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

Proceeding	91164764
Party	Defendant The Brinkmann Corporation
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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 SURREPLY TO OPPOSER'S MOTION FOR  
LEAVE TO FILE THIRD AMENDED NOTICE OF OPPOSITION**

Applicant The Brinkmann Corporation ("Brinkmann") hereby files this surreply to the reply filed by Opposer Brink's Network, Incorporated ("Brink's Network") in connection with its motion for leave to file a third amended Notice of Opposition ("Motion"). Applicant Brinkmann is mindful that surreplies are generally not considered by the Board, but respectfully submits that this surreply is necessary in order to address certain statements made for the first time in Opposer's Reply that should have been submitted in Opposer's Motion. For the reasons set forth below, the Board should deny Opposer's Motion.

**I.**

**DISCUSSION**

**A. Opposer Is Not Entitled To State Grounds In Its Reply That It Should Have Stated In Its Motion**

Opposer Brink's Network has submitted additional factual "evidence" and over 200 pages worth of accompanying exhibits *for the first time* in its *Reply*, allegedly in order to

respond to Applicant Brinkmann's statement in its opposition that Opposer was inexcusably dilatory in seeking to amend the Notice of Opposition. Opposer's actions violate the rules of motion practice because Opposer was required to explain the reason for its inexcusable delay at the outset, not as a purported response to Brinkmann's opposition.

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." However, undue delay or prejudice to the opposing party may dictate otherwise. *See, e.g., 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)).

Section 507.02(a) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") specifically states:

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) (citations omitted) (emphasis added). *See also Trek Bicycle Corp. v. StyleTrek Limited*, 64 USP.2d 1540 (TTAB 2001) (motion for leave to amend filed prior to close of discovery but based on facts known to opposer prior to institution of the case denied due to unexplained delay); *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).

Accordingly, Opposer Brink's Network knew very well that all of the alleged reasons and evidence that it presented in its Reply should originally have been in its Motion. Applicant Brinkmann merely pointed out the obvious in its opposition, that Opposer Brink's Network failed utterly in its Motion to explain the years-long delay between registration of the three newly-asserted registrations and the filing of the Motion. On this ground alone, Opposer Brink's Network's motion should be denied.

**B. Opposer's Ability to Assert the Three Additional Registrations Were Not "Beyond Opposer's Control" and Should Have Been Pleaded Years Ago**

Opposer Brink's Network now tries to explain its delay by arguing that its failure to plead the three additional registrations was due to circumstances which "clearly are beyond Opposer's control." *Reply* at p. 8. Opposer's argument is preposterous.

Opposer Brink's Network filed a Notice of Opposition on April 1, 2005. The first trademark registration that Opposer seeks to add is Registration No. 2,330,884 for the mark BRINKS HOME SECURITY & Design, which registered on March 21, 2000, *five years* before Opposer filed the original Notice of Opposition. The second trademark registration that Opposer seeks to add is Registration No. 2,582,146 for the mark BRINKS, which registered on June 18, 2002, *three years* before Opposer filed the original Notice of Opposition. The third trademark registration that Opposer seeks to add is Registration No. 3,548,670 for the mark BRINKS & Design, which registered on December 23, 2008, nearly *two years ago* and well before Opposer

filed its motions to file a first and second amended Notice of Opposition in 2009. Opposer could have asserted the three registrations at any of those times but failed to do so.

Instead, Opposer Brink's Network tries to explain for the first time in its Reply that its related company Brink's Home Security Holdings, Inc. ("BHS") was spun off as a separate company on September 12, 2008 with a license to continue using certain BRINKS marks; that BHS adopted a new name and mark, BROADVIEW, in July 2009; that Broadview was acquired by Tyco International and merged into Tyco's subsidiary Barricade Merger Sub, Inc. on May 14, 2010; and that Barricade and BHS have entered into an amendment of the license so that use of the BRINKS marks should end by August 15, 2010, with continuing use for one year by Barricade of domain names that contain the word "Brinks." Opposer Brink's Network also explains that even if use of BRINKS and BRINKS HOME SECURITY for residential and commercial security monitoring services is discontinued by Barricade, there will still be continuing use of the marks for "residential security products and equipment" through Opposer's licensee Hampton Products International Corporation, based on a separate license entered into on January 1, 2005.

