

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

May 9, 2019

Opposition No. 91246431

*Lulu's Fashion Lounge, LLC*

*v.*

*Hongkong Yinghui International Trading  
Co., Limited*

**Geoffrey M. McNutt, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1)–(a)(2), 37 C.F.R. § 2.120(a)(1)–(a)(2), the parties held a discovery and settlement conference on May 8, 2019, at 1:00 pm Eastern Time. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 401.01 (2018). At Opposer’s request the Board participated in the conference. Participating in the conference were Amanda Phillips and Jennifer Taylor, counsel for Opposer, and Francis John Ciaramella, counsel for Applicant. Interlocutory Attorneys Geoffrey McNutt and Rebecca Stempien Coyle participated on behalf of the Board.

**1. Settlement/Other Litigation**

The parties indicated that there are no related Board proceedings or federal or state court actions between them that may have a bearing on this case. In the event that a civil action or separate Board proceeding between the parties is instituted, the

parties are required to promptly advise the Board so that the Board can determine whether suspension or consolidation is appropriate. *See* TBMP §§ 510.02(a) and 511; *see also* Trademark Rule 2.117(a).

The parties were advised that if they are engaged in settlement discussions, unless a suspension request is filed the Board presumes the parties are preparing for trial. The Board typically will grant a consented or joint motion to suspend proceedings for a reasonable period of time in order to allow the parties to engage in settlement negotiations.<sup>1</sup> *See* TBMP § 510.03(a); *see also* Trademark Rule 2.117(c).

Opposer stated that Applicant had previously agreed to change its mark from LULUGAL to another mark. The Board noted that the notice of opposition does not include any allegations of a prior agreement, and if the Opposer seeks to enforce such an agreement Opposer should amend its notice of opposition to include an allegation of collateral estoppel, to the extent warranted by the facts and otherwise appropriate. At the end of this order the Board has afforded Opposer time to amend its pleading accordingly.

## **2. Pleadings**

The Board then reviewed the sufficiency of the parties' respective pleadings.

### **a. Notice of Opposition**

Turning first to the notice of opposition, Applicant has applied to register the mark LULUGAL and design, in the following form

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<sup>1</sup> The parties are advised, however, that the Board will not suspend proceedings indefinitely for settlement negotiations. After a period of time, the Board may require the parties to file a detailed report on the progress of their settlement activities. While the Board encourages settlement efforts, it also has an interest in seeing its cases conclude in a timely manner.



for the following goods in International Class 25<sup>2</sup>:

Aprons; Babies' trousers; Baby layettes for clothing; Baby tops; Bathrobes; Bikinis; Blazers; Blouses; Boots; Bras; Bustiers; Camisoles; Capes; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Coats; Costumes for use in children's dress up play; Dresses; Footwear; Footwear, namely, pumps; Gloves; Hats; Heels; Jackets; Jumpers; Jumpsuits; Kimonos; Knitwear, namely, knit tops, knit bottoms; Leggings; Lingerie; Negligees; Night gowns; Pajamas; Pants; Parkas; Rainwear; Sandals; Scarves; Shawls; Shirts; Shoes; Shorts; Socks; Sweaters; Sweatshirts; Swimwear; T-shirts; Tank tops; Trousers; Vests; Women's shoes, namely, foldable flats; Belts for clothing; Platform shoes.

As the sole ground for opposition, Opposer has pleaded likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on allegations of prior registration and use of the marks LULU'S, LULUS and LULUS (stylized), a pending application and prior use of the mark LOVELULUS,<sup>3</sup> and prior use and rights at common law to the marks LULU'S, LULUS and LULUS (stylized). Opposer's alleges that that Applicant's LULUGAL and design mark is likely to cause confusion with Opposer's previously registered and used marks.

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<sup>2</sup> Serial No. 8853110, filed on July 25, 2018, based on Applicant's declared use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and claiming April 25, 2018, as both the date of first use of the mark anywhere and in commerce.

