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

November 18, 2022

Opposition No. 91278187

Dinefresh Group LLC

v.

Monir Nasser

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 discovery and settlement conference on November 17, 2022.[1] *See* TBMP § 401.01. At counsel for Applicant's request, a member of the Board joined in the conference. *See* Trademark Rule 2.120(a)(2)(i). Participating were Richard Sierra on behalf of Opposer, Mark Terry on behalf of Applicant, and the assigned interlocutory attorney.

The Board apprised the parties of some general procedural rules and guidelines that govern inter partes proceedings, including the importance of reducing all stipulations to writing, the Board's liberal granting of motions to suspend for settlement efforts, and the requirement that a party serve its initial disclosures

[1] To facilitate scheduling, the Board, in its discretion, allowed for the conference to be held beyond the deadline set forth in the August 25, 2022 institution order.

pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) prior to serving discovery requests under Trademark Rule 2.120(a)(3).

The Board's Standard Protective Order is automatically in force and effect 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 to use an alternative order is granted by the Board. TBMP § 412 *et. seq.* The parties stipulated to utilize the Standard Protective Order without modification. If at any time the parties wish to modify the order they must file a motion for the Board's approval of the modification(s). Trademark Rule 2.116(g). Lastly, although they are not required to do so, the parties may elect to exchange executed copies of the Protective Order.

Turning to the pleadings, upon review of the notice of opposition the Board found that Opposer sufficiently alleges 1) an interest falling within the zone of interests protected by the statute, and 2) a reasonable belief in damage proximately caused by the registration of the mark. Thus, Opposer has sufficiently alleged its entitlement to a statutory cause of action. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), cert. denied, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), cert. denied, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.,* 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

Opposer alleges common law rights since August 1, 2020 in the mark HOOK'S CATCH in connection with restaurant services; pleads ownership of Registration No. 6297056, which registered on March 16, 2021 for the mark HOOK'S CATCH and

design for "restaurant services; restaurant services, including sit-down service of food and take-out restaurant services;" and made of record a copy of the pleaded registration from TSDR (Trademark Status and Document Retrieval) showing the current status and title thereto. Trademark Rule 2.122(d)(1); TBMP § 317. 1 TTABVUE 9. Because Opposer's pleaded registration is of record and is not the subject of cancellation or counterclaim, Section 2(d) priority is not an issue in this proceeding with respect to Opposer's registered mark and the services identified in its registration, vis-à-vis Applicant's mark and identified services. *King Candy Co. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.,* 108 USPQ2d 1134, 1139 (TTAB 2013); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.,* 98 USPQ2d 1066, 1072 (TTAB 2011).

Opposer's November 4, 2022 motion to amend the notice of opposition is granted. 7 TTABVUE. The amended notice of opposition is Opposer's operative pleading in this proceeding. The amended pleading amends: ¶ 10 to correctly state the date on which Applicant filed its opposed intent-to-use application, and ¶ 11 to correctly state the date the application was published for opposition. As the Board noted in the conference, inasmuch as the application filing date and publication date are objective facts not subject to proof, Applicant need not file an amended answer. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009). *Cf.* TBMP § 503.02.

In the answer, Applicant denies most salient allegations, and admits Opposer's allegations in¶¶ 16, 17 and 21. 4 TTABVUE 6-7. The Board notes that Applicant set

forth various matters captioned as affirmative defenses, and that Opposer moved to strike these under Fed. R. Civ. P. 12(f). The motion is untimely.[2] TBMP § 506.02. 6 TTABVUE. Nonetheless, the Board may, upon its own initiative and/or during a discovery conference, determine whether any matter is to be stricken from a pleading. The Board may strike from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f).

Turning to this issue, the Board noted in the conference that the first and fourth affirmative defenses are stricken as impertinent, and are insufficiently pleaded. The doctrines of laches and acquiescence are generally not applicable in Board opposition proceedings. *Nat'l. Cable Television Assoc., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (laches unavailable); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence and estoppel generally not available in opposition proceeding).

