

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: October 10, 2014

Opposition No. 91217585

Fey Cha

v.

Maisie Waston

**George C. Pologeorgis,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the parties to this case conducted a discovery conference with Board participation.¹

The parties agreed to hold the telephonic discovery conference with Board participation at 1:30 p.m. EDT on Wednesday, October 8, 2014. The conference was held as scheduled among Kevin Viau,² as counsel for Opposer, Mark R. Leonard, as counsel for Applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

This order memorializes what transpired during the conference.

¹ Applicant requested Board participation in the parties' discovery conference via telephone on September 30, 2014.

² Appearance of counsel on behalf of Applicant filed on October 7, 2014 is noted. Board records have been updated accordingly.

During the discovery conference, the parties advised that they have not conducted settlement negotiations prior the telephone conference.

The parties further advised that there are no related Board proceedings or federal district court actions concerning issues related to this case.

Pleadings

The Board reviewed the pleadings in this matter and noted that Opposer, in its notice of opposition, has alleged priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, as well as dilution and fraud, as grounds for opposition. The Board found that Opposer's allegations regarding her standing, as well as her asserted claims of priority and likelihood of confusion, as well as fraud, are sufficiently pleaded. The Board, however, found Opposer's claim of dilution deficiently pleaded.

In order to plead a sufficient claim of dilution, a plaintiff must affirmatively plead both that (1) its pleaded mark is famous, and (2) the fame was acquired prior to Applicant's first use in commerce of its subject mark. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-73 (TTAB 2001). Here, Opposer does not allege that her pleaded mark is famous, nor does Opposer plead affirmatively that Opposer's pleaded mark became famous prior to Applicant's first use in commerce of her subject mark.³

³ The Board notes that Applicant filed a use-based application under Section 1(a) of the Trademark Act on January 15, 2014, claiming November 28, 2013 as both the date of first use and the date of first use in commerce.

Accordingly, Opposer will be allowed the time set forth below in which to file and serve an amended notice of opposition which sets forth a proper claim of dilution, failing which this claim will be dismissed with prejudice.

The Board then reviewed Applicant's answer to Opposer's notice of opposition and noted that applicant has denied the salient allegations asserted therein.

Finally, during the telephone conference, the parties stipulated that the marks and goods at issue are legally equivalent for likelihood of confusion purposes. In view of such stipulation, the parties should refrain from propounding discovery concerning the similarities of the marks at issue, as well as the relatedness of the goods at issue.

Board's Standard Protective Order

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval.

Further, under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. According to the terms of the Board's protective order, within thirty days following termination of a proceeding, the parties and their attorneys must return to each disclosing party the protected

information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is not necessary for the parties to sign copies of the Board's protective order for it to take effect, although it may be desirable to do so.

It is unclear, however, whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007). Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. *Id.*

Discovery and Motion Practice

The Board then noted that the exchange of discovery requests could not occur until the parties made their initial disclosures as required by Fed. R.

Civ. P. 26(f). The parties are limited to seventy-five interrogatories, including subparts. *See* Trademark Rule 2.120(d)(1); TBMP Section 405.03 (2014). There is no rule limiting the number of document requests or requests for admission that a party may serve, but the parties are reminded that each party "has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case." TBMP Section 408.01 (2014).

Additionally, the Board advised the parties that if either party plans to file a motion to compel discovery, the moving party must first contact the Board by telephone (with the adverse party on the line) so that the Board can ascertain whether the moving party has demonstrated a good faith effort in resolving the discovery dispute before filing its motion.⁴ The Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties, except for a motion asserting issue or claim preclusion or lack of jurisdiction by the Board.

The Board also provided the parties instruction as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). In such disclosures, the parties should provide to each other

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 [and] a copy — or a description by

⁴ The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. *See* TBMP Section 408.01 (2014).

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.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties should not file their respective initial disclosures with the Board.

The Board also noted that, to the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend proceedings for the sole purpose of allowing the parties to take discovery of a designated expert witness.

Pretrial Disclosures

Pretrial disclosures are governed by Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii). Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need

arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under 37 CFR § 2.121(e), however, does not substitute for issuance of a proper notice of examination under 37 CFR § 2.123(c) or 37 CFR § 2.124(b). Further, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.

For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

Service of Papers

The parties agreed to accept service of papers by e-mail, except for service of documents pursuant to document requests that exceed 10 megabytes in size. In such circumstances, the parties have agreed to serve such document production by first-class mail via hard copy.

For service of papers other than responses to document requests that exceed 10 megabytes, Opposer indicated that it may be served at the following email address: tm_docket@iplg.com; and that Applicant may be served at the following email address: mleonard@davisandleonard.com. The

Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional 5 days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013).

Additionally, it is recommended that the parties file papers via the Board's electronic filing system, i.e., ESTTA. The parties should not file consented motions to extend time prior to the deadline for initial disclosures by employing the "consented motion forms" in ESSTA. Instead, the parties should use the "general filing forms" option.

Finally, the Board advised the parties of the Board's accelerated case resolution ("ACR") process. While the parties declined to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, by stipulation only, if appropriate.⁵

As noted above, Opposer has failed to plead properly a claim of dilution. In view thereof, Opposer is allowed until **twenty (20) days** from the mailing date of this order to file and serve an amended notice of opposition which sets forth a proper claim of dilution, pursuant to the guidelines provided above, failing which Opposer's dilution claim will be dismissed with prejudice, Paragraph 9 of Opposer's original pleading will be stricken, and the

⁵ Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at the Board's website. See <http://www.uspto.gov/trademarks/process/appeal/index.jsp>

opposition will move forward only on the claims of priority and likelihood of confusion and fraud.⁶

In turn, Applicant is allowed until **twenty (20) days** from the date indicated on the certificate of service of Opposer's amended pleading in which to file an answer or otherwise respond to the amended notice of opposition.⁷

Remaining trial dates are reset as follows:

Initial Disclosures Due	12/19/2014
Expert Disclosures Due	4/18/2015
Discovery Closes	5/18/2015
Plaintiff's Pretrial Disclosures Due	7/2/2015
Plaintiff's 30-day Trial Period Ends	8/16/2015
Defendant's Pretrial Disclosures Due	8/31/2015
Defendant's 30-day Trial Period Ends	10/15/2015
Plaintiff's Rebuttal Disclosures Due	10/30/2015
Plaintiff's 15-day Rebuttal Period Ends	11/29/2015

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.

⁶ Opposer should re-assert her allegations regarding her standing and her claims of priority and likelihood of confusion and fraud in her amended pleading.

⁷ In the event Opposer fails to file an amended pleading pursuant to this order, (1) Opposer's originally-filed pleading will remain Opposer's operative pleading, except that Paragraph 9 of the original pleading will be stricken, and (2) Applicant's originally-filed answer will remain as Applicant's operative pleading.

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The Board would like to thank counsel for their professional decorum and cooperation during the discovery conference.