

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: October 30, 2018

Opposition No. 91240601

University of Louisiana at Lafayette,

v.

Pickin' Cotton Communications, LLC

Winston Folmar, Attorney (571-272-2085):

On October 18, 2018, at Applicant's request, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were Blair B. Suire, attorney for Opposer, Matt Fogarty, MD (on behalf of Applicant), and Winston Folmar, attorney for the Board.¹ Such conferences are informal in nature and may not be recorded, but this summary order becomes part of the record. Applicant requested the Board's participation in order to ensure strict adherence to all relevant Trademark Rules of Practice and the Trademark Trial and Appeal Board Manual of Procedure (TBMP)(June 2018).

LEGAL REPRESENTATION IS STRONGLY ENCOURAGED

As set forth in the Board's April 11, 2018 institution and trial order, and again in the Board's September 15, 2018 order denying consolidation, Applicant is advised

¹ The Board also had other non-participating staff in attendance for training purposes.

that obtaining counsel is strongly recommended. 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, whether or not they are represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

PLEADED CLAIMS AND DEFENSES

Applicant seeks registration of a mark described in the application as “a fleur de lis with a mean facial expression. The fleur de lis appears to be flexing its muscular body” for various clothing items in Class 25 (application Serial No. 87559244).

i. Notice of Opposition

Opposer, a state university of Louisiana, claims prior common law rights and ownership of two pleaded registrations for fleur-de-lis designs, namely:

- Registration No. 3459949, issued July 8, 2008 in connection with educational services in Class 41; and
- Registration No. 4349160 issued June 11, 2013 in connection with various clothing items in Class 25 and various entertainment and educational services in Class 41.

Status and title copies of the pleaded registrations were attached to the notice of opposition. Because Opposer proved its ownership of valid and live registrations for its pleaded mark, there is no issue with respect to Opposer’s standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185,

189 (CCPA 1982). Opposer alleges a claim of priority of use and likelihood of confusion. To the extent Opposer relies on its pleaded registrations, and no counterclaim is pending, priority also is not in issue. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). To the extent Opposer relies on common law use, its priority remains an issue for trial. As discussed, the predecessor to the Board's primary reviewing court established a list of factors² to be considered when testing for likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The Board concludes that the notice of opposition is legally sufficient.

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- ² (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
- (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

ii. Answer

On May 2, 2018, Applicant filed its timely answer which denies the salient allegations of the notice of opposition and lists two affirmative defenses (which were repeated). An affirmative defense is “[a] defendant’s assertion raising new facts and arguments that, if true, will defeat the plaintiff’s or prosecution’s claim, even if all allegations in the complaint are true.” *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) citing Black's Law Dictionary, p. 430 (7th ed. 1999). In view of the Board’s review of the pleadings, and the finding that Opposer has pled both standing and its likelihood of confusion claim, Applicant’s affirmative defense that the notice of opposition fails to state a claim for relief is stricken.

While the remaining allegations listed as affirmative defenses do not plead affirmative defenses, they permissibly amplify Applicant’s general denial of the likelihood of confusion, and so may remain part of the answer. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n. 11 (TTAB 2015).

CLARIFICATION OF ENTITY

Applicant specifically denied in its answer (§ 15) the assertion that it is a Louisiana limited liability company. During the conference, Applicant stated that it is a limited liability company of Delaware, and that a clerical mistake was made in the original application (Serial No. 87559244) listing its state of incorporation as Louisiana instead of Delaware. Applicant also noted that its correct legal name is not stated in the opposed application.

Applicant is ordered, within ten (10) days after issuance of the present order, to file with the Board a motion to amend the application to correctly state Applicant's legal name and entity, making clear that there is no second entity in Louisiana, but that Applicant made a mistake in listing its entity. If the requested action is characterized as correction of Applicant's mistake, and not a motion to amend the application, the motion to correct can be granted without Opposer's consent. See TMEP 1201.02(c) and TBMP 514.03.

The Trademark Rules of Practice use the term "representative" to refer to a legal representative, or lawyer. Dr. Fogarty is not a lawyer and should not identify himself as "Applicant representative." As a corporate officer of Applicant, Dr. Fogarty's statements are binding on Applicant. Accordingly, papers signed by a corporate officer should identify the filer as "Applicant" only.

