

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

EJW

Mailed: April 24, 2017

**Opposition No. 91232631 (parent)**

Opposition No. 91232633

Opposition No. 91232635

Cancellation No. 92065355

*Eczacibasi Holding Anonim Sirketi*

*v.*

*South Shore Slag LLC*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

On April 20, 2017, Opposer/Petitioner (represented by Kevin Viau of Intellectual Property Law Group LLP), Applicant/Respondent, (represented by David Oberdick of Meyer Unkovic & Scott LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a). This order sets forth a summary of the significant points addressed during the conference.

Conference Summary

Initially, the Board inquired as to whether the parties had engaged in any settlement discussions and whether there are any related proceedings, other than the four already consolidated proceedings. The parties informed the Board that there is no related federal court or other Board case, and that they had not conducted any settlement negotiations. *Should the parties engage in settlement discussions, they are*

*reminded to file a consent motion to extend trial dates or to suspend the proceeding, if applicable.*

The parties are required to promptly advise the Board should a civil action between the parties or other Board proceeding be instituted so that the Board can determine whether suspension or consolidation is appropriate.

Nature of Opposition; Pleadings

- *Notices of Opposition; Petition to Cancel; Answers*

Applicant/Respondent seeks registration of the marks VITRASPARG, VITRAAGG and VITRADUST; and Opposer/Petitioner seeks to cancel Applicant/Respondent's registration for the mark VITRAFINE. Applicant/Respondent has denied the salient allegations in Opposer/Petitioner's pleadings. The pleadings contain sufficient allegations in support of Opposer/Petitioner's likelihood of confusion claim. However, to the extent that Opposer/Petitioner seeks to allege a claim for false suggestion of a connection, there are no supporting allegations<sup>1</sup>; therefore, paragraph 10 in

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<sup>1</sup> To set forth a sufficient claim under Section 2(a) of the Trademark Act for false suggestion of a connection, the plaintiff must set forth allegations consistent with the following four-part test:

- (1) that defendant's mark is the same as or a close approximation of plaintiff's previously used name or identity;
- (2) that defendant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to plaintiff;
- (3) that plaintiff is not connected with the goods or services that are sold or will be sold by defendant under its mark; and
- (4) that plaintiff's name or identity is of sufficient fame or reputation that when defendant's mark is used on its goods or services, a connection with plaintiff would be presumed.

*See Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1972 (TTAB 2007); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

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Opposer/Petitioner's pleadings is stricken, with leave to amend.<sup>2</sup> *See* Fed. R. Civ. P. 12(f).

The Board also advised Opposer/Petitioner that the photocopies of its certificates of registration were insufficient to show current status and title of its pleaded registrations. *See* Trademark Rule 2.122(d); *see also United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1041 (TTAB 2014) (“[T]he problem with unauthenticated copies of pleaded registrations is that they ... are insufficient to meet the requirements of Trademark Rule 2.122(b) [now subsection (d)] and hence are incompetent to establish the current status of opposer’s pleaded registrations, that is, to show that such registrations are still subsisting. Moreover, the fact that the copies of the registration certificates filed by opposer indicate on their face that the registrations originally issued to opposer cannot serve to show that opposer is still the owner thereof and thus the “registrant” within the meaning of Section 7(b) of the Act of 1946.”); *Alcan Aluminum Corp. v. Alcar Metals Inc.*, 200 USPQ 742, 744 n. 5 (TTAB 1978) (the notice of opposition was accompanied by copies of opposer’s pleaded registrations, but they were not copies prepared by the Patent and Trademark Office showing status and title ... the registrations were given no consideration in determination of the case). Therefore, priority is still at issue.

- *Affirmative Defenses*

For the following reasons, all of Applicant’s affirmative defenses were stricken, with leave to amend. *See* Fed. R. Civ. P. 12(f).

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<sup>2</sup> Opposer/Petitioner should file a separate amended pleading in each proceeding. Likewise, Applicant/Respondent should file an answer in each proceeding.

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- Affirmative defenses 1 and 5: Applicant’s affirmative defenses of “estoppel, waiver and estoppel, acquiescence, and laches” and “unclean hands” comprise bald, conclusory statements, therefore, they do not provide sufficient notice to Opposer/Petitioner regarding the bases for the defenses. 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, 663 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)); *see also Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give fair notice of claim). Affirmative defenses, like claims in a notice of opposition or petition for cancellation, must be supported by enough factual background and detail to fairly place the plaintiff 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”); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (pleading of unclean hands insufficient as answer did not include “specific allegations of conduct by petitioner that, if proved, would prevent petitioner from prevailing on its claim; instead, the allegations of the fourth affirmative defense are either unclear, non-specific, irrelevant to the pleading of unclean hands, or merely conclusory in nature”).

