

ESTTA Tracking number: **ESTTA242439**

Filing date: **10/14/2008**

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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
Correspondence Address	ALAN S. COOPER HOWERY SIMON ARNOLD & WHITE LLP 1299 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 UNITED STATES lapidusn@howrey.com, ipdocketing@howrey.com, figginsl@howrey.com, coopera@howrey.com
Submission	Other Motions/Papers
Filer's Name	Alan S. Cooper
Filer's e-mail	coopera@howrey.com, lapidusn@howrey.com, mckeons@howrey.com, ipdocketing@howrey.com, mckeons@howrey.com
Signature	/Alan S. Cooper/
Date	10/14/2008
Attachments	Motion.pdf ( 4 pages )(133211 bytes ) Declaration of Kristin T. D'Andrea.pdf ( 36 pages )(983055 bytes ) Memorandum.pdf ( 16 pages )(697165 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
	)	
THE BRINKMANN CORPORATION	)	
	)	
Applicant	)	

MOTION TO DEFER CONSIDERATION  
OF APPLICANT'S MOTION FOR PARTIAL  
SUMMARY JUDGMENT TO DISMISS  
OPPOSER'S CLAIM OF DILUTION

On or about September 23, 2008, Applicant filed a paper entitled "Applicant Brinkmann's Motion for Partial Summary Judgment to Dismiss Opposer's Claim of Dilution" (hereinafter "Applicant's partial summary judgment motion"). In accordance with Rule 2.127(d) of the Trademark Rules of Practice, 37 C.F.R. § 2.127(d), Opposer respectfully requests the Board to defer consideration of Applicant's partial summary judgment motion pending a resumption of proceedings after a decision has been rendered on Opposer's Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense (hereinafter "Opposer's summary judgment motion").

The grounds for this motion are as follows:

- (1) The Notice of Opposition in this proceeding sets forth two grounds for opposition, namely, likelihood of confusion and likelihood of dilution under §§ 2(d) and 43(c) of the Federal Trademark Act, respectively.

- (2) Paragraph 26 of the Answer to the Notice of Opposition pleads laches as an affirmative defense to the opposition in its entirety.
- (3) Opposer's summary judgment motion seeking dismissal of the affirmative defense of laches pleaded in Applicant's Answer to the Notice of Opposition was filed on August 12, 2008.
- (4) The Board entered an Order on August 19, 2008, pursuant to Rule 2.127(d) of the Trademark Rules of Practice, suspending proceedings pending its decision on Opposer's summary judgment motion. That Order specifically states that "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration."
- (5) An affirmative defense by definition admits the elements of the plaintiff's *prima facie* case, but seeks to avoid the imposition of liability based on facts that are outside the scope of that *prima facie* case.
- (6) In the context of the affirmative defense of laches in an opposition proceeding, the applicant admits that the opposer has established a *prima facie* case with respect to the grounds for opposition (e.g., confusion and/or dilution is likely), but that the relief sought is precluded based on facts outside those grounds for opposition; namely, that the opposer has unreasonably delayed in contesting registration of the mark in question for all or certain goods or services.
- (7) Applicant's partial summary judgment motion, although purportedly predicated on its laches defense, in reality is directed to the merits of Opposer's dilution claim and not whether that claim is precluded by some unreasonable delay.

(8) Accordingly, Applicant's partial summary judgment motion is not relevant to Opposer's summary judgment motion seeking dismissal Applicant's laches defense within the meaning of Rule 2.127(d) of the Trademark Rules of Practice and thus violates the suspension Order entered on August 19, 2008.

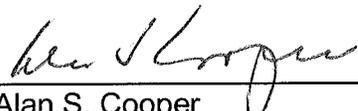
For the reasons stated above, the Board should defer consideration of or any action on Applicant's partial summary judgment motion, which is directed to the merits of Opposer's dilution claim, until proceedings are resumed following a decision on Opposer's summary judgment motion filed on August 12, 2008.

Opposer also requests the Board to set a new schedule to provide Opposer with thirty days to submit its substantive opposition to Applicant's partial summary judgment motion, as prescribed in Rule 2.127(e)(1) of the Trademark Rules of Practice, upon the resumption of proceedings after the Board renders a decision on Opposer's summary judgment motion.

A memorandum and the Declaration of Kristin D'Andrea in support of this motion are submitted concurrently herewith.

BRINK'S NETWORK, INCORPORATED

Date: October 14, 2008

By:   
\_\_\_\_\_  
Alan S. Cooper  
Nancy S. Lapidus  
Jason A. Cody  
Howrey LLP  
1299 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
(202) 783-0800  
Fax: (202) 383-7195

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Motion to Defer Consideration of Applicant's Motion for Partial Summary Judgment to Dismiss Opposer's Claim of Dilution 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 14th day of October, 2008:

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



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Supplemental Responses to Opposer's First Set of Interrogatories which was marked as Dunham Dep. Ex. 1.

(4) Attached hereto as Appendix C is a true copy of pp. 19-21 of the deposition of Helen Dunham, Applicant's Rule 30(b)(6) witness, taken on February 16, 2007 (hereinafter "Dunham Dep.>").

(5) Attached hereto as Appendix D is a true copy of Dunham Dep. pp. 28-32.

(6) Attached hereto as Appendix E is a true copy of Dunham Dep. Ex. 6.

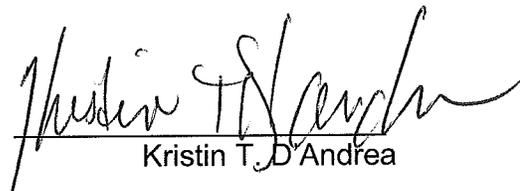
(7) Attached hereto as Appendix F is a true copy of Dunham Dep. p. 35.

(8) Attached hereto as Appendix G is a true copy of Dunham Dep. p. 70.

(9) Attached hereto as Appendix H is a true copy of Dunham Dep. pp. 37-38.

In accordance with 28 U.S.S. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Executed at Washington, D.C., this 14th day of October, 2008.