<sup>3</sup> The pending application subsequently issued as Registration No. 5690666 on March 5, 2019. Opposer informed the Board that it intended to amend its pleading to assert the issued registration.

Opposer has sufficiently alleged priority and likelihood of confusion as to its pleaded registrations and its alleged rights at common law to the marks LULU'S and LULUS. Regarding Opposer alleged common law rights in the unregistered mark LULUS in stylized form, however, Opposer has failed to indicate the particular stylization of the mark in the notice of opposition, and therefore has failed to sufficiently plead common law rights in the stylized LULUS mark, and similarly has not provided Applicant with sufficient notice of the stylization and appearance of the mark. Accordingly, the Section 2(d) claim is **dismissed in part** solely as to the insufficiently pleaded allegations of prior common law rights in the stylized LULUS mark.

At the end of this order the Board has afforded Opposer an opportunity to amend its notice of opposition to attempt to sufficiently plead common law rights in the stylized LULUS mark. Opposer may also amend its pleading to reflect that its pleaded application Serial No. 88042747 recently issued as Registration No. 5690666. Additionally, during the conference Opposer stated its position that Applicant's application is barred by a prior settlement agreement between the parties. The Board noted, however, that Opposer has not pleaded a claim of contractual estoppel. Accordingly, Opposer also is being allowed time to amend its pleading to assert the claim of contractual estoppel, to the extent warranted by the facts.

Finally, Opposer has alleged sufficient facts, which if proved, would establish that it has a reasonable basis for its belief of damage, and therefore, has standing to

maintain this proceeding.<sup>4</sup> *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

**b. Applicant's Answer**

Applicant, in its answer, denied the salient allegations in the notice of opposition<sup>5</sup> and asserted nine affirmative defenses. Applicant's answer is sufficient in that it fairly responds to the substance of the allegations in the notice of opposition.

Applicant's first affirmative defense is an assertion that the allegations in the notice of opposition fail state a claim upon which relief can be granted. Failure to state a claim upon which relief may be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of Opposer's claim rather than a statement of a defense to a properly pleaded claim. *Compare* Fed. R. Civ. P. 12(b)(6) *with* Fed. R. Civ. P. 8(b); *see also Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Moreover, and in any event, as discussed above the Board has determined that Opposer has sufficiently

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<sup>4</sup> Where a plaintiff has alleged standing as to at least one properly pleaded ground, its allegation of standing satisfies the standing requirement for any other legally sufficient ground. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012); *Nike*, 116 USPQ2d at 1029; *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011). Of course standing, as an element of Opposer's case, must be maintained throughout the proceeding and affirmatively proved at trial. *See Lipton Indus.*, 213 USPQ at 189; *see also Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017).

<sup>5</sup> Applicant's responses to paragraphs 1-7, 10, 11 and 19 state that Applicant is without knowledge. The Board construes these responses as denials pursuant to Fed. R. Civ. P. 8(b)(5).

pleaded its standing and a claim of priority and likelihood of confusion. Accordingly, the Board sua sponte **strikes** Applicant's first affirmative defense.

Applicant's second through ninth affirmative defenses consist of arguments that Opposer does not have priority or why there is no likelihood of confusion between the parties' marks. Applicant's assertions are not true affirmative defenses, but rather amplifications of its denial of Opposer's likelihood of confusion claim. Nevertheless, because these "defenses" provide fuller notice to Opposer of how Applicant intends to defend this opposition, the Board sees no harm in allowing them to remain, and does not strike them. *See Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999).

### **c. Amendment of Pleadings**

The parties were reminded that any motion for leave to amend a pleading to add a new claim or defense must be filed promptly after the facts supporting the new claim or defense are discovered. *See generally*, TBMP §§ 315 and 507.

### **3. Standard Protective Order**

The parties were reminded that the Board's Standard Protective Order<sup>6</sup> is automatically imposed in this proceeding pursuant to Trademark Rule 2.116(g), unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. *See*

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<sup>6</sup> The standard protective order is available on the Board's web site at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

TBMP §§ 412.01 and 412.02. Although they are not required to do so, the parties may elect to exchange executed copies of the order.<sup>7</sup> The terms of the standard protective order may be modified upon motion or stipulation approved by the Board. *See* TBMP § 412.02.

