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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061135
Party	Defendant Weems Industries, Inc.
Correspondence Address	BRIAN LAURENZO BRICK GENTRY PC 6701 WESATOWN PKWY , STE 100 WEST DES MOINES, IA 50266 UNITED STATES brian.laurenzo@brickgentrylaw.com, jessica.susie@brickgentrylaw.com, carole.mcfadden@brickgentrylaw.com
Submission	Reply in Support of Motion
Filer's Name	Brian J. Laurenzo
Filer's e-mail	carole.mcfadden@brickgentrylaw.com
Signature	/bjl/
Date	06/02/2015
Attachments	Registrant's Reply in Support of Motion to Suspend Proceeding.pdf(2142134 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MATTOON RURAL KING SUPPLY, INC.,	)	Cancellation No.: 92061135
Petitioner,	)	Registration No.: 3765628
v.	)	Filing Date: May 26, 2009
WEEMS INDUSTRIES, INC. d/b/a LEGACY MANUFACTURING COMPANY,	)	Registration Date: March 23, 2010
Registrant.	)	

REGISTRANT'S REPLY IN SUPPORT OF MOTION TO SUSPEND PROCEEDING

COMES NOW, Registrant, Weems Industries, Inc. d/b/a Legacy Manufacturing Company (hereinafter "Weems"), pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), and for its Reply in Support of its Motion to Suspend Proceedings, states as follows:

1. The civil action in question clearly "may have a bearing on [this] case," as it involves the same parties, the same mark, and will address the same alleged issues as this cancellation, to wit: functionality, shade confusion, and acquired distinctiveness. "It is generally the Board's policy to suspend when the parties are engaged in such a civil action." Boyds Collection, Ltd. v. Herrington & Co., 65 U.S.P.Q.2d 2017 (TTAB Jan. 16, 2003).

2. Although suspension is permissive, suspension should only be denied when a party seeks to use suspension as a means to avoid a potentially dispositive motion or to delay the outcome of a proceeding where there would be little or nothing to resume upon conclusion of the civil action. Id. These circumstances do not exist in this matter. There are no dispositive motions pending, discovery has not been undertaken, and this case will not be fully submitted for at least a year.

3. Petitioner claims the TTAB's decision will probably be faster and to the advantage of both sides and argues issues preclusion may apply. However, this is simply not true. Weems' Resistance to Rural King's Motion to Stay the district court action is attached hereto and incorporated herein by this reference. As briefed in the civil action, a stay by the district court in favor of the TTAB will only result in a waste of judicial and administrative resources as any decision of this Board would still be subject to a *de novo* trial before the district court where the court would be allowed to take additional evidence and witnesses. CAE, Inc. v. Clean Eng'g, Inc., 267 F.3d 660, 673 (7th Cir. 2001). To the contrary, the District Court's determinations of functionality, shade confusion, and acquired distinctiveness will be dispositive in this proceeding. B&B Hardware, Inc. v. Hargis Indus., Inc., 575 U.S. ___, 135 S. Ct. 1293 (March 24, 2015) ("When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment.").

4. Furthermore, since the TTAB cannot determine infringement, award damages, or grant injunctive relief, a stay in the civil action will allow Rural King to continue its infringing actions unabated into the foreseeable future at the expense of Weems. Rhoades v. Avon Prods., 504 F.3d 1151, 1164 (9th Cir. 2007); PHC v. Pioneer Healthcare, 75 F.3d 75, 80-81 (1st Cir. 1996); Goya Foods, Inc. v. Tropicana Prod., Inc., 846 F.2d 848, 853-54 (2d Cir. 1988); see also Cornerstone Sys. V. Cornerstone Logistics USA L.P., 2010 U.S. Dist. LEXIS 62635 (W.D. Tenn. 2010); Just Enters. v. (888) Justice, Inc., 2007 U.S. Dist. LEXIS 9040 (W.D. Mo. 2007); Spring Air Co. v. Englander Licensing LLC, 2001 U.S. Dist. LEXIS 19849 (N.D. Ill. 2001); McGuire v. Regents of the Univ. of Michigan, 2000 U.S. Dist. LEXIS 21615 (S.D. Ohio 2000); Fight for Children, 1997 U.S. Dist. LEXIS 24020; Forschner Group v. B-Line A.G., 943 F.Supp. 287, 290-91 (S.D. N.Y. 1996); Maritz Inc. v. Cybergold Inc., 947 F. Supp. 1328, 1336 (E.D. Mo.

