

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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March 9, 2020

Cancellation No. 92073076

*InTouch Technologies, Inc. dba InTouch  
Health*

*v.*

*GlobalMedia Group, LLC DBA GlobalMed*

**M. Catherine Faint,  
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 March 3, 2020 with Board participation. Participating in the conference were Petitioners' counsel, Joshua G. Gigger, Atty.; and Respondent's counsel, Michael B. Dvoren, Atty. Also before the Board was Petitioner's motion to strike four of Respondent's five affirmative defenses. *See* TBMP § 506.02 (2019). 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 informed the Board that there had been some brief settlement discussions but they had been unsuccessful so far.

Respondent's counsel raised the issue of early production of Petitioner's evidence of use of the XPRESS mark by itself to aid in settlement efforts.

**A. 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 remain 30 days. Similarly, deadlines for responses to discovery requests are 30 days.

**B. The 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.

The parties agreed to submit a signed copy of the standard protective order within 30 days of the teleconference, although the parties may also discuss whether there are any amendments they wish to make to the protective order. Mr. Dvoren will submit a signed copy to Mr. Gigger, who will sign and file it with the Board.

### **C. Electronic Resources**

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, may be accessed via the Board's website: <http://estta.uspto.gov/>. Addresses can be changed easily through an electronic form. Also, consented motions to extend or suspend can be filed and normally an automatic grant of the motion will be generated.

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 should monitor the electronic system regularly to be sure that no filings are missed.

### **D. 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, although discovery may not be served prior to the

opening of the discovery period. The Board views this as a means to aid settlement discussions between the parties.

### **E. Review of Pleadings/Motion to Strike**

#### **a. Petition to cancel**

Reviewing the petition to cancel, Petitioners' claims are likelihood of confusion under Trademark Act § 2(d), and express abandonment.

Petitioner has alleged common law rights in the marks XPRESS and INTOUCH XPRESS in connection with, "remotely controlled portable system for use in wireless telecommunications comprised of computer hardware, computer software, monitors and cameras to transmit 2-way audio and video communications and other electronic data with an accessory cart," in Classes 9 and 10, and "services related to delivering data and images from the system to remote computers over the internet," in Classes 38 and 42. Petitioner has essentially alleged that Respondent is a competitor.

Petitioner has the burden of proof in this proceeding. A likelihood of confusion determination under Trademark Act § 2(d) is based on an analysis of the priority of use claim and of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *duPont* factors). *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. *In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Petitioner has adequately alleged standing and the ground of priority and likelihood of confusion. Proof of the matter is left to trial or final decision.

As to abandonment, Petitioner alleges Respondent expressly abandoned its mark in response to Petitioner's emails in 2017 without intent to resume use. The petition to cancel was filed December 31, 2019 and does not allege that Respondent's mark, which registered July 31, 2018, has not been in use for at least three years. A prima facie case of abandonment requires a showing of three consecutive years of non-use; therefore, as three years of nonuse is not pled, the presumption of abandonment is inapplicable, and Petitioner "must affirmatively establish a prima facie case by a preponderance of the evidence that [Respondent] discontinued use of the mark with the intent not to resume use." *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409 at \*15, 2019 BL 377409 (TTAB 2019); *see also FirstHealth of Carolinas, Inc. v. CareFirst of Md., Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1922 (Fed. Cir. 2007).

**b. Answer, Affirmative Defenses and Motion to Strike**

Respondent has answered the petition to cancel denying the salient allegations and asserting five "affirmative defenses." Petitioner filed and served on February 19, 2020, a motion to strike the first, second, fourth and fifth affirmative defenses. The Board carefully considered the arguments raised, as well as the supporting correspondence and the record of this case, in coming to a determination regarding affirmative defenses. During the telephone conference, the parties were each allowed to make further statements, and the Board made the following findings and determinations.

**1. First Affirmative Defense**

The first affirmative defense alleges the petition to cancel fails to state a claim

upon which relief can be granted. This is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading rather than a statement of a defense to a properly pleaded claim. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Here Petitioner has alleged common law rights in and a likelihood of confusion with its mark as a competitor of Respondent's. The pleading of a belief in damage is adequate for pleading standing. Also Opposer has adequately alleged grounds for relief. Accordingly, the first affirmative defense is **stricken**.

## 2. Second and Fourth Affirmative Defenses

In the affirmative defense at paragraph two, Respondent makes bald assertions of laches, and/or estoppel. Similarly at paragraph four, Respondent alleges Petitioner does not have valid trademark rights in any trademark that is the same or similar to Respondent's mark, but does not plead a factual basis for invalidity. Bald, conclusory allegations are insufficient to provide Petitioner with adequate notice of the bases for the defenses. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). A pleading of a defense must include enough factual detail to provide Petitioner fair notice of the defense. Fed. R. Civ. P. 8(b)(1); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (the primary purpose of pleadings "is to give fair notice of the claims or defenses asserted").

