

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: December 29, 2017

Opposition No. 91237356

Rocket Sports, LLC

v.

Dexter Kan

**M. Catherine Faint,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on December 28, 2017, between Paul W. Koda, Atty., counsel for Rocket Sports, LLC, and Dexter Kan, appearing pro se. This order memorializes what transpired during the conference as well as providing additional guidance for both parties.

The Board asked if the parties were involved in any other Board proceeding (to determine whether consolidation was appropriate), or in litigation in court (to determine whether suspension was appropriate). The Board was informed that the parties were not so involved. The parties also indicated that they were familiar with the Board's electronic resources for filing papers electronically.

1. Legal Representation Strongly Recommended

As discussed, while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with

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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 Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure.

Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006). If Applicant decides to continue without counsel, he is urged to frequently consult the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) and the Trademark rules of practice, which are available from the USPTO website at www.uspto.gov.

2. Requirement for Service

Trademark Rules 2.119(a) and (b) require that every submission filed in a proceeding before the Board must be served upon the other party or parties, and proper proof of such service must be made before the submission will be considered by the Board. Accordingly, all submissions filed in this proceeding must be accompanied by a statement, signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made, the name of each party or person upon whom service was made, and the email address or address. *See* TBMP § 113.03. Service must be made by email unless otherwise stipulated, or unless

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the filing party has satisfied the requirements for another method of service as set forth in Trademark Rule 2.119(b). The statement 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 forwarding said copy on (insert date of emailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

Signature _____

Date _____

Submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and (b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are at <http://estta.uspto.gov/>.

It is recommended that any pro se party be familiar with the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. Parties should also be familiar with the Trademark Trial and Appeal Board Manual of Procedure (TBMP), available at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>, the TTABVUE system for viewing the record for all Board proceedings, available at <http://ttabvue.uspto.gov/ttabvue/>, and the Standard Protective Order, available at <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>.

3. Email Service

Pursuant to Trademark Rule 2.119(b) service of papers must be made via email unless otherwise stipulated by the parties. Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. 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.

4. Electronic Resources

As discussed, the Board has an electronic filing system that is different than the one used to file Trademark applications and updates to registrations. This system, named ESTTA, was discussed briefly during the teleconference, and may be accessed via the Board's website: <http://estta.uspto.gov/>. To highlight some features of the system, when a filing is made, a pre-populated cover sheet is generated; filings then may be attached in a .PDF format; if the filing has successfully been completed, the filer will receive an ESTTA tracking number; if there are any problems, call the Board at 571-272-8500 and ask to be put through to one of the computer specialists. Addresses can be changed easily through an electronic form. For instance, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.¹

¹ Ordinarily a consented motion to extend or reopen or suspend will be granted by the Board. See TBMP § 509.02, and cases cited therein.

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Also available to the parties is the Board's TTABVUE system which contains all of the Board's electronic files, including the one for this case. The parties may wish to conduct a status check of this case at least twice per month to be sure something is not missed. Most law firms already have a system for periodically checking status, and Applicant may access TTABVUE through the Board's website at: <http://ttabvue.uspto.gov/ttabvue/>.

The Board directed the parties to TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at http://www.uspto.gov/trademarks/process/appeal/tbmp_3rd_ed_rev_1.pdf. The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should also look to the Trademark Rules for specific guidance. TBMP § 414 provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

5. 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. Opposer indicated that it was amenable to the standard protective order. The Board noted that inasmuch as Applicant is representing himself *pro se* in this case, he would be unable to view any documents

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produced by Opposer that have been designated “Highly Confidential – For Attorneys Eyes Only.”

The parties agreed that they wished to submit a signed copy of the standard protective order for the record. Mr. Koda will provide a signed copy to Mr. Kan. Mr. Kan will sign that copy and file it with the Board via ESTTA within **TWENTY DAYS** of the date of this discovery conference.

6. Availability of ACR

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution (“ACR”) procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board’s website: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. *See* Trademark Rule 2.120(a)(2).

7. Review of the Pleadings

Upon review of the first amended notice of opposition, the Board noted there are claims based on Trademark Act § 2(d) for likelihood of confusion. Opposer claims ownership of a registration for the mark ROCKET SPORTS on the Principal Register. The Board looks to the goods and services as they are identified in the application

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and registration. Opposer has the burden of proof in this proceeding. A likelihood of confusion determination under § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). There are 13 *duPont* factors, however, not all of the *duPont* factors are relevant or of similar weight in every case. *In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Opposer has adequately alleged standing and the ground of priority and likelihood of confusion. Proof of the matter is left to trial or final decision.

