

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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DUNN

October 24, 2018

Opposition No. 91243195

*Pizzeria Uno Corporation*

*v.*

*Uno Dos Tres, LLC*

**Elizabeth A. Dunn, Attorney (571-272-4267):**

On October 16, 2018, at Opposer's request, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were John Welch, attorney for Opposer, Joseph Woolfolk, Principal for Applicant<sup>1</sup>, acting pro se, and Elizabeth Dunn, attorney for the Board. Such conferences are informal in nature and may not be recorded, but this summary order becomes part of the record. Opposer requested the Board's participation so all parties, including those without counsel, would share a common expectation as to how the proceeding will move forward.

**AUTHORITY OF SIGNER**

The answer was filed by Joseph Woolfolk, sole owner of Applicant, a limited liability company of Wisconsin. The signature is not accompanied by a printed version of the signer's name or any indication of title. Pursuant to United States Patent and

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<sup>1</sup> Applicant's business consultant, Lucy Woolfolk, also attended the conference.

Trademark Office Rule 11.14(e), an individual may appear in a trademark matter in his or her own behalf, or for:

- (1) A firm of which he or she is a member,
- (2) A partnership of which he or she is a partner, or
- (3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.

A document filed in a proceeding before the Board should include the name, in typed or printed form, of the person who signed; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; or as the filing party's attorney); and his or her business address and telephone number. *See* TBMP §106.02 (June 2018).

Joseph Woolfolk confirmed that he signed the answer as a Member of the Applicant. From this point forward, and any filings on behalf of Applicant must identify the signer and the signer's title with Applicant.

#### PLEADED CLAIMS AND DEFENSES

Applicant seeks registration on the basis of its bona fide intent to use in commerce the mark UNO DOS TRES (standard characters), which translates to "one two three". for "restaurant services, namely, providing of food and beverages for consumption on and off the premises" (application Serial No. 87821726 filed March 6, 2018).

Opposer Pizzeria Uno Corporation, a Delaware corporation, claims ownership of eleven pleaded registrations for marks including the terms UNO, UNO'S, and DUE for various restaurant services, and common law rights since 1943 in the terms PIZZERIA

UNO and UNO, and pleads a claim of likelihood of confusion. Opposer's standing and claim have been sufficiently pleaded.

Applicant is advised that ownership of a prior registration is sufficient to establish both Opposer's standing to bring its claims, and its priority for purposes of likelihood of confusion. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The predecessor to the Board's primary reviewing court established a list of factors to be considered when testing for likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

- (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.

Applicant also is advised that the scope of the pleaded issues determines the scope of relevant 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...”). Accordingly, discovery requests addressing any of the factors listed above are relevant to Opposer’s likelihood of confusion claim.

Applicant’s answer is informal and consists of a general denial of the allegations in the notice of opposition. Applicant is advised that all subsequent submissions must be double-spaced, and otherwise conform to the requirements of Trademark Rule 2.126. The Trademark Rules of practice are available from the USPTO website.

The answer also refers to “counsel of Uno Dos Tres.” Mr. Woolfolk clarified that he was using the term as a synonym for “corporation”, and not as a reference to a legal representative. The Board advised that such references to counsel by a party acting pro se are confusing, and should not be used in any subsequent Board submissions.

**LEGAL REPRESENTATION IS STRONGLY ENCOURAGED**

While U.S. Patent and Trademark Office Rule 11.14 permits any person to represent herself, it is generally advisable for a person 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 Patent and Trademark Office cannot aid in the selection of an attorney.

Applicant is advised that an inter partes proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, 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 in the case unless it has been introduced in evidence in accordance with the applicable rules. 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). Both parties are encouraged to consult the Trademark Rules of Practice and the Trademark Trial and Appeal Board Manual of Procedure (TBMP)(2018), both available at the Board's webpage at [www.uspto.gov](http://www.uspto.gov).

## SETTLEMENT

The parties indicated that no substantive settlement discussions have taken place. 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 litigation. The parties should preview Board filings with care to ensure that settlement matters do not inadvertently become part of the record.<sup>2</sup>

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<sup>2</sup> If confidential matters inadvertently become part of the record, the parties may file a redacted copy and request that the original filing be designated as confidential and masked from public view. The Board's standard protective order automatically is in effect for this proceeding, and confidential business information requested in discovery should be served in accord with provisions of the agreement, which can be viewed at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

## ACR (ACCELERATED CASE RESOLUTION) PROCEDURES

ACR options are set forth on the TTAB's webpage at [www.uspto.gov](http://www.uspto.gov); *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.”). ACR remains available throughout the proceeding (though the most benefit occurs with early adoption). 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 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 ...”

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.

As to trial, the parties are strongly urged to communicate early and often regarding their plans regarding the submission of testimony. For example, objections to planned testimony by deposition should be raised before the deposition. 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. 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.

Dates remain as set by the Board's August 23, 2018 institution and trial order.