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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
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Date	08/12/2008
Attachments	Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense.pdf (10 pages)(332864 bytes) Memo in Support of Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense.pdf (8 pages)(307203 bytes)

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

BRINK'S NETWORK, INCORPORATED	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91164764
	)	
BRINKMANN CORPORATION	)	
	)	
Applicant	)	

MOTION FOR PARTIAL SUMMARY JUDGMENT
DISMISSING APPLICANT'S LACHES DEFENSE

Opposer Brink's Network, Incorporated, in accordance with Rule 56 Fed. R. Civ. P. and Rule 2.127 of the Trademark Rules of Practice, respectfully moves for summary judgment dismissing the affirmative defense of laches asserted by Applicant Brinkmann Corporation.

As grounds for this motion, Opposer states as follows:

(1) Applicant filed Application Serial No. 76/483,115 to register the mark BRINKMANN, which is the subject of the above-captioned opposition proceeding (hereinafter the "opposed application"), on January 17, 2003.

(2) The opposed application was published in the *Official Gazette* for purposes of opposition on October 5, 2004.

(3) The Trademark Trial and Appeal Board granted Opposer's Requests for Extension of Time to Oppose the opposed application

in its Orders dated November 2, 2004, November 9, 2004[1] and January 26, 2005, resulting in the statutory deadline for the filing of a notice of opposition against the opposed application ultimately being extended to April 3, 2005.

(4) Opposer filed the subject opposition against the opposed application on April 1, 2005, objecting to registration of the mark BRINKMANN in connection with specific goods identified in International Class 9 (*viz.*, home security systems and components therefore, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets) within the extension of the opposition period.

(5) Applicant's Answer to the Notice of Opposition, filed on May 16, 2005, pleads the affirmative defense of laches based on an allegation that Opposer unreasonably delayed in asserting its objection to registration of the mark BRINKMANN shown in the opposed application in connection with specific goods in International Class 9.

(6) In the context of an *inter partes* proceeding before the Trademark Trial and Appeal Board, the time period for calculating the delay which is an essential element of the laches defense commences

[1] The Orders dated November 2, 2004 and November 9, 2004 both are directed to Opposer's First Request for Extension of Time to Oppose for Good Cause. Both Orders extended the deadline to February 2, 2005.

when a party could first object to registration of the mark at issue, *i.e.*, the time the application in question is published for opposition.

(7) Opposer filed its notice of opposition within the statutory timeframe after publication of the opposed application as duly extended by the Board. Accordingly, there is no genuine issue of material fact with respect to the duration of the delay required to establish a laches defense.

(8) As the delay in question is reasonable, Opposer is entitled to judgment as a matter of law dismissing Applicant's affirmative defense of laches.

The present motion is based on the prosecution history of the opposed application, the pleadings in this proceeding, the answer to Opposer's Interrogatory No. 22 set forth in Applicant Brinkmann's First Amended and Supplemental Response to Opposer Brink's Network's First Set of Interrogatories served on February 15, 2007,[2] and p. 67, lines 17-21, of the Rule 30(b)(6) deposition of Applicant taken pursuant to notice on February 16, 2007.[3]

A memorandum in support of this motion is submitted concurrently herewith.

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[2] A true copy of Applicant's Answer to Opposer's No. 22 as set forth in Applicant Brinkmann's First Amended and Supplemental Responses to Opposer Brink's Network's First Set of Interrogatories, at pp. 27-28, is annexed hereto as Appendix A.

[3] A true copy of p. 67, lines 17-21, of the Rule 30(b)(6) deposition of Applicant's designated deponent Helen Dunham taken on February 16, 2007 is annexed hereto as Appendix B.

BRINK'S NETWORK, INCORPORATED

Date: August 12, 2008

By: _____

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense was served on the following counsel of record for Applicant by Federal Express, with confirming service by depositing the same in the U.S. Mail, first class mail postage prepaid, this 12th day of August, 2008:

Gary A. Clark, Esq.
Susan Hwang, Esq.
Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071

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

BRINK'S NETWORK, INCORPORATED, Opposer, v. THE BRINKMANN CORPORATION, Applicant.	Opposition No. 91164764

APPLICANT BRINKMANN'S FIRST AMENDED AND SUPPLEMENTAL RESPONSES TO OPPOSER BRINK'S NETWORK'S FIRST SET OF INTERROGATORIES

Pursuant to FED. R. CIV. P. 33, Applicant The Brinkmann Corporation ("Brinkmann") hereby amends and supplements its responses to OPPOSER BRINK'S NETWORK, INCORPORATED'S FIRST SET OF INTERROGATORIES served by Opposer Brink's Network, Incorporated ("Brink's Network") by mail on September 6, 2005.