Because of the automatic imposition of the protective order, parties may designate information or documents as confidential but typically cannot withhold properly discoverable information or documents on that basis. *See* TBMP § 412.01.

If the parties agree to modify the terms of the Board's standard protective order and enter into their own stipulated protective order, a copy of the executed agreement should be filed with the Board. The Board will acknowledge receipt of the agreement, but the parties should not wait for the Board's acknowledgement to conduct themselves in accordance with the terms of their agreement. The terms of the agreement are binding as of the date the agreement is signed. *See* TBMP § 412.01.

#### **4. Discovery and Motions Practice**

The Board advised the parties that they must make their initial disclosures as required by Fed. R. Civ. P. 26(a) prior to seeking discovery,<sup>8</sup> absent modification of

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<sup>7</sup> Once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties. It is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. Therefore, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. Nonetheless, any determination of whether the agreement establishes contractual rights or is enforceable outside of the Board proceeding is for a court to decide should such matter come before it. *See* TBMP § 412.03.

<sup>8</sup> The parties indicated their willingness to produce at least some documents with their initial disclosures.

this requirement by the Board. Trademark Rule 2.120(a)(3). A motion to compel initial disclosures must be filed within thirty days after the deadline for initial disclosures. Trademark Rule 2.120(f)(1).

The parties also were advised that they may not file a motion for summary judgment until they have made their initial disclosures, except for a summary judgment motion asserting issue preclusion, claim preclusion, or lack of jurisdiction by the Board. Trademark Rule 2.127(e)(1).

Pursuant to 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[.]”

With respect to discovery, the parties are expected to plan accordingly so that this proceeding is not unduly delayed because Applicant resides outside the United States. Applicant indicated that, at this time, it does not anticipate any issues with adhering to the Board’s schedule. Should it become apparent to Applicant that it will not be able to adhere to the schedule, Applicant should promptly contact Opposer to discuss a reasonable extension of time or suspension, as appropriate, and file the necessary motion with the Board. As discussed, the subject of how to obtain testimony from witnesses located outside the United States is a subject which the parties should discuss following service of initial disclosures.

Although the Board encourages the parties to consent to extensions of time to accommodate reasonable scheduling difficulties, absent a motion to extend a deadline – based on either the consent of the other party or the requisite showing of good cause



for an extension – the parties are expected to adhere to the Board’s schedule for this proceeding.

In addition, as a means of expediting discovery, Applicant is ordered, within **30 DAYS** of the date of this Order, to inform Opposer in writing if it has offices in the United States, and whether any corporate officers, individuals listed in Applicant’s initial disclosures, or individuals knowledgeable about the pleaded issues in this case will be travelling in the United States over the next six months and thus would be available for a discovery deposition.

Unless the parties stipulate to an alternate procedure, the discovery deposition of a natural person who resides in a foreign country, and who is a party or an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, may be taken on notice alone but it must be taken on written question unless the Board, on motion for good cause, orders that the deposition be taken by oral examination. *See* Trademark Rules 2.123 and 2.124.<sup>9</sup>

Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than

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<sup>9</sup> Some countries prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. A party which wishes to take a deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State. TBMP § 404.03(b)-(c).

the close of the discovery period. Trademark Rule 2.120(a)(3). Similarly, discovery depositions must be properly noticed and taken during the discovery period.<sup>10</sup> *Id.*

The parties are limited to seventy-five interrogatories, including subparts; seventy-five requests for production of documents and things, including subparts; and seventy-five requests for admission. *See* Trademark Rules 2.120(d), 2.120(e), and 2.120(i). Independent of the limit on the number of requests for admission, a party may make one comprehensive request for admission of any adverse party that has produced documents for an admission authenticating specific documents, or specifying which of those documents cannot be authenticated. Trademark Rule 2.120(i).

