

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

Mailed: September 28, 2013

Opposition No. 91211436

Armando Pérez, and  
ACP IP, LLC

v.

Eric Insua

**Robert H. Coggins,  
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 3:00 p.m. EDT on September 19, 2013. Board participation was requested by opposers. During the conference, opposers were represented by Joel R. Feldman, applicant was represented by Oliver A. Ruiz, and participating for the Board was the above-signed Interlocutory Attorney.

**Nature of Board Proceedings**

The parties stated that they were familiar with *inter partes* proceeding before the Board.

**Similar Proceedings**

Opposer Armando Pérez has opposed registration of third-party application Serial No. 85737828 (for the mark DÁLE DURO)

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in Opposition No. 91210926; however, that proceeding does not appear to have a bearing on Opposition No. 91211436 (the instant proceeding). The parties stated that they are not engaged in any other Board proceeding or any civil action involving the subject or pleaded marks.

### **Resources**

The Board reminded the parties that they may access many legal resources, including the TBMP and the Trademark Rules of Practice, from the Board's website at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Both parties have used ESTTA (<http://estta.uspto.gov>) and TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) and are familiar with these systems.

The Board commented that Sections 400-800 of the TBMP will likely be of the most interest to the parties going forward. Chapter 400 describes disclosures, written discovery, and discovery depositions; Chapter 500 describes motions practice; and Chapter 700 describes trial procedure and introduction of evidence.

### **Settlement**

The parties stated that they had not previously discussed settlement. While there is always a possibility of settlement in Board proceedings, the parties stated that neither of them currently had a compromise settlement position.

The parties were informed that the Board encourages settlement, and that the Board is generous with periods of extension or suspension to facilitate settlement discussions. After the deadline for initial disclosures has passed, the parties may use the "consent motions" option in ESTTA to automatically obtain an extension or suspension of time.<sup>1</sup> The parties may also upload a consented scheduling motion under the "general filings" option, embedding the agreed-upon schedule in the motion.

#### **Service of papers**

The parties agreed to accept service by email. In view thereof, the five-day period allowed under Trademark Rule 2.119(c) will not apply. See *McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013). Opposers' email addresses for service are atltrademark@gtlaw.com and feldmanjoel@gtlaw.com, and applicant's email addresses for service are oruiz@malloylaw.com and litigation@malloylaw.com.

#### **Pleadings**

Upon review of the notice of opposition, the Board noted that opposers had sufficiently pleaded their standing, and

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<sup>1</sup> Parties should not use the "consent motions" option when the next deadline is the due date for initial disclosures. Instead, the parties should use the ESTTA "general filings" option and attach a proposed schedule with the desired new initial disclosure deadline (and all subsequent deadlines). See more information at the following ESTTA Important User Guidelines URL: [http://www.uspto.gov/web/offices/dcom/ttab/ttab\\_notification.pdf](http://www.uspto.gov/web/offices/dcom/ttab/ttab_notification.pdf)

that ACP IP, LLC had sufficiently pleaded the ground of priority and likelihood of confusion. However, the Board noted that Armando Pérez had not sufficiently pleaded the ground of false suggestion of a connection, and, in view thereof, struck paragraphs 26-34 from the notice of opposition. Specifically, Mr. Pérez had not alleged that applicant's mark is the same or a close approximation of Mr. Pérez's previously used name or identity.<sup>2</sup> In view of the striking of paragraphs 26-34, the Board allowed opposers until October 10, 2013, in which to file an amended notice of opposition that properly alleges a ground of false suggestion of a connection, failing which, this proceeding will continue under the original notice of opposition as stricken (i.e., only under the ground of priority and likelihood of confusion as to ACP IP, LLC).

Opposers stated that although the word "disparages" appeared in paragraph 26 and "disparage" appeared in paragraph 33, opposers did not intend to plead that applicant's mark is

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<sup>2</sup> In order to properly assert a ground of false suggestion of a connection, an opposer must plead that (1) applicant's mark is the same or a close approximation of the opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to the opposer; (3) that opposer is not connected with the goods sold by applicant under the mark; and (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods, a connection with the opposer would be presumed. See *Bd. of Trs. of the Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013); *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008).

disparaging. The Board suggested that if opposers replead the ground of false suggestion of a connection as to Mr. Pérez, to maintain clarity in the pleading they should not refer to the mark as disparaging.

Upon review of the answer, the Board noted that the answer fairly and clearly met the allegations in the notice of opposition. However, the Board advised the parties that applicant's third affirmative defense (i.e., restriction) was not sufficiently pleaded because the proposed restriction was not set forth with any detail or with an explanation or allegation as to how the restriction would alleviate a likelihood of confusion. *See Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013). In view thereof, the Board struck paragraph 3 of the affirmative defenses from the answer. Applicant was allowed until October 31, 2013, in which to file an answer to the first amended notice of opposition, if a first amended notice is filed, or a first amended answer if no first amended notice is filed. If no first amended notice is filed and no first amended answer is filed, this proceeding will continue under the original answer as stricken.

To advance possible settlement of this proceeding, the Board asked applicant what restriction he was considering and whether opposers would accept such a restriction. A short, but positive, discussion ensued without agreement or

commitment from either party. The Board reminded the parties that the Board encourages settlement and that it is generous with extensions or suspensions to facilitate settlement.

