UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

Mailed: June 15, 2017

Opposition No. 91233907
Cancellation No. 92065824

Clutch Analytics, LLC

v.

Clutch Technologies, LLC

M. Catherine Faint,
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 June 15, 2017 with Board participation. Participating in the conference were counsel for Clutch Analytics, LLC (CAL), Oliver A. Ruiz, Atty. and Jessica N. McDonald, Atty., and counsel for Clutch Technologies, LLC (CTL), Anne E. Keenan-Yates, Atty. and Anthony J. Dovale, Atty. This order memorializes what transpired during the conference as well as providing additional guidance for both parties.

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). The Board was informed that the parties were not so involved. The parties also informed the Board that they had discussed settlement but were unable to reach settlement at this time.

1. Proceedings Consolidated

CTL filed a motion to consolidate these proceedings in the opposition proceeding. There was no response to the motion.

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993).

It is noted that the parties to these proceedings captioned above are identical, and the issues are similar or related. In view thereof the motion to consolidate is **granted** as conceded and for good cause. Accordingly, proceedings are hereby **consolidated** and may be presented on the same record and briefs. *See Hilson Research* 27 USPQ2d 1423; and *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. 91233907 as the "parent case." From this point on, only a single copy of all motions and papers should be filed,

and each such motion or paper should be filed in the parent case only, but captioned with all consolidated proceeding numbers, listing the "parent case" first.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

These proceedings were filed one day apart. In keeping with Board practice, the Board adopts the calendar of the most recently filed case as copied below.

2. Email Service

Pursuant to Trademark Rule 2.119(b) service of papers must be made via email unless otherwise stipulated by the parties. Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.

3. The Board's Standard Protective Order

The Board advised the parties that the Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may view the order here: https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0. The parties are advised that if they

agree to changes to the standard protective order, they must submit a signed revised order to the Board for approval.

4. Electronic Resources

The Board has an electronic filing system that is different than the one used to file Trademark applications and updates to registrations. This system, named ESTTA, may be accessed via the Board's website: http://estta.uspto.gov/. Addresses can be changed easily through an electronic form. Also, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.

Also available to the parties is the Board's TTABVue system which contains all of the Board's electronic files, including the one for this case.

5. Initial Disclosures

Pursuant to the Board's rules, neither the exchange of discovery requests nor the filing of a motion for summary judgment, except on the basis of res judicata or lack of Board jurisdiction, can occur until the parties have made their initial disclosures, as required by Fed. R. Civ. P. 26(f).

The Board clarifies that under Trademark Rule 2.120(a)(3), "A party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board." Thus once an individual party has made its initial disclosures it may serve discovery, even if the other party has not yet

served its initial disclosures. The Board views this as a means to aid settlement discussions between the parties.

6. Review of Pleadings

With regard to the pleadings, the Board noted that the notice of opposition and petition to cancel allege likelihood of confusion pursuant to Trademark Act § 2(d).

CAL has the burden of proof in this proceeding. A likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). *See In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). There are 13 *duPont* factors. However, not all of the *duPont* factors are relevant or of similar weight in every case. Indeed, any one of the factors may control a particular case. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

CTL has denied the salient allegations of the complaints.

7. Discovery

There was some discussion of ways to possibly streamline discovery, but the parties did not stipulate to any measures limiting discovery. Counsel also believed that there would not be significant electronically stored information (ESI) required in this case. The parties believed that the usual discovery rules would suffice for this proceeding.

The parties **agreed** that discovery responses and documents would be provided electronically via a flash drive, email or other mutually agreed electronic format with

the reservation that if the documents to be produced turned out to be voluminous, documents would be produced for physical inspection in the usual course of business as provided in Fed. R. Civ. P. 34(b)(2)(E).

The parties are reminded that the Board is an administrative tribunal that determines the registrability of trademarks. If the case should progress so far, the parties should be mindful when submitting trial evidence to the Board that the better practice is to focus on supporting, only to the extent required by the pertinent burden of proof, the facts to be established.

8. Accelerated Case Resolution ("ACR")

The Board encourages settlement of matters between the parties and the parties are continuing to discuss settlement at this time. While the Board does not conduct settlement conferences, there is an ACR procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review the more detailed information about ACR at the Board's website.

The parties were not interested in the ACR procedure at this time, but may be interested in the future. Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to facts after the close of the initial disclosure period and to a shortening of the discovery period. *See* Trademark Rule 2.120(a)(2). The Board advises the parties that if the parties agree to pursue ACR, they should notify the Board in writing as soon as possible.

The parties may also enter other stipulations, as discussed, to streamline the trial procedure or final decision.

9. Schedule

Dates for this now consolidated proceeding remain as set in the Board's order of April 11, 2017 in Cancellation No. 92065824, as copied below. Although the discovery conference is being held on June 15, 2017, discovery does not open until the date set out below.

Discovery Opens	6/20/2017
Initial Disclosures Due	7/20/2017
Expert Disclosures Due	11/17/2017
Discovery Closes	12/17/2017
Plaintiff's Pretrial Disclosures Due	1/31/2018
Plaintiff's 30-day Trial Period Ends	3/17/2018
Defendant's Pretrial Disclosures Due	4/1/2018
Defendant's 30-day Trial Period Ends	5/16/2018
Plaintiff's Rebuttal Disclosures Due	5/31/2018
Plaintiff's 15-day Rebuttal Period Ends	6/30/2018
Plaintiff's Opening Brief Due	8/29/2018
Defendant's Brief Due	9/28/2018
Plaintiff's Reply Brief Due	10/13/2018

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).

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