

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

October 14, 2021

Opposition No. 91267248

Dani Fox, Associates, LLC

v.

Doctors Daughters LLC

Katie Bukrinsky, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a discovery conference on October 14, 2021. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 401.01 (2020).¹ At Opposer’s request, a member of the Board participated in the conference. *See* Trademark Rule 2.120(a)(2)(i). Participating were Christopher DiSchino, Brenda Schamy, and Michael Seiger, counsel for Opposer; David Sunshine, counsel for Applicant; and Interlocutory Attorney Katie Bukrinsky.

This order memorializes what transpired during the conference. Conferences with the Board may not be recorded.

¹ The TBMP is available electronically at the following link: <https://tbmp.uspto.gov/RDMS/TBMP/current#/current>

I. Settlement

During the discovery conference, the parties advised that they had exchanged settlement proposals but that those proposals had not resulted in settlement. The parties both expressed willingness to continue discussing settlement.

The Board encouraged the parties to discuss settlement and advised that the Board does entertain, and is liberal in granting, motions to suspend proceedings for settlement discussions. The parties were cautioned, however, that the parties must be actively engaged in settlement discussions to obtain a suspension and that requests to suspend or extend may be denied where there has been protracted suspension or extension without substantial progress towards settlement. *See* TBMP § 605.02. Further, proceedings may only be suspended for settlement with the consent of both parties and either party may request resumption of the proceedings at any time. *Id.*

II. Board's Jurisdiction

The Board is an administrative tribunal that is empowered solely to determine the right to register, and has no authority to determine the right to use a mark or any infringement or unfair competition issues. *See* TBMP § 102.01. The Board also does not possess injunctive powers to prohibit a party from using its mark, and cannot award monetary damages or attorneys' fees. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011).

III. Related Proceedings

Opposer informed the Board that Applicant had filed an application for the mark DOCS DAUGHTERS, Serial No. 90534227, which Opposer intends to oppose. Opposer indicated that it considers the potential opposition related to the current proceeding.

As set forth in the Board's institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding or a civil action involving the same or related marks or issues of law or fact that overlap with this proceeding. Accordingly, Opposer should notify the Board in writing if it files an opposition against application Serial No. 90534227, so that the Board can consolidate and/or suspend related Board proceedings, if appropriate. *See* Trademark Rule 2.117(c); TBMP §§ 510 and 511.

IV. Electronic Filing and Service of Papers

The Board advised the parties that each paper filed with the Board must be served on the opposing party electronically and that all filings with the Board must be made via ESTTA, the Board's online electronic filing system. If email service is not possible because of technical problems or extraordinary circumstances and there is no stipulation, the serving party must show by written explanation accompanying the submission or paper that email service was attempted but could not be made. In addition, the failure to file motions and papers via ESTTA requires a showing of technical difficulty or an explanation of extraordinary circumstances.

V. Pleadings

In its prior order, the Board had stricken Opposer's dilution and false suggestion of a connection claims, as well as Applicant's affirmative defenses and counterclaim. *See* 10 TTABVUE 13. Inasmuch as neither party filed an amended pleading, this proceeding will go forward on Opposer's likelihood of confusion claim only.

VI. ACR

The Board next advised the parties of the option to utilize the Accelerated Case Resolution ("ACR") process. While the parties did not stipulate to pursue ACR at this time, the parties may reserve the right to pursue ACR at a future date, if appropriate.²

VII. The Board's Standard Protective Order

The Board advised the parties of the automatic imposition of the Board's two-tiered standard protective order pursuant to Trademark Rule 2.116(g), and further indicated that the parties would control which tier of confidentiality applies. Because the Board's standard protective order is automatically imposed on this proceeding, the parties are precluded from objecting to any discovery on the ground of confidentiality.

Under the Board's standard protective order, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. According to the terms of the Board's protective order, within thirty days

² Additional information regarding ACR may be found on the Board's website at: <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/ttab-acr-options>

following termination of a proceeding, the parties must return to each disclosing party the protected information disclosed during the proceeding, including any briefs, memoranda, summaries, and the like, that discuss or in any way refer to such information. Alternatively, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

It is unclear, however, whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42251 (August 1, 2007). Thus, it may be advisable for the parties to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract that will survive the proceeding; and that there may be a remedy at court for any breach of that contract that occurs after the conclusion of the Board proceeding.³ 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.