The parties should **not** file their initial disclosures, discovery requests, or discovery responses with the Board, except as permitted under Trademark Rule 2.120(k)(8); in connection with a motion to compel discovery, as required by Trademark Rule 2.120(f)(1); or in connection with a motion to determine the sufficiency of an answer or objection to a request for admission, as required by Trademark Rule 2.120(i)(1).

The parties were reminded that they each have a duty not only to make a good faith effort to satisfy the legitimate discovery needs of their adversary, but also to

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<sup>10</sup> The discovery deposition of a natural person residing in the United States shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree in writing. The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. Trademark Rule 2.120(b). *See also* TBMP §§ 404.03(a)(2) and 404.05.

make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See* TBMP § 408.01.

The parties were advised to consult the “Discovery Guidelines” listed in the TBMP § 414 before making or objecting to discovery requests. The Board expects parties to cooperate with one another in the discovery process. *See* TBMP § 408.01. If either party plans to file a motion to compel discovery or a motion to test the sufficiency of a response or objection to a request for admission, the moving party must first confer with the other party in good faith to attempt to resolve or narrow the dispute, and then must demonstrate its good-faith efforts as part of its motion. *See* Trademark Rules 2.120(f)(1) and 2.120(i); *see also* TBMP § 523.02. The obligation to meet and confer in good faith is a mutual obligation.

Motions to compel discovery, motions to test the sufficiency of responses or objections to a request for admission, and motions for summary judgment must be filed no later than the day **before** the deadline for pretrial disclosures for the first testimony period as originally set or as reset. Trademark Rules 2.120(f)(1), 2.120(i)(1), and 2.127(e)(1).

To the extent either party plans to use an expert witness, such party must make their expert witness disclosure by the set deadline, and provide the Board with notification that the party will be employing an expert. Trademark Rule 2.120(a)(2)(iii). The Board may suspend proceedings as appropriate to allow the parties to take discovery of a designated expert witness or to allow a rebuttal expert witness.

## **5. Pretrial Disclosures and Trial Procedures**

Pretrial disclosures are governed by Trademark Rule 2.121(e) and Fed. R. Civ. P. 26(a)(3) with one exception: the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as required by Fed. R. Civ. P. 26(a)(3)(A)(iii). Additionally, a party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. Trademark Rule 2.121(e).

In making its pretrial disclosures, the party must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises. The party must disclose general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Pretrial disclosure of a witness under Trademark Rule 2.121(e), however, does not substitute for service of a proper notice of examination under Trademark Rule 2.123(c) or 2.124(b). Additionally, if a party does not plan to take testimony from any witness in any form, it must state so in its pretrial disclosures.

For further information regarding pretrial disclosures, the parties should consult TBMP § 702.01.

The testimony of a witness may be taken upon oral examination and transcribed, or presented in the form of an affidavit or declaration, as provided in Trademark Rule 2.123. If witness testimony is presented in the form of an affidavit or declaration, the adverse party may elect to take oral cross-examination of that witness as provided under Trademark Rule 2.123(c).<sup>11</sup> A party electing to take oral cross-examination shall bear the expense of such cross-examination.

Finally, the Board advised the parties of the variety of options available to streamline the introduction of evidence at trial, including, for example, stipulations of fact and stipulations permitting the introduction of various documents (*e.g.*, documents produced in response to document requests, business records, etc.) by notice of reliance.

## **6. Filing and Service of Papers**

Except for the initial notice of opposition (as opposed to any amended notice of opposition), 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. Trademark Rule 2.119(a)–(b). Service must be made by email unless otherwise stipulated, or unless the filing party has satisfied the requirements for another method of service as set forth in Trademark Rule 2.119(b).<sup>12</sup>

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<sup>11</sup> If an affiant or declarant witness is not within the jurisdiction of the United States, then the adverse party may elect to take cross-examination of that witness by written questions. *See* Trademark Rules 2.123(a)(1) and 2.124.

