

**IN THE UNITED PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

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CENTRAL MFG. CO.  
(a Delaware Corporation)  
P.O. Box 35189  
Chicago, IL 60707-0189

Opposition No: 91123765

Opposer,

Trademark: HYPERSONIC

vs.

PARAMOUNT PARKS, INC.  
8720 Red Oak Blvd.  
Charlotte, NC 28217

Applicant

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Box TTAB/NO FEE

**MOTION FOR RECONSIDERATION OF  
BOARD ORDER DATED MARCH 9, 2004**

NOW COMES the Opposer and requests that the Board reconsider its decision of March 9, 2004, and states as follows:

First of all, it is important to point out that the Board abused its discretion by refusing to grant Opposer's motion to file a brief in excess of 25 pages in support of its motion for summary judgment. The Opposer requested that the Board grant its motion to permit Opposer's brief, which was slightly in excess of twenty-five pages. The Opposer, who has been involved with the FRCP and District Court litigation involving trademarks for over twenty-five years, has never heard or been involved in a case where the District Court would not have granted a movant leave to accept a brief which was a page or two in excess of the page limit. The Opposer asserts in this case the Board's failure to grant Opposer's motion to accept its brief which was one or two pages in excess of 25, represents a bias and prejudice towards the Opposer in favor of the Applicant. There is no other interpretation possible. Thus, the Opposer would like to give the Board its opportunity to reconsider that decision and to grant Opposer's motion for leave to file its brief in excess of 25 pages, to establish that this Board, consisting of Judges Bottorff, Rogers and Drost, were not biased and prejudiced against the Opposer.

The Board further found at page 6 of its decision of March 9, 2004:

"After reviewing the arguments and supporting papers of the parties, we find that opposer has not met its burden of establishing that genuine issue of material fact exists as to any of the grounds on which it bases its motion for summary judgment. In view of the facts that (1) applicant has filed a counterclaim to cancel opposer's pleaded registration based on a claim of abandonment and (2) there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce, a genuine issue of material fact exists as to whether opposer has standing to maintain this proceeding."

The Board's conclusion that there is a genuine issue of material fact as to whether Opposer has standing to maintain this proceeding, was in error, as the Board considered Opposer's declaration to its motion for summary judgment "based solely on Mr. Stoller's capacity as opposer's president, at page 4. The Board, at page 7, is inconsistent in its above finding, in its footnote 8, for the Board contradicts itself by attempting to interpret Opposer's declaration differently than the Board's initial acceptance to limit the Board's interpretation of Leo Stoller's declaration, "based solely on Mr. Stoller's capacity as opposer's president", on page 4.

Further, the Board erred in stating on page 7 that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...". The Opposer has pled a valid registration for the mark HYPERSONIC. A registration(s) on the Principal Register is prima facie evidence of the validity of the registered mark, of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark **Similarly a federal registration resulting from a use-based application is prima facie evidence that the mark has been used in interstate commerce prior to registration.**

The fact that the applicant has pled a counterclaim for cancellation of Opposer's pled registration based on a claim of abandonment, without any proof whatsoever, does not automatically shift the burden of the registrant to establish proof of use of a registered trademark that has reached the incontestable status. This principle in law is well-known to the Board

members. The applicant has put into the record nothing whatsoever that establishes the Applicant's abandonment claim. Barring which, the Opposer in its motion for summary judgment, is under no obligation to present anything other than its valid Federal trademark registration which establishes its presumption of use. Applicant's boilerplate counterclaim for abandonment does not, per se, destroy the said registrant's presumption of use. Consequently, had the Board followed the law, the facts and the evidence in this case, it would have not found necessary for the Opposer in its motion for summary judgment to have had to include any evidence of use other than a copy of Opposer's valid, incontestable Federal trademark registration.

As a result, the Opposer asserts that the Board clearly erred in its finding that "... there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...", page 7. The Opposer requests, respectfully, that the Board reconsider its said erroneous finding and to rewrite its finding pursuant to the current law which states that there is a heavy burden of proof on the counterclaimant<sup>1</sup>.