  
Kristin T. D'Andrea

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Declaration of Kristin T. D'Andrea in Support Of Opposer's Motion to Defer Consideration of Applicant's Motion for Partial Summary to Dismiss Opposer's Claim of Dilution 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 14th day of October, 2008:

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

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# APPENDIX A

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

BRINK'S NETWORK )  
INCORPORATED, )  
 )  
Opposer, )

**Certified Copy**

VS. ) Opposition No. 91164764  
 )

THE BRINKMANN CORPORATION )  
 )  
Applicant. )  
 )  
 )

\*\*\*\*\*

ORAL DEPOSITION OF  
HELEN DUNHAM  
FEBRUARY 16, 2007  
VOLUME I

\*\*\*\*\*

ORAL DEPOSITION OF HELEN DUNHAM, produced as  
a witness at the instance of the Opposer, and duly  
sworn, was taken in the above-styled and numbered cause  
on the 16th day of February, 2007, from 9:03 a.m. to  
10:57 a.m., before Stacey R. Cruz, CSR in and for the  
State of Texas, reported by machine shorthand, at the  
offices of Carrington Coleman, Sloman & Blumenthal,  
located at 901 Main Street, Dallas, Texas, in accordance  
with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

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 RESPONSES TO OPPOSER BRINK'S  
NETWORK'S FIRST SET OF INTERROGATORIES

Pursuant to FED. R. CIV. P. 33 and 37 C.F.R. § 2.120, Applicant The Brinkmann Corporation ("Brinkmann") hereby responds 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.

$\Delta \pi$ EXHIBIT <u>  2  </u>
Deponent _____
Date _____ Rptr. _____
WWW.DEPOBOOK.COM

discuss Brink's Network's filing of the first request for extension of time to file the Notice of Opposition.

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

**INTERROGATORY NO. 6:**

Identify with specificity all goods Applicant provides under the mark BRINKMANN which Applicant believes to be included in the description "home security systems and components therefor."

**RESPONSE TO INTERROGATORY NO. 6:**

Subject to and without waiving the General Objections, which are incorporated by reference, Brinkmann provides the following response:

Brinkmann considers the following products offered under the mark BRINKMANN to be included in the description "home security systems and components therefor":

- Home Security Solar Motion Activated Lighting System, and all components thereof
- Solar Home Security SL-7 Motion Detector
- Solar Home Security SL-8 Motion Detector
- Home Security Halogen Motion Detector
- Home Security 110° Motion Detector
- Home Security 180° Motion Detector
- Home Security Wireless Security System, and all components thereof

Brinkmann offers replacement lamps for these products.

# **APPENDIX B**

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

3 BRINK'S NETWORK )  
4 INCORPORATED, )  
5 Opposer, )

**Certified Copy**

6 VS. ) Opposition No. 91164764

7 THE BRINKMANN CORPORATION )  
8 Applicant. )

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.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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BRINK'S NETWORK, INCORPORATED,

Opposer,

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THE BRINKMANN CORPORATION,

Applicant.

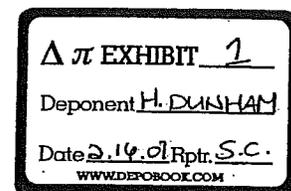
Opposition No. 91164764

**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.



discuss Brink's Network's filing of the first request for extension of time to file the Notice of Opposition.

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Brinkmann considers the following products offered under the mark BRINKMANN to be included in the description "home security systems and components therefor":

- Home Security Solar Motion Activated Lighting System, and all components thereof
- Solar Home Security SL-7 Motion Detector
- Solar Home Security SL-8 Motion Detector
- Home Security Halogen Motion Detector
- Home Security 110° Motion Detector
- Home Security 180° Motion Detector
- Home Security Wireless Security System, and all components thereof

Brinkmann offers replacement lamps for these products.

# APPENDIX C

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE

THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK )  
INCORPORATED, )

**Certified Copy**

Opposer, )

VS. ) Opposition No. 91164764

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Applicant. )

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1 MR. COOPER: Mr. Clark, I assume that if any  
2 additional information would have been uncovered that  
3 related to interrogatory number 1, it would have been  
4 included in what was served yesterday?

5 MR. CLARK: Correct, counsel.

6 MR. COOPER:: Which is Exhibit 1.

7 Q. (BY MR. COOPER) Ms. Dunham-- I don't think  
8 Mr. Clark will disagree with me, but in this opposition  
9 proceeding shortly after the notice of opposition was  
10 filed, Brinkmann Corporation amended the home security  
11 part of the description -- home security products part of  
12 the description in the opposed application, and it now  
13 reads as, quote, Home security systems and components  
14 therefore; namely, motion-sensitive home security lights,  
15 detectors, receivers, transmitters and wall-mount  
16 brackets.

17 A. Okay.

18 Q. Closed quotes.

19 Okay. In that context, the wall-mount  
20 brackets are wall-mount brackets for home security  
21 products, correct?

22 A. Correct.

23 Q. Okay. Would you please look at interrogatory  
24 number 6 in Exhibit 2?

25 A. (Witness complies.)

1 Q. There is a listing there that's about two-thirds  
2 down the page of the products offered under the mark  
3 "Brinkmann" that are included in the description, quote  
4 Home security systems and components therefore. Do you  
5 see that?

6 A. Yes.

7 Q. There are one, two, three, four, five, six, seven  
8 products, correct?

9 A. One, two, three, four, five, six.

10 Q. Let me read them.

11 A. Okay.

12 Q. The first is home security solar motion-activated  
13 lighting system --

14 A. Okay.

15 Q. -- and all components thereof, correct?

16 A. Yes.

17 Q. The next is solar home security SL-7 motion  
18 detector, correct?

19 A. Yes.

20 Q. The next is solar home security SL-8 motion  
21 director, correct?

22 A. Okay. Yes.

23 Q. And the next is home security halogen motion  
24 detector, correct?

25 A. Yes.

1 Q. And the next is home security 110-degree motion  
2 detector, correct?

3 A. Yes.

4 Q. And the next is home security 180-degree motion  
5 detector, correct?

6 A. Yes.

7 Q. And the last is home security wireless security  
8 system and all components thereof, correct?

9 A. Yes.

10 Q. And since the answer to the interrogatories are  
11 not verified, can I ask you, please, to confirm that this  
12 is an accurate statement with respect to the products  
13 that are included in the description "home security  
14 systems and components therefore"?