1996); Hanlon Chem. Co. v. Dymon, Inc., 1991 U.S. Dist. LEXIS 1345 (D. Kan. 1991); W&G Tennessee Imports, Inc. v. Esselte Pendaflex Corp., 769 F. Supp. 264, 265 (M.D. Tenn. 1991); Am. Bakeries Co. v. Pan-O-Gold Baking Co., 650 F. Supp. 563 (D. Minn. 1986).

5. Finally, denying the suspension in this case will prejudice both parties, as the parties may then be forced to litigate in two separate tribunals, which duplicates motions and risks inconsistent rulings. Society of Mexican American Engineers & Scientists, Inc. v. GVR Pub. Relations Agency, Inc., 2002 TTAB LEXIS 697 (TTAB Nov. 6, 2002).

WHEREFORE, Registrant respectfully requests the Board suspend these proceedings pending the conclusion of the civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) and grant such other and further relief the Board deems equitable in the premises.

Respectfully submitted,

Date: 6/2/15

By: Brian J. Laurenzo

Brian J. Laurenzo (Reg. No. 34,207)
BRICK GENTRY P.C.
6701 Westown Parkway, Suite 100
West Des Moines, IA 50266
Ph. 515-271-1748
Fax 515-274-1488
ATTORNEY FOR RESPONDENT

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Registrant's Reply in Support of its Motion to Suspend Proceedings has been served on Frank B. Janoski, Eric D. Block, and Michael J. Hickey, Esqs., by mailing said copy in a postage prepaid envelope deposited in a box under the custody of the U.S. Postal Service on this 2nd day of June, 2015, to Lewis Rise LLC, Box IP Department, 600 Washington Avenue, Suite 2500, St. Louis, Missouri 63101.

Signature: Carol McFadden
Date: 6/2/2015

CERTIFICATE OF FILING

I hereby certify that this document is being filed electronically on-line as a PDF document filing form to the Assistant Commissioner for Trademarks this this 2nd day of June, 2015.

Signature: Carol McFadden
Date: 6/2/2015

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF IOWA
CEDAR RAPIDS DIVISION

WEEMS INDUSTRIES, INC. d/b/a LEGACY MANUFACTURING COMPANY, Plaintiff, v. MATTOON RURAL KING SUPPLY, INC. Defendant.	Case No. **1:15-cv-00036-LRR**

PLAINTIFF'S RESISTANCE TO DEFENDANT'S MOTION TO STAY CASE AND ALL DEADLINES

COMES NOW the Plaintiff, Weems Industries, Inc. d/b/a Legacy Manufacturing Company (hereinafter "Weems"), by and through its attorneys, pursuant to Local Rule 7(e), and for its Resistance to Defendant, Mattoon Rural King Supply, Inc.'s (hereinafter "Rural King"), Motion to Stay Case and All Deadlines, states as follows:

INTRODUCTION

In this case, Weems' Complaint alleges four separate counts: (1) federal trademark infringement based upon common law rights, (2) federal unfair competition, (3) federal trademark infringement based upon Plaintiff's U.S. Registration No. 3,765,628, and (4) Iowa unfair competition. Prior to filing a responsive pleading, Rural King has requested a stay of this case and all deadlines pending a decision from the Trademark Trial and Appeal Board ("TTAB") in a cancellation proceeding brought by Rural King against Weems' supplemental trademark registration. Weems has already requested a stay in this cancellation proceeding, and at the time of the filing of this resistance, a ruling has not been made by the TTAB on this request.

Regardless, because a decision from the TTAB in the cancellation proceeding will not resolve all issues in this case, a stay will greatly prejudice Weems, and a stay will result in increased costs and wastefulness, it is in the interests of judicial economy to not stay this case.

STANDARD OF REVIEW

"[T]he power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants." Landis v. N. Am. Co., 229 U.S. 248, 254 (1936). The party seeking a stay "must make out a clear case of hardship or inequity in being required to go forward, if there is even a fair possibility that the stay for which he prays will work damage to someone else." Id. at 255.