"The burden of proof is on the party claiming abandonment. Because abandonment is in the nature of a forfeiture, the burden of proof is a heavy one<sup>2</sup>. One decision characterized the burden as requiring evidence that 'leaves no room for doubt or speculation' and leads to 'but not inescapable conclusion, namely, that the use of the mark was discontinued with intent to abandon it to the world.'<sup>3</sup> On the other hand, another decision described the burden of proof for abandonment in a cancellation action as a preponderance of the evidence, the same as the burden for likelihood of confusion. Once non-use has been proven, the burden of production (not the burden of proof) shifts to the registrant."

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1. See Third Edition, Trademark Law, A Practitioner's Guide, by Siegrun D. Kane, §11-19, The Heavy Burden of Proof.

2. *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1044 (2d Cir. 1980).

3. *Miller Brewing Co. v. Oland's Breweries, Ltd.*, 189 U.S.P.Q. 481, 488 (TTAB 1975), aff'd, 548 F.2d 349 (CCPA 1976).

The Board, in the Opposer's decision, made an absolute egregious abuse of its discretion and/or clear error, when it stated at page 7 that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce...". The Board, this panel of Judges, already assumed that the Applicant has met its heavy proof of non-use, and that the burden of production had shifted to the Registrant/Opposer. When in fact the Applicant has not met its burden of production, proving the Registrant's non-use, and the burden has not shifted to the Registrant. Consequently, a fair and impartial panel of Trademark Trial and Appeal Board Judges, the Opposer respectfully asserts, would not have come to the conclusion that "there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce ...". The Board violated the Opposer's Due Process and Equal Protection Rights by not giving the Opposer's said Registration the statutory presumption of use which it was entitled to under the law. Thus, the Board should reconsider and reverse its finding that relates to the *prima facie* validity of Opposer's Registration which has not been satisfactorily met by the Applicant.

The Board further found, "in addition, at minimum, genuine issues exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they come from the same source, and as to whether applicant's intended use of the mark on the goods would constitute use in commerce."

There could be no question that the goods of the parties need not be identical or directly competitive to find likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 22 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i). In this case, there can be no question that the goods of the parties are similar, related and/or competitive, and could be used in conjunction with the

Registrant's goods. The Board must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

Furthermore, it is clear that Applicant's intrastate use of the mark on the goods does not constitute use in commerce. The Board's finding that the Opposer's motion for summary judgment was denied in all respect was clear error and/or abuse of discretion. The Board, Judges Bottorff, Rogers and Drost, have a lawful obligation to follow the current law based upon the facts and the evidence presented by the Opposer. The Opposer respectfully asserts that the Board could have, within its discretion, ruled in favor of the Opposer's motion for summary judgment, but chose not to strictly follow the facts and the law in this case for the reasons previously stated.

The Opposer strongly objects to the Express Mail sanction that has been leveled on the parties. The Opposer asserts that the sanction imposes a burdensome, oppressive and unnecessary hardship on the Opposer in violation of its Due Process and Equal Protection Rights. The Board clearly found at page 9 that the "Applicant has submitted no evidence, such as copies of a postmark envelope in which the responses were enclosed, to rebut that prima facie proof of service. Cf. *S. Industries, Inc. v. Lamb-Weston, Inc.*, 45 USPQ 2d 1293 (TTAB 1997). Accordingly, we find that applicant has not met its burden of proof with regard to its allegation that opposer's discovery responses were not timely served in compliance with the July 24, 2002 order."

In view of the fact that the Applicant did not meet its burden of proof that Opposer's discovery responses were not timely served, does not justify in any manner, shape or form, this Board's sanction of Express Mail delivery which the Board has imposed upon the parties. The Opposer, as well-known to Judges Bottorff, Rogers and Drost, has over 50 inter-party proceedings pending before this Honorable Board, and that various members of this Board are attempting to impose an express mail delivery sanction on the Opposer in each and every proceeding in which the Opposer is involved in order to deprive the Opposer of its ability to fairly litigate before the TTAB. This imposition, under these circumstances of an expensive express mailing sanction, which is not justified, directly violates the Opposer's Due Process

and Equal Protection Rights under the 5th and 14th Amendments of the U.S. Constitution. The Opposer is requesting that the Board reverse its express mail sanction in this proceeding and permit the parties to make mailings by first class United States mail.

