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

April 11, 2023

Opposition No. 91282859

Horizon Therapeutics Ireland DAC

v.

Geron Corporation

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On April 11, 2023, Opposer (represented by Frances M. Jagla of Christensen O'Connor Johnson Kindness PLLC), Applicant (represented by Sharon R. Smith of Goodwin Procter LLP) and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a), 37 C.F.R. § 2.120(a). This order sets forth a summary of the significant points addressed during the conference.

CONFERENCE SUMMARY

Initially,[1] the Board asked whether there are any related proceedings and whether the parties had engaged in any settlement discussions since the filing of the proceeding.

[1] The Board reminded the parties that the telephone conference was not to be recorded.

The parties informed the Board that there is no related federal district court or Board case, and the parties have discussed the possibility of settlement. The Board recommended that should the parties engage in serious settlement discussions, one of the parties should submit a consent motion to extend or suspend the trial schedule. The parties agreed to suspend this proceeding for thirty days to discuss the possibility of settlement. The trial schedule shall be reset at the conclusion of this order.

Should a civil action between the parties or other Board proceeding be instituted, the parties are required to so inform the Board so that it can determine whether suspension or consolidation is appropriate.

PLEADINGS; AMENDMENT TO PLEADINGS ENTERED

Opposer sets forth in the Notice of Opposition a sufficiently pleaded claim of likelihood of confusion based on priority accrued at common law and based on its pleaded registration for the mark TEPEZZA. Notice of Opp. ¶ 2, 1 TTABVUE 4. Because Opposer attached a printout from the USPTO TSDR database showing the current status and title of its registration, priority based on the registration is not at issue in this proceeding. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To the extent Opposer intends to rely on its pleaded date of first use, February 3, 2020, Notice of Opp. ¶ 1, 1 TTABVUE 3-4, Opposer does not state with which goods it uses in connection with the applied-for mark. Additionally, the Board reminded Opposer that alleged rights accrued at common law must be proven at trial. *See* Trademark Rule 2.122(b)(2).

Regarding the Answer, Applicant denies the salient allegations in the Notice of Opposition, and sets forth "affirmative defenses," which are essentially amplifications of its denials. *See* TBMP § 311.02(c).

The parties agreed to amend the pleadings as follows (additional wording shown in bold); therefore, **IT IS ORDERED** that the parties' pleadings are **AMENDED** as shown below:

1) **Notice of Opposition**, 1 TTABVUE 4:

"… and claims a first use date of February 3, 2020. **Opposer claims rights in the mark TEPEZZA accrued at common law at least as early as February 3, 2020, in connection with the same goods as set forth in its pleaded registration.** The filing date …"

2) **Answer**, 5 TTABVUE 2, ¶ 1:

"… As to the allegation that the Opposed Application is confusingly similar to the goods and services in the alleged registration, Applicant denies this allegation. Applicant denies any remaining allegations in Paragraph 1**, including any common law claims**."

STIPULATIONS

Various stipulations may be agreed to by the parties, either during the course of the conference or during the pendency of the proceeding. By way of example, the parties may agree or stipulate **in writing** to the following measures to facilitate the progress of this proceeding:[2]

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[2] Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;
- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- That documents are deemed authenticated;
- That a notice of reliance can be filed after the testimony periods are closed;
- That electronic evidence will be exchanged in a certain manner; and/or
- Agree to serve documents to be produced in discovery by email, rather than by requiring inspection and copying of documents at the location of the documents.

See, e.g., TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 403.01, 501, 704.03(b) and 705 (2022).

STANDARD PROTECTIVE ORDER

The Board reminded the parties that the Board's standard protective order applies to this proceeding. The standard protective order may be modified by the parties in writing. Should the parties modify the standard agreement, the Board requests that the parties identify which clause or provision has been modified.

Applicant's counsel requests that the parties execute a copy of the standard protective order and to submit it to the Board.

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to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. *See* TBMP §§ 403.01 and 501.02.

INITIAL DISCLOSURES

Initial disclosures should not be filed with the Board; they are served on the adverse party. The parties were reminded that until the party seeking to serve discovery or to file a motion for summary judgment has served its initial disclosures, discovery may not be served, nor may a summary judgment motion be filed.

