

ESTTA Tracking number: **ESTTA448225**

Filing date: **12/23/2011**

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

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Attachments	Applicant's Motion for Partial Dismissal, Motion to Strike, and Motion for a More Definite Statement.pdf (43 pages)(228316 bytes)

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

In the Matter of Application Serial No. 77/886,135

<p>James Murta, Opposer, v. Victor Suarez. Applicant.</p>	<p>Opposition No. 91/200,327 Interlocutory Attorney: Elizabeth J. Winter APPLICANT'S MOTION FOR PARTIAL DISMISSAL FOR FAILURE TO STATE A CLAIM PURSUANT FED. R. CIV. P. 12(b)(6); APPLICANT'S MOTION TO STRIKE MATTER FROM OPPOSER'S AMENDED NOTICE OF OPPOSITION PURSUANT TO FED. R. CIV. P. 12(f); APPLICANT'S MOTION FOR A MORE DEFINITE STATEMENT PURSUANT TO FED. R. CIV. P. 12(e)</p>
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**APPLICANT'S MOTION FOR PARTIAL DISMISSAL FOR
FAILURE TO STATE A CLAIM PURSUANT FED. R. CIV. P. 12(b)(6);**

**APPLICANT'S MOTION TO STRIKE MATTER FROM OPPOSER'S
AMENDED NOTICE OF OPPOSITION PURSUANT TO FED. R. CIV. P. 12(f);**

**APPLICANT'S MOTION FOR A MORE DEFINITE
STATEMENT PURSUANT TO FED. R. CIV. P. 12(e)**

Applicant, Victor Suarez, by his attorneys and pursuant to Rule 12(f) of the Federal Rules of Civil Procedure, hereby moves the Trademark Trial and Appeal Board ("TTAB" or "Board"):

- 1) to strike certain matter from Opposer's Amended Notice of Opposition filed November 23, 2011;
- 2) to dismiss certain allegations from Opposer's Amended Notice of Opposition for failure to state a claim upon which relief can be granted; and
- 3) to direct Opposer to provide a more definite statement with respect to certain claims included in his Amended Notice of Opposition.

The facts and arguments supporting this Motion are set forth below.

I. INTRODUCTION

On June 16, 2011, Opposer James Murta ("Opposer") filed a sixteen (16) page Notice of Opposition with forty-two (42) pages of exhibits. The Notice contained numerous allegations of evidentiary facts which made it difficult for Applicant to ascertain the legal basis for Opposer's claims. During an August 31, 2011 discovery conference, the Board directed Opposer to clarify the nature of his claims and granted Opposer additional time in which to file an amended Notice of Opposition for that purpose. See the Board's September 4, 2011 Order attached as Exhibit A.

On November 23, 2011, Opposer filed an Amended Notice of Opposition. However, the Amended Notice of Opposition still contained many of the same superfluous factual allegations which have again made it difficult for Applicant to decipher the legal basis for Opposer's claims or to sufficiently affirm or deny Opposer's essential allegations.¹

Although motions to strike are not favored, Opposer has already been granted an opportunity by the Board to clarify the nature of his claims and has not done so. Without Board intervention, Applicant will once again be unable to properly respond to the allegations contained in the Notice of Opposition. For the foregoing reasons, Applicant respectfully requests that the following allegations of Opposer's Amended Notice of Opposition be stricken.

II. ARGUMENTS

A. **Applicant Requests that the Claims Described Under Paragraphs 2-6, 27-30, 31, 36-40, and 41-44 Be Dismissed for Failure to State a Claim Upon Which Relief Can Be Granted.**

A Motion for Partial Dismissal under Federal Rule 12(b)(6) is proper where an allegation fails to state a claim upon which relief may be granted to a plaintiff. Fed. R. Civ. P. 12(b)(6). The purpose of a Rule 12(b)(6) motion is to challenge "the legal theory of the complaint, not the sufficiency of any evidence that might be adduced" and "to eliminate actions that are fatally flawed in their legal premises and destined to fail..." *Neitzke v. Williams*, 490 U.S. 319 (S.Ct. 1989); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra* at 26 USPQ2d 1041 (Fed.Cir.1993).

¹ Applicant notes that the first thirty paragraphs of the Amended Notice of Opposition consist only of factual allegations and do not actually state any grounds for the present opposition. Paragraphs 31 through 42 purport to state the grounds for this opposition. Therefore, Applicant is uncertain as to whether any response is even required for Paragraphs 1 through 30.