WHEREFORE, the Opposer prays that the Board reconsider its decision of March 9, 2004, and to reverse those contested findings cited herein by the Opposer, to withdraw the express mail sanction placed upon the parties, and to grant Opposer's motion for summary judgment as a matter of law.

By: 

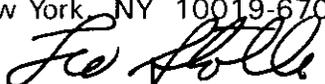
Leo Stoller  
CENTRAL MFG. CO., Opposer  
Trademark & Licensing Dept.  
P.O. Box 35189  
Chicago, Illinois 60707-0189  
773-283-3880 FAX 708 453-0083

Date: April 8, 2004

**Certificate of Service**

I hereby certify that this *Motion for Reconsideration* is being deposited with the U.S. Postal Service by **Express Mail**  
**No: ER 854975740 US** in an express mail envelope addressed to:

Lacy H. Koonce  
Lance Koonce  
DAVIS WRIGHT TREMAINE LLP.  
1633 Broadway  
New York, NY 10019-6708

  
\_\_\_\_\_  
Leo Stoller  
Date: April 8, 2004

**Certificate of Mailing**

I hereby certify that the foregoing *Motion for Reconsideration* is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to:

TTAB/NO FEE  
Assistant Commissioner of Patents and Trademarks  
2900 Crystal Drive, Arlington, Virginia 22202-3513

  
\_\_\_\_\_  
Leo Stoller  
Date: April 8, 2004

THIS OPINION IS NOT  
CITABLE  
AS PRECEDENT OF  
THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Baxley

Mailed: March 9, 2004

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CENTRAL MFG. CO.

v.

PARAMOUNT PARKS, INC.

Before Bottorff, Rogers and Drost,  
Administrative Trademark Judges.

By the Board:

Paramount Parks, Inc. ("applicant") seeks to register the mark HYPERSONIC in typed form for "paper goods and printed matter, namely calendars, fiction magazines, comic books, greeting cards, posters, a series of fiction books, trading cards, stickers, notepads, notebooks, postcards, gift wrapping paper, bumper stickers, rubber stamps" in International Class 16<sup>1</sup> and "T-shirts, sweatshirts, hats, jackets, pajamas, masquerade costumes, tank tops, footwear, sweatpants, [and] shorts" in International Class 25.<sup>2</sup>

Central Mfg. Co. ("opposer") has opposed registration of applicant's mark on grounds that the mark is likely to

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<sup>1</sup> Application Serial No. 76103448, filed August 2, 2000, based on an assertion of a bona fide intent to use the mark in commerce.

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cause confusion with opposer's previously used and registered mark HYPERSONIC under Trademark Act Section 2(d),<sup>2</sup> 15 U.S.C. Section 1052(d); that registration of applicant's mark will cause dilution of opposer's "famous" mark; that applicant's involved applications were "obtained fraudulently" because, in view of the fact that applicant was already using the mark at the time it filed its applications, applicant's assertions of a bona fide intent to use the mark in commerce were false; that applicant's involved applications were "obtained fraudulently" because applicant asserted a bona fide intent to use the mark in commerce when it never intended to use its mark in commerce; that applicant's involved applications were obtained fraudulently because applicant had no right to register its mark; that applicant did not have a "valid" intent to use the mark in commerce and has no right to register its mark; that applicant had been using the HYPERSONIC mark prior to filing its involved intent-to-use applications; that applicant's mark is merely descriptive or deceptively misdescriptive of its goods; and that the mark as set forth

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<sup>2</sup> Application Serial No. 76103447, filed August 2, 2000, based on an assertion of a bona fide intent to use the mark in commerce.

<sup>1</sup> Registration No. 1593157 for "sports racquets, namely tennis racquets, racquetball racquets, squash racquets, badminton racquets; golf clubs, golf balls, tennis balls, sports balls, namely basketballs, baseballs, footballs, soccerballs, volleyballs; crossbows, tennis racquet string and shuttlecocks" in International Class 28, issued April 24, 1990.

