

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 27, 2008

Cancellation No. 92049168

Cancellation No. 92049203

**SKEETER PRODUCTS, INC.**

v.

**DAVID WAYS**

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

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 at 1:00 p.m. EST, on June 17, 2008. Board participation was requested by respondent. Prior to agreeing to participation, the Board asked if the parties were involved in any other Board proceeding (to determine whether consolidation was appropriate) or in litigation in court (to determine whether suspension was appropriate). Respondent informed the Board that the parties were involved in the two proceedings identified in the caption of this order and that he had recently filed a suit for declaratory judgment in district court.

Petitioner was represented by Catherine Holland and Gregory Phillips. Respondent, David Ways, represented himself. Other attendees were Steele Williams, with respondent; James Walsh, Administrative Trademark Judge; and Cindy Greenbaum, Managing Interlocutory Attorney. The conference lasted about half an hour.

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**Proceedings consolidated**

The Board granted respondent's motion (filed May 9, 2008) to consolidate Cancellation Nos. 92049168 and 92049203. The "parent" case is Cancellation No. **92049168**, but all papers filed in the parent case should include both proceeding numbers in ascending order. See Fed. R. Civ. P. 42(a); and TBMP §511 (2d ed. rev. 2004).

**Respondent to submit pleadings from district court**

Respondent was allowed until time to submit copies of the pleadings filed in district court so that the Board may determine whether this consolidated proceeding should be suspended pending final disposition of the district court case. Before this order was mailed, the pleadings were submitted. The Board now has had an opportunity to review the submission.

**Proceedings suspended**

Whenever it comes to the attention of the Board that a party (or parties) to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceeding before the Board may be suspended until final determination of the civil action. To the extent that a case in Federal district court involves issues in common with those in the proceeding before the Board, the decision of the court is often binding on the Board, while the decision of the Board is not binding upon the court. See TBMP §510.02 (2d ed. rev. 2004). It is not necessary that the claims or issues be identical, only that the

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determination of issues presented to the court may have a bearing on the issues presented to the Board. Moreover, judicial economy lies in the suspension of the Board proceeding because the Board has limited jurisdiction, involving the issue of registrability only, and any decision of the Board is appealable to U.S. District Court. See Trademark Act Section 21.

The Board has reviewed the pleading submitted from the district court action and determined that adjudication therein may have a bearing on at least some of the issues presented herein.

Accordingly, proceedings herein are suspended pending final disposition of the district court action.

The Board discussed other topics, some of which are relevant only if proceedings are resumed.

#### **Representation**

The Board confirmed that Mr. Williams is not representing respondent in this consolidated cancellation proceeding. Mr. Williams was reminded that, should he file any paper herein on behalf of Mr. Ways, he will have made an appearance and will be representing respondent. Mr. Williams was also asked to clearly indicate to petitioner's attorneys the scope of any communications he has with them on behalf of Mr. Ways so that no confusion arises later.

**Electronic resources**

The Board pointed out relevant electronic resources available at the USPTO website, [www.uspto.gov](http://www.uspto.gov). These included: E-business (ESTTA and TTABVUE); the Trademarks homepage (the federal trademark statute and rules); and the TTAB homepage (answer to frequently asked questions, TTAB summaries for final decisions, the new rules, a chart of the new rules, and the Board Manual "TBMP"). Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties.

**E-mail service**

The parties agreed to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic transmission when mutually agreed upon by the parties.").<sup>1</sup>

**The petitions to cancel**

The Board confirmed that petitioner's claim is priority and likelihood of confusion. Petitioner was informed that the Board does not have jurisdiction to consider petitioner's claim under Trademark Act §43(a), "false designation of origin."<sup>2</sup>

**Discovery**

The Board discussed that there were provisions in place with respect to a protective order, directed the parties to TBMP §414

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<sup>1</sup> The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First Class Mail) is not available for email service.

<sup>2</sup> Paragraph No. 15 of each petition to cancel.

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(2d ed. rev. 2004) for an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings, and further discussed some specific topics of discovery.

More particularly, the Board advised the parties that the Board's standard protective order was in place in this case governing the exchange of confidential and proprietary information and materials. The parties were informed that they may substitute a stipulated protective agreement (signed by both parties) but that the Board would not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

Although not exclusive, the Board highlighted important aspects of the scope of discovery in this case. Priority is to be proven in a cancellation proceeding, so discovery concerning each party's first and continuous use is appropriate, as is discovery concerning the likelihood of confusion factors. See TBMP §§309.03(c) (2d ed. rev. 2004) (A-Priority and B-Likelihood of confusion). Discovery is not to be pursued unless the proceedings are resumed.

### **Settlement**

The Board clarified that the parties are not presently engaged in any substantive settlement discussions.

### **Nature of Board proceedings**

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a

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wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. 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 the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. 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.

The parties are reminded that the Board is an administrative tribunal empowered to determine the right to register only. See TBMP §102.01 (2d ed. rev. 2004).

**Conclusion of conference**

At the conclusion of the conference, the parties were directed to stay on-line to discuss whether they wish to discuss settlement as a possibility and any other matter they may deem of interest.

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