

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
General Email: TTABInfo@uspto.gov

EJW

September 20, 2019

Opposition No. 91249091

Intuitive Surgical Operations, Inc.

v.

*Board of Supervisors of Louisiana State
University and Agricultural and Mechanical
College University and Agricultural and
Mechanical College*

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On September 19, 2019, Opposer (represented by Michelle Kahn of Sheppard Mullin), Applicant (represented by Andrew Maas and Robert Brown), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a), 37 C.F.R. § 2.120(a). This order sets forth a summary of the significant points addressed during the conference.

CONFERENCE SUMMARY

Initially, the Board inquired as to whether there are any related proceedings and whether the parties had engaged in any settlement discussions. The parties informed the Board that there is no related federal district court or Board case, and that the parties had not yet conducted any settlement discussions. However, at the end of the

conference, Opposer advised Applicant of its position regarding Applicant's mark and its identification of services as set forth in the subject application, and informed Applicant that Opposer would be amenable to an amendment to the identification of services, specifically, certain exclusionary wording. The parties agreed to suspend the proceeding for a period of thirty days from the date of the conference to further discuss settlement.

The parties are required to promptly advise the Board should a civil action between the parties or other Board proceeding be instituted so that the Board can determine whether suspension or consolidation is appropriate.

PLEADINGS

The Board advised the parties that Opposer has set forth sufficient claims of likelihood of confusion, dilution, false suggestion of a connection, and misrepresentation of source.¹ The Board advised Opposer that priority remains at issue because it did not attach proof of title and status of its pleaded registrations to the notice of opposition. *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

¹ Although the ESTTA cover sheet refers to the claim of deceptiveness under Section 2(a) of the Trademark Act, there are no allegations in the pleading setting forth such a claim. *See In re Budge Manufacturing Co., Inc.*, 837 F.2d 77, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *see also In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1493, 1495 (Fed. Cir. 2009); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1312 (TTAB 1990); *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984). Mere reference to a claim on the ESTTA cover form is insufficient to constitute a pleading of that claim. *See Embarcadero Technologies, Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013); *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005). In view thereof, said claim is **stricken**. *See* Fed. R. Civ. P. 12(f).

With respect to the answer, Applicant denies the salient allegations in the notice of opposition. One of the affirmative defenses was **stricken** under Fed. R. Civ. P. 12(f), Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), namely, the first affirmative defense (failure to state a claim) because Opposer's claims are sufficiently pleaded; and Applicant's reservation of the right to add affirmative defenses at a later date was also **stricken**. Applicant's "reserv[ation of] the right to plead additional affirmative defenses and other defenses should any such defenses be revealed by discovery" is improper under the Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) (reservation of right to add affirmative defenses at a later date is improper under the Federal Rules). Specifically, Applicant cannot reserve unidentified defenses or counterclaims in its answer since it does not provide Opposer fair notice of such defenses. Whether Applicant may, at some future point, amend its answer to include affirmative defenses and/or counterclaims would be resolved by way of a motion for leave to amend under Fed. R. Civ. P. 15(a).

The Board also reminded Applicant that the list of alleged trademark registrations for the mark DA VINCI (or formatives) in its answer does not make said registrations of record, *see* Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d); nor does that list show that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *AMF Inc. v. Am.*

Leisure Products, Inc., 474 F.2d 1407, 177 USPQ 268 (CCPA 1973); *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

STIPULATIONS

Various stipulations may be agreed to by the parties, either during the course of the conference or during the pendency of the proceeding. By way of example, the parties may agree or stipulate **in writing** to the following measures to facilitate the progress of this proceeding:²

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;
- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- That documents are deemed authenticated; and/or
- That a notice of reliance can be filed after the testimony periods are closed.
- That electronic evidence will be exchanged in a certain manner.

See TBMP §§ 403.01, 501, 704.03(b) and 705.

² Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. See Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §§ 403.01 and 501.02 (June 2019).

DURING THE CONFERENCE, THE PARTIES AGREED TO THE FOLLOWING:

- **The parties will notify each other by email that the receiving party has received emailed documents from the other party (or a link to documents) and that the documents are accessible.**

STANDARD PROTECTIVE ORDER

The Board also reminded the parties that the Board's standard protective agreement applies to this proceeding and may be modified by the parties in writing. Should the parties modify the standard agreement, the Board requested that the parties identify which clause or provision has been modified.

INITIAL DISCLOSURES

The next deadline in this proceeding after resumption of the proceeding is for serving initial disclosures. Initial disclosures should not be filed with the Board; they are served on the adverse party.

Until the party seeking to serve discovery or to file a motion for summary judgment has served its initial disclosures, discovery may not be served, nor may a summary judgment motion be filed.

Should the parties seek additional information on initial disclosures, it may obtain additional information regarding initial disclosures at the following sources:

http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf and to <http://edocket.access.gpo.gov/2006/pdf/06-197.pdf>, or to

http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf. See Notice of Final Rulemaking (“Miscellaneous Changes to Trademark Trial and Appeal Board Rules”) in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006) (pages 2498 and 2501).

