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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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October 3, 2019

Cancellation No. 92070823

*ICware Systems, Inc. dba BatchTest
Corporation*

v.

Ikonix USA LLC

By the Trademark Trial and Appeal Board:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(g)(1) and (2), the Board held a telephonic discovery conference on October 3, 2019, between Dinesh Patel, President appearing for Petitioner pro se; and Thomas J. Moore, Atty., and Thomas Lee, Atty., counsel for Respondent. 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 indicated that they were familiar with the Board's electronic resources for filing papers electronically. The parties had not yet discussed settlement, but agreed to do so immediately after the discovery conference.

1. Legal Representation Strongly Recommended

As discussed, 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, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure.

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. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006). If Petitioner decides to continue without counsel, it is urged to frequently consult the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) and the Trademark rules of practice, which are available on the USPTO website at www.uspto.gov.

2. Requirement for Service

Trademark Rules 2.119(a) and (b) require that every submission filed in a proceeding before the Board must be served upon the other party or parties, and proper proof of such service must be made before the submission will be considered by the Board. Accordingly, all submissions filed in this proceeding must be accompanied by a statement, signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed,

clearly stating the date and manner in which service was made, the name of each party or person upon whom service was made, and the email address. *See* TBMP § 113.03. Service must be made by email unless otherwise stipulated, or unless the filing party has satisfied the requirements for another method of service as set forth in Trademark Rule 2.119(b). The statement will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a Certificate of Service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by forwarding said copy on (insert date of emailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

Signature _____
Date _____

Submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and (b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are at <http://estta.uspto.gov/>.

It is recommended that any pro se party be familiar with the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. Parties should also be familiar with the Trademark Trial and Appeal Board Manual of Procedure (TBMP), available at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>, the TTABVUE system for viewing the record for all Board proceedings, available at <http://ttabvue.uspto.gov/ttabvue/>, and the Standard Protective Order, available at

<https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>.

3. Email Service

Pursuant to Trademark Rule 2.119(b), service of papers must be made via email unless otherwise stipulated by the parties. 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 are 30 days for response briefs and 20 days for reply briefs. Similarly, deadlines for responses to discovery requests are 30 days.

4. Electronic Resources

As discussed, 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, was discussed briefly during the teleconference, and may be accessed via the Board's website: <http://estta.uspto.gov/>. To highlight some features of the system, when a filing is made, a pre-populated cover sheet is generated; filings then may be attached in a .PDF format; if the filing has successfully been completed, the filer will receive an ESTTA tracking number; if there are any problems, call the Board at 571-272-8500 and ask to be put through to one of the computer specialists.

Addresses can be changed easily through an electronic form. For instance, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.¹

¹ Ordinarily a consented motion to extend or reopen or suspend will be granted by the Board. See TBMP § 509.02, and cases cited therein.

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. The parties may wish to conduct a status check of this case at least twice per month to be sure something is not missed. Most law firms already have a system for periodically checking status, and Petitioner may access TTABVUE through the Board's website at: <http://ttabvue.uspto.gov/ttabvue/>.

The Board directed the parties to the *TTAB Manual of Procedure*, the TBMP, available in an electronic version on the Board's website. The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions and declarations.

5. 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.

6. 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 due date for initial disclosures is reset at the end of this order.

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.

7. Review of the Pleadings

Reviewing the petition to cancel, Petitioner alleges likelihood of confusion under Trademark Act § 2(d); that Respondent is not the rightful owner of the mark under Trademark Act §§ 14(1) and 1; false suggestion of a connection under Trademark Act § 2(a); misrepresentation of source under Trademark Act § 14(3); and fraud also under Trademark Act § 14(3).

A. Likelihood of Confusion Claim at Count II

Petitioner has alleged standing as a competitor of Respondent and at Count II a likelihood of confusion. 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 du Pont factors). *See In re E. I. du Pont 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.*, 41 USPQ2d 1531 at 1533 (internal citations and quotation marks omitted). The claim at Count II is legally sufficient.

