

**Strafford**

*presents*

# **TTAB Accelerated Case Resolution: Recent Trends in Trademark Cases**

## **Evaluating and Leveraging ACR Procedures to Expedite Litigation**

### **A Live 90-Minute Teleconference/Webinar with Interactive Q&A**

**Today's panel features:**

Honorable Peter W. Cataldo, **Trademark Trial and Appeal Board, U.S. Patent and Trademark Office**, Alexandria, Va.

David M. Kelly, Partner, **Finnegan, Henderson, Farabow, Garrett & Dunner, LLP**, Washington, D.C.

Stephanie H. Bald, Attorney, **Finnegan, Henderson, Farabow, Garrett & Dunner, LLP**, Washington, D.C.

### **Wednesday, September 29, 2010**

The conference begins at:

**1 pm Eastern**

**12 pm Central**

**11 am Mountain**

**10 am Pacific**

You can access the audio portion of the conference on the telephone or by using your computer's speakers.

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September 29, 2010



# Accelerated Case Resolution (ACR) and Other Options for Streamlining TTAB Cases

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# Opportunities Abound

- Settlement and Discovery Planning Conference
- Accelerated Case Resolution
- Phone Conferences with Interlocutory Attorney
- Stipulations of Fact
- Stipulations as to Procedure



# Early Settlement Talks

- Two-thirds of TTAB cases are disposed of without an answer being filed
- During early settlement talks consider informal proffers of proof
- Discuss ACR and other options for streamlining case



# Discovery Conference

- Authorities:
  - Trademark Rules 2.120(a)(1), (a)(2)
  - Fed. R. Civ. P. 26(f)
  - *Notice of Final Rulemaking*, 72 Fed. Reg. 42242, 42245 (Aug. 1, 2007)  
[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf)



# Discovery Conference

- TTAB's amended rules require parties to engage in settlement and discovery planning conference within 30 days of answer
- Parties have “equal responsibility” to conference by deadline
  - *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701 (TTAB 2008)
- Scheduling problems? Contact the Board



# Discovery Conference

- TTAB participation (by phone) on request of any party by phone or ESTTA
  - No later than ten (10) days before conference deadline
- Interlocutory Attorney may expand or reduce number or nature of subjects
  - *Automedx, Inc. v. Artivent Corp.*, Opp. No. 91182429 (TTAB Apr. 23, 2008)
  - *Caterpillar Inc. v. TDE Consulting Group*, Opp. No. 91181909 (TTAB May 21, 2008)



# Prepare for Conference

- Will you seek Board participation? Why?
  - Board participated in 64 FY08, 74, FY09; half in FY09 involved pro se party and nearly 90 percent a 2(d) claim
- Benefits of Board participation:
  - Will address jurisdiction, insufficiency or inapplicability of claims, defenses; can review burdens of proof



# Benefits, continued

- Can discuss applicable rules, authorities and remind pro se parties of obligations
- Can discuss scheduling issues
- Can discuss expectations of parties
- Can discuss application and utilization of standard protective order
- Can discuss procedural options



# Conferencing

- Discuss Accelerated Case Resolution (ACR) and possible tailoring of a discovery plan
- Discuss Alternative Dispute Resolution, Mediation, Arbitration
- Discuss stipulations of fact, procedure
- Discuss disclosure of expert witnesses and reports



# Conferencing

- Be prepared to discuss settlement options such as amendment of an identification or mark, restrictions on use (e.g., with a house mark)
- Look for areas of agreement and *genuine* disagreement



# Thinking Ahead

- How will you use settlement/discovery planning conference to streamline proceedings?
- Do you want to use Accelerated Case Resolution (ACR)?
- Other streamlined discovery/trial procedures?
- Stipulate to certain facts/evidence?



# ACR

- Most attractive option when parties can stipulate to many facts, or some facts so that remaining evidence limited
- Parties file cross-motions for summary judgment and briefs, evidence
- Stipulate Board can resolve any lingering issues of fact



# ACR

- Parties can revisit ACR option after disclosures and some discovery, but should do so early in discovery
- Board will issue decision within 50 days of briefing under ACR
- Decision is immediately appealable



# Parties Agreed to ACR

- *philosophy, inc. v. Amansala USA, LLC* (91190154): Parties' stipulation to proceed by ACR was filed shortly after deadline for serving initial disclosures, but without such disclosures having been filed.
- *Anheuser-Busch, Inc. v. BLhUE, Inc.* (91184562): After answer and at deadline for initial disclosures opposer filed consented motion to proceed by ACR, noting only that the parties had agreed to allow Board to resolve genuine issues of material fact.



