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

Proceeding	91164764
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**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 OPPOSITION TO  
OPPOSER'S FIRST AND SECOND MOTIONS FOR LEAVE  
TO AMEND NOTICE OF OPPOSITION**

Once again, Opposer Brink's Network, Incorporated ("Brink's Network") has brought meritless motions that needlessly consume the resources of both Applicant The Brinkmann Corporation ("Brinkmann") and the Board in this proceeding. In this instance, Opposer Brink's Network has moved the Board for leave to amend its Notice of Opposition to add an allegation of fraud and delete a registration on which it relied. Opposer Brink's Network has also moved the Board for leave to substitute its proposed amended Notice of Opposition with a second proposed amended Notice of Opposition to drop two additional registrations (collectively, "Motions"). By consent, Applicant Brinkmann submits this combined opposition to Opposer's Motions.

Opposer's Motions should be denied because Opposer's claim of fraud *has no factual or legal basis*, and Opposer has been dilatory in attempting to assert it. Allowing

Opposer to assert fraud would be a futile exercise, and its belated assertion by Opposer would unnecessarily cause prejudice to Applicant.

**I.**

**STATEMENT OF FACTS**

On January 17, 2003, Brinkmann filed the application at issue in this opposition, Ser. No. 76/483,115, for its trademark BRINKMANN in multiple classes to cover its then-existing lines of goods. The current description of goods in International Class 9, the relevant class in this proceeding, is as follows:

Home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets; batteries; wall mount brackets for battery chargers and flashlight; cooking thermometers; electrical extension cords; electric connectors; electric converters; electronic mineral and metal detectors, flashlight and spotlight accessories sold together or separately, namely, transmitters, lighter plugs and filter caps.

The date of first use asserted for International Class 9 is June 12, 1978. Mr. J. Baxter Brinkmann, President of Brinkmann, executed the declaration for the application on November 22, 2002. The application was prepared and submitted by Brinkmann's counsel of record in this proceeding.

The application was published for opposition on October 5, 2004. Opposer Brink's Network filed a Notice of Opposition on April 1, 2005. Opposer objected to registration of BRINKMANN only in connection with certain goods in International Class 9, namely, "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets." The grounds for opposition asserted by Brink's Network were (1) likelihood of confusion under section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) with various marks incorporating BRINK'S; (2) dilution

under section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), of various marks incorporating BRINK'S; and (3) misuse of the federal registration symbol.

In its Notice of Opposition, Opposer Brink's Network also alleged that the application at issue claimed June 12, 1978 as the date of first use for Applicant Brinkmann's home security systems and components.

On May 13, 2005, Applicant Brinkmann filed its Answer, in which Brinkmann denied Opposer's allegations, including a denial that the application at issue claims a date of first use of June 12, 1978 with respect to the home security products. Applicant Brinkmann did, however, admit in its Answer that the first use date of June 12, 1978 for International Class 9 is not applicable to the home security products.

Opposer Brink's Network served its First Set of Interrogatories on September 6, 2005. Interrogatory No. 3 requested Applicant to state Applicant's date of first use and date of first use in commerce of the mark BRINKMANN in connection with "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets."

Applicant Brinkmann served responses to the First Set of Interrogatories on October 11, 2005, in which Applicant stated that the date of first use for the "home security products" was at least as early as October 1989. A true and correct copy of relevant excerpts from Applicant's responses served on October 11, 2005 is attached hereto as Exhibit A.

Applicant Brinkmann served amended and supplemental responses to the First Set of Interrogatories on February 15, 2007, in which Applicant's response to Interrogatory No. 3 remained unchanged. A true and correct copy of relevant excerpts from Applicant's amended and supplemental responses served on February 15, 2007 is attached hereto as Exhibit B.

