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

Proceeding	91199922
Party	Defendant Nike, Inc.
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Attachments	NIKE 12e Motion for More Definite Statement.pdf (11 pages)(193183 bytes)

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

CHRISTOPHER A. McGRATH, Opposer,)	Opposition No. 91199922
v.)	Serial No. 85053714
NIKE, INC., Applicant.)	Mark: 

**APPLICANT’S MOTION FOR A MORE DEFINITE STATEMENT
PURSUANT TO RULE 12(E) FED.R.CIV.P.
AND BRIEF IN SUPPORT OF MOTION**

Pursuant to Rule 12(e) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.) and Section 505 of the *Trademark Trial & Appeal Board Manual of Procedure* (TBMP), Applicant, NIKE, INC. (“NIKE” or “Applicant”), by and through its undersigned counsel, moves the Trademark Trial & Appeal Board (the “Board”) for an Order requiring Opposer, CHRISTOPHER A. McGRATH (“McGRATH” or “Opposer”) to provide a more definite statement of his claims against NIKE. The grounds for the motion are as follows:

1. Statement of Facts

On March 28, 2012, the Board issued an Order in response to NIKE’s renewed Rule 12(b) (6) motion to dismiss (citations to the Order will be “Ord. p. ___”). In that Order, the Board:

- Dismissed with prejudice McGRATH’s claims for 1) willful trademark infringement, 2) relief under the Paris Convention, 3) any claim based solely on his ownership of a foreign registration and 4) a standalone claim based solely on the Federal Circuit’s decision in

First Niagara Insurance Brokers Inc. v. First Financial Group, Inc., 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007) (Ord. p. 15);

- Dismissed McGRATH’s dilution claim, but gave him until April 17, 2012, to file an amended notice of opposition with a properly pleaded dilution claim (barring which the Board would dismiss the dilution claim with prejudice)¹ (Ord. p. 15);
- Barred McGrath from raising any claims for injunctive relief (Ord. p. 16);
- Denied NIKE’s 12(b)(6) motion with respect to the issues of priority/likelihood of confusion and standing (Ord. p. 15); and
- Ordered McGrath, in his revised pleading of a proper claim of dilution, to re-allege his claim of priority and likelihood of confusion in a form consistent with the guidelines set forth by the Board. Specifically, the Board advised that the amended pleading should not include evidentiary matters and “...must include (1) a short and plain statement of the reason(s) why opposer believes he would be damaged by the registration of the opposed mark and (2) a short and plain statement of one or more grounds for opposition” (Ord. p. 16).

The Board gave NIKE twenty (20) days to respond to the revised pleading it ordered McGRATH to file (Ord. p. 17). However, McGRATH did not comply with the Board’s Order and has not filed an amended pleading.²

2. Argument

A motion for a more definite statement pursuant to Rule 12(e) Fed.R.Civ.P. is appropriate when a pleading to which a responsive pleading must be made is so vague or ambiguous that a

¹ On May 2, 2015, the Board issued an order dismissing McGRATH’s dilution claim with prejudice in view of McGRATH’s failure to timely file a revised amended notice of opposition.

² NIKE calculated its deadline for submitting this response based on the April 17, 2012, deadline the Board set for McGRATH to amend his pleading.

party cannot reasonably be required to frame a responsive pleading. See also TBMP §505.01 and C. Wright & A Miller, Federal Practice and Procedure Civil 3d § 1378 (2009).

McGRATH's "Revised Notice of Opposition" (cited as "Rev. NOP ¶ ___"), filed on July 14, 2011, in response to NIKE's first 12(b)(6) Motion, included a hodge-podge of claims and legal arguments, mixed with purported evidentiary submissions. It also included McGRATH's response to NIKE's 12(b)(6) motion, in violation of Board procedure (Ord. p. 3, n. 2). The Board, recognizing the defects in McGRATH's Revised Notice of Opposition, offered McGRATH specific guidance as to the form of averments which should be included in his amended pleading that was due to be filed and served by April 17, 2012. Because McGRATH has not re-alleged his claim of priority and likelihood of confusion in a form consistent with the guidelines set forth by the Board (Ord. pp. 15-16, 18-19), NIKE cannot reasonably be required to frame a responsive pleading.

First, NIKE is faced with the task of answering a Revised Notice of Opposition in which the Board dismissed five of the six grounds³ for the opposition raised by McGRATH, and the remaining ground is so intertwined with the rejected grounds that NIKE cannot reasonably answer the allowed claims without incurring prejudice to its position (see, e.g., Rev. NOP ¶¶ 5, 9, 11b, 13, 18, 27 and 40 for representative examples of intertwined claims). Specifically, as the record stands today, it is not at all clear to what averments NIKE is supposed to respond.

