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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Winter/Hayes

August 13, 2020

Opposition No. 91247656

Tavistock Freebirds, LLC

v.

MobileOffer, Inc.

**Before Taylor, Goodman, and Hudis,
Administrative Trademark Judges.**

By the Board:

Applicant seeks registration of the mark FREEBIRD in standard characters for several types of “interactive computer application software and downloadable software in the nature of mobile applications” with various functions in the field of bar and entertainment services.¹ Opposer opposes registration of Applicant’s mark

¹ Application No. 87121817, filed July 29, 2016, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce in connection with “interactive computer application software and downloadable software in the nature of mobile applications for connecting drinking establishments, namely, bars, cocktail lounges, and wine bars with individuals and groups utilizing mobile phone based automobile transportation service providers; interactive computer application software and downloadable software in the nature of mobile applications for providing information in the field of bar and entertainment services using electronic message alerts featuring leads, optimal matches and suggested discounts, deals, special offers, coupons and reimbursements for users of mobile phone based automobile transportation service providers; interactive computer application software and downloadable software in the nature of mobile applications that enable users to communicate with bar and entertainment service providers to reimburse customers for automobile transportation expenses,” in International Class 9.

based on a claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and in support thereof alleges, inter alia, rights accrued at common law in connection with the mark FREEBIRDS for “downloadable mobile applications for ordering food, earning rewards and finding locations of restaurants; magnetically encoded gift cards services [sic],”² for which it has asserted a pending application for registration.³ ¶¶ 1, 4, 12-17, 1 TTABVUE 2-3, 5-8.⁴

This case now comes up for consideration of Applicant’s motion (filed March 12, 2020, 12 TTABVUE) for partial summary judgment on the issue of priority as it relates to Opposer’s likelihood of confusion claim.

I. Sufficiency of the Pleadings

Consideration of a motion for summary judgment may require a review of relevant portions of the operative pleadings because a party may not obtain summary judgment on an unpleaded or legally insufficient claim or defense. *See* Fed. R. Civ. P. 56(a); *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009).

² We note that Opposer refers to its own alleged goods, as well as Applicant’s identified goods, as “services.” *See, e.g.*, ¶¶ 1, 12 and 18, 1 TTABVUE 3, 6 and 8. Such inexact drafting is one of several issues that render the Notice of Opposition unclear (see *infra*).

³ Application No. 87136427, filed August 12, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), asserting December 12, 2006 as its date of first use anywhere and in commerce for its magnetically encoded gift cards, and May 31, 2016 for its mobile applications. *See* 15 TTABVUE 32-33.

⁴ Citations to the record or briefs in this order also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer.

Accordingly, before considering the merits of Applicant's motion for partial summary judgment, we first examine the sufficiency of the parties' pleadings.

A. Notice of Opposition

We noted initially, *supra*, that Opposer alleges common law rights in the mark FREEBIRDS (hereafter, Opposer's "pleaded common law mark") for "downloadable mobile applications for ordering food, earning rewards and finding locations of restaurants; magnetically encoded gift cards services [sic]," ¶¶ 1, 4, 12-17, 1 TTABVUE 2-3, 5-8. Further, Opposer alleges that "[p]rior to the filing date of the Opposed mark," ¶ 8, *id.* at 5, it adopted and has continually used the pleaded common law mark for its "mobile application services [sic]...since at least as early as May, 2016," ¶ 1, *id.* at 3, and for its "magnetically encoded gift card services[sic] since at least as early as December, 2006," *id.*; *see also* ¶ 8, *id.* at 5; and that registration of Applicant's mark so resembles Opposer's FREEBIRDS marks as to be likely to cause confusion, mistake or to deceive. ¶ 13, *id.* at 7. In view thereof, Opposer has sufficiently pleaded a claim of priority and likelihood of confusion based on its alleged prior use of and common law rights accrued in the mark FREEBIRDS for its mobile applications. *See Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1030 (TTAB 2015); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Nonetheless, it also appears that Opposer seeks to support its likelihood of confusion claim by referencing its ownership of five registered trademarks for FREEBIRDS and FREEBIRDS derivatives for various goods and services, including

the mark FREEBIRDS WORLD BURRITO & design shown immediately below, and two other registrations for the backwards encircled letter “F” design mark shown second below. ¶¶ 2, 8, *id.* at 4-5.