B. Not the Rightful Owner Claim at Count I is Stricken

As to the allegations at Count I that Respondent is not the rightful owner of the mark, the claim is insufficient. To properly plead a non-ownership claim under Trademark Act Section 1, Petitioner must allege facts, that if proven, would establish that prior to Respondent’s filing of the underlying application, 1) Petitioner (or another entity) owned the subject mark; 2) Respondent is not the rightful owner of the mark; and 3) Respondent did not own the mark at the time it filed the underlying application. Petitioner has not alleged the third element and Count I is **stricken**.

C. False Suggestion of a Connection Claim at Count III

At Count III Petitioner alleges “false association,” but when read with the ESTTA cover sheet the Board construes this is a claim of false suggestion of a connection. To properly plead a Section 2(a) claim of false suggestion of a connection, a plaintiff must allege the following:

1. Defendant’s mark is the same or a close approximation of the name or identity of a person or institution;
2. Defendant’s mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to the person or institution named or identified;
3. The person or institution named or identified is not connected with the goods sold or activities performed by the defendant under the mark; and,
4. The name or identity of the person or institution identified is of sufficient fame or reputation that when the defendant’s mark is used in

connection with its goods or services, a connection with the person or institution identified would be presumed.

In re Nieves & Nieves, LLC, 113 USPQ2d 1629, 1632-33 (TTAB 2015) (*citing inter alia*, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983) and *Bd. of Trs. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013)). Fundamental to a pleading of false suggestion of a connection under Trademark Act § 2(a) is the “initial and critical requirement” that the identity being appropriated is unmistakably associated with the person or institution identified. *Springs Indus., Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984) (*quoting Univ. of Notre Dame*, 217 USPQ at 509). The pleadings do not contain the critical requirement that the mark is Petitioner’s identity. In view thereof, the false suggestion of a connection claim at Count III is ***stricken***.

D. Misrepresentation of Source Claim at Count IV is Stricken

Count IV is alleged as “confusion as to source of origin,” but when read together with the ESTTA cover sheet the Board construes this as a misrepresentation of source claim. In order to properly plead a claim of misrepresentation of source, the pleading “*must be supported* by allegations of blatant misuse of the mark by [defendant] in a manner calculated to trade on the goodwill and reputation of [plaintiff]. *See Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (*quoting McDonnell Douglas Corp. v. Nat’l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985)) (emphasis added). The plaintiff must “do more than make a bald allegation in the language of the statute,” and the claim must go beyond the allegations “that typically support a claim of likelihood of confusion under Section 2(d).” *Id.* at 1864. Petitioner’s claim is legally

insufficient as it does not allege any facts that show blatant misuse of the mark by Respondent. Accordingly Count IV is **stricken**.

E. Fraud Claim at Count V is Stricken

Count V alleges fraud. However, with respect to a claim of fraud, such a claim requires allegations that an applicant for registration knowingly made specific false representations of material fact in connection with an application to register with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Intent to deceive is a required element of a fraud claim which must be pleaded. *Id.* While malice, intent, knowledge, and other conditions of mind may be averred generally, Petitioner “must state with particularity the circumstances constituting [the alleged] fraud.” *See* Fed. R. Civ. P. 9(b). Further, to satisfy Fed. R. Civ. P. 9(b), any allegations based on “information and belief” must be accompanied by a statement of facts upon which the belief is founded. *See Asian and Western Classics v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) (*citing Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009)).

Additionally, when a party claims that the oath or declaration in another's application for registration was signed fraudulently in that there was another legitimate use of the mark at the time of the signing, the party must allege particular facts which, if proven, would establish that: 1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; 2) the other user had legal rights superior to applicant's rights; 3) applicant knew that the other user

had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and 4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which applicant was not entitled. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). *Accord Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1593 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289 (TTAB 1999).

The Board's primary reviewing court has held that a fraud claim based on a false oath regarding the rights of others to use the mark only lies where the other party's rights were clearly established and known to be superior. In other words, for the purpose of fraud, knowledge of another party's use of the mark is not equivalent to knowledge of another party's superior rights to the mark. *See Metro Traffic Control v. Shadow Network, Inc.*, 41 USPQ2d 1369 (Fed. Cir. 1997). *Accord Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899, 1909 (TTAB 2006); *Intellimedia*, 43 USPQ2d at 1207.

Petitioner's claim is devoid of any allegations that Respondent made false representations in its application. Accordingly, Count V is **stricken**.

