

ESTTA Tracking number: **ESTTA665831**

Filing date: **04/09/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057500
Party	Plaintiff Orbis Distribution, Inc.
Correspondence Address	JOHN M BOLGER BOLGER LEGAL GROUP LLC PO BOX 170616 WHITEFISH BAY, WI 53217 UNITED STATES John@BolgerLegalGroup.com
Submission	Response to Board Order/Inquiry
Filer's Name	John M Bolger
Filer's e-mail	john@bolgerlegalgroup.com
Signature	/John M. Bolger/
Date	04/09/2015
Attachments	Joint Report. 4.9.15.pdf(172070 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial Number: 78/368710
Registration Number: 3197276
For the Mark: Bee Naturals

Orbis Distribution, Inc, Petitioner, v. Bee Naturals, Inc., Registrant.

Cancellation Number:
 92057500

**JOINT REPORT REGARDING
DISCOVERY CONFERENCE
PURSUANT TO BOARD ORDER**

The Board has recently ordered the parties, by counsel, to submit a joint report regarding the discovery conference. Therefore, as ordered by the Board in its recent Order dated January 8, 2015, the petitioner and registrant submit the following report.

1. The nature of and basis for the respective claims and defenses.

A. For the petitioner.

As raised in the Petition to Cancel and the other documents filed by the petitioner, the petitioner’s basis for this case is the undisputed fact that the registrant of the mark was administratively dissolved prior to the mark’s registration until after the Combined Declaration of Use and Incontestability under Sections 8 & 15 were filed. Further, the company was dissolved until after time for filing the Combined Declaration was due as well as after the six-month grace period in question had elapsed. In fact, the company was dissolved until nearly one

year after the commencement of this Cancellation Proceeding, and nearly one year after the grace period in question had expired.

Because the registrant was administratively dissolved, it was informed by the Missouri Secretary of State that, pursuant to the unambiguous Statutes, it could not conduct business legally in the State of Missouri. The registrant was unable to conduct the requisite legal interstate commerce necessary in order to have and maintain a trademark. If a company cannot conduct interstate commerce, it cannot register nor maintain a trademark.

Therefore, the mark must be cancelled.

The petitioner has also raised the issue that because the registration of the registrant does not match the spelling of the company name, that the registration must also be cancelled. The Board has ruled against this issue as an initial matter; however, the petitioner reserves the right to argue this issue at trial or raise it on appeal.

Moreover, the registrant knew that it could not conduct legal commerce in the State of Missouri, and it knew that conducting continuous interstate commerce was a necessary in order to have, register or maintain a trademark. Therefore, the registrant, in allowing its registration to proceed, in filing the statement of use, and in filing the document regarding incontestability, has committed fraud; therefore, the registration must be cancelled.

The petitioner reserves the right to raise other issues not expressly raised or presented in this Joint Report, as well as issues brought forth in its Petition and all subsequently filed documents. The petitioner also reserves the right to pursue any issue subsequently discovered in this case.

B. For the registrant.

The petitioner received the following reply from counsel for the registrant regarding the nature of their defenses:

“I laid out to you the general nature of our defenses in the call, but in case you don’t recall, I’ll refer you to the motion and to dismiss and also to the summary judgment motion that was filed by us but deemed premature. That should identify everything for you in explicit detail.” (Counsel for the registrant, Email, 3/30/14.)

2. Settlement.

The parties have discussed the settling this matter.

Settlement is not possible at this time.

3. Limiting the Issues: Narrowing Claims and Defenses.

Again, the petitioner reserves the right to raise other issues not expressly raised or presented in this Joint Report, as well as issues brought forth in its Petition and all subsequently filed documents. The petitioner also reserves the right to pursue any issue or claim subsequently discovered in this case.

However, the facts of the case are not in dispute and have been admitted by the registrant. Therefore, all that appears to remain are legal questions for the Board to answer.

The registrant did not address this issue.

4. Arrangements relating to disclosures, discovery and introduction of evidence at trial.

The parties have stipulated to exchange all further documents in this case by email, including any motions, discovery request, discovery responses, trial documents, et cetera. The sending party agrees to do the following: (1) All documents are to be attached to emails as PDF documents; (2) all emails are to be sent with a “delivery receipt” and “read receipt” requested; and (3) a courtesy call is to be placed to the opposing counsel’s phone number listed on the

TTABVUE site, describing the item sent. The receiving party agrees to acknowledge the email either by clicking the “receipt” button or by sending a confirming email that the email was received.

4. Initial Disclosures.

The parties agreed that as of now, no changes should be made in terms of the initial disclosure requirements or timing.

5. Discovery.

The parties agreed that discovery should proceed as outlined by the Board order (and thus completed by 9/27/2015), that the opposing party would have 30 days to respond to any discovery request, and that the discovery limitations would remain.

6. Topics of Discovery

A. For the petitioner.

The facts are undisputed and may not require any further discovery. To the extent that further discovery is warranted, the petitioner may inquire as to when the registrant knew that it was dissolved. The petitioner may also cover the subject that upon filing a declaration of use, the document states that false statements are punishable by monetary and other sanctions. The petitioner reserves the right to request other documents or ask other questions as warranted to pursue this case.

B. For the registrant.

The registrant wrote the following:

“Discovery should obviously not been done in phases because the way it’s usually phased is liability and then damages, which doesn’t apply here. The subjects to be covered in discovery are not fully known, but I’ll refer you again to previous pleadings.” (Id.)

7. Electronically Stored Information.

The parties agreed (as above) that electronically stored information should be presented as in PDF document. To comply with discovery requests, said documents can be scanned or electronically stored and converted into PDF documents, and then emailed to opposing counsel.

The only electronically stored information or document that the petitioner is aware of are two documents that were on the Missouri Secretary of State website, and those on the on the USPTO website itself. These documents were preserved by the petitioner.

8. Privilege or protection of trial-preparation materials.

The parties are unaware of any issues of privilege or protection of trial-preparation materials. To the extent that a protective order is necessary and depending on the circumstances, a standard protective order may suffice.

9. No changes should be made in terms of the limitations on discovery.

10. No modifications to the discovery or trial calendar are necessary at this time.

11. The parties are uncertain regarding expert testimony as of this time.

12. The deadline for expert disclosures is satisfactory.

Dated: April 8, 2015

Respectfully Submitted,
/John M. Bolger/
John M. Bolger, Esq., Wisconsin bar member
Bolger Legal Group, LLC
P.O. Box 170616
Whitefish Bay, WI 53217
(414)270-9900
John@BolgerLegalGroup.com

Attorney for the Petitioner

Drafted by Attorney Bolger

CERTIFICATION OF SERVICE

I hereby certify that a true and correct PDF copy of this Joint Report was sent via email, delivery and read receipt requested, and that a courtesy phone call was also placed (per the discovery conference stipulation) to Nelson D. Nolte at the email listed below and the phone number listed on the TTABVUE website on this 9th Day of April, 2015:

Nelson D. Nolte
nn@noltefirm.com

/John M. Bolger/
John M. Bolger, Esq.
Wisconsin bar member
Bolger Legal Group, LLC
P.O. Box 170616
Whitefish Bay, WI 53217