Opposer Brink's Network asserts that these events that were "clearly [] beyond Opposer's control" made it necessary for Opposer to "augment" the registrations pleaded in the original Notice of Opposition. *Reply* at 7-8. Opposer Brink's Network also argues that the Opposer did not delay because proceedings were suspended from October 24, 2009 until April 23, 2010. Finally, Opposer Brink's Network argues that the registered goods in the three additional registrations are all within the category of residential security products that were pleaded at the beginning of the proceeding, such that these products are not different and that Applicant Brinkmann presumably is not prejudiced by assertion of the registrations.

1. **Opposer Does Not Explain Why It Failed to Plead Registrations for Goods Allegedly in the Same Category of Security Products**

The three additional registrations which Opposer Brink's Network attempts to add are registered for keyed and combination metal locks and hasps and timers, which Opposer characterizes as security monitoring products. Opposer notes that some of the registrations asserted in the Notice of Opposition are for security monitoring services and for keyed and combination metal locks. Opposer concludes that "Applicant clearly has been on notice of Opposer's rights in the mark BRINK'S in various forms for both security monitoring services *and* products since the outset of this proceeding." *Reply* at p. 3 (original emphasis).

However, Opposer fails to explain why — if the goods in the three additional registrations are the same or similar to the originally pleaded registrations — Opposer did not also assert those registrations in the Notice of Opposition or when Registration No. 3,548,670 was registered nearly two years ago. Either it was Opposer's oversight or Opposer must have believed that the goods, and the corresponding registrations, were irrelevant to the proceeding. Either reason is no excuse to try to add the registrations now.

2. **The Spin-Off and Acquisition Are Irrelevant to Opposer's Ability to Plead the Three Additional Registrations**

Opposer Brink's Network states in its Reply that concurrent with the October 2008 spin-off, Opposer and Broadview entered into a license to use BRINKS until October 31, 2011 and Opposer's corporate parent The Brink's Company ("BCO") and Broadview entered into a non-competition agreement that prohibits BCO from using the mark BRINKS in connection with security monitoring services until October 31, 2013. In other words, Broadview has three years to select a different name for business other than BRINKS after its license ends and BCO is required to refrain from using BRINKS for security monitoring services in order to allow Broadview's new name to be established. Apparently, the issue is now rendered moot by

Tyco's acquisition of Broadview and merger into Barricade, and Barricade's recent decision to end the BRINKS license on August 15, 2010.

The spin-off occurred on October 31, 2008, nearly two years ago, and Opposer knew *at that time* that its related company BSHH would be required to eventually change its name. Regardless of whether the spin-off and eventual acquisition were not in Opposer's control, it *was* within Opposer's control and ability to realize that three additional registrations should have been asserted at the time of the spin-off. Opposer's belated realization that it should "augment" its Notice of Opposition is too late.

Interestingly, even though Opposer Brink's Network has admitted in its Reply that Barricade must stop use of the BRINKS marks for security monitoring services by August 15, 2010 and effectively abandon the marks, Opposer has not moved to delete Registration Nos. 1,412,587 and 1,411,610, registered for "Security alarm and monitoring system services," from its Notice of Opposition. Although Opposer tries to argue that use of BRINKS will continue through its insertion in domain names used by Barricade, Opposer should know that this does not constitute proper trademark use. *See In re Supply Guys Inc.*, 86 USPQ.2d 1488, (TTAB 2008) ("the simple fact that a term is used as part of the internet address does not mean that it is a trademark for the goods sold on the website").

### **3. Opposer's License with Hampton Products**

Opposer Brink's Network points out that even if its use of BRINKS for security monitoring services is abandoned, that it still has continuing use of the mark for security products and equipment, through its January 1, 2005 license with Hampton Products International Corporation and that it is necessary to "augment" the Notice of Opposition to include the registrations that cover the security products sold by Hampton. The license with Hampton was entered into exactly three months before Opposer filed the Notice of Opposition.

Accordingly, Opposer should have known that it should have pleaded Registration Nos. 2,330,884 and 2,582,146 when the Notice of Opposition was filed, and later, pleaded Registration No. 3,548,670 when it was registered nearly two years ago. Its license with Hampton was certainly not an event beyond the control of Opposer.

