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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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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 TO STRIKE OPPOSER’S AMENDED NOTICE OF
OPPOSITION AND TO DISMISS OPPOSITION WITH PREJUDICE
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 505.03 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 striking the amended notice of opposition filed on August 6, 2012 by Opposer, CHRISTOPHER A. McGRATH (“McGRATH” or “Opposer”). Further, in view of Opposer’s four failed attempts to file a notice of opposition that complies with the Federal Rules of Civil Procedure and the Board’s rules, Applicant moves for dismissal of the opposition with prejudice.

1. Statement of Facts

The August 6, 2012 amended notice of opposition that is the subject of this motion is Opposer’s fourth version of its notice of opposition in more than a year.

The initial notice of opposition was filed on May 22, 2011. The first revised (amended) notice of opposition was filed on July 14, 2011, in response to Applicant’s first motion to dismiss

pursuant to Rule 12(b)(6) Fed.R.Civ.P. NIKE renewed its 12(b)(6) motion on July 28, 2011. Opposer filed a responsive communication, but not an amended pleading.

On March 28, 2012, the Board issued an order in response to NIKE's renewed rule 12(b)(6) motion and dismissed with prejudice most of Opposer's claims, including Opposer'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) (March 28 order at p. 15). The Board gave Opposer an opportunity to properly plead his dilution claim, which he failed to do, so subsequently, in its July 2, 2012 order, the Board dismissed Opposer's dilution claim with prejudice.

In the March 28, 2012 order, the Board ordered Opposer to submit a revised pleading within twenty days that properly pleaded his claim of priority and likelihood of confusion. Opposer did not file a response to the Board's March 28, 2012 order.

On May 3, 2012, NIKE filed a motion for a more definite statement. Opposer failed to respond to NIKE's motion for a more definite statement in the time set by the TTAB rules.

On July 2, 2012, the Board issued an order granting as conceded NIKE's motion for a more definite statement, and gave opposer twenty days to file a revised amended notice of opposition.

On July 18, 2012, nearly four months after the March 28, 2012 order in which the Board instructed Opposer to file an amended notice of opposition, Opposer finally filed a response to NIKE's motion for a more definite statement.

In an order dated July 24, 2012, the Board refused to entertain Opposer's response to NIKE's motion on the ground that the response was neither timely nor persuasive (July 24 order at p. 2). However the Board did consider a portion of the response as comprising another amended notice of opposition filed by Opposer.¹ The Board refused to accept Opposer's July 18 amended notice of opposition, stating that the revised pleading:

...does not comply with the guidelines set forth in the Board's orders dated March 28, 2012 and July 2, 2012. Specifically, opposer's revised pleading improperly (1) embeds evidence in the pleading, (2) cites to case law in support of his allegations, and (3) argues the merits of his allegations. (July 24 order at p. 2)

The Board then gave Opposer a further chance to submit a proper revised notice of opposition:

Inasmuch as the deadline to file a proper revised amended notice of opposition has expired, and not to prejudice opposer, opposer is allowed until **August 10, 2012** in which to file his revised amended notice of opposition setting forth his claim of priority and likelihood of confusion, consistent with the guidelines set forth in the Board's March 28, 2012 and July 2, 2012 orders, failing which the notice of opposition will be dismissed with prejudice. (July 24 order at pp. 2-3.)

However, the Board tempered this further opportunity to provide an amended notice of opposition with the following admonition:

The Board recognizes that opposer is a foreign litigant and is representing himself in this matter. However, these circumstances do not excuse opposer from complying with Board orders, the U.S. federal rules of civil procedure, or Board rules and procedures. In view thereof, the Board will be reluctant to afford opposer another opportunity to file and serve a revised amended pleading if opposer fails to do so in compliance with this order, as well as the Board's previous orders dated March 28, 2012 and July 2, 2012. (July 28 order at pp. 3-4)

On August 6, 2012, Opposer filed another amended notice of opposition (his fourth version of his notice of opposition since the proceeding was filed). The August 6, 2012 amended notice of opposition once again (1) embeds evidence in the pleading; (2) contains numerous

¹ The July 18 filing represented Opposer's third attempt to provide a notice of opposition that complied with the Board's rules.

citations to case law in support of Opposer's allegations; (3) argues the merits of Opposer's allegations; (4) includes claims that were dismissed; and (5) does not comply with the Board's rules or the Federal Rules of Civil Procedure.