SETTLEMENT

The parties indicated that no settlement discussions have taken place but that both parties are open to the possibility of resolving the matter via settlement. Unlike the federal courts, the Board does not take an active role in promoting settlement. As discussed, because its jurisdiction is limited to registrability determinations, the Board's role in settlement is limited. The Board has no authority to enforce settlement provisions regarding the use of marks.

Should settlement come up again, the parties are advised that the Board is liberal in granting stipulations to suspend proceedings to allow settlement discussions. Stipulations to suspend the proceeding should be filed promptly because, absent

suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (“[I]t is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay.”).

Settlement discussions generally are confidential, so that statements made during settlement discussions should not be submitted in the proceeding. The parties should preview Board filings with care to ensure that settlement matters do not inadvertently become part of the record.

ACR (ACCELERATED CASE RESOLUTION) PROCEDURES

ACR options are set forth on the TTAB's webpage at www.uspto.gov (alternate resolution options); see also *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1266 fn9 (TTAB 2008) (“ACR is a procedure akin to summary judgment in which parties can receive a determination of the claims and defenses in their case promptly, but without the uncertainty and delay typically presented by standard summary judgment practice. In order to take advantage of ACR, the parties must stipulate that, in lieu of trial, the Board can resolve any material issues of fact... After the briefs are filed, the Board will issue a decision within fifty days, which will be judicially reviewable as set out in 37 CFR §2.145.”). If the parties wish to revisit the issue of ACR after they exchange initial discovery responses, they should discuss mutually convenient meeting times, and call Board Attorney Elizabeth Dunn. In addition, the Board will entertain any stipulations designed to save the parties time

and money, such as stipulating to facts, agreeing to a shortened schedule of disclosure, discovery, and trial, and/or stipulating as to the admissibility of evidence.

ARRANGEMENTS FOR DISCLOSURE, DISCOVERY AND TRIAL

The parties next must serve each other with initial disclosures. Fed. R. Civ. P. 26(a) (1) provides “a party must, without awaiting a discovery request, provide to the other parties:

(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) 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 ...”

With respect to discovery, the scope of the pleadings determines the scope of discovery. See Fed. R. Civ. P. 26(b) (1) (“Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense...”). The parties are expected to promptly respond to discovery requests, and to consult Chapter 400 of the TBMP before refusing to provide any requested information. Please consult the Board’s rules as to relevant discovery deadlines.

The Board notes the new ease in submitting trial testimony (submission of an affidavit in lieu of an oral examination), subject to the right of cross-examination. As

discussed, in the event that testimony is submitted by way of sworn affidavit, the affiant must be made available for cross-examination by opposing party, if requested. Cross-examination of a declarant generally takes place where the declarant lives or works. *USPS v. RPost Commc'n Ltd.*, 124 USPQ2d 1045 (TTAB 2017).

Finally, the Board advises that initial disclosures should be promptly supplemented as the parties' trial strategy evolves, to avoid surprise at trial, and to allow discovery to be taken from prospective witnesses. As indicated above, the parties remain free to stipulate to an abbreviated schedule or alternate forms of evidence. Absent such stipulation, the Board's current schedule and rules define applicable deadlines and evidentiary requirements.

SCHEDULE REMAINS AS SET

Dates remain as set by the Board's September 15, 2018 order (TTABVUE 10) (as indicated below):

Discovery Opens	10/15/2018
Initial Disclosures Due	11/14/2018
Expert Disclosures Due	3/14/2019
Discovery Closes	4/13/2019
Plaintiff's Pretrial Disclosures Due	5/28/2019
Plaintiff's 30-day Trial Period Ends	7/12/2019
Defendant's Pretrial Disclosures Due	7/27/2019
Defendant's 30-day Trial Period Ends	9/10/2019
Plaintiff's Rebuttal Disclosures Due	9/25/2019
Plaintiff's 15-day Rebuttal Period Ends	10/25/2019
Plaintiff's Opening Brief Due	12/24/2019
Defendant's Brief Due	1/23/2020
Plaintiff's Reply Brief Due	2/7/2020
Request for Oral Hearing (optional) Due	2/17/2020