

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: April 20, 2016

Cancellation No. 92062364

*Anom Suheri,
Anthony Marcotti,
Raymond Wilcoxon, and
D3 Holdings, LLC*

v.

Raihana Heuer

**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 held the mandatory settlement and discovery conference at 2:00 p.m. EDT on April 20, 2016. *See* TBMP § 401.01 (2015). Board participation was requested by Petitioners. Participating in the conference were Joshua Richman, and Ben White, counsel for Petitioners; Lindy Herman, counsel for Respondent; and Robert Coggins, the assigned Board attorney.

Similar Proceedings

The California district court action which prompted the Board's February 28, 2016 request for information has been dismissed under the doctrine of *forum non*

conveniens, and Respondent has withdrawn her earlier motion to suspend. *See* 10 and 11 TTABVUE. In view thereof, the former California civil action will not have a bearing on the Board case, and Respondent's motion to suspend was given no consideration.

Petitioners stated that the parties are now involved in a civil action in Padang, Indonesia. Inasmuch as Petitioners are plaintiffs in the Indonesian action, Petitioners were allowed until **May 5, 2016**, in which to file with the Board an English translation of the operative complaint (without exhibits) from that civil action. Upon review of the civil action complaint, the Board will consider whether suspension of this cancellation proceeding is appropriate. *See* Trademark Rule 2.117(a).

The parties stated that they are not currently involved in any other Board proceeding or third-party civil litigation involving the subject marks.

Nature of Board Proceedings

The Board apprised the parties of general procedural rules and guidelines that govern *inter partes* proceedings. The parties stated that they are familiar with Board proceedings.

Resources

The Board reminded the parties that they may access many legal resources, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP), Trademark Rules of Practice, and the standard protective order at the Board's home

page on the following URL: <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>.

The parties have used the ESTTA filing system (<http://estta.uspto.gov>) and TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) and are familiar with these electronic systems.

Settlement

Both parties stated that they are open to the possibility of settlement, and that settlement activity occurred prior to the conference. Inasmuch as settlement is generally confidential in nature, details about the settlement activities mentioned during the conference are not memorialized in this order.

The parties did not agree to suspend proceedings at this stage for their continuing settlement activities. The parties were informed that the Board is generous with periods of extension or suspension to facilitate settlement discussions. After the deadline for initial disclosures has passed, the parties may use the “consent motions” option in ESTTA to automatically obtain an extension or suspension of time for settlement, should the parties need such time. Prior to the deadline for initial disclosures, the parties should use the ESTTA “general filings” option and attach a proposed schedule with the desired new deadlines.

Email Service of Papers

The parties were reminded of their obligation to serve each paper filed with the Board, and the parties agreed to electronic service (by email). The parties agreed to use traditional means of service, with courtesy copies by email. Petitioners’ email

address for courtesy service copies is litigation@ipla.com, and Respondent's email address for courtesy service copies is lherman@fishiplaw.com.

Pleadings

Upon review of the Petition for Cancellation, the Board noted that Petitioners have sufficiently pleaded their standing and two grounds for cancellation, namely, priority and likelihood of confusion, and that Respondent is not (and was not, at the time she filed the applications underlying the subject registrations) the rightful owner of the registered marks and, similarly, did not possess the actual bona fide intent-to-use the mark.

Upon review of the Answer, the Board noted that Respondent had fairly and clearly met the allegations in the petition. However, the Board **struck** Respondent's first affirmative defense (failure to state a claim) with prejudice, and **struck** the remainder of the affirmative defenses without prejudice. The first affirmative defense (failure to state a claim) is inappropriate because it was (and had previously been) determined that the Petition for Cancellation sufficiently alleges Petitioners' standing and grounds for cancellation. The second through sixth defenses are nakedly pleaded. The seventh defense attempts to reserve unidentified defenses which do not provide Petitioner fair notice of a specific, available defense. While Respondent cannot reserve unidentified defenses, it is possible that Respondent may, in the

future, file a motion to amend her answer to add an affirmative defense. Any such motion would, of course, require either Petitioners' consent or leave from the Board.¹

In view of the striking of all seven defenses, Respondent was allowed until **May 5, 2016**, in which to file an amended answer that properly alleges any available affirmative defense; failing which, the case will proceed under the current answer as stricken.