<sup>12</sup> The Board also uses email when sending decisions, orders, or other notices to the parties. The Board will send email to the parties at the addresses they have provided, so it is essential that the parties promptly update their email and street addresses with any change. It is the parties' responsibility to take any necessary steps to ensure that papers from opposing counsel or the Board are not rejected by their spam filters. Where possible, it is strongly

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.

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 mailing), via email to: (set out name, address, and email address of opposing counsel or party).

Signature: \_\_\_\_\_  
Date: \_\_\_\_\_

The parties were further advised that they are required to file all pleadings and submissions (including confidential filings) via ESTTA, the Board's electronic filing system.<sup>13</sup> Documents uploaded to ESTTA are deemed filed upon successful completion of transmission to the Board, including the receipt of any required fee. Eastern Time controls the filing date. *See* TBMP § 110.09.

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recommended that the Board's domain and that of opposing counsel be put on a "safe-senders list" of email which should not be rejected by a filter.

<sup>13</sup> The ESTTA user manual, ESTTA forms, and instructions for their use can be found on the Board's website (<http://estta.uspto.gov/>). If the parties have questions about electronic filing or experience difficulties, they may call the Board's main number at (571) 272-8500 or (800) 786-9199 (toll free). The Board's Information Specialists are available to assist filers from 8:30 a.m. until 5:00 pm Eastern time, Monday through Friday. Filers are urged to plan ahead and to attempt to file well before any deadline. The Board cannot guarantee that any technical problem will be resolved quickly, and deadlines will not normally be extended in such a case.

## 7. Accelerated Case Resolution

The Board advised the parties of the Board's Accelerated Case Resolution ("ACR") process. ACR is an alternative to typical Board inter partes proceedings with full discovery, trial, and briefing. *See Chanel Inc. v. Makarczyk*, 110 USPQ2d 2013, 2016–17 (TTAB 2013) (Board's final decision on ACR); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1775 (TTAB 2013) (ACR stipulation approved by Board); *see also Bond v. Taylor*, 119 USPQ2d 1049, 1051 (TTAB 2016); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 (TTAB 2015). The form of ACR can vary, but the process generally approximates a summary bench trial or a motion (or cross-motions) for summary judgment and accompanying evidentiary submissions that the parties agree to submit in lieu of creating a traditional trial record and traditional briefs at final hearing. As already noted, the Board allows the parties to stipulate to a variety of deviations from the Board's rules in order to streamline discovery and testimony. If the parties stipulate to ACR they could avoid a formal trial altogether. Although the Board may not decide disputed issues of material fact when considering a motion for summary judgment,<sup>14</sup> the parties may stipulate to the submission of such briefs and evidence in lieu of trial and agree that the Board may make any factual determinations based on such a record. If the parties agree to ACR relatively early in

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<sup>14</sup> While Board litigants are permitted to move for summary judgment under Fed. R. Civ. P. 56, the parties are advised that questions of a likelihood of confusion often are heavily fact-bound and ill-suited for summary disposition. As a result, the Board frequently denies motions for summary judgment. If the parties desire a resolution of the case short of a full trial, they are encouraged to consider ACR, rather than a motion for summary judgment.

the proceeding, they could realize a very significant saving in time<sup>15</sup> and cost. More information about the Board's ACR options can be found in the TBMP and on the Board's website, as follows:

1. General description of ACR:

[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_notice_from_TTAB_webpage_12_22_11.pdf);

2. FAQs on ACR:

[https://www.uspto.gov/sites/default/files/trademarks/process/appeal/Accelerated\\_Case\\_Resolution\\_%28ACR%29\\_FAQ\\_updates\\_12\\_22\\_11.doc](https://www.uspto.gov/sites/default/files/trademarks/process/appeal/Accelerated_Case_Resolution_%28ACR%29_FAQ_updates_12_22_11.doc); and

3. TBMP §§ 528.05(a)(2), 702.04, and 705.

As an alternative to the “traditional” ACR process discussed above, the parties also may explore stipulating to facts, evidence, and/or procedures at trial. *See, e.g., Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to entire record of the case including business records, public records, government documents, marketing materials, materials obtained from the Internet, and thirteen paragraphs of facts; the parties agreed to reserve the right to object to such facts and documents on the bases of relevance, materiality and weight). *See generally* TBMP § 705 regarding evidentiary stipulations.

