

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

DUNN

Mailed: June 5, 2013

Opposition No. 91209962

Dowco, Inc.

v.

Michael A. Siciliano

**Elizabeth A. Dunn, Attorney (571-272-4267):**

On June 4, 2012, at opposer's request, the Board participated in the parties' discovery conference, which was conducted by phone.<sup>1</sup> Trademark Rule 2.120(a)(2). During the conference the parties agreed to adopt ACR (accelerated case resolution) procedures.

The participants were Katrina Hull, attorney for opposer, Michael Siciliano, applicant acting pro se, and Elizabeth Dunn, attorney for the Board.<sup>2</sup>

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<sup>1</sup> Phone conferences, which are considered an informal Board tool, may not be recorded in any way. Trademark Trial and Appeal Board Manual of Procedure (TBMP) §502.06 (3rd ed., rev. 2012). A Board order summarizing the important points issues after the conference and becomes part of the record.

<sup>2</sup> Opposer attorney Billie Jean Smith also attended the conference, as did USPTO externs Collopy and Calabro.

LEGAL REPRESENTATION STRONGLY RECOMMENDED

As discussed, while Patent and Trademark Rule 10.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. If applicant decides to continue without counsel, he is urged to frequently consult TBMP which, like the rules of practice, is available from the Office website at [www.uspto.gov](http://www.uspto.gov). Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

PRIOR COMMUNICATIONS/SETTLEMENT/RELATED PROCEEDINGS

There has been no prior communication between the parties related to the substance of the pleaded claims and defenses, and settlement offers no longer are being exchanged. The parties are aware of no related proceedings before the Board or in any court. As set forth in the institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding, or a civil action,

which involve related marks or issues of law or fact which overlap with this case.

PLEADED CLAIMS

Opposer pleads priority of use and likelihood of confusion between applicant's HAIL GUARDIAN and design (HAIL disclaimed) mark for "telecommunication services, namely, providing e-mail notification alerts via the internet" (application Serial No. 85631068, based on Trademark Act Sec. 1(b)) and opposer's GUARDIAN marks, the subject of pleaded registrations<sup>3</sup>:

Registration No. 1805992	Registration No. 2919591	Registration No. 3629593
GUARDIAN COVERS (COVERS disclaimed)	GUARDIAN	GUARDIAN WEATHERALL
fitted and semi-fitted vehicle covers; namely, motorcycle covers	fitted and semi-fitted covers for vehicles, namely, all- terrain vehicle covers, boat covers, snowmobile covers and personal watercraft covers	fitted motorcycle covers, excluding fitted and semi- fitted automobile and truck covers

Applicant's answer denies the salient allegations of the notice of opposition.<sup>4</sup>

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<sup>3</sup> Status and title copies of the pleaded registrations were submitted with the notice of opposition and now are part of the record. Trademark Rule 2.122(c).

<sup>4</sup> Applicant's exhibits will be given no consideration. Applicant is advised that, with the exception of copies of the registrations pleaded by opposer, an exhibit attached to a

ACR (ACCELERATED CASE RESOLUTION) PROCEDURES APPROVED

Here, with the submission of opposer's pleaded registrations, there is no issue as to opposer's standing and priority, leaving only the issue of likelihood of confusion. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing); *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) (priority not at issue where opposer pleads registration the validity of which is unchallenged).

The marks share the common term GUARDIAN, with other elements disclaimed (except one of opposer's marks includes the term "WEATHERALL"). The primary issue in this proceeding is whether opposer can prove that the consumer of its vehicle covers is likely to believe applicant's email alerts emanate from the same source. In these circumstances, the Board strongly recommends the use of ACR procedures to expedite this proceeding. *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1266 fn9 (TTAB 2008) ("ACR is a procedure akin to

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pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c).

summary judgment in which parties can receive a determination of the claims and defenses in their case promptly, but without the uncertainty and delay typically presented by standard summary judgment practice.”).