Without conferring in advance with Applicant Brinkmann, Opposer Brink's Network filed its Motion for Leave to file an Amended Notice of Opposition ("First Amended Notice of Opposition") on April 30, 2009. In the proposed First Amended Notice of Opposition, Brink's Network seeks to add a "fraudulent representation of material fact" as a ground for opposition, citing an alleged failure to comply with the Trademark Manual of Examining Procedure ("TMEP") § 903.09, which provides in part that "[w]here the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain." In other words, Opposer Brink's Network alleges that Brinkmann should have specified in its application the different date of first use (October 1989) for its home security products. Opposer Brink's Network alleges that Mr. Brinkmann, President of Brinkmann, "either knew or should have known that the mark BRINKMANN had not been used in connection with Applicant's home security systems and components at least as early as June 12, 1978." Brink's Network states that the alleged "fraudulent misrepresentation renders the opposed application void *ab initio*." See Paragraph 34 of the First Amended Notice of Opposition.

Opposer Brink's Network's proposed First Amended Notice of Opposition deleted Opposer's claim of ownership of Reg. No. 2,476,114 because that registration was cancelled under section 8 of the Trademark Act, subsequent to the filing of the original Notice of Opposition.

Opposer Brink's Network filed a second motion, titled Motion for Leave to File Second Amended Notice of Opposition on May 13, 2009, in which Opposer requested leave to substitute a second Amended Notice of Opposition ("Second Amended Notice of Opposition") for the First Amended Notice of Opposition submitted with its motion on April 30, 2009.

Opposer's asserted reason for filing the motion for leave to substitute is that the Second Amended Notice of Opposition deletes ownership of Reg. Nos. 2,691,470 and 2,646,784, in anticipation of their cancellation under section 8 of the Trademark Act. Opposer Brink's Network requested the Board to decide both of its motions "concurrently."

Given that Opposer Brink's Network's two motions are related to each other and that Brink's Network requested that the Board decide both motions concurrently, Applicant Brinkmann requested Opposer's consent to set the deadline for Brinkmann's responses to June 2, 2009, which is Brinkmann's deadline to respond to the second motion. Opposer Brink's Network gave its consent on May 18, 2009 and Applicant Brinkmann filed a consent motion on May 19, 2009, extending the deadline to respond to both motions to June 2, 2009 and consolidating its responses to both motions into a single response.

## **II.**

### **DISCUSSION**

Federal Rule of Civil Procedure 15(a) provides that a party may amend its pleading by "the court's leave" and that the "court should freely give leave when justice so requires." Here, justice mandates the contrary. The Board should not grant leave for Opposer Brink's Network to amend its Notice of Opposition to allege fraud because it would be an exercise in futility, and it would cause substantial prejudice and undue delay. *Mitsui Foods, Inc. v. U.S.*, 867 F.2d 1401, 1403-04 (Fed. Cir. 1989) ("[T]he existence of such factors as 'undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, [or] futility of amendment' may justify the denial of a motion for leave to amend," quoting *Foman v. Davis*, 371 U.S. 178, 182 (1962)).

**A. Leave to Amend is Futile Because Opposer Fails to State a Legal Cause of Action**

Applicant Brink's Network should not be allowed to amend its Notice of Opposition to allege fraud because the fraud claim is legally insufficient and, thus, futile. Section 507.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") provides that "where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend." TBMP § 507.02; *see also Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ.2d 1699, 1702-1703 (TTAB 2002) (proposed amended pleading of abandonment insufficient and leave to amend denied as futile where opposer asserted applicant's lack of exclusive rights in the mark but failed to include allegation that mark had lost all capacity to act as a source indicator for applicant's goods); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (where proposed pleading of dilution was legally insufficient, leave to re-plead not allowed in view of delay in moving to amend); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000) (motion to add counterclaim denied where mere allegation that opposer did not submit copy of foreign registration at time of examination is insufficient to state claim); *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) (opposers could not prevail on *res judicata* claim as a matter of law); *American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (proposed amendment to add 2(d) claim denied as legally insufficient).