15 A. Yes.

16 MR. COOPER: Let me ask the reporter to mark  
17 as Dunham Deposition Exhibit 3 a document produced by  
18 Brinkmann Corporation bearing production No. BM 01702.

19 (Exhibit Number 3 marked.)

20 Q. (BY MR. COOPER) Ms. Dunham, would you please look  
21 at Exhibit 3.

22 A. Yes.

23 Q. Do you recognize that?

24 A. Yes.

25 Q. This is a -- packaging for a Brinkmann home

# **APPENDIX D**

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INCORPORATED, )  
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**Certified Copy**

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sworn, was taken in the above-styled and numbered cause  
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10:57 a.m., before Stacey R. Cruz, CSR in and for the  
State of Texas, reported by machine shorthand, at the  
offices of Carrington Coleman, Sloman & Blumenthal,  
located at 901 Main Street, Dallas, Texas, in accordance  
with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

1 blank spot in the deposition transcript here and ask you,  
2 after the deposition is over, to confirm that "Brinkmann"  
3 is used as a trademark on labels or tags affixed to the  
4 components and so indicate in that blank space; is that  
5 agreeable?

6 MR. CLARK: Well, except that the question, I  
7 think, is a little unclear. You're asking as to every  
8 product in the home security --

9 MR. COOPER: Generally. Or labels or tags  
10 generally used on the various home security products so  
11 we have trademark use on the product as well as on  
12 packaging.

13 MR. CLARK: All right. So long as it's  
14 understood --

15 MR. COOPER: General.

16 MR. CLARK: -- the answer doesn't require it  
17 on every product.

18 MR. COOPER: Of course. Of course.

19 A. \_\_\_\_\_  
20 \_\_\_\_\_

21 MR. COOPER: I've asked the reporter to mark  
22 as Exhibit 6, Dunham Exhibit 6, a copy of registration  
23 number 1153730, which was produced as document BM 001706.

24 (Exhibit Number 6 was marked.)

25 Q. (BY MR. COOPER) Ms. Dunham, do you recognize

1 Exhibit 6?

2 A. Yes.

3 Q. Now, this registration issued on May 12, 1981. Is  
4 that what it shows?

5 A. Yes.

6 Q. Okay. That was before you began your employment  
7 with Brinkmann Corporation?

8 A. Yes.

9 Q. Okay. If you would look, please, in about the  
10 middle of the page on the right-hand side after the word  
11 "for," it has, quote, Electrical extension cords,  
12 brackets, radar detectors, semicolon, and electronic  
13 metal detectors, headphones and search coils and  
14 electrical connectors for use therewith. Do you see  
15 that?

16 A. Yes.

17 Q. Okay. Some of the wording here specifically  
18 "radar detectors and electronic metal detectors,  
19 headphones and search coils" has been lined through. Do  
20 you see that?

21 A. Yes.

22 Q. What does that mean?

23 A. I don't know what that means.

24 MR. COOPER: Mr. Clark, can we agree that  
25 what this means is, is that when this registration was

1 renewed in 2001, these goods were deleted? The  
2 lined-through goods?

3 MR. CLARK: Well, I'm -- the record will  
4 speak for itself on the renewal. I believe you're right  
5 about that, whether the lined-through is -- relates to  
6 that, I don't know.

7 MR. COOPER: Okay.

8 MR. CLARK: I -- I don't know what that  
9 means.

10 MR. COOPER: But I think if you looked at a  
11 copy of the registration as it appears on the US Patent  
12 and Trademark Office website, you would see that radar  
13 detectors and electronic metal detectors, headphones and  
14 search coils are within brackets.

15 MR. CLARK: Right.

16 MR. COOPER: That generally means that those  
17 goods have been deleted in the renewal, correct?

18 MR. CLARK: I agree with that.

19 MR. COOPER: Okay.

20 Q. (BY MR. COOPER) Okay. Now, electrical extension  
21 cords are not among the list of home security products  
22 listed in interrogatory number 6; is that correct?

23 A. No.

24 Q. It's not correct?

25 A. I'm sorry.

1 Q. Let me try to ask the question again.

2 A. I'm sorry.

3 Q. We have the agreed list of home security systems  
4 and components listed in the answer to interrogatory  
5 number 6 on page 8 of Exhibit 2, correct?

6 A. Yes.

7 MR. CLARK: Why don't you look --

8 Q. (BY MR. COOPER) Look at that, please.

9 A. Okay.

10 Q. Electrical extension cords are not among those  
11 items, correct?

12 A. Well, there are -- there is an electric cord that  
13 goes from some of these products.

14 Q. An electric extension cord is a cord that is used  
15 in a home or an office so that you can attach a -- some  
16 sort of an electrical device to a electrical outlet that  
17 is too far away for the cord, from the device, to reach;  
18 is that correct?

19 A. Yes.

20 Q. Okay.

21 A. So, no, it's not.

22 Q. Right. And radar detectors are not among the  
23 items listed in the answer to interrogatory number 6,  
24 correct?

25 A. Yes.

1 Q. And electronic metal detectors, headphones and  
2 search coils are not among the items listed in the answer  
3 to interrogatory number 6, correct?

4 A. Right.

5 Q. And electric connectors for use in connection with  
6 electronic metal detectors are not listed in  
7 interrogatory number 6, correct?

8 A. Correct.

9 Q. Okay.

10 MR. COOPER: I asked the reporter to mark as  
11 Dunham Deposition Exhibit 7 a copy of a -- an item that I  
12 will represent, Mr. Clark, was one of the specimens found  
13 in the file history or registration number 1153730.

14 (Exhibit Number 7 was marked.)