Opposer's Amended Notice of Opposition includes two claims that are legally insufficient: 1) Opposer's fraud claim based on the specimen Applicant originally filed with his application (Paragraphs 2-6 and 36-40) and 2) Opposer's fraud claim based on geographically deceptive misdescriptiveness (Paragraphs 27-30, 31, and 41-44).

1. Opposer's Claim of Fraud Based on the Specimen Submitted with the Application at the Time of Filing is Unsupportable as a Matter of Law and Cannot Support a Claim Upon Which Relief May be Granted.

Opposer claims that Applicant committed fraud by submitting a specimen with his application that did not depict products being sold by Applicant. Specifically, Paragraphs 2-6 of the Amended Notice of Opposition claim that the specimens originally submitted by Applicant depict a jacket which was not sold by Applicant but was instead sold by a third party. In Paragraphs 36 through 40, Opposer contends that the fact that Applicant submitted these specimens is evidence of fraud on Applicant's part because the submission of this specimen constituted an intent to deceive the PTO by submitting a specimen showing "a jacket [Applicant] did not manufacture or sell."

Opposer's claim is legally insufficient because Applicant has already acknowledged that the originally-filed specimens were submitted in error and has submitted a verified substitute specimen which was accepted by the assigned Examining Attorney. An applicant is permitted to file a substitute specimen if the proposed substitute specimen was in use in commerce as of the date of filing, and the applicant includes a declaration verifying these facts. 37 C.F.R. § 2.59; T.M.E.P. § 904.05. An applicant may submit a substitute specimen for many reasons (e.g., the original specimen is unacceptable to the Examining Attorney or does not show use of the mark with the relevant goods or services). However, as long as the requirements of 37 C.F.R. § 2.59

are met, the Applicant will be permitted to file the substitute specimen and the Examining Attorney may accept the new specimen into the record.

Moreover, in cases where an applicant cannot submit a proper substitute specimen (e.g., the original specimen did not show actual use of the mark and no other specimens of use are available), the filing of an incorrect or unacceptable specimen in an application filed under Section 1(a) is still not a fatal act. In such an instance, an applicant is permitted to amend the filing basis of the application to 1(b) or “intent-to-use” because the PTO will presume that the Applicant had a continuing valid basis. 37 C.F.R. § 2.35(b)(3); T.M.E.P. §§ 806.03(c) and 904.05.

On May 26, 2011, Applicant filed a Petition to the Director, requesting that jurisdiction be resorted to the Examining Attorney to consider Applicant’s substitute specimen and declaration under 37 C.F.R. 2.20. In his Petition and Post-Publication Amendment, Applicant explained that the original specimens were incorrect and were submitted in error.² The Examining Attorney reviewed and accepted Applicant’s substitute specimen and accompanying declaration and entered them into the record.

Therefore, Opposer’s argument that Applicant’s filing of an incorrect specimen constitutes intent to deceive is without merit. Applicant was not prejudiced by filing an incorrect specimen because Applicant addressed the error and properly filed a verified substitute specimen

² Applicant has never denied that the specimens originally submitted with his application as filed do not depict his own products. After Applicant’s application was filed, but before the present opposition was instituted, Applicant learned that his previous attorney had uploaded the wrong photographs to the TEAS online filing system when filing this application. Applicant had originally provided his previous attorney with several photographs depicting products that Applicant had sold under his DERBY OF SAN FRANCISCO (and Design) mark (the “DOSF Mark”). The photographs submitted with the application were of a used jacket that Applicant had purchased in order to re-create the vintage look of one of his product lines. These photographs were saved on Applicant’s computer in the same folder as several other product photographs and were inadvertently included in the photographs sent to Applicant’s previous counsel who then selected the photos for submission with Applicant’s application.

which was accepted by the Examining Attorney. Moreover, in the event that Applicant did not possess a substitute specimen, Applicant still would have been permitted to amend the application to an intent-to-use basis without loss of his filing date. Therefore, the filing of an incorrect specimen and Applicant's eventual correction of that error, did not constitute a fatal error. Moreover, Applicant's filing of the wrong specimens did not constitute a material false statement upon which the PTO would have granted registration because a) Applicant rectified the error in a timely manner as permitted by the PTO rules of practice and b) Applicant would have been permitted to amend his filing basis to assert intent-to-use in the event he had no other specimens to produce.