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in the application is not a substantially exact representation of the mark intended to be used with the identified goods. Applicant denied the salient allegations of the notice of opposition and asserted affirmative defenses in its answer and filed a counterclaim to cancel opposer's pleaded Registration No. 1593157.

This case now comes up for consideration of (1) opposer's combined motion (filed October 15, 2002) for summary judgment, for oral hearing on that motion, and for leave to file a brief in excess of twenty-five pages;<sup>4</sup> (2) applicant's motion (filed April 11, 2003) for discovery sanctions, which was included in its brief in response to opposer's motion for summary judgment; and (3) opposer's motion (filed May 27, 2003) for sanctions under Fed. R. Civ. P. 11.

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<sup>4</sup> In a declaration submitted with exhibits in support of opposer's motion for summary judgment, declarant Leo Stoller, who executed the declaration in both his individual capacity and as president of opposer, refers to himself as "the Opposer and President of CENTRAL MFG. CO." and claims to own pleaded Registration No. 1593157. We note, however, that the notice of opposition identifies Central Mfg. Co. as the sole opposer herein. As opposer is well aware, a corporation is a separate legal entity. See *Timex Corporation v. Leo Stoller d/b/a Sentra Sporting Goods U.S.A. Co.*, 961 F. Supp. 374 (D.C. Conn. 1997) ("Stealth Industries is a Delaware corporation, an independent entity from Leo ... Stoller."). Inasmuch as no document reflecting the assignment of pleaded Registration No. 1593157 to Mr. Stoller has been filed with the Board or recorded with the USPTO's Assignment Branch, neither joinder nor substitution of Mr. Stoller as a party to this proceeding is appropriate. See TBMP Section 512.01. Further, inasmuch as Mr. Stoller is not a party to this proceeding, we will not consider any papers filed by him individually unless and until he is joined or substituted as a party plaintiff herein. Nonetheless, we will consider the

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*Opposer's motion to file a brief in excess of twenty-five pages is denied*

We turn first to opposer's motion to file a brief in excess of twenty-five pages in support of its motion for summary judgment. Opposer's initial filing in support of its motion for summary judgment consists of two briefs, i.e., a seventeen-page "verified motion for summary judgment with supporting memorandum" and a separate ten-page "verified memorandum."

Trademark Rule 2.127(a), as amended, states in relevant part: "[t]he brief in support of the motion and the brief in response to the motion shall not exceed [twenty-five] pages in length." As was stated in the Notice of Final Rulemaking in which the twenty-five page limitation was adopted, "[i]t is believed that [twenty-five] ... pages [is] sufficient for the main brief ... of any motion that arises in a Board *inter partes* proceeding. Because of the limited nature of Board proceedings, briefing for motions in such proceedings should not be as extensive as that in proceedings in court." Notice of Final Rulemaking, 63 Fed. Reg. 48081, 48094 (September 9, 1998). See *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220 (TTAB 2003). Taken together, opposer's combined briefs exceed the twenty-five page limit. While opposer contends

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declaration based solely on Mr. Stoller's capacity as opposer's president.

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that it needs additional pages to fully inform the Board of the facts and issues of this case, opposer should have, under the circumstances, been able to inform us of the facts and issues of this case in a single brief of less than twenty-five pages.<sup>5</sup>

In view thereof, opposer's motion to file a brief in excess of twenty-five pages is hereby denied. Accordingly, we have considered the "verified motion for summary judgment with supporting memorandum," but have not considered the "verified memorandum."<sup>6</sup>

***Opposer's motion for an oral hearing on its motion for summary judgment is denied***

We find that the parties' arguments with regard to opposer's motion for summary judgment are adequately presented in the parties' briefs thereon. See TBMP Section 502.03. Accordingly, opposer's motion for an oral hearing on its motion for summary judgment is hereby denied.

***Opposer's motion for summary judgment is denied***

Opposer seeks entry of summary judgment on the grounds that there is a likelihood of confusion between its pleaded mark and applicant's mark; that Viacom, Inc., not applicant,

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<sup>5</sup> Further, Trademark Rule 2.127(a), however, limits a moving party to a brief in support of its motion and a reply brief, which the Board may, in its discretion, consider, and specifically states that no further papers will be considered. As such, opposer's piecemeal briefing of its motion for summary judgment is inappropriate.