15 Q. (BY MR. COOPER) Ms. Dunham, do you recognize  
16 Exhibit 7?

17 A. Yes.

18 Q. This is a counter display for the Q-beam portable  
19 electric spotlight; is that correct?

20 A. Yes.

21 Q. And do you recognize that product?

22 A. Yes.

23 Q. And this shows a -- it says it has a cigarette  
24 lighter receptacle; is that correct?

25 MR. COOPER: Excuse me one second, please.

# **APPENDIX E**

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with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

at. Cls.: 9 and 11

Prior U.S. Cls.: 21, 26 and 34

Reg. No. 1,153,730

Registered May 12, 1981

United States Patent and Trademark Office

TRADEMARK  
Principal Register

**BRINKMANN**

The Brinkmann Corporation (Texas corporation)  
4215 McEwen Rd.  
Dallas, Tex. 75240

For: ELECTRICAL EXTENSION CORDS,  
BRACKETS, RADAR ~~DETECTORS~~, AND  
ELECTRONIC ~~METAL DETECTORS~~, HEAD-  
PHONES AND SEARCH COILS, AND ELEC-  
TRIC CONNECTORS FOR USE THEREWITH, in  
CLASS 9 (U.S. Cls. 21 and 26).

First use Jun. 12, 1978; in commerce Jun. 12, 1978.

For: CHARCOAL FIRED AND ELECTRIC  
ROASTING, GRILLING AND BARBECUE  
COOKERS FOR DOMESTIC USE AND PORTA-  
BLE ELECTRIC LIGHTS AND FILTERS, AND  
REPLACEMENT LAMPS, in CLASS 11 (U.S. Cls:  
21 and 34).

First use Aug. 24, 1978; in commerce Aug. 24,  
1978.

Ser. No. 193,053, filed Nov. 13, 1978.

ABRAM I. SACHS, Primary Examiner

$\Delta \pi$ EXHIBIT <u>e</u>
Deponent _____
Date _____ Rptr. _____
WWW.DEPOBOOK.COM

BM 001706

# **APPENDIX F**

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

BRINK'S NETWORK )  
INCORPORATED, )

**Certified Copy**

Opposer, )

VS. ) Opposition No. 91164764

THE BRINKMANN CORPORATION )

Applicant. )

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ORAL DEPOSITION OF

HELEN DUNHAM

FEBRUARY 16, 2007

VOLUME I

\*\*\*\*\*

ORAL DEPOSITION OF HELEN DUNHAM, produced as  
a witness at the instance of the Opposer, and duly  
sworn, was taken in the above-styled and numbered cause  
on the 16th day of February, 2007, from 9:03 a.m. to  
10:57 a.m., before Stacey R. Cruz, CSR in and for the  
State of Texas, reported by machine shorthand, at the  
offices of Carrington Coleman, Sloman & Blumenthal,  
located at 901 Main Street, Dallas, Texas, in accordance  
with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

1 A. No.

2 Q. Are you aware of any registrations of the  
3 trademark "Brinkmann" for the home security products that  
4 are listed -- cover the home security products listed in  
5 the answer to interrogatory number 6 in Exhibit 2?

6 A. I'm sorry. Can you repeat that, please?

7 Q. Okay. One of the areas that we are asking about  
8 in the deposition is prior registrations that Brinkmann  
9 Corporation owns that purportedly cover home security  
10 products. The one that was produced is the registration  
11 which has been marked as Exhibit Number 6.

12 A. Okay.

13 Q. My question to you is: Are you aware of any other  
14 registrations of Brinkmann that purportedly cover home  
15 security products?

16 A. No.

17 MR. COOPER: All right. I asked the reporter  
18 to mark as Dunham Deposition Exhibit 9 a copy of the file  
19 history of application serial number 76483115, which is  
20 the application involved in this opposition proceeding.

21 (Exhibit Number 9 was marked.)

22 Q. (BY MR. COOPER) Ms. Dunham, do you recognize  
23 Exhibit Number 9?

24 A. No.

25 Q. Well, I'm going to be asking you some questions

# APPENDIX G

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

3 BRINK'S NETWORK )  
4 INCORPORATED, )  
5 )  
6 Opposer, )

**Certified Copy**

7 VS. ) Opposition No. 91164764

8 THE BRINKMANN CORPORATION )  
9 )  
10 Applicant. )  
11 )  
12 )

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13 ORAL DEPOSITION OF  
14 HELEN DUNHAM  
15 FEBRUARY 16, 2007  
16 VOLUME I

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24 located at 901 Main Street, Dallas, Texas, in accordance  
25 with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

1 them support the latches defense, counsel, but certainly  
2 the sales history documents and the advertising documents  
3 support the position that Brinks should have known about  
4 Brinkmann and its home security systems and they also  
5 support the prejudice, the continued investment, in those  
6 products and the use of the "Brinkmann" mark in those  
7 products.

8 MR. COOPER:: Well, this is not a question,  
9 but I think we probably will be moving for summary  
10 judgment and dismissing the latches defense, and we'll  
11 test some of these points in that context. Give me just  
12 a minute, please. Go off the record.

13 (Break taken.)

14 MR. COOPER: I have no further questions  
15 under direct examination.

16 MR. CLARK: I have no questions.

17 (Proceedings concluded.)

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# APPENDIX H

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

BRINK'S NETWORK )  
INCORPORATED, )  
 )  
Opposer, )

**Certified Copy**

VS. ) Opposition No. 91164764  
 )

THE BRINKMANN CORPORATION )  
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Applicant. )  
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located at 901 Main Street, Dallas, Texas, in accordance  
with the Federal Rules of Civil Procedure and the  
provisions stated on the record or attached hereto.

1 Q. Is she still with the company?

2 A. No.

3 Q. Do you know where she is now?

4 A. No, I don't.

5 Q. And would decisions to file applications for  
6 federal registrations of trademark have been part of  
7 Ms. McDonald's responsibilities?

8 A. Yes.

9 Q. The next question I'm asking you is in your Rule  
10 30(b)(6) capacity as -- as actually all the other  
11 questions are -- what were the reasons for filing the  
12 application that's been marked as Exhibit 9? And I am  
13 not inquiring as to any advice from counsel.

14 A. The Brinkmann trademark came up for renewal. And  
15 at that time --

16 MR. COOPER: Excuse me for interrupting. You  
17 said the Brinkmann trademark came up for renewal. You're  
18 referring to the registration number 1153730 marked as  
19 Exhibit 6?

