

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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SKS

January 18, 2020

Cancellation No. 92072748

*Carmelo DI SANO, Salvatore DI SANO and  
Biagio DI SANO*

*v.*

*Arclusa Inc.*

**Shanna K. Sanders, Interlocutory Attorney:**

The answer to the petition to cancel was due December 24, 2019. Arclusa Inc. (“Respondent”) filed a communication on December 23, 2019.

The Board presumes that this communication is intended as Respondent’s answer to the petition to cancel. However, said communication does not comply with Fed R. Civ. P. 8(b), which is made applicable this proceeding by Trademark Rule 2.116(a).

Fed. R. Civ. P. 8(b) provides, in part:

(b) Defenses; Admissions and Denials.

(1) *In General.* In responding to a pleading, a party must:

(A) state in short and plain terms its defenses to each claim asserted against it; and

(B) admit or deny the allegations asserted against it by an opposing party.

(5) *Lacking Knowledge or Information.* A party that lacks knowledge or information sufficient to form a belief about the truth of an allegation must so state, and the statement has the effect of a denial.

The petition to cancel filed by Carmelo Di Sano, Salvatore Di Sano and Biagio Di Sano (“Petitioners”) consists of ten paragraphs setting forth the basis of Petitioners’ claim of damage. In accordance with Fed. R. Civ. P. 8(b), Respondent must answer the petition to cancel **by specifically admitting or denying the allegations contained in each paragraph. If Respondent is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it should so state and this will have the effect of a denial.** Trademark Rule 2.114(b)(2).

In view of the foregoing, Respondent is allowed until **thirty days from the date of this order** in which to file through ESTTA pursuant to Trademark Rule 2.114(b)(1)<sup>1</sup>, and serve pursuant to Trademark Rule 2.119(b), an answer which complies with Fed. R. Civ. P. 8(b).<sup>2</sup>

Accordingly, conference, disclosure, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	3/18/2020
Discovery Opens	3/18/2020
Initial Disclosures Due	4/17/2020
Expert Disclosures Due	8/15/2020
Discovery Closes	9/14/2020
Plaintiff’s Pretrial Disclosures Due	10/29/2020

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<sup>1</sup> Instructions and forms for filing through ESTTA are available at <http://estta.uspto.gov>. All Board proceeding files can be viewed via TTABVUE at <http://ttabvue.uspto.gov>.

<sup>2</sup> The Board notes that Respondent’s communication filed on December 23, 2019 is entitled “notice of opposition” and contains allegations related to Petitioners’ pleaded applications, which are pending before the examining attorney. To be clear, Petitioners’ pleaded applications are not before the Board. The Board has no jurisdiction over a pleaded application that is still pending before an examining attorney. *See Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986). Thus, a counterclaim to refuse a petitioner’s pending application is improper in view of the Board’s lack of jurisdiction over such applications. *See Int’l Tel. and Tel. Corp. v. Int’l Mobile Mach. Corp.*, 218 USPQ 1024, 1026 (TTAB 1983).

Plaintiff's 30-day Trial Period Ends	12/13/2020
Defendant's Pretrial Disclosures Due	12/28/2020
Defendant's 30-day Trial Period Ends	2/11/2021
Plaintiff's Rebuttal Disclosures Due	2/26/2021
Plaintiff's 15-day Rebuttal Period Ends	3/28/2021
Plaintiff's Opening Brief Due	5/27/2021
Defendant's Brief Due	6/26/2021
Plaintiff's Reply Brief Due	7/11/2021
Request for Oral Hearing (optional) Due	7/21/2021

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).

- **Proof of Service**

Respondent's proof of service attached to its December 23, 2019 communication indicates that Petitioners were served via First Class Mail. However, Trademark Rule 2.119(b) states that every submission filed in an inter partes proceeding must be served upon the other party or parties by email, unless otherwise stipulated. In

order to expedite this matter, Petitioners are directed to the following URL where it may view a copy of the filing: <http://ttabvueint.uspto.gov/ttabvue/v?pno=92072748&pty=CAN&eno=4>. Copies of all submissions filed in this proceeding **must** be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 113.03 (June 2019). The statement, whether attached to or appearing on the submission when filed, 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 mailing), via email (or insert other appropriate method of delivery) to: (set out name, and address or 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/>.

- **Information for Pro Se Party**

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.

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/appealingtrademark-decisions/standard-documents-and-guidelines-0>.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx.865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008).

This inter partes proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. Trademark Rules §§ 2.122–2.125 govern the trial evidence and testimony. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written

transcripts thereof, together with any exhibits thereto, are then filed with the Board. Additionally, the testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to 37 C.F.R. § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness. *See* Trademark Rule 2.123(a)(1), 37 C.F.R. § 2.123(a)(1). No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.