ARGUMENT

A. A Stay of this Action Will Significantly Prejudice Weems.

Rural King first asserts that a stay will not unduly prejudice or tactically disadvantage Weems. In support, Rural King claims the "central issue" of this case is what trademarks rights, if any, Weems possesses in its chartreuse colored air hoses. Rural King reads Weems' Complaint too narrowly and its own Cancellation Petition too broadly. Weems' Complaint asserts a trademark infringement claim under the mark it has on the Supplemental Register, which is subject to the cancellation proceeding. However, Weems also has a broader claim based on its common law trademark rights as well as state and federal claims for unfair competition. The TTAB is incapable of resolving the trademark infringement and unfair competition claims. Apple Computer, Inc. v. Podfitness, Inc., 2007 U.S. Dist. LEXIS 36347 (N.D. Cal. 2007); see also 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:3 (4th ed. 2005) ("Although a federal registration will give the owner of a

mark important legal rights and benefits, the registration does not create the trademark. . . . [T]he absence or cancellation of a registration does not invalidate the trademark. It is the use of the mark to identify a single source which creates exclusive trademark rights."). Accordingly, the TTAB cancellation proceeding will only address one of the four counts before this court. See Fight for Children, Inc. v. Fight Night, Inc., 1997 U.S. Dist. LEXIS 24020 (D. D.C. 1997) (refusing to stay a district court action because a TTAB proceeding and a district court action "involve substantially different questions" as the "TTAB litigation concerns the *registration* of the [mark], whereas this [district court action] concerns the *use* of that mark." (emphasis in original)).

Further showing the inefficiency of a stay is that no matter what the result of the TTAB cancellation proceeding, this matter would still have to be returned to this court for future proceedings. Although Rural King's argument presupposes success before the TTAB, no matter who prevails, the only effect of a stay would be the passage of time. For instance, if the TTAB rules in favor of Weems, the TTAB cannot determine infringement, unfair competition, award damages, or grant injunctive relief. Paramount Pictures Corp. v. White, 31 U.S.P.Q.2d 1768, 1771 n.5 (TTAB 1994) ("The Board has no jurisdiction over claims of trademark infringement and unfair competition. The proper forum for such claims is a civil action."); Allied Mills, Inc. v. Janitor Supply Co., 188 U.S.P.Q. 507 (N.D. Ind. 1975) ("[I]f [registrant] won in the opposition proceeding, it would not be conclusive on the success of [registrant] in this infringement and unfair competition action."). Therefore, the case would still have to be returned to this court to make these determinations. Additionally, if Rural King would prevail before the TTAB, the cancellation proceeding would be subject to relitigation. Calista Enters. v. Tenza Trading, Ltd., 2103 U.S. Dist. LEXIS 164356 (D. Ore. Nov. 19, 2013). A party that has not prevailed before

the TTAB may appeal to the U.S. Court of Appeals for the Federal Circuit, 15 U.S.C. § 1071(a), or alternatively elect for a *de novo* judicial trial, 15 U.S.C. § 1071(b). At a *de novo* trial, the parties may request additional relief and submit new evidence. CAE, Inc. v. Clean Eng'g, Inc., 267 F.3d 660, 673 (7th Cir. 2001). Therefore, under this circumstance, granting a stay would only serve to postpone resolution of all issues by this court.

The passage of time resulting from a stay would cause significant prejudice to Weems. Because the TTAB cannot grant injunctive relief, the result of this delay will be to allow Rural King to continue its infringing activities unfettered. Rhoades v. Avon Prods., 504 F.3d 1151, 1164 (9th Cir. 2007); see also PHC v. Pioneer Healthcare, 75 F.3d 75, 80-81 (1st Cir. 1996); Goya Foods, Inc. v. Tropicana Prod., Inc., 846 F.2d 848, 853-54 (2d Cir. 1988). As the Second Circuit has aptly stated:

> [W]here . . . a district court suit concerns infringement, the interest in prompt adjudication far outweighs the value of having the views of the PTO. Whether a litigant is seeking to halt an alleged infringement or, as in this case, seeking a declaration of noninfringement, it is entitled to have the infringement issue resolved promptly so that it may conduct its business affairs in accordance with the court's determination of its rights. Delaying consideration of Goya's claim pending the outcome of the TTAB proceedings undercuts the purpose of declaratory relief by forcing Goya either to abandon use of trademarks it has had for more than a decade or to persist in piling up potential damages.