Specifically, Opposer alleges that it (or its predecessors in interest) has “advertised, marketed and sold on a nationwide basis ... beginning in 1991” restaurant and bar services under the FREEBIRDS marks. ¶ 7, *id.* at 5. However, although Opposer’s registered marks are identified in the “The Parties and the Marks” portion of the enumerated grounds of the Notice of Opposition,⁵ they are not referenced in the ESTTA cover sheet as a basis for opposition and are not included in the definition of the “FREEBIRDS Marks” alleged in the enumerated grounds as the basis of Opposer’s Section 2(d) claim.⁶ See ¶ 1, *id.* at 3. Because Opposer has failed to

⁵ We note that Opposer has submitted electronic copies of its pleaded registrations from the USPTO Trademark Status & Document Retrieval (“TSDR”) database. 1 TTABVUE 11-30.

⁶ The ESTTA cover sheet as well as the attached enumerated grounds form the complete notice of opposition. See *Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (“[The ESTTA] form, along with any attached supplementary elaboration of the basis for the opposition, serves as the complaint in the opposition proceeding”) *rev’d on other grounds*, *Koninklijke Philips Elecs. N.V. v. Hunt Control Sys.*, No. 11-3684, 2017 WL 3719468 (D.N.J. August 29, 2017); *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (“Since ESTTA’s inception, the Board

clearly allege its reliance on those registered marks to support its priority and likelihood of confusion claim, it has not provided fair notice of such intent to Applicant. In view thereof, if Opposer intends to rely on any registered mark other than its pleaded common law FREEBIRDS mark in support of its priority and likelihood of confusion claim, Opposer must amend its Notice of Opposition to so state explicitly.

Opposer also alleges that “prior to the filing date of the intent-to-use application for the Opposed Mark, Opposer’s FREEBIRDS Marks had become famous for Opposer’s services,” and that “the use of the Opposed Mark by Applicant is likely to dilute the distinctive quality of Opposer’s famous marks.” ¶¶ 18-19, 1 TTABVUE 8. To the extent Opposer intended to plead a dilution claim under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), Opposer has not pleaded a legally sufficient claim. This claim was not included in the ESTTA cover sheet and is not separately identified in the Notice of Opposition. *See O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) (“claims must be separately stated ... We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground.”).

Notwithstanding the foregoing defects in the Notice of Opposition, it is the Board’s policy to allow amendment of defective pleadings, particularly where the offending pleading is the initial pleading. *See, e.g., Intellimedia Sports Inc. v. Intellimedia*

has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board”).

Corp., 43 USPQ2d 1203, 1208 (TTAB 1997); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 503.03 (2020). At the end of this order, we will allow Opposer time in which to amend its Notice of Opposition to clarify whether it intends to rely on any of the previously-mentioned registered marks in addition to its pleaded FREEBIRDS common law mark in support of its priority and likelihood of confusion claim and, if appropriate, to assert a proper claim of dilution.⁷

B. Answer and Affirmative Defenses

In its Answer, Applicant denies the salient allegations in the Notice of Opposition and asserts eight “Affirmative Defenses.” 6 TTABVUE 2-6. Applicant’s first Affirmative Defense which asserts that the Notice of Opposition fails to state a claim upon which relief may be granted, ¶ 1, 6 TTABVUE 5, is not a true affirmative defense because it relates to the sufficiency of the pleading of Opposer’s Notice of Opposition, and does not set forth a defense to a properly pleaded claim. *See Hornblower & Weeks, Inc.*, 60 USPQ2d at 1738 n.7 (TTAB 2001). Moreover, as discussed supra, Opposer has sufficiently pleaded a claim of likelihood of confusion. Accordingly, the Board sua sponte **strikes** Applicant’s first affirmative defense. *See Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a); see also NSM Resources Corp. v.*

⁷ Opposer is reminded that fame for dilution purposes requires a stringent showing. “To establish the requisite level of fame, the ‘mark’s owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner’s use of the mark.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1725 (Fed. Cir. 2012) (quoting *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001)). “A famous mark is one that has become a ‘household name.” *Coach Services, Inc.*, 101 USPQ2d at 1725.

