

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: July 12, 2017

Cancellation No. 92066126

*Chocoladefabriken Lindt & Sprungli AG*

*v.*

*Geraldine Elliott*

**Jennifer Krisp, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held a timely discovery and settlement conference on July 11, 2017. *See* TBMP § 401.01 (June 2017). At Petitioner's request, a member of the Board participated in the conference. *See* Trademark Rule 2.120(2)(i). Participating were Petitioner's counsel, James L. Vana, Respondent's counsel, Kurt M. Rylander, and the assigned interlocutory attorney.

The Board's Standard Protective Order is automatically imposed in this proceeding pursuant to Trademark Rule 2.116(g), unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board.

At this time, neither party proposes modifications to the Order. Although they are not required to do so, the parties may elect to exchange executed copies of the Order.

Turning to the pleadings, the Board noted in the conference that in the petition to cancel, Petitioner sufficiently sets forth allegations which, if proven, would establish its standing to bring this proceeding; specifically, registration of Petitioner's Application Serial No. 86727923, which is the subject of a currently suspended ex parte appeal, was refused registration citing Respondent's involved registration.<sup>1</sup> Also, Petitioner pleads the ground of abandonment, against International Class 35 only, pursuant to Trademark Act Section 14(3), 15 U.S.C. § 1064(3). Regarding this claim, Petitioner must prove nonuse of the mark and intent not to resume use, and bears the burden of proving a *prima facie* case. See *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1393 (TTAB 2007) citing *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). If Petitioner can show three consecutive years of nonuse, it has established a *prima facie* showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark without intent to resume use. The burden of production, *i.e.*, going forward, then shifts to Respondent to produce evidence that she has either used the mark, or intended to resume use. The burden of persuasion remains with Petitioner to prove abandonment by a preponderance of the evidence. *On-line Careline*, 56 USPQ2d at 1476, and *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989). See also, *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d1036, 1042 (TTAB 2012).

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<sup>1</sup> 1 TTABVUE 4; Not of Opp. ¶¶ 8 – 10.

In her answer, Respondent admits certain non-salient allegations, and denies all other allegations. The matters that Respondent set forth under the subtitle “Affirmative Defense(s)” are statements setting forth Respondent’s position with respect to certain matters that are not affirmative defenses to Petitioner’s abandonment claim. Inasmuch as the “defenses” are statements that merely amplify matters that may be part of Respondent’s defense, the Board declined Petitioner’s request to strike them. *See* TBMP § 311.02(d). To be clear, however, Respondent is left to her arguments and proofs on the stated matters to the extent that she can demonstrate that they are relevant to her defense.

The Board encouraged the parties to commence discovery early in the discovery period. Mr. Rylander noted that that he is in communication with counsel located in the U.K., and that Respondent resides in Scotland. Counsel for the parties discussed manners in which they will conduct discovery, as well as depositions in view of the fact that Respondent is not domiciled in the U.S., and expressed a willingness to take and attend depositions by remote means. *See* Fed. R. Civ. P. 30(b)(4); TBMP § 404.06. The Board referred the parties to TBMP § 404.03(b) with respect to taking Respondent’s deposition, and related matters.

The Board noted certain rules of procedure which have been amended since the institution of this proceeding, including the limits on the number of interrogatories, document requests and requests for admission. Regarding discovery, the Board directs the parties’ attention to TBMP Chapter 400, and in particular to TBMP § 414, for guidance.

The Board reminded the parties to reduce to writing all procedural and substantive stipulations.

Relevant procedural rules that govern *inter partes* proceedings, include:

- the Board’s liberal granting of motions to suspend for settlement efforts;
- the requirement that a party serve its initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii), prior to serving discovery requests (*see* Trademark Rule 2.120(a)(3));
- the requirements that a motion to compel initial disclosures must be filed within thirty days after the deadline therefor (*see* Trademark Rule 2.120(f)(1)), and a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset (*see* Trademark Rule 2.120(f)(1)); and
- the requirement that a motion for summary judgment must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset (*see* Trademark Rule 2.127(e)(1)).

When referring to the record herein, the parties should reference evidence by citation to the Board’s TTABVUE docket electronic file by the entry and page number (*e.g.*, 9 TTABVUE 20). *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

In the conference, the Board briefly explained the availability of and features of the “accelerated case resolution” (“ACR”) process, and urged the parties to give serious consideration to pursuing resolution by ACR, given that it will result in a decision

on the merits far sooner than as set out in the current discovery and trial schedule. Inasmuch as this proceeding involves one ground for cancellation, and is not likely to involve complex or document-intensive issues, the Board emphasized that it is particularly suited to resolution using a stipulated accelerated discovery and/or trial and briefing schedule under ACR. For further information regarding ACR options, the Board refers the parties to TBMP §§ 528.05(a)(2), 702.04 and 705, as well as the link on the Board's web page to a vast amount of ACR information and exemplary ACR proceedings.

The parties should contact the assigned interlocutory attorney (571-272-9183) in the event that they develop an ACR schedule or have questions regarding the ACR option.

### **Schedule**

Disclosure, discovery and trial dates remain as set forth in the Board's May 18, 2017 order instituting this proceeding.

Generally, the Federal Rules of Civil Procedure and 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

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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).