Finally, the Board's September 4, 2011 Order of Suspension reminded Opposer that allegations directed to ex parte examination issues fail to state a proper ground for an inter partes proceeding. See *Demon Int.'l LC v. William Lynch*, 86 UPQ2d 1058 (TTAB 2008), citing *Century 21 Real Estate v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination). In this instance, the assigned Examining Attorney, Maureen Dall Lott, has already accepted the substitute specimen offered by Applicant and entered this specimen into the record. In addition, the Examining Attorney is aware of Applicant's reason for offering his substitute specimen and still accepted his specimen. Therefore, to the extent that Opposer is indirectly challenging the sufficiency of the Examining Attorney's decision to accept the substitute specimen, Board precedent directs that such a challenge cannot constitute a ground upon which relief may be granted. Therefore, Applicant respectfully requests that the allegations of fraud based on the submission of Applicant's original specimen be dismissed from Opposer's Amended Notice of Opposition.

2. Opposer's Claim of Fraud Based on Geographically Deceptively Misdescriptiveness is Unsupportable as a Matter of Law and Cannot Support a Claim Upon Which Relief May be Granted.

Opposer claims that Applicant committed fraud when Applicant stated that his goods were produced in the San Francisco area. Opposer contends that the goods were not manufactured in the San Francisco Bay Area and that Applicant's statement constituted a material false statement upon which the PTO would have granted registration (Paragraphs 28 and 42). Opposer's claim is legally insufficient because it does not allege facts sufficient to support a finding of geographically deceptive misdescriptiveness. Moreover, Opposer's claim is insufficient because it misstates the test for determining geographically deceptive misdescriptiveness and therefore provides no valid legal basis for opposition of Applicant's mark.

Registration will not be granted if a mark is primarily geographically deceptively misdescriptive. 15 U.S.C. § 1052(a). In order to support a finding of geographically deceptive misdescriptiveness, it must be shown that:

- 1) the primary significance of the mark is a generally known geographic location;
- 2) the goods or services do not originate in the place identified in the mark;
- 3) purchases would be likely to believe that the goods or services originate in the geographic place identified in the mark; and
- 4) the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods.

T.M.E.P. §§ 1210.01(b) and 1210.03.

In Paragraphs 27 through 30, the last sentence of Paragraph 31, and in Paragraphs 41 through 44, Opposer makes numerous statements in which he claims that Applicant committed fraud by a statement made in his response to an Office Action issued March 16, 2010.³ In Applicant's August 6, 2010 response, Applicant stated that he disagreed with any finding that the DOSF Mark is geographically deceptively misdescriptive of the goods because the goods were "produced in the San Francisco area." Applicant affirms the statement made in his July 28 response and confirms that at least some of the products included in his application were manufactured in the San Francisco Bay Area at the time Applicant made the statement. For instance, Applicant first began personally manufacturing his t-shirts in 1997 and was continuing to do so at the time of filing.

However, notwithstanding the disputed veracity of Applicant's statement, the fact remains that Opposer cannot sustain this claim as a matter of law, regardless of the place of manufacture of Applicant's goods. The test for determining geographically deceptive misdescriptiveness is not whether the goods are manufactured in a particular geographic location but rather, whether the goods *originate* from that location. The fact that goods are manufactured in a certain location is only one way to show origination of the goods in the relevant area. Goods or services may be said to "originate" from a geographic location if they are **manufactured, produced, or sold** there (emphasis added). See *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996).

In fact, the Board has found previously that it is not necessary that goods be produced in a particular region in order to support the finding that the goods originate from that location. In

³ Opposer's Amended Notice of Opposition refers to an Office Action issued March 10, 2010. However, Applicant notes that no Office Action issued that date; rather, two non-final Office Actions were issued March 16 and July 28, 2010, respectively. Applicant believes these are the Office Actions to which Opposer is referring.

In re Nantucket Allserve Inc., 28 USPQ2d 1144 (TTAB 1993), the Board found no deceptive misdescriptiveness for Applicant's NANTUCKET NECTARS mark, even though the goods were manufactured elsewhere. In *In re Nantucket Allserve*, the record showed that applicant's headquarters and research and development division were on Nantucket; the distributor of the goods was located on Nantucket; the goods were sold in the applicant's store on Nantucket; and the specimens were labels that bore a picture of Nantucket and stated that the goods were "born" or "created" on Nantucket, and mentioned no other geographic location.

