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Filing date: **08/18/2009**

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

Proceeding	91181448
Party	Defendant Patriot Guard Riders, Inc.
Correspondence Address	James R. Foley Trexler, Bushnell, Giangiorgi, Blackston 105 West Adams St., 36th Floor Chicago, IL 60603 UNITED STATES dmarr@trexlaw.com, ptodocket@trexlaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	James A. O'Malley
Filer's e-mail	ptodocket@trexlaw.com, jomalley@trexlaw.com, dmarr@trexlaw.com
Signature	/James A. O'Malley/
Date	08/18/2009
Attachments	Motion.pdf (4 pages)(84074 bytes) Memorandum.pdf (9 pages)(277749 bytes) Exhibit1.pdf (3 pages)(47804 bytes)

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

JEFF BROWN,	)	
	)	
Opposer,	)	
	)	Opposition No. 91181448
v.	)	
	)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,	)	
	)	
Applicant.	)	

APPLICANT'S MOTIONS TO DISMISS OR, IN THE ALTERNATIVE, STRIKE AND FOR SUSPENSION OF THESE PROCEEDINGS

Applicant, Patriot Guard Riders, Inc., by and through its counsel, hereby moves to dismiss the Amended Notice of Opposition filed by Opposer, Jeff Brown, or, in the alternative, moves to strike portions of the Amended Notice of Opposition.

Applicant also requests that, pursuant to Rule 2.127(d), the Board suspend these proceedings as of today pending determination of its Motion. Should the Board's decision regarding this Motion require Applicant to respond to Opposer's Amended Notice of Opposition as filed, Applicant hereby requests that the time period for Applicant to file and serve an Answer to Opposer's Amended Notice of Opposition be set at fifteen (15) days after disposition of this motion (or fifteen (15) days after service of Opposer's Amended Notice of Opposition, whichever is later) and that Opposer's 30-day Trial Period be set to end at forty-five (45) days after the date on which Applicant must file and serve the Answer.

This Motion to Dismiss is made on the grounds that Opposer failed to serve his Amended Notice of Opposition on Applicant's counsel as specifically required in 37 CFR §2.119 (*see also* TBMP §113) and as specifically set forth by the Board in its Opinion mailed July 21, 2009 (*see*

page 3, 1st paragraph).

In the alternative, this Motion to Strike is made on the grounds that:

1. Count One of Opposer's Amended Notice of Opposition still does not *sufficiently* allege priority and ownership of the mark in Opposer's application Serial No. 77/041,061 nor likelihood of confusion under Fed. R. Civ. P. 8(a) as specifically required by the Board in its Opinion mailed July 21, 2009 (*see* page 3, 1st paragraph); and

2. Count Two of Opposer's Amended Notice of Opposition maintains the fraud claim despite the Board's *obvious* clue that Opposer should remove this claim from the Opposition in order to save resources (*see* the Board's Opinion mailed July 21, 2009 at page 6, 3rd paragraph and fn. 5) and, in fact, even brazenly broadens the fraud claim by adding issues not previously pleaded by the Opposer and which were not addressed or raised during discovery (which is now closed), including matters relating to the specimens filed by Applicant during prosecution of application Serial No. 77/040,379 and even those relating to the filing of separate application Serial No. 77/383,586, which is not subject to the present Opposition proceeding.

Applicant's Motion to Dismiss or, in the alternative, Strike is supported by "Applicant's Memorandum in Support of its Motion to Dismiss or, in the Alternative, Strike".

This Motion is being filed within fifteen days from the date (August 4, 2009) on which the Opposer filed his Amended Notice of Opposition through ESTTA. Applicant states, though, that the Board's Opinion mailed July 21, 2009 allowed Applicant fifteen days from the ***service*** of

Opposer's Amended Notice of Opposition to file an Answer thereto. Because Applicant has not received any indication that Opposer has served the Amended Notice of Opposition, as presently advised, Applicant's allotted fifteen day time period has, to the best of Applicant's knowledge, not yet begun.

Wherefore, Applicant respectfully prays that its Motion to Dismiss be granted, or in the Alternative, that Applicant's Motion to Strike be granted.