Here, a grant of leave would be a textbook exercise in futility, causing inefficiency and waste in the legal process. Opposer Brink's Network has raised a big hue and cry about the fact that Applicant Brinkmann cited June 12, 1978 as the date of first use for International Class 9, alleging that Brinkmann should have separately designated the date of first

use of October 1989 for Brinkmann's home security products. The *sole* authority that Brink's Network cites for its allegation is TMEP § 903.09, which provides in part that "[w]here the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain." However, TMEP § 903.09 merely says that the applicant *should* designate the particular items to which the dates do pertain, *not* that the applicant *must* designate separate dates. Opposer Brink's Network has failed to consider TMEP § 903.09 in its entirety, which expressly acknowledges that identifying each and every date of first use for a laundry list of goods can be cumbersome and unnecessary, such that it is unclear to what extent applicants "should" designate separate dates of first use:

**903.09 More than One Item of Goods or Services**

If more than one item of goods or services is specified in a particular class, the date of first use anywhere and date of first use in commerce do not have to pertain to every item in the class. It might be that the mark, although in use on all of the items at the time the application or allegation of use was filed, was first used on various items on differing dates, *so that it would be cumbersome to designate the dates for all items individually*. See *Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (PTO 1955); *Ex parte Wayne Pump Co.*, 88 USPQ 437 (PTO 1951).

There must be at least one specified item in a class to which the specified dates pertain. 37 C.F.R. §§ 2.34(a)(1), 2.76(c) and 2.88(c). Where the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain.

Where the dates of use do not pertain to every item in the class, and the identification of goods or services is amended to delete the item(s) to which the dates of use pertain, the applicant must amend the dates-of-use clause to specify the dates that apply to an item that remains in the identification, and this item should be designated. See TMEP § 903.05 regarding amendments to dates of use.

If more than one item of goods or services is specified in a particular class, the Office will presume that the dates of use apply

to all the goods or services, unless the applicant states otherwise.

Where more than one date is specified for a particular class, the earliest date will be printed in the Official Gazette and, if a registration issues, on the certificate of registration.

(Emphasis added.)

In any event, TMEP § 903.09, as part of an administrative manual, does not have the force of law. And, the only authorities referred to in TMEP § 903.09—37 C.F.R. §§ 2.34(a)(1), 2.76(c) and 2.88(c)<sup>1</sup>—are cited solely for the proposition that “[t]here must be at least one specified item in a class to which the specified dates pertain.” Further, a review of each of those rules fails to support Opposer’s position. On its face, 37 C.F.R. § 2.34(a)(1), which applies to used-based applications under section 1(a), only requires one date of first use and one

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<sup>1</sup> 37 C.F.R. §§ 2.34(a)(1), 2.76(c) and 2.88(c) are reproduced below:

37 C.F.R. § 2.34(a)(1): Use in commerce under section 1(a) of the Act. The requirements for an application based on section 1(a) of the Act are:

(i) The trademark owner's verified statement that the mark is in use in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date;

(ii) The date of the applicant's first use of the mark anywhere on or in connection with the goods or services;

(iii) The date of the applicant's first use of the mark in commerce as a trademark or service mark; and

(iv) One specimen showing how the applicant actually uses the mark in commerce.

37 C.F.R. § 2.76(c): An amendment to allege use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the application, for which applicant will seek registration in that application unless the amendment to allege use is accompanied by a request in accordance with § 2.87 to divide out from the application the goods or services to which the amendment pertains. If more than one item of goods or services is specified in the amendment to allege use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

37 C.F.R. § 2.88(c): The statement of use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the notice of allowance, for which applicant will seek registration in that application, unless the statement of use is accompanied by a request in accordance with § 2.87 to divide out from the application the goods or services to which the statement of use pertains. If more than one item of goods or services is specified in the statement of use, the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

date of first use in commerce for the goods and services listed in the application, without any specification as to which goods or services the two dates apply. In contrast, 37 C.F.R. §§ 2.76(c) and 2.88(c) both state that

If more than one item of goods or services is specified . . . , the dates of use required in paragraph (b)(1) of this section need be for only one of the items specified in each class, provided the particular item to which the dates apply is designated.