Second, the Revised Notice of Opposition is filled with McGRATH's improper legal arguments in response to NIKE's 12(b)(6) motion (see, e.g., Rev. NOP ¶¶ 9, 11 – 11b, and 27-

³ The Board identified the six grounds as: (1) priority and likelihood of confusion, (2) dilution, including injunctive relief, (3) violation of opposer's trade name rights under Article 8 of the Paris Convention, as implemented by § 44(g) of the Lanham Act, (4) willful infringement, (5) ownership of a United Kingdom trademark registration for the mark 20XII THE HONOR OF SPORT, and (6) a claim based upon the Federal Circuit's decision in *First Niagara Ins. Brokers Inc. v. First Financial group, Inc.*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007) (Ord. at p. 2).

38 for representative examples of legal arguments that should have been in a separate brief), and with impermissible assertions of purported evidence in support of McGRATH's claims (see, e.g., Rev. NOP ¶¶ 25, 35, 43-44 for representative examples of inappropriate evidentiary documents/submissions). Because not only the form, but also the content, of McGRATH's Revised Notice of Opposition violates the Board's procedural rules, NIKE is in the untenable position of having to respond to an improper pleading without itself violating the Board's rules of procedure.

Pursuant to Rule 8(e)(1) Fed.R.Civ.P., a plaintiff must state its claims simply, concisely and directly so that the defendant has fair notice of the basis for each claim. McGRATH has failed to provide a revised pleading that meets these requirements. Because of the jumbled nature of McGRATH's claims and their interwoven inclusion of improper materials, NIKE cannot reasonably be expected to frame a responsive pleading. Similar to the case, *I Mpack Immedia Systems, Inc., Mpack Immedia Corporation, and MPact Immedia, Inc. v. Chromatic Research, Inc.*, 1998 WL 111040 (Trademark Tr. & Ap. Bd. 1998),⁴ wherein the Board found that the failure to plead facts establishing the standing of each individual opposer did not give fair notice and impeded the applicant's ability to answer the notice of opposition, here, the intertwining of allowed and dismissed claims does not give NIKE fair notice and impedes NIKE's ability to answer the notice of opposition. As such, McGRATH should be required to submit an amended notice of opposition that complies with the Board's Order, and if he fails to do so, the opposition should be dismissed.

3. Conclusion

For the reasons stated above, NIKE respectfully requests that its motion for a more definite statement pursuant to Rule 12(e) Fed.R.Civ.P. be granted. In the event that McGRATH

⁴ A copy of the *IMPACT* case is included in Exhibit A.

fails to respond in a timely manner to the Board's Order regarding this motion, NIKE requests that the Board issue an order to show cause why the opposition should not be dismissed, or such other order as the Board may deem appropriate. Further, NIKE requests that the Board suspend all other deadlines in this matter while this motion is pending.

Respectfully submitted,

Date: May 3, 2012

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Enclosure:

Exhibit A – Copy of decision in *I Mpact Immedia Systems, Inc., Mpact Immedia Corporation, and MPact Immedia, Inc. v. Chromatic Research, Inc.*, 1998 WL 111040 (Trademark Tr. & Ap. Bd. 1998).

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of May, 2012, a true and complete copy of the foregoing **APPLICANT'S MOTION FOR A MORE DEFINITE STATEMENT PURSUANT TO RULE 12(E) FED.R.CIV.P. AND BRIEF IN SUPPORT OF MOTION** has been served on Opposer Christopher A. McGrath via First Class Mail, postage prepaid, and also by email, addressed as follows:

Mr. Christopher McGrath
McG Productions Ltd.
22 St. John Street
Newport Pagnell, Milton Keynes,
United Kingdom MK16 8HJ

Email: legal@mcgproductionsltd.com

By: /Helen Hill Minsker/

EXHIBIT A

C

1998 WL 111040 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

*1 MPACT IMMEDIA SYSTEMS, INC., MPACT IMMEDIA CORPORATION, AND MPACT IMMEDIA, INC.
v.
CHROMATIC RESEARCH, INC.

Opposition No. 107, 575

February 27, 1998

Before [Seeherman, Quinn](#) and [Hohein](#)
Administrative Trademark Judges.

By the Board:

Chromatic Research, Inc. (“applicant”) filed an application to register the mark “MPACT” for “computer hardware and software for multimedia applications, namely, microprocessors and multimedia software modules providing the following capabilities: full motion video, digital video disk control, 2-D graphics, 3-D graphics, audio, fax/modem, telephony, telephone answering, and videoconferencing.”

Registration has been opposed by Mpack Immedia Systems, Inc., Mpack Immedia Corporation, and Mpack Immedia, Inc. (“opposers”) essentially on the ground that applicant's mark, as used in connection with the identified goods, is likely to cause confusion, mistake or deception with opposers' previously adopted and used “MPACT” and “MPACT IMMEDIA” marks used “in connection with the sale of computer software including communications systems, [and] electronic messaging systems.

