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: May 31, 2017

Cancellation No. 92060308

SFM, LLC

v.

Corcamore, LLC

Robert H. Coggins,
Administrative Trademark Judge:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding held the mandatory settlement and discovery conference at 10:00 a.m. EDT on May 31, 2017. *See* TBMP § 401.01 (Jan. 2017). Board participation was requested by Petitioner. Participating in the conference were Christian Stahl, counsel for Petitioner; Charles L. Thomason, counsel for Respondent; and Robert Coggins, judge for the Board.[1]

Similar Proceedings

The parties stated that they are not currently involved in any civil litigation involving the subject or pleaded marks. Petitioner and a third-party, Sprout Retail, Inc., which is alleged to be in privity with Respondent through common ownership, are involved in Cancellation No. 92061193. Due to the current procedural posture of

[1] Also on the line was Louis Klapp, counsel for Petitioner.

Cancellation No. 92061193, which is suspended pending a show cause order under Trademark Rule 2.134(b), the Board did not consolidate Cancellation Nos. 92060308 and 92061193 at this time. The Board discussed the possibility of future consolidation, especially in view of the Section 18 counterclaim for restriction pleaded in Cancellation No. 92061193 and the defense seeking restriction in Cancellation No. 92060308.

Nature of Board Proceedings

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, disclosures, discovery, a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts of oral testimony, or affidavit or declaration testimony if used, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

Resources

The Board informed the parties that they may access many legal resources, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP),[2] Trademark Rules of Practice, the revised standard protective order, and the Office's

[2] Chapters 400-800 of the TBMP may be of the most interest to the parties. Chapter 400 describes disclosures, written discovery, and discovery depositions; Chapter 500 describes motions practice; Chapter 600 describes settlement; and Chapter 700 describes trial procedure and introduction of evidence.

FOIA page for access to Board case summaries at the Board's home (http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab). The parties have used the ESTTA filing system and TTABVUE and are familiar with those electronic systems.

Settlement

The parties stated that they had previously, although not recently, discussed the possibility of settlement. The parties remain open to settlement and briefly discussed their respective settlement positions. It did not appear during the conference that the case would currently benefit from a suspension of proceedings, but the parties stated that they would continue to discuss settlement outside the presence of the Board.

E-mail Service

The parties were reminded of their obligation to serve each submission filed with the Board. Pursuant to Trademark Rule 2.119(b), service must be made by email. Petitioner's email addresses for service are christian.stahl@quarles.com and louis.klapp@quarles.com, and Respondent's email addresses for service is thomason@spatlaw.com. Petitioner's change of email correspondence address (filed May 16, 2017) was noted.

Pleadings

It was previously determined in this proceeding that the First Amended Petition for Cancellation sufficiently alleges Petitioner's standing and a single ground for cancellation, namely, priority and likelihood of confusion. Upon review of the Answer, the Board determined that Respondent had fairly and clearly met the allegations in

the amended petition. Inasmuch as a party alleged to be in privity with Respondent has filed in Cancellation No. 92061193 a Section 18 counterclaim for restriction of Petitioner's pleaded Registration No. 3322841 (*see* 13 and 16 TTABVUE, in Cancellation No. 92061193), the defense in the Answer of Cancellation No. 92060308 seeking to restrict Petitioner's pleaded registrations was construed against only Registration No. 3322841 under Trademark Rule 2.133(d).[3]

Discovery

The parties were advised that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings. Not all of the topics will be relevant to the sole pleaded ground in this proceeding.

Standard protective order

The Board's revised standard protective order is automatically applicable to this proceeding pursuant to Trademark Rule 2.116(g). Although they are not required to do so, the Board recommends that parties exchange executed copies of the order. If the parties wish to modify the order in any manner, they must file a motion for the Board's approval of the modification(s).

Scope of discovery

The Board briefly mentioned the use of interrogatories, requests for admission, requests for production of documents and things, and depositions as discovery devices. Discovery should focus on priority and likelihood of confusion of the

[3] Rule 2.133(d) provides that "[a] plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith."

respective marks. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973).

Discovery may not be served until the discovery period opens and the serving party has made initial disclosures. Any discovery served in this proceeding prior to the opening of the discovery period is premature and the party upon whom it was served need not respond thereto. All written discovery requests must be served early enough in the discovery period so that responses will be due no later than the close of discovery. The recent amendments to the Federal Rules of Civil Procedure (e.g., proportionality and relevance in discovery) affect Board proceedings.

Electronically stored information

In general, production of electronically stored information ("ESI") is not an issue in Board cases, likely due to the Board's limited jurisdiction to determine only the right to a registration and due to the public nature of trademarks. However, if the parties anticipate or encounter a problem, they should work together to resolve the matter. Petitioner raised several issues regarding the way (e.g., labeling and format) documents might be produced, and the parties stated that they would discuss the parameters for producing documents in discovery.

Initial Disclosures

Initial disclosures are: 1) the identity of witnesses likely to have discoverable information and 2) the description and location of documents and things having or containing relevant information. More particularly, and as provided for by Fed. R. Civ. P. 26(a)(1)(A)(i) & (ii), those disclosures are:

> (i) the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;
>
> (ii) a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Disclosures should not be filed with the Board except under specific, limited circumstances. *See* Trademark Rule 2.120(k)(8). The parties were reminded of the obligation to supplement disclosures under Fed. R. Civ. P. 26(e)(1).

Accelerated Case Resolution (ACR)

The Board appreciated the parties' interest in and discussion of ACR, and encouraged the parties to review TBMP §§ 528.05(a)(2), 702.04, and 705 for more information on ACR.

Schedule

Dates remain as set.

Sanction Lifted

After consideration during the conference, the procedural sanction imposed by the Board's December 30, 2015 order against Respondent was lifted. The Board may, however, reconsider the application of procedural sanctions against either party, as necessary. Similarly, if it appears to the Board that a motion may be resolved by a telephone conference involving the parties, the Board may, upon its own initiative or upon request made by a party, convene a conference to hear arguments on and to resolve the motion by telephone. *See* TBMP §§ 413.01 and 502.06(a).