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Filing date: **07/16/2010**

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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
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Submission	Motion to Extend
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Date	07/16/2010
Attachments	Opposer's Motion to Extend Opening of Parties' Testimony Periods.pdf ( 5 pages )(181025 bytes ) Memo in Support of Motion to Extend Opening of Parties' Testimony Periods.pdf ( 10 pages )(493155 bytes )



- (a) Opposer's testimony period as plaintiff in the opposition proceeding will close on September 30, 2010.
- (b) Applicant's testimony period as defendant in the opposition and as plaintiff in its counterclaims will close on November 29, 2010.
- (c) Opposer's rebuttal testimony as plaintiff in the opposition proceeding and its testimony as defendant in connection with Applicant's counterclaims will close on January 28, 2011.
- (d) Applicant's rebuttal testimony as plaintiff in connection with its counterclaims will close on March 14, 2010.

(2) On June 4, 2010, Opposer filed its Motion for Leave to File Third Amended Notice of Opposition ("Motion for Leave") which now has been fully-briefed<sup>1</sup> and is pending before the Board.

(3) In order to avoid any possible claim of prejudice by Applicant resulting from the filing of the Third Amended Notice of Opposition, the Motion for Leave requested the Board to extend discovery and all other dates for a period of sixty (60) days following its decision on that motion.

(4) Applicant's memorandum in opposition to the Motion for Leave, filed on June 23, 2010, states that if the Board grants the Motion for Leave,

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<sup>1</sup> Applicant's memorandum in opposition to the motion for leave was filed on June 23, 2010, and Opposer's reply memorandum in support of the motion for leave was filed on July 13, 2010.

Applicant joins in Opposer's request to extend the discovery period by sixty (60) days from the date of the Board's Order.

(5) If the Board grants the Motion for Leave and re-opens discovery for a period of sixty (60) days as jointly requested by the parties, there will be ample time to not only take discovery, but to prepare for the submission of proofs during the parties' respective testimony periods that are directed to the claims, defenses and counterclaims as articulated in the Third Amended Notice of Opposition and the Answer filed by Applicant in response thereto.

(6) However, it is uncertain as to when a decision will be rendered on the Motion for Leave. If the Motion for Leave is not decided by the September 1, 2010 initiation of Opposer's present testimony period, Opposer would face the prospect of going forward with presenting its testimony without knowledge as to whether the Third Amended Notice of Opposition will be accepted and, if it is ultimately accepted, without knowledge of any new affirmative defenses and/or counterclaims that Applicant may assert in its Answer to the Third Amended Notice of Opposition.

(7) In order to avoid the uncertainty discussed above, Opposer respectfully submits that even if discovery is not extended as a result of the ruling on the Motion for Leave, the Board should still re-schedule the opening of the parties' respective testimony periods to commence sixty (60) days after the Board's ruling on the Motion for Leave.

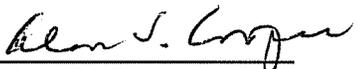
(8) In an effort to avoid burdening the Board with another contested motion, counsel for Opposer contacted Applicant's counsel to inquire whether

Applicant would join in or at least not contest the present motion. However, Applicant declined to take either of those steps.

For all of the reasons stated above, Opposer respectfully submits that the relief sought by the motion is fully warranted and should be granted. A Memorandum in support of this motion is filed concurrently herewith.

BRINK'S NETWORK, INC.

Date: July 16, 2010

By:   
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Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Opposer's Motion to Extend Opening of Parties' Testimony Periods Pending Disposition of Opposer's Motion for Leave to File Amended Third Notice of Opposition was served on the following attorneys of record for Applicant by Federal Express overnight courier service on this 16th day of July 2010:

Gary A. Clark, Esq.  
Susan Hwang, Esq.  
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## II. BACKGROUND OF THE MOTION

The opposed application was filed on January 17, 2003, and is based on a claim of use of the mark BRINKMANN in commerce under § 1(a) of the Federal Trademark Act. The opposed application seeks registration of the mark BRINKMANN for the following goods in Class 9: “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 Notice of Opposition in this proceeding was filed on April 1, 2005, and is directed only to registration of the mark BRINKMANN for “home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets” in International Class 9.

On April 5, 2005, the Board instituted proceedings and set discovery and testimony periods, with discovery to close on October 22, 2005. On October 18, 2005, Opposer filed a consented motion to extend the discovery period until December 21, 2005, which the Board granted.

On December 8, 2005, Opposer filed a motion to compel discovery, and proceedings were suspended on March 9, 2006, pending the Board’s decision on that motion. On December 12, 2006, the Board granted Opposer’s motion to compel discovery and reset discovery to close on February 15, 2007. On February 5, 2007, nearly two months after the Board granted Opposer’s motion to compel discovery,

Applicant filed a motion to compel discovery, to stay proceedings pending disposition of that motion, and to reset discovery. On February 16, 2007, the parties filed a joint motion to extend discovery for thirty (30) days until March 17, 2007. One month later, on March 15, 2007, the parties filed a joint motion to suspend proceedings for sixty (60) days while the parties explored settlement.

