

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: August 9, 2016

Opposition No. 92063902

Bigfoot Ventures LLC

v.

Anchor Audio, Inc.

Geoffrey M. McNutt, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(g)(1)–(2), the parties to this case conducted a discovery conference with Board participation on Tuesday, August 9, 2016, at 2:00 p.m. EDT. Roman Popov, counsel for Bigfoot Ventures LLC, appeared on behalf of Petitioner, and Gene Bolmarcich, counsel for Anchor Audio, Inc., appeared on behalf of Respondent. Geoffrey McNutt, Board Interlocutory Attorney, participated in the conference on behalf of the Board.

During the discovery conference, the parties advised the Board that they currently are not engaged in settlement discussions and thus a suspension of proceedings for that purpose is not warranted.

The parties further advised that there are no related Board proceedings or federal or state court actions concerning issues related to this case. In the event that a civil action or related Board proceeding between the parties is instituted, the parties are required to

promptly advise the Board so that the Board can determine whether suspension or consolidation is appropriate.

Pleadings

As an initial matter, the Board reviewed the parties' pleadings. Petitioner has asserted a claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Board determined that Petitioner's allegations regarding its standing and Section 2(d) claim have been sufficiently pleaded.¹ The Board then reviewed Respondent's answer and determined that it is sufficient.

Finally, the Board advised the parties that any motion for leave to amend a pleading to add a new claim or defense must be filed promptly after the facts supporting the new claim or defense are discovered. *See generally*, TBMP §§ 315 and 507.

Board's Standard Protective Order

The Board then advised the parties of the automatic imposition of the Board's standard protective order by operation of Trademark Rule 2.116(g), and further indicated that the parties would control which tier of confidentiality applies.² Because

¹ Petitioner was advised, however, that the plain copies of the pleaded registrations attached as exhibits to the petition for cancellation are not in evidence because they are not originals or photocopies of the registrations prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or current printouts of information from the electronic database records of the USPTO showing the current status and title of the registrations. Trademark Rules 2.122(c) and (d)(1); TBMP §§ 317 and 704.05(a) (2016).

² A Board opposition is a public proceeding. Accordingly, the parties should designate as confidential only those parts of their filings which genuinely comprise non-public information protected under the standard order. When a document containing confidential information is filed, the filer must also submit a redacted copy of the filing for the public file.

of the automatic imposition of the protective order, parties may designate information or documents as confidential but cannot withhold properly discoverable information or documents on that basis. *See* TBMP 412.01. Additionally, the Board stated that if the parties wish to modify the Board's standard protective order, they may attempt to do so by filing a motion for Board approval.

The Board further advised the parties that under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no authority to enforce the protective order. According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party may make a written request that such materials be destroyed rather than returned.

It is not necessary for the parties to sign copies of the protective order for it to take effect, although it may be desirable to do so. It is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242, 42,251 (August 1, 2007). Thus, the parties and their attorneys may find it advisable to sign a stipulated protective order, so that it is clear that they are bound by it; that they have created a contract which will survive the proceeding; and that there may be a remedy for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any

determination of whether such an agreement establishes contractual rights or is enforceable outside of the Board proceeding is for an appropriate tribunal to decide should such matter come before it. *Id.*

Discovery and Motions Practice

The Board then noted that the exchange of discovery requests may not occur until the parties make their initial disclosures as required by Fed. R. Civ. P. 26(f), nor may a party file a motion for summary judgment until it has made its initial disclosures, except for a motion asserting issue preclusion, claim preclusion, or lack of jurisdiction by the Board.

The Board also provided the parties instructions as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). In such disclosures, the parties should provide to each other

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 [and] 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.

Fed. R. Civ. P. 26(a)(1)(A)(i)–(ii). The parties should *not* file their respective initial disclosures (or any discovery) with the Board except as permitted under Trademark Rule 2.120(j)(8).

The parties are limited to seventy-five interrogatories, including subparts. *See* Trademark Rule 2.120(d)(1); TBMP Section 405.03. There is no rule limiting the

number of document requests or requests for admission that a party may serve, but the parties are reminded that each of them “has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case.” TBMP § 408.01. Pursuant to Fed. R. Civ. P. 26(b)(1), “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case[.]” The Board may limit excessive or inappropriate discovery upon a motion for a protective order.

Additionally, the Board expects parties to cooperate with one another in the discovery process and looks with disfavor on those who do not do so. *See* TBMP § 408.01. If either party plans to file a motion to compel discovery, the moving party must first confer with the other party in good faith to attempt to resolve or narrow the discovery dispute, and then must demonstrate its good-faith efforts as part of its motion to compel.

To the extent either party plans to use an expert witness, such party must make their expert witness disclosure by the set deadline, and provide the Board with notification that the party will be employing an expert. The Board may suspend proceedings as appropriate to allow the parties to take discovery of a designated expert witness or to allow a rebuttal expert witness.

