

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

Mailed: June 17, 2008

Opposition No. **91175892**
91175893

Microsoft Corporation

v.

Daniel, Mark T

Linda Skoro, Interlocutory Attorney

This case now comes up on applicant's motion to dismiss opposer's amended notice of opposition, or in the alternative, to strike opposer's allegations of applicant's bad faith, filed August 15, 2007. Opposer has responded.

By Board order dated May 8, 2007, opposer was given leave to amend its notice of opposition to properly plead a second ground of opposition, namely, priority of use analogous to trademark use. Opposer filed its amended notice of opposition on May 11, 2007. By order dated June 14, 2007, the Board found the amended pleading based on use analogous to trademark use sufficient, applicant's motion to suspend was denied and dates were reset. Applicant was allowed until August 16, 2007 to file its answer to the

amended notice.¹ In lieu of an answer, applicant filed the motion to dismiss or alternative motion to strike which is now before the Board.²

As grounds for its motion to dismiss, applicant states that opposer's amended notice "does not plead use prior to July 2006" (Br. p.3); and that it pleads "at least as early as July 11, 2007" (Amended Not. ¶ 6). The May 8, 2007 order requiring opposer's amended pleading merely stated that opposer "must plead use prior [to July 16, 2006³]" to properly plead use analogous to trademark use. (Order p.2). In pleading use analogous to trademark use prior to July 11, 2006, opposer's amended complaint satisfies the Board's order and, as stated in the Board's June 14, 2007 order "we hold that the notice of opposition has adequately asserted opposer's requisite standing and statutory grounds for opposing applicant's current application". (Order p.2).

¹ In the Board's June 14, 2007 order, while dates were reset, the order failed to state the date by which applicant's answer was due. The oversight was corrected by Order dated July 16, 2007 wherein applicant was allowed thirty days to file an answer and the trial dates remained as set in the June 14, 2007 order.

² On August 31, 2007 applicant also filed a motion to suspend proceedings pending a decision on the motion to dismiss and for a protective order precluding opposer from compelling discovery responses propounded on April 12, 2007. In that there is no motion to compel discovery responses before the Board from opposer, applicant's motion is denied as moot. In that it is standard Board procedure to suspend proceedings pending a decision on a motion to dismiss, that request was granted on September 17, 2007.

³ Applicant's filing date of his intent-to-use application.

Applicant also argued that opposer lacks standing to oppose his application under the Paris Convention, namely, it cannot seek priority based on a foreign application when it is not a foreign national. Applicant is mistaken in his interpretation of the pleadings and Section 44(d) of the Trademark Act. As opposer states, it has properly alleged a bona fide and effective commercial establishment in Germany (Br. p. 17), thereby rendering the pleading sufficient to withstand a motion to dismiss.

Accordingly, applicant's motion to dismiss the amended notice of opposition is hereby DENIED.

As to applicant's alternative motion to strike opposer's allegations of bad faith, namely, that applicant knew of opposer's superior legal rights in the mark when he filed his application, in that opposer has not been plead this allegation with sufficient particularity, the Board disagrees. Opposer's allegations, as well as the other claims, remain subject to proof at trial, but are sufficiently plead.⁴

Accordingly, applicant's motion to strike these allegations is hereby DENIED.

Applicant is allowed THIRTY DAYS from the mailing date of this order within which to file an answer to the amended

⁴ Applicant seems more disconcerted by opposer's ability to claim priority of use in a foreign country, rather than challenging the sufficiency of the pleading.

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notice of opposition and to ANSWER all outstanding discovery. Trial dates are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	October 15, 2008
30-day testimony period for party in position of plaintiff to close:	January 13, 2009
30-day testimony period for party in position of defendant to close:	March 14, 2009
15-day rebuttal testimony period for plaintiff to close:	April 28, 2009

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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NEWS FROM THE TTAB:

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

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/stndagmnt.htm>