

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: January 19, 2016

Cancellation No. 92060328

L.A. Gem and Jewelry Design, Inc.

v.

Souki Manufacturing Inc.

**M. Catherine Faint,  
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on Thursday, January 14, 2016, between Milord A. Keshishian, Atty., counsel for Petitioner, L.A. Gem and Jewelry Design, Inc. and Mr. Nobuhiko Minaki, appearing pro se for Respondent, Souki Manufacturing, Inc.

The parties confirmed that there are no currently pending related Board proceedings, federal district court actions, or third-party litigation involving both parties. The parties indicated they have been discussing settlement prior to the discovery conference, but have been unable to reach agreement. The parties indicated that they were familiar with the Board's electronic resources for filing papers electronically.

**1. Legal Representation Strongly Recommended**

As discussed, while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board 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.

Respondent has been informed by prior Board orders regarding the advisability of hiring legal counsel, and resources for information about the Board's Rules and how to conduct proceedings. While the Board has been patient in explaining these Rules to Respondent, Respondent is cautioned that it is expected to participate in these proceedings, to understand and follow the Board's Rules and procedures and the Federal Rules of Civil Procedure. Respondent has a duty to learn and follow the applicable Trademark Rules of Practice and Board procedure which are readily accessible on the USPTO web site at [www.uspto.gov](http://www.uspto.gov), and fully explained in the Trademark Board Manual of Procedure (TBMP) (2015).

Respondent is cautioned that its pro se status will not excuse any noncompliance with the rules.

Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d

1212, 1212 (TTAB 2006). If Respondent decides to continue without counsel, it is urged to frequently consult the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark rules of practice, which are available from the USPTO website at [www.uspto.gov](http://www.uspto.gov).

## **2. Requirement for Service of Papers**

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) 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 further 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 [name of party] by forwarding said copy, via email to: [insert name and email address].

Signed: \_\_\_\_\_ Date: \_\_\_\_\_

The certificate of service must be signed and dated. *See also* TBMP § 113.

Respondent is reminded that the certificate of mailing procedure is not available for submissions filed with the Board by mail from outside of the United States. *See* Trademark Rule 2.197; TBMP § 110. Respondent is urged to continue filing submissions herein through the Board's ESTTA database.

### **3. Email Service**

The parties stipulated to accept service of papers by email, and that Petitioner may be served at the following email address: [uspto@milordlaw.com](mailto:uspto@milordlaw.com), and that Respondent may be served at the following email address: [mina-csj@nifty.com](mailto:mina-csj@nifty.com). The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional five days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail.

### **4. Electronic Resources**

The Board has an electronic filing system that is different than the one used to file Trademark applications and updates to registrations. This system, named ESTTA, may be accessed via the Board's website: <http://estta.uspto.gov/>. To highlight some features of the system, when a filing is made, a pre-populated cover sheet is generated; filings then may be attached in a .PDF format; if the filing has

successfully been completed, the filer will receive an ESTTA tracking number; if there are any problems, call the Board at 571-272-8500 and ask to be put through to one of the customer service specialists.

Addresses can be changed easily through an electronic form. Also, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.

Also available to the parties is the Board's TTABVue system which contains all of the Board's electronic files, including the one for this case. The parties may wish to conduct a status check of this case at least twice per month to be sure something is not missed. Most law firms already have a system for periodically checking status, and applicant may access TTABVue through the Board's website at: <http://ttabvue.uspto.gov/ttabvue/>.

## **5. TBMP**

The Board directed the parties to TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at: [http://www.uspto.gov/trademarks/process/appeal/Preface\\_TBMP.jsp](http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp). The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should also look to the Trademark Rules for specific guidance. TBMP § 414 provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

## 6. Initial Disclosures

Initial disclosures are the witnesses, documents and things having or containing relevant information. Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii):

- (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 Board noted that discovery was set to open January 23, 2016, and the exchange of discovery requests could not occur until discovery opens. The parties indicated that they have already served initial disclosures on each other. Any concerns about the adequacy of initial disclosures must be addressed well prior to the close of discovery. See Trademark Rule 2.120 (e)(1).

## 7. Board's Standard Protective Order

The Board advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. See Trademark Rule 2.116(g). The Board's standard protective order is available on the website at: <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval. The Board noted that inasmuch as Respondent is representing itself pro se in this case, it would be unable to view any

documents produced by Petitioner that have been designated “Highly Confidential – For Attorneys Eyes Only.” The Board advised, however, that Respondent could hire an attorney to review such documents and/or contest the appropriateness of the “Highly Confidential – For Attorneys Eyes Only” designation by seeking an in camera inspection by the Board of such documents designated “FOR ATTORNEYS EYES ONLY.”

#### **8. Review of the Pleadings**

With regard to the pleadings, the Board noted that the ESTTA cover sheet to the petition to cancel alleges a count of abandonment. Petitioner appears to have adequately alleged an abandonment claim in the body of the petition to cancel that Respondent’s mark has been abandoned due to nonuse with intent not to resume use, and nonuse for at least three consecutive years, if shown, can be prima facie evidence of abandonment. *See Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (plaintiff must allege ultimate facts pertaining to the alleged abandonment).

The Board’s order of December 29, 2015 construed Respondent’s answer as a general denial.

#### **9. Discovery**

The parties were directed to TBMP § 414 regarding the discoverability of various categories of information in Board proceedings. The Board suggested to the parties that they could in the future adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories,

document production requests, or admission requests, and to stipulate to the authenticity of documents. The parties declined to stipulate to limitations to discovery, and did not contemplate that there would be any significant electronically stored information at this stage of the proceeding.

### **Schedule**

Dates remain as set in the Board's order of December 29, 2015, as copied below.

Discovery Opens	1/23/2016
Initial Disclosures Due	2/22/2016
Expert Disclosures Due	6/21/2016
Discovery Closes	7/21/2016
Plaintiff's Pretrial Disclosures Due	9/4/2016
Plaintiff's 30-day Trial Period Ends	10/19/2016
Defendant's Pretrial Disclosures Due	11/3/2016
Defendant's 30-day Trial Period Ends	12/18/2016
Plaintiff's Rebuttal Disclosures Due	1/2/2017
Plaintiff's 15-day Rebuttal Period Ends	2/1/2017

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.

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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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