

TTAB

BOX TTAB
NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UMAC, Inc.,

Opposer,

v.

Upside Software, Inc.,

Applicant.

No. 91160262

APPLICANT'S MOTION TO
STRIKE OPPOSER'S NOTICE OF
OPPOSITION FOR FAILURE TO
SIGN THE PLEADING



06-04-2004

U.S. Patent & TMO/TM Mail Rept Dt. #78

APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF
OPPOSITION FOR FAILURE TO SIGN THE PLEADING

Applicant, Upside Software, Inc. requests that the Board strike Opposer, UMAC, Inc.'s, Notice of Opposition under Rule 11(a) of the Federal Rules of Civil Procedure for failure of Opposer's counsel, Simor L. Moskowitz of Jacobson Holman, PLLC, to sign the pleading.

Rule 11(a) requires that the Notice of Opposition be signed by at least one attorney of record. Opposer's Notice of Opposition is not signed at all, and is therefore defective. Applicant, through its attorneys, notified Mr. Moskowitz of the defect and gave reasonable opportunity to cure the defect. Mr. Moskowitz did not respond to the notice, and, to date, has failed to cure the defect. Therefore, under Rule 11(a), Opposer's Notice of Opposition to the registration of U.S. Trademark Application Serial No. 76/257,660 should be stricken.

FACTS

On February 25, 2004, Opposer, through its attorney, Simor L. Moskowitz of Jacobson Holman, PLLC, filed a Notice of Opposition to Applicant's U.S. Trademark Application Serial No. 76/257,660 to register the mark UPSIDE SOFTWARE for consulting services for electronic commerce. Opposer bases its opposition upon a registration for UPSIDE, U.S. Registration No. 1,653,067 for subscription magazine services. On April 24, 2004, the Notice of Opposition together with the notice setting the discovery and testimony

1 periods was sent to Applicant. Applicant's Answer to the Notice of Opposition is presently
2 due on June 3, 2004.

3 In the preparation of the Answer, Applicant's attorneys observed that the Notice of
4 Opposition was unsigned. On May 26, 2004, Applicant's attorney, Gregory F. Wesner, sent a
5 letter by facsimile transmission to Mr. Moskowitz giving him notice of the defect. See
6 Declaration of Gregory F. Wesner, attached hereto, ¶ 3. In light of the June 3, 2004 deadline
7 for Applicant to file its Answer, Mr. Wesner requested that the defect be cured no later than
8 noon, PDT, Friday, May 28, 2004. If not Cured, Applicant has no choice but to file a motion
9 to strike the Notice of Opposition in order to preserve Applicant's right to challenge the
10 sufficiency of Opposer's pleading.¹ Wesner Decl. ¶ 3. The facsimile confirmation sheet
11 shows that Jacobson Holman, PLLC received the fax on May 26, 2004 at 3:02 PM. Wesner
12 Decl. ¶ 4. To date, there has been no response from anyone at Mr. Moskowitz's firm.

13 On Friday, May 28, 2004, at approximately noon PDT, Mr. Wesner called Mr.
14 Moskowitz to inquire whether Opposer intended to cure the defect in the Notice of
15 Opposition. Wesner Decl. ¶ 5. Mr. Wesner was informed that Mr. Moskowitz had been in
16 the office that day, but could not presently be located. Wesner Decl. ¶ 5. Mr. Wesner was
17 directed to the telephone extension for Mr. Moskowitz's secretary, where he left a voicemail
18 message asking that Mr. Moskowitz, or his secretary, call him as soon as possible. Wesner
19 Decl. ¶ 6. To date, no return call has been received. Wesner Decl. ¶ 6.

20 ARGUMENT

21 Trademark Rule 2.116(a), 37 CFR § 2.116(a) provides that "[e]xcept as otherwise
22 provided, and wherever applicable and appropriate, procedure and practice in *inter partes*
23 proceedings shall be governed by the Federal Rules of Civil Procedure." TBMP § 502.01.
24 Furthermore, Trademark Rule 10.18 (a), 37 CFR § 10.18(a) requires that all documents, with
25

26 ¹ Applicant is disinclined to ignore the defect, because the stakes are quite high. The opposition
27 period on Applicant's Application to Register has closed. If Opposer's Notice of Opposition is stricken, this
Opposition potentially could come to an end.

1 the exception of correspondence that is required to be signed by an applicant or party, filed by
2 a practitioner in the Patent and Trademark Office "must bear a signature, personally signed by
3 such practitioner, in compliance with §1.4(d)(1) of this chapter." See TBMP §527.02.