In lieu of an answer, applicant filed a combined motion to dismiss or, in the alternative, motion for a more definite statement and motion to strike.

This case now comes up for consideration of that motion. Opposer filed a brief in response. In addition, applicant filed a motion for leave to file a reply brief and submitted therewith a reply. We have exercised our discretion and considered applicant's reply. See [Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 \(TTAB 1991\)](#); and TBMP Section 502.03.

Turning first to the motion to dismiss, applicant contends that pursuant to [Fed. R. Civ. P. 12\(b\)\(6\)](#), the notice of opposition fails to state a claim upon which relief can be granted. Particularly, applicant argues that the notice of opposition was filed by three separate entities all purporting to use marks that are allegedly confusingly similar to applicant's involved mark “IMPACT;” that based on the pleading, the “inevitable” assumption is that all three entities are owners of the alleged common law trademarks since there is no allegations as to, which, if any, of the opposers is the owner of the alleged marks; and that ownership by three entities of a trademark is contrary to established principles of

trademark jurisprudence. Thus, applicant maintains that some or all of the named opposers do not have standing to bring this opposition.

In contrast, opposers fundamentally argue that [15 U.S.C. § 1063](#) does not require that an opposer own a mark, but only that an opposer believe that it would be damaged by the mark opposed; that opposers are related entities, all of which have used “MPACT” prior to applicant; and that while not required to be joined as opposers, their decision to do so does not create a fatal flaw in the pleadings.

A motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of the complaint. See [Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.](#), 22 USPQ2d 1594 (TTAB 1992). In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought therein. See [Lipton Industries, Inc., v. Ralston Purina Company](#), 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

*2 In this case, applicant focuses its arguments on fact that more than a single entity is claiming rights in the pleaded marks. It should be noted that an opposition may be filed by two or more parties jointly.^[FN1] However, when parties file jointly, the notice of opposition should include allegations concerning the standing of each party. See generally, TBMP § 304.

While opposers' claim of standing could have been less ambiguous, opposers pleaded, as related entities, prior adoption and use of an allegedly similar mark, and a Section 2(d) claim of likelihood of confusion. Proof of opposers' claim of standing is a matter for trial. In view thereof, applicant's motion to dismiss is denied.

Alternatively, applicant argues that it is entitled to a more definite statement because the notice of opposition is so vague as to the ownership of the pleaded trademarks and the standing of each of the opposers that applicant cannot reasonably be required to frame a response.

In response, opposers argue that the notice of opposition, as it stands, meets the notice requirement of the Federal Rules of Civil Procedure; and that opposers have claimed that they are related companies with prior use of the mark “MPACT” who will be damaged by registration of applicant's mark.

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding), and (2) a short and plain statement of one or more grounds for opposition. See [37 CFR § 2.104\(a\)](#); and [Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.](#), 228 USPQ 752 (TTAB 1985).

The elements of a claim should be stated simply, concisely, and directly. See [FRCP 8\(e\)\(1\)](#). However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim. See [McDonnell Douglas Corp. v. National Data Corp.](#), 228 USPQ 45 (TTAB 1985). See also [Harsco Corp. v. Electrical Sciences Inc.](#), 9 USPQ2d 1570 (TTAB 1988), and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

Moreover, as indicated previously in this order, the notice of opposition filed by joint opposers should include allegations concerning the standing of each party, and the ground or grounds for opposition. If the case is ultimately determined on the merits, any joint plaintiff whose standing has not been proved cannot prevail therein, even though a ground for opposition has otherwise been proved. See [Chemical New York Corp. v. Conmar Form Systems, Inc.](#) 1 USPQ2d 1139 (TTAB 1986).

After a careful review of the notice of opposition in this case, we find that the allegations of standing contained therein

are somewhat ambiguous as to the exact claim of standing asserted by each opposer. To allow all three opposers to lump their claim of standing into a single set of allegations does not give applicant fair notice of the basis of each opposer's claim and, thus, impedes applicant's ability to answer the notice of opposition. Notably, opposers, in their response to the motion to dismiss, stated that “[w]hile not all would be required to join as Opposers, their decision to do so at this time does not create a flaw in the pleadings.”

***3** In view of the foregoing, applicant's motion for a more definite statement is granted and opposers are allowed until **THIRTY DAYS** from the mailing date hereof to submit an amended notice of opposition which includes allegations pertaining to the relationship between the opposers and each opposer's standing in this case.

