

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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February 16, 2022

Opposition No. **91273482**

Anastasia Beverly Hills, LLC

v.

Rubi Arreola

Yong Oh (Richard) Kim, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on February 15, 2022. Board participation was requested by Opposer. Joel R. Feldman, Esq., and Kristen E. Van Dyke, Esq., of Greenberg Traurig, LLP appeared on behalf of Opposer and Dileep P. Rao, Esq., of Rao DeBoer Osterrieder, PLLC appeared on behalf of Applicant.

Introductory Remarks

The Board informed the parties that a spirit of cooperation and good faith dealing were expected from the parties during the duration of this proceeding and that any points of contention that may arise should be handled through direct communication between the parties and in a spirit of good faith. The parties were put on notice that a motion to compel would not be entertained and good faith would

not be found where the parties have failed to previously conduct at least one telephone conference to resolve each discovery issue raised in the motion to compel.

Telephone conferences with a Board attorney are available as necessary but both parties must be on the call to discuss any substantive matter; *ex parte* communications with the Board are generally inappropriate. Questions relating to the filing or status of a paper should initially be directed to the Board paralegal assigned to the proceeding. This information can be found in TTABVUE.

Like all papers in Board proceedings, appearances of counsel and change of correspondence forms, as necessary, must be filed via ESTTA, the Board's electronic filing system. *See* Trademark Rule 2.126, 37 C.F.R. § 2.126.

Prior Communications and Disputes

The Board inquired as to whether the mark in the involved application was the subject of any other disputes with Opposer or with a third-party. Applicant confirmed that it was not.

The Board also inquired as to whether the parties have previously engaged in settlement discussions. The parties noted that they have not and after a brief discussion, it was apparent that the parties, while open to the idea of settlement, were currently unwilling to negotiate their respective settlement demands to warrant suspending this matter to facilitate any settlement discussions. The parties were, nevertheless, encouraged to remain open to engaging in settlement discussions throughout the proceeding. Of course, should the parties engage in such discussions, the parties should agree to a suspension of this matter for a stated

period of time that they deem reasonably necessary to negotiate and finalize an agreement and file a stipulation for suspension for Board approval.

Pleadings

In the Board's review of the pleadings, Opposer confirmed that it is only asserting a claim of priority and likelihood of confusion based on its pleaded registration. As for Applicant's answer, Applicant requested leave to amend its answer to add a *Morehouse* defense. *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969). The Board granted Applicant leave to do so and set **FEBRUARY 23, 2022**, as the deadline to file the amended answer. No other issues regarding the pleadings were raised by the parties.

Discovery and Stipulations

The parties were advised that the Board's standard protective order is operative in this proceeding, *see* Trademark Rule 2.116(g), and available to review at https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order_02052020.pdf. Should the parties wish to modify the Board's standard protective order, the parties may negotiate any changes and file a copy of the proposed protective order with the Board for approval.

If the parties wish to acknowledge their obligations under the standard protective order in writing, the parties are referred to the form found at <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines>.

The Board inquired as to whether the parties had considered or would otherwise like to propose any discovery or testimonial stipulations. The parties had not discussed any such stipulations prior to the discovery conference and declined to do so at this stage of the proceeding. The Board, nevertheless, encouraged the parties to consider ways in which to potentially limit and simplify discovery and testimony through reciprocal disclosures, stipulations of fact, and/or agreements. For instance, the parties may consider greater use of reciprocal disclosures and less use of formal discovery or streamlining their discovery by limiting the number of depositions, interrogatories, document production requests and admission requests. The parties may also consider simplifying the introduction of evidence into the record such as by stipulating to the authentication of documents produced in response to document requests via a notice of reliance by the propounding party.

Alternative Dispute Resolution and Accelerated Case Resolution

The Board informed the parties that mediation and arbitration are outside resources available to the parties to facilitate settlement discussions. Although the Board will not refer the parties to any particular arbitrator or mediator, the Board would be amenable to suspending this proceeding should the parties choose these alternatives to aid in settlement.

Accelerated Case Resolution (ACR) was also discussed as a way to expeditiously obtain a final determination of this proceeding without the time and expense of a full trial. A proceeding that is ideally suited for ACR is one in which the parties anticipate being able to stipulate to many facts, or in which each party expects to

rely on the testimony of only one or two witnesses and the overall record will not be extensive.

The parties are encouraged to consider utilizing the procedure if the parties wish to accelerate the disposition of this matter and believe it can be streamlined through the use of factual, procedural and evidentiary stipulations. As noted during the conference, the parties must mutually agree to ACR as the procedure cannot be instituted unilaterally and there is no procedural mechanism by which an unwilling party can be compelled to engage in ACR.

To facilitate the parties' considerations, they are referred to the following for additional information on the procedure:

<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 \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution (ACR) FAQ updates 12 22 11.doc)

Conclusion

Finally, neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata*, collateral estoppel, or lack of Board jurisdiction) may occur until after initial disclosures (required under Fed. R. Civ. P. 26(a)(1)) are made.

The current schedule is modified to include the deadline for Applicant's amended answer but remains otherwise unchanged:

Amended Answer Due	2/23/2022
Discovery Opens	2/23/2022
Initial Disclosures Due	3/25/2022
Expert Disclosures Due	7/23/2022

Discovery Closes	8/22/2022
Plaintiff's Pretrial Disclosures Due	10/6/2022
Plaintiff's 30-day Trial Period Ends	11/20/2022
Defendant's Pretrial Disclosures Due	12/5/2022
Defendant's 30-day Trial Period Ends	1/19/2023
Plaintiff's Rebuttal Disclosures Due	2/3/2023
Plaintiff's 15-day Rebuttal Period Ends	3/5/2023
Plaintiff's Opening Brief Due	5/4/2023
Defendant's Brief Due	6/3/2023
Plaintiff's Reply Brief Due	6/18/2023
Request for Oral Hearing (optional) Due	6/28/2023

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. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, 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).

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