(Emphasis added.) While these rules thus go further than 37 C.F.R. § 2.34(a)(1), they expressly apply only to amendments to allege use and statements of use, respectively, in intent-to-use applications under section 1(b). Obviously the absence of any requirement to designate “the particular item to which the dates apply” in 37 C.F.R. § 2.34(a)(1) for dates of use in applications under section 1(a) is a strong indicator that there is no such requirement in use-based applications. Brinkmann’s application at issue was filed as a use-based application under section 1(a), and thus only 37 C.F.R. § 2.34(a)(1) applies to Brinkmann’s application.

Even more, nowhere in the Title 15 of the U.S. Code or Title 37 of the Code of Federal Regulations, much less in the TMEP, does it state that failure to designate separate dates of first use constitutes fraud. The Board’s decisions are consistent with this omission. For example, in *Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (Comr. 1955), the testimony showed that the petitioner’s mark had not in fact been used on pretzels and on shredded wheat until some years after 1931 and hence the statement of the date of first use made under oath in the application was incorrect insofar as it applied to these two items. The applicant attempted to argue fraud through unclean hands with respect to this mistake in the application in an effort to get the petition for cancellation dismissed. The Board held that

While the statement made in the application is not entirely correct, no unclean hands requiring dismissal of the petition for cancellation or equivalent action is the interference is found. The Examiner of Trademarks should, after the termination of these

proceedings, require appropriate correction in accordance with the present rules.

*Id.* at 224.

In *Lyon Metal Products, Inc. v. Lyon Inc.*, 134 USPQ 31 (TTAB 1962), the applicant argued that the opposer had perpetuated a fraud on the U.S. Patent and Trademark Office because the applicant's Registration Nos. 570,062 and 573,619 falsely represented use of the trademark on kitchen cabinets beginning as of December 1, 1913, whereas the opposer did not commence to manufacture and sell kitchen cabinets until January 1, 1946. The Board disagreed and held,

the fact that the date of first use alleged in Registration Nos. 570,062 and 573,619 does not apply to all goods named therein does not constitute fraud or unclean hands since the record shows and it is not disputed that the mark was in use on that date on one or more of the goods identified therein.

*Id.* at 37-8 (citing *Sunshine Biscuits, Inc. v. Berke Bakeries, Inc.*, 106 USPQ 222 (Comr. 1955)).

In fact, even the assertion of erroneous dates of first use altogether in an application does not constitute fraud, so long as the mark was in use in commerce for the goods as of the filing date of the application. *See, e.g., L. & J.G. Stickley, Inc. v. Ronald C. Cosser*, 81 USPQ.2d 1956, 1970 n.17 (TTAB 2007) (“We point out that inaccurate information regarding claimed dates of first use does not, by itself, constitute fraud.”); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ.2d 1137, 1141 (TTAB 1990) (“The Board repeatedly has held that the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing of the [section 1(a)] application.”); *Gaffrig Performance Indus. v. Livorsi Marine, Inc.*, 2003 U.S. Dist. LEXIS 23018, \*41 n. 4 (N.D. Ill. Dec. 19, 2003) (“The Trademark Trial and Appeals Board has repeatedly held that an erroneous date of first use is immaterial to an allegation of fraud, because

an erroneously asserted date, even if intentional, could not result in the allowance of a registration which would otherwise not be allowed, so long as the applicant used the mark prior to filing the application.”).