Discovery

The parties were advised that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings. Not all of the topics will be relevant to the current, two-ground cancellation.

Citizenship

The Board inquired about the citizenship and residency of each party. Inasmuch as the individual parties all reside abroad, the parties were referred to TBMP §§ 404.03(b) and (d) and Trademark Rules 2.120(c) and 2.124. The Board asked the parties to consider efficiencies with any prospective deposition (if permitted by the country of residence), such as deposition by video-conference or telephone.

Standard protective order

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. Trademark Rule 2.116(g). Although they are not required to do so, the parties may elect to exchange

¹ Similarly, any unconsented motion to amend the Petition for Cancellation (for example, to reallege a ground of fraud) will require Respondent's permission or leave from the Board. Fed. R. Civ. P. 15(a)(2).

executed copies of the order. If the parties wish to modify the order in any manner, they must file a motion for the Board's approval of the modification(s). The parties stated that they do not anticipate amending the standard protective order.

Scope of discovery

The Board briefly mentioned the use of interrogatories, requests for admission, requests for production of documents and things, and depositions as discovery devices. Discovery should focus on ownership, priority, and likelihood of confusion of the involved marks. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973).

The parties discussed the possibility of narrowing the issues for discovery and trial, and possibly stipulating to certain facts (from the district court pleading) and/or *du Pont* factors or sub-factors.

The Board mentioned that recent amendments to the Federal Rules of Civil Procedure (e.g., proportionality and relevance in discovery) affect Board proceedings.

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 due to the public nature of trademarks. However, if the parties anticipate or encounter a problem, they should work together to resolve the matter. The parties stated that ESI should not be a problem in this case, and that given the remote location of potentially responsive documents for all parties they anticipate exchanging responsive documents in .pdf (or other electronic) format.

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.

Initial disclosures are due May 21, 2016. *See* schedule, *infra*. Disclosures should not be filed with the Board except under specific, limited circumstances. *See* Trademark Rule 2.120(j)(8). The Board reminded the parties that discovery may not be served, or a motion for summary judgment filed, until the serving or moving party has made initial disclosures (except that a motion for summary judgment may be filed prior to initial disclosures in connection with limited circumstances which do not appear to be at issue in this case). *See* TBMP § 528.02.

Accelerated Case Resolution (ACR)

The parties stated that they are open to, and are actively contemplating, the use of ACR. A discussion ensued about possible procedural and substantive efficiencies, and options for ACR; however, the parties did not stipulate during the conference to use ACR or any specific efficiency. The appreciated the parties' interest in and

discussion about ACR, and encouraged the parties to continue thinking about ACR. If the parties agree to ACR or other efficiencies, the parties are to contact the Board for further discussion and administration. In the meantime, the parties were referred to TBMP §§ 528.05(a)(2) and 702.04 and to the “ACR & ADR” section of the Board’s home page for more information on ACR.

Schedule

Petitioners were allowed until **May 5, 2016**, in which to file with the Board an English translation of the complaint from that Indonesian civil action. Respondent was also allowed until **May 5, 2016**, in which to file an amended answer alleging any available affirmative defense. Dates otherwise remain as set. For the parties’ convenience, the current schedule is reproduced below:

Civil Action Information Due from Petitioners	5/5/2016
Amended Answer Due, if Filed	5/5/2016
Discovery Opens	4/21/2016
Initial Disclosures Due	5/21/2016
Expert Disclosures Due	9/18/2016
Discovery Closes	10/18/2016
Petitioners’ Pretrial Disclosures	12/2/2016
Petitioners’ 30-day Trial Period Ends	1/16/2017
Respondent’s Pretrial Disclosures	1/31/2017
Respondent’s 30-day Trial Period Ends	3/17/2017
Petitioners’ Rebuttal Disclosures	4/1/2017
Petitioners’ 15-day Rebuttal Period Ends	5/1/2017

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. Briefs shall be filed in

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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.