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

Goodman

Mailed: March 1, 2010

Opposition No. **91181448**

Jeff Brown

v.

Patriot Guard Riders, Inc.

Before Seeherman, Hairston and Ritchie, Administrative Trademark Judges.

By the Board:

This case comes up on applicant's motion to dismiss or, in the alternative, to strike certain grounds and allegations in the amended pleading. By way of background, on July 21, 2009, the Board denied the parties' cross-motions for summary judgment on the grounds of likelihood of confusion and fraud, and noted that opposer's pleading was deficient with regard to the likelihood of confusion claim. The Board allowed opposer fifteen days (until August 5, 2009) to file and serve an amended pleading sufficiently alleging likelihood of confusion under Fed. R. Civ. P. 8(a), ownership of application Serial No. 77041061, and priority and ownership of the mark in the '061 application.

On August 4, 2009 opposer filed an amended pleading. On August 18, 2009, applicant filed a motion to "dismiss the

Amended Notice of Opposition" as untimely served under Trademark Rule 2.119 or alternatively to strike portions of the amended notice of opposition. Applicant also seeks an extension of time to answer as well as an extension of trial dates in the event the Board denies its motion to dismiss. Although applicant uses the language "dismiss the Amended Notice of Opposition," it appears that applicant seeks to have the opposition proceeding dismissed, rather than objecting to the amended pleading, such that the original notice of opposition should be treated as the operative pleading.

In response to applicant's motion to dismiss, opposer acknowledged that he did not timely serve the amended pleading, and stated that he served it one day late due to the hospitalization of the child of the administrative assistant who had been directed to prepare it. Along with the response, opposer also served another copy of the amended pleading (on August 27, 2009). Opposer has requested that the Board reopen his time to serve the amended pleading, deem the certificate of service valid, and recalculate applicant's time to file an answer thereto. Opposer has also objected to the alternative motion to strike, arguing that his pleading is proper and sufficient.

Motion to Dismiss

We turn first to the motion to dismiss.

We find that opposer has established excusable neglect under *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993) for reopening his time to serve the amended notice of opposition on applicant and to provide a copy of the certificate of service to the Board.

Applicant does not contend that it suffered any prejudice (first *Pioneer* factor), and indeed there can be none because applicant electronically accessed the amended notice of opposition on August 6, 2009, one day after the amended notice of opposition was to be filed and served. The length of the delay (second *Pioneer* factor) is de minimis given that opposer served a copy of the amended pleading on August 6, 2009 (one day late). Also, while we have no reason to question opposer's declaration that the amended notice of opposition was served on August 6, 2009, even if in fact the amended notice of opposition was not served until August 27, 2009, we do not consider even this amount of time to be significant. We also find no indication of bad faith on opposer's part (fourth *Pioneer* factor). With regard to the reason for delay (third *Pioneer* factor), we find that the delay was excusable given that opposer's counsel's assistant who handled the mailing of the amended notice of opposition and certificate of service had to deal with the hospitalization of her child.

Accordingly, inasmuch as the *Pioneer* factors weigh in opposer's favor, opposer's motion to reopen his time to serve the amended pleading is granted, and the amended pleading is considered timely. In view thereof, applicant's motion to dismiss is denied.

Motion to Strike

We now turn to applicant's alternative motion to strike from the amended pleading the likelihood of confusion and fraud grounds and to strike allegations relating to specimens in the opposed application, as well as references relating to another application owned by applicant, Serial No. 77383586.

*Likelihood of Confusion Ground*

Applicant seeks to strike the priority and likelihood of confusion claim as insufficiently pleaded.

With regard to the requirements for pleading, Fed. R. Civ. P. 8(a)(2), as made applicable by Trademark Rule 2.116(a), in relevant part requires only "a short and plain statement of the claim showing that the pleader is entitled to relief." "The elements of a claim should be stated concisely, and directly ... and should include enough detail to give the defendant fair notice of the basis for each claim." TBMP § 309.03(a)(2d ed. rev. 2004). Opposer's pleading is sufficient for purposes of notice pleading and provides applicant fair notice of the priority and

likelihood of confusion claim. To the extent that applicant seeks exceedingly detailed factual allegations in the notice of opposition, such allegations are not required under Fed. R. Civ. P. 8(a)(2). *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). In view thereof, applicant's motion to strike is denied with regard to the priority and likelihood of confusion ground.