The present case is directly on point with *In Re Nantucket* in nearly every respect. The Applicant is located in the San Francisco area, he has been selling his products from the San Francisco area since the inception of his business, he advertises and promotes the products from the San Francisco area, and the DOSF Mark features a picture of the iconic Golden Gate Bridge.

Moreover, the file history for Applicant's application reflects the Examining Attorney's observation that Applicant's place of business is in the San Francisco area. Please see selected excerpts from the March 16, 2010 and August 26, 2010 Office Actions (attached hereto as Exhibit B) in which the Examining Attorney confirms that "'San Francisco' is a city in Northern California and applicant is located in Millbrae in the San Francisco area." The fact that Applicant's goods are or are not manufactured in San Francisco is not dispositive of a finding of whether the goods *originate* from the San Francisco region. Had the Examining Attorney wished to inquire further or to issue a formal rejection on these grounds, Applicant would simply have responded to any such rejection by providing additional information on his sales and promotional activities to confirm that his products did indeed originate in the San Francisco area.

Simply put, Opposer's Amended Notice of Opposition does not allege that Applicant's goods do not originate in the San Francisco area. Therefore, Opposer's fraud allegation based on

geographically deceptive misdescriptiveness is legally insufficient because it is premised on an improper application of the law. Accordingly, Opposer's allegations based on geographically deceptive misdescriptiveness should be dismissed for failure to state a claim upon which relief can be granted.

B. Applicant Requests that Paragraphs 12 Through 26 Be Stricken as Immaterial and Insufficient to Provide Applicant Fair Notice of the Nature of the Claims Asserted.

Federal Rule 12(f) provides, in relevant part, for striking from a pleading any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f). Motions to strike are not favored and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (S.D.N.Y. 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977); and cases cited therein. A plaintiff is generally permitted some latitude to assert factual allegations if they aid in a full understanding of the claims asserted in the proceeding. 2A *Moore's Federal Practice*, §12.21[2] (2nd ed. 1985). However, allegations that have no bearing on the outcome of a proceeding, or which may prejudice a defendant, may be stricken. *Id.*

1. Opposer's Amended Notice of Opposition Includes an Unusually Large Number of Superfluous Factual Allegations Which Are Insufficient to Give Applicant Reasonable Notice of the Claims Asserted.

A Notice of Opposition must include **a short and plain statement** (emphasis added) of the reasons Opposer believes he will be damaged by registration of Applicant's mark, as well as **a short and plain statement** (emphasis added) of one or more grounds for opposition. 37 C.F.R. § 2.101(b). In addition, a pleading should provide enough detail to give the defendant fair notice of the basis for each claim. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554 (S.Ct. 2007);

Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536 (TTAB 2007)(elements of each claim should be stated concisely and directly, and include enough detail to give the Defendant fair notice).

Contrary to customary TTAB practice of requiring “short and plain statements”, Opposer’s originally-filed Notice of Opposition was sixteen pages long and included sixty-two separate allegations, as well as forty-two additional pages of exhibits. Most of the allegations in the original Notice of Opposition contained no actual claim or legal theory; instead, most consisted of purely factual or evidentiary assertions which were so voluminous that it was difficult for Applicant to ascertain the legal basis for Opposer’s claims. Rather than simply identifying the legal basis for this opposition, Opposer seemed more intent on trying to overwhelm Applicant with a barrage of “evidence” of Applicant’s alleged fraudulent actions and commercial activities. However, the actual legal claims themselves ended up being buried beneath all the clutter.

The Board reached the same conclusion in its September 4, 2011 Order when the Interlocutory Attorney observed the “unusually large number of factual allegations in the notice of opposition” and stated that “the allegations that are essential to give applicant notice of the bases for the fraud claim and to facilitate discovery are difficult to ascertain. (Please see TTAB Order of Suspension dated September 4, 2011, pages 2-3, attached hereto as Exhibit A.) Specifically, the Board held that the allegations contained in the original Notice of Opposition were too muddled to ascertain sufficient claims of non-use or abandonment:

...while the notice of opposition contains allegations that applicant failed to maintain continuous use of the subject mark, the Board did not find a sufficient claim of abandonment; nor did the Board find it clear in the notice of opposition that opposer intends to allege an alternate claim of non-use under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

See TTAB September 6, 2011 Order of Suspension, Page 3.

