

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact No.: 571-272-8500

wbc

Mailed: May 23, 2015

Cancellation No. 92061096

Shirley A. Dicko

v.

Everett and Jones Barbeque –  
Jack London, LLC

**Wendy Boldt Cohen, Interlocutory Attorney:**

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 on May 21, 2015.<sup>1</sup> Participating in the conference were Petitioner, Shirley A. Dicko, Respondent's attorney, Ralph Francis, and Board interlocutory attorney, Wendy Boldt Cohen.

The Board reminds the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov>. The Board reminds the parties that they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminds the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on

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<sup>1</sup> Respondent requested Board participation on or about May 15, 2015.

the basis of *res judicata* or lack of Board jurisdiction) can occur until the parties make their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties indicated that they have engaged in settlement negotiations. The parties have indicated that they do not believe there is any pending litigation, in federal court or before the Board, between the parties but will need to confirm this belief. The parties are reminded that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations. As discussed and agreed by the parties, these proceedings are suspended for sixty days for settlement negotiations.

The Board discussed accelerated case resolution (ACR) and urged the parties to discuss it further at a later date. Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of this proceeding, including: abbreviating the length of the discovery, testimony, and briefing periods as well as the time between them; limiting the number or types of discovery requests or the subject matter thereof; limiting the subject matter for testimony, or limiting the number of witnesses, or streamlining the method of introduction of evidence, for example, by stipulating to facts and introduction of evidence by affidavit or declaration. The parties are directed to review the Board's website regarding ACR and TBMP §§ 528.05(a)(2) and 702.04 (2014). If the parties later agree to pursue ACR, they should notify the

interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

*Stipulations/Filings*

The parties agreed to service by e-mail only to the parties' e-mail addresses of record, with Trademark Rule 2.119(b)(6) being applicable to such service. The parties were reminded that by making this stipulation, the parties may not avail themselves of the additional five days contemplated by Trademark Rule 2.119(c) afforded to parties when service is made by first-class or express mail. *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at: <http://estta.uspto.gov>. Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"). The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure.

*Pleadings*

The Board has reviewed the pleadings in this case. In the petition to cancel, it is unclear if Petitioner is alleging ownership rights, as an individual, in a mark previously owned by her mother's corporation, whether Petitioner was assigned rights in the mark owned by her mother's corporation, or whether

Petitioner is alleging ownership rights in the mark based on her role as president of her mother's corporation. In short, it is unclear on what rights Petitioner is basing her standing and as such, it is not properly pleaded. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (2014); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Petitioner asserts fraud as her basis for cancellation. To plead a claim of fraud, Petitioner must identify a specific false statement of material fact that Respondent or its predecessor-in-interest made in obtaining or maintaining the involved registration and that such false statement was made with the intent to deceive the USPTO into issuing or maintaining that registration.<sup>2</sup> *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Petitioner has identified the specific false statements of material fact that Respondent or its predecessor-in-interest made to obtain or maintain the involved registration but failed to allege that such false statement was made with the

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<sup>2</sup> There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). Unless a party alleging fraud can point to clear and convincing evidence that supports drawing an inference of deceptive intent, it will not be entitled to judgment on a fraud claim. *In re Bose Corp.*, 91 USPA2d at 1942. Any doubt must be resolved against the party making a claim of fraud. *Id.* at 1939.

intent to deceive the USPTO into issuing or maintaining that registration. As discussed in the conference, fraud is improperly pleaded and is hereby *sua sponte* stricken by the Board. *See* TBMP § 506.01.

In its answer Respondent denied the salient allegations and raised two affirmative defenses.<sup>3</sup>

Petitioner is allowed until **June 15, 2015** to file an amended petition to cancel wherein she repleads her allegations of standing and ground for fraud, failing which the cancellation may be dismissed. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02. If Petitioner files an amended petition to cancel, Respondent is allowed until **July 15, 2015** to file an answer, or otherwise respond to the amended petition to cancel.

Because the parties are negotiating for a possible settlement of this case, proceedings herein are suspended,<sup>4</sup> except as otherwise noted, until July 25, 2015, subject to the right of either party to request resumption at any time. *See* Trademark Rule 2.117(c).

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<sup>3</sup> Respondent has asserted its defenses in a conclusory fashion without providing facts which constitute a basis therefor, and which provide fair notice thereof. *See Midwest Plastic Fabricators*, 5 USPQ2d 1067; *Heisch v. Katy Bishop Prod.*, 45 USPQ2d 1219 (N.D. Ill. 1997); TBMP § 311.02(b).

<sup>4</sup> The parties are advised, however, that to continue suspension after this period expires, the parties will be expected to report on the progress of their settlement talks to establish good cause for any continued suspension. This report should include: a recitation of issues that have been resolved, issues that remain to be solved, and a firm timetable for resolution. Absent such a report, any future motion to extend or suspend may not be approved, even though agreed to by the parties.

If there is no word from either party concerning the progress of their negotiations, proceedings shall resume on July 26, 2015, without further notice or order from the Board, upon the schedule set out below:

Discovery Opens	<b>7/26/2015</b>
Initial Disclosures Due	<b>8/25/2015</b>
Expert Disclosures Due	<b>12/23/2015</b>
Discovery Closes	<b>1/22/2016</b>
Plaintiff's Pretrial Disclosures	<b>3/7/2016</b>
Plaintiff's 30-day Trial Period Ends	<b>4/21/2016</b>
Defendant's Pretrial Disclosures	<b>5/6/2016</b>
Defendant's 30-day Trial Period Ends	<b>6/20/2016</b>
Plaintiff's Rebuttal Disclosures	<b>7/5/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/4/2016</b>

*Pro Se Information*

It is noted that Petitioner intends to represent herself in this proceeding. While Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, Petitioner should note that Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the other party, or if represented by an attorney, on the attorney for the other party and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which the parties may subsequently file in

this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

It is recommended that Petitioner obtain a copy of the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. Strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

Files of TTAB proceedings can be examined using TTABVue, accessible at: <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format. The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is posted on the USPTO web site at: <http://www.uspto.gov>.

The Board thanks the parties for their participation.