As discussed, with adoption of the ACR procedures stipulated below, both parties gain the advantage of less formal evidentiary submissions and a quicker final decision on the merits of the case. Allowing the use of affidavits in lieu of depositions allows the parties to submit testimony without the time and expense of hiring court reporters, preparing cross-examination, or paying for transcripts. This is particularly useful where, as here, the applicant has not begun use of the mark and thus must rely on his own testimony, instead of documents like invoices and advertisements, to establish, for example, its prospective channels of trade and consumers.

Opposer’s concern regarding authentication of documents without discovery was addressed by an agreement to serve applicant with a proposed stipulation regarding those documents, including screen shots from applicant’s website. If the parties cannot agree to the stipulation, the Board will hold another conference with the parties to address this issue.

Applicant's concerns that the screen shots from its website were not relevant, and that the stipulation would be considered a concession as to the weight the screen shots should be given by the panel of judges, were discussed in some detail. The screen shots alleged to advertise email alerts, which in turn are alleged to advertise vehicle covers, are relevant if opposer wishes to show that its vehicle covers and applicant's email alerts travel in the same channels of trade or are addressed to the same group of consumers. Stipulating, for example, that applicant's website featured certain information on a certain day, as demonstrated by the screen shots, allows the screenshots to be admitted as evidence.

Agreeing to such a stipulation is NOT a concession that the evidence should be considered persuasive, and applicant is free to argue in its ACR brief that the screen shots should not be given any weight. Applicant may submit his own evidence that the website changed quickly, and argue, for example, that because the information shown on the screen shots was available only briefly, only limited number of prospective consumers saw the website, and no association between email alerts and vehicle covers was created. In short, the use of ACR procedures does not change opposer's burden of proving its case; stipulations

that documents are authentic are not stipulations that the documents prove what the submitting party argues they prove; and applicant is free to submit evidence which contradicts or rebuts opposer's evidence and to make any argument which applicant believes supports its case. In its rebuttal brief, opposer has the same opportunity to contradict or rebut applicant's evidence or arguments (and the rebuttal brief cannot be used to submit new evidence or arguments, since applicant would not have a chance to respond).

The parties stipulated as follows:

- 1) Neither party shall serve disclosures; conduct discovery or rely on expert testimony;
- 2) The parties shall forego trial and an oral hearing;
- 3) The parties shall submit summary judgment briefs, accompanied by any evidence, which may be submitted in the form of declarations or affidavits;
- 4) The page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b);
- 5) The parties are not required to submit separate statements of material fact as part of their briefs;
- 6) Evidence may be marked as "Confidential" pursuant to the Board's protective order automatically applicable in this proceeding (and available from the Board's webpage); and
- 7) The parties agree that the Board may resolve genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions.

Opposer will serve applicant with a proposed stipulation regarding the authentication of documents by July 17, 2013.

By July 31, 2013, after reviewing the stipulation, applicant will either sign the stipulation and return it to opposer or call opposer to discuss why applicant is unwilling to sign the stipulation.

On August 1, 2013, the parties will either file the signed stipulation with the Board or seek a phone conference to address the issue with the stipulation, which will result in suspension of the schedule below.

If the stipulation is filed, the parties will follow this briefing schedule:

Submission of Opposer's ACR Brief and Evidence:	October 1, 2013
Submission of Applicant's ACR Brief and Evidence:	November 1, 2013
Submission of Opposer's ACR Rebuttal Brief and Evidence, if any:	November 22, 2013

Because the parties agree that the Board may resolve disputes as to material fact which the Board may find to exist, and may issue a final ruling after considering the parties' ACR submissions, the parties' ACR stipulation is hereby APPROVED.<sup>5</sup> The Board will expedite determination of this matter and render a final decision in accordance with

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<sup>5</sup> The Board construes the parties' stipulation as an agreement that the Board may decide any issues not anticipated by the parties but which the Board may find the record to present.



the evidentiary burden at trial, that is, by a preponderance of the evidence. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). The Board will endeavor to issue a decision on the merits within 50 days of the due date for opposer's rebuttal brief.

The interlocutory attorney assigned to this case (and listed at the top of this order) is available for telephone conferences should any questions or issues arise concerning this ACR proceeding.