

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

Mailed: November 5, 2012

Opposition No. 91206066

Sizzler USA Franchise, Inc.

v.

Ruth's Hospitality Group,
Inc.

**George C. Pologeorgis,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the parties to this proceeding conducted a discovery conference with Board participation.¹

The parties agreed to hold the telephonic discovery conference with Board participation at 12:00 p.m. EDT time on Friday, November 2, 2012. The conference was held as scheduled among Rod S. Berman, as counsel for opposer, Joseph C. Chautin III, as counsel for applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

This order memorializes what transpired during the conference.

¹A telephonic request for Board participation in the discovery conference was received from applicant's counsel on October 23, 2012.

During the discovery conference, the parties advised the Board that no settlement discussions were conducted prior to the conference.

The parties further advised that there are no related Board proceedings or federal district court actions concerning issues related to this case.

The Board reviewed the pleadings herein and indicated that opposer has alleged a claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, as well as a claim of dilution in its amended notice of opposition.² The Board finds these claims sufficiently pleaded, as well as opposer's allegations regarding its standing.

The Board then reviewed applicant's answer to opposer's amended notice of opposition and noted that applicant has denied the salient allegations therein. The Board also reviewed the affirmative defenses asserted in applicant's answer. The Board found that applicant's Affirmative Defense Nos. 4 and 5 were mere amplifications of its denials of the claims asserted in the amended notice of opposition

²By order dated September 12, 2012, the Board, *inter alia*, granted applicant's motion (filed August 20, 2012) to dismiss opposer's asserted claim of dilution with leave to amend to file an amended pleading which properly sets forth a dilution claim. Opposer filed its amended notice of opposition on September 26, 2012.

and, therefore, the Board saw no reason to strike them from applicant's answer especially since it puts opposer on notice of applicant's defenses. With respect to Affirmative Defense No. 1, namely, opposer lacks standing to assert the allegations contained in the notice of opposition, the Board noted that it is unnecessary to assert such a defense since opposer must prove its standing to prevail in this matter. The Board nonetheless found no harm in allowing this affirmative defense to remain in applicant's pleading. The Board also noted that applicant has asserted an affirmative defense based upon the doctrine of *res judicata*, as well as an affirmative defense predicated on the prior registration and/or *Morehouse* defense. Finally, the Board noted that applicant also asserted an affirmative defense based upon estoppel for failing to prosecute two previous applications filed by applicant.

The Board then 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. 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.

Further, under the Board's standard protective order, once a proceeding before the Board has been finally

determined, the Board has no further jurisdiction over the parties thereto. According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties and their attorneys 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 or its attorney 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 Board's protective order for it to take effect, although it may be desirable to do so.

It is unclear, however, 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. 42242, 42251 (August 1, 2007). Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any determination of whether the

agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. *Id.*

The Board then noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). The parties are limited to seventy-five interrogatories, including subparts. See Trademark Rule 2.120(d)(1); TBMP Section 405.03 (3d ed. rev. 2012). 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 party "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 Section 408.01 (3d ed. rev. 2012).

Additionally, the Board advised the parties that if either party plans to file a motion to compel discovery, the moving party must first contact the Board by telephone (with the adverse party on the line) so that the Board can ascertain whether the moving party has demonstrated a good faith effort in resolving the discovery dispute before filing its motion.³ The Board also noted that a motion for

³ The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. See TBMP Section 408.01 (3d ed. rev. 2012).

summary judgment may not be filed until initial disclosures were made by the parties, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board.

The Board also provided the parties instruction 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) and (ii). The parties should not file their respective initial disclosures with the Board.

The Board also noted that, to the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend

proceedings for the sole purpose of allowing the parties to take discovery of a designated expert witness.

Moreover, the parties did not agree to accept service of papers by email. Accordingly, all papers filed with the Board should be served by first-class mail. The parties, however, may serve a courtesy copy of their filings by email. Opposer indicated that it may be served a courtesy copy of a filing at the following email addresses:

rberman@jmbm.com; sduncan@jmbm.com;

trademarkdocket@jmbm.com; and jbromall@jmbm.com Applicant

indicated that it may be served such courtesy copies at the following email addresses: estubbe@hardycarey.com;

jchautin@hardycarey.com; and admin@hardycarey.com

Additionally, the Board recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA. The Board further noted that the parties should not file consented motions to extend time prior to the deadline for initial disclosures by employing the "consented motion forms" in ESSTA. Instead, the parties should use the "general filing forms" option. The Board also advised the parties that they should consult the Board's website for further guidance regarding ESTTA filings.

Finally, the Board advised the parties of the Board's accelerated case resolution ("ACR") process. While the parties declined to pursue ACR at this time, the parties may

reserve the right to pursue ACR at a future date, if appropriate.⁴

Trial dates remain as reset by Board order dated September 12, 2012.

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.

The Board would like to thank counsel for their professional decorum during the discovery conference.

⁴Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at the Board's website.