Goya, 846 F.2d at 853-54; see also Rhoades, 504 F.3d at 1165 (holding if a potential infringement claim "requires the district court to resolve much or all of the substance of [the registration issues], it would waste everyone's time not to settle the registration issue now [in district court].").

In a single footnote, Rural King cites "the doctrine of primary jurisdiction" as further support of granting a stay. However, a majority of courts, including three district courts from this circuit, have rejected this doctrine finding it inapplicable to proceedings before the TTAB.

Rhoades, 504 F.3d at 1164; PHC, 75 F.3d at 80-81; Goya Foods, 846 F.2d at 848; Just Enters. v. (888) Justice, Inc., 2007 U.S. Dist. LEXIS 9040 (W.D. Mo. 2007); Maritz Inc. v. Cybergold Inc., 947 F. Supp. 1328, 1336 (E.D. Mo. 1996); Am. Bakeries Co. v. Pan-O-Gold Baking Co., 650 F. Supp. 563 (D. Minn. 1986); see also Cornerstone Sys. V. Cornerstone Logistics USA L.P., 2010 U.S. Dist. LEXIS 62635 (W.D. Tenn. 2010); Spring Air Co. v. Englander Licensing LLC, 2001 U.S. Dist. LEXIS 19849 (N.D. Ill. 2001); McGuire v. Regents of the Univ. of Michigan, 2000 U.S. Dist. LEXIS 21615 (S.D. Ohio 2000); Fight for Children, 1997 U.S. Dist. LEXIS 24020; Forschner Group v. B-Line A.G., 943 F.Supp. 287, 290-91 (S.D. N.Y. 1996); Hanlon Chem. Co. v. Dymon, Inc., 1991 U.S. Dist. LEXIS 1345 (D. Kan. 1991); W&G Tennessee Imports, Inc. v. Esselte Pendaflex Corp., 769 F. Supp. 264, 265 (M.D. Tenn. 1991). The basis for the rejection of this doctrine is, in part, and contrary to Rural King's assertions, that "the area of trademark infringement and unfair competition are ones in which the courts have long-standing familiarity," and are areas "Congress has expressly given the courts the authority to decide." See Just Enters., 2007 U.S. Dist. LEXIS 9040 at *27. Thus, while the courts can respect the expertise of the TTAB, "the benefits of waiting for its ruling would be outweighed by the delay that would occur if this Court refused to act until after the TTAB determined the validity of [Registrant's] trademark." W&G, 769 F.Supp. at 266.

Rural King further attempts to argue it will be prejudiced by allowing this case to proceed because it plans to file a motion challenging this Court's jurisdiction. Rural King provides no support for its jurisdictional statements and its claim is premature. Nonetheless, Rural King's litigation strategy or personal decisions to file a motion of disputed merit is entirely its own and has no bearing on the prejudice analysis. To the contrary, the threat of filing this motion is another example of Rural King's strategy to delay and prejudice Weems in this case. If this

Court grants the stay and the delay of all deadlines, this jurisdictional question will still be present, and upon the lifting of the stay at some unknown future date, Rural King could still file the motion, conduct jurisdictional discovery, and cause the parties to expend significant time and money before ever reaching the merits of this case. As a result, the only effect the requested stay will have on this potential jurisdictional motion will be that it would now be litigated with stale facts and faded memories.

B. A Stay Will Not Simplify the Issues in Question or Trial.

Rural King further asserts a stay will simplify the issues in question or trial. However, as stated above, the problem with this assertion is that a trial before the district court will still be required no matter what the eventual result is in the TTAB proceeding. As stated, even assuming Rural King prevails before the TTAB, this Court would still hold a *de novo* trial where the parties may request additional relief and submit new evidence. CAE, 267 F.3d at 673.