# Parties Agreed to ACR

- *Get It In Writing Inc. v. IQ in Tech, Inc. and Get It In Writing, Inc.* (92046274): Case commenced more than a year prior to amendment of Board rules for inter partes cases. After MSJ, parties moved for ACR and asked that their cross-motions for SJ be treated as briefs and that any evidence of record in motions be deemed properly of record.
- *Merelinda Farms L.L.C. DBA Alpaca.com L.L.C. v. The American Breeders Co-op* (91167038).
- Both cases decided on merits via ACR



# Parties Agreed to ACR

- *Cantine Leonardo Da Vinci S.c.r.l. v. Helwig Tasting Room, LLC* (91192075) (August 11, 2010): Parties agreed to ACR after Answer filed; filed joint stipulation for accelerated/shortened schedule, declaration testimony, standing, priority, and other facts; and reserved right to object to admissibility of evidence and testimony on any grounds available under Fed. R. Evid.



# Parties Agreed to ACR

- *Kelly v. Citystay Hotels, LLC* (92048998) (April 28, 2010): Parties agreed to ACR 18 months after complaint filed and after extensive discovery motion practice; parties agreed that stipulations, affidavits, and exhibits serve as testimony and evidence for trial, and that business/office records, matters of public record, and discovery depositions excerpts may be filed under notice of reliance.



# Final Decisions via ACR

- *Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511 (TTAB 2009) (91180015) (opposition sustained).
- *Direct Marketing Consultants, LLC v. Wise-Buys, Inc.* (92049014) (petition dismissed).
- *Facing the World v. Dan Maerovitz* (91181253) (opposition sustained).
- *M2 Software, Inc. v. M2 Communications, Inc.* (91158118) (ACR case final decision dismissing opposition nonprecedential; affirmed 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006)).



# Streamlining Discovery

- Make more use of disclosures of core information and less use of formal discovery
- Forgo discovery depositions or allow either party to introduce discovery deposition as testimony
- See TBMP Section 414 (2d ed. Rev. 2004)
- See NPRM at 71 FR 2498, 2501 (January 17, 2006)



# Streamlining Discovery

- “The parties may stipulate to a shortening of the discovery period.” Trademark Rule 2.120(a)(2)
- Stipulate to limits on interrogatories, requests for admissions, requests for production
- Use fewer interrogatories



# Streamlining Discovery

- *Factory Five Racing, Inc. v. Carroll Shelby and Carroll Hall Shelby Trust* (91150346): Parties stipulated that either could introduce “previously-taken discovery depositions” of three individuals “including the depositions taken in” two district court cases. Stipulation included reservation of right by applicant to take further testimony from two of these witnesses during trial of the opposition, and of opposer’s right to cross-examine them.



# Stipulations of Fact

- *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007) (Opposition No. 91163556)
- Opposer used ULTIMATE POLO descriptively; applicant claimed acquired distinctiveness
- Entire record stipulated, including business records, government documents, marketing and Internet materials



# Stipulations of Fact

- Stipulated to 13 paragraphs of facts
- Applicant's dates of first use
- Extent and manner of applicant's use
- Channels of trade for applicant
- Recognition by others of applicant's use
- Dates, nature and extent of descriptive use by opposer's parent



# Stipulations of Fact

- See also, *Hachette Filipacchi Presse v. Ev International, LLC* (Opp. 91174433)
- 16-pages, 36 paragraphs of stipulated facts and accompanying exhibits
- Facts in document and exhibits true and undisputed and exhibits genuine
- No objections to truth, admissibility even on appeal or de novo appeal



# Stipulations of Fact

- *Christopher Brooks v. Creative Arts by Calloway, LLC*, 93 USPQ2d 1823 (TTAB 2009) (91160266): Board issued short order approving a stipulation to submit testimony of certain witnesses in declaration form. Further stipulations followed but were not addressed until the final decision. These included stipulation to fourteen paragraphs of particular facts, that the sole issue for the Board to decide was opposer's priority, and that opposer's testimony on priority (with exhibits) could be submitted in affidavit form.



# Procedural Stipulations

- Stipulate to record or portion of record, but reserve right to object on bases of relevance, materiality, probative value
- Stipulate to authenticity of business records produced in response to requests for production and that each party can introduce them by Notice of Reliance



# Procedural Stipulations

- Stipulate to testimony by affidavit or declaration (with or without reservation of right to live cross examination)
- Stipulate to telephone depositions
- Stipulate to limit the number of testimony witnesses



# Procedural Stipulations

- Stipulate to introduction of report of expert witness and necessary supporting materials by Notice of Reliance; and to introduction of same by any countervailing expert; reserve rights to live cross-exam if needed
- Stipulate to opt out of pretrial and expert disclosures, and shorten time periods, subject to approval of TTAB



# ACR “Plug and Play”

- TTAB considering possible “Plug and Play” options for ACR



# Closing Reminders

- Board trials do *not* have to be filled with tribulations
- Think about what possible approaches would be most efficient and economical for you and your client
- Think creatively of options
- Act cooperatively in search of merits