On April 2, 2007, the Board granted Applicant's motion to compel discovery and suspended proceedings for six months to permit the parties to continue settlement negotiations. On October 23, 2007, Opposer moved to resume proceedings and for reconsideration of a portion of the Board's Order granting Applicant's motion to compel. The Board granted Opposer's motion to resume proceedings and for reconsideration of the portion of the Board's Order granting Applicant's motion to compel on May 21, 2008. The Board also reset discovery to close on July 25, 2008.

On June 6, 2008, the parties filed a joint motion to extend the discovery cut-off and other dates for thirty (30) days, which the Board granted. On July 9, 2008, the parties filed another joint motion to extend the discovery cut-off and other dates for thirty days, which the Board also granted.

On August 12, 2008, Opposer filed a motion for partial summary judgment directed to Applicant's laches defense. The Board suspended proceedings pending disposition of Opposer's motion on August 19, 2008. On September 25, 2008, Applicant filed a motion for partial summary judgment dismissing Opposer's dilution claim. On November 5, 2008, the Board directed that proceedings were suspended pending a decision on both parties' motions for partial summary judgment. By Order entered on March 16, 2009, the Board granted Opposer's motion for partial summary

judgment dismissing Applicant's laches defense and denied Applicant's motion for partial summary judgment dismissing Opposer's dilution claim. The Board also resumed proceedings with discovery to close on May 29, 2009.

On April 30, 2009, Opposer filed a Motion for Leave to File Amended Notice of Opposition. One day later, on May 1, 2009, Applicant filed an uncontested motion to extend the discovery cut-off for thirty (30) days and other dates accordingly. On May 13, 2009, Opposer filed a Motion for Leave to Filed a Second Amended Notice of Opposition. On June 29, 2009, Opposer filed a consented motion to extend the discovery cut-off and other dates for ninety (90) days. In an Order entered on August 7, 2009, the Board reset the discovery cut-off date until November 6, 2009 and reset other dates. Applicant filed its Answer and Counterclaims in response to Opposer's Amended Notices of Opposition on August 26, 2009.

Applicant filed a motion to divide its Application on August 27, 2009, which Opposer did not contest. On September 16, 2009, the Board granted Applicant's motion to divide, and suspended proceedings pending the U.S. Patent and Trademark Office's completion of the application division process.

On October 1, 2009, Opposer filed a motion to compel the discovery deposition of Applicant's President, Mr. J. Baxter Brinkmann. As a result of that motion, on October 24, 2009, the Board suspended proceedings pending the disposition of Opposer's motion to compel. The Board granted Opposer's motion by Order entered on April 23, 2010, and resumed proceedings with discovery set to close on July 2, 2010, and reset the parties' testimony periods.

On May 21, 2010, Opposer filed its Reply to Applicant's counterclaims. Two weeks later, on June 4, 2010, Opposer filed a Motion for Leave to File a Third Amended Notice of Opposition which now has been fully briefed and is pending before the Board. In order to avoid any possible claim of prejudice resulting from the filing of the Third Amended Notice of Opposition, Opposer's Motion for Leave requested the Board to extend discovery and all other dates for a period of sixty (60) days following its decision on that motion. Applicant's memorandum in opposition to the Motion for Leave to File the Third Amended Notice of Opposition, filed on June 23, 2010, states that if the Board grants the motion, Applicant joins in Opposer's request to extend the discovery period by sixty (60) days from the date of the Board's Order. Discovery closed on July 2, 2010. Opposer's testimony period is set to close on September 30, 2010.

In view of the uncertainty as to when the Board will rule on Opposer's pending Motion for Leave to File the Third Amended Notice of Opposition, and with the September 1, 2010 initiation of Opposer's present testimony period approaching, Opposer has no alternative but to file the subject motion to extend the opening of the parties' respective testimony periods for sixty (60) days following the Board's decision on Opposer's pending Motion for Leave to File the Third Amended Notice of Opposition.<sup>1</sup> For the reasons discussed below, Opposer believes that its Motion to Extend Opening of Parties' Testimony Period Pending Disposition of Opposer's Motion

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<sup>1</sup> In an effort to avoid burdening the Board with another contested motion, counsel for Opposer contacted Applicant's counsel on July 8, 2010 to inquire about whether Applicant would join in or at least not contest the present motion. However, Applicant declined to take either of those steps.

for Leave to File Third Amended Notice of Opposition is fully warranted and should be granted.