4 Like the Trademark Rule, Rule 11(a) of the Federal Rules of Civil Procedure is
5 unmistakably clear: all pleadings must be signed or the pleading shall be stricken. FRCP Rule
6 11(a) states, in pertinent part:

7 **(a) Signature.** Every pleading, written motion and other paper shall be signed
8 by at least one attorney of record in the attorney's individual's name, or, if the
9 party is not represented by an attorney, shall be signed by the party. . . . An
10 unsigned paper shall be stricken unless omission of the signature is corrected
11 promptly after being called to the attention of the attorney or the party.

12 Striking a pleading may be regarded by some as an extreme remedy, but it is one specifically
13 considered by the drafters of the Federal Rules. The Advisory Committee Notes to the 1983
14 Amendment to Rule 11 point out that:

15 Since its original promulgation, Rule 11 has provided for the striking of
16 pleadings and the imposition of disciplinary sanctions to check abuses in the
17 signing of pleadings Experience shows that in practice Rule 11 has not
18 been effective in deterring abuses The new language is intended to reduce
19 the reluctance of courts to impose sanctions, by emphasizing the
20 responsibilities of the attorney and reenforcing those obligations by the
21 imposition of sanctions.

22 Rule 11 is specifically applicable to pleadings, motions, and other papers filed in *inter partes*
23 proceedings before the Board, and the Board is authorized to impose sanctions up to and
24 including the entry of judgment. See 37 CFR § 2.116(a); *Hilson Research Inc. v. Society for*
25 *Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Avia Group International*
26 *Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d
27 1216 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13
USPQ2d 1719 (TTAB 1989); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552

1 (TTAB 1987); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986);
2 and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986).²

3 In the present opposition proceeding, Applicant notified counsel for Opposer as soon
4 as possible after it learned of the defect. Counsel for Applicant faxed notice of the defect to
5 counsel for Opposer on May 26, 2004, and requested that the defect be cured before noon
6 PDT on May 28, 2004. Applicant's notice of the defect and the requested time to cure was
7 reasonable in light of the impending June 3, 2004, Answer deadline. Furthermore, it is
8 evident that: Applicant's facsimile notice was successfully transmitted to the office of counsel
9 for Opposer; Opposer's counsel was available to receive the facsimile; curing the defect could
10 have been accomplished with very little effort; and, yet, to date, it appears that no steps have
11 been taken to cure the defect or to indicate any intent to cure.

12 RELIEF REQUESTED

13 Applicant requests that Opposer's Notice of Opposition be stricken for failure to sign
14 the pleading as required by FRCP Rule 11(a), and as authorized by 37 CFR § 10.18(c).
15 Pending the Board's disposition of this motion, Applicant requests that the deadline for filing
16 the Answer, and all other proceedings not germane to this Motion, be suspended.

17 ///

18 ///

19 ///

20 ///

21 ///

22

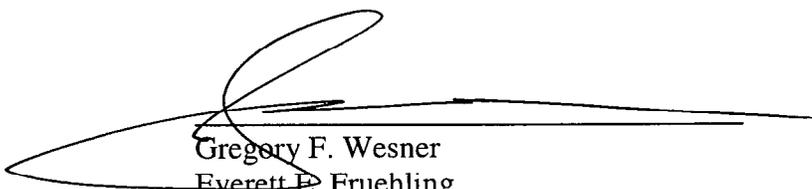
23

24 2 At least one recent case interpreting Rule 11(a) suggests that a pleading should not be stricken
25 if the failure to sign was an oversight, and no prejudice would result to the other parties to the proceeding. In
26 *Scarborough v. Principi*, 124 S.Ct. 1856 (May 2004), the United States Supreme Court ruled that a jurisdictional
27 defect occasioned by a party's good faith inadvertent failure to sign could be overcome by the filing of a
corrective pleading. The *Scarborough court*, however, acknowledged that such leniency should only be applied
to a party who corrects a defective pleading promptly upon receiving notice of the defect.

1 If the Board strikes Opposer's Notice of Opposition, any Notice of Opposition would
2 be untimely as outside the opposition period, and this opposition would conclude in
3 Applicant's favor. If the Board denies Applicant's Motion, or grants relief other than the
4 striking of Opposer's pleading, Applicant requests an additional 40 days from the date of the
5 Board's ruling within which to file its Answer, or 40 days from Applicant's receipt of a
6 revised Notice of Opposition, whichever is later.