By its first amended answer Applicant has stated he lacks sufficient information to admit or deny, or otherwise denied, the salient allegations of the complaint which serves as a denial.

As to the affirmative defenses, the Board construes the first, third and fourth “affirmative defenses” as amplifications of Applicant’s denials. As such they are not true affirmative defenses but are permitted to provide Opposer with a fuller notice of the position which Applicant plans to take in defense of his application. *See Morgan Creek*, 91 USPQ2d at 1136; *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading “affirmative defenses” were arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (objection to certain paragraphs of answer as verbose and argumentative not well taken).

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The second affirmative defense is not a proper allegation of fraud as it lacks any specific details, and to the extent it is a collateral attack on Opposer's registration is not allowed. Applicant may not plead what is essentially a collateral attack on Opposer's registrations absent a counterclaim. Trademark Rule 2.106(b)(2)(ii). *See also* TBMP § 311.02(b) The Board notes that Applicant has not asserted a counterclaim to cancel Opposer's registration on any ground in this proceeding. Accordingly, this affirmative defense **will be given no consideration** and is **stricken**. Applicant's fifth and sixth affirmative defenses are also collateral attacks on Opposer's pleaded registration and are **stricken**.

By his seventh affirmative defense, Applicant "reserves the right" to set forth additional defenses. A defendant cannot reserve some unidentified defenses, because such a "reservation" does not provide plaintiff with fair notice of any such defenses. Whether or not Applicant may, at some future point, add an affirmative defense would be resolved by way of a motion to amend for Board approval. *See* Fed. R. Civ. P. 15(a). Accordingly, Applicant's seventh affirmative defense, it is hereby **stricken**

8. Discovery

The Board explained to parties that all discovery requests should be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. The duty to supplement discovery responses continues even 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

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summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127. Requests for production of documents 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.

The parties were directed to TBMP § 414 regarding the discoverability of various categories of information in Board proceedings.

9. Initial Disclosures

The Board reminded the parties that discovery does not open until December 30, 2017 despite the conference being held several days prior. As indicated, dates are to remain as last reset by the Board on November 22, 2017 unless parties file a motion to extend discovery approved by the Board, or the Board otherwise resets the dates. Initial disclosures are due January 29, 2018.

The Board provided the parties information as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). Initial disclosures are the witnesses, documents and things having or containing relevant information. Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii):

- (i) 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;
- (ii) (ii) 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

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use to support its claims or defenses, unless the use would be solely for impeachment.

Furthermore, the Board 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 Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties. *See* Trademark Rules 2.120(a)(3) and 2.127(e)(1). Initial disclosures do not need to be filed with the Board, only served on the other party.

The Board advised the parties that they may adopt various measures to limit the scope of discovery and also stipulate to the authenticity of documents.

10. ESI

The Board asked the parties whether there will be any discovery of ESI, and if so what types or categories of discoverable information each party had in electronic form. Opposer indicated that it might have some emails and some electronic documents.

When concluding the conference, the Board asked about any limitations to discovery the parties were willing to discuss. Applicant expressed a desire to discuss a potential settlement agreement at the time. The Board indicated that this was not a function of the Board or of the discovery conference. The Board, however, strongly encouraged the parties to discuss settlement options. Opposer indicated it was willing to discuss settlement options with Applicant. No limitations on discovery were agreed to at this time.

11. Summary and Schedule

Dates for this proceeding remain as set in the Board’s order of November 22, 2017, as copied below. Once again, although the discovery conference was held December 28, 2017, discovery does not open until the date set out below.

Applicant’s second, fifth, sixth and seventh affirmative defenses are **stricken**.

Within **TWENTY DAYS** of this discovery conference, the parties will submit a signed copy of the Board’s protective order.

Deadline for Discovery Conference	12/30/2017
Discovery Opens	12/30/2017
Initial Disclosures Due	1/29/2018
Expert Disclosures Due	5/29/2018
Discovery Closes	6/28/2018
Plaintiff’s Pretrial Disclosures Due	8/12/2018
Plaintiff’s 30-day Trial Period Ends	9/26/2018
Defendant’s Pretrial Disclosures Due	10/11/2018
Defendant’s 30-day Trial Period Ends	11/25/2018
Plaintiff’s Rebuttal Disclosures Due	12/10/2018
Plaintiff’s 15-day Rebuttal Period Ends	1/9/2019
Plaintiff’s Opening Brief Due	3/10/2019
Defendant’s Brief Due	4/9/2019
Plaintiff’s Reply Brief Due	4/24/2019
Request for Oral Hearing (optional) Due	5/4/2019

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for

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submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).
