

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: January 23, 2015

Opposition No. 91216311

SocialWhirled, LLC

v.

Global Social Inc.

**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 held the mandatory settlement and discovery conference at 4:00 p.m. EST on January 12, 2015. *See* TBMP § 401.01 (2014). Board participation was requested by Opposer. Participating in the conference were Eric M. Fraser, Ellie Hourizadeh, and the assigned interlocutory attorney.

### **Similar Proceedings**

The parties stated that they are not involved in any other Board proceeding or civil litigation involving the subject or pleaded marks.

### **Nature of Board Proceedings**

The parties stated that they are familiar with Board proceedings.

## **Resources**

The Board reminded the parties that they may access many legal resources, including the standard protective order and the Trademark Trial and Appeal Board Manual of Procedure (TBMP), at the Board's home page <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Both parties have used the ESTTA filing system (<http://estta.uspto.gov>) and TTABVue (<http://ttabvue.uspto.gov/ttabvue>) and are familiar with these electronic systems.

## **Settlement**

The parties were informed 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 for settlement, should the parties need such time. Prior to the deadline for initial disclosures, the parties should use the ESTTA "general filings" option and attach a proposed schedule with the desired new deadlines.

The parties stated that they had engaged in brief settlement discussions after the Notice of Opposition was filed. Both parties stated that they are open to the possibility of settlement, but neither party had a compromise settlement position. The parties did not believe that it would be beneficial to suspend proceedings at this time for further settlement discussions.

### **Service of papers**

The parties were reminded of their obligation to serve each paper filed with the Board, and the parties agreed to electronic service (by email). Opposer's email addresses for service are trademarks@omlaw.com and efraser@omlaw.com, and Applicant's email addresses for service are ehourizadeh@mwe.com and jarciniega@mwe.com. The parties were reminded that the additional time allowed under Trademark Rule 2.119(c) is not applicable to agreed use of electronic service. *See McDonald's Corp. v. Cambridge Overseas Dev. Inc.*, 106 USPQ2d 1339 (TTAB 2013); and TMBP §113.05.

### **Pleadings**

Upon review of the Notice of Opposition, the Board noted that Opposer had sufficiently pleaded its standing and a single ground for opposition, namely, priority and likelihood of confusion. The Board also noted that while neither Opposer's pleaded application nor the registration subsequently issuing therefrom was currently of record (*see* Notice of Opp., para. 2; and Trademark Rule 2.122(c)), Opposer may make the registration of record at trial without amending the notice of opposition to plead the registration itself. *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (if a party pleads a pending application in the notice of opposition, it may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration).

Upon review of the Answer, the Board noted that Applicant fairly and clearly met the allegations in the Notice of Opposition. The Board construed

paragraph 12 of the Answer to deny each allegation of paragraph 11 of the Notice of Opposition. The Board construed Applicant's tenth and fourteenth affirmative defenses as amplifications of Applicant's denial of priority and likelihood of confusion; however the remaining affirmative defenses were stricken. *See* Fed. R. Civ. P. 12(f)(1); and *American Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (Board may, upon its own initiative, and at any time, strike an insufficient defense).

The first affirmative defense (failure to state a claim upon which relief can be granted) was stricken because it was determined that the Notice of Opposition sufficiently alleges Opposer's standing and a ground for opposition. The second through ninth and eleventh through thirteenth defenses were stricken because the individual defenses were not pleaded with particularity - they are all nakedly pleaded. Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of "naked assertion[s]" devoid of "further factual enhancement," to support its claims. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009), quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). Moreover, the availability of the

defenses of laches (seventh defense), acquiescence (twelfth defense), and equitable estoppel (fifth defense) is severely limited in opposition proceedings because these defenses, in Board proceedings, start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition). *See National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). *See also Bausch & Lomb Incorporated v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526 (TTAB 2008); *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005); and *Warner-Lambert Co. v. Sports Solutions Inc.*, 39 USPQ 2d 1686, 1697 (TTAB 1996). In the answer, applicant has not alleged any facts or events occurring between the time its mark was published for opposition (i.e., March 11, 2014) and the filing of the notice of opposition (i.e., May 8, 2014). Inasmuch as the opposition was filed with the time allowed therefor (as extended), it does not appear that these affirmative defenses will be available to applicant. Similarly, because the opposition was filed with the time allowed, it does not appear that an affirmative defense of "statute of limitations" (sixth defense) will be available to applicant. Further, with regard to estoppel, the Board notes that this defense is otherwise not pleaded with the appropriate particularity. Trademark Act § 19 provides, in relevant part, that the equitable principles of estoppel may be considered and applied. However, there are various types of estoppel recognized by law, including: collateral estoppel, estoppel by laches, equitable estoppel<sup>1</sup>, licensee estoppel, and contract estoppel.