The present case falls squarely within the foregoing examples. Applicant Brinkmann filed the present application for the mark BRINKMANN under the good faith belief that asserting one date of first use for International Class 9 was sufficient under the applicable federal rules and regulations. Even if Applicant Brinkmann is mistaken in its belief, the inadvertent omission of a separate date of first use for Applicant’s home security products does *not* rise to the level of fraud, especially since Applicant Brinkmann commenced use of the mark BRINKMANN for its home security products in October 1989, well before the filing date of the present application. In fact, Applicant Brinkmann would be surprised to find that Opposer Brink’s Network itself has always complied with TMEP § 903.09 as well. By way of example, Opposer Brink’s Network’s Reg. No. 1,309,375 for the mark BRINK’S alleges a date of first use of January 1, 1912 for “Security transportation-namely, armored car transport services of currency, securities, and other valuables, domestic and international air courier services, air transport and air freight of goods,” in International Class 39. (Emphasis added). While Applicant Brinkmann requires additional discovery to confirm its suspicion, Applicant Brinkmann doubts that Opposer Brink’s Network was offering “domestic and international air courier services, air transport and air freight of goods” under the BRINKS mark in the year 1912. Presumably, then, under Opposer Brink’s Network’s reasoning, Brink’s Network is also guilty of a fraudulent misrepresentation and unclean hands, and is vulnerable to cancellation of its own registration(s). If Opposer’s amendment to assert fraud were to be allowed, Brinkmann would have to pursue those issues.

Finally, Opposer Brink's Network states that Brinkmann's alleged "fraudulent misrepresentation renders the opposed application void *ab initio*." See Paragraph 34 of Opposer's Amended Notice of Opposition. Opposer's allegation is a flagrant misstatement of the law, since Applicant's multi-class application is not void *ab initio*. See *G&W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ.2d 1571, 1574 (TTAB 2009) (holding that fraud in one class of goods in a multi-class application does not render the entire application void).

For the foregoing reasons, Opposer Brink's Network's motion for leave to file an amended Notice of Opposition should be denied as futile, because Opposer has failed to state a legal cause of action such that granting leave would be contrary to justice.

**B. Opposer Has Failed to Plead Fraud With the Requisite Heightened Specificity**

Opposer Brink's Network has also failed to identify any real facts that point to fraud. It is fundamental that a party alleging fraud or mistake "must state with particularity the circumstances constituting fraud or mistake." Fed. R. Civ. P. 9(b). "[T]he pleader must state the time, place and content of the false representation, the fact misrepresented and what was obtained or given up as a consequence of the fraud." *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 672 (Comm'r Pat. 1977).

In the present case, Opposer Brink's Network has failed to plead the alleged fraud with the requisite heightened specificity, and understandably so, since no fraud exists. The only "fact" that Opposer Brink's Network can point to is not even a fact at all, but merely the conclusory statement that Mr. Brinkmann, President of Brinkmann, "either knew or should have known that the mark BRINKMANN had not been used in connection with Applicant's home security systems and components at least as early as June 12, 1978."

It is well-settled that mere conclusory statements about what a party knew or should have known are wholly deficient to buttress a fraud claim. In *Intellimedia Sports Inc. v.*

*Intellimedia Corp.*, 43 USPQ.2d 1203 (TTAB 1997), the petitioner tried to allege that the registrant had obtained its registration by fraudulent means, because at the time registrant signed its oath in support of its registration, the petitioner was already using the same or confusingly similar mark and had legal rights superior to that of the registrant, that the registrant “knew or should have known that Petitioner had superior rights in the mark.” The Board shot down the fraud claim, noting that:

[I]t is clear that petitioner has failed to plead particular facts which, if proven, would establish the third element of its fraud claim. Petitioner has alleged that respondent, at the time respondent signed the application for registration of its mark, “knew or should have known” that Petitioner had superior rights in the mark. In addition to being merely conclusory, this allegation is insufficient because it does not set forth any particular facts which, if proven, would establish that respondent believed, or had no reasonable basis not to believe, that petitioner had a superior or clearly established right to use the same or a substantially identical mark on or in connection with the same or substantially identical goods as those set forth in the application for registration.