EVIDENCE

The parties were reminded that each party has a duty to preserve material evidence and to avoid spoliation or destruction of evidence.[3]

ACCELERATED CASE RESOLUTION (ACR)

The Board suggested that the parties consider using the Board's Accelerated Case Resolution procedure. **Should the parties need assistance to develop the appropriate stipulation, please contact the Interlocutory Attorney[4] who can assist the parties in doing so.**

If the parties are interested in the summary judgment model of ACR, they would need to submit to the Board a stipulation on the following issues:

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[3] "While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request." *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D. Pa. 2007) (addressing law firm's failure to preserve temporary electronic files); *see also Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) ("ESI must be produced in Board proceedings where appropriate, notwithstanding the Board's limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings") (internal citations omitted).

[4] The parties should contact the assigned Interlocutory Attorney, Elizabeth Winter, at elizabeth.winter@uspto.gov or 571-272-9240.

- that cross-motions for summary judgment and accompanying evidentiary submissions would substitute for a trial record and traditional briefs at final hearing;
- that the parties would forego trial; and
- that the Board may make determinations of genuine disputes of material fact on the basis of the final record and may issue a final ruling based thereon in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence.

The parties are advised that other approaches have been adopted by parties that realize the efficiencies sought through the ACR process and, therefore, should be considered as falling under the ACR umbrella. *See, e.g., Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007), in which the parties stipulated to 13 paragraphs of facts, including Applicant's dates of first use, channels of trade for Applicant, extent and manner of Applicant's use, recognition by others of Applicant's use, as well as the dates, nature and extent of descriptive use by the Opposer's parent; and the parties stipulated to the admissibility of business records, government documents, marketing materials and internet printouts.[5] Information concerning use of ACR in Board proceedings is available online at the following URL:

http://www.uspto.gov/trademarks/process/appeal/index.jsp.

[5] By way of example only, the parties may view ACR related stipulations and orders in the following cases on Ms. Winter's docket: Opposition No. 91222612 (see no. 14); Opposition No. 91227798 (see no. 8); 91219403 (see no. 34); 91214266 (see nos. 5, 7 and 13); 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history). The parties are directed also to review *Fiserv, Inc. v. Electronic Transaction Sys. Corp.*, 113 USPQ2d 1913 (TTAB 2015) (Opposition No. 91214266, nos. 5 and 21).

Additionally, the parties may find the following cases helpful in crafting their ACR stipulation, if any:[6]

1. 92068515: The parties agreed to the summary judgment model of ACR.
2. 92068150: The parties agreed to an informal discovery exchange and the summary judgment model of ACR, and stipulated to what the issues in dispute were. The petition to cancel was subsequently withdrawn.
3. 92068042: The parties agreed to make initial disclosures, forgo discovery, and use the summary judgment model of ACR.
4. 92068841: The parties agreed to waive initial disclosures, move up the discovery deadline, limit discovery, and use the summary judgment model of ACR.
5. 92068970: The parties agreed to a schedule for discovery and to use the summary judgment model of ACR.
6. 92069524: The parties agreed that they would produce documents with their initial disclosures, limit discovery, forgo expert testimony, and use the summary judgment model of ACR. The petition to cancel was subsequently withdrawn.
7. 92069629: The parties stipulated to the petitioner's standing and agreed to informally exchange documents, limit discovery, and use the summary judgment model of ACR.
8. 92069904 & 92069906: The parties stipulated to the petitioner's standing and agreed to limit discovery and use the summary judgment model of ACR.

Proceeding Suspended; Trial Dates Reset

In accordance with the parties' agreement during the conference, this proceeding is **SUSPENDED through May 11, 2023**, so that the parties can discussed settlement. *See* Trademark Rules 2.117(c) and 2.127(a); *see also Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings suspended subject to the right of either party to request resumption); TBMP § 510.03(b). The proceeding resumes on **May 12, 2023**.

Accordingly, the trial schedule is reset as shown below:

[6] If the parties do not decide to use ACR early in the proceeding, it can be adopted later.

Proceeding Resumes	**5/12/2023**
Discovery Opens	**5/12/2023**
Initial Disclosures Due	**6/11/2023**
Expert Disclosures Due	**10/9/2023**
Discovery Closes	**11/8/2023**
Plaintiff's Pretrial Disclosures Due	**12/23/2023**
Plaintiff's 30-day Trial Period Ends	**2/6/2024**
Defendant's Pretrial Disclosures Due	**2/21/2024**
Defendant's 30-day Trial Period Ends	**4/6/2024**
Plaintiff's Rebuttal Disclosures Due	**4/21/2024**
Plaintiff's 15-day Rebuttal Period Ends	**5/21/2024**
Plaintiff's Opening Brief Due	**7/20/2024**
Defendant's Brief Due	**8/19/2024**
Plaintiff's Reply Brief Due	**9/3/2024**
Request for Oral Hearing (optional) Due	**9/13/2024**

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). Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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).