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

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Mailed: April 15, 2015

Opposition No. **91216326**

Tom Miles

v.

Continental Mills, Inc.

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 this proceeding conducted a discovery conference on April 13, 2015. Board participation was requested by Opposer. Wendy Peterson, Esq., of Not Just Patents, LLC appeared on behalf of Opposer and Grace Han Stanton, Esq., and John Halski, Esq., of Perkins Coie LLP 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 this proceeding and that any points of contention that may arise during the course of the proceeding 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 both parties would need to be on the call to discuss any substantive matter. *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

Applicant noted that the parties were engaged in settlement discussions prior to the appearance of new counsel for Opposer. Subsequent thereto, however, the parties are no longer engaged in settlement discussions but Applicant remains open to further discussions. To that end, 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. Applicant further confirmed that its mark was not the subject of any other third-party dispute.

Pleadings

The Board and the parties discussed the claims in Opposer's amended notice of opposition and Applicant's answer thereto. **Opposer confirmed that it was asserting a claim of priority and likelihood of confusion based on common law use of its mark and a claim of no bona fide intent to use**.

As for Applicant's answer, the Board noted that Applicant failed to give Opposer notice of the bases for ¶¶ 1 and 2 of its Affirmative Defenses[1] and thereby ordered Applicant to replead the defenses with more specificity. As discussed during the conference, Applicant's amended answer is due no later than **APRIL 27, 2015**.

Discovery and Stipulations

The parties were advised that the Board's standard protective order is operative in this proceeding, 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.

[1] 1. The Notice of Opposition fails to state a claim upon which relief may be granted.
2. Opposer's allegations are barred under the doctrine of laches.

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 for Board approval.

The parties stipulated to allow the testimony of either party's witnesses to be submitted in the form of an affidavit or declaration subject to live cross-examination by the non-submitting party as well as to accept service of papers by e-mail. As to this latter stipulation, the parties 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 at wsp@NJPLS.com for Opposer and at pctrademarks@perkinscoie.com for Applicant.

As mentioned during the conference, the Board encourages the parties to consider additional 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,[2] interrogatories, document production requests and admission requests. The parties may also consider further simplifying the introduction of evidence into the record by stipulating to the

[2] 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.

authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

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 this proceeding should the parties choose these alternatives to aid in settlement.

Accelerated Case Resolution (ACR) was also discussed as a way to expeditiously obtain a final determination of the proceeding 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. While Applicant expressed interest in the procedure, Opposer opted to reserve judgment until it had taken some discovery.

The parties are reminded that both must 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. Should the parties be interested in ACR at a future time, 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

Conclusion

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.

Dates are **RESET** as follows:

Amended Answer Due	**4/27/2015**
Discovery Opens	**4/28/2015**
Initial Disclosures Due	**5/28/2015**
Expert Disclosures Due	**9/25/2015**
Discovery Closes	**10/25/2015**
Plaintiff's Pretrial Disclosures Due	**12/9/2015**
Plaintiff's 30-day Trial Period Ends	**1/23/2016**
Defendant's Pretrial Disclosures Due	**2/7/2016**
Defendant's 30-day Trial Period Ends	**3/23/2016**
Plaintiff's Rebuttal Disclosures Due	**4/7/2016**
Plaintiff's 15-day Rebuttal Period Ends	**5/7/2016**

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 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.

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