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

Proceeding	91179739
Party	Plaintiff Roland Corporation
Correspondence Address	Christopher C. Larkin Seyfarth Shaw LLP 2029 Century Park EastSuite 3300 LOS ANGELES, CA 90067-3063 UNITED STATES clarkin@seyfarth.com, kelko@seyfarth.com
Submission	Other Motions/Papers
Filer's Name	Christopher C. Larkin
Filer's e-mail	clarkin@seyfarth.com, kelko@seyfarth.com
Signature	/Christopher C. Larkin/
Date	11/21/2007
Attachments	Opposer's Motion to Strike Applicant's Answer.pdf (9 pages)(309859 bytes)

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

In the Matter of Application Serial No. 78/883,538
Published in the Official Gazette of July 31, 2007

ROLAND CORPORATION, Opposer, v. CHRISTOPHER R. MAHONEY, Applicant.	Opposition No. 91179739

OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure, opposer Roland Corporation hereby moves the Board for an order striking the purported answer to Opposer's notice of opposition filed by applicant Christopher R. Mahoney ("Applicant") on the ground that the purported answer consists entirely of immaterial matter that fails to conform to the requirements of Rule 8(b) of the Federal Rules of Civil Procedure.

This motion is based upon the attached brief, the notice of opposition filed by Opposer on September 27, 2007, and Applicant's purported answer thereto, filed on November 6, 2007, and such other argument and evidence as may be presented to the Board on this motion.

OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION TO STRIKE

On September 27, 2007, Opposer filed this opposition to Applicant's application to register "BOSS TONE" for guitar pedals, namely, effects pedals for use with sound amplifiers. Opposer pleaded three claims for relief, in 15 numbered paragraphs, based upon Opposer's prior use and registration of "BOSS" for various types of electronic musical instruments, including effects pedals, and Applicant's fraudulent misuse of the federal registration symbol in connection

with his claimed "BOSS TONE" mark. Under the Board's scheduling order issued that day, Applicant's answer to Opposer's notice of opposition was due to be served and filed on November 6, 2007.

On November 6, 2007, Applicant, appearing *pro se*, electronically filed (but did not serve on Opposer)[1] a letter denominated in the cover sheet as Applicant's "Answer" and directed "To whom it may concern." Applicant's letter discussed various aspects of the prosecution history of the opposed application and argued that it would be unfair for the Patent and Trademark Office not to permit registration of "BOSS TONE" over Opposer's challenge. This letter is an "answer" in name only, as it does not permit Opposer to determine which of its allegations are admitted or denied, or what claims are at issue on the basis of the pleadings. For the reasons set forth below, the purported answer should be stricken and Applicant should be required to file an answer that conforms to the requirements of the Federal Rules of Civil Procedure.

ARGUMENT
APPLICANT'S PURPORTED ANSWER SHOULD BE STRICKEN.

Rule 8(b) of the Federal Rules of Civil Procedure provides in pertinent part as follows:

> "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."

Fed. R. Civ. P. 8(b).

Under Rule 8(b), Applicant's purported answer to Opposer's notice of opposition "must be directly responsive to the notice of opposition; it should not be used as an opportunity for

[1]Opposer's counsel obtained a copy of the answer from TTABVUE page for this case.

[A]pplicant to present evidence or arguments in the nature of a brief on the case." *Safety Angel International, Inc. v. Safety Angel, Inc.*, 2005 TTAB LEXIS 368, * 3-4 (TTAB August 31, 2005).[2] Applicant's letter does not satisfy these requirements because it is "argumentative, nonresponsive and otherwise not in compliance with Rule 8(b)." *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1943 (TTAB 1996). Applicant's letter-answer should be stricken and Applicant should be ordered to file an answer that is in proper form and conforms to the requirements of Rule 8(b), and that is properly served upon Opposer's counsel.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: November 21, 2007

By: _____
Christopher C. Larkin
Attorneys for Opposer
ROLAND CORPORATION

[2]A copy of this decision is attached hereto.

ATTACHMENT

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*2005 TTAB LEXIS 368, **

Safety Angel International, Inc. v. Safety Angel, Inc.

Opposition No. 91162586

Trademark Trial and Appeal Board

2005 TTAB LEXIS 368

August 31, 2005, Mailed

CORE TERMS: opposer, notice, summary judgment, Trademark Rules, Trademark Rule, opening, effective, untimely, caption, responsive pleading, alternative motion, party filing, pleader, intends, reset, web

JUDGES: [*1]

Before Walters, Holtzman, and Rogers, Administrative Trademark Judges.

OPINION:
THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

On August 5, 2005, opposer filed a motion for judgment on the pleadings and alternative motion for summary judgment.

To be timely, a motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset. See TBMP § 504.01 (2d. ed. rev. 2004) and cases cited therein. Moreover, it is noted that a motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See* TBMP § 528.01 (2d. ed. rev. 2004), and the authorities cited therein. n1

n1 Cf. 37 CFR § 2.127(e)(1).