Microsoft Corp., 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may sua sponte dismiss any insufficiently pleaded claim).

Applicant's second through sixth Affirmative Defenses, ¶¶ 2-6, 6 TTABVUE 5, are not true defenses, rather, they are assertions that go to the merits of Opposer's claims. We therefore construe these "defenses" as amplifications of Applicant's denials of the salient allegations in the Notice of Opposition, which we will allow in this instance because they provide Opposer fuller notice of how Applicant intends to defend the opposition. See *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.11 (TTAB 2015); *Morgan Creek Prods., Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1135-36 (TTAB 2009).

Applicant's seventh Affirmative Defense of unclean hands, ¶ 7, 6 TTABVUE 5, asserts only a bald conclusory allegation that fails to provide Opposer with fair notice of the factual bases for the defense. See *Midwest Plastic Fabricators Inc. v. Underwriters Labs. 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... are either unclear, non-specific, irrelevant to the pleading of unclean hands, or merely conclusory in nature"). In view thereof, Applicant's seventh affirmative defense is **stricken without prejudice**. See Fed. R. Civ. P. 12(f).

Applicant's eighth alternative Affirmative Defense, which seeks to narrow the scope of Applicant's goods so as to avoid a likelihood of confusion, ¶ 8, 6 TTABVUE 5-6, fails to specify the manner in which the goods should be narrowed or how the

restriction will avoid confusion. *See* Trademark Act Section 18, 15 U.S.C. § 1068; *ProQuest Info. and Learning Co. v. Island*, 83 USPQ2d 1351, 1353-54 (TTAB 2007) (applicant failed to state with precision how a restriction of its own application would aid in avoidance of confusion). In view thereof, Applicant's eighth Affirmative Defense is also **stricken without prejudice**. *See* Fed. R. Civ. P. 12(f).

We note also that, in its motion for partial summary judgment, Applicant bases its claim of priority, in part, on "analogous trademark use." *See* 12 TTABVUE 9; note 2, 17 TTABVUE 5. However, Applicant did not plead priority based on analogous use as an affirmative defense. *Cf. Central Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1141-42 (TTAB 2013) (reliance on priority through analogous use must be specifically pleaded); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (applicant's mere denial of opposer's allegation of priority not sufficient to put opposer on notice that applicant will attempt to prove priority through tacking); *Fair Indigo v. Style Conscience*, 85 USPQ2d 1536, 1538-39 (TTAB 2007); *see also Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed Cir. 2002) (to establish proprietary rights, the party must allege and show prior use sufficient to create an association in the minds of the purchasing public between the mark and its goods, that is, "the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark").

Nevertheless, **solely** for purposes of deciding Applicant's motion for partial summary judgment, we deem the Answer to have been amended by agreement of the

parties to assert priority based on analogous use as an Affirmative Defense in view of Opposer having addressed the issue without objecting on the ground that it was not pleaded. *See* TBMP § 528.07(a) (the Board may deem pleadings amended if party defends against summary judgment by asserting genuine disputes of material fact regarding an unpleaded issue, and the moving party treats the matter on its merits and does not object thereto on the ground that it is unpleaded).

At the end of this order, we allow Applicant time in which to amend its Answer, whether or not Opposer files an amended Notice of Opposition, to assert or perfect deficient affirmative defenses, failing which they will not be further considered. *See Musical Directions v. McHugh*, 104 USPQ2d 1157, 1160 (TTAB 2012) (the Board sua sponte reviewed opposer's pleading, determined that certain claims were insufficiently pleaded, and allowed opposer time to file and serve an amended pleading which properly set forth those claims, failing which those claims would be dismissed).

II. Applicant's Motion for Partial Summary Judgment

A. Legal Standard

Turning to Applicant's motion for partial summary judgment, we have considered the parties' briefs and evidence, but address the record on summary judgment only to the extent necessary to set forth our analysis and findings, and do not repeat or address all of the parties' arguments or evidence. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). We presume the parties' familiarity with

the pleadings, and the arguments and evidence submitted in connection with the subject motion.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record must be viewed in the light most favorable to the non-moving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the proceeding. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544; *see also Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) (“If there is a real dispute about a

material fact or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial.”).