Further, the equitable defenses of laches and estoppel and are not available against a claim of abandonment. While invalidity may be a valid defense against

likelihood of confusion where there is not a current registration, the defense at paragraph four does not assert any facts on which to base the defense. Accordingly paragraphs two and four are **stricken**. *See, e.g., Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (“It is well established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud, and abandonment.”); *Salacuse v. Ginger Spirits, Inc.*, 44 USPQ2d 1415, 1419 (TTAB 1997) (allowing invalidity defense to challenge petitioner’s pleaded applications); *American Vitamin Prods., Inc. v. DowBrands, Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (equitable defenses, such as unclean hands, unavailable against abandonment claims).

### **3. Fifth Affirmative Defense**

The fifth affirmative defense “reserves the right” to assert defenses in the future. A defendant cannot reserve some unidentified defenses, because such a “reservation” does not provide plaintiff with fair notice of any such defenses. Whether or not Respondent may, at some future point, add an affirmative defense would be resolved by way of a motion to amend for Board approval. *See* Fed. R. Civ. P. 15(a). Accordingly, to the extent Respondent asserts a “reservation of rights” as an Affirmative Defense, it is hereby **stricken**.

### **4. Third Affirmative Defense**

For the sake of completeness, the Board reviewed Respondent’s third affirmative defense and noted it is more in the nature of amplification of Respondent’s denials as to the lack of a likelihood of confusion. *See Morgan Creek Prods., Inc. v. Foria Int’l*,

*Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant’s “affirmative defenses” amplified its denials of opposer’s allegations regarding likelihood of confusion); *Humana, Inc. v. Humanomics, Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading “affirmative defenses” were arguments in support of denial of claim rather than true affirmative defenses and were treated as such).

### **5. Decision on Motion to Strike**

Petitioner’s motion to strike is **granted** as to the first, second, fourth and fifth affirmative defenses. Respondent is allowed until **30 DAYS** from the date of this discovery conference to file an amended answer repleading its second and fourth affirmative defenses, if appropriate, failing which this proceeding will go forward on the pleadings as construed herein.

### **F. Accelerated Case Resolution (“ACR”)**

The Board encourages settlement of matters between the parties and the parties are continuing to discuss settlement at this time. While the Board does not conduct settlement conferences, there is an 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 the more detailed information about ACR at the Board’s website.

Counsel indicated that they may be interested in the ACR procedure and were to discuss it further with their clients and review TBMP § 528.05(a)(2) over the next few weeks. 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). The Board advises the parties that if the parties agree to pursue ACR, they should notify the Board in writing as soon as possible. The parties may also enter other stipulations, as discussed, to streamline the trial procedure or final decision.

#### **F. Discovery**

There was some discussion of ways to possibly streamline discovery, but the parties did not stipulate to any measures limiting discovery.

The parties did not expect there to be much in the way of Electronically Stored Information (ESI), although they were still exploring this. Petitioner's counsel was to send a document about ESI formats to Respondent's counsel and they will discuss. The parties believe that if any discovery issues arise, they can likely resolve any such issues amongst themselves.

The Board explained to the parties that all discovery requests should be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120, 37 C.F.R. § 2.120. The Board has clarified that this means 31 days prior to the close of discovery. *Estudi Moline Dissey, S.L. v. BioUrn, Inc.*, 123 USPQ2d 1268, 1270 (TTAB 2017) (discovery requests must be served with at least thirty-one days remaining in the discovery period, including date of service, regardless of whether day of service falls on weekend or holiday). 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 day of the deadline for pretrial disclosures. Trademark Rules 2.120 and 2.127. *See Asustek Comput., Inc. v. Chengdu Westhouse Interactive Entm't Co.*, 128 USPQ2d 1470, 1471 (TTAB 2018) (reconsideration of Board order denying untimely motion to compel filed on deadline for pretrial disclosures denied). 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. TBMP § 414 provides an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

The Board advised the parties that they may adopt various measures to limit the scope of discovery and also stipulate to the authenticity of documents. No further limitations on discovery were agreed to at this time.

### **G. Summary and Schedule**

The parties agreed to submit a signed copy of the standard protective order within 30 days of the teleconference, although the parties may also discuss whether there are any amendments they wish to make to the protective order. Mr. Dvoren will submit a signed copy to Mr. Gigger, who will sign and file it with the Board.

Petitioner's motion to strike is **granted** as to the first, second, fourth and fifth affirmative defenses. Respondent is allowed until **30 DAYS** from the date of the discovery conference to file an amended answer repleading its second and fourth affirmative defenses, if appropriate, failing which this proceeding will go forward on the pleadings as construed herein.

Dates are reset as set out below.

Time to File Amended Answer, if any	4/2/2020
Deadline for Discovery Conference	CLOSED
Discovery Opens	5/2/2020
Initial Disclosures Due	6/1/2020
Expert Disclosures Due	9/29/2020
Discovery Closes	10/29/2020
Plaintiff's Pretrial Disclosures Due	12/13/2020
Plaintiff's 30-day Trial Period Ends	1/27/2021
Defendant's Pretrial Disclosures Due	2/11/2021
Defendant's 30-day Trial Period Ends	3/28/2021
Plaintiff's Rebuttal Disclosures Due	4/12/2021
Plaintiff's 15-day Rebuttal Period Ends	5/12/2021
Plaintiff's Opening Brief Due	7/11/2021
Defendant's Brief Due	8/10/2021
Plaintiff's Reply Brief Due	8/25/2021
Request for Oral Hearing (optional) Due	9/4/2021

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).

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