<sup>6</sup> We hasten to add that consideration thereof would not have changed our decision herein.

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owns the involved mark; that applicant's failure to disclose its relationship with Viacom is fatal to its applications; that applicant does not have a valid intent to use the mark because it merely intended to use its mark in intrastate commerce; that applicant has not established a valid first use date; that the mark in the drawing is not a substantially exact representation of the mark as used in the specimens of use that were submitted with its amendments to allege use; that applicant did not have a bona fide intent to use the mark when it filed its applications and did not have actual use when it filed its "Statements to Amend Use"; that the involved marks were not applied for in their correct type; and that applicant made misrepresentations to the Board in its amendments to allege use.

After reviewing the arguments and supporting papers of the parties, we find that opposer has not met its burden of establishing that no genuine issue of material fact exists as to any of the grounds on which it bases its motion for summary judgment.<sup>7</sup> In view of the facts that (1) applicant

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<sup>7</sup> We note that opposer's grounds for its summary judgment motion that applicant is not the owner of the involved mark and that applicant has failed to disclose the nature of its relationship with Viacom, Inc., as well as all of opposer's grounds related to applicant's use of the mark are unpleaded and that applicant has objected on that basis. See TBMP Section 528.07. Accordingly, opposer may not obtain summary judgment on any of these grounds.

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has filed a counterclaim to cancel opposer's pleaded registration based on a claim of abandonment and (2) there are no documents in support of opposer's motion for summary judgment establishing that opposer has ever used its pleaded HYPERSONIC mark in commerce, a genuine issue of material fact exists as to whether opposer has standing to maintain this proceeding.<sup>8</sup> In addition, at minimum, genuine issues exist as to whether the goods at issue are related in a manner that would cause prospective purchasers to have a mistaken belief that they come from the same source, and as

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Moreover, we note that applicant's applications are filed based on applicant's assertion of a bona fide intent to use in commerce under Trademark Act Section 1(b). Accordingly, any issues<sup>9</sup> regarding the methods in which applicant uses the mark are prematurely raised. See TMEP Sections 1102.01 and 1202. Although applicant filed amendments to allege use in connection with both applications, those amendments to allege use are untimely filed and therefore a nullity. See TMEP Section 1104.03(c). Further, opposer's allegations regarding applicant's specimens of use of its mark are an *ex parte* examination issues, which may not be grounds for opposition or cancellation. Cf. *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355 (TTAB 2003); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989).

<sup>8</sup> We further note that the declaration in support of opposer's motion for summary judgment states that Leo Stoller, not opposer, is the owner of the pleaded registration relied upon as a basis for the Section 2(d) claim. Such declaration also raises a genuine issue of material fact as to opposer's standing to maintain this proceeding. Although opposer contends that it has adequately pleaded its standing, an adequate pleading of one's standing does not establish that there are no disputed issues related to standing and that opposer is entitled to judgment as a matter of law.

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to whether applicant's intended use of the mark on the goods would constitute use in commerce.<sup>9</sup>

In view thereof, applicant's motion for summary judgment is hereby denied in all respects.<sup>10</sup>

***Applicant's motion for discovery sanctions is denied***

Applicant has moved for entry of judgment as a discovery sanction.<sup>11</sup> In a July 24, 2002 order, opposer was "ordered to respond to any of applicant's outstanding discovery requests" and was allowed until thirty days therefrom to do so. Accordingly, opposer was allowed until not later than August 23, 2002 to serve responses to applicant's discovery requests. Applicant contends that, while the certificates of service on opposer's responses to its discovery requests state that those responses were served on August 21, 2002, it did not receive them until September 3, 2002. Applicant further contends that those

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<sup>9</sup> The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

<sup>10</sup> The parties should note that the evidence submitted in connection with opposer's motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1983)); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

<sup>11</sup> Although not stated specifically, applicant's motion for discovery sanctions is pursuant to Trademark Rule 2.120(g).

