

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: April 1, 2015

Opposition No. 91220439

University of Louisiana at Lafayette

v.

Pickin' Cotton Communications, LLC

**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 3:00 p.m. EDT on Wednesday, April 1, 2015. The conference was held as scheduled among Alicia Grahn Jones, as counsel for Opposer, Matt Fogarty, as corporate representative of *pro se* 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 March 25, 2015.

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During the discovery conference, the parties advised that there have been no settlement discussions prior to the telephone conference. Additionally, Applicant stated that, at the current time, it wishes to proceed *pro se* in this proceeding without representation by counsel. The Board advised Applicant that inasmuch as it wished to proceed without legal representation at this juncture, Applicant would be required to familiarize itself with all Board procedures, rules and regulations governing this case.

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 has alleged the following claims as grounds for opposition: (1) priority and likelihood of confusion under Section 2(d) of the Trademark Act, (2) false suggestion of a connection under Section 2(a) of the Trademark Act, and (3) deceptiveness under Section 2(a) of the Trademark Act. The Board found that Opposer's allegations regarding its standing, as well as its asserted claim of priority and likelihood of confusion, are sufficiently pleaded. The Board, however, found that Opposer's claims of false suggestion of a connection and deceptiveness are deficiently pleaded.

False Suggestion Of A Connection

In order to assert properly a ground of false suggestion of a connection under Section 2(a) of the Trademark Act, Opposer must plead that (1)

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Applicant's mark is the same or a close approximation of Opposer's previously used name or identity (not its pleaded mark); (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) that Opposer is not connected with the goods provided 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 its goods, a connection with Opposer would be presumed. *Petróleos Mexicanos V. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

Opposer's pleading, however, merely alleges that Applicant's mark falsely suggests a connection with Opposer in violation of Section 2(a) of the Lanham Act. See ¶ 19 of Opposer's notice of opposition. This allegation alone is insufficient to state a claim of false suggestion of a connection.

Deceptiveness

To state properly a claim of deceptiveness under Section 2(a), Opposer need only allege facts from which it may be inferred that Opposer has a reasonable belief that it would be damaged by use of Applicant's allegedly deceptive mark and facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase Applicant's goods. An opposer asserting such a claim need not allege prior use, or any use at all, of a mark or trade name similar to Applicant's mark.

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Furthermore, a proper pleading of “deceptiveness” under Section 2(a) requires Opposer to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See, e.g. Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992)(issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990)(issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete).

Opposer’s pleading is devoid of any allegations to support a claim of deceptiveness under Section 2(a) of the Trademark Act.

Accordingly, Opposer will be allowed the time set forth below in which to file and serve an amended notice of opposition which sets forth proper claims of false suggestion of a connection and deceptiveness, failing which these claims will be dismissed with prejudice.

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The Board then reviewed Applicant's answer to Opposer's notice of opposition and noted that Applicant has denied the salient allegations asserted therein. The Board also noted that Applicant has asserted various affirmative defenses. With regard to Applicant's Affirmative Defenses 2 and 3, the Board construes these defenses as mere amplifications of Applicant's denials to the corresponding allegations in the notice of opposition and the Board sees no harm in allowing these defenses to remain since they provide Opposer more complete notice of Applicant's position regarding Opposer's asserted claim(s).

With regard to Applicant's Affirmative Defense No. 1, namely, that Opposer's pleading does not state a claim upon which relief may be granted, the Board notes that this asserted defense is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of Opposer's claims rather than a statement of a defense to a properly pleaded claim. In view thereof, this asserted defense will not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). However, inasmuch as the Board, by this order, has made a determination regarding the sufficiency of Opposer's asserted claims, this defense is deemed moot and is hereby stricken from Applicant's answer.

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

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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. Moreover, the Board noted that inasmuch as Applicant is representing itself *pro se* in this case, it would be unable to view documents produced by Opposer that have been designated "Highly Confidential – For Attorneys Eyes Only." The Board advised, however, that Applicant could contest the appropriateness of the "Highly Confidential – For Attorneys Eyes Only" designation by seeking an *in camera* inspection by the Board of such documents designated "FOR ATTORNEYS EYES ONLY" by Opposer.

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.

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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. 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.

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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.² 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 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

² 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.

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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 §

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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 first-class mail, but also provide a courtesy copy of any filings by e-mail. The parties are therefore, required to provide courtesy email copies of any future filings in this matter.

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 did not stipulate to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, by stipulation only, if appropriate.³

Trial Schedule

As noted above, Opposer has failed to plead properly the claims of false suggestion of a connection and deceptiveness. In view thereof, Opposer is

³ 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>

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allowed until **twenty (20) days** from the mailing date of this order in which to file and serve an amended notice of opposition which sets forth proper claims of false suggestion of a connection and deceptiveness, pursuant to the guidelines provided above, failing which these claims will be dismissed with prejudice and the opposition will move forward only on the claim of priority and likelihood.⁴

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 and serve an answer to the amended notice of opposition.

Remaining trial dates are reset as follows:

Initial Disclosures Due	5/29/2015
Expert Disclosures Due	9/26/2015
Discovery Closes	10/26/2015
Plaintiff's Pretrial Disclosures Due	12/10/2015
Plaintiff's 30-day Trial Period Ends	1/24/2016
Defendant's Pretrial Disclosures Due	2/8/2016
Defendant's 30-day Trial Period Ends	3/24/2016
Plaintiff's Rebuttal Disclosures Due	4/8/2016
Plaintiff's 15-day Rebuttal Period Ends	5/8/2016

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.

⁴ Opposer should re-assert its allegations regarding its standing and its claim of priority and likelihood of confusion in its amended pleading.

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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.

The Board would like to thank the parties for their professional decorum during the discovery conference.

Pro Se Information

As noted above, Applicant is representing itself in this proceeding. Although Patent and Trademark Rule 11.14 permits an entity to represent itself, it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Any party who does not retain counsel should be familiar with the authorities governing this proceeding, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and the Trademark Rules of Practice (37 C.F.R. Part 2), both accessible directly from the Board's web page: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also on the

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Board's web page are links to ESTTA, the Board's electronic filing system⁵ at <http://estta.uspto.gov>, and TTABVUE, for case status and prosecution history at <http://ttabvue.uspto.gov/ttabvue>.

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).

Signature _____
Date _____

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before

⁵ The Board strongly encourages parties to file all papers through ESTTA, which operates in real time and provides a tracking number that the filing has been received. For assistance in using ESTTA, call 571-272-8500.

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the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

This *inter partes* proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.