UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 1, 2007

Opposition No. **91152940**

Sinclair Oil Corporation

v.

Sumatra Kendrick

By the Trademark Trial and Appeal Board:

On March 1, 2006, opposer filed a motion for summary judgment on its newly pleaded grounds of nonuse and fraud. On April 4, 2006, applicant filed a motion to extend her time to respond to the motion for summary judgment. In an August 28, 2006 order, the Board granted applicant's motion to extend and allowed applicant until thirty days therefrom, i.e., until September 27, 2006, to file both an answer to the amended notice of opposition and a brief in response to opposer's motion for summary judgment.

On October 2, 2006, applicant filed a submission captioned "Amendment to Notice of Opposition: 91152940," which indicates that such submission was served on opposer on September 27, 2006 ("the October 2, 2006 submission"). In that submission, applicant contends that, in response to an interrogatory of opposer's, "the answer was mistakenly filed as I had not used my mark in commerce" on account of

"confusion with [the] question" and asks that her "answer" be amended to Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The Board construes the October 2, 2006 as a combined informal answer to the amended notice of opposition, brief in response to the motion for summary judgment, and motion to amend the filing basis of involved application Serial No. 76212011 to Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).[1]

On October 17, 2006, opposer filed a motion to extend time to respond to applicant's October 2, 2006 submission, followed on October 24, 2006 by three separate submissions: 1) a brief in response to applicant's October 2, 2006 submission to the extent that such submission is construed as a motion to amend applicant's involved application; 2) a motion to strike applicant's October 2, 2006 submission and for entry of default judgment; and 3) a reply brief in support of its motion for summary judgment.[2] Applicant did not file either a reply brief in connection with her motion to amend or a brief in response to opposer's motion to strike or for default judgment.

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[1] As the Board noted in a January 29, 2004 order, the Board attributes any lack of artfulness in applicant's filings herein to her apparent inexperience in legal proceedings.

[2] Opposer should have set forth all of its arguments concerning the October 2, 2006 submission in a single filing.

With regard to the October 2, 2006 submission, the Board presumes that this submission was mailed to the Board on September 27, 2006, i.e., the date on which it was served upon opposer by first class mail. Because that submission was filed by mail without a certificate of mailing, it is considered filed on the day it was received in the USPTO mailroom and is thus untimely.[3] See Trademark Rule 2.197; TBMP Section 110 (2d ed. rev. 2004). However, inasmuch as opposer has not objected to the October 2, 2006 submission on the basis that it was filed after the time provided by the August 28, 2006 order, we have considered that submission. Moreover, as the law prefers that cases be decided on the merits, filing of an answer a few days late generally would be excused and would not provide a basis for entry of a default judgment. See TBMP Section 312.02 (2d ed. rev. 2004).

We turn now to opposer's motion to extend time to respond applicant's October 2, 2006 submission. To the extent that opposer seeks an extension of time in which to file a reply brief in support of its motion for summary judgment, "[t]he time for filing a reply brief will not be

[3] The October 2, 2006 submission would have been timely if applicant had filed it electronically through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) on September 27, 2006. Applicant is reminded that ESTTA is available, but if it is not used, then filings sent by mail without certificate of mailing generally must received by the Board by the due date.

extended." Trademark Rule 2.127(a). Accordingly, opposer's motion to extend is denied with regard to such reply brief, but is otherwise granted as conceded. See Trademark Rule 2.127(a). We have considered opposer's motion to strike the October 2, 2006 submission and for entry of default judgment and opposer's brief in response to the October 2, 2006 submission to the extent that such submission is a motion to amend, but will not consider applicant's reply brief in support of its motion for summary judgment because that reply brief was filed more than twenty days after applicant served the October 2, 2006 submission by first class mail. See Trademark Rule 2.119(c) and *id.* Although applicant did not file a brief in response to opposer's motion to strike the October 2, 2006 submission and for entry of default judgment, we elect to decide that motion on the merits. See *id.*

With regard to opposer's motion to strike and for entry of default judgment, opposer contends that the October 2, 2006 submission is not a proper responsive pleading to the amended notice of opposition and therefore asks that such submission be stricken and default judgment be entered herein. However, when a defendant in a Board *inter partes* proceeding files, in response to a complaint, a submission which is argumentative and not a proper responsive pleading,

the Board ordinarily advises the defendant accordingly and allows time in which to file a proper answer. The Board generally does not strike such a submission, and the circumstances in this case do not warrant varying from the Board's general practice. See TBMP Section 506.01 (2d ed. rev. 2004). In view thereof, opposer's motion to strike the October 2, 2006 submission and for entry of default judgment is hereby denied.[4]