F. Petitioner Allowed Time to Replead

Petitioner is allowed time to replead the claims if it chooses to do so and believes that a valid claim, or claims, may be alleged. Petitioner is allowed until 20 days from

the date of the discovery conference to file and serve an amended pleading, failing which this proceeding will go forward on the pleadings as construed in this order.

If Petitioner files and serves an amended pleading, Respondent is allowed until 30 days from the date of an amended petition to cancel to file and serve its amended answer.

G. Respondent's Answer

Respondent's answer denies the salient allegations of the petition to cancel. The Board has previously reviewed the affirmative defenses and struck them.²

8. Availability of ACR

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("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 more detailed information about ACR at the Board's website: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. 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).

Petitioner expressed interest in use of the ACR procedure and the parties may revisit this in the future.

² 10 TTABVUE 4.

9. Discovery

There was some discussion of ways to possibly streamline discovery, but the parties did not stipulate to any measures limiting discovery at this time. They will further consider limitations on discovery in the future.

The Board explained to parties that all discovery requests should be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. The duty to supplement discovery responses continues even after the close of discovery. Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120. Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed before the deadline for submission of Further Disclosures, if any. *See, e.g.*, Trademark Rules 2.120 and 2.127. *See also, Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271 (TTAB 2017) (sustaining objection to discovery requests as untimely because answers were due after the close of discovery period).

Requests for production of documents and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120. Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.

The parties were directed to TBMP § 414 regarding the discoverability of various categories of information in Board proceedings. 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.

The parties discussed means for exchanging discovery electronically. Respondent noted that email attachments on its system are limited to 10Mb. The parties **agreed** that discovery files smaller than 10 Mb could be provided via email, but that larger files would be made available via a file service such as Dropbox or something similar.

Respondent noted that its witnesses will likely be available for deposition in the Chicago area. Petitioner expected its witnesses to be primarily in the Bay Area of California, but also expected to have witnesses in Florida and Arizona. Neither party will have witnesses located in a foreign country. Respondent reserves discussion of the use of video depositions at a later date, if appropriate, but is not inclined to use them.

10. Stipulation as to Electronically Stored Information (ESI)

The parties did not expect there to be significant ESI.

The parties **stipulated** that electronically stored information (ESI), if there is any in this case, would be provided in PDF format with the right to seek native format for the ESI if required.

11. Summary

Counts I and III-V of the petition to cancel are **stricken**.

Petitioner is allowed until 20 days from the date of the discovery conference to file and serve an amended pleading, failing which this proceeding will go forward on the pleadings as construed in this order.

If Petitioner files and serves an amended pleading, Respondent is allowed until 30 days from the date of an amended petition to cancel to file and serve its amended answer.

The parties **agreed** that discovery files smaller than 10 Mb could be provided via email, but that larger files would be made available via a file service such as Dropbox or something similar.

The parties **stipulated** that electronically stored information (ESI), if there is any in this case, would be provided in PDF format with the right to seek native format for the ESI if required.

12. Schedule

As discussed, dates are reset.

Petitioner is allowed until 20 days from the date of the discovery conference to file and serve an amended petition to cancel, failing which this proceeding will go forward on the pleadings as construed in this order.

If Petitioner files and serves an amended pleading, Respondent is allowed until 30 days from the date of an amended petition to cancel to file and serve its amended answer.

Deadline for Discovery Conference	Closed
Discovery Opens	12/10/2019
Initial Disclosures Due	1/9/2020
Expert Disclosures Due	5/8/2020

Discovery Closes	6/7/2020
Plaintiff's Pretrial Disclosures Due	7/22/2020
Plaintiff's 30-day Trial Period Ends	9/5/2020
Defendant's Pretrial Disclosures Due	9/20/2020
Defendant's 30-day Trial Period Ends	11/4/2020
Plaintiff's Rebuttal Disclosures Due	11/19/2020
Plaintiff's 15-day Rebuttal Period Ends	12/19/2020
Plaintiff's Opening Brief Due	2/17/2021
Defendant's Brief Due	3/19/2021
Plaintiff's Reply Brief Due	4/3/2021
Request for Oral Hearing (optional) Due	4/13/2021

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).