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- Affirmative defenses 2, 3, 4 and 6: Applicant attacks the validity of the pleaded registrations by essentially alleging that Opposer/Petitioner has failed to use its marks, has failed to police its marks, and committed fraud in obtaining its registrations. To the extent that Applicant is alleging that Opposer's marks are not registrable, such allegations will not be considered unless Applicant/Respondent files a counterclaim seeking cancellation of Opposer/Petitioner's pleaded marks. *See* Trademark Rule 2.106(b)(2).
- Affirmative defense 7: Applicant/Respondent reserves the right to assert additional affirmative defenses based upon information learned during discovery in this matter. Such assertion of the right to put forward affirmative defenses is improper under the Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) (reservation of right to add affirmative defenses at a later date is improper under the Federal Rules). Specifically, Applicant/Respondent cannot reserve unidentified defenses or counterclaims in its answer since it does not provide Opposer/Petitioner fair notice of such defenses. Whether Applicant/Respondent may, at some future point, amend its answers to include affirmative defenses and/or counterclaims would be resolved by way of a motion for leave to amend under Fed. R. Civ. P. 15(a).

Inasmuch as the affirmative defenses were stricken, counsel for Applicant/Respondent and the Board discussed the scope of discovery as it relates to

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potential affirmative defenses and/or counterclaims. The Board reminds the parties of the following:

Under Fed. R. Civ. P. 26(b)(1), “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties’ relative access to relevant information, the parties’ resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. Information within this scope of discovery need not be admissible in evidence to be discoverable.” Section 402.01 of the TBMP (Jan. 2017) explains that a party may take discovery as to matters that are relevant to its claims and defenses (*i.e.*, those specifically raised in the pleadings). However, *discovery relevant to the pleaded claims may also be conducted to the extent that said discovery may serve as the basis for an additional claim, defense, or counterclaim. See J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information sought had a bearing on issues involved in proceeding but could also be a basis for providing information concerning possible abandonment, that, if revealed, may provide basis for counterclaim).

Notwithstanding the foregoing specific parameters, the parties should be mindful that “[t]he dividing line between information relevant to the claims and defenses and that relevant only to the subject matter of the action cannot be defined with precision.” Fed. R. Civ. P. 26(b)(1) Advisory committee notes (2000 amendment); *see*

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*also Wright & Miller et al.*, 8 Fed. Prac. & Proc. Civ. § 2008 (3d ed. April 2017) (“the boundaries defining information that is relevant to the subject matter involved in the action are necessarily vague and it is practically impossible to state a general rule by which they can be drawn. ... [T]he requirement of relevancy should be construed liberally and with common sense, rather than in terms of narrow legalisms. But no one would suggest that discovery should be allowed of information that has no conceivable bearing on the case.”). Thus, the parties should use their discretion in propounding discovery, keeping in mind the Board’s limited jurisdiction (*see Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011) (the Board is empowered to determine only the right to register), their respective duty to cooperate (TBMP § 408.01), and the obligation to request information that is proportional to the case. *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1266 (TTAB 2015) (“the parties are expected to take into account the principles of proportionality with regard to discovery requests ... and are expected to consider the scope of the requests as well as to confer in good faith about the proper scope of discovery so as to minimize the need for motions”). Should the parties have questions in this case regarding the scope of discovery for this proceeding, they are urged to contact the assigned Interlocutory Attorney.<sup>3</sup>

Stipulations

Various stipulations may be agreed to by the parties, either during the course of the conference or during the pendency of the proceeding. By way of example, the

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<sup>3</sup> Elizabeth Winter, 571-272-9240, elizabeth.winter@uspto.gov.

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parties may agree or stipulate *in writing* to the following measures to facilitate the progress of this proceeding:<sup>4</sup>

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;
- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- That documents are deemed authenticated; and/or
- That a notice of reliance can be filed after the testimony periods are closed.
- That electronic evidence will be exchanged in a certain manner.

*See* TBMP §§ 403.01, 501, 704.03(b) and 705 (Jan. 2017).

**The parties agreed to exchange electronic evidence, if any, in native format, unless otherwise agreed.**

Standard Protective Agreement

The Board also reminded the parties that the Board's standard protective agreement applies to these proceedings and may be modified by the parties in writing.

