

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: February 13, 2015

Opposition Nos. **91215114 (parent)**
91216395

Upper Shirley Vineyards, LLC and
Shirley Plantation LLC

v.

Stillhouse Vineyards, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to these proceedings conducted a discovery conference on February 9, 2015. Board participation was requested by Opposers. Kristen M. Hoover, Esq., of McCarthy, Lebit, Crystal & Liffman, Co., L.P.A. appeared on behalf of Opposers and Jarrod A. Thomas, Esq., of Strother Law Offices, P.L.C. appeared on behalf of Applicant.

Introductory Remarks

At the outset of the conference, the Board informed the parties that a spirit of cooperation and good faith dealing were expected from the parties during the duration of these proceedings and that any points of contention that may arise during the course of the proceedings should be handled through direct communication between the parties and in a spirit of good faith. **The parties were put on notice that a motion to compel would**

not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the issue.

The Board also noted that telephone conferences with a Board attorney are available as necessary but that both parties would need to be on the call to discuss any substantive matter and that *ex parte* communications with the Board are generally inappropriate.

The parties were instructed to file appearances of counsel and change of correspondence forms as necessary, preferably via ESTTA, the Board's electronic filing system.

Prior Communications and Disputes

Aside from the scheduling of this conference, the parties have not had any prior communications of note. The Board inquired as to the parties' interest in discussing settlement. Although the parties were open to the possibility of settlement negotiations, neither was inclined at this point of the proceedings to suspend this matter to explore that option. The Board encouraged the parties to revisit the issue at a later juncture.

The Board then inquired as to whether the parties were involved in any other disputes with each other involving the subject mark to which the parties responded in the negative. The parties further confirmed that their marks were not the subject of any third-party dispute.

Pleadings

The Board and the parties discussed the claims in Opposers' amended notices of opposition. **Opposers confirmed that they were asserting, in both oppositions, claims of false suggestion of a connection under Section 2(a) of the Trademark Act, geographical indication used on wines and spirits also under Section 2(a), geographically deceptive misdescriptiveness under Section 2(e)(3), and priority and likelihood of confusion under Section 2(d). Opposers added that they were also asserting claims of dilution under Section 43(c) and nonuse as against Application Serial No. 86121979 in Opposition No. 91216395.**

As to the false suggestion claim, the Board observed that the amended claim remains legally insufficient as Opposers have alleged that "Applicant's applied-for mark is the same as or a close approximation of Shirley's registered marks and Upper Shirley's pending application" rather than "the same as, or a close approximation of, the name or identity previously used" by Opposers. *See Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). **Rather than have Opposers replead the claim, the Board determined that by virtue of the discussion herein, Applicant has sufficient notice of Opposers' false suggestion claim and therefore the parties are to read the claim as referring to the name or identity previously used by Opposers rather than the "registered marks" and "pending application,"** to which Applicant did not object.

As for Applicant's answer, no issues were raised by either the Board or Opposers.

Discovery and Stipulations

The parties were advised that the Board's standard protective order is operative in these proceedings, made applicable by operation of Trademark Rule 2.116(g) and available at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. If the parties wish to acknowledge their obligations under the standard protective order in writing, the parties are referred to the form found at <http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp>.

Should the parties wish to modify the Board's standard protective order, the parties may negotiate any changes and file a copy of the proposed protective order with the Board for approval.

As the parties' prior communications have been limited, the parties have not given consideration to discovery or testimonial stipulations. As noted during the conference, the Board encourages the parties to consider ways in which to potentially limit and simplify discovery and testimony through reciprocal disclosures, stipulations of fact, and/or agreements. For instance, the parties may consider greater use of reciprocal disclosures and less use of formal discovery or streamlining their discovery by limiting the

number of depositions,¹ interrogatories, document production requests and admission requests. The parties may also consider simplifying the introduction of evidence into the record such as by stipulating to the authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

The parties did, however, stipulate to accept service of papers by e-mail and acknowledged that in doing so, the five day grace period for response afforded the parties under Trademark Rule 2.119(c) would no longer be applicable. Each party respectively confirmed that service by email is to be made to kmh@mccarthylebit.com and mwv@mccarthylebit.com for Opposers and to pstrother@strotherlaw.com and jthomas@strotherlaw.com for Applicant.

Alternative Dispute Resolution and Accelerated Case Resolution

The Board informed the parties that mediation and arbitration are outside resources available to the parties to facilitate settlement discussions. Although the Board will not refer the parties to any particular arbitrator or mediator, the Board would be amenable to suspending these proceedings should the parties choose these alternatives to aid in settlement.

¹ Pursuant to Fed. R. Civ. P. 30(a), made applicable to Board proceedings by Trademark Rule 2.116, a party may not seek more than ten discovery depositions without a prior stipulation between the parties or leave of the Board.

Accelerated Case Resolution (ACR) was also discussed as a way to expeditiously obtain a final determination of these proceedings without the time and expense of a full trial. A proceeding that is ideally suited for ACR is one in which the parties anticipate being able to stipulate to many facts, or in which each party expects to rely on the testimony of only one or two witnesses and the overall record will not be extensive.

The Board observed that ACR may not be appropriate to these proceedings due to the number and types of claims asserted by Opposers. The parties were, nevertheless, encouraged to consider the procedure in the future, particularly if the parties are able to make many stipulations so as to narrow the issues for ACR. As mentioned during the conference, the parties must mutually agree to ACR as the procedure cannot be instituted unilaterally and there is no procedural mechanism by which an unwilling party can be compelled to engage in ACR. To facilitate the parties' consideration, they are referred to the following for additional information on the procedure:

<http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf>

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution (ACR) FAQ updates 12 22 11.doc)

Consolidation

Finally, Opposers raised the issue of consolidating these oppositions pursuant to their motion filed on May 22, 2014. The Board may consolidate pending cases that involve common questions of law or fact. *See* Fed. R. Civ.

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P. 42(a); *see also Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Consolidation in appropriate cases will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays.

Inasmuch as the parties to the oppositions are the same and the proceedings involve common questions of law or fact, the Board finds that consolidation is appropriate. In view thereof, Opposers' motion to consolidate is hereby **GRANTED. Opposition Nos. 91215114 and 91216395 are hereby consolidated** and may be presented on the same record and briefs. The record will be maintained in **Opposition No. 91215114 as the "parent" case**. The parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as such in the case caption as this order.

The parties are reminded that consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See* 9A Wright, Miller, Kane, Marcus & Steinman, Fed. Prac. & Proc. Civ. § 2382 (3d ed. 2015).

The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42.

The schedule for the consolidated proceeding is set as follows:

Discovery Opens	2/9/2015
Initial Disclosures Due	3/11/2015
Expert Disclosures Due	7/9/2015
Discovery Closes	8/8/2015
Plaintiff's Pretrial Disclosures Due	9/22/2015
Plaintiff's 30-day Trial Period Ends	11/6/2015
Defendant's Pretrial Disclosures Due	11/21/2015
Defendant's 30-day Trial Period Ends	1/5/2016
Plaintiff's Rebuttal Disclosures Due	1/20/2016
Plaintiff's 15-day Rebuttal Period Ends	2/19/2016

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

As noted by the Board during the conference, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

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