions have not yet changed. The Board discussed the pleadings (see discussion, *infra*) and suggested the parties resume settlement negotiations. The parties remain open to the possibility of settlement, and agreed to continue the suspension of this case for sixty days to accommodate such discussions.

Pleadings

Upon review of the petition for cancellation, the Board found that petitioner’s ground of abandonment was properly pleaded. Respondents were informed of following definition of “abandonment” pursuant to Trademark Act § 45, 15 U.S.C. § 1127:

A mark shall be deemed to be “abandoned” ... [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Upon review of the answer, signed only by Ms. Mandarinino, the Board noted that the answer was argumentative and more in the nature of a brief on the case than a responsive pleading to the petition. In view of Ms. Mandarinino’s statements that respondents last “used the mark from 2003 to 2007” (Answer, para. 2), that they “have not abandoned [their] mark” but merely “postponed [their] use,” and “that plans are underway for the [mark]” (Answer, para. 4), it appears that respondents’ nonuse in interstate commerce of the registered mark for the relevant services for at least three years constitutes a *prima facie* showing of abandonment, so the burden would shift to respondents to show evidence of an intent to resume use to disprove the presumed fact of no intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and *Stromgren Supports, Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997). To show intent to resume use, respondents must put forth evidence with respect to either specific activities undertaken during the period of nonuse or special circumstances which excuse nonuse. *See*

Imperial Tobacco, 14 USPQ2d at 1394. *See also Rivard*, 45 USPQ2d at 1376 (“To provide excusable nonuse, the registrant must produce evidence showing that, under his particular circumstances, his activities are those that a reasonable businessman, who had a bona fide intent to use the mark in United States commerce, would have undertaken.”).

Notwithstanding Ms. Mandarino’s statements in her answer, the Board made no determination on the issue of abandonment, and reminded the parties that the ultimate burden of persuasion remains with petitioner (as the party claiming abandonment) to prove abandonment by a preponderance of the evidence. *Online Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). The Board construed the remainder of the answer as a general denial by Ms. Mandarino of the allegations in the petition.

It was noted that respondent Eugene Mandarino did not file an answer, and he is, therefore, in technical default. In view of the answer filed by Ms. Mandarino, and because respondents are appearing *pro se*, the Board found good cause to set aside Mr. Mandarino’s technical default. Mr. Mandarino must file an answer to the petition for cancellation when proceedings are resumed.

Accelerated Case Resolution (ACR)

The Board discussed the possibility of accelerated case resolution (ACR). The Board stated that this case appears to be a good candidate for

ACR and encouraged the parties to consider ACR if the case doesn't settle. The parties did not agree to ACR, but did agree to limit discovery to four months. The parties are encouraged to stipulate to ACR upon resumption of proceedings, and to contact the Board for further discussion and administration. The parties should consider stipulating, at a minimum, to petitioner's standing and respondents' last date of use of the mark in commerce.

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, for TTAB suggestions, and for 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 the 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).

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.¹

A. The Board's Standardized Protective Order

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 all three 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). Respondents were informed that, as parties representing themselves, they may not have access to a certain level of higher designation of confidentiality should it be used by petitioner. The parties were directed to the standardized protective order on the Board's home page.

¹ Of course, not all subject matters discussed in § 414 will be applicable to the sole ground in this case.

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 petition for cancellation and current answer, discovery should focus on respondents' last use of the mark and their intent to resume use. Discovery concerning petitioner's intent to use the pleaded mark may also be appropriate. The parties may, of course, serve discovery requests on other matters to ascertain whether there may be additional grounds for cancellation or affirmative defenses. However, if initial responses do not indicate the existence of any such ground or defense, discovery on those matters should not be pursued.

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

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 on the schedule at the end of this order. The parties may serve initial disclosures before the due date. A party seeking discovery, or a party filing a motion for summary judgment, must serve initial disclosures before serving discovery or a summary judgment motion, except that a summary judgment motion may be filed in connection with certain limited circumstances before initial disclosures are served. *See* TBMP § 528.02 (3d ed. rev.2 2013). The exceptions do not appear applicable to this proceeding. The parties may mutually agree to waive initial disclosures but did not do so during the conference.

E. Expert Disclosures

The parties stated that they do not expect to use expert testimony in this case. *See* TBMP § 401.03 (3d ed. rev.2 2013).

Schedule

Proceedings remain suspended for sixty days to allow for settlement negotiations. Dates were reset on the following schedule.

Proceedings Resume	7/7/2014
Mr. Mandarino's Answer Due	7/14/2014
Discovery Opens	7/21/2014
Initial Disclosures Due	8/20/2014
Expert Disclosures Due	10/22/2014
Discovery Closes	11/21/2014
Plaintiff's Pretrial Disclosures	1/5/2015
Plaintiff's 30-day Trial Period Ends	2/19/2015
Defendants' Pretrial Disclosures	3/6/2015
Defendants' 30-day Trial Period Ends	4/20/2015
Plaintiff's Rebuttal Disclosures	5/5/2015
Plaintiff's 15-day Rebuttal Period Ends	6/4/2015

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.