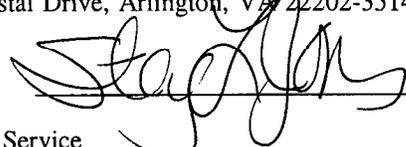
7
8 Dated this 1st day of June, 2004.

9
10 CHRISTENSEN O'CONNOR
11 JOHNSON KINDNESS^{PLLC}

12
13
14 
15 Gregory F. Wesner
16 Everett E. Fruehling
17 Attorneys for Applicant Upside Software, Inc.

18 Certificate of Mailing

19 I hereby certify that this Applicant's Motion To Strike For Failure To Sign Pleading is being deposited
20 with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and
21 addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the below
22 date.

23 Date: June 1, 2004 

24 Certificate of Service

25 I hereby certify that a copy of this Applicant's Motion To Strike For Failure To Sign Pleading is being
26 deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid
27 and addressed to:

28 Simor L. Moskowitz
29 Jacobson Holman
30 400 Seventh Street NW
31 Washington DC 20004
32 Attorneys for Opposer

33 Date: June 1, 2004 

1
2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3 UMAC, Inc.,

4 Opposer,

5 v.

6 Upside Software, Inc.,

7 Applicant.

No. 91160262

DECLARATION OF GREGORY F.
WESNER IN SUPPORT OF
APPLICANT'S MOTION TO
STRIKE OPPOSER'S NOTICE OF
OPPOSITION FOR FAILURE TO
SIGN THE PLEADING



06-04-2004
U.S. Patent & TMO/ct/TM Mail Rept Dt. #78

9 I, Gregory F. Wesner, hereby declare under penalty of perjury as follows:

10 1. I am an attorney for Upside Software, Inc., and am personally knowledgeable
11 about the facts asserted herein.

12 2. On April 24, 2004, the Notice of Opposition together with the notice setting
13 the discovery and testimony periods was sent to Applicant. Applicant's Answer to the Notice
14 of Opposition is presently due on June 3, 2004.

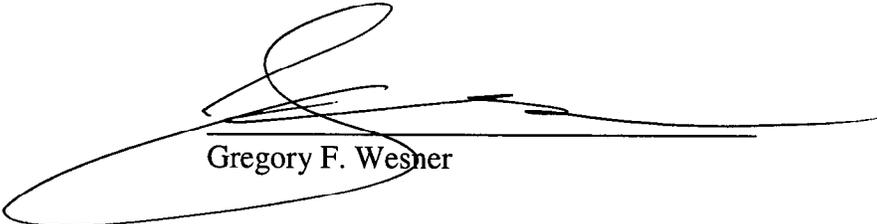
15 3. In the preparation of the Answer, Applicant's attorneys observed that the
16 Notice of Opposition was unsigned. On May 26, 2004, Declarant sent a letter by facsimile
17 transmission to Mr. Moskowitz giving him notice of the defect. See Exhibit "A" attached
18 hereto. In light of the June 3, 2004 deadline for Applicant to file its Answer, Declarant
19 requested that the defect be cured no later than noon, PDT, Friday, May 28, 2004.

20 4. The facsimile confirmation sheet shows that Jacobson Holman, PLLC received
21 the fax on May 26, 2004 at 3:02 PM. See Exhibit "A" attached hereto. To date, there has
22 been no response from anyone at Mr. Moskowitz's firm.

23 5. On Friday, May 28, 2004, at approximately noon PDT, Declarant called Mr.
24 Moskowitz to inquire whether Opposer intended to cure the defect in the Notice of
25 Opposition. Declarant was informed that Mr. Moskowitz had been in the office that day, but
26 could not presently be located.

1 6. Declarant was directed to the telephone extension for Mr. Moskowitz's
2 secretary, where Declarant left voicemail message asking that Mr. Moskowitz, or his
3 secretary, call me as soon as possible. To date, no return call has been received.

4 Dated this 1st day of June, 2004.

5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27

Gregory F. Wesner

I hereby certify that this Declaration of Gregory F. Wesner is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3514, on the below date.