Finally, turning to the motion to strike, applicant moves the Board to strike the following allegation from paragraph 5 of the notice of opposition:^[FN2]“The likelihood of confusion is further aggravated by the applicant's use of 'MPACT' with 'MPACT MEDIA,' 'MPACT MEDIA ENGINE,' and 'MPACT MEDIA PROCESSOR'.” Applicant asserts as the ground for its motion that the allegation is irrelevant to this proceeding. More specifically, applicant argues that in determining likelihood of confusion in the context of an opposition, it is the mark as depicted in the application which must be considered, not the context of how the mark is used by the applicant, and cites as support for that argument *Wisconsin Historical Society v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.* 190 USPQ 29 (TTAB 1976).

On the other hand, opposers argue that the above-noted allegation is merely a further explanation as to why opposers believe they would be damaged by applicant's use of its mark; and that while the allegation may not be a required element of opposers' claim, it is not improper and not prejudicial to applicant.

In reply, applicant states that for it to be required to later respond to discovery on the irrelevant issue is unwarranted and “presumably 'prejudicial'.”

Under [Fed. R. Civ. P. 12\(f\)](#), the Board may grant a motion to strike from the pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. [Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 \(TTAB 1988\)](#); and TBMP section 506.^[FN3]

It is well settled that in the context of an opposition, the determination of likelihood of confusion must be made based on a comparison of the mark(s) and goods recited in the application vis-a-vis the mark(s) and goods identified in the registration [or otherwise pleaded] and not by what evidence or argument shows those goods differently to be. See: [Sealy, Incorporated v. Simmons Company, 121 USPQ 456 \(CCPA 1959\)](#); [Burton-Dixie Corporation v. Restonic Corporation, 110 USPQ 272 \(CCPA 1956\)](#); and [Hat Corporation of America v. John B. Stetson Company, 106 USPQ 200 \(CCPA 1955\)](#). Moreover, “[i]n determining likelihood of confusion in an opposition, it is the mark as shown in the application and as used on the goods described in the application which must be considered, not the mark as actually used by applicant” [3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:04\[1\]](#), p. 20-26,27 (3d ed. 1996).

In the instant case, the determination of likelihood of confusion is not based on whether opposers' pleaded “MPACT” and “MPACT IMMEDIA” marks are confusingly similar to the terms “MPACT MEDIA,” “MPACT MEDIA ENGINE,” and “MPACT MEDIA PROCESSOR.” Rather, the issue of likelihood of confusion is determined on whether opposers' pleaded marks are confusingly similar to applicant's involved mark “MPACT.” Nonetheless, applicant's actual use of the terms “MPACT MEDIA,” “MPACT MEDIA ENGINE,” and “MPACT MEDIA PROCESSOR,” (i.e., applicant's use of other terms in connection with the use of the involved mark) may have a bearing on the likely commercial impression of the involved mark. Thus, to that limited extent, such use may be minimally relevant to our likelihood of confusion analysis.

*4 In view thereof, applicant's motion to strike is denied.

DECISION SUMMARY

1. Applicant's motion to dismiss the opposition is denied.

2. Applicant's alternative motion for a more definite statement is granted. Opposers are allowed until **THIRTY DAYS** from the mailing date of this order to file an amended notice of opposition which clearly sets forth the relationship between the opposers and the grounds on which each claim standing in this case, and applicant is allowed until **FORTY DAYS** from the date of service of the amended complaint to file its answer or otherwise plead thereto.

3. Applicant's motion to strike is denied.

E. J. Seeherman

T. J. Quinn

G. D. Hohein

Administrative Trademark Judges

Trademark Trial and Appeal Board

FN1. Correspondingly, as regards registration of marks, while ownership of a mark by more than one entity would, under applicant's theory, be contrary to the function of a trademark to indicate singleness of commercial source, the decision of *Ex parte Edward Taylor and Isabelle Stone Taylor doing business as Baby's Spray-Tray Co.*, 18 USPQ 292 (Comm'r Pats. 1933), held that joint applicants could qualify under the trademark statute.

FN2. Paragraph 5 of the notice of opposition, in total, reads: The applicant's mark "MPACT" is identical to Opposers' "MPACT" mark and is confusingly similar to Opposers' "MPACT" and "MPACT IMMEDIA" marks. The likelihood of confusion is further aggravated by the applicant's use of "MPACT" with "MPACT MEDIA," "MPACT MEDIA ENGINE," and "MPACT MEDIA PROCESSOR." As such, the applicant's use of "MPACT" on its computer hardware and software is likely to cause confusion, mistake or deception as to the origin of Applicant's goods bearing the subject mark.

FN3. The Trademark Trial and Appeal Board Manual of Procedure (TBMP) (Stock No. 903-022-00000-1) is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. (Telephone (202) 512-1800). The TBMP is also available on the World Wide Web at <http://www.uspto.gov/offices/dcom/ttab/tbmp/>.

1998 WL 111040 (Trademark Tr. & App. Bd.)

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