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responses were deficient.<sup>12</sup> Accordingly, applicant asks that the Board enter judgment against opposer.

Although applicant's contentions regarding opposer's president's alleged assertions that the mail was slow outside Chicago raise serious questions as to the timeliness of service of opposer's discovery responses, the certificates of service included therein constitute *prima facie* proof of service. See Trademark Rule 2.119(a). Applicant has submitted no evidence, such as copies of a postmarked envelope in which the responses were enclosed, to rebut that *prima facie* proof of service. Cf. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997). Accordingly, we find that applicant has not met its burden of proof with regard to its allegation that opposer's discovery responses were not timely served in compliance with the July 24, 2002 order.<sup>13</sup>

With regard to the alleged deficiency of those responses, we note that the Board, in the July 24, 2002

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<sup>12</sup> A review of those responses indicates that, on August 21, 2002, opposer served written responses to applicant's first request for production and a general objection to applicant's first set of interrogatories based on their alleged excessive number. Opposer served amended responses to applicant's first set of interrogatories on September 25, 2002 that include responsive information regarding only sixteen of applicant's twenty-eight interrogatories and has not produced any documents responsive to applicant's first request for production.

<sup>13</sup> Moreover, in view of the fact that applicant's counsel received opposer's initial discovery responses shortly after the date specified in the July 24, 2002 order, entry of judgment as a sanction would be an unduly harsh remedy at this time.

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order, reset opposer's time to serve discovery responses, but did not compel discovery.<sup>14</sup> We further note that applicant did not file a motion to compel discovery in the time between the expiration of opposer's time to serve discovery responses in accordance with that order and the issuance of the Board's October 17, 2002 order which suspended proceedings herein pending disposition of opposer's motion to dismiss the counterclaim. See Trademark Rule 2.120(e)(1). Inasmuch as no order compelling discovery has been violated herein and opposer served responses to applicant's discovery requests, applicant's motion for discovery sanctions is premature. See Trademark Rule 2.120(g)(1); TBMP Section 527.01 (2d ed. June 2003).

In view thereof, applicant's motion for discovery sanctions is hereby denied.

***Use of Express Mail required for all papers henceforth***

To avoid further disputes with regard to the timeliness of service of papers in this proceeding, the Board, in exercising its inherent authority to control the conduct of parties in this proceeding, will only consider papers filed by the "Express Mail" procedure described in Trademark Rule 1.10 or by another overnight courier. Additionally, each party is hereby ordered to serve all papers on its

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<sup>14</sup> Any alleged deficiencies in opposer's responses to applicant's discovery requests must first be raised by way of a motion to

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adversary, as required by Trademark Rule 2.119(a), by the "Express Mail" procedure described in Trademark Rule 1.10, including a sworn certificate of service by "Express Mail," or by another overnight courier.

***Standard protective order imposed***

In view of the contentious nature of this proceeding, the Board hereby imposes its standard protective order published in the *Official Gazette* on June 20, 2000 at 1235 TMOG 670.<sup>15</sup> A copy of the Board's standard form order is enclosed with each party's copy of this order.

***Opposer's motion for Fed. R. Civ. P. 11 sanctions is denied***

Turning to opposer's motion for sanctions under Fed. R. Civ. P. 11, we note initially that opposer set forth such motion as a separate filing and served it on April 25, 2003, twenty-five days before filing it with the Board. As such, opposer has complied with the safe-harbor provisions of Rule 11(c)(1)(a). However, with regard to the merits of opposer's motion, which is based on allegations previously set forth in its combination reply brief in connection with its summary judgment motion and response to applicant's motion for discovery sanctions, we find that entry of sanctions against applicant is inappropriate.

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compel. See Trademark Rule 2.120(e)(1); TBMP Sections 523. See also TBMP Section 527.01.

