

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

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Mailed: August 12, 2015

Opposition No. **91221750**

*Incyte Corporation and
Incyte Holdings Corporation*

v.

Kent A. Murphy

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 August 5, 2015. Board participation was requested by Opposers. Parna A. Mehrbani, Esq., of Lane Powell PC appeared on behalf of Opposers and Duane M. Byers, Esq., of Nixon & Vanderhye PC 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 placed 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

In addition to the scheduling of this conference, the parties have had preliminary discussions concerning settlement and indicated that they would confer further immediately following this conference. However, neither party believed that an extension or suspension for the sake of settlement discussions was necessary at this juncture. The Board instructed the parties to move for an extension or suspension as necessary should settlement discussions gain traction.

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 his mark was not the subject of any other third-party dispute.

Pleadings

The Board and the parties discussed the claims in Opposers' notice of opposition and Applicant's answer thereto. **Opposers confirmed that they were solely asserting a claim of priority and likelihood of confusion based on ownership of two registrations¹ and common law use of the marks.²**

As for Applicant's answer, the Board observed that the assertions comprising Applicant's "affirmative defenses" are not affirmative defenses but rather amplifications of Applicant's denial of Opposers' claim. As they provide Opposers with further notice of the basis of Applicant's defenses, the Board declined to strike them from the pleading. However, **the Board saw fit to strike ¶ 17 from the answer as Applicant conceded that the priority and likelihood of confusion claim was well-pleaded.**

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

¹ Registration Nos. 3044806 and 4052607.

² Opposers noted that Applicant owns additional NCYTE-formative applications that are currently pending in the examining branch of the USPTO and that they plan on opposing and seeking consolidation with this proceeding should any of the applications be published for opposition. Applicant stated his intention to oppose any such motion.

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 for Board approval.

The parties stipulated 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. Email service should be made to trademarks@lanepowell.com and mehrbanip@lanepowell.com for Opposers and to dmb@nixonvan.com and nixonptomail@nixonvan.com for Applicant.

The parties further stipulated to serve discovery requests in both PDF and Word[®] formats so as to facilitate discovery responses.

No other stipulations were proposed at this time. The Board encouraged 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,³ interrogatories, document production requests and admission requests. The parties may also consider

³ 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.

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.

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.

The parties were 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)

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. Furthermore, and as a point of practice, a party moving for summary judgment should confirm the status of its initial disclosures at the beginning of any motion for summary judgment irrespective of whether the motion was filed prior or subsequent to the deadline for disclosure.

Dates remain as last reset on June 8, 2015. That schedule is reproduced below:

Discovery Opens	8/7/2015
Initial Disclosures Due	9/6/2015
Expert Disclosures Due	1/4/2016
Discovery Closes	2/3/2016
Plaintiff's Pretrial Disclosures Due	3/19/2016
Plaintiff's 30-day Trial Period Ends	5/3/2016
Defendant's Pretrial Disclosures Due	5/18/2016
Defendant's 30-day Trial Period Ends	7/2/2016
Plaintiff's Rebuttal Disclosures Due	7/17/2016
Plaintiff's 15-day Rebuttal Period Ends	8/16/2016

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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