*Should the parties modify the standard agreement, the Board requests that the parties*

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<sup>4</sup>Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. *See* TBMP §§ 403.01 and 501.02.



*identify which clause or provision has been modified.* The parties were reminded that a new standard protective order became effective on June 24, 2016.

Initial Disclosures

***Until the party seeking to serve discovery or to file a motion for summary judgment has served its initial disclosures, discovery may not be served, nor may a summary judgment motion be filed.***

Should the parties seek additional information on initial disclosures, they may obtain additional information regarding initial disclosures at the following sources:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf) and to

<http://edocket.access.gpo.gov/2006/pdf/06-197.pdf>, or to

[http://www.uspto.gov/trademarks/process/appeal/RULES01\\_17\\_06.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf). See Notice of

Final Rulemaking (“Miscellaneous Changes to Trademark Trial and Appeal Board Rules”) in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006) (pages 2498 and 2501).

Evidence

The parties were also reminded that each party has a duty to preserve material evidence and to avoid spoliation of evidence.<sup>5</sup>

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<sup>5</sup>“While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request.” *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D.Pa. 2007) (addressing law firm’s failure to preserve temporary electronic files). See also *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) (“ESI must be produced in Board proceedings where appropriate, notwithstanding the

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Accelerated Case Resolution (ACR)

The Board recommended that the parties considering using the Board's Accelerated Case Resolution procedure. If the parties decide to use ACR, the parties would submit to the Board a stipulation that cross-motions for summary judgment and accompanying evidentiary submissions would substitute for a trial record and traditional briefs at final hearing, that the parties would forego trial, and that the Board may make determinations of genuine disputes of material fact on the basis of the final record and may issue a final ruling based thereon in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence. However, other approaches have been adopted by parties that realize the efficiencies sought through the ACR process and should, therefore, be considered as falling under the ACR umbrella. *See, e.g., Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007), in which the parties stipulated to 13 paragraphs of facts, including applicant's dates of first use, channels of trade for applicant, extent and manner of applicant's use, recognition by others of applicant's use, as well as the dates, nature and extent of descriptive use by the opposer's parent; and the parties stipulated to the admissibility of business records, government documents, marketing materials and internet printouts.<sup>6</sup> Information concerning use of ACR in Board proceedings is available online at the following URL:

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Board's limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings") (internal citations omitted).

<sup>6</sup> By way of example only, the parties may view ACR related stipulations and orders in the following cases: 91219403 (see no. 34); 91214266 (see nos. 5, 7 and 13); 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history). The parties are directed

[http:// www.uspto.gov/trademarks/process/appeal/index.jsp](http://www.uspto.gov/trademarks/process/appeal/index.jsp).

### New Trademark Rules

The Board reminded the parties of the new Trademark Rules which apply to these proceedings and became effective on January 14, 2017 (see below).

### Trial Schedule

As discussed, Opposer is allowed until **May 15, 2017**, to submit an amended notice of opposition with a sufficient claim of false suggestion of a connection. Applicant is allowed until **June 5, 2017**, to submit an answer to any revised pleading filed by Opposer and/or a revised answer that includes sufficient affirmative defenses.<sup>7</sup> The trial schedule is revised as set forth in the following schedule:

<b>Discovery Opens</b>	<b>4/20/2017</b>
<b>Deadline for Amended Notice of Opp., if any</b>	<b>5/15/2017</b>
<b>Deadline for Answer to Amended Not. of Opp.</b>	<b>6/5/2017</b>
<b>Initial Disclosures Due</b>	<b>7/5/2017</b>
<b>Expert Disclosures Due</b>	<b>9/17/2017</b>
<b>Discovery Closes</b>	<b>10/17/2017</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>12/1/2017</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>1/15/2018</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>1/30/2018</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>3/16/2018</b>

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also to review *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015).

<sup>7</sup> As regards any amended pleading, the parties are reminded that under Rule 11 of the Federal Rules of Civil Procedure, they are certifying that all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. See Fed. R. Civ. P. 11.

Plaintiff's Rebuttal Disclosures Due	3/31/2018
Plaintiff's 15-day Rebuttal Period Ends	4/30/2018

**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. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.



**NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website:  
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:  
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- A chart summarizing the affected rules and changes:  
[http://www.uspto.gov/sites/default/files/documents/RulesChart\\_12\\_9\\_16.pdf](http://www.uspto.gov/sites/default/files/documents/RulesChart_12_9_16.pdf)

For all proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

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- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.