Rural King has cited to *Kemin Industries, Inc. v. Watkins Products, Inc.*, 183 U.S.P.Q. 799 (D. Minn. 1974) claiming a stay can conserve judicial resources. However, the *Kemin* case has already been questioned as a ruling based more on that court's recognition of its own backlog than on actual conservation of judicial resources. See 3-11 Gilson on Trademarks § 11.03[3]; see also Questor Corp. v. Wold Indus., Inc., 194 U.S.P.Q. 141 (D. Minn. 1976); see also Kemin, 183 U.S.P.Q. at 799 ("Due to two long and complex cases this Court's docket is extremely crowded. . . . With the situation in this Court, it will be to the advantage of both sides to let the Patent Office move initially in this area."). As stated above, deferring to the TTAB just to have a de novo trial or a trial for infringement and damages does not conserve judicial resources and significantly prejudices Weems.

Rural King also cites *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293 (March 24, 2015) for the proposition that issue preclusion may apply to any ruling of the TTAB. However, *B&B* is clearly distinguishable because in that case, after the TTAB determined Hargis' mark could not be registered, Hargis did not seek judicial review in either the Federal Circuit or District Court. Id. at 1302. This procedural feature is still in play in this case, thus, eliminating the potential issue preclusion issue entirely. Furthermore, in *B&B*, the U.S. Supreme Court specifically held that issue preclusion may not apply to "many registrations." Id. at 1306. Before issue preclusion applies, the "ordinary elements of issue preclusion" must be met. Id. In this regard, "materiality" is often essential. Id. at 1308.

> If a mark owner uses its mark in ways that are materially the same as the usages included in its registration application, then the TTAB is deciding the same likelihood-of-confusion issue as a district court in infringement litigation. By contrast, if a mark owner uses its mark in ways that are materially unlike the usages in its application, then the TTAB is not deciding the same issue. Thus, if the TTAB does not consider the marketplace usage of the parties' marks, the TTAB's decision should "have no later preclusive effect in a suit where actual usage in the marketplace is the paramount issue."

Id. (quoting 6 McCarthy § 32:101, at 32-246). In this case, it is premature to discuss how the TTAB will consider materiality and actual use; therefore, there is no way to determine if issue preclusion will even apply at all.

Finally, it is also important to note that while the preclusive effect of a TTAB ruling is subject to substantial dispute, a district court ruling in this matter will fully resolve the TTAB cancellation proceeding. See id. at 1305-06 ("When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment."). For these reasons, there is no guarantee a decision by the TTAB will have any effect on this Court, and what effect it could have cannot outweigh the prejudice Weems would suffer by the stay. See Goya, 846 F.2d at 853-54.

C. A Stay is Not Appropriate because this Case is in its "Infancy."

Lastly, Rural King argues a stay is appropriate because this case is in its infancy. However, this argument cuts both ways, as the cancellation proceeding is also in its infancy. Weems has filed an answer in the cancellation proceeding, and concurrently therewith filed a motion to stay the cancellation proceedings pending the resolution of this district court action. At the time of the filing of this resistance, a ruling from the TTAB is pending. In both actions, neither party has performed any discovery nor significantly addressed the merits of the claims. Since the TTAB is also in its infancy, this factor is negligible.

Further, Weems disagrees with Rural King's assertion that "if a party become[s] dissatisfied with the pace at which the TTAB Proceeding progresses (which Rural King estimates will conclude within approximately six to nine months), the stay could be lifted." Seeing that Rural King is asking for this stay, it is hard to believe it would not object to having this potential stay lifted, especially when Rural King can continue with its infringing activities unfettered due to the TTAB being unable to provide any injunctive relief. There is also no guarantee the TTAB would stay its proceedings if this Court were to lift its stay at a future date. Although it is generally the TTAB's policy to suspend proceedings when the parties are engaged in a civil action, there is an exception when parties seek a stay to avoid a potentially dispositive motion or to delay the outcome of a proceeding where there would be little to nothing to resume upon conclusion of the civil action. Boyds Collection, Ltd. v. Herrington & Co., 65 U.S.P.Q.2d 2017 (TTAB Jan. 16, 2003). If the TTAB refused to enter a stay at a future date and this court lifted its stay, the parties would be required to litigate the same issues before two different tribunals. This will result in a waste of judicial and administrative resources and an increased

risk of inconsistent rulings. See Society of Mexican American Engineers & Scientists, Inc. v. GVR Pub. Relations Agency, Inc., 2002 TTAB LEXIS 697 (TTAB Nov. 6, 2002).