GENERAL OBJECTIONS

1. Brinkmann objects to each interrogatory insofar as it is vague, overly broad, oppressive, harassing or vexatious; imposes burden or expense that outweighs its likely benefit; seeks a legal conclusion; and/or seeks information not relevant to the claim or defense of any party.

position. In this regard, Brinkmann notes that Opposer has not yet provided any discovery to Brinkmann.

Brinkmann objects to this interrogatory on the ground of the work product doctrine.

Subject to and without waiving the foregoing objections, Brinkmann will identify documents and tangible things that support Brinkmann's position as its investigations and discovery progress.

Brinkmann reserves the right to amend and/or supplement this response as its investigations and discovery progress.

INTERROGATORY NO. 22:

State the factual basis for Applicant's affirmative defense pleaded in ¶ 26 of the Answer that the doctrine of laches bars the relief sought by Opposer.

RESPONSE TO INTERROGATORY NO. 22:

In addition to the grounds set forth in the General Objections, which are incorporated by reference, Brinkmann objects to this interrogatory on the following grounds:

Brinkmann objects that this interrogatory is premature because discovery has just commenced, and Brinkmann does not yet know, and cannot be expected to know without further investigation and discovery, the facts on which it will rely in support of its position. In this regard, Brinkmann notes that Opposer has not yet provided any discovery to Brinkmann.

Brinkmann objects to this interrogatory to the extent it seeks information protected by the attorney-client privilege and/or the work product doctrine.

Subject to and without waiving the foregoing objections, Brinkmann provides the following response:

As presently advised, the relevant facts demonstrating laches include, but are not limited to, the following:

- Brinkmann's home security system products have been on the market since at least as early as October 1989. Presumably Brink's Network has known, and certainly it should have known, about Brinkmann and its home security system products for many years prior to this opposition proceeding. Brink's Network has unreasonably delayed in filing this opposition proceeding after first learning about Brinkmann and its home security system products.
- Brinkmann has suffered prejudice as a result of Brink's Network unreasonable delay in filing the opposition proceeding. At a minimum, such prejudice includes Brinkmann's continued investment in its home security system products and "Brinkmann" mark for such products.

Brinkmann reserves the right to amend and/or supplement this response as its investigations and discovery progress.

INTERROGATORY NO. 23:

Identify all documents and tangible things upon which Applicant intends to rely to support the affirmative defense of laches pleaded in ¶ 26 of its Answer.

RESPONSE TO INTERROGATORY NO. 23:

In addition to the grounds set forth in the General Objections, which are incorporated by reference, Brinkmann objects to this interrogatory on the following grounds:

Brinkmann objects that this interrogatory is premature because discovery has just commenced, and Brinkmann does not yet know, and cannot be expected to know without further investigation and discovery, all documents and tangible things on which it will rely in support of

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
2 THE TRADEMARK TRIAL AND APPEAL BOARD
3 BRINK'S NETWORK)
INCORPORATED,) Certified Copy
4)
Opposer,)
5 VS.) Opposition No. 91164764
)
6 THE BRINKMANN CORPORATION)
)
7 Applicant.)
)
8)
9 **********
10 ORAL DEPOSITION OF
11 HELEN DUNHAM
12 FEBRUARY 16, 2007
13 VOLUME I
14 **********
15
16 ORAL DEPOSITION OF HELEN DUNHAM, produced as
17 a witness at the instance of the Opposer, and duly
18 sworn, was taken in the above-styled and numbered cause
19 on the 16th day of February, 2007, from 9:03 a.m. to
20 10:57 a.m., before Stacey R. Cruz, CSR in and for the
21 State of Texas, reported by machine shorthand, at the
22 offices of Carrington Coleman, Sloman & Blumenthal,
23 located at 901 Main Street, Dallas, Texas, in accordance
24 with the Federal Rules of Civil Procedure and the
25 provisions stated on the record or attached hereto.

1 witness ought to at least have a very basic definition of
2 what latches is. And if you want to take a break and
3 provide that, I'd be glad to continue.
4 MR. CLARK: And I disagree, counsel. The
5 witness is here as a factual witness. Facts are
6 presented in response to interrogatory number 22. You
7 can ask her if she has been provided any additional facts
8 to -- to -- go forward with the --
9 MR. COOPER: All right. Let's try to --
10 MR. CLARK: -- deposition and you can ask her
11 about the facts that are stated there. She's not here as
12 a legal witness to argue our case.
13 MR. COOPER: Well, answers is peculiarly
14 factual. I'm entitled to interrogate a witness on these
15 points, and I'll proceed by focusing on the answer to
16 interrogatory number 22.
17 Q. (BY MR. COOPER) Ms. Dunham -- and I'm asking you
18 this in your 30(b)(6) capacity -- are you aware of any
19 relevant facts demonstrating latches other than the ones
20 listed at passages 24 and 25 of Exhibit 2?
21 A. No, I'm not.
22 Q. Are you aware of any documents that support the
23 latches defense -- any documents that support -- let's do
24 this one at a time.
25 Are you aware of any documents that support