20 THE WITNESS: Yes.

21 MR. CLARK: I'm sorry. Go ahead.

22 A. Okay. It came up for renewal, and we were just --  
23 we decided to file in -- in all the classes that we were  
24 using the mark.

25 Q. (BY MR. COOPER) So you didn't think that

1 Exhibit 6 provided sufficient reg- -- sufficient coverage  
2 in terms of products?

3 A. Exhibit 6?

4 Q. Exhibit 6 is the registration that came up for  
5 renewal.

6 A. Okay. That trademark?

7 Q. Yes.

8 A. Okay. Well, I think we realized at that point,  
9 that it didn't cover all of our products, and therefore  
10 we decided to file in all the classes that would cover  
11 our products.

12 Q. Okay. Do you know if Ms. McDonald consulted with  
13 counsel? And that's -- I'm not asking for the substance  
14 of the consultation, but whether or not she had any  
15 discussions with counsel about filing a new application?

16 A. Oh, I'm sure she did.

17 Q. And would that have been Mr. Clark?

18 A. Yes.

19 Q. Do you know whether any opinion was rendered by  
20 Mr. Clark or any other attorney regarding the filing of  
21 the application that has been marked as Exhibit 9?

22 MR. CLARK: And let me ask for clarification.  
23 Are you referring to a formal written opinion?

24 MR. COOPER:: Either written or verbal, but  
25 let's --



## II. PROCEDURAL BACKGROUND OF MOTION

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 therefor in International Class 9. After obtaining several extensions of the opposition period, Opposer timely filed a Notice of Opposition on April 1, 2005, directed to certain, but not all, of the goods in the International Class 9 portion of the opposed application, namely, "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").<sup>1</sup>

This opposition is based on Opposer's prior use and registration of the marks BRINK'S and BRINK'S HOME SECURITY, alone and in combination with designs, for residential and commercial security systems and related residential and commercial security alarm and monitoring services, among other goods and services. The grounds for opposition asserted in the Notice of Opposition are likelihood of confusion and likelihood of dilution under §§ 2(d) and 43(c) of the Federal Trademark Act, respectively.

Applicant's Answer, filed on May 16, 2005, asserts as an affirmative defense 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.)

On August 12, 2008, Opposer filed its Motion for Partial Summary Judgment Dismissing Applicant's Laches Defense (hereinafter "Opposer's summary judgment

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<sup>1</sup> The specific goods in question were clarified in the Board's Order entered on June 28, 2005.

motion"). In accordance with Rule 2.127(d) of the Trademark Rules of Practice, the Board entered an Order on August 19, 2008, suspending proceedings pending a decision on Opposer's summary judgment motion. That Order specifically states that "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration."<sup>2</sup>

On or about September 23, 2008, Applicant filed a paper entitled "Applicant Brinkmann's Motion for Partial Summary Judgment to Dismiss Opposer's Claim of Dilution" (hereinafter "Applicant's partial summary judgment motion"). Applicant's partial summary judgment motion is purportedly predicated on the assertion that "Opposer's allegation of dilution under Section 43(c) fails as a matter of law *because, on the undisputed record, Opposer is guilty of laches.*" (Applicant's Partial Summary Judgment Motion, p. 1; emphasis added.) However, as demonstrated below, Applicant's partial summary judgment motion in reality is directed to the merits of Opposer's dilution claim rather than any affirmative defense, and thus does not meet the relevancy requirement set forth in the Board's Order of August 19, 2008.

For the reasons discussed more fully below, Opposer respectfully requests the Board to defer consideration of Applicant's partial summary judgment motion pending a resumption of proceedings after a decision has been rendered on

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<sup>2</sup> On August 26, 2008, Opposer filed a motion to resume proceedings on the ground that Opposer's motion for partial summary judgment was not potentially dispositive of the proceedings. On September 12, 2008, the Board denied Opposer's motion to resume proceedings, finding that Opposer's motion for partial summary judgment dismissing the laches defense was potentially dispositive of that defense and thus that the suspension of proceedings was appropriate.

Opposer's summary judgment motion seeking dismissal of Applicant's laches defense.

### III. ARGUMENT

#### A. AS AN AFFIRMATIVE DEFENSE, LACHES IS DIRECTED TO MATTERS BEYOND OPPOSER'S CASE-IN-CHIEF ON ITS DILUTION CLAIM

Applicant correctly designated laches, as pleaded in ¶ 26 of its Answer, as an affirmative defense. However, Applicant's partial summary judgment motion fails to take into account that an affirmative defense, by definition, admits the elements of the plaintiff's *prima facie* case, but seeks to avoid the imposition of liability based on facts that are outside the scope of that *prima facie* case. See, e.g., Wright & Miller, *Federal Practice and Procedure*, § 1270 n. 2; *Ford Motor Co. v. Transport Indemnity Co.*, 795 F.2d 538, 546 (6th Cir.1986) (an affirmative defense raises matters extraneous to the plaintiff's *prima facie* case); *Gwin v. Curry*, 161 F.R.D. 70, 71 (N.D. Ill. 1995) (an affirmative defense accepts rather than contradicts the well-pleaded allegations in the complaint); *Federal Deposit Ins. Corp. v. Hurdman*, 655 F. Supp. 259, 262 (E.D. Cal. 1987) (affirmative defenses plead matters extraneous to the plaintiff's *prima facie* case which deny the plaintiff's right to recover even if the allegations of the complaint are true). In contrast, a defense that simply negates or controverts one or more elements of the plaintiff's *prima facie* case is not an affirmative defense. E.g., *Ford Motor Co. v. Transport Indemnity Co.*, 795 F.2d at 546.

Thus, in the context of a laches defense in an opposition proceeding, the applicant admits, solely for purpose of that defense, that the opposer has established a *prima facie* case with respect to the grounds for opposition (e.g., confusion and/or dilution is likely), but maintains that the relief sought is precluded

based on facts outside the grounds for opposition; namely, that the opposer has unreasonably delayed in contesting registration of the mark in question for all or certain goods or services.