Finally, assuming no extensions, the conference, discovery, disclosure and trial schedule set by the TTAB in the cancellation proceeding currently provides that this matter would not be fully submitted until June 10, 2016. A true and accurate copy of the TTAB Notification is attached hereto as Exhibit 1. Based on this schedule, there is no reason to believe the TTAB proceeding will be any faster than a district court action.

CONCLUSION

For the foregoing reasons, Weems respectfully requests the Court deny Rural King's Motion to Stay Case and All Deadlines, and order Rural King to file a responsive pleading within seven (7) days.

Respectfully submitted this 1st day of June 2015.

BRICK GENTRY P.C.

By: */s/ Brian J. Laurenzo*

BRIAN J. LAURENZO, # 6197605
STEVEN P. BRICK, Iowa AT0001084
MATT O'HOLLEARN, Iowa AT0010122
6701 Westown Parkway, Suite 100
West Des Moines, IA 50266
Telephone: (515) 274-1450
Fax: (515) 274-1488
Email: brian.laurenzo@brickgentrylaw.com
Email: steve.brick@brickgentrylaw.com
Email: matt.ohollearn@brickgentrylaw.com
ATTORNEYS FOR PLAINTIFF

Electronically filed.

CERTIFICATE OF SERVICE

I hereby certify that, on June 1, 2015, a copy of the above and foregoing was served upon Defendant's counsel, via the Court's ECF system, as follows:

Stephen J. Holtman
115 Third Street SE, Suite 1200
Cedar Rapids, IA 52401
sholtman@simmonsperrine.com

Frank B. Janoski
Michael J. Hickey
Eric D. Block
600 Washington Avenue, Suite 2500
St. Louis, MO 63101
fjanoski@lewisrice.com
mhickey@lewisrice.com
eblock@lewisrice.com
(pro hac vice motions to be filed)

/s/ Jennifer Chesney

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: March 23, 2015

Cancellation No. 92061135
Registration No. 3765628

WEEMS INDUSTRIES INC
6281 N GATEWAY DR
MARION IA 52302

Mattoon Rural King Supply, Inc.

v.

Weems Industries, Inc.

FRANK B JANOSKI
LEWIS RICE LLC
BOX IP DEPARTMENT
600 WASHINGTON AVE STE 2500
ST LOUIS MO 63101

Victoria von Vistauxx, Paralegal Specialist:

The petitioner (plaintiff) identified above has filed a petition for cancellation of the above-identified registration owned by respondent (defendant). A service copy of the petition for cancellation was forwarded to respondent by the petitioner. An electronic version of the petition for cancellation, and of the entire proceeding, is viewable on the Board's web page via the TTABVUE link: http://ttabvue.uspto.gov/ttabvue/.

PETITIONER DIRECTED TO FORWARD COPY TO OWNER OF RECORD

The Board acknowledges that petitioner included proof that it forwarded a service copy of its petition to respondent. However, the proof of service indicates that petitioner sent that service copy to an attorney for respondent, rather than to respondent. **As provided in amended Trademark Rule 2.111(a), a petitioner must include "proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record."** The rule does not

direct a petitioner to serve an attorney, though an attorney should be served if the attorney is the respondent's designated domestic representative. The reference in the rule to correspondence address is a reference to the address for the owner of the registration or the domestic representative, if one has been appointed. **While petitioner's proof of service is a reasonable attempt to effect service, petitioner is directed to forward an additional copy of its petition to the owner of record for the registration, at its address of record.** In addition, any future filing must be served directly on the owner of the registration. If an attorney files an answer or other paper for respondent, thereby entering an appearance, petitioner may thereafter forward service copies to that attorney rather than respondent.

RESPONDENT MUST FILE AND SERVE ANSWER

As required in the schedule set forth below, **respondent must file an answer within forty (40) days from the mailing date of this order.** (For guidance regarding when a deadline falls on a Saturday, Sunday or federal holiday, *see* Trademark Rule 2.196.) Respondent's answer must comply with Fed. R. Civ. P. 8(b), must contain admissions or denials of the allegations in the petition for cancellation, and may include available defenses and counterclaims. For guidance regarding the form and content of an answer, *see* Trademark Rule 2.114(b), and TBMP §§ 311.01 and 311.02. Failure to file a timely answer may result in entry of default judgment and the cancellation of the registration.