Date: June 1, 2004 Stacy Johnson

Certificate of Service

I hereby certify that a copy of this Declaration of Gregory F. Wesner is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to:

Simor L. Moskowitz
Jacobson Holman
400 Seventh Street NW
Washington DC 20004
Attorneys for Opposer

Date: June 1, 2004 Stacy Johnson

CHRISTENSEN
O'CONNOR
JOHNSON
KINDNESS[®] PLLC

Law Offices

Intellectual Property Law
and Related Litigation

1420 Fifth Avenue, Suite 2800
Seattle, Washington 98101-2347

206.682.8100 *phone*
206.224.0779 *fax*
www.cojk.com

May 26, 2004

VIA FACSIMILE ONLY

Facsimile No. (202) 393-5350

Simor L. Moskowitz
Jacobson Holman, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004-2201

Re: *UMAC, Inc. v. Upside Software, Inc.*
Trademark Trial and Appeal Board
Case No. 91160262
Our Reference: UPSI-6-2617

Dear Mr. Moskowitz:

This firm represents Upside Software, Inc. ("Upside") in U.S. intellectual property matters. We are writing in regard to the Opposition filed by you on behalf of UMAC, Inc. ("UMAC") against Upside's application to register the mark UPSIDESOFTWARE.

We fail to see how your client's use of the mark UPSIDE in association with a "monthly business magazine" is confusingly similar to our client's use of the mark UPSIDESOFTWARE in association with software. We will, therefore, be responding to your Opposition by the June 3, 2004, deadline for an Answer.

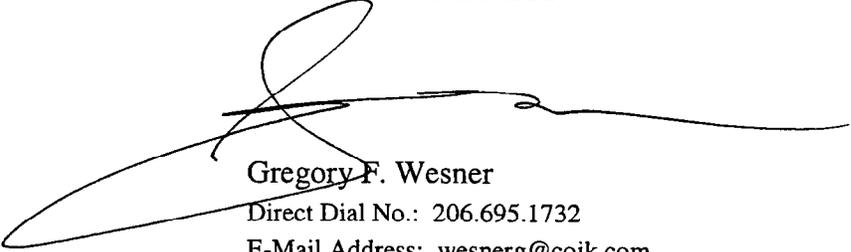
As an initial matter, we regard your Opposition pleading as clearly defective under Rule 11(a) of the Federal Rules of Civil Procedure because it is not signed by UMAC, or any attorney for UMAC. You are hereby given notice of this defect. In light of the June 3, 2004, deadline for Upside's Answer, if you have not cured this critical defect by noon PDT, Friday, May 28, 2004, we will be filing a motion to strike your pleading. As the opposition period for the UPSIDESOFTWARE mark is now closed, the striking of your pleading will result in the termination of UMAC's opposition.

Simor L. Moskowitz
May 26, 2004
Page 2

Thank you for your consideration. If you wish to discuss this matter, please contact the undersigned. Please include our above-referenced file number in all correspondence regarding this matter.

Very truly yours,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Gregory F. Wesner

Direct Dial No.: 206.695.1732

E-Mail Address: wesnerg@cojk.com

GFW:slj

cc: Upside Software, Inc.
Everett E. Fruehling
Kevan L. Morgan

* * * COMMUNICATION RESULT REPORT (MAY. 26. 2004 3:03PM) * * *

COMPLETEDFAX HEADER 1: CHRISTENSEN OCONNOR
FAX HEADER 2: 2062240779TRANSMITTED/STORED : MAY. 26. 2004 3:02PM
FILE MODE OPTION

ADDRESS

RESULT

PAGE

2147 MEMORY TX

812023935350

OK

3/3

REASON FOR ERROR OR LINE FAIL
E-1) HANG UP
E-3) NO ANSWERE-2) BUSY
E-4) NO FACSIMILE CONNECTION**CHRISTENSEN
O'CONNOR
JOHNSON
KINDNESS^{RLC}**

Law Offices

Intellectual Property Law
and Related Litigation1420 Fifth Avenue, Suite 2800
Seattle, Washington 98101-2347206.682.8100 *phone*
206.224.0779 *fax*
www.cojk.com**FACSIMILE COVER SHEET**

DATE: May 26, 2004

TO: Simor L. Moskowitz
FACSIMILE NO: (202) 393-5350
RE: *UMAC, Inc. v. Upside Software, Inc.*
OUR REFERENCE: UPSI-6-2617
FROM: Gregory F. Wesner**(Facsimile No. 206.224.0779)****MESSAGE:** Please see attached.

*** The information contained in this facsimile message is privileged and confidential information intended only for the use of the recipient named above. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, any distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone and return the original message to us at the above address by mail. ***

We have 3 pages to send, including this sheet. If any pages need to be retransmitted, please call 206.682.8100, Ext. 1222.

slj