EVIDENCE

The parties were reminded that each party has a duty to preserve material evidence and to avoid spoliation or destruction of evidence.³

ACCELERATED CASE RESOLUTION (ACR)

The Board recommended that the parties consider using the Board’s Accelerated Case Resolution procedure. The parties are requested to advise the Board in writing within **SIXTY (60) DAYS** from the mailing date of this order whether the parties are interested in resolving this matter by using ACR.⁴ Should the parties need assistance to develop the appropriate stipulation, please contact the Interlocutory Attorney⁵ who can assist the parties in doing so.

³ “While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request.” *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D. Pa. 2007) (addressing law firm’s failure to preserve temporary electronic files); see also *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) (“ESI must be produced in Board proceedings where appropriate, notwithstanding the Board’s limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings”) (internal citations omitted).

⁴ If the parties do not decide to use ACR early in the proceeding, it can be adopted later.

⁵ The parties should contact the assigned Interlocutory Attorney, Elizabeth Winter, at elizabeth.winter@uspto.gov or 571-272-9240.

If the parties are interested in the summary judgment model of ACR, they would need to submit to the Board a stipulation on the following issues:

- that cross-motions for summary judgment and accompanying evidentiary submissions would substitute for a trial record and traditional briefs at final hearing;
- that the parties would forego trial; and
- that the Board may make determinations of genuine disputes of material fact on the basis of the final record and may issue a final ruling based thereon in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence.

The parties are advised that other approaches have been adopted by parties that realize the efficiencies sought through the ACR process and should, therefore, be considered as falling under the ACR umbrella. *See, e.g., Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007), in which the parties stipulated to 13 paragraphs of facts, including Applicant's dates of first use, channels of trade for Applicant, extent and manner of Applicant's use, recognition by others of Applicant's use, as well as the dates, nature and extent of descriptive use by the Opposer's parent; and the parties stipulated to the admissibility of business records, government documents, marketing materials and internet printouts.⁶ Information concerning use of ACR in Board proceedings is available online at the following URL:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

⁶ By way of example only, the parties may view ACR related stipulations and orders in the following cases on Ms. Winter's docket: Opposition No. 91222612 (see no. 14); Opposition No. 91227798 (see no. 8); 91219403 (see no. 34); 91214266 (see nos. 5, 7 and 13); 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history). The parties are directed also to review *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (Opposition No. 91214266, nos. 5 and 21).

Additionally, the parties may find the following cases helpful in crafting their ACR stipulation, if any:

1. [92068515](#): The parties agreed to the summary judgment model of ACR.
2. [92068150](#): The parties agreed to an informal discovery exchange and the summary judgment model of ACR, and stipulated to what the issues in dispute were. The petition to cancel was subsequently withdrawn.
3. [92068042](#): The parties agreed to make initial disclosures, forgo discovery, and use the summary judgment model of ACR.
4. [92068841](#): The parties agreed to waive initial disclosures, move up the discovery deadline, limit discovery, and use the summary judgment model of ACR.
5. [92068970](#): The parties agreed to a schedule for discovery and to use the summary judgment model of ACR.
6. [92069524](#): The parties agreed that they would produce documents with their initial disclosures, limit discovery, forgo expert testimony, and use the summary judgment model of ACR. The petition to cancel was subsequently withdrawn.
7. [92069629](#): The parties stipulated to the petitioner's standing and agreed to informally exchange documents, limit discovery, and use the summary judgment model of ACR.
8. [92069904](#) & [92069906](#): The parties stipulated to the petitioner's standing and agreed to limit discovery and use the summary judgment model of ACR.

PROCEEDING SUSPENDED; TRIAL DATES RESET:

In accordance with the parties' agreement, this proceeding is **SUSPENDED** for purposes of settlement for a period of **THIRTY (30) DAYS** from the date of the discovery conference and shall resume on **October 20, 2019**, subject to the right of either party to request resumption at any time. *See The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings suspended subject to the right of either party to request resumption); TBMP § 510.03(b).

Trial dates, including the commencement of the discovery period, are reset as shown in the following schedule:

| | |
|------------------------------------------------|-------------------|
| Proceeding Resumes | 10/20/2019 |
| Discovery Opens | 10/20/2019 |
| Initial Disclosures Due | 11/15/2019 |
| Expert Disclosures Due | 3/18/2020 |
| Discovery Closes | 4/17/2020 |
| Plaintiff's Pretrial Disclosures Due | 6/1/2020 |
| Plaintiff's 30-day Trial Period Ends | 7/16/2020 |
| Defendant's Pretrial Disclosures Due | 7/31/2020 |
| Defendant's 30-day Trial Period Ends | 9/14/2020 |
| Plaintiff's Rebuttal Disclosures Due | 9/29/2020 |
| Plaintiff's 15-day Rebuttal Period Ends | 10/29/2020 |
| Plaintiff's Opening Brief Due | 12/28/2020 |
| Defendant's Brief Due | 1/27/2021 |
| Plaintiff's Reply Brief Due | 2/11/2021 |
| Request for Oral Hearing (optional) Due | 2/21/2021 |

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),

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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).

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