Date: August 18, 2009

Respectfully submitted,

By: _____

One of Applicant's Attorneys
David J. Marr
James R. Foley
James A. O'Malley
TREXLER, BUSHNELL, GIANGIORGI,
BLACKSTONE & MARR, LTD.
105 W. Adams Street, Suite 3600
Chicago, Illinois 60603-6210
(312) 704-1890

AF6655

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 18, 2009, true and correct copies of the following documents:

1. *"Applicant's Motion To Dismiss Or, In the Alternative, Strike And For Suspension Of These Proceedings"*; and

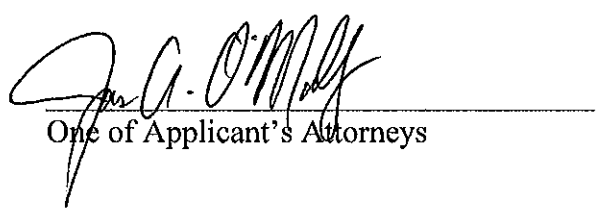
2. *"Applicant's Memorandum In Support Of Its Motion To Dismiss Or, In the Alternative, Strike"* including Exhibit 1 thereto,

were sent via electronic delivery and mailed, with proper postage thereon, to:

Tom Q. Ferguson (tferguson@dsda.com)
Courtney Bru (cbru@dsda.com)
DOERNER, SAUNDERS, DANIEL
& ANDERSON, L.L.P.
320 South Boston Avenue, Suite 500
Tulsa, Oklahoma 74103-3725

and

Rachel Blue (rachel.blue@mcafeetaft.com)
MCAFEE & TAFT
500 Oneok Plaza
100 West 5th Street
Tulsa, Oklahoma 74103



One of Applicant's Attorneys

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

JEFF BROWN,	)	
	)	
Opposer,	)	
	)	Opposition No. 91181448
v.	)	
	)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,	)	
	)	
Applicant.	)	

APPLICANT'S MEMORANDUM IN SUPPORT OF ITS
MOTION TO DISMISS OR, IN THE ALTERNATIVE, STRIKE

Applicant, Patriot Guard Riders, Inc. ("PGR"), by and through its counsel, has moved to dismiss the Amended Notice of Opposition filed by Opposer, Jeff Brown ("Brown"), or, in the alternative, to strike portions of the Amended Notice of Opposition.

INTRODUCTION

On July 21, 2009, the Trademark Trial and Appeal Board ("TTAB") issued an Opinion in which it denied the parties' cross-motions for summary judgment, both filed January 22, 2009, on the priority and likelihood of confusion and fraud claims, as well as Brown's Motion to Strike PGR's Exhibits (Nos. 7, 16, 17 and 18), filed February 26, 2009. In this Opinion, the TTAB stated that Brown's "simple assertion of 'likelihood of confusion' and 'Trademark Act Section 2(d)' on the ESTTA filing coversheet would not meet the pleading requirement of Fed. R. Civ. P. 8(a)." (*See* page 2, 2nd paragraph). Rather than ruling in PGR's favor in view of Brown's failure to meet the pleading requirement of Fed. R. Civ. P. 8(a), the TTAB allowed Brown "until FIFTEEN DAYS from the mailing date of this order to file *and serve* an amended notice of opposition to *sufficiently* allege likelihood of confusion under Fed. R. Civ. P. 8(a) and to allege

ownership of application Serial No. 77041061, as well as priority and ownership of the mark in the '061 application. Applicant is then allowed until FIFTEEN DAYS *from the service* of opposer's amended notice of opposition to file an answer thereto." (Emphasis added). (*See* page 3, 1st paragraph).

I. Brown's Failure To Serve The Amended Notice Of Opposition Requires That It Be Dismissed And Not Considered By The TTAB

In view of the TTAB's fifteen day deadline, Brown was due to file *and serve* his Amended Notice of Opposition no later than August 5, 2009. (*See* Declaration of David J. Marr, attached hereto as Exhibit 1 at ¶2). When PGR's attorneys had not received service by e-mail of the Amended Notice of Opposition by August 6, 2009 (the parties had typically previously served documents both by e-mail and by first class mail), PGR's attorney checked the United States Patent and Trademark Office's website in order to determine whether Brown had filed his Amended Notice of Opposition by the August 5, 2009 deadline. (*See* Exhibit 1 at ¶3). PGR's attorney's check revealed that an Amended Notice of Opposition had, in fact, been filed on August 4, 2009 through ESTTA, but further revealed that the filed Amended Notice of Opposition did not provide any proof that this document had been served on PGR's attorneys as it did not include a Certificate of Service. (*See* Exhibit 1 at ¶4). Regardless, PGR's attorney still expected to receive service of the filed Amended Notice of Opposition by first class mail, but, as of today, August 18, 2009 (fourteen (14) days after Brown filed the Amended Notice of Opposition), PGR's attorney has still not received service of the filed Amended Notice of Opposition by e-mail, first class mail or any other appropriate manner. (*See* Exhibit 1 at ¶5).