2. Argument

Rule 8(e)(1) Fed.R.Civ.P. requires that a plaintiff state its claims simply, concisely and directly so that the defendant has fair notice of the basis for each claim. For the fourth time in fifteen months, Opposer again has submitted a notice of opposition that states the claims in a manner that is so vague and ambiguous that NIKE 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).

The Board has given Opposer every reasonable opportunity to submit a properly pleaded notice of opposition, including providing detailed instruction on the elements required for the pleading in three separate orders. Opposer did not comply with the Board's order of March 28, 2012, and failed to respond in the time allotted to NIKE's May 3, 2012 motion for a more definite statement. Opposer's July 18 response/amended notice of opposition, filed in response to the Board's July 2 order granting NIKE's motion, was rejected. Opposer's latest amended notice of opposition should be rejected for the same reasons.

TBMP 505.03, citing Rule 12(e) Fed.R.Civ.P., states that:

If the Board, upon motion, issues an order for a more definite statement, and the order is not obeyed within the time specified by the Board, the Board may strike the pleading to which the motion was directed, or make such order as it deems just.

Opposer's August 6, 2012 amended notice of opposition contains the same flaws that caused the Board to reject his July 18 amended notice of opposition (as well as the prior notices of opposition) (see p. 2 of Board's July 24 order):

- Both the July 18 amended notice of opposition and the August 6 amended notice of opposition include embedded evidence (see e.g., pp. 2-5).
- Both the July 18 amended notice of opposition and the August 6 amended notice of opposition contain numerous, detailed citations to case law (see, e.g., pp. 2, 3, 5, 7, 8, 9, 10).
- Both the July 18 amended notice of opposition and the August 6 amended notice of opposition are infused throughout with arguments on the alleged merits of Opposer's claim (see, e.g., pp. 5-10).

Further, in the August 6 amended notice of opposition, Opposer again raises claims based on its United Kingdom registration (pp. 1-3), and the *First Niagara* case (p. 3).² In its order of March 28, 2012, the Board specifically instructed Opposer not to include these claims. (See March 28 order at pp. 15-16). Finally, Opposer again fails to provide an amended notice of opposition that complies with the requirement in all three Board orders that:

... (1) averments should be made in numbered paragraphs, the contents of which should be limited as far as practicable to a statement of a single set of circumstances, (2) each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded, and (3) a paragraph may be referred to by the number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint.

(See March 28 order at p. 16, July 2 order at p. 2 and July 24 order at p. 3)

As the record stands today, it is still not at all clear to what averments NIKE is supposed to respond. And once again, NIKE is in the untenable position of having to respond to an improper pleading without itself violating the Board's rules of procedure. Four opportunities to file a proper pleading are enough. Opposer has repeatedly failed to comply with the Board's orders and should not be rewarded with another chance to file an amended notice of opposition.

² With regard to the *First Niagara* case, after discussing it at length as a basis for the opposition (p. 3), Opposer then attempts to skirt the issue of non-compliance with the Board's order by adding that he is not citing it as a "standalone reason to oppose." Of course, citing it at all is improper, since case citations are not supposed to be included in the pleading.

3. Conclusion

For the reasons set forth above, NIKE requests that the Board strike Opposer's August 6, 2012 amended notice of opposition and dismiss the opposition with prejudice.³

Respectfully submitted,

Date: August 24, 2012

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³ During the pendency of this motion, NIKE respectfully requests that all other deadlines in this proceeding be suspended, and that the Board issue such order regarding future dates, if any, that it deems appropriate after deciding this motion.

CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of August, 2012, a true and complete copy of the foregoing **APPLICANT'S MOTION TO STRIKE OPPOSER'S AMENDED NOTICE OF OPPOSITION AND TO DISMISS OPPOSITION WITH PREJUDICE 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
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By: /helen hill minsker/