

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

WINTER

Mailed: January 15, 2008

Opposition No. 91178890

VVI

v.

**Siemens Medical Solutions
USA, Inc.**

Elizabeth J. Winter, Interlocutory Attorney:

On December 26, 2007, the Board issued an order that discharged the notice of default issued on November 8, 2007. The notice of default had allowed applicant time to show cause why default judgment should not be entered against it under Fed. R. Civ. P. 55(a) for failure to timely file an answer.

The Board notes that on December 26, 2007, opposer filed a motion related to the Board's November 8, 2007 "show cause" order.¹ Even though opposer's filing is entitled "Request for Summary Judgment Against Defendant," opposer clarifies (on page 4 of its submission) that its filing "is specifically to add information for the purpose of a §312.02 determination." In view thereof, we do not consider opposer's submission to be

¹ The Board's order and opposer's filing evidently "crossed" in the mail.

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a motion for summary judgment as contemplated under Fed. R. Civ. P. 56 or Trademark Rule 2.127, 37 C.F.R. § 2.127.

To the extent opposer's motion could be construed as a either a motion for default judgment based on applicant's failure to file a timely answer to the notice of opposition or a motion for reconsideration of the Board's order discharging the notice of default, we do not find opposer's arguments therefor to be persuasive. Opposer essentially argues that default judgment should be issued against applicant because applicant's conduct shows gross neglect and bad faith, applicant's responses to the complaint are not plausible or meritorious, and opposer has been substantially prejudiced. Opposer also in part argues the merits of its case, which will not be considered in determining whether a notice of default should be discharged.

As explained in the Board's December 26, 2007 order, the notice of default was discharged because applicant provided a showing of good cause for its failure to file a timely answer. Moreover, there was no evidence of record showing that applicant's failure to file its answer was the result of willful inattention or bad faith, or that opposer is substantially prejudiced by applicant's late filing. See, e.g., *Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1903-04 (Comm'r 1990) (no evidence that failure

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was willful; costs incurred in preparing and filing motion not sufficient to support finding of prejudice). Further, by filing a non-frivolous answer, applicant showed that it has a meritorious defense, that is, a plausible response² to the allegations in the complaint. Finally, because the law favors deciding cases on their merits, the Board is reluctant to grant judgments of default and tends to resolve all doubts by setting aside default. *See Paolo's Associates, supra.*

Accordingly, to the extent that opposer's submission could be considered either a motion for default judgment or for reconsideration of the Board's December 26, 2007 order, opposer's motion is denied.

The Board also notes that opposer is not currently represented by counsel in this proceeding. In view thereof, and as a courtesy, the Board provides the following important information.

² Opposer should note that under Rule 8(b) of the Federal Rules of Civil Procedure, applicant is permitted to state "admit," "deny" or "applicant is without knowledge or information sufficient to form a belief as to the truth of" the allegations set forth in the notice of opposition. Fed. R. Civ. P. 8(b) provides, in part:

A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

Nature of an Opposition Proceeding

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. *No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.*

Rules Applicable to Board Proceedings

The above-referenced rules on pleadings are set forth in Rule 8 of the Federal Rules of Civil Procedure. 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 also govern the conduct of this opposition proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). There

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are other rules in part one of Title 37, relevant to filing of papers, meeting due dates, etc., that are also applicable to this case. The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries, and may be available at some public libraries. If opposer or applicant wishes to obtain a copy of Title 37 of the CFR, it may be ordered for a fee from the Government Printing Office, Washington, D.C. 20401, or from the U.S. Government Bookstore, using the following web address:

<http://bookstore.gpo.gov/actions/GeneralSearch.do>.

Requirement for Service of All Papers on Adverse Party

Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party (or adversary), or on the party (or adversary) if there is no attorney, and proof of such service must be made *before the paper will be considered by the Board*. Consequently, copies of all papers that the parties may subsequently file in this proceeding must be accompanied by "proof of service" of a copy on the other party or the other party's counsel.

"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

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the address used to effect service, and (4) the date of service.

Legal Representation Is Strongly Encouraged

It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent itself,³ it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or 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.

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, www.uspto.gov.

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 counsel.

All Parties Must Comply With Board Deadlines

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent

³ Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office. Further, individuals who are not attorneys are not recognized to practice before the Office in trademark matters. Trademark Rules 10.14(b) & (e), 37 C.F.R. §§ 10.14(b) and (e).

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and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Patent and Trademark Rules 1.8 and 1.10 is utilized.⁴ These rules are in part one of Title 37 of the previously-discussed Code of Federal Regulations.

Discovery and Trial Dates

Discovery and trial dates remain as set in the Board's institution order dated August 13, 2007.

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⁴ Use of electronic filing with ESTTA (Electronic System for Trademark Trials and Appeals (ESTTA)), available through the USPTO website, is strongly encouraged.

Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

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

on _____ (Date)

_____ (Signature)

_____ (Typed or printed name)

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>