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<sup>1</sup> "Conduct which occurs prior to the publication of the application for opposition generally cannot support a finding of equitable estoppel." *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d at 1531). See discussion, *supra*.

Applicant has not indicated which type of estoppel it is asserting affirmatively or provided enough information concerning the nature of the purported estoppel and the underlying factual circumstances, even in general terms, which may give rise to the asserted estoppel. Applicant has not provided sufficient allegations of fact to put opposer on notice of the bases upon which the estoppel defense is being asserted. *See Heller Finance, Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989) (upholding motion to strike affirmative defenses because they were bare bones, conclusory allegations); and *Fleet Business Credit Corp. v. National City Leasing Corp.*, 191 F.R.D. 568, 570 (N.D. Ill. 1999) (bare bones waiver and estoppel defenses fail to sufficiently plead the affirmative defenses). Further, the defense of “good faith” adoption of a mark (eighth defense) is not a defense to a claim of likelihood of confusion, *see. e.g., Lebanon Seaboard Corp. v. R&R Turf Supply, Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012); likewise, “innocent intent” (thirteenth defense) is similarly treated. And “fair use” (eleventh defense) is not a defense to a Board proceeding. *See Truescents LLC v. Ride Skin Care, L.L.C.*, 81 USPQ2d 1334, 1338 (TTAB 2006).

In view of the striking of twelve of the fourteen defenses, applicant was allowed until February 12, 2015, in which to file an amended answer that properly alleges an affirmative defense; failing which, the case will proceed under the current answer as stricken. Applicant is reminded of its Fed. R. Civ. P. 11(b) obligations that each pleaded defense must be warranted, and that the factual contentions alleged in connection with each defense have evidentiary support or, if specifically so identified, will likely have

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evidentiary support after a reasonable opportunity for further investigation or discovery.

### **Discovery**

The parties were advised that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.<sup>2</sup>

#### ***The Board's Standardized Protective Order***

The Board reminded the parties that the Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. Trademark Rule 2.116(g). The parties were directed to the standardized protective order link on the Board's home page. The parties stated that they do not anticipate amending the standard protective order.

#### ***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 pleadings, 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. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (need only consider those factors which are

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<sup>2</sup> Of course, not all subject matters discussed in § 414 will be applicable to the single ground alleged in the present case. *See* "scope of discovery" discussion, *infra*.

relevant). Information about the various *du Pont* factors may also assist the parties in crafting a mutually agreeable settlement.

The parties stated that they did not currently want to place limits on discovery. The Board encouraged the parties to streamline discovery if the case does not settle and to consider limitations after initial disclosure and some preliminary discovery.

***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.

**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.

Initial disclosures are due March 28, 2015. *See* new schedule, *infra*. Disclosures should not be filed with the Board except under specific, limited circumstances. *See* Trademark Rule 2.120(j)(8). The Board reminds the parties that discovery may not be served, or a motion for summary judgment filed, until the serving or moving party has made initial disclosures (except that a motion for summary judgment may be filed prior to initial disclosures only in connection with limited circumstances which do not appear to be at issue in this case). *See* TBMP § 528.02.

#### **Accelerated Case Resolution (ACR)**

Each party stated that it may be interested in the possibility of accelerated case resolution (ACR), and the Board stated that this case appears to be a good candidate for ACR since there is a single ground and priority might easily be removed as an issue if Opposer makes its registration of record. The parties stated that they would consider using ACR after initial disclosure and some preliminary discovery. If the parties agree to pursue ACR or other efficiencies, the parties are to contact the Board for further discussion and administration. The parties were referred to TBMP §§ 528.05(a)(2) and 702.04 and to the “ACR & ADR” section of the Board’s home page for more information on ACR.

## Schedule

Proceedings were reset on the following schedule.

Amended Answer Due, if Filed	2/12/2015
Discovery Opens	2/26/2015
Initial Disclosures Due	3/28/2015
Expert Disclosures Due	7/26/2015
Discovery Closes	8/25/2015
Plaintiff's Pretrial Disclosures	10/9/2015
Plaintiff's 30-day Trial Period Ends	11/23/2015
Defendant's Pretrial Disclosures	12/8/2015
Defendant's 30-day Trial Period Ends	1/22/2016
Plaintiff's Rebuttal Disclosures	2/6/2016
Plaintiff's 15-day Rebuttal Period Ends	3/7/2016

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 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.