The TTAB's Opinion mailed July 21, 2009 clearly required that Brown file *and serve* an

Amended Notice of Opposition no later than fifteen days after the mailing date. (*See* page 3, 1st paragraph). Furthermore, 37 CFR §2.119(a) clearly states that: (1) *every* paper filed in the Patent and Trademark Office in inter parties cases (with a few exceptions that are not applicable here) *must be served* upon the other party; (2) proof of such service *must be made* before the paper will be considered by the Office; and (3) a statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as *prima facie* proof of service.

As the Amended Notice of Opposition filed by Brown does not provide, either as an attachment or on the original paper, any statement signed by Brown's attorney or another authorized representative which clearly states the date and manner in which service was made, and because PGR's attorneys never were served with a copy of the Amended Notice of Opposition as filed (by e-mail, first class mail or any other appropriate manner), the TTAB must not consider the Amended Notice of Opposition pursuant to 37 CFR 2.119(a). Therefore, PGR respectfully requests that the Amended Notice of Opposition not be considered and, thus, dismissed.

In the event that the TTAB elects to consider the Amended Notice of Opposition, contrary to 37 CFR §2.119(a), PGR requests that the TTAB strike portions of the Amended Notice of Opposition for the reasons discussed hereinbelow.

II. Count One Of Brown's Amended Notice Of Opposition Should Be Stricken

The TTAB ruled that Brown's simple assertion of likelihood of confusion and Trademark Act Section 2(d) on the ESTTA filing coversheet would not meet the pleading requirements of Fed. R. Civ. P. 8(a), but rather than ruling in PGR's favor in view of Brown's failure to meet the

pleading requirement of Fed. R. Civ. P. 8(a), the TTAB allowed Brown "until FIFTEEN DAYS from the mailing date of this order to file and serve an amended notice of opposition to *sufficiently allege likelihood of confusion under Fed. R. Civ. P. 8(a) and to allege ownership of application Serial No. 77041061, as well as priority and ownership of the mark in the '061 application.*" (Emphasis added). (*See* page 3, 1st paragraph).

While Brown's Amended Notice of Opposition provides more information than that as originally provided, PGR submits that the Amended Notice of Opposition still does not *sufficiently* allege priority and ownership of the mark in Brown's application Serial No. 77/041,061 nor likelihood of confusion under Fed. R. Civ. P. 8(a). More specifically, and keeping in mind that discovery has long since been completed, Brown does not provide any allegations regarding at least the following matters that are extremely pertinent to him to prove and prevail on his Section 2(d) claim:

1. Brown provides information from his trademark application regarding the dates of first use of the mark in connection with "association services, namely, promoting the interests of families deceased military members and families of deceased veterans", but provides absolutely no assertions regarding how or where such alleged first uses of the mark occurred;[1]
2. Brown provides absolutely no assertions regarding why/how first use of the mark was allegedly done by Brown, on his own behalf, as an individual, rather than on behalf of the PGR or by others on behalf of the PGR;

[1]As noted in PGR's Opposition to Brown's Motion for Summary Judgment at pp. 4-8, Brown's alleged dates of first use in connection with association services are not supported by evidence uncovered during discovery.

3. Brown provides absolutely no assertions as to how he, as an individual, could allegedly perform "association services";

4. While Brown alleges that the PGR operated its association services by means of a license from Brown (which Brown did not originally plead), Brown provides absolutely no assertions regarding this alleged license, namely, for instance, what type of license it is, when the license came into existence, who was aware of the license, the terms of the licence, etc.;[2]

5. Brown provides absolutely no assertions as to how/when/where PGR allegedly became aware of Brown's alleged ownership of the mark; and

6. Brown provides absolutely no assertions as to how/when/where PGR allegedly became aware that Brown's use of the mark was done on Brown's own behalf, as an individual, rather than on behalf of PGR.

Thus, PGR states that, despite the TTAB giving Brown another bite at the apple, Brown's Amended Notice of Opposition still does not *sufficiently* allege matters relating to Brown's alleged ownership and priority of use of the mark and, thus, Brown's likelihood of confusion claim, as ordered by the TTAB. Because Brown's Count One is not sufficiently pleaded, PGR respectfully requests the TTAB to strike Count One from this Opposition proceeding.

III. Count Two Of Brown's Amended Notice Of Opposition Should Be Stricken

In the TTAB's Opinion mailed July 21, 2009, the TTAB allowed Brown to file and serve an amended notice of opposition in order to "sufficiently allege likelihood of confusion under

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[2]As discussed in PGR's Opposition to Brown's Motion for Summary Judgment at p. 10, Brown even seems to be unsure of what type of license supposedly existed as he has referred to it as being an express, oral license at times and then, alternatively, as an implied license-in-fact.