Pretrial Disclosures

Pretrial disclosures are governed by Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). *See*

TBMP § 702.01. Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under Trademark Rule 2.121(e), however, does not substitute for service of a proper notice of examination under Trademark Rule 2.123(c) or 2.124(b). Additionally, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure. For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

The Board also encouraged the parties to cooperate and confer with one another in advance of trial with respect to the scheduling of testimony depositions.³

³ Because discovery and trial depositions can be taken anywhere in the United States (and sometimes abroad), they often require a substantial dedication of time and resources. The parties should attempt to schedule depositions in a way that is most convenient and economical for the witnesses and for both parties' counsel. It should be a very rare occasion when arrangements for a deposition become the subject of motions practice.

Finally, the Board advised the parties of the variety of options available to streamline the introduction of evidence at trial, including, for example, stipulations of fact, stipulations permitting trial testimony by means of written declaration (with or without reserving the right to live cross-examination), and stipulations permitting the introduction of various documents (*e.g.*, documents produced in response to document requests, business records, etc.) by notice of reliance.

Service of Papers

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO 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. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

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: (name and address of opposing counsel or party).

Signature_____

Date_____

The parties agreed to accept service of all papers and documents by email.⁴ Respondent's counsel indicated that emails directed to Respondent should be sent to gxbesq1@gmail.com. Petitioner's counsel indicated that emails sent to Petitioner should be directed to rp@mortonassociates.com.

The Board also advised the parties that because they have agreed to service by email, the parties may no longer avail themselves of the additional 5 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. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013). *See also* TBMP § 113.05.

Finally, it is strongly recommended that the parties file papers (including confidential filings) via ESTTA, the Board's electronic filing system.⁵ Documents uploaded to ESTTA are deemed filed upon successful completion of transmission to the Board, including the receipt of any required fee. Eastern Time controls the filing date. *See* TBMP § 110.09.

⁴ The Board also uses email when sending decisions, orders, or other notices to the parties. The Board will send email to the parties at the addresses they have provided, so it is essential that the parties promptly update their email and street addresses with any change. It is the parties' responsibility to take any necessary steps to ensure that papers from opposing counsel or the Board are not rejected by their spam filters. Where possible, it is strongly recommended that the Board's domain and that of opposing counsel be put on a "safe-senders list" of email which should not be rejected by a filter.

⁵ If the parties have questions about electronic filing or experience difficulties, they may call the Board's main number at (571) 272-8500 or (800) 786-9199 (toll free). The Board's Information Specialists are available to assist filers from 8:30 a.m. until 5:00 pm Eastern time, Monday through Friday. Filers are urged to plan ahead and to attempt to file well before any deadline. The Board cannot guarantee that any technical problem will be resolved quickly, and deadlines will not normally be extended in such a case. If ESTTA filing is not possible for any reason, parties must file by mail. *See* TBMP § 110 (certificate of mailing procedures).

The parties should not file consented motions to extend time prior to the deadline for initial disclosures by employing the “consented motion forms” in ESTTA. Instead, the parties should use the “general filing forms” option.

Accelerated Case Resolution

Finally, the Board advised the parties of the Board’s Accelerated Case Resolution (“ACR”) process. ACR is an alternative to typical Board *inter partes* proceedings with full discovery, trial and briefing. The form of ACR can vary, but the process generally approximates a summary bench trial or cross-motions for summary judgment and accompanying evidentiary submissions that the parties agree to submit in lieu of creating a traditional trial record and traditional briefs at final hearing. As already noted, the Board allows the parties to stipulate to a variety of deviations from the Board’s rules in order to streamline discovery and testimony. If the parties stipulate to ACR they could avoid a formal trial altogether. Although the Board may not decide disputed issues of fact when considering a motion for summary judgment,⁶ the parties may stipulate to the submission of such briefs and evidence in lieu of trial and agree that the Board may make any factual determinations based on such a record. If the parties agree to ACR relatively early in the proceeding, they could realize a very significant saving in time⁷ and cost. More information about the Board’s ACR options

⁶ While Board litigants are permitted to move for summary judgment under Fed. R. Civ. P. 56, the parties are reminded that trademark disputes (including questions of likelihood of confusion) are often heavily fact-bound. As a result, the Board frequently denies motions for summary judgment. If the parties desire a resolution of the case short of a full trial, they are urged to consider ACR, rather than a motion for summary judgment.

⁷ Because ACR records are usually more compact than those presented on formal testimony and notices of reliance, the Board can usually render a final decision more quickly.

can be found in TBMP § 702.04. and on the Board's website.⁸ If the parties have questions about their ACR options, they are encouraged to contact the assigned interlocutory attorney.

Proceedings Resumed

Proceedings are resumed in accordance with the schedule set forth in the Board's June 16, 2016, order. *See* 2 TTAVBUE 3.

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.

⁸ *See* <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.