SERVICE OF ANSWER AND OF ALL FILINGS

The answer, and **all** other filings in this proceeding, **must** be served in a manner specified in Trademark Rule 2.119(b), and **must** include proof of service. For guidance regarding the service and signing of all filings, *see* TBMP §§ 113-113.04. As noted in TBMP § 113.03, proof of service should be in the following certificate of service form:

> *I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party).*
>
> *Signature*_____
> *Date*_____

The parties may agree to forward service copies by electronic transmission, *e.g.*, e-mail. *See* Trademark Rule 2.119(b)(6) and TBMP §113.04. Pursuant to Trademark Rule 2.119(c), however, five additional days are afforded only

to actions taken in response to papers served by first-class mail, "Express Mail," or overnight courier, not by electronic transmission.

LEGAL RESOURCES AVAILABLE AT WEB PAGE

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. These rules, as well as amendments thereto, the Manual of Procedure (TBMP), information on Accelerated Case Resolution (ACR) and Alternative Dispute Resolution (ADR), and many Frequently Asked Questions, are available on the Board's web page, at: http://www.uspto.gov/trademarks/process/appeal/index.jsp. For a general description of Board proceedings, *see* TBMP §102.03.

FILING PAPERS ONLINE

The link to the Board's electronic filing system, ESTTA (Electronic System for Trademark Trials and Appeals), is at the Board's web page, at: http://estta.uspto.gov/. The Board **strongly encourages parties to use ESTTA** for all filings. ESTTA provides various electronic filing forms; some may be used as is, and others may require attachments. For technical difficulties with ESTTA, parties may call 571-272-8500. Due to potential technical issues, parties should not wait until the last date of a deadline for filing papers. The Board may decline to consider any untimely filing.

PETITIONER'S OBLIGATION IF SERVICE IS INEFFECTIVE

If a service copy of the petition for cancellation is returned to petitioner as undeliverable or petitioner otherwise becomes aware that service has been ineffective, petitioner must notify the Board in writing within ten (10) days of receipt of the returned copy. Notification to the Board may be provided by any means available for filing papers with the Board, but preferably should be provided **by written notice filed through ESTTA**. For guidance regarding notice of ineffective service, *see* Trademark Rule 2.111(b) and TBMP § 309.02(c)(2).

While petitioner is under no obligation to search for current correspondence address information for, or investigate the whereabouts of, any respondent petitioner is unable to serve, if petitioner knows of any new address information for the respondent, petitioner must report the address to the Board. If a petitioner notifies the Board that a service copy sent to a respondent was returned or not delivered, including any case in which the notification includes a new address for the respondent discovered by or reported to petitioner, the Board will give notice under Trademark Rule 2.118.

FORMAT FOR ALL FILINGS

Trademark Rule 2.126 sets forth the required form and format for all filings. The Board may **decline to consider** any filing that does not comply with this rule, including, but not limited to motions, briefs, exhibits and deposition transcripts.

CONFERENCE, DISCOVERY, DISCLOSURE AND TRIAL SCHEDULE

Time to Answer	5/2/2015
Deadline for Discovery Conference	6/1/2015
Discovery Opens	6/1/2015
Initial Disclosures Due	7/1/2015
Expert Disclosures Due	10/29/2015
Discovery Closes	11/28/2015
Plaintiff's Pretrial Disclosures	1/12/2016
Plaintiff's 30-day Trial Period Ends	2/26/2016
Defendant's Pretrial Disclosures	3/12/2016
Defendant's 30-day Trial Period Ends	4/26/2016
Plaintiff's Rebuttal Disclosures	5/11/2016
Plaintiff's 15-day Rebuttal Period Ends	6/10/2016

PARTIES ARE REQUIRED TO HOLD DISCOVERY CONFERENCE

As noted in the schedule above, the parties are required to schedule and to participate with each other in a discovery conference by the deadline in the schedule. For guidance, *see* Fed. R. Civ. P. 26(f), Trademark Rule 2.120(a)(2), and TBMP § 401.01. In the conference, the parties are required to discuss (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling or at least narrowing the scope of claims or defenses, and (3) arrangements for disclosures, discovery and introduction of evidence at trial, if the parties are unable to settle at this time.