Fed. R. Civ. P. 8(a) and to allege ownership of application Serial No. 77041061, as well as priority and ownership of the mark in the '061 application." (*See* page 3, 1st paragraph). This allowance by the TTAB clearly did not set forth an avenue for Brown to expand upon his fraud claim as originally pleaded (which Brown has attempted to do, despite discovery having long since been closed, and as will be discussed in further detail hereinbelow), especially in view of the TTAB's guidance and hints that the parties should narrow the issues at trial to "focus their energy and resources on the priority and likelihood of confusion claim", namely by removing the fraud claim in its entirety. (*See* page 6, 3rd paragraph and fn. 5).

A. Brown Has Improperly Broadened The Scope Of Its Fraud Claim To Include Matters Relating To The Specimens Filed By PGR During Prosecution of Application Serial No. 77/040,379

Count Two (Brown's Fraud Claim) states in paragraph 12 that "Opposer repeats and realleges the allegations set forth in paragraphs 1 through 9 as though set forth herein." Paragraph 5 of Brown's Amended Notice of Opposition states, in pertinent part, that "specimens submitted on August 23, 2007 in response to the Examiner's requirement are in fact photographs of Opposer's goods, as evidenced by the use of PATRIOT GUARD RIDER in the singular on the pins, rather than PATRIOT GUARD RIDERS as the mark appears in the drawing for Applicant's mark."

While the remainder of Count Two (paragraphs 13 and 14) does not further discuss matters relating to the specimens submitted by PGR during prosecution of Application Serial No. 77/040,379, PGR requests that the TTAB clearly set forth that any such issue be stricken from the proceeding. PGR notes that Brown's original Notice of Opposition did not make any allegations with regard to this matter and that it was first brought to PGR's attention in Brown's

Motion for Summary Judgment. (*See* Brown's Motion for Summary Judgment at pp. 21-24). In response, PGR squarely addressed the fact that Brown had not previously pleaded this issue. (*See* PGR's Opposition to Brown's Motion for Summary Judgment at p. 20).

As Brown did not originally plead this issue, and as Brown never attempted on its own initiative to amend his Notice of Opposition to include this issue, Brown should not now be allowed to try and include this issue in the present Opposition, especially considering the facts that the events surrounding this issue all took place prior to Brown's initiating the present Opposition and that the documents regarding same were all of public record prior to Brown's initiating the present Opposition. Thus, PGR respectfully requests that any matters relating to the specimens submitted by PGR during prosecution of Application Serial No. 77/040,379 be stricken from this proceeding.

B. Brown Has Improperly Broadened The Scope Of Its Fraud Claim To Include Matters Relating To PGR's Application Serial No. 77/383,586

Count Two (Brown's Fraud Claim) states in paragraph 14 that PGR's claims of use in Application Serial No. 77/383,586 in connection with goods are "fraudulent in that the Applicant had not used the mark on any of those goods as claimed in the application."[3] PGR requests that the TTAB clearly set forth that issues relating to Application Serial No. 77/383,586 will be stricken and not considered by the TTAB as they are not properly a part of this Opposition

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[3]Inexplicably, Brown does not allege that PGR's claims of use in Application Serial No. 77/383,586 related to services provided in interstate commerce as of November 9, 2005 are fraudulent. Thus, Brown appears to tacitly admit that PGR did use the word mark PATRIOT GUARD RIDERS of Application Serial No. 77/383,586 in connection with the services provided at least as early as November 9, 2005, even though Brown had instituted the present Opposition by claiming that PGR did not use the mark PATRIOT GUARD RIDERS RIDING WITH RESPECT and design in connection with the services provided.

relating to Application Serial No. 77/040,379. PGR notes that Brown's original Notice of Opposition did not make any allegations with regard to this matter (nor could it have as this application was not filed until after Brown filed his original Notice of Opposition) and that it was first brought to PGR's attention in Brown's Motion for Summary Judgment.[4] (*See* Brown's Motion for Summary Judgment at pp. 21-24). In response, PGR squarely addressed the fact that Brown had not previously pleaded this issue. (*See* PGR's Opposition to Brown's Motion for Summary Judgment at pp. 23-24 & fn.13).

As Brown did not originally plead this issue, and as Brown never attempted on its own initiative to amend his Notice of Opposition to include this issue (not that he should have been allowed to as the Opposition proceeding should be solely focused on Application Serial No. 77/040,379), Brown should not now be allowed to try and include this issue in the present Opposition, especially considering the facts that the events surrounding this issue all took place soon after Brown initiated the present Opposition and that the documents regarding same were all of public record soon after Brown initiated the present Opposition. Thus, PGR respectfully requests that any matters relating to the prosecution of Application Serial No. 77/383,586 be stricken from this proceeding.