VIII. Discovery and Motion Practice

The Board apprised the parties of the general procedural rules and guidelines that govern inter partes proceedings, including the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests. *See* Trademark Rule 2.120(a)(3). The Board further noted the

³ While it may be advisable for the parties to sign a stipulated protective order, it is not necessary for the Board's protective order to take effect.

parties may not take discovery or file a motion for summary judgment until they had made their initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1).

The Board explained that discoverable material includes electronically stored information and advised the parties to identify any potential problems with the production of electronically stored information in advance. The parties are encouraged to consult TBMP § 414 when preparing and responding to discovery requests and to consult Chapter 400 for other questions concerning discovery.

The Board then advised the parties that if any party plans to file a motion to compel discovery, the moving party must demonstrate a good faith effort has been made to resolve the discovery dispute before filing its motion.⁴ The Board also advised the parties that a motion to compel must be filed prior to the day of the deadline for pretrial disclosures for the first testimony period. The parties are advised to consult Chapter 500 of the TBMP for more information on motions practice before the Board.

The parties are further advised of the following matters concerning discovery: (1) all discovery requests must be served early enough in the discovery period so that responses will be due no later than the close of discovery;⁵ (2) interrogatories, requests for production of documents and things and requests for admission are limited to seventy-five, including subparts.⁶

⁴ The Board expects the parties to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. *See* TBMP § 408.01.

⁵ Trademark Rule 2.120(a)(3).

⁶ Trademark Rules 2.120(d), (e) and (i).

IX. Initial Disclosures

Initial disclosures are governed under Fed. R. Civ. P. 26(a) and should include the following information:

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 [and] 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.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties **should not** file their respective initial disclosures with the Board.

X. Expert Witness Disclosures

To the extent either party retains an expert witness, such party must make their expert witness disclosure by the set deadline, as well as provide the Board with notification that the party will be employing an expert. Depending upon when such notification is made with the Board, the Board, in its discretion, may suspend proceedings for the sole purpose of allowing the parties to take discovery of a designated expert witness.

XI. Pretrial Disclosures

Pretrial disclosures are governed by 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 provided by Fed. R. Civ. P. 26(a)(3)(A)(iii).

Disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.

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 that 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 issuance of a proper notice of examination under Trademark Rules 2.123(c) and 2.124(b). Further, if a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure.

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

XII. Testimony

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 written transcripts thereof, together with any exhibits thereto, are then filed with the Board. The parties may elect to submit testimony via affidavit or declaration,

subject to a right by the other side to cross-examine the witness. Trademark Rule 2.123.

XIII. Trial

The Board advised the parties to consult Chapter 700 of the TBMP for information on trial procedure and the proper introduction of evidence. 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. *See* Trademark Rules 2.122 and 2.123. The parties were advised that they may utilize stipulations of fact and evidence to realize cost and procedural efficiencies. Finally, an oral hearing is set only upon request as provided by Trademark Rule. 2.129.

XIV. Stipulations

The parties reached the following stipulations during the conference:

1. The parties adopt the Board's standard protective order with no modifications.
2. With the exception of physical samples or other items that cannot be sent electronically, the parties will produce all discovery electronically by email or secure upload.

XV. Schedule

Discovery is open as of the date of the conference. The remaining deadlines remain as previously set, and are reiterated below for convenience of the parties.

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| Initial Disclosures Due | 11/14/2021 |
| Expert Disclosures Due | 3/14/2022 |
| Discovery Closes | 4/13/2022 |
| Plaintiff's Pretrial Disclosures Due | 5/28/2022 |
| Plaintiff's 30-day Trial Period Ends | 7/12/2022 |

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| Defendant's Pretrial Disclosures Due | 7/27/2022 |
| Defendant's 30-day Trial Period Ends | 9/10/2022 |
| Plaintiff's Rebuttal Disclosures Due | 9/25/2022 |
| Plaintiff's 15-day Rebuttal Period Ends | 10/25/2022 |
| Plaintiff's Opening Brief Due | 12/24/2022 |
| Defendant's Brief Due | 1/23/2023 |
| Plaintiff's Reply Brief Due | 2/7/2023 |
| Request for Oral Hearing (optional) Due | 2/17/2023 |

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).