

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 21, 2011

Opposition No. 91199964

RalphAnderl, ic! berlin
brillen GmbH

v.

INSPEC International Limited

Cheryl S. Goodman, 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 2:00 pm (EDT) on Thursday, July 21, 2011. Board participation was requested via ESSTA by applicant on July 6, 2011.

Participating in the conference were Teresa Tucker, counsel for opposer and Paul Clarke, Managing Director for applicant. Present for the Board was the above-identified interlocutory attorney. This order memorializes generally what transpired at the conference.

General Information

The Board noted that applicant's filings of July 14, 2011 (change of correspondence address and response to Board inquiry) did not comply with the Board's service requirements.

Trademark Rule 2.119 requires a party filing any paper with the Board during the course of a proceeding to serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served; (2) the method of service (e.g., first class mail); (3) the person being served and the address used to effect service; and (4) the date of service.¹

Also, applicant should note that any paper it is required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations. The Board does not accept facsimile or e-mail filings. It is

¹ Shown below is a suggested format for a certificate of service:
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

recommended that the Board's electronic filing system ESTTA be used for all papers filed with the Board.²

The parties stipulated to e-mail service in the discovery conference. It was noted that no additional response time (i.e., such as with service by mail) is provided for papers served electronically.

The Board advised the parties of the imposition of the Board's standard protective order at the commencement of these proceedings and that pro se parties are limited in their access to information designated as trade secret and commercially sensitive under the Board's standard protective order. See TBMP Section 412 (3d ed. 2011) for more information regarding the Board's protective order.³

The Board reviewed the required disclosures in this case: initial, expert and pretrial and advised that formal discovery cannot occur until after service of initial disclosures. Additionally, a motion for summary judgment cannot be filed prior to service of initial disclosures unless it is based on preclusion or lack of jurisdiction of the Board. Initial disclosures need not be filed with the

² The Board's automated consent extension and suspension motions should not be utilized until after service of initial disclosures. Please read the alerts on ESTTA for further information. If the automated motion does not provide the parties with the desired dates, a general motion option should be used with the desired trial schedule set forth in an attachment.

³ The standard protective order is viewable at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

Board unless they are filed in connection with a discovery motion, motion for summary judgment or notice of reliance.⁴

The Board advised the parties of other options available to settle this dispute, discussing, in particular, the availability of accelerated case resolution as well as third party mediation and arbitration.

The Board also advised the parties of the availability of telephone conferences (with the interlocutory attorney) to expedite the resolution of disputes in the case or to expedite consideration of a motion.

The parties agreed to a 30 day suspension for settlement. Proceedings will automatically resume after the thirty day period. The amended disclosure, discovery and trial schedule is set forth below.

Pro Se Information

Applicant is reminded that it will be expected to comply with all applicable rules and Board practices during the remainder of this case. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this cancellation proceeding. Applicant should note that Patent and Trademark Rule 10.14 permits any person or legal entity

⁴ Similarly expert disclosures and pretrial disclosures need not be filed with the Board unless the subject of a motion.

to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If applicant does not retain counsel, then applicant will have to familiarize itself with the rules governing this proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries, and may be available at some public libraries. Finally, the Board's manual of procedure will be helpful.

On the World Wide Web, applicant may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

Files of TTAB proceedings can now be examined using TTABVue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

The third edition (2011) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at:

http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp.

The Trademark Manual of Examining Procedure (TMEP) is available at

<http://www.uspto.gov/trademarks/resources/index.jsp>.

Proceedings are suspended.⁵ Proceedings will resume on the schedule set forth below.

Proceedings resume:	August 21, 2011
Discovery Opens	9/5/11
Initial Disclosures Due	10/5/11
Expert Disclosures Due	2/2/12
Discovery Closes	3/3/12
Plaintiff's Pretrial Disclosures	4/17/12
Plaintiff's 30-day Trial Period Ends	6/1/12
Defendant's Pretrial Disclosures	6/16/12
Defendant's 30-day Trial Period Ends	7/31/12
Plaintiff's Rebuttal Disclosures	8/15/12
Plaintiff's 15-day Rebuttal Period Ends	9/14/12

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.

⁵ If the parties' settlement negotiations are successful and require an amendment to the application, the amendment, with an allegation of opposer's consent, should be filed with the Board. See TBMP Section 514 regarding motions to amend the application.