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[4]PGR notes that it did informally request that this application be included in the original Notice of Opposition in its Amended Answer, but notes that none of the TTAB, Brown or the PGR took any affirmative action to try and make this happen and, as such, PGR has operated throughout this Opposition with the understanding that PGR's Application Serial No. 77/383,586 is not a part of the present Opposition proceeding. Furthermore, PGR notes that its Application Serial No. 77/383,586 has not yet passed to publication, such that it can not be the subject of an Opposition proceeding and, furthermore, Brown has not paid the required fee in accordance with 37 CFR §2.104(b) to have this application included in the present Opposition.

IV. Various Other Matters Relating To Brown's Amended Notice Of Opposition

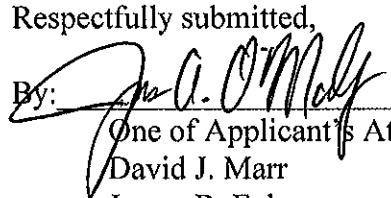
PGR notes other further matters relating to Brown's blatant disregard for the rules relating to the filing of documents before the TTAB, even after the TTAB has allowed Brown a second chance to correct his original mistakes with the filing of an Amended Notice of Opposition. For instance, Brown's Amended Notice of Opposition is not double-spaced, even though 37 CFR §2.126(a)(1) clearly states that a paper submission *must* be printed in at least 11-point type and *double-spaced.* The Amended Notice of Opposition also does not include Brown's entity type (i.e., individual, partnership, corporation, association, etc.) or business address. *See* TBMP §309.02(a). Finally, the Amended Notice of Opposition does not include a description of the capacity in which the signing individual signed, e.g., as attorney for Brown or otherwise. *See* TBMP §§309.02(a) & 309.02(b).

CONCLUSION

In view of the foregoing, PGR respectfully requests the TTAB to dismiss Brown's Amended Notice of Opposition or, in the alternative, to strike portions of Brown's Amended Notice of Opposition.

Date: August 18, 2009

Respectfully submitted,

By: 

One of Applicant's Attorneys
David J. Marr
James R. Foley
James A. O'Malley
TREXLER, BUSHNELL, GIANGIORGI,
BLACKSTONE & MARR, LTD.
105 W. Adams Street, Suite 3600
Chicago, Illinois 60603-6210
(312) 704-1890

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

JEFF BROWN,	)	
	)	
Opposer,	)	
	)	Opposition No. 91181448
v.	)	
	)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,	)	
	)	
Applicant.	)	

EXHIBIT 1

of

"Applicant's Memorandum In Support Of Its Motion To Dismiss Or, In The Alternative, Strike"

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

JEFF BROWN,	)	
	)	
Opposer,	)	
	)	Opposition No. 91181448
v.	)	
	)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,	)	
	)	
Applicant.	)	

DECLARATION OF DAVID J. MARR IN SUPPORT OF APPLICANT'S MOTION TO DISMISS OR, IN THE ALTERNATIVE, STRIKE

I, David J. Marr, declare and state as follows:

1. I am an attorney with the law firm of Trexler, Bushnell, Giangiorgi, Blackstone & Marr, Ltd., counsel for Applicant Patriot Guard Riders, Inc. in the above-captioned proceeding. As such, I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify to the facts set forth below.

2. I read the TTAB's Opinion mailed July 21, 2009 and understood that Opposer, Jeff Brown, had to file and serve his Amended Notice of Opposition no later than August 5, 2009 (fifteen days after July 21, 2009).

3. When I had not received service of the Amended Notice of Opposition by e-mail (as the parties had typically previously served documents both by e-mail and by first class mail) by August 6, 2009, I checked the United States Patent and Trademark Office's website in order to determine whether Brown had, in fact, filed his Amended Notice of Opposition by the August 5, 2009 deadline.

4. My check of the United States Patent and Trademark Office's website revealed that an Amended Notice of Opposition had, in fact, been filed on August 4, 2009, but further

revealed that the filed Amended Notice of Opposition did not provide any proof that this document had been served on myself or any of the other attorneys in my firm who have worked on this Opposition as it did not include a Certificate of Service.

5. Regardless, I still expected to receive service of the filed Amended Notice of Opposition by first class mail, but, at the time of my execution of this Declaration today, August 18, 2009 (fourteen (14) days after Brown filed the Amended Notice of Opposition), neither I nor any of the other attorneys in my firm have received service of the filed Amended Notice of Opposition by e-mail, first class mail or any other appropriate manner.

Executed on: 8/18/09

David J. Marr

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