*Fraud Ground*

Applicant complains that opposer was not granted leave to amend the fraud claim and that opposer has impermissibly expanded the fraud claim to assert other bases for fraud which were not originally pleaded.

The Board's order dated July 21, 2009 granted leave to amend the priority and likelihood of confusion ground only, and opposer has not sought leave to amend the fraud ground under Fed. R. Civ. P. 15(a). Accordingly, opposer's allegations relating to additional bases for fraud in the amended notice of opposition are improper. In view thereof, applicant's motion to strike the fraud ground in the amended notice of opposition is granted to the extent that the amended allegations of fraud are stricken, and the pleading of fraud in the original notice of opposition remains operative.

If opposer wishes to add any allegations regarding a fraud claim, he must file a motion seeking leave to amend.

Opposer is advised that any such motion must include sufficient justification and explanation as to the reason for the delay in seeking leave to amend at this stage of the proceeding. In this regard, a long delay in a party filing a motion for leave to amend may render the amendment untimely due to the resultant prejudice to its adversary. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1286 (TTAB 2008).

*Specimen issue*

Applicant seeks to strike any references to matters relating to specimens filed by applicant during the prosecution of involved application Serial No. 77040379.

To the extent that opposer is raising the adequacy of the specimens as an additional ground for opposition, such an allegation was not in the original notice of opposition and the Board did not previously give opposer leave to add such a claim. Therefore, as with the additional claim of fraud, if opposer wishes to add another ground to the opposition, he must file a motion to amend. Opposer is also advised that the sufficiency of specimens is considered an ex parte examination issue which is not a proper ground for an inter partes proceeding. *See Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989). To the extent that such an allegation relates to an expanded fraud claim, as stated supra, amendment is improper

inasmuch as opposer has not sought leave to amend to add additional bases for the fraud claim.

In view thereof, applicant's motion to strike is granted with regard to the allegation relating to the specimens of applicant's involved application.

*Pleading of copending application 77383586*

Applicant seeks to strike any issues or references that relate to its application Serial No. 77383586 as this application is not part of the opposition proceeding.

Inasmuch as application Serial No. 77383586 is currently in examination and has not been published for opposition, any attempt to assert likelihood of confusion or fraud with respect to this application is premature.

In view thereof, applicant's motion to strike any issues and references relating to application Serial No. 77383586 in the amended notice of opposition is granted.

In view of the denial of the motion to dismiss, applicant's motion to extend its time to answer and to extend trial dates is granted.

In summary, applicant's motion to dismiss is denied and opposer's motion to reopen is granted. Opposer's amended notice of opposition is accepted, subject to the granting of applicant's motion to strike with regard to the amended fraud claim, the specimen issue and any references and issues relating to application serial No. 77383586.

Withdrawal of Counsel

On November 3, 2009, opposer's co-counsel filed a request to withdraw. The withdrawal of co-counsel Courtney Bru and the law firm of Doerner, Saunders, Daniel & Anderson is in compliance with the USPTO Rules and is accordingly granted. Courtney Bru and the law firm of Doerner, Saunders, Daniel & Anderson no longer represent opposer. Counsel of record for opposer, Rachel Blue of McAfee & Taft, continues to represent opposer and is listed as the correspondent in this case.

Proceedings are resumed.

Opposer is allowed until FIFTEEN DAYS from the mailing date of this order to file a motion to amend the fraud ground only if such an amendment is justified and opposer can adequately explain the undue delay. If opposer does not file a motion to amend he should, nonetheless, file a "clean copy" of the amended notice of opposition in accordance with our ruling on the motion to strike. That is, opposer should file a "clean copy" of the amended notice of opposition which sets forth the priority and likelihood of confusion claim in the amended notice of opposition and the fraud claim in the original notice of opposition.

In the event that opposer does not file a motion to amend but files only a "clean copy" of the amended notice of opposition in accordance with the above, applicant is

allowed until THIRTY DAYS from the mailing date of this order to file an answer to that amended notice of opposition, and trial dates are reset below. If applicant files a motion to amend, proceedings will be considered suspended until the Board can rule on that motion.

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| Plaintiff's 30-day Trial Period Ends | **5/15/10** |
| Defendant's Pretrial Disclosures | **5/30/10** |
| Defendant's 30-day Trial Period Ends | **7/14/10** |
| Plaintiff's Rebuttal Disclosures | **7/29/10** |
| Plaintiff's 15-day Rebuttal Period Ends | **8/28/10** |

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.

cc:

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