The Board discussed several possible options for ACR, which the parties agreed to consider, including the following: foregoing the use of expert witnesses; limiting each party to three discovery depositions; limiting the number of interrogatories,

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<sup>15</sup> Because ACR records are usually more compact than those presented on formal testimony and notices of reliance, the Board usually can render a final decision more quickly.



document requests, and requests for admission to 40 each (including subparts); stipulating to the submission of trial testimony by declaration or affidavit without cross-examination; and adopting the summary judgment form of ACR, including the requisite stipulation that the Board may resolve any genuine dispute of material fact it may find to exist and render a final decision based on the ACR record and briefs. The Board further suggested that the parties considering stipulating that discovery depositions may be used by either side as trial testimony.

Although the parties did not agree to ACR or any other stipulation during the conference, the parties agreed to confer with Board again after they serve their initial disclosures to further discuss the possibility of ACR. Accordingly, **one week** after the parties have served initial disclosures, the parties are to jointly contact the Board to schedule a time to further discuss the possibility of ACR or alternative stipulations to streamline the submission of evidence at trial.

### **8. Leave to Replead and Amended Case Schedule**

Upon dismissing an insufficiently pleaded ground for opposition the Board may exercise its discretion to allow a party the opportunity to cure a defective pleading, particularly where the defective pleading is the initial pleading, and provided amendment of the pleading would not be futile. *See, e.g., Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1110 (TTAB 2016); TBMP § 503.03. Accordingly, Opposer is allowed until **May 31, 2019**, by which to file and serve an amended notice of opposition, in which it may attempt to re-plead the dismissed Section 2(d) claim based on its alleged common law rights in the stylized LULUS mark, failing which the claim

will be dismissed with prejudice and the case will proceed solely on the Section 2(d) claim based on Opposer's pleaded registrations and Opposer's alleged common law rights to the LULU'S and LULUS word marks. If an amended notice of opposition is filed, Oposer may also amend the notice to reflect the fact that its pleaded application Serial No. 88042747 has matured to registration, and to plead the claim of contractual estoppel, if warranted.

Applicant is allowed until **June 20, 2019**, to file and serve an answer to the amended notice of opposition (if one is filed).

**One week** after the parties have served initial disclosures, the parties are to jointly contact the Board to schedule a time to further discuss ACR stipulations and other means of streamlining the introduction of evidence at trial.

Finally, Applicant is ordered, within **30 DAYS** of the date of this Order, to inform Opposer in writing if it has offices in the United States, and whether any corporate officers, individuals listed in Applicant's initial disclosures, or individuals knowledgeable about the pleaded issues in this case will be travelling in the United States over the next six months and thus would be available for a discovery deposition.

The case schedule and deadlines are reset as follows.

Deadline for Amended Notice of Opposition	5/31/2019
Time to Answer Amended Notice of Opposition	6/20/2019
Discovery Opens	7/20/2019
Initial Disclosures Due	8/19/2019
Expert Disclosures Due	12/17/2019
Discovery Closes	1/16/2020
Plaintiff's Pretrial Disclosures Due	3/1/2020
Plaintiff's 30-day Trial Period Ends	4/15/2020

Defendant's Pretrial Disclosures Due	4/30/2020
Defendant's 30-day Trial Period Ends	6/14/2020
Plaintiff's Rebuttal Disclosures Due	6/29/2020
Plaintiff's 15-day Rebuttal Period Ends	7/29/2020
Plaintiff's Opening Brief Due	9/27/2020
Defendant's Brief Due	10/27/2020
Plaintiff's Reply Brief Due	11/11/2020
Request for Oral Hearing (optional) Due	11/21/2020

The Federal Rules of Evidence generally 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 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).