On summary judgment, to establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must show that there is no genuine dispute that, vis-à-vis the other party, it owns “a mark or trade name previously used in the United States ... and not abandoned. ...” Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). To do so, a party may rely on its own prior proprietary rights in a mark through ownership of a prior registration, actual use of a trademark, or use analogous to trademark use. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *see also Herbko Int’l*, 64 USPQ2d at 1378; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996), (vacating *Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994)); *Era Corp. v. Electronic Realty Assocs., Inc.*, 211 USPQ 734, 745 (TTAB 1981) (“prior use of a term analogous to trademark or service mark use . . . may be sufficient to preclude a cause of action by a subsequent user notwithstanding that said party may have been the first to have made a technical trademark or service mark usage of its designation”).

B. Analysis and Order

Based on our review of the parties’ arguments and the evidence of record, and drawing all inferences in favor of Opposer, the non-movant, we find that Applicant has not met its burden of establishing the absence of a genuine dispute of material facts and that it is entitled to judgment as a matter of law as to its alleged priority with respect to the mark FREEBIRD. In particular, the declarations and exhibits

submitted by Applicant are insufficient to establish the absence of a genuine factual dispute that the beta testing conducted by Applicant constitutes in this case prior technical trademark use or prior use analogous to trademark use sufficient to create an association in the minds of the purchasing public between the mark and Applicant's goods. *See Nexsan Tech., Inc. v. EMC Corp.*, 260 F. Supp. 3d 68, 76 (D. Mass. 2017) (In order for beta testing to be a sufficient basis for priority, that testing must reach a sizable proportion of the relevant public, and the testing cohort must constitute more than a small, hand-picked group.); *see also Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017) ("Depending on the particular facts and industry practice, some types of promotional activities, such as distributing samples, may qualify as use in commerce."). Evaluation of analogous prior use through beta testing is dependent on the nature and extent of the specific beta test, as well as other supporting factors, *see CCBN.com, Inc. v. C-call.com, Inc.*, 73 F. Supp. 2d 106, 111 (D. Mass. 1999), and such a fact-based analysis is inappropriate for summary judgment.⁸ *Cf. Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991) (factual questions involving intent and good faith are particularly unsuited to disposition on summary judgment).

⁸ *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1301.03(a) ("[A] beta version of non-downloadable or downloadable software may be made available to the public for use even though the final version has not been released. Thus, the appearance of this term on a service-mark specimen does not, by itself, necessarily mean that the relevant services are not in actual use in commerce or that the specimen is unacceptable.") (October 2018).

Additionally, the uncorroborated declarations of Applicant's witnesses and exhibits attached thereto,⁹ do not demonstrate, beyond dispute, that Applicant's mobile application was approved for download by Apple and publicly available for download from Apple's iTunes store on November 20, 2015.¹⁰ Therefore, at a minimum, there exists a genuine dispute as to material facts concerning: (1) whether Applicant's beta testing of its FREEBIRD application offered on November 3, 2015, and again on November 13, 2015, was sufficient to constitute technical trademark use or use analogous to trademark use sufficient to confer priority; (2) when Applicant's FREEBIRD mobile application was made available to the public for download on Apple's iTunes store; and (3) when the application was first downloaded from Apple's iTunes store by a consumer.¹¹

In view of the foregoing, we find that Applicant has not established the absence of a genuine dispute as to material facts, and that it is entitled to judgment as a matter

⁹ Although Applicant's declarants refer to the exhibits attached to their respective declarations, the exhibits are not individually designated, making it difficult for the Board to consider them. The better practice is to assign an exhibit number to each document referred to in a declaration.

¹⁰ Exhibit 6 to the declaration of Anthony J. Wentzel (the "Wentzel Declaration," 12 TTABVUE 13) only lists the dates on which various versions of the application were uploaded to the "App Store Connect portal," and when the application versions ("iOS Builds") were updated. *See* Wentzel dec. ¶¶ 11, 15, 12 TTABVUE 16-17 and 12 TTABVUE 33-81. Moreover, Exhibits 3, 5, 8, and 9 to the Wenzel Declaration are not self-authenticating, *see* 12 TTABVUE 23, 28-32, 85-86, and have not been authenticated through the Wentzel Declaration, *see* ¶¶ 8, 10, 16, 18, *id.* at 15, 17-18, because it does not provide the actual source of the screen shots or dates they were obtained. *See* TBMP § 528.05(e) (materials that are not self-authenticating may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.). Inasmuch as Opposer did not object to the exhibits, the Board considered them for what probative value they may have.