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BRINKMANN CORPORATION	)	
	)	
Applicant	)	

MEMORANDUM IN SUPPORT OF OPPOSER'S
MOTION FOR PARTIAL SUMMARY JUDGMENT
DISMISSING APPLICANT'S LACHES DEFENSE

I. INTRODUCTION

This matter is before the Board on Opposer's motion pursuant to Rule 56 Fed. R. Civ. P. and Rule 2.127 of the Trademark Rules of Practice, which respectfully requests the Board to grant summary judgment dismissing the laches defense asserted by Applicant. Opposer's motion is based on the prosecution history of Application Serial No. 76/483,115, (the "opposed application"), the pleadings in the present proceeding, Applicant's answer to Opposer's Interrogatory No. 22, and p. 67, lines 17-21, of the transcript of the discovery deposition of Applicant's designated Rule 30(b)(6) deponent Helen Dunham, all of which demonstrate that there are no genuine issues of material fact with respect to the critical unreasonable delay element of Applicant's laches defense and that Opposer is entitled to judgment as a matter of law dismissing that affirmative defense.

II. STATEMENT OF UNCONTESTED MATERIAL FACTS

On January 17, 2003, Applicant filed the opposed application seeking to register the mark BRINKMANN for a variety of goods including home security systems and components therefore in International Class 9. By virtue of the Order entered by the Board on June 28, 2005, the relevant portion of the goods in International Class 9 to which the present opposition is directed consists of "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets" (hereinafter "home security systems and components therefor").

The opposed application was published for opposition on October 5, 2004. Opposer filed Requests for Extension of Time to Oppose, which were granted by the Board on November 2, 2004, November 9, 2004[1] and January 26, 2005, thus ultimately extending the statutory deadline for the filing of a notice of opposition to April 3, 2005. Opposer filed a timely Notice of Opposition to the opposed application on April 1, 2005.

This opposition is based on Opposer's prior use and registration of the marks BRINK'S, BRINK'S & Design and BRINK'S HOME SECURITY for residential and commercial security systems and related residential and commercial security alarm and monitoring services, among other goods and services. The principal ground for opposition is that Applicant's use of the mark BRINKMANN for home security systems and components therefor is likely to cause confusion as to the source and/or

[1] The Orders dated November 2, 2004 and November 9, 2004 are both directed to Opposer's First Request for Extension of Time to Oppose for Good Cause. Both of those Orders extended the deadline to February 2, 2005.

sponsorship of Applicant's goods within the meaning of § 2(d) of the Federal Trademark Act.

Applicant's Answer, filed on May 16, 2005, asserts *inter alia* the affirmative defense of laches based on the allegation that Opposer "is precluded by the doctrine of laches from opposing Applicant Brinkmann's U.S. trademark application serial No. 76/483,115." (Answer, ¶ 26.)

Opposer's Interrogatory No. 22 inquired as to the factual basis of Applicant's laches defense pleaded in ¶ 26 of Applicant's answer. Applicant's answer to Opposer's Interrogatory No. 22 makes the following statement with respect to the factual basis for the unreasonable delay element of the laches defense:

> Brinkmann's home security system products have been on the market since at least as early as October 1989. Presumably Brink's Network has known, and certainly should have known, about Brinkmann and its home security system products for many years prior to this opposition proceeding. Brink's Network has unreasonably delayed in filing this opposition proceeding after first learning about Brinkmann and its home security products."[2]

During the deposition of Applicant's deponent Helen Dunham, she was asked in her Rule 30(b)(6) capacity where Applicant was aware of any relevant facts demonstrating laches other than those set forth in the Answer to Opposer's Interrogatory No. 22 and answered that Applicant was not aware of any other facts.[3]

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[2] A true copy of Applicant's Answer to Opposer's Interrogatory No. 22 is attached as Exhibit A to Opposer's Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense.

[3] A true copy of the relevant portion of Ms. Dunham's deposition transcript is annexed to Opposer's Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense as Exhibit B.

As discussed below, Applicant cannot demonstrate the unreasonable delay required to sustain a laches defense in an opposition proceeding. Accordingly, the Board should grant summary judgment in favor of Opposer dismissing the laches defense.