*Id.* at 1207. *See also Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983) (“Petitioner's allegation of fraud is deficient because it does not recite detailed facts tending to show willful or knowingly-made false representations by the registrant during ex parte prosecution of the application.”).

Mr. Brinkmann’s execution of the declaration in support of Applicant Brinkmann’s application in no way demonstrates a willful intent to mislead the U.S. Patent and Trademark Office about the date of first use of Brinkmann’s home security products. As stated previously, Applicant Brinkmann had a good faith belief that providing one date of first use for International Class 9 (which includes Brinkmann’s home security products among other goods) was sufficient, the way providing one specimen of use for the entire International Class 9 was sufficient. Even if Applicant Brinkmann knew or should have known that a different date of first

use applied to the home security products, there is no evidence to suggest that Applicant Brinkmann knew or should have known that such different date should have been expressly designated in its application. Simply put, Applicant Brinkmann did not commit any fraud.

For the foregoing reasons, Opposer Brink's Network's motion for leave to file an amended Notice of Opposition should be denied, because Opposer has failed to demonstrate *any* evidence of fraud on the part of Applicant, much less with any degree of specificity.

**C. Leave to Amend Would Cause Undue Prejudice to Applicant**

Although amendments to pleadings are usually permitted with liberality, Opposer's request for leave to amend its Notice of Opposition should be denied in light of the undue prejudice to Applicant Brinkmann. *Mitsui Foods*, 867 F.2d at 1403-04.

First, Opposer Brink's Network is guilty of unreasonable delay in bringing its motion for leave to amend. "The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely." TBMP § 507.02(a); *see also M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention); *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ.2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ.2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend). In the present case, Opposer Brink's Network was put on

notice four years ago that a different date of first use applied to Applicant Brinkmann's home security products, when Applicant filed its Answer on May 13, 2005. Applicant Brinkmann provided the actual date of first use for its home security products on October 11, 2005 and February 15, 2007, when it served its original and amended/supplemental responses to Opposer's First Set of Interrogatories. Yet Opposer Brink's Network is only now trying to assert fraud, with no explanation whatsoever as to why Opposer Brink's Network delayed so long in bringing its motion. A delay of four years is wholly untimely and Opposer Brink's Network's motion should be barred on this basis alone.

Opposer Brink's Network tries to argue that no prejudice exists because the discovery period could be extended to accommodate additional discovery with respect to the allegation of fraud. But the very fact that additional discovery would be necessary is prejudice to Applicant Brinkmann in and of itself. *See, e.g., McKnight v. Kimberly Clark Corp.*, 149 F.3d 1125, 1130 (10th Cir. 1998) (defendant would be prejudiced when many key individuals would have had to be deposed again if complaint were amended, and plaintiff was aware of information on which proposed amendment was based prior to filing original complaint); *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 805-807 (6th Cir. 2005) (defendant would be unfairly prejudiced if required to respond to distinct new claim with only a few weeks of discovery remaining); *Bell v. Allstate Life Ins. Co.*, 160 F.3d 452, 454 (8th Cir. 1998) (prejudice found when issues raised by proposed amendment involved new factual and legal issues and would require additional discovery). By way of example, Opposer Brink's Network has already noticed and taken the deposition of Applicant Brinkmann under Federal Rule of Civil Procedure 30(b)(6). Applicant's designated deponent was Ms. Helen Dunham, Brinkmann's Director of Creative Services. If Opposer Brink's Network had asserted its fraud claim earlier, Applicant Brinkmann

would have considered another designated deponent. Opposer Brink's Network's fraud claim, if allowed, would only increase the burden of discovery and ultimately to no avail. Opposer's motion should be denied on this ground as well.

