UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Goodman

Mailed: April 8, 2003

Opposition No. **91117894**

LEO STOLLER D/B/A CENTRAL MFG and CENTRAL MFG CO., joined as party plaintiff[1]

v.

SUTECH U.S.A., INC.

Before Walters, Chapman and Bucher, Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of the parties' cross-motions for summary judgment. The motions are fully briefed.

A brief review of the history regarding the filing of these motions is in order.

The Board has no record of receiving opposers' motion for summary judgment, allegedly filed via certificate of mailing on September 6, 2002. On September 24, 2002, applicant filed a consented request to extend its time to respond to opposers' motion for summary judgment up to and

[1] Both parties are reminded that the Board order of September 9, 2002 amended the caption of this proceeding to join Central Mfg. Co. as a party plaintiff. All future filings of the parties should use the proper caption as shown above.

including October 18, 2002. On October 24, 2002, the Board granted applicant's motion to extend and, now notified of the existence of a motion for summary judgment, suspended proceedings pending disposition of summary judgment. The October 24, 2002 Board order also requested that opposers fax a copy of the summary judgment motion to the Board. On October 17, 2002, applicant filed its response and cross-motion to opposers' motion for summary judgment, and on November 18, 2002, opposers filed their response to applicant's cross-motion for summary judgment. It was not until November 25, 2002, that opposers provided the Board with a "Verified Motion for Summary Judgment with Supporting Memorandum and Request for Oral Hearing on Motion" and "Opposer's [sic] Verified Amended Memorandum in Support of Its Motion for Summary Judgment".

In applicant's reply, filed December 5, 2002, applicant advised the Board that opposers had not provided a true and accurate copy of the original September 6, 2002 summary judgment motion; and that instead, opposers had "unilaterally decided to make changes and amendments as it wished." Applicant specifically requested that the Board "admonish or sanction opposer for making amendments or changes to its motion after applicant had filed its response in opposition to this motion." Additionally, applicant requested that the Board impose Rule 11(b) sanctions on

applicant for its "slanderous attack on applicant and a personal attack on applicant's counsel" as allegedly contained in opposers' response to applicant's cross motion for summary judgment.

The Board will first consider applicant's request for sanctions. We note that Rule 11 sanctions would not be appropriate inasmuch as applicant did not comply with the safe harbor provisions required by Fed. R. Civ. P. 11(c)(1)(A). However, the Board has the inherent authority to sanction a party based on the conduct undertaken in a proceeding. *See Carrini, Inc. v. Carla Carini* S.R.L., 57 USPQ2d 1067, 1070 (TTAB 2000). We find that some form of sanction is appropriate here inasmuch as opposers were ordered by this Board to provide a copy of their previously filed motion and opposers did not do so. In fact, opposers filed an entirely new paper entitled "amended motion."

Accordingly, in view of opposers' failure to provide a copy of their original motion for summary judgment (allegedly filed via certificate of mailing on September 6, 2002), the Board will not consider either of the summary judgment papers filed by opposers on November 25, 2002, specifically, opposers "Verified Motion for Summary Judgment with Supporting Memorandum and Request for Oral Hearing on Motion" and "Opposer's [sic] Verified Amended Memorandum in Support of Its Motion for Summary Judgment."

Therefore, the only summary judgment issue before the Board is applicant's motion for summary judgment, which has been briefed by the parties.

Before considering applicant's motion, we note that (i) opposers' amended notice of opposition[2], filed on June 4, 2002, supersedes the original pleading and is the operative notice of opposition in this proceeding, and (ii) applicant's answer filed on September 30, 2002 in response to opposers' amended pleading is the operative answer herein. Therefore, to the extent that applicant is moving for summary judgment on an unpleaded ground that was in the original pleading but not in the amended notice of opposition, applicant's motion for summary judgment must be denied. See Fed. R. Civ. P. 56(a) and 56(b); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994); and TBMP Section 528.07(a) and cases cited therein.

Further, after careful review of the arguments and supporting papers of the parties, we find that there are genuine issues of material fact as to any and all pleaded grounds. Accordingly, applicant's motion for summary judgment is hereby denied.

[2] Opposers filed their motion for leave to amend their pleading accompanied by a signed copy of the pleading on June 4, 2002, and the Board granted the motion as conceded on September 9, 2002.

Additionally, applicant seeks dismissal[3] of the dilution claim in opposers' June 4, 2002 amended notice of opposition. In order to properly plead dilution, opposers are required to allege, inter alia, when their mark(s) became famous. *See Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000). Opposers have not done so in the June 4, 2002 amended notice of opposition.[4]

In view thereof, applicant's request to dismiss opposers' dilution claim under Fed. R. Civ. P. 12(b)(6) as not properly pleaded is hereby granted.

Opposers are allowed until THIRTY DAYS from the mailing date of this order to file an amended pleading properly setting forth a dilution claim, failing which, the ground of dilution will be considered stricken.

If opposers file an amended notice of opposition in accordance with this order, then applicant is allowed until

[3] On page 23 of its "cross-motion for summary judgment" applicant states that "opposer has failed to plead or support its dilution claim and this Board should grant applicant's motion dismissing this claim." While applicant has not referenced any rule in support of its request to dismiss this claim, we shall construe applicant's request as one under Fed. R. Civ. P. 12(b)(6).

[4] While opposers' pleading as a whole is not entirely clear, it appears that opposers allege a claim of dilution in paragraphs 15 and 16 of the amended notice of opposition: "Opposer [sic] asserts that its mark STEALTH is well known and or famous and that the applicant seeking registration of the confusingly similar mark STEALTH, which when used, would cause dilution under Section 43(c)" and "[i]f applicant's mark STEALTH is allowed to register it will lessen the capacity of opposer's [sic] famous mark STEALTH to identify and distinguish its goods or services and to license it's [sic] well known STEALTH BRAND NAME."

SIXTY DAYS from the mailing date of this order to file an answer to the amended notice of opposition.

Both parties are advised that the Board will not entertain any further motions for summary judgment in this proceeding.

Proceedings are resumed. Discovery and trial dates are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	**June 30, 2003**
30-day testimony period for party in position of plaintiff to close:	**September 28, 2003**
30-day testimony period for party in position of defendant to close:	**November 27, 2003**
15-day rebuttal testimony period for party in position of plaintiff to close:	**January 11, 2004**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.