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

Mailed: November 27, 2012

Opposition No. 91207039

Traditional Medicinals, Inc.

v.

Kevin Alan Tussy

M. Catherine Faint,
Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on Tuesday, November 27, 2012, between Jeremy Johnson, Atty., appearing for opposer, and Ryan Gile, Atty., appearing for applicant. Applicant requested the Board's participation via a request filed through ESTTA on November 16, 2012.

The parties confirmed that there are no currently pending related Board proceedings, federal district court actions, or third-party litigation involving both parties. The parties indicated they had discussed settlement prior to the discovery conference, but settlement had not been reached. The attorneys indicated that they were familiar with the Board's electronic resources.

1. Email Service

The parties stipulated to accept service of papers by email, that opposer's counsel may be served at the following email address: jjohnson@tradmed.com, and that applicant's counsel may be served at the following email address: RGile@WeideMiller.com. The Board noted that since the parties 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.

2. Board's Standard Protective Order

The Board 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. After some discussion regarding the standard protective order, the parties agreed opposer's counsel would draft a modified version of the protective order, and the parties would submit a signed copy of the protective order with the Board within **THIRTY DAYS** of the teleconference. To facilitate this, opposer's counsel will file a copy, executed by both parties, with the Board and serve a copy on applicant at the same time.

The Board advised, that if the parties encountered any difficulty regarding a revised protective order, they may set

up a teleconference with the Interlocutory Attorney for further discussion.

3. Initial Disclosures

The Board 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 Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties. *See* Trademark Rules 2.120(a)(3) and 2.127(e)(1). Initial disclosures do not need to be filed with the Board, only served on the other party.

4. Review of the Pleadings

Upon review of the notice of opposition, the Board noted there are claims in the ESTTA coversheet based on Trademark Act § 2(a) both for deception and false suggestion of a connection, on § 2(d) for priority and likelihood of confusion, and on § 43(c) for dilution. Opposer has the burden of proof in this proceeding. Through his answer, applicant has denied the salient allegations of the complaint.

The Board notes that at this stage of the proceeding, the Board looks only to whether claims have been adequately pleaded, and not to the sufficiency of the evidence which may be introduced in support of those claims. As discussed, during trial each party must present sufficient facts in support of each claim.

As noted below, certain of opposer's claims are stricken. Opposer may, however, file amended pleadings if it wishes to do so.

a. *Section 2(a) Deception and False Suggestion of a Connection*

As noted during the discovery conference, opposer's § 2(a) deception claim does not allege that applicant's mark is deceptive as to the nature or meaning of the mark in relation to the services. *See e.g., In re Budge Manufacturing Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). Opposer has alleged deception more in the nature of that seen in a case of likelihood of confusion under § 2(d). In view thereof, to the extent opposer believes it has alleged a Section 2(a) deception claim in the notice of opposition, *it is hereby stricken*.

For a proper § 2(a) claim of false suggestion of a connection, a plaintiff must allege facts from which it may be inferred that its mark is famous and points uniquely and unmistakably to itself, as an entity -- i.e., that its mark is its identity or "persona" -- and that purchasers would assume that goods bearing the mark are connected with plaintiff. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). To prevail on a claim of false suggestion of a connection, plaintiff must plead (and prove) the following:

> (1) Defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
> (2) That the defendant's mark would be recognized as such;
> (3) That the plaintiff is not connected with the activities performed by the defendant under the mark; and,
> (4) That plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used in connection with its services, a connection with the plaintiff would be presumed.

Consolidated Natural Gas Co v. CNG Fuel Systems, Ltd., 228 USPQ 752, 754 (TTAB 1985), *citing Buffett v. Chi Chi's*, 226 USPQ 428, 429 (TTAB 1985). Opposer's pleading does not contain any allegations regarding the fame or reputation of its marks. In view thereof, to the extent opposer believes it has alleged a Section 2(a) false suggestion of a connection claim in the notice of opposition, *it is hereby stricken*.

b. *Section 43(c) Dilution*

A proper pleading of a dilution claim requires an allegation as to when the claimant's mark became famous, which does not appear in the notice of opposition. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); *see also Demon Int'l v. Lynch*, 86 USPQ2d 1058, 1059-60 (TTAB 2008) (dismissing dilution claim as improperly pled because it did not include allegation that opposer's mark is famous).

