UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact No.: 571-272-8500

wbc

Mailed: December 18, 2019

Cancellation No. 92072474

Body Fit Training Company Pty Ltd

v.

Anne-Marie Houle

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 December 17, 2019.[1] Participating in the conference were Petitioner's attorney, Sheldon Klein, Respondent's attorney, Jason Preciphs, Administrative Trademark Judge Cynthia Lynch, and Board Interlocutory Attorney, Wendy Boldt Cohen.

Standard Protective Order

The Board reminded 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 reminded the parties that they may negotiate an amended protective agreement, subject to Board approval.

Related Litigation and Settlement Discussion

The parties indicated that they have engaged in initial settlement negotiations and that there is no other pending litigation in a United States

[1] The Board required Board participation in the parties' discovery conference by order dated December 3, 2019. 7 TTABVUE.

court or before the Board, between the parties. 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.

The Board has reviewed the pleadings in this case.

Petition to Cancel

Standing

In the amended petition to cancel,[2] Petitioner has adequately pleaded its standing. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP § 309.03(b) (2019); *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). That is, the statements in the amended petition to cancel, particularly paragraphs 1-4, allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. *See* 4 TTABVUE; *Empresa Cubana del Tabaco v. Gen. Cigar Co.,* 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). Further, Petitioner

[2] Petitioner's amended petition to cancel was accepted by the Board on November 5, 2019. *See* 5 TTABVUE.

has alleged that it believes its application[3] will be refused registration because of Respondent's registration. *See* 4 TTABVUE 5. These allegations are also enough to plead standing because, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. *Id*.; *see Empresa Cubana del Tabaco,* 111 USPQ2d at 1062; *Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *Universal Oil Prod. Co.*, 174 USPQ at 459.

Abandonment

Petitioner alleges that Respondent "is not currently using the mark BODYFIT in U.S. commerce on the goods"; and that Respondent has ceased use of its mark for a period of at least three years without intent to resume such use.[4] 4 TTABVUE 5. The claim of abandonment is properly pleaded. *See SaddleSprings Inc. v. Mad Croc Brands Inc*., 104 USPQ2d 1948, 1950 (TTAB 2012); *Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1875 (TTAB 2010).

Answer

In its answer, Respondent denies the salient allegations of the petition to cancel. *See* 6 TTABVUE. Respondent additionally enumerates three "affirmative defenses". *See* 6 TTABVUE 3-4. The first "affirmative defense" is

[3] In the amended petition to cancel, Petitioner noted that "due to a typographical error," its relied upon application was entered as application Serial No. 886**14**919 instead of 886**41**919. 4 TTABVUE 2.

[4] To properly plead a claim of abandonment, a party must allege (1) at least three consecutive years of nonuse, or (2) a period of nonuse less than three years coupled with an intent not to resume use. *See* Trademark Act § 45, 15 U.S.C. § 1127; *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990).

failure to state a claim. For the reasons already noted herein, Petitioner has adequately pleaded its standing and its claim of abandonment.

Respondent's second and third "affirmative defenses"[5] are asserted in a conclusory fashion without giving any facts for which Respondent's defenses are based and thus, Respondent has failed to 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).

Because these "affirmative defenses" gives Petitioner a more complete picture and notice of Respondent's position, the Board treats these allegations as amplifications of Respondent's denials. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 USPQ2d 1570 (TTAB 1988). If Respondent wishes to later amend its pleading to raise any affirmative defenses or otherwise, it will need to do so pursuant to Fed. R. Civ. P. 15. *See* Trademark Rule 2.107; TBMP § 507.[6]

ACR

As noted in the Board's December 3, 2019 order, this proceeding has been identified as a possible candidate for Accelerated Case Resolution ("ACR") given the matters at issue following the filing of Respondent's answer, namely

[5] The defenses asserted are laches, waiver and estoppel. 6 TTABVUE 3-4.

[6] "The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02 and cases cited therein.

that the claims at issue are limited to abandonment. During the conference, Judge Lynch discussed the possible application of ACR in view of the parties' pleadings.[7]

The parties indicated that they are interested in ACR and plan to explore the available options at a later date. Initially, however, the parties have agreed that initial disclosures will not be required; the Board's schedule below reflects this agreement.

Discovery

The Board expects that the parties will cooperate with one another in the discovery process and seek only discovery that is relevant to the disputed issues in the case. The parties should keep in mind that discovery must be proportionate to the needs of the case. Fed. R. Civ. P. 26(g).

Because there is a protective order in place, the parties should not assert confidentiality objections in response to discovery requests. Rather, discovery should be produced subject to the appropriate tier of confidentiality under the standard protective order. The parties also should refrain from asserting

[7] Parties requesting ACR may stipulate to a variety of matters to accelerate disposition of a 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. *See, e.g., Chanel Inc. v. Makarczyk,* 110 USPQ2d 2013 (TTAB 2014) and 106 USPQ2d 1774 (TTAB 2013); *Target Brands, Inc. v. Hughes,* 85 USPQ2d 1676, 1678 (TTAB 2007). The parties are directed to review the Board's website regarding ACR and TBMP §§ 528.05(a)(2) and 702.04. If the parties later agree to pursue ACR, they should notify the interlocutory attorney assigned to this proceeding.

boilerplate or blanket objections. Fed. R. Civ. P. 34(b)(2)(B); *Metronic, Inc. v. Pacesetter Sys., Inc.,* 222 USPQ 80, 83 (TTAB 1984). If a party asserts privilege in response to a discovery request, the party must produce a privilege log. *Amazon Techs. Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009); *No Fear Inc. v. Rule,* 54 USPQ2d 1551, 1556 (TTAB 2000).

Schedule

Proceedings are resumed and dates are reset as follows:

Discovery Opens	December 20, 2019
Expert Disclosures Due	May 18, 2020
Discovery Closes	June 17, 2020
Plaintiff's Pretrial Disclosures Due	August 1, 2020
Plaintiff's 30-day Trial Period Ends	September 15, 2020
Defendant's Pretrial Disclosures Due	September 30, 2020
Defendant's 30-day Trial Period Ends	November 14, 2020
Plaintiff's Rebuttal Disclosures Due	November 29, 2020
Plaintiff's 15-day Rebuttal Period Ends	December 29, 2020
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	February 27, 2021
Defendant's Main Brief Due	March 29, 2021
Plaintiff's Reply Brief Due	April 13, 2021

General Information

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).