The second and third affirmative defenses are stricken because they are insufficiently pleaded and do not allege all elements of an unclean hands or estoppel defense. Moreover, the allegations of "estoppel" fail to place Opposer on fair notice of the specific doctrine of estoppel that Applicant sought to plead.

The fifth, sixth, seventh and eighth affirmative defenses are not true affirmative defenses, but rather are statements which set forth Applicant's position on

[2] A motion to strike matter from a pleading should be filed within 21 days after service upon the moving party of the pleading that is the subject of the motion. Fed. R. Civ. P. 12(f)(2); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *Western Worldwide Enter. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

substantive matters and which go to the merits of the elements of Opposer's claim of priority and likelihood of confusion. Moreover, the fifth, sixth and seventh affirmative defenses are stricken as immaterial and impertinent; as noted above, at the pleading stage Opposer has established its priority of use for Section 2(d) purposes. The eighth affirmative defense – "a lack of likelihood of confusion" - is not a true defense but rather an amplifying denial that provides notice of Applicant's position on this substantive issue. The "defense" is not stricken, though, inasmuch as Applicant may present arguments and evidence at trial to support its position.

The Board reminded the parties that it will base the likelihood of confusion determination on an analysis of all of the probative arguments and facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Whether a likelihood of confusion exists between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). The Board determines the issue on the basis of the identifications of goods and services as they appear in the pleaded registration(s) and in the opposed application(s). *See, e.g.*, *B & B Hardware, Inc. v. Hargis Inds., Inc.*, 135 S. Ct. 1293, 1300 (2015) (recognizing that an "applicant's right to register must be made on the basis of the goods described in the application"); *Stone*

Lion Cap. Partners, L.P. v. Lion Cap. LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Comp. Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *13 (TTAB 2020).

The Board advised the parties that, in the event this proceeding does not settle, discovery should be very narrowly tailored, e.g., directed to the relevant *du Pont* factors. The Board also noted for the parties to consult TBMP § 414 in connection with drafting written discovery requests and responses thereto, and prior to any discovery deposition(s). The parties may consult TBMP Chapter 600 for specific guidelines and options regarding the settlement and disposition of Board proceedings.

The parties will exchange discovery and documents in a manner agreed upon if and when discovery gets underway.

The Board advised that, in the event the parties seek to amend the opposed application in any manner, all statutory requirements apply, and the parties should

be mindful of whether one or more of the miscellaneous statements with which the opposed mark was published for opposition would require amendment.

The Board briefly explained the availability and features of the "accelerated case resolution" ("ACR") process. For further information, the Board referred 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 this proceeding involves only one claim, and discovery is narrowed to and focused on the issue of likelihood of confusion, the proceeding is appropriate for resolution under the ACR option. The parties briefly discussed this. The parties are encouraged to consider the ACR option early during the discovery period, and may contact the assigned interlocutory attorney to receive a prompt review of whatever ACR stipulations the parties develop, and to assure that the proceeding is placed on the ACR docket.

Schedule

The parties anticipate engaging in settlement discussions, and stipulated to extend the due date to serve initial disclosures to January 6, 2023, and to extend discovery and trial dates. In accordance with the stipulation, discovery and trial dates are therefore reset as follows:

Discovery Opens	12/7/2022
Initial Disclosures Due	1/6/2023
Expert Disclosures Due	5/6/2023
Discovery Closes	6/5/2023
Plaintiff's Pretrial Disclosures Due	7/20/2023
Plaintiff's 30-day Trial Period Ends	9/3/2023
Defendant's Pretrial Disclosures Due	9/18/2023

Defendant's 30-day Trial Period Ends	11/2/2023
Plaintiff's Rebuttal Disclosures Due	11/17/2023
Plaintiff's 15-day Rebuttal Period Ends	12/17/2023
Plaintiff's Opening Brief Due	2/15/2024
Defendant's Brief Due	3/16/2024
Plaintiff's Reply Brief Due	3/31/2024
Request for Oral Hearing (optional) Due	4/10/2024

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).

It is the responsibility of each party to ensure that the Board has the party's 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. Trademark Rule 2.18(b)(1).

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.[3] 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.

[3] To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.