

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

January 4, 2022

Opposition No. 91271869

Kabushiki Kaisha Zoom

v.

Zoom Video Communications, Inc.

J. Krisp, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a timely discovery and settlement conference on January 3, 2022. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 401.01 (June 2021). At Applicant’s request, a member of the Board participated in the conference pursuant to Trademark Rule 2.120(a)(2)(i). Participating were Applicant’s counsel Joyce Liou, Opposer’s counsel R. Glenn Schroeder, and the assigned interlocutory attorney.

The Board apprised the parties of general procedural rules and guidelines that govern inter partes proceedings, including the Board’s liberal granting of motions to suspend for settlement efforts, 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 (Trademark Rule 2.120(a)(3)), and the importance of reducing all stipulations to writing.

The parties noted that they are also currently involved in litigation regarding the marks at issue in other jurisdictions, such as the European Union and Japan.

The Board's Standard Protective Order 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. Although they are not required to do so, the Board advises, and here the parties plan, to exchange executed copies of the order.

As noted, if the parties wish to modify the standard order in any manner, they must file a motion for the Board's approval of the modification(s). The parties have no modified protective order at this time, but anticipate filing a motion which sets forth a modified protective order with certain amendments once discovery is underway.

Turning to the pleadings, the Board noted that in the notice of opposition Opposer sufficiently alleges its entitlement to bring a statutory cause of action, as well as the elements of a claim of priority and likelihood of confusion pursuant to Trademark Act Section 2(d). Opposer pleads ownership of Registration No. 3555352, registered on December 30, 2008, for goods in International Classes 9 and 15. 1 TTABVUE.

In its answer, Applicant denied the salient allegations in the notice of opposition. Applicant also set forth a sufficiently alleged counterclaim based on Trademark Act Section 18 for the entry of a restriction of certain International Class 9 goods

identified in Opposer's pleaded registration, and alleged that the proposed restriction would avoid a likelihood of confusion. 5 TTABVUE 6.

In its answer, Opposer denied the salient allegations in the counterclaim. 7 TTABVUE.

The parties will utilize traditional discovery devices and plan to exchange discovery and documents electronically by a means or service amenable to the parties. Depositions by oral examination through VTC are encouraged. The Board advised the parties to inform the Board in the event that any deposition is noticed to be taken upon written questions pursuant to Trademark Rule 2.124, such that the Board may promptly issue a suspension order as appropriate. TBMP § 404.07 et seq. The parties are encouraged to plan discovery in advance so as to enable them to adhere to the limits on the number of allowable written discovery requests under Trademark Rules 2.120(d), (e) and/or (i); if either party desires leave to serve discovery requests in excess of the seventy-five allowed, the request must be made by motion. TBMP § 519 et seq.

The Board advised the parties to consult TBMP Chapter 400 generally, as well as TBMP § 414, for any needed guidance in drafting, or objecting or responding to discovery requests.

The Board briefly explained the availability and features of the "accelerated case resolution" ("ACR") process. The ACR option is an alternative to a typical inter partes Board trial where under parties can obtain a determination of their claims and defenses using simplified methods of introducing evidence and in a shorter time

period than contemplated by the standard schedule under the Trademark Rules. The form of ACR can vary, though the typical process approximates a motion (or cross-motions) for summary judgment method with accompanying evidentiary submissions that the parties stipulate will constitute the record in lieu of creating a traditional trial record and traditional briefs at final hearing. The parties' stipulations must include the stipulation that the Board may resolve any genuine disputes of material fact raised by the parties' filings and the record. *See, e.g., TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411-12 (TTAB 2018); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1776 (TTAB 2013); TBMP § 702.04(b).

The standards of proof in an ACR proceeding are the same as the standards of proof in a traditional Board proceeding – the burden of proof remains with the plaintiff to prove its case by a preponderance of the evidence. TBMP §§ 528.05(a)(2) and 702.04(a). A final decision rendered under ACR may be appealed in the same manner and under the same time frames as non-ACR decisions by the Board. *Id.*

For further information, the Board refers the parties to TBMP §§ 528.05(a)(2), 702.04 and 705, as well as the link on the Board's web page to a vast amount of ACR information and exemplary ACR proceedings.

Inasmuch as the central issue in both the main opposition and the counterclaim is likelihood of confusion, the Board encourages the parties to give serious consideration to the ACR option once the parties have exchanged the first round of discovery responses, if the opposition and counterclaim cannot be settled.

As noted in the conference, if the parties do not stipulate to ACR, the Board still allows the parties to stipulate to a variety of deviations from the Rules of Procedure in order to streamline discovery, testimony, and development of the written record.

Finally, it is the responsibility of each party to ensure that the Board has its current correspondence address, including an email address. TBMP § 117.07. The Board must be promptly notified of any address or email address changes for the parties or their attorneys.

The schedule setting forth the initial disclosure, discovery and trial dates remains as set in the November 4, 2021 order. 6 TTABVUE 2.