**Discovery**

The parties were reminded that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

*A. The Board's Standardized Protective Order*

The Board advised the parties that the Board's standard protective order was in place in this case and governs the exchange of confidential and proprietary information and materials. Trademark Rule 2.116(g). The parties were informed that they could substitute a stipulated protective agreement (signed by both parties) but that the Board generally does not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order. See TBMP § 412.02. The parties were directed to the standardized protective order on the TTAB's home page.

*B. Scope of discovery*

The Board briefly mentioned the use of interrogatories, requests for admission, requests for production of documents and things, and depositions as discovery devices. Under the current notice of opposition, as stricken, discovery should focus on priority and likelihood of confusion. See *In re E.I.*

*du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). The parties should easily ascertain which *du Pont* factors are relevant and further concentrate discovery on those factors.<sup>3</sup> See *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (need only consider those factors which are relevant). Applicant stated that although his application was filed under an intent-to-use basis he had previously begun using the mark on at least some of the goods in the application.

The parties may, of course, serve discovery requests on other matters to ascertain whether there may be additional grounds for opposition (in opposers' case) or for a compulsory counterclaim (in applicant's case). However, if initial responses do not indicate the existence of any such grounds, discovery on those matters should not be pursued.

Opposers stated that they would likely replead the ground of false suggestion of a connection to Mr. Pérez. If so, discovery may also focus on this claim. Opposers noted that they would likely rely on publicly available material to show the fame, reputation, and alleged association of DALE with Mr. Pérez.

The parties stated that they were not, at present, interested in limiting the use traditional discovery devices;

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<sup>3</sup> Information about the various *du Pont* factors may also assist the parties in crafting a mutually agreeable settlement.

however, they agreed to reconsider this possibility and to discuss Accelerated Case Resolution (see below) once the pleadings were settled.

*C. Electronically stored information*

In general, production of electronically stored information ("ESI") is not an issue in Board cases, likely due to the Board's limited jurisdiction to determine only the right to a registration and due to the public nature of trademarks. However, if the parties anticipate or encounter a problem, they should work together to resolve the matter.

*D. Initial disclosures*

Initial disclosures are: 1) the identity of witnesses likely to have discoverable information and 2) the description and location of documents and things having or containing relevant information. More particularly, and as provided for by Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii), those disclosures are:

(i) 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;

(ii) 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.

The deadline for initial disclosures was reset to December 15, 2013.<sup>4</sup> The parties may serve initial disclosures before the due date. A party seeking discovery, or a party filing a motion for summary judgment, must serve initial disclosures before serving discovery or a summary judgment motion, except that a summary judgment motion may be filed in connection with certain limited circumstances before initial disclosures are served. See TBMP § 528.02. It does not appear to the Board that any of the exceptions might apply to the current opposition proceeding.

**Accelerated Case Resolution (ACR)**

The Board discussed the possibility of accelerated case resolution (ACR). The parties did not agree to pursue ACR at this early stage, but stated that they would reconsider the use of ACR after the pleadings were settled and, possibly, after some discovery had been taken. If the parties agree to pursue ACR or other efficiencies at a later date, the parties are to contact the Board for further discussion and administration. The parties stated that they would confer again, and the Board agreed to participate to discuss ACR and possibly limiting discovery.

Both parties must stipulate to an ACR proceeding and that the Board may make findings of fact from the ACR record. The parties were referred to TBMP § 702.04 for more information on

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<sup>4</sup> See "schedule" section of this order, *infra*.

ACR. The usual models for ACR include: 1) conversion of a currently pending summary judgment motion (usually the parties elect ACR after the motion is fully briefed); 2) an approximation of a summary bench trial using ACR briefs and accompanying evidence, similar to summary judgment briefs and evidence (usually the parties elect ACR prior to presenting this ACR record and briefs); and 3) a stipulated record submitted with the trial brief, where the parties extensively use stipulations, with or without other evidence and with or without testimony (thus the parties are not required to forgo trial or the taking of testimonial depositions). As the parties may perceive, there is substantial flexibility with the ACR approaches in Board proceedings. The goal is to reduce the time and expense to the parties of a full trial. See TBMP § 702.04. As the parties move forward in this proceeding, they should keep in mind that this case may have opportunities for other efficiencies. See TBMP § 702.04(e).

**Schedule**

Dates were reset on the following schedule.

Amended Complaint Due, if Filed	10/10/2013
Answer or Amended Answer Due, if Filed	10/31/2013
Deadline for Discovery Conference <sup>5</sup>	11/15/2013
Discovery Opens	11/15/2013

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<sup>5</sup> The parties need not hold another Fed. R. Civ. P. 26(f) conference unless the prospective amended pleadings raise claims or defenses not discussed in the September 19th conference. Notwithstanding this, the parties did agree to conference again to discuss the possibility of ACR.

Initial Disclosures Due	12/15/2013
Expert Disclosures Due	4/14/2014
Discovery Closes	5/14/2014
Plaintiff's Pretrial Disclosures	6/28/2014
Plaintiff's 30-day Trial Period Ends	8/12/2014
Defendant's Pretrial Disclosures	8/27/2014
Defendant's 30-day Trial Period Ends	10/11/2014
Plaintiff's Rebuttal Disclosures	10/26/2014
Plaintiff's 15-day Rebuttal Period Ends	11/25/2014

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.