Discussion of amendments of otherwise prescribed procedures can include limitations on disclosures and/or discovery, willingness to stipulate to facts, and willingness to stipulate to more efficient options for introducing at trial information or materials obtained through disclosures or discovery.

The parties must hold the conference in person, by telephone, or by any means on which they agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference, upon request of any party, provided that such request is made no later than ten (10) days prior to the conference deadline. *See* Trademark Rule 2.120(a)(2). A request for Board participation must be made either through an ESTTA filing, or by telephone call to the assigned interlocutory attorney whose name

is on the TTABVUE record for this proceeding. A party should request Board participation only after the parties have agreed on possible dates and times for the conference. A conference with the participation of a Board attorney will be by telephone, and the parties shall place the call at the agreed date and time, in the absence of other arrangements made with the Board attorney.

PROTECTIVE ORDER FOR CONFIDENTIAL INFORMATION

The Board's Standard Protective Order is applicable, and is available at: http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp. During their conference, the parties should discuss whether they agree to supplement or amend the standard order, or substitute a protective agreement of their choosing, subject to approval by the Board. *See* Trademark Rule 2.116(g) and TBMP § 412. The standard order does not automatically protect a party's confidential information and its provisions for the designation of confidential information must be utilized as needed by the parties.

ACCELERATED CASE RESOLUTION

During their conference, the parties should discuss whether they wish to seek mediation or arbitration, and whether they can stipulate to follow the Board's Accelerated Case Resolution (ACR) process for a more efficient and economical means of obtaining the Board's determination of the proceeding. For guidance regarding ACR, *see* TBMP § 528. Detailed information on ACR, and examples of ACR cases and suggestions, are available at the Board's webpage, at: http://www.uspto.gov/trademarks/process/appeal/index.jsp.

DISCOVERY AND INTERLOCUTORY PROCEDURES

For guidance regarding discovery, *see* Trademark Rule 2.120 and TBMP Chapter 400, regarding the deadline for and contents of initial disclosures, *see* Trademark Rule 2.120(a)(2) and TBMP § 401.02, and regarding the discoverability of various matters, *see* TBMP § 414. Certain provisions of Fed. R. Civ. P. 26 are applicable in modified form. The interlocutory attorney has discretion to require the parties, or to grant a request made by one or both parties, to resolve matters of concern to the Board, or a contested motion, by telephone conference. *See* Trademark Rule 2.120(i)(1) and TBMP § 502.06(a).

TRIAL

For guidance regarding trial and testimony procedures, *see* Trademark Rules 2.121, 2.123 and 2.125, as well as TBMP Chapter 700. The parties should review authorities regarding the introduction of evidence during the trial phase, including by notice of reliance and by taking testimony from witnesses. For instance, any notice of reliance must be filed during the filing

party's assigned testimony period, with a copy served on all other parties, and any testimony of a witness must be both noticed and taken during the party's testimony period. A party that has taken testimony must serve on each adverse party a copy of the transcript of such testimony, together with copies of any exhibits introduced during the testimony, within thirty (30) days after completion of the testimony deposition.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing is not required, but will be scheduled upon request of any party, pursuant to Trademark Rule 2.129. For guidance regarding briefing and an oral hearing, *see* TBMP §§ 801-802.

PARTIES NOT REPRESENTED BY COUNSEL

This proceeding is similar to a civil action in a federal district court. The Board **strongly** advises all parties to secure the services of an attorney who is familiar with trademark law and Board procedure. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. Parties not represented by such an attorney are directed to read the Frequently Asked Questions, available at the Board's web page: http://www.uspto.gov/trademarks/process/appeal/index.jsp.

PARTIES MUST NOTIFY BOARD OF OTHER PENDING ACTIONS

If the parties are, or during the pendency of this proceeding become, parties in another Board proceeding or a civil action involving the same or related marks, or involving any issues of law or fact which are also in this proceeding, they shall notify the Board immediately, so the Board can consider whether consolidation and/or suspension of proceedings is appropriate. *See* TBMP § 511.

CC:

BRIAN LAURENZO
BRICK GENTRY PC
6701 WESTOWN PKWY STE 100
WEST DES MOINES IA 50266