As discussed more fully below, Applicant's partial summary judgment motion -- although purportedly predicated on its laches defense -- is essentially directed to the merits of Opposer's dilution claim, and not whether that claim is precluded by some unreasonable delay. Moreover, to the extent that Applicant's partial summary judgment motion arguably is directed to the laches defense as applied to Opposer's § 43(c) dilution claim, it totally ignores the question of when dilution became a cognizable basis for contesting registration in an *inter partes* proceeding before the Board.

**B. APPLICANT'S PARTIAL SUMMARY JUDGMENT MOTION IS DIRECTED TO THE MERITS OF OPPOSER'S DILUTION CLAIM**

Applicant argues that the fact that the present opposition "is limited to just a few goods in one class of Applicant Brinkmann's multi-class application . . . is fatal to Opposer's claim of alleged dilution." (Applicant's Partial Summary Judgment Motion, pp. 1-2.) The apparent basis for this contention is that the issuance of a registration based on the opposed application for goods other than home security systems and components therefore would somehow preclude any diluting effect with respect to the goods which are being challenged. Again, this argument goes to the merits of Opposer's dilution claim and is totally irrelevant to the laches defense which precipitated the suspension of proceedings by the Board.

The principal thrust of Applicant's partial summary judgment motion, as set forth at p. 11, is directed to the basic elements of a § 43(c) dilution claim, namely: (1) the opposer's mark is famous; (2) the opposer's mark became famous prior to the

use of the applicant's mark; and (3) the applicant's use of its mark is likely to cause dilution by blurring of the distinctiveness of the opposer's mark. *E.g., 7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1727 (TTAB 2007). Specifically, Applicant argues that Opposer's dilution claim is "fatally flawed" because Opposer cannot demonstrate that the marks pleaded in the Notice of Opposition have become famous and that those marks attained famous status prior to Applicant's first use of the mark BRINKMANN for home security systems and components.<sup>3</sup> (Applicant's Partial Summary Judgment Motion, pp. 13-14.) This argument clearly is directed to the merits of Opposer's dilution claim and has nothing to do with Applicant's laches defense.

Applicant also argues that the fact that the Notice of Opposition does not assert a § 43(c) dilution claim against all of the goods covered by the opposed application somehow precludes the assertion of a dilution claim directed to registration of the mark BRINKMANN for home security systems and components therefor. (Applicant's Partial Summary Judgment Motion, p. 19.) That argument plainly goes to the merits of the dilution claim, not whether it is precluded by laches and thus further demonstrates that Applicant's partial summary judgment motion is not relevant to Opposer's previously-filed summary judgment motion.

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<sup>3</sup> The listing of goods in International Class 9 in the opposed application and the drawing submitted therewith asserts a date of first use of June 12, 1978 for all such goods. In ¶ 3 of the Notice of Opposition, Opposer alleges that the June 12, 1978 date of first use is not applicable to home security systems and components therefor. Applicant's response to that allegation, as set forth in ¶ 3 of its Answer, admits that the June 12, 1978 date of first use "is not applicable to its home security systems and components (as properly defined)." Applicant has admitted that the actual date of first use of BRINKMANN for home security systems and components therefor is October 1989.

C. BECAUSE APPLICANT'S PARTIAL SUMMARY JUDGMENT MOTION IS NOT DIRECTED TO APPLICANT'S LACHES DEFENSE, IT IS NOT RELEVANT TO OPPOSER'S SUMMARY JUDGMENT MOTION AND ACCORDINGLY VIOLATES AUGUST 19, 2008 ORDER SUSPENDING PROCEEDINGS

As discussed above, it is clear that Applicant's partial summary judgment motion is essentially directed to the merits of Opposer's § 43(c) dilution claim rather than the laches defense.<sup>4</sup> Accordingly, Applicant's partial summary judgment motion is not relevant to Opposer's summary judgment motion within the meaning of Rule 2.127(d) of the Trademark Rules of Practice. For that reason, the filing of Applicant's partial summary judgment motion violates the Order suspending proceedings entered on August 19, 2008, and that motion should not be considered at this time.

D. TO THE EXTENT APPLICANT'S PARTIAL SUMMARY JUDGMENT MOTION IS PREDICATED ON LACHES, IT IS FATALLY FLAWED

1. Applicant's Partial Summary Judgment Motion Fails to Address the Critical Issue of When Dilution Became a Cognizable Basis for Contesting Registration in an *Inter Partes* Proceeding and Its Impact on the Unreasonable Delay Element of its Laches Defense

As noted above, the principal basis for Applicant's partial summary judgment motion is the assertion that "Opposer's allegation of dilution under Section 43(c) of the Trademark Act fails as a matter of law because, based on the undisputed record, Opposer is guilty of laches." (Applicant's Partial Summary Judgment Motion, p. 1.) Applicant proceeds to make a detailed argument in support of that assertion, relying

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<sup>4</sup> The few arguments that are directed to the laches defense are also set forth in Applicant Brinkmann's Opposition to Opposer's Motion for Partial Summary Judgment to Dismiss Applicant's Laches Defense was filed on or about September 23, 2008. Opposer has responded to those arguments in its Reply Memorandum in support of its summary judgment motion filed on October 8, 2008.

heavily on two, earlier-issued registrations of marks containing the word BRINKMANN – neither of which cover home security systems and components therefor – which Opposer has not contested on dilution grounds. (Applicant’s Partial Summary Judgment Motion, pp. 18-19.)

Applicant conveniently ignores the fact that dilution under § 43(c) was not a cognizable ground for an opposition or cancellation proceeding before the Board until the Trademark Amendments Act of 1999<sup>5</sup> (hereinafter the “TAA”) was enacted. Equally important, the TAA provides that a dilution claim in an opposition context can only be asserted against an application that was filed after the January 16, 1996 effective date of the Federal Trademark Dilution Act, codified as § 43(c) of the Federal Trademark Act. See, *Polaris Industries, Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000). For the same reason, a dilution claim in a cancellation context could only be asserted against a registration that issued from an application filed after January 16, 1996.