**4. Opposer's Calculation of Its "Delay" is Completely Erroneous**

Finally, Opposer Brink's Network tries to calculate its delay from the suspension of proceedings on October 21, 2009 until April 23, 2010 and the Tyco acquisition of Broadview on May 14, 2010, as somehow those dates were the triggering event for bringing the Motion to Amend. Opposer knows very well that the triggering dates were the registration dates of the three additional registrations that Opposer is belatedly trying to add at this time.

Opposer has no excuse for its undue delay in bringing up these registrations when it has been aware of these registrations for years and could have pleaded them years ago, irrespective of the spin-off and acquisition by Tyco or any other events. Opposer Brink's Network's "explanation," therefore, is really no explanation at all. The Board should deny Opposer's motion.

**C. Applicant Brinkmann Will Suffer Prejudice if the Motion is Granted**

Opposer Brink's Network tries to shift its failure to meet its burden to Applicant Brinkmann by asserting that Applicant has not made a "specific" showing of prejudice and that "normal cost and delay" is insufficient to defeat a motion to amend. However, there is nothing "normal" about the several year delays at issue here. Brink's Network's delay discussed above are clearly extraordinary and prejudicial in and of themselves.

Moreover, although it is unclear what exactly Opposer means by "specific" showing, Applicant Brinkmann is not required to do so, other than to simply point out that the discovery period has ended and testimony periods are about to open shortly. *See Long John*

*Silver 's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982) (opposer' motion to amend to rely on eight additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed); *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ.2d 1597, 1604 (TTAB 2002) (opposer's motion to amend denied because "applicant would suffer prejudice if opposer is permitted to add a dilution claim long after close of discovery" and especially because opposer waited over two years with no explanation why it failed to raise dilution claim earlier); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ.2d 1285, 1286-87 (TTAB 2008) (motion to amend to add two additional claims seven months after petition to cancel was filed denied because opposer knew about underlying facts at time the petition was filed and "allowing piecemeal prosecution of this case would unfairly prejudice respondent by increasing the time, effort, and money that respondent would be required to expend to defend against petitioner's challenge to its registration").

In fact, the Board has held that even undue delay by the moving party is sufficient to deny a motion to amend, even if the discovery period has not yet closed. *Trek Bicycle Corp. v. StyleTrek Limited*, 64 USP.2d 1540 (TTAB 2001) (motion for leave to amend filed prior to close of discovery but based on facts known to opposer prior to institution of the case denied due to unexplained delay).

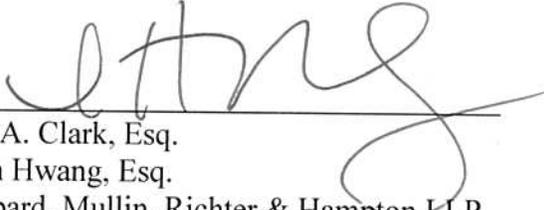
The discovery period in the present proceeding ended on July 2, 2010. Opposer Brink's Network should not be allowed to add three new registrations after the close of discovery period and upon imminent start of the testimony periods, especially since Opposer Brink's Network could have asserted those registrations years ago. Applicant Brinkmann will be unduly prejudiced if Opposer is allowed to drag the proceeding out further by adding the three new registrations.

**II.**  
**CONCLUSION**

Opposer has absolutely no excuse for failing to plead the three additional registrations promptly, two of which issued years before the original Notice of Opposition was even filed and the third of which issued two years ago. Yet Opposer unduly delayed and took no action until the eve of the discovery close. Now that the discovery period has closed, Opposer should not be allowed to prejudice Applicant Brinkmann by piecemeal litigation and further delay of a proceeding that has been pending *for over five years*.

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 the three additional trademark registrations.

Dated: July 30, 2010

  
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CERTIFICATE OF SERVICE

This is to certify that I have this day, July 30, 2010, caused to be served a copy of the foregoing "Applicant Brinkmann's Surreply to Opposer's Motion for Leave to File Third Amended Notice of Opposition" by placing a copy in the United States Mail, postage pre-paid, addressed as follows: Alan S. Cooper, counsel for Opposer, at Howrey LLP, 1299 Pennsylvania Avenue, N.W., Washington, DC 20004.

  
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Susan Hwang