¹¹ The fact that we identify certain material facts that are genuinely in dispute should not be construed as a finding that these are the only issues that remain for trial.

of law on the issue of its priority as to the mark FREEBIRD in connection with its identified goods. Accordingly, Applicant's motion for partial summary judgment is **DENIED**.¹²

Additionally, in view of the fact-intensive nature of Opposer's claims and the limited time left remaining for discovery prior to Applicant filing its motion for partial summary judgment, the Board will not consider any further motions for summary judgment filed by either party.

III. Accelerated Case Resolution

This case appears to be suitable for resolution via the Board's Accelerated Case Resolution ("ACR") procedure. Opposer's sole claim for relief is under Section 2(d) of the Trademark Act. In every Section 2(d) case, two key considerations under the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), are the similarity of the marks and the similarity of the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). It appears that those matters and others germane to the prosecution and defense of Opposer's claim may be addressed effectively using the streamlined ACR procedures.

The parties may wish to consider supplementing their respective submissions related to Applicant's motion for partial summary judgment and providing the Board

¹² The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, absent a stipulation between the parties approved by the Board, any such evidence must be properly introduced during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); TBMP § 528.05(a).

with a stipulation allowing the Board to decide disputed issues of fact in a final decision on the merits based on such record. Pursuing resolution by ACR will require the parties to stipulate, at a minimum: (1) that the Board will treat Applicant's motion for summary judgment and evidence, Opposer's response and evidence, Applicant's reply brief, and supplementation thereto filed by the parties within an agreed-upon period, as the final record and briefs herein; (2) to forego trial; (3) that the Board may resolve genuine disputes of material fact on the basis of the final record; and (4) that the Board may issue a final ruling based on the parties' stipulation, evidence and briefs in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence. Information concerning the use of ACR in Board proceedings is available online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The parties are urged to contact the Interlocutory Attorney assigned to the case to discuss the possible use of ACR in lieu of trial.

IV. Summary; Proceeding Resumed; Trial Dates Reset

Applicant's First Affirmative Defense is **STRICKEN**, Applicant's Seventh and Eighth Affirmative Defenses are **STRICKEN WITHOUT PREJUDICE**, and Applicant's motion for partial summary judgment is **DENIED**. As set forth above, the Board will not consider any further motions for summary judgment filed by either party.

To the extent that Opposer intends to rely on any registered marks in support of its priority and likelihood of confusion claim and/or pursue a claim of dilution,

Opposer is allowed until **FIFTEEN DAYS** from the date of this order to file and serve an amended Notice of Opposition, failing which this proceeding will go forward **solely** on Opposer's claim of priority and likelihood of confusion based on its alleged prior use of its pleaded common law mark. *See* TBMP § 503.03.

Applicant is allowed until **THIRTY-FIVE DAYS** from the date of this order to file an Answer to any amended Notice of Opposition or an Amended Answer (if an amended pleading is not filed by Opposer), as discussed herein. Applicant is reminded that if it intends to rely on use analogous to technical trademark use in support of its claim of priority, it must be expressly plead as an affirmative defense.

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Time to File Amended Notice of Opposition	8/28/2020
Time to Answer or File Amended Answer	9/17/2020
Expert Disclosures Due	3/16/2021
Discovery Closes	4/15/2021
Plaintiff's Pretrial Disclosures Due	5/30/2021
Plaintiff's 30-day Trial Period Ends	7/14/2021
Defendant's Pretrial Disclosures Due	7/29/2021
Defendant's 30-day Trial Period Ends	9/12/2021
Plaintiff's Rebuttal Disclosures Due	9/27/2021

Plaintiff's 15-day Rebuttal Period Ends	10/27/2021
Plaintiff's Opening Brief Due	12/26/2021
Defendant's Brief Due	1/25/2022
Plaintiff's Reply Brief Due	2/9/2022
Request for Oral Hearing (optional) Due	2/19/2022

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, 37 C.F.R. §§ 2.121-2.125. 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), 37 C.F.R. §§ 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), 37 C.F.R. § 2.129(a).