III. STANDARDS APPLICABLE TO SUMMARY JUDGMENT

Pursuant to Rule 56(c) Fed. R. Civ. P., summary judgment should be granted when the record presents no genuine issue of material fact and, based upon the undisputed facts, the moving party is entitled to judgment as a matter of law. *See, e.g., Celotex Corp. v. Catrett,* 477 U.S. 317, 322-323 (1986). The substantive law governing the civil action or proceeding will identify those facts that are material, and "only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment." *Anderson v. Liberty Lobby, Inc.* 477 U.S. 242, 249 (1986).

When the summary judgment motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law, the burden shifts to the non-movant to demonstrate the existence of specific genuinely-disputed facts that will need to be resolved at trial. *E.g., Fram Trak Industries, Inc. v. Wiretracks LLC,* 77 USPQ2d 2000 (TTAB 2006). While the non-moving party is not required to present its entire case in response to a motion for summary judgment, "to defeat the motion the non-movant must present sufficient evidence to show an evidentiary conflict as to the material fact in dispute, . . . with due consideration to the evidentiary burdens. . . ." *Opryland USA Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 850 (Fed. Cir. 1992). The non-

movant may not rest on the mere allegations of its pleadings and the arguments of counsel, but must designate specific portions of the record or produce additional evidence that shows the existence of a genuine issue of material fact. *E.g. Fram Trak Industries, Inc. v. Wiretracks LLC, supra.*

As in this instance, one of the principal purposes of the summary judgment procedure is to narrow the issues for trial. For the reasons discussed below, summary judgment dismissing Applicant's laches defense should be entered thereby avoiding the necessity of the parties addressing this baseless affirmative defense during their testimony periods and alleviating the burden on the Board of dealing with that defense when a decision is rendered.

IV. ARGUMENT

In the context of an *inter partes* proceeding before the Trademark Trial and Appeal Board, there is no opportunity for an opposer to challenged the applicant's right to registration of the mark in issue until the opposed application is published for opposition. *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572 (Fed. Cir. 1991). Although the *National Cable* case concerned an appeal from a decision rendered in the context of a cancellation proceeding, the Court of Appeals for the Federal Circuit stated, in relevant part, as follows:

> We conclude that there is no precedent which requires us to determine laches in an *opposition* or cancellation proceeding under a standard based on the time running from knowledge of use rather than knowledge of the application for registration. 937 F.2d at 1581 (Emphasis added).

Accordingly, for purposes of determining laches in an opposition proceeding, the period for measuring the alleged unreasonable delay starts to run when the opposed

application is published for opposition. *See, e.g., Callaway Vineyard & Winery v. Endsley Capital Group*, 63 USPQ2d 1919, 1923 (TTAB 2002) ("inasmuch as opposer promptly opposed registration of applicant's mark, applicant has no basis for the defenses of laches"); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1295 (TTAB 1999) ("laches can only begin from the first time when opposer could object to registration; i.e. the date when an application is published for opposition"); *DAK Indus., Inc. v. Daiichi Kosho Co., Ltd.,* 25 USPQ2d 1622, 1624 (TTAB 1992).

The *National Cable* decision and its progeny clearly stand for the basic proposition that the time period for calculating delay for purposes of laches commences when the application in question is published for opposition. The opposed application in this instance was published for opposition in the *Official Gazette* on October 5, 2004. It is undisputed that Opposer timely filed its notice of opposition within the statutory timeframe after publication of the opposed application as duly extended by the Board. Thus, even accepting *arguendo* that Opposer was aware of Applicant's use of the mark BRINKMANN "for many years" (which has not been established), any such delay would not be relevant in the present context because there was no opportunity for Opposer to challenge Applicant's right to register BRINKMANN for home security systems and components therefor until the opposed application was published for opposition on October 5, 2004.

In this instance, it is undisputed that the opposed application to register the mark BRINKMANN for home security systems and components therefor was published for opposition purposes on October 5, 2004, and that the Notice of Opposition was timely filed on April 1, 2005. A "delay" of that magnitude cannot rise to the level of laches,

particularly where the Notice of Opposition was filed within the time period established by the Board in its Orders granting Opposer's requests for extension of the opposition period. Accordingly, Opposer is entitled to judgment as a matter of law dismissing Applicant's laches defense.

V. CONCLUSION

For all of the foregoing reasons, summary judgment should be entered as a matter of law dismissing Applicant's affirmative defense of laches.

BRINK'S NETWORK, INCORPORATED

Dated: August 12, 2008

By: _____

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Memorandum in Support of Opposer's Motion For Partial Summary Judgment Dismissing Applicant's Laches Defense was served on the following counsel of record for Applicant by Federal Express, with confirming service by depositing the same in the U.S. Mail, first class mail postage prepaid, this 12th day of August, 2008:

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