With regard to applicant's motion to amend the filing basis of involved application Serial No. 76212011 to Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), the Board generally defers determination of contested motions to amend involved applications until the case is finally decided or is decided upon summary judgment. See *Space Base Inc. v. Stadis Corp.,* 17 USPQ2d 1216 (TTAB 1990). However, because a determination of the motion to amend the filing basis of the involved application may be dispositive of opposer's nonuse claim, the Board, in its discretion, elects to review the motion to amend the involved application.[5] See TBMP Section 514.03 (2d ed. rev. 2004).

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[4] Applicant's time in which to file an answer to the amended notice of opposition has been reset at the conclusion of this order.

[5] Applicant was advised in the January 31, 2006 order that, if she intended to move to amend the filing basis for her involved application to Trademark Act Section 1(b), 15 U.S.C. 1051(b), she should so move promptly. Although applicant should have filed her motion to amend the filing basis of her involved application sooner, we will consider that motion.

An applicant under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), who is a defendant in a Board opposition proceeding, can move to amend its application to substitute Section 1(b) as its filing basis and maintain its original filing date, provided that it meets all the requirements for a Section 1(b) filing basis. See Trademark Law Treaty Implementation Act of 1998 (TLTIA), Pub. L. No. 105-330, 112 Stat. 3064 (15 U.S.C. Section 1051), and the "Trademark Law Treaty Implementation Act Changes" to the Rules of Practice of Procedure, published in the Federal Register at 64 FR 48900 (Sept. 8, 1999) and in the Official Gazette at 1226 TMOG 103 (Sept. 28, 1999). See also Trademark Rules 2.34, 2.35 and 2.133(a) and Exam Guide No. 3-99 at 6.[6] When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date. See Trademark Rule 2.35(c).

In an application under Section 1(b), an applicant must verify that it has a *bona fide* intent to use the mark in commerce on or in connection with the goods or services listed therein. If the verification is not filed with the initial application, the applicant must submit a verified

[6] Exam Guide No. 3-99 is available on the USPTO web site at http://www.uspto.gov/web/offices/tac/notices/notices.htm

statement which alleges that the applicant had a *bona fide* intention to use the mark in commerce as of the filing date of the application. See Trademark Rule 2.34(a)(2)(i).

A review of the involved application and applicant's motion to amend indicates that applicant has not submitted a verified statement that she had a *bona fide* intention to use the mark in commerce as of the filing date of the application. Thus, the Board cannot allow applicant to amend her filing basis at this time. Rather, the Board hereby defers determination of both applicant's motion to amend the filing basis of her involved application and opposer's motion for summary judgment.

Applicant is allowed until **thirty days** from the mailing date set forth in the caption of this order to file with the Board the following separate submissions: 1) a verified statement that she had a bona fide intent to use her involved mark in commerce as of the filing date of the application;[7] and 2) a proper answer to the amended notice of opposition.[8]

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[7] Applicant's verified statement may be in the following form and should be signed at the conclusion thereof:

> I had a bona fide intention to use the mark that is subject of application Serial No. 76212011 in commerce on or in connection with the goods or services listed in the application as of the filing date of the application. The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom,

Proceedings herein otherwise remain suspended.

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declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

_____
Name and date

[8] Federal Rule of Civil Procedure 8(b) sets forth guidelines regarding the substance of an answer. See also TBMP Section 310 (2d ed. rev. 2004). Rule 8(b) provides, in part, as follows:

> A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

Opposer's amended notice of opposition consists of eighteen paragraphs which set forth the basis of opposer's claim of damage. Pursuant to Fed. R. Civ. P. 8(b), applicant should answer the notice of opposition by simply admitting or denying the allegations set forth in each of the individual paragraphs of the amended notice of opposition, as applicant did in her answer to the original notice of opposition. If applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, applicant should so state and this will have the effect of a denial.

We note that, while Patent and Trademark Rule 10.14 permits any person to represent itself, a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding is advised to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

Applicant should review the Trademark Rules of Practice, which are available online at http://www.uspto.gov/web/offices/tac/tmlaw2.html, and the Trademark Board Manual of Procedure, which is available online at http://www.uspto.gov/web/offices/dcom/ttab/tbmp/. The Board expects parties to comply with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, whether or not they are represented by counsel.