

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

Mailed: January 31, 2008

Opposition No. 91179739

Roland Corporation

v.

Christopher R. Mahoney

Frances S. Wolfson, Interlocutory Attorney:

Opposer's motion (filed November 21, 2007) to strike applicant's answer is hereby granted as conceded and as well taken. Trademark Rule 1.127(a). Applicant's answer is informal and does not comply with Fed. R. Civ. P. 8.

An answer to the notice of opposition must comply with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable 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.

The notice of opposition filed herein consists of **fifteen** paragraphs setting forth the basis of opposer's claim of

damage. In accordance with Fed. R. Civ. P. 8(b) it is incumbent on applicant to answer the notice of opposition by **admitting or denying** the allegations contained in each paragraph. If applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it should so state and this will have the effect of a denial.¹

In view of the foregoing, applicant is allowed until THIRTY DAYS from the mailing date of this order in which to file an answer which complies with Fed. R. Civ. P. 8.²

¹ For example, if the first numbered paragraph in the notice of opposition sets forth opposer's name and address, a matter about which applicant has no knowledge, the second numbered paragraph sets forth applicant's name, application number and the mark, a matter which applicant knows is factually accurate, and the third numbered paragraph asserts a likelihood of confusion between opposer's mark and applicant's mark, a matter which applicant disputes, then an answer which complies with Fed. R. Civ. P. 8(b) would address these matters as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and therefore it is denied.
2. Admitted.
3. Denied.

² Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received. 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 general format for a certificate of mailing is:

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

Proceedings are otherwise herein suspended.

General Information for Applicant

Applicant is advised that 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.***

REQUIREMENT FOR SERVICE ON ADVERSE PARTY OF ALL PAPERS FILED

Applicant is expected to comply with the service requirements set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) require that every paper filed in the

The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party 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 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. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated.

See also TBMP §113 (2d ed. rev. 2004).

Applicant should note that it is responsible for ensuring that the Board has its current correspondence

address. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party. See TBMP § 117.07 (2d ed. rev. 2004).

Applicant should note that any paper it is required to file with the Board should not take the form of a letter; proper format should be utilized. The form of submissions is governed by Trademark Rule 2.126. See also TBMP § 106.03 (2d ed. rev. 2004).

ELECTRONIC RESOURCES

Applicant may access some of the materials referred to above by logging onto <http://www.uspto.gov> and making the connection to trademark materials. The files of this Board proceeding can be examined using TTABVUE, accessible at <http://ttabvue.uspto.gov>. (after entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.)

Finally, the Board's manual of procedure will be helpful. The first revision of the second edition (March 2004) 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/. Below are guidelines as to the relevant sources of law governing the conduct of this proceeding. The Trademark Rules of Practice 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 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 applicant wishes to obtain a copy of Title 37 of the CFR, it may be ordered for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

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 and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991).

Applicant should note that although Patent and Trademark Rule 10.14 permits any person to represent itself in a Board proceeding, it is generally advisable for a person unfamiliar with the above-referenced rules to secure the services of an attorney familiar with such matters. The Office cannot aid in the selection of an attorney. If applicant does not retain counsel, applicant must familiarize itself with the rules governing this proceeding.

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.

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>