The Interlocutory Attorney also advised Opposer in the August 31, 2011 discovery conference to “re-work” his Notice of Opposition in order to clarify the nature of his claims and to avoid a lengthy recitation of facts which do not serve to clarify the grounds upon which Opposer’s opposition are based.

However, when Applicant received Opposer’s Amended Notice of Opposition on November 23, 2011, Applicant immediately noticed that many, if not most, of the factual allegations contained in Opposer’s original Notice of Opposition remained in Opposer’s amended pleading. Applicant is once again faced with the task of trying to decipher the meaning and relevance behind these voluminous pages of factual allegations. Opposer has already been admonished once before on the improper inclusion of such a large number of extraneous and irrelevant factual allegations.

Specifically, the allegations in Paragraphs 12 through 26 span five pages and recite a litany of alleged quotes made by Applicant on internet blogs and other social media websites. The quotes appear to relate to Applicant’s efforts to promote a highly specialized style of jacket, one on which Applicant has expended considerable time and effort developing and marketing for future commercial sales. Opposer has spent several pages detailing the marketing and promotional efforts made by Applicant – all presumably in an effort to demonstrate the fact that this style of jacket is not being sold.

However, Applicant submits that the jacket to which Opposer is apparently referring is only one product of several offered by Applicant. Most clothing retailers introduce new lines of merchandise on a regular basis. Therefore, Applicant does not understand how five pages of

internet traffic relating to *one* of Applicant's products can plausibly support a claim of fraud when Opposer has made no mention of any other facts related to Applicant's use or non-use of his DOSF Mark. Moreover, Opposer never alleges any facts to support his belief that Applicant had not used his DOSF Mark on *any of the other products listed in his application*, nor has Opposer offered any facts to support his assertion that Applicant has not used his DOSF Mark on other types of jackets besides the style featured in the alleged "evidence" offered by Opposer.

Instead, Opposer focuses **solely** on his assertion that Applicant simply must have committed fraud because he has not yet mass released his recreation of the classic 1960's style jacket sold decades ago under the old DERBY OF SAN FRANCISCO brand that Applicant has now revived. Opposer's allegations as shown in Paragraphs 12-26 do not support this claim, nor do they support any other reasonable basis for the position that Applicant committed fraud with respect to use or non-use of the DOSF Mark on his other products. Therefore, without a plausible connection to the claims of fraud for non-use, these allegations cannot possibly serve any reasonable purpose and should be stricken as irrelevant.

2. Opposer's Amended Notice of Opposition Contains Numerous Allegations Which Are Matters of Proof and Not Pleading and Are Not Appropriate for a Notice of Opposition

Opposer's Allegations as shown in Paragraphs 12 through 26 are also clearly matters of proof and not pleading and are therefore not appropriate for a Notice of Opposition under customary TTAB practice:

Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not pleading.

T.B.M.P. § 309.03(a)(2); *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16 (TTAB 1959).

Despite the lengthy recitation of facts in the Amended Notice of Opposition, at no point does Opposer actually connect these allegations to any cognizable legal theory, either of fraud or otherwise. Moreover, Opposer has not attached or otherwise referenced any of the original sources of the alleged quotes made by Applicant through these various internet and social media websites. Applicant notes that Opposer did previously attach alleged copies of these articles and websites as exhibits to his original Notice of Opposition. However, exhibits attached to a pleading cannot serve as evidence on behalf of the party to whose pleading they are attached unless and until they are properly identified and introduced during the testimony period. 37 C.F.R. § 2.122(c). As such, the Board properly advised Opposer in its September 4, 2011 Order that none of these exhibits would be admitted into the record. (Please see Exhibit A, page 3 of the Board's September 4 Order.)

That being said, Applicant cannot possibly be expected to affirm or deny the veracity of these evidentiary statements when he has not been allowed the opportunity to review or authenticate their sources. Therefore, Applicant is in a no-win situation if he is compelled to answer these allegations. On the one hand, Opposer is prohibited by TTAB pleading practice from introducing these exhibits; on the other hand, Applicant cannot legitimately answer these allegations without having had any access to confirmed, genuine documents. Therefore, Applicant cannot make a good faith response to these allegations without prejudicing himself. As such, the balance of hardship weighs in Applicant's favor and these allegations should be stricken from Opposer's amended pleading.

