

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

May 16, 2022

Opposition No. 91274662

Agilent Technologies, Inc.

v.

mAgilEnt LLC

Mary Beth Myles, 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 May 13, 2022. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 401.01 (2021).¹ At Opposer’s request, a member of the Board participated in the conference. *See* Trademark Rule 2.120(2)(i). Participating were John Fandl, Founder of Applicant, appearing pro se, Alexander Garcia and Julie Kent, counsel for Opposer, and Mary Beth Myles, Interlocutory Attorney for the Board.

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. Pro Se Party

Mr. Fandl advised the Board that Applicant intends to appear pro se. Applicant was advised that it has the option to retain counsel at any time. Applicant was also advised that, due to the nature of the proceedings, legal counsel was strongly advised. The parties were notified that the Board is unable to provide legal advice to either party and can only provide guidance regarding procedural issues. Applicant will be required to familiarize itself with all Board procedures, rules, and regulations governing the case, including but not limited to the Trademark Rules of Practice and the Federal Rules of Civil Procedure, where appropriate.

II. Settlement

During the discovery conference, the parties stated that there had been no substantive settlement discussions and no agreements have been reached. 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 may be denied where there has been protracted suspension without substantial progress towards settlement. *See* TBMP § 605.02. The parties were further advised that proceedings may only be suspended for settlement with the consent of both parties and that either party may request resumption of the proceedings at any time. *Id.*

III. 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).

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

The Board also reviewed the pleadings and finds that Opposer has sufficiently pleaded its entitlement to a statutory cause of action. The Board finds, however, that Opposer's claim of likelihood of confusion is, in part, insufficiently pleaded and indefinite. The notice of opposition pleads likelihood of confusion based on Opposer's "AGILENT Marks," which are defined to include both Opposer's pleaded registrations

as well as Opposer's "AGILENT Common Law Marks." Notice of opposition ¶ 7. While Opposer has identified its pleaded registrations and attached copies of TSDR records thereof, Opposer's pleading of its common law rights is insufficient to provide fair notice to Applicant. Opposer defines its "AGILENT Common Law Marks" as "a family of marks consisting of or incorporating the mark AGILENT in connection with a wide range of goods and services related to life sciences and laboratory analysis." *Id.* at ¶ 6. Opposer's identification of a "wide range of services" is indefinite and lacks the specificity required to clearly plead prior common law rights. In order to properly plead prior common law rights, Opposer must specifically identify the marks and goods or services in its notice of opposition.

Additionally, to plead ownership of a family of marks, a plaintiff must allege the following: "(1) prior use of marks sharing a recognizable common characteristic; (2) that the common characteristic is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark); and (3) that prior to the defendant's first use (or constructive first use) of its involved mark, plaintiff's marks have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition among the purchasing public such that the common characteristic is itself indicative of a common origin of the goods or services." *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016).

The Board freely grants leave to amend pleadings found to be insufficient upon review, however. Accordingly, Opposer is allowed until **May 26, 2022** to file and serve

an amended notice of opposition that properly pleads a claim of likelihood of confusion based on common law marks and/or a family of marks, failing which, said claims will be dismissed with prejudice and the opposition will go forward solely with respect to Opposer's claim of likelihood of confusion based on its three pleaded registrations.

In turn, Applicant is allowed until **June 15, 2022** to file and serve an answer to the amended notice of opposition, if any.²

VI. ACR

The Board informed the parties of the Board's Accelerated Case Resolution ("ACR") process. While the parties did not stipulate to pursue ACR at this time, the parties may revisit the option of ACR at a later date. The parties are directed to consult the following for more information regarding ACR: <https://www.uspto.gov/trademarks/ttab/ttab-acr-options>.

VII. The Board's Standard Protective Order

The Board then advised the parties of the Board's two-tiered standard protective order pursuant to Trademark Rule 2.116(g), which is automatically imposed on the parties in this proceeding. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval. Because the Board's standard protective order is automatically

² The Board notes that in its answer, while Applicant clearly admits or denies each allegation in the notice of opposition, Applicant also includes numerous paragraphs beginning with the word "FURTHERMORE..." See, e.g., ¶ 14 of Applicant's answer to the notice of opposition. A defendant should not argue the merits of the plaintiff's allegations in its answer, but rather merely state which allegations are admitted or denied. See TBMP § 311.02(a).

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, parties may elect to designate material as Confidential—Attorneys' Eyes Only. In this case, where Applicant is not represented by counsel, any material designated as Confidential—Attorneys' Eyes Only should not be produced. Rather, if appropriate, Opposer should respond by stating that it has responsive documents or information in its possession, custody or control, but that it is withholding the information as Confidential—Attorneys' Eyes Only.

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 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 Board's liberal granting of motions to suspend for settlement efforts, and 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 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 parties are advised that discoverable material includes electronically stored information. The parties should identify any potential problems with the production of electronically stored information in advance. The parties should consult TBMP § 414 when preparing and responding to discovery requests and 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

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.

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 motion 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

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.

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(f).

⁶ Trademark Rules 2.120(e) and (i).

X. Expert Disclosures

The Board also noted that, 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 parties were advised that 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, the parties were reminded that an oral hearing is set only upon request as provided by Trademark Rule. 2.129.

XIV. Schedule

Consistent with the time set to replead, remaining dates are reset as follows:

Amended Notice of Opposition Due	5/26/2022
Answer to Amended Notice of Opposition Due	6/15/2022
Discovery Opens	6/16/2022
Initial Disclosures Due	7/16/2022
Expert Disclosures Due	11/13/2022
Discovery Closes	12/13/2022
Plaintiff's Pretrial Disclosures Due	1/27/2023
Plaintiff's 30-day Trial Period Ends	3/13/2023
Defendant's Pretrial Disclosures Due	3/28/2023
Defendant's 30-day Trial Period Ends	5/12/2023
Plaintiff's Rebuttal Disclosures Due	5/27/2023
Plaintiff's 15-day Rebuttal Period Ends	6/26/2023
Plaintiff's Opening Brief Due	8/25/2023
Defendant's Brief Due	9/24/2023
Plaintiff's Reply Brief Due	10/9/2023
Request for Oral Hearing (optional) Due	10/19/2023

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, 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). 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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.⁷ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

⁷ To facilitate accuracy, ESTTA provides previews of each page before submitting.