Additionally, it is well settled that an alleged violation of a state dilution statute is not a cognizable ground for opposition or cancellation under §§ 13 and 14 of the Federal Trademark Act, respectively. See e.g., *Enterprises Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 330 F.3d 1333 (Fed. Cir. 2003), *reh’g en banc denied*, (July 9, 2003) and *cert. denied*, 540 U.S. 1089 (2003); *K2 Corp. v. Philip Morris Inc.*, 192 USPQ 174, 177 (TTAB 1976), *aff’d*, 555 F.2d 815 (CCPA 1977); *Dickel Co. v. General Mills, Inc.*, 317 F.2d 954 (CCPA 1963).

Thus, contrary to the implicit predicate for Applicant’s partial summary judgment motion, Opposer could not ever have challenged Registration No. 1,153,730

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<sup>5</sup> Pub. L. 106-43, 113 Stat. 218 (Aug. 5, 1999).

of the mark BRINKMANN (Stylized), for any or all of the goods covered by that registration, on § 43(c) dilution grounds because that registration issued on May 21, 1981, long prior to the January 16, 1996 effective date of § 43(c). Nor could Applicant's Registration No. 1,153,730 have been challenged on state dilution grounds at any time.

Applicant also relies on its ownership of Registration No. 2,779,986 of the mark BRINKMANN BACKYARD KITCHEN, for combined outdoor grill and kitchen appliance units comprised of gas grills, sinks and coolers, which issued on November 4, 2003. As a result of the TAA, the earliest point at which Opposer could have challenged Applicant's right to register the mark BRINKMANN BACKYARD would have been October 22, 2002, when the application that matured into Registration No. 2,779,986 was published for opposition. Thus, the period of any "delay" is roughly thirty (30) months; namely, from October 22, 2002, when the application in question was published until April 1, 2005, when the present opposition was commenced. A "delay" of that magnitude generally does not rise to the level of laches in an opposition proceeding. See, e.g., *Plymouth Cordage Co. v. Solar Nitrogen Chemicals, Inc.*, 152 USPQ 202 (TTAB 1966) (delay of three years insufficient to constitute laches).

Applicant also argues that Opposer is guilty of laches because it had constructive notice of Applicant's use of the mark BRINKMANN since 1981 by virtue of the issuance of Registration No. 1,153,730. (Applicant's Partial Summary Judgment Motion, pp. 6 and 19.) However, the only constructive notice effect flowing from the issuance of Registration No. 1,153,730 arises under § 22 of the Federal Trademark Act which provides that the issuance of a registration on the

Principal Register is constructive notice of the registrant's claim of ownership, not use, of the mark which is the subject of that registration.

Although the Board recently concluded that laches can be asserted against a dilution claim, *Hornsby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008), the question of what period of time constitutes unreasonable delay with respect to a § 43(c) dilution claim in an opposition proceeding does not appear to have been addressed by the Board. In making such a determination, Opposer respectfully submits that the Board should adopt the conceptual approach used by a clear majority of the U.S. Circuit Courts of Appeals of looking to an analogous statute of limitations to measure the reasonableness of the delay in a trademark infringement and unfair competition context.<sup>6</sup> Because there is no statute of limitations with respect to a § 32 infringement claim or a § 43(a) unfair competition claim, these courts look to the analogous state statute of limitations to measure the reasonableness of the alleged delay and hold that a delay which does not exceed the analogous statute of limitations is presumptively reasonable.

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<sup>6</sup> This approach has been followed by the U.S. Courts of Appeals for the Second, Third, Fourth, Sixth, Seventh, Ninth and Eleventh Circuits and by a number of District Courts in other Circuits. *E.g.*, *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829 (9th Cir. 2002); *Chattanooga Manufacturing Co. v. Nike, Inc.*, 301 F.3d 789 (7<sup>th</sup> Cir. 2002); *Lyons Partnership, L.P. v. Morris Costumes*, 243 F.3d 789 (4th Cir. 2001); *Kason Industries, Inc. v. Component Hardware Group, Inc.*, 120 F.3d 1199 (11th Cir 1997); *Beauty Time, Inc. v. VU Skin Systems, Inc.*, 118 F.3d 140 (3d Cir. 1997); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187 (2d Cir. 1996). *Tandy Corp. v. Malone & Hyde, Inc.*, 769 F.2d 362 (6th Cir. 1985), *cert. denied*, 476 U.S. 1158 (1986); *Icon Health & Fitness, Inc. v. Nautilus Group, Inc.*, No. 1:02cv00109tc, 2005 U.S. Dist. LEXIS 39765 (D. Utah, Oct. 24, 2005); *Minnesota Mining and Manufacturing Co. v. Beautone Specialties*, 82 F. Supp.2d 997 (D. Minn. 2000); *Derrick Manufacturing Corp. v. Southwestern Wire Cloth, Inc.*, 934 F. Supp. 796 (S.D. Tex. 1996); *Kusek v. The Family Circle, Inc.*, 894 F. Supp. 522 (D. Mass. 1995).

However, in the context of a § 43(c) dilution claim, there is no need to search for an analogous state statute of limitations because 28 U.S.C. § 1658 (enacted on December 1, 1990), created a federal statute of limitations directly applicable to a § 43(c) dilution claim:

“Except as otherwise provided by law, a civil action arising under an Act of Congress enacted after the date of enactment of this section may not be commenced later than 4 years after the cause of action accrues.”

This four-year “catch all” federal statute of limitations is applicable to a cause of action arising under any federal law enacted after December 1, 1990. *Jones v. R.R. Donnelley*, 541 U.S. 369, 370 (2004). The § 1658 four-year statute of limitations accordingly is applicable to dilution claims arising under § 43(c) which became effective on January 16, 1996. T.J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 24:130 (2008). Consistent with the rationale of the Circuit decisions cited above, the controlling federal statute of limitations in 28 U.S.C. § 1658 should be used to measure the reasonableness of the alleged “delay” in the present laches context. Because the 30-month “delay” in this instance is less than the four-year statute of limitations prescribed in § 1658, it is presumptively reasonable.