Finally, it must be noted that Applicant has already attempted once to address the numerous allegations contained in Opposer's Notice of Opposition, including those now represented in Paragraphs 12-26 of the Amended Notice of Opposition. When Applicant filed

his Answer to the original Notice of Opposition, Applicant properly denied the majority of the allegations on the grounds that the facts pleaded therein were matters of proof and not pleading. It was Applicant's position that the allegations far exceeded the "short, simple statement of the facts" contemplated by TTAB practice.

However, upon receiving Applicant's Answer, counsel for Opposer responded by contacting counsel for Applicant and threatening to file a motion to strike Applicant's answer as "non-responsive" to the original Notice of Opposition. (Please see Exhibit C, an e-mail exchange between Kurt Leyendecker and Marina Lewis dated August 19, 2011 in which counsel for Opposer communicated his intention to file a motion to strike.) Counsel for Opposer also communicated his intent to move to strike Applicant's Answer as in violation of Rule 11 of the Federal Rules of Civil Procedure, despite the fact that Opposer had never given Applicant or his counsel the required twenty-one days' notice dictated by TBMB Section 527.02. before filing his motion for sanctions.

After requesting Board participation in the parties' mandatory discovery conference on August 31, 2011, the Board ultimately held that Applicant's answer and the denials contained therein were perfectly appropriate in view of the convoluted nature and excess number of factual allegations in Opposer's notice of opposition. However, if Applicant is compelled to respond to the allegations contained in Paragraphs 12-26 and to offer the same basis for properly denying these allegations, Applicant assumes he can expect to receive the same response from Opposer and Opposer's counsel. Therefore, Applicant asks that the Board strike the allegations in Paragraphs 12-26 as they do not further an understanding of the nature of Opposer's claims and they can only serve to further prejudice Applicant.

C. Applicant Moves for a More Definite Statement on Opposer's Fraud Claim of Non-Use Because the Claims as Currently Asserted Are Not Pled With the Requisite Specificity to Support an Allegation of Fraud.

A party may move for a more definite statement of a pleading when the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself. Fed. R. Civ. P. 12(e); C. Wright & A. Miller, *Federal Practice and Procedure Civil* 3d §§ 1376-1377 (2009). In this instance, Opposer's fraud claim does not meet the required level of specificity. (Paragraphs 7-11, 12-26, and 31-35).

With respect to Opposer's allegations in Paragraphs 7-11, Opposer states that "on information and belief" Applicant has not used the DOSF Mark on each of the respective items in his application. In *Asian and Western Classics VB v. Lynne Selkow*, the Board rejected a motion for summary judgment on the grounds that the allegations of fraud upon which the motion was based were not pled with sufficient particularity. Specifically, the Board ruled that allegations based solely on "information and belief" and unsupported by any underlying fact failed to meet the particularity requirement of Rule 9(b) of the Federal Rules of Civil Procedure. *Asian and Western Classics VB v. Lynne Selkow*, 92 USPQ2d 1478 (TTAB 2009).

The allegations in Paragraphs 7, 8, 10, and 11 refer to the items in Applicant's application apart from "jackets." These allegations are based solely on Opposer's "information and belief" that the goods were not in use as of the filing date. Moreover, there are no other facts in the Amended Notice of Opposition to support the particularity requirement required by Rule 9(b). Therefore, Applicant requests that Opposer be ordered to plead his claim of fraud with respect to goods other than jackets with more particularity. Otherwise, these allegations should be stricken from the Amended Notice of Opposition for failure to meet the required level of specificity.

With respect to Paragraph 10, Opposer again bases his claim on “information and belief” that the DOSF Mark was not in use with jackets as of the filing date of the application. As stated above, if Opposer seeks to tie the allegations in Paragraphs 12-26 to his claim of fraud for non-use on jackets, Applicant submits that Opposer still has not made a connection between the speculative factual allegations contained in those paragraphs and Opposer’s fraud claim. Moreover, the allegations in Paragraphs 31 (third sentence) and 32-35 simply plead fraud for non-use without asserting any supporting facts to show the legal basis for Opposer’s claim. Therefore, Applicant requests that the Board direct Opposer to more specifically plead the basis for his assertion that the mark has never been used with jackets with more specificity.

