

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 14, 2006

Opposition No. **91167540**

Mintek Corporation

v.

Samuel Bouter dba Minatek
Solutions

Before Quinn, Rogers and Cataldo,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of opposer's motion, filed January 9, 2006, for default judgment.

Preliminarily, we note that on June 7, 2006, the Board vacated applicant's "consented" motion, filed December 13, 2006, to extend the discovery and testimony periods. We further note that the filing of the motion to extend was unnecessary, inasmuch as we consider the filing of the motion for default judgment to have effectively tolled the running of this proceeding.

Turning now to opposer's motion for default judgment, opposer states that applicant was required to file an answer in this case by Tuesday, December 27, 2005; that applicant emailed a copy of his answer to opposer's counsel on Friday, December 23, 2005; and that accordingly, the answer was not

properly served on opposer. Opposer contends that as can be seen by Board records¹, applicant's answer was not properly served upon the Board, because an answer must bear the required proof of service before consideration.²

Opposer also argues that applicant's denials, consisting of nothing more than the allegations raised in the notice of opposition and a one-word agree or deny corresponding thereto, fail to meet the substance of the allegations denied, and that applicant's digital signature referenced in the email does not comply with the electronic signature requirements set forth in TBMP § 106.02.

¹ Applicant filed his answer with the Board via ESTTA, the Board's electronic filing system, on December 23, 2005.

² Opposer also argues that applicant's motion to extend its time to answer, filed December 13, 2005, should not be considered inasmuch as it was not served on counsel for opposer and for other deficiencies. Because applicant filed its answer prior to the expiration of time originally set for filing his answer, applicant's motion to extend is moot.

We are compelled to note that applicant's motion to extend sought additional time to answer based on delays occasioned, presumably, by correspondence having to be sent to him outside the United States. Although applicant is not required to appoint counsel, strict compliance with the Trademark Rules and all other applicable rules is expected of him, and he must deal with the problems caused by his presence outside of the country and the attendant delays in communication between him and both the Board and opposer.

With regard to future communication between the parties, notwithstanding opposer's complaints about applicant's technical noncompliance with the service requirements set forth in Trademark Rule 2.119, the parties are free to agree to make certain exchanges by email, although the exchange of confidential matter by email is not recommended. Such email exchanges between the parties would likely increase the efficiency of their communications.

Opposer also argues that it will be substantially prejudiced not only by the continued suspension of its application but the "inexcusably" drawn-out process arising from applicant's unwillingness to comply with the rules; and that applicant's decision to proceed without counsel cannot provide good cause for the numerous procedural and substantive failings of the answer.

Opposer maintains that "entry of a notice of default" is proper given that the delay was a result of applicant's willful decision to act without the assistance of counsel and gross neglect in learning the necessary procedures.³

In his brief in response to the motion for default judgment,⁴ applicant contends that a ruling of default judgment is not appropriate and would be harsh. Specifically, applicant argues that he answered the notice of opposition before his deadline; that he was advised that email was satisfactory [as a method of service]; that although the method of service was technically incorrect, the method was effective; and that "another copy of the answers have been sent, mailed this time, to the opposer."⁵

³ By this, we presume that opposer is seeking default judgment.

⁴ We note that applicant's response is in letter format and contains several single-spaced paragraphs. Submissions to the Board should be captioned as this order is and should be printed in at least 11-point type and double-spaced, with the text on one side only of each sheet. See TMBP § 106.03 (2d ed. rev. 2004).

⁵ Applicant did not indicate the manner of mailing. However, we presume that the second copy was mailed via the Canadian and

As regards the substance of its answer, applicant states that trademark law states that the answer may contain short explanations, but he does not have enough details about opposer to further answer.

On review of the record in this case, we find that applicant is not in default because he timely filed his answer with the Board. Although the Board generally may defer consideration of a filing until it has been served on the party's adversary, the Board would not refuse to consider a submission unless there was a complete failure of service or refusal to serve. We do not find that applicant's service of his answer by email a willful disregard of the rules. Rather, we find that applicant misapprehended the service rules. Notably, applicant indicates that he has since mailed a copy of the answer on counsel for opposer, and opposer did not dispute this assertion. While applicant's initial method of service was improper, opposer's counsel admitted receipt of an email copy of applicant's answers on December 23, 2005. Thus, we do not find that opposer was prejudiced by delay because opposer timely received, albeit improperly, notice of

United States Postal Services. Applicant is advised that any future paper that is filed with the Board must be accompanied by what is known as "proof of service." "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service. See also TBMP § 113.03 (2d. ed. rev. 2004).

applicant's intent to defend this case. We further do not find that opposer is prejudiced by the delay inherent in the prosecution of this proceeding and opposer's assertion that this proceeding will be "drawn-out" is mere speculation. Indeed, opposer's unwarranted motion for default judgment has created as much, if not more, delay than the brief distraction of applicant's inappropriate ESTTA extension. If opposer had proceeded with discovery, it would be closer to trial at this point in the proceeding.

As regards the substance of applicant's answers, contrary to opposer's position, at this stage of the proceeding, applicant need only admit or deny the allegations contained in each paragraph of the notice of opposition. If an applicant does not have sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it could say so and this would have the effect of a denial. In this instance, applicant denied such allegations. Since the effect is the same, opposer cannot claim that it is unaware of applicant's position with regard to those allegations. We thus find applicant's answer is proper under the notice pleading requirements set forth in Fed. R. Civ. P. 8.

In view of the foregoing, opposer's motion for default judgment is denied.

Trial dates, including the close of discovery, are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	November 25, 2006
30-day testimony period for party in position of plaintiff to close:	February 23, 2007
30-day testimony period for party in position of defendant to close:	April 24, 2007
15-day rebuttal testimony period to close:	June 8, 2007

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If applicant is to defend himself in this proceeding, he should note the following. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. Applicant will have to familiarize himself with the rules governing this proceeding. As previously noted, strict compliance with the Trademark Rules and all other applicable rules is expected of all parties, even those representing themselves.

The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries containing materials on U.S. law, and may be available at some public libraries containing such materials. The Trademark Rules are also available on the World Wide Web at www.uspto.gov. Additional information may be obtained in The Trademark Trial and Appeal Board Manual of Procedure, (TBMP) which is also available on the World Wide Web at www.uspto.gov. As applicant may not have access to a library with U.S. legal materials, he will be expected to familiarize himself, quickly, with materials available on the USPTO website, or through other Internet resources.

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