<sup>15</sup> An electronic copy is available from the PTO website at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndaqmnt.htm>

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Opposer contends that the amendments to allege use that applicant filed in connection with its applications on October 26, 2001, i.e., during the pendency of this proceeding, are in violation of Trademark Rule 2.133(a) and thus should result in refusal of registration of the mark in both applications as a sanction. An amendment to allege use, however, is filed with the Trademark Examining Group of the USPTO as part of the *ex parte* examination of the application and does not constitute a pleading, motion, or other paper filed with the Board. Accordingly, the filing of an amendment to allege use does not fall within the purview of Rule 11.<sup>16</sup> Rather, applicant's amendments to allege use and the filing fees submitted therewith should not have been accepted and should have been returned to applicant.<sup>17</sup> See *In re Sovran Financial Corp.*, 25 USPQ2d 1537 (Comm'r Pats. 1991); TMEP Section 1104.03(c).

Opposer also contends that applicant should be sanctioned for filing a motion for discovery sanctions during the pendency of opposer's motion for summary judgment.

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<sup>16</sup> To the extent that opposer seeks entry of Rule 11 sanctions on this basis, opposer's motion is essentially frivolous. However, because opposer's motion for Rule 11 sanctions as it relates to the filing of applicant's motion for discovery sanctions sets forth a minimally plausible basis therefor, we decline to order opposer to show cause why sanctions under Fed. R. Civ. P. 11(c) should not be entered against opposer for filing a frivolous motion for entry of Rule 11 sanctions. See TBMP Section 527.02.

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when the only available discovery-related motion available to it at the time was pursuant to Fed. R. Civ. P. 56(f) and for making misrepresentations of law and fact therein which it contends are intended to prejudice the Board. Although applicant's motion for discovery sanctions was not germane to the motion for summary judgment, we find that its filing and the allegations raised therein do not warrant entry of sanctions herein.

As such, opposer's motion for Rule 11 sanctions is hereby denied. In the interest of avoiding unnecessary delay herein, each party is hereby prohibited from serving on its adversary, for safe harbor purposes, or filing with the Board, any further motions for Rule 11 sanctions without first outlining the basis for any such motion in a telephone conference with the interlocutory attorney assigned to this case.

Proceedings herein are resumed. Discovery and trial dates are reset as follows.

DISCOVERY PERIOD TO CLOSE:	<b>6/11/04</b>
Plaintiff's thirty-day testimony period to close:	<b>9/9/04</b>
Defendant's thirty-day testimony period to close:	<b>11/8/04</b>
Plaintiff's fifteen-day rebuttal period to close	<b>12/23/04</b>

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<sup>17</sup> Applicant's amendments to allege use and the filing fee submitted in connection therewith will be returned to applicant in due course.

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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 2.125.

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 2.129.

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v.

Paramount Parks, Inc.

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**PROVISIONS FOR PROTECTING  
CONFIDENTIALITY OF INFORMATION  
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, **or** the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract.<sup>18</sup> The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

<sup>18</sup> There may be a remedy at court for any breach of contract that occurs after the conclusion of this Board proceeding. See *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987). See also, *Alltrade Inc. v. Uniweld Products Inc.*, 20 USPQ2d 1698 (9th Cir. 1991).

## TERMS OF ORDER

### 1) **Classes of Protected Information.**

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

**Confidential**—Material to be shielded by the Board from public access.

**Highly Confidential**—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

**Trade Secret/Commercially Sensitive**—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

### 2) **Information Not to Be Designated as Protected.**

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

### 3) **Access to Protected Information.**

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters,

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stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

**Parties** and their **attorneys** shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions.

**Outside counsel, but not in-house counsel**, shall have access to information designated as **trade secret/commercially sensitive**.

**Independent experts or consultants, non-party witnesses, and any other individual** not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

#### 4) **Disclosure to Any Individual.**

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected

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information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

**5) Disclosure to Independent Experts or Consultants.**

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

**6) Responses to Written Discovery.**

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

**7) Production of Documents.**

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1.

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Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

### **8) Depositions.**

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

### **9) Filing Notices of Reliance.**

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

### **10) Briefs.**

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

### **11) Handling of Protected Information.**

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

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If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

### **15) Board's Jurisdiction; Handling of Materials After Termination.**

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

### **16) Other Rights of the Parties and Attorneys.**

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

**By Order of the Board, effective March 8, 2004.**

/apb/

Andrew P. Baxley  
Interlocutory Attorney

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