In view thereof, to the extent opposer believes it has alleged a dilution claim in the notice of opposition as to its two registered marks, *it is hereby stricken*.

As noted below, opposer was granted leave to file an amended notice of opposition. If opposer knows a time certain by which its marks became famous, it should so state. At a minimum, to support the dilution claim, opposer's marks must have become famous before the filing date of applicant's application.

c. *Section 2(d) Priority and Likelihood of Confusion*

A likelihood of confusion determination under § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). There are 13 *duPont* factors, however, not all of the *duPont* factors are relevant or of similar weight in every case. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Opposer's pleading of the claim appears adequate. As discussed during the teleconference, priority does not appear to be an issue in this case, as applicant has filed an intent to use application under Trademark Act § 1(b). The parties discussed entering a stipulation as to priority, but did not do so at this time.

i. *Stipulation as to Marks*

The parties stipulate that the word marks are identical.

d. *Leave to file Amended Notice of Opposition*

Opposer was granted leave to file an amended notice of opposition if it wishes to perfect its false suggestion of a

connection or dilution claims. As discussed during the teleconference, the amended notice of opposition may include copies of opposer's pleaded registrations showing current status and title in opposer in conformance with Trademark Rule 2.122(d)(1).

The Board indicated that (1) it will allow opposer 14 days from the date of this teleconference in which to file an amended notice of opposition, should opposer so choose, and (2) applicant will have 14 days from the date of service thereof to file its amended answer. The pleadings may be served via email.

5. *Limits on Discovery*

The Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests. The Board discussed with the parties that annual sales and advertising figures, stated in round numbers, for a party's involved goods sold under its involved marks are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v.*

Fairfield-Noble Corp., 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability). In certain cases, the period of time the figures cover may also be limited. *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years). After some discussion, the parties declined to limit the scope of discovery at this time, although they may revisit the question in the future.

a. Stipulation as to Conduct of Depositions

The parties stipulate that depositions may be conducted via telephonic means.

6. *Availability of ACR*

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("ACR") procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board's website.[1] Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to

[1] Information about the Board's ACR procedure may be viewed at: http://www.uspto.gov/trademarks/process/appeal/index.jsp.

facts after the close of the initial disclosure period and to a shortening of the discovery period. *See* Trademark Rule 2.120(a)(2). There are also further stipulations that may streamline this case without agreeing to the full ACR procedure, as described on the Board's website.

As pointed out during the teleconference, this case may be a good candidate for the Board's ACR procedure. The parties may contact the Interlocutory Attorney if they wish to discuss the issue further.

7. Summary of Stipulations

The parties agreed to service via email, to submit a signed copy of an amended protective order, that the word marks are identical, and that depositions may be conducted via telephonic means.

8. *Schedule*

Opposer's amended notice of opposition, if filed, is due 14 days from the date of this teleconference, and (2) applicant will have 14 days from the date of service thereof to file its amended answer. The pleadings may be served via email.

Dates otherwise remain as set in the Board's institution order as copied below.:

Initial Disclosures Due	12/27/2012
Expert Disclosures Due	4/26/2013
Discovery Closes	5/26/2013
Plaintiff's Pretrial Disclosures	7/10/2013

Plaintiff's 30-day Trial Period Ends 8/24/2013

Defendant's Pretrial Disclosures 9/8/2013

Defendant's 30-day Trial Period Ends 10/23/2013

Plaintiff's Rebuttal Disclosures 11/7/2013

Plaintiff's 15-day Rebuttal Period Ends 12/7/2013

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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