

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: April 5, 2018

Cancellation No. 92067794

Joshua S. Schoonover

v.

The Burton Corporation

Christen M. English, Interlocutory Attorney:

On April 5, 2018, at Petitioner's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1)-(2), 37 C.F.R. § 2.120(a)(1)-(2). Petitioner, who is an attorney, appeared *pro se*, Cathleen Stadecker, appeared on behalf of Respondent, and the assigned Interlocutory Attorney, Christen English, participated on behalf of the Board.

As an initial matter, the Board reminded the parties that all submissions must be filed with the Board through the Board's electronic filing system, ESTTA, and all papers must be served via email. Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a); Trademark Rule 2.126(a), 37 C.F.R. § 2.126(a).

The parties advised that they have discussed settlement, but settlement does not appear feasible at this time. If the parties decide to resume settlement negotiations, they should consider filing a consented motion to suspend to allow time for settlement discussions. TBMP § 510.03(a) (June 2017).

The parties are not currently involved in any other litigation regarding the involved marks, but Respondent indicated that the parties may become involved in litigation in another forum that may relate to the issues in the Board proceeding. As the Board advised during the teleconference, if either party commences litigation in another forum, the parties must promptly notify the Board and submit copies of the operative pleadings from the other proceeding so that the Board can consider possible suspension of the Board proceeding.

The Board reviewed the pleadings during the teleconference and explained that Petitioner has sufficiently pleaded his standing in paragraphs 6-7 of the petition to cancel and claims of abandonment in paragraph 11 of the petition to cancel. Petitioner attached to the petition to cancel copies of the registration certificates and TSDR printouts for Respondent's involved registrations as well as TSDR printouts for Petitioner's pleaded applications. The Board explained that the USPTO files for Respondent's involved registrations are automatically of record in this proceeding, and therefore, need not be submitted into evidence. Trademark Rule 2.122(a)(1), 37 C.F.R. § 2.122(a)(1). The Board further explained that the USPTO files for Petitioner's pleaded applications are not automatically of record and the TSDR printouts attached to the petition to cancel are not evidence of record in this proceeding. Trademark Rule 2.122(c). If Petitioner wishes to rely on TSDR printouts for the pleaded applications, he will have to properly submit them during his testimony period.

In its answer, Respondent admits that: (1) Petitioner "is listed in the records of the USPTO as the owner of" the pleaded applications, 4 TTABVUE 2-3, ¶¶ 4-5; and (2)

Respondent “has abandoned and discontinued use of the FOURSQUARE” mark “in commerce for more than three years,” and “such abandonment was made with the intent to not use and to not resume use of the FOURSQUARE” mark. 1 TTABVUE 5, ¶ 11; 4 TATBVUE 3, ¶ 11. Respondent denies the remaining salient allegations in the petition to cancel and asserts 2 affirmative defenses. The first affirmative defense of failure to state a claim is **stricken** because Petitioner has sufficiently alleged his standing and claims for abandonment. Respondent’s second affirmative defense is not a true affirmative defense, but it amplifies Respondent’s denials, and therefore, is allowed to stand.

The Board next discussed ways to streamline this case by using Accelerated Case Resolution (“ACR”). Respondent indicated that at this time it is not interested in resolving the proceeding through ACR. If the parties wish to revisit the possibility of ACR, the following materials may be helpful:

1. General Description of ACR:

http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf; and

2. Sections 528.05(a)(2), 702.04 and 705 of the TBMP.

The Board’s standard protective order, governing the exchange of confidential information, is automatically applicable by operation of Trademark Rule 2.116(g) and available here:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>

The Board concluded the teleconference with a reminder that a party may not serve discovery requests or file a motion for summary judgment until after the party has served its initial disclosures.

Dates remain as set in the Board's institution order of January 29, 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).