### III. ARGUMENT

The Board has expressly stated that a party has “a right to know the issues before the Board before proceeding to trial.” *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (1987). Where a ruling on a motion could impact the scope of issues to be dealt with at trial, the Board has stated that parties should refrain from further activity until the Board has had an opportunity to rule on such a motion, rather than “rush headlong into trial.” *NationsBank Corp. v. First Nations Financial Services Co.*, 2000 TTAB LEXIS 69, at \*1 (TTAB Feb. 24, 2000) (non-precedent decision).<sup>2</sup>

As discussed above, Opposer’s Motion for Leave to File Third Amended Notice of Opposition is currently pending before the Board, and Opposer’s testimony period is set to begin on September 1, 2010. The Board’s ruling on Opposer’s Motion for Leave to File Third Amended Notice of Opposition will certainly impact the scope of issues to be dealt with and the evidence to be presented at trial because the Third Amended Notice of Opposition pleads, *inter alia*, ownership of three additional registrations (Registration Nos. 2,585,259, 2,582,146 and 3,548,760 of the mark BRINKS in various forms for residential security equipment). Assuming that leave is granted to file the Third Amended Notice, Opposer will have no way of knowing whether Applicant will

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<sup>2</sup> The USPTO’s Official Gazette Notice, dated January 23, 2007, stated that “[a] decision designated as not precedential is not binding upon the TTAB but may be cited for whatever persuasive value it might have.” The decision cited above has persuasive value in this instance.

assert any new affirmative defenses and/or counterclaims until its Answer is filed at some unknown date in the future.

However, because it is uncertain as to when a decision will be rendered on the Motion for Leave to File the Third Amended Notice of Opposition, Opposer presently faces the prospect of presenting its testimony without knowledge as to whether the Third Amended Notice of Opposition will be accepted, and if it is accepted, without knowledge of any new affirmative defenses and/or counterclaims that Applicant may assert in its Answer to the Third Amended Notice of Opposition. Put simply, Opposer would be forced to proceed with its trial testimony without knowing the precise issues before the Board. The Board expressly disapproved of such action in *NationsBank Corp. v. First Nations Financial Services Co.*, *supra* at \*1.

Indeed, the opposer in *NationsBank Corp.*, prior to the close of discovery, moved for leave to amend its notice of opposition and the applicant moved for leave to amend the identification of goods in the opposed application. The Board stated that “[c]learly, approval of either of these motions would impact the scope of the issues to be dealt with at trial.” *Id.* Thus, the Board reasoned that the parties should have refrained from further activity until the Board had an opportunity to rule on the motions, rather than, as they did, rush headlong into trial. *Id.* Opposer submits that the Board’s persuasive reasoning expressed in *NationsBank Corp.* applies here and should be considered.<sup>3</sup>

If the Board grants Opposer’s Motion for Leave and re-opens discovery for a period of sixty (60) days as jointly requested by the parties, there will be ample time to not only take any discovery that may be necessary, but to also prepare for the

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<sup>3</sup> See fn 2, *supra*.

submission of proofs during the parties' respective testimony periods that are directed to the claims, defenses, and counterclaims as articulated in the Third Amended Notice of Opposition and the Answer filed by Applicant in response thereto. However, if the Board denies Opposer's Motion for Leave and discovery is not extended, the Board should still re-schedule the opening of the parties' respective testimony period to commence sixty (60) days after the Board's ruling on the Motion for Leave in order to avoid any uncertainty as to the scope of the issues to be dealt with at trial.

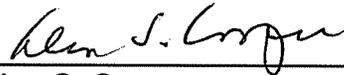
Opposer is aware that granting the present motion will further extend this proceeding which has been pending since 2005. However, such a consequence should not impact the Board's decision. As summarized above, the relatively prolonged duration of this proceeding is the result of both parties filing motions that resulted in long suspensions of proceedings, the filing of a number of uncontested or joint motions to extend the discovery period, and a suspension of proceedings for six (6) months to permit the parties to explore a possible settlement. This case history should not influence the outcome of the present motion because, as the Board noted in *Midwest Plastic Fabricators, Inc.*, 5 USPQ2d at 1069, a party has "a right to know the issues before the Board before proceeding to trial." Thus, even though re-scheduling the opening of the parties' respective testimony periods to commence sixty (60) days after the Board's ruling on Opposer's Motion for Leave will further extend the duration of this proceeding, such an extension is warranted to ensure that the parties are fully aware of the scope of issues to be dealt with at trial.

IV. CONCLUSION

For the reasons stated above, Opposer respectfully requests the Board to grant its Motion to Extend Opening of Parties' Testimony Period Pending Disposition of Opposer's Motion for Leave to File Third Amended Notice of Opposition.

BRINK'S NETWORK, INC.

Date: July 16, 2010

By: 

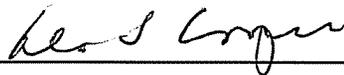
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CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Memorandum in Support of Motion to Extend Opening of Parties' Testimony Period Pending Disposition of Opposer's Motion for Leave to File Third Amended Notice of Opposition was served on the following attorneys of record for Applicant by Federal Express overnight courier service on this 16th day of July 2010:

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