For these reasons, a motion for judgment on the pleadings and/or one seeking summary judgment ordinarily should be filed prior to the opening of the first testimony period, as originally set or as reset, and the Board, in its **[*2]** discretion, may deny as untimely any such motion filed thereafter. *See* 37 CFR § 2.127 (e) (1); *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH*, 5 USPQ2d 1376 (TTAB 1986); and *La Maur, Inc. v. Bagwells Enterprises, Inc.*, 193 USPQ 234 (Comm'r 1976).

A review of the record in this case reveals that opposer's first testimony period opened, as originally set, on July 8, 2005, nearly one month before opposer's motion for judgment was filed. Thus, opposer's motion, filed on August 5, 2005, is untimely and is denied, both as a

motion for judgment on the pleadings and as an alternative motion for summary judgment.

Nonetheless, it is observed that the record does not include a complete copy of applicant's December 6, 2004 "answer" to the notice of opposition and that applicant's "answer" fails to comply with Fed. R. Civ. P. 8.

Accordingly, applicant is allowed until **thirty days** from the mailing date set forth above the caption hereof to file an answer that complies **[*3]** with Fed. R. Civ. P. 8.

Applicant's answer must properly respond to the notice of opposition as required by Rule 8(b) of the Federal Rules of Civil Procedure, made applicable to this proceeding by Trademark Rule 2.116(a). 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.

Opposer's notice of opposition is the initial "pleading" in this case. Applicant, if it wishes to defend this case, must file a responsive pleading, i.e., an answer. The answer must be directly responsive to the **[*4]** notice of opposition; it should not be used as an opportunity for applicant to present evidence or arguments in the nature of a brief on the case.

The notice of opposition filed by opposer herein consists of an opening paragraph, eight numbered paragraphs (with sub-paragraphs) setting forth the basis of opposer's claim of damage, and a closing "prayer" for relief. Each of the numbered paragraphs contains one or more allegations of fact. In accordance with Fed. R. Civ. P. 8(b), **it is incumbent on applicant to respond to each allegation, using correspondingly numbered paragraphs, by either *admitting* the truth of the allegation or *denying* that the allegation is true. If applicant is without sufficient knowledge or information on which to form a belief as to the truth or falsity of a particular allegation, then applicant may say so without risk;** such a response is considered to have the same effect as a denial.

Also, the answer and any other papers filed herein by applicant should not be sent out in letter form. Rather, they should be headed with a proper "caption" setting out the parties' names, the opposition number and **[*5]** a title stating the nature of the submission.

The above-referenced rules on filing a responsive pleading are set forth in Rule 8(b) 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 govern the conduct of this opposition proceeding.

It is recommended that applicant obtain counsel. While Trademark 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. n2

n2 If applicant intends to represent itself in this matter, applicant will have to become familiar with the rules governing this proceeding. 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). There 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 Trademark Rules set out in Title 37 and the Trademark Trial and Appeal Board's Manual of Procedure (TBMP) both are available for viewing via the USPTO web page, at www.USPTO.gov.

One rule that applicant must pay particular attention to is Trademark Rule 2.119. That rule requires that a party filing any paper with the Board during the course of a proceeding must serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. With the paper that is filed with the Board, the party filing the paper must include "proof of service" of the copy on the other party. Consequently, copies of all papers which applicant may subsequently file in this proceeding, including its answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service. **[*6]**

Applicant's August 15, 2005 objections to opposer's August 3, 2005 motion to extend are noted.

Inasmuch as opposer has recently retained new counsel in this proceeding, because opposer had moved to extend its testimony period prior to the close of its testimony period, and insofar as the filing of opposer's potentially dispositive motion on August 5, 2005 effectively tolled n3 the trial schedule in this proceeding, we hereby **suspend** opposer's testimony dates in this proceeding pending applicant's response consistent with the foregoing. Once a proper answer has been received into the record from applicant, the Board will issue an order resuming opposer's testimony period for a duration of two weeks, allowing opposer only a limited time in which to take and complete its testimony.

n3 See Trademark Rule 2.127(d).

Applicant is advised that failure to submit an answer which complies with Fed. R. Civ. P. 8 could result in entry of default judgment against applicant.

* * * *

Notice Regarding TTAB Electronic Resources and New Rules

. TTAB forms for electronic filing of extensions of time to oppose, notices **[*7]** of opposition, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

. Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.

. The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law > Foreign & International Protections > International Treaties

Trademark Law > U.S. Trademark Trial & Appeal Board Proceedings > Oppositions > General Overview

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CERTIFICATE OF SERVICE

I hereby certify that on November 21, 2007, I served the foregoing Opposer's Motion to Strike Applicant's Answer on the applicant by depositing a copy thereof in a sealed envelope, postage prepaid, in First Class United States Mail addressed to applicant as follows:

Mr. Christopher R. Mahoney
2009 Big Oak Drive
Spring Hill, TN 37174-2587

Eleanor Elko

Eleanor Elko