2. Applicant’s Reliance on Laches Based on the *Morehouse* Defense Is Misplaced

At pp. 15-16 of its partial summary judgment motion, Applicant argues that a laches defense may be based on the opposer’s failure to object to the applicant’s prior registration of substantially the same mark for substantially the same goods or services, which is the recognized defense first articulated in *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881 (CCPA 1969). However, as demonstrated below, the *Morehouse* defense is not applicable in this instance because the record

establishes that Applicant does not own a registration of BRINKMANN -- or any other mark substantially the same as BRINKMANN -- that covers the home security systems and components therefor at issue in this proceeding or any substantially similar goods.

Applicant's response to Opposer's Interrogatory No. 6 identified the following seven products sold under the mark BRINKMANN that comprise "home security systems and components therefor" as described in the opposed application:

Home Security Solar Motion Activated Lighting System, and all components thereof

Solar Home Security SL-7 Motion Detector

Solar Home Security SL-8 Motion Detector

Home Security Halogen Motion Detector

Home Security 110° Motion Detector

Home Security 180° Motion Detector

Home Security Wireless Security Systems, and all components thereof.<sup>7</sup>

Applicant's designated Rule 30(b)(6) witness, Ms. Helen Dunham, confirmed that the seven items listed in the answer to Interrogatory No. 6 are an accurate identification of all of the products that are included in the descriptive language "home security systems and components therefor" covered by the opposed

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<sup>7</sup> A true copy of Applicant's response to Opposer's Interrogatory No. 6 (which was marked as Exhibit 2 during the deposition of Applicant's Rule 30(b)(6) witness Helen Dunham) is attached as Appendix A to the Declaration of Kristin T. D'Andrea in Support of Opposer's Motion to Defer Consideration of Applicant's Motion for Partial Summary Judgment to Dismiss Opposer's Dilution Claim (hereinafter "D'Andrea Declaration"). The same response to Interrogatory No. 6 was stated in Applicant's First Amended Answers to Opposer's First Set of Interrogatories (Exhibit 1 to the Dunham deposition), a true copy of which is annexed to the D'Andrea Declaration as Appendix B.

application. (Dunham Dep., pp. 19:23-21:15.<sup>8</sup>) Ms. Dunham also testified that none of following items in the description of goods in Registration No. 1,153,730 of the mark BRINKMANN fall within the home security systems and components therefor identified in Applicant's answer to Interrogatory No. 6: electrical extension cords; radar detectors; electronic metal detectors, head phones and search coils; and electronic connectors for use in connection with electronic metal detectors. (Dunham Dep., pp. 28:21-32:8 and Ex. 6<sup>9</sup>.) Ms. Dunham also testified that she was not aware of any other registrations of the mark BRINKMANN that cover home security products. (Dunham Dep., p. 35:2-16.<sup>10</sup>) As a Rule 30(b)(6) witness, Ms. Dunham is required to testify as to the information reasonably available to Applicant and her testimony is binding on Applicant. See, e.g., *Poole v. Textron, Inc.*, 192 F.R.D. 494, 504 (D. Md. 2000); *United States v. Taylor*, 166 F.R.D. 356, 361 (M.D.N.C. 1996).

Ms. Dunham's testimony that Registration No. 1,153,730 does not cover home security systems and components therefor as specified in the answer to Interrogatory No. 6 and that Brinkmann does not have any other registrations of BRINKMANN that cover home security products was not challenged, explained, limited or corrected in any respect on cross-examination by Applicant's counsel.

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<sup>8</sup> A true copy of Dunham Dep. pp. 19:23 – 21:15 is annexed as Appendix C to the D'Andrea Declaration.

<sup>9</sup> True copies of Dunham Deposition pp. 28:21-32:8 and Ex. 6 are annexed as Appendices D and E, respectively, to the D'Andrea Declaration.

<sup>10</sup> A true copy of Dunham Dep., p. 35:2-16, is annexed as Appendix F to the D'Andrea Declaration.

(Dunham Dep., p. 70:14-16.<sup>11</sup>) That binding testimony accordingly precludes any legitimate reliance on a *Morehouse* defense because the record establishes that Registration No. 1,153,730 of the mark BRINKMANN (Stylized) does not cover the same products or substantially the same products as the home security systems and components therefor described in the opposed application which are at issue in this proceeding and that Applicant does not own any other registrations of BRINKMANN that cover such goods. Indeed, Ms. Dunham testified that the very reason that Applicant filed the opposed application is that Registration No. 1,153,730 did not cover all of the products on which the mark BRINKMANN was used. (Dunham Dep. pp. 37:9-38:11.<sup>12</sup>)

Applicant also argues that laches bars Opposer's § 43(c) dilution claim because Opposer failed to object to Applicant's registration of the mark BRINKMANN for over 30 years and now is only challenging registration of BRINKMANN for certain goods in the opposed application. However, as noted above, a fundamental flaw in this argument is that until the enactment of the TAA, it was not possible to base an opposition or cancellation proceeding on a federal dilution claim, nor could such a claim ever be based on a state dilution statute. Accordingly, Applicant's unreasonable delay claim based on an alleged failure to on the part of Opposer to contest Applicant's earlier registrations on dilution grounds is plainly unfounded as a matter of law.

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<sup>11</sup> A true copy of Dunham Dep. p. 70:14-16 is annexed as Exhibit G to the D'Andrea Declaration.

<sup>12</sup> A true copy of Dunham Dep. pp. 37:9-38:11, is annexed as Appendix H to the D'Andrea Declaration.

#### IV. CONCLUSION

Because Applicant's partial summary judgment motion is not relevant to the laches defense that is the subject of Opposer's summary judgment motion which precipitated the present suspension of proceedings, the Board should defer consideration of, or any action on, Applicant's partial summary judgment motion until proceedings are resumed following a decision on Opposer's August 12, 2008 summary judgment motion. To the extent Applicant's partial summary judgment motion is predicated on laches, its arguments are misplaced.

Upon a resumption of the proceedings, Opposer requests that it be granted thirty days to submit its substantive opposition to Applicant's partial summary judgment motion.

BRINK'S NETWORK, INCORPORATED

Date: October 14, 2008

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Memorandum in Support Of Opposer's Motion to Defer Consideration of Applicant's Motion for Partial Summary Judgment to Dismiss Opposer's Claim of Dilution 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 14th day of October, 2008:

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