Applicant Brinkmann wishes to note, in passing, that Opposer Brink's Network did not meet and confer with Applicant Brinkmann before bringing its motion for leave to amend, something which very well could have avoided the undue time and expense incurred by the parties and the Board in this proceeding. Applicant Brinkmann would have pointed out the relevant facts and case law to demonstrate that Opposer Brink's Network has no factual or legal basis in bringing its fraud claim. Applicant Brinkmann also would have pointed out that Opposer's motion, if granted, would raise the possibility that the undersigned counsel for Brinkmann (who has been representing Brinkmann in its trademark matters since 1984) might have to withdraw from representation of Brinkmann in this proceeding, since Opposer is trying to attack the application, and counsel for Brinkmann prepared and filed the application at issue (as it has prepared and filed other trademark applications for Applicant Brinkmann for nearly 25 years). Thus, counsel for Brinkmann might find itself in the position of both counsel and witness in this proceeding, which might not be permitted. *See* 37 C.F.R. § 10.63; *In re Gray*, 3 USPQ2d 1558 (TTAB 1987). All of these complications, of course, stem ultimately from a fruitless cause, because Opposer Brink's Network's fraud claim lacks any merit.

Applicant Brinkmann should not bear the unnecessary prejudice and costs stemming from Opposer Brink's Network's misguided attempt to claim fraud in this proceeding. Opposer Brink's Network's fraud claim has no factual or legal basis and requiring Applicant Brinkmann to defend itself against such a meritless claim is unfair and contrary to justice.

**D. Applicant Does Not Oppose Deletion of Opposer’s Three Registrations but Reserves the Right to Conduct Discovery and Assert Impropriety by Opposer in Asserting Them in the First Instance**

Applicant, of course, does not oppose the proposed amendments to the extent Opposer seeks to delete three of its pleaded registrations from its Notice of Opposition. However, the proposed deletions raise the issue of exactly when those registered marks were abandoned, whether those marks had already been abandoned at the time the Notice of Opposition was filed, and whether Opposer Brink’s Network has been inexcusably dilatory in filing for leave to amend its Notice of Opposition to delete such registrations. *See* 15 U.S.C. § 1052(d) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another *and not abandoned*, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive,” emphasis added); *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 1128-29, 31 USPQ.2d 1660, 1666 (Fed. Cir. 1994) (an abandonment allegation asserted by the defendant “is, in effect, in the stance of a defense to a prior use assertion.”).

Applicant Brinkmann reserves the right to conduct discovery on these issues and, if the facts warrant, to assert that Opposer Brink’s Network’s inclusion of its deleted registrations in its Notice of Opposition, or its delay in seeking to delete them, constitutes unclean hands.

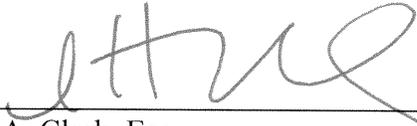
**III.**

**CONCLUSION**

Opposer’s motion to assert fraud, if granted, is destined to cause the very prejudice, delay, and futility that our jurisprudence seeks to prevent. For all the reasons stated

herein, Applicant Brinkmann respectfully requests that the Board deny Opposer's motion for leave to amend the Notice of Opposition to assert fraud.

Dated: June 2, 2009



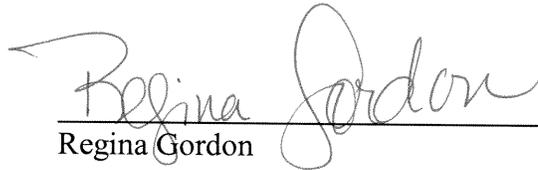
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CERTIFICATE OF SERVICE

This is to certify that I have this day, June 2, 2009, caused to be served a copy of the foregoing “Applicant Brinkmann’s Opposition to Opposer’s First and Second Motions for Leave to Amend Notice of Opposition” by placing a copy in the United States Mail, postage pre-paid, addressed as follows: Nancy S. Lapidus, counsel for Opposer, at Howrey LLP, 1299 Pennsylvania Avenue, N.W., Washington, DC 20004.

  
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Regina Gordon