III. CONCLUSION

For the foregoing reasons, Applicant’s Motion for Partial Dismissal, Motion to Strike Matter From Opposer’s Amended Notice of Opposition, and Motion for a More Definite Statement should be granted.

Respectfully submitted,

Date: December 23, 2011

By: /Marina A. Lewis/
Michael E. Dergosits
Marina A. Lewis
Attorneys for Opposer

Dergosits & Noah LLP
Three Embarcadero Center, Suite 410
San Francisco, California 94111
Telephone: (415) 705-6377
Facsimile: (415) 705-6383

CERTIFICATE OF SERVICE

I certify that on December 23, 2011, a true copy of the foregoing

**APPLICANT'S MOTION FOR PARTIAL DISMISSAL FOR
FAILURE TO STATE A CLAIM PURSUANT FED. R. CIV.
P. 12(b)(6);**

**APPLICANT'S MOTION TO STRIKE MATTER FROM
OPPOSER'S AMENDED NOTICE OF OPPOSITION
PURSUANT TO FED. R. CIV. P. 12(f);**

**APPLICANT'S MOTION FOR A MORE DEFINITE
STATEMENT PURSUANT TO FED. R. CIV. P. 12(e)**

was sent via first class mail, postage prepaid, to:

Mr. Kurt Leyendecker
Leyendecker & Lemire LLC
9137 E. Mineral Cir., Ste. 280
Centennial, CO 80112

/Marina A. Lewis/

EXHIBIT A

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

Mailed: September 4, 2011

Opposition No. 91200327

James Murta

v.

Victor Suarez

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

Proceeding Suspended

On August 31, 2011, at the close of the parties' discovery conference, this proceeding was **SUSPENDED** until **SIXTY DAYS** from the conference date to allow the parties to discuss settlement, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c). The remainder of this order summarizes the significant points discussed during the discovery conference and resets the trial schedule in this proceeding should the proceeding resume.

Discovery Conference

Counsel for opposer, Kurt Leyendecker of Leyendecker & Lemire LLC, counsel for applicant, Marina Lewis and Michael Dergosits of Dergosits & Noah LLP, and Elizabeth Winter, the assigned Interlocutory Attorney, conducted a discovery

Opposition No. 91200327

conference on August 31, 2011, regarding this proceeding pursuant to Trademark Rule 2.120(a).

At the outset, the parties advised the Board that they had previously discussed settlement without resolution thusfar, and that there are no other related cases between the parties either at the Board or in state or Federal court.¹

• ***Notice of Opposition***

Turning to the pleadings, the Board reviewed opposer's fraud claim, which is based in part on allegations that applicant was not using the involved mark with any of the identified goods on or before the application filing date and/or on the date of first use alleged in the involved application. The Board also noted that, although the essential elements for the fraud claim were asserted in opposer's pleading,² due to the unusually large number of

¹ The parties are requested to inform the Board should any related proceedings commence either between the parties or with third parties concerning the marks involved in this proceeding.

² See Fed. R. Civ. P. 9(b). See also *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 n. 7 (Fed. Cir. 2009), citing *Kowal v. MCI Communications Corp.*, 16 F.3d 1271, 1279 n. 3 (D.C. Cir. 1994) ("[P]leadings on information and belief [under Rule 9(b)] require an allegation that the necessary information lies within the defendant's control, and ... such allegations must also be accompanied by a statement of the facts upon which the allegations are based" (citation omitted)); and *Meckatzer Lowenbrau Benedict Weib KG v. White Gold, LLC*, 95 USPQ2d 1185, 1187 (TTAB 2010) (fraud claim held to be sufficient under Fed. R. Civ. P. 12(b)(6) because, *inter alia*, allegations were not based solely on information and belief, but were based on an investigation revealing lack of use of the involved mark).

Opposition No. 91200327

factual allegations in the notice of opposition, the allegations that are essential to give applicant notice of the bases for the fraud claim and to facilitate discovery are difficult to ascertain.³ See Fed. R. Civ. P. 8(a)(2) and 10(b); and Trademark Rules 2.104(a) and 2.116(a), 37 C.F.R. §§ 2.104(a) and 2.116(a). Additionally, while the notice of opposition contains allegations that applicant failed to maintain continuous use of the subject mark, the Board did not find a sufficient claim of abandonment⁴