

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

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Mailed: November 18, 2008

Opposition No. 91175363

RONALD M. CREATORE

v.

PARKER INTANGIBLES LLC

By the Board:

IT IS HEREBY ORDERED:

Opposer's motion for default judgment or, in the alternative, to reset discovery and trial dates for opposer only, is denied.

Opposer is allowed until thirty days from the mailing date of this order to file a copy of the complaint opposer filed against applicant' parent company in Ohio state court seeking, among other things, to enjoin applicant's use of the term PERFORMANCE STAINLESS, the subject of opposed Application Serial No. 76642100.

Summary:

This case comes up on opposer's motion, filed June 14, 2008, for default judgment based on applicant's failure to serve its answer filed March 6, 2007 or, in the alternative, to reset discovery and trial dates for opposer only.<sup>1</sup> The motion is contested, and following opposer's inquiry regarding the status of the motion, the Board held a phone hearing on November 17, 2008. The participants were Ronald Creatore, opposer (919929-8270), Roger Bora, attorney for applicant (937-443-6817), and Elizabeth Dunn (571-272-42670), attorney for the Board.

The Board's institution and trial order in this proceeding issued January 27, 2008, and ordered applicant to file its answer by March 8, 2007. On March 6, 2007, applicant filed an answer which lacked a certificate of service. Opposer did not move for default judgment or to suspend discovery and trial dates. Pursuant to the Board's trial schedule, on August 15, 2007, discovery closed, and

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<sup>1</sup> It appears that opposer filed three copies of the motion, each accompanied by the Board's institution and trial order and applicant's answer. Opposer is ordered to file only a single copy of any paper filed with the Board, and to abstain from submitting as attachments papers already in the record.

Opposer is advised that, to the extent opposer wishes to support his motion with a declaration in lieu of an affidavit, the declaration must comport with Trademark Rule 2.20. The Trademark Rules, as well as the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2nd ed. rev. 2004), are available from the USPTO website at [www.uspto.gov](http://www.uspto.gov).

on November 13, 2007, opposer's testimony period closed. No testimony was filed.

Plainly, since an answer was filed, there is no question that entry of default judgment for failure to file answer is inappropriate. Opposer, who is an attorney, offers no support for his argument that the failure to serve the answer should result in entry of default judgment or reopening of discovery for opposer only. In similar circumstances the Board has found that opposer's failure to receive an answer, when one has in fact been filed, brings a duty to determine the status of the case, and does not allow opposer to assume that applicant is in default. *Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 USPQ2d 1701, at 1701 (TTAB 2002).<sup>2</sup> Opposer's motion for default judgment or, in the alternative, to reset discovery and trial dates for opposer only, is denied.

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<sup>2</sup> In *Old Nutfield Brewing*, the Board noted that notice of default does not issue automatically, that discovery and trial dates are not suspended automatically, and that if opposer had any question as to whether applicant was in default and proceedings were suspended, opposer was under an obligation to contact the Board to ascertain the status of the proceeding. Since opposer failed to do so until well after its testimony date closed, the Board found that opposer had failed to establish excusable neglect for its failure to present its case and entered judgment for applicant. *Id.*, at 1703-1704.

During the telephone hearing opposer urged the Board to disregard applicant's statement that the failure to serve was inadvertent because applicant has previously acted in bad faith in its dealings with opposer.<sup>3</sup> Opposer alleges that there is a civil action between the parties, that applicant knew of opposer's assertion of superior rights in a confusingly similar mark, and that applicant's filing of the opposed application with its averment of an exclusive right to use the mark in commerce was made in bad faith. The gist of opposer's position is that opposer's opinion that the marks are likely to be confused and that opposer's rights to the mark are superior, was enough to make the filing of the opposed application an act of bad faith.<sup>4</sup> We reject this argument and urge opposer to refrain

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<sup>3</sup> Opposer's argument that applicant acted in bad faith in failing to serve discovery so as not to alert opposer that an answer had been filed also is unpersuasive. There is no duty to conduct discovery. The answer has been a public record available on the USPTO website since it was electronically filed on March 6, 2007.

<sup>4</sup> When a party claims that the declaration in another's application for registration was executed fraudulently in that there was another use of the same or confusingly similar mark at the time the declaration was signed, the party must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's rights; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which applicant was

from allegations of bad faith against an adversary with a different legal opinion.

It should be noted that while Patent and Trademark Office Rule 10.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by experienced trademark counsel.

The discussion of the civil action between the parties raises the issue of whether this proceeding should be suspended. Opposer, plaintiff in the civil action, confirms that he seeks to enjoin applicant's use of the mark in the opposed application. Accordingly, the court's disposition of the civil action may have a bearing on this proceeding. As noted above, opposer is allowed until thirty days from the mailing date of this order to file a

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not entitled. See *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899 (TTAB 2006); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Intellimedia Sport Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1206 (TTAB 1997) and cases cited therein.

copy of the complaint opposer filed against applicant's parent company in Ohio state court.

Proceedings herein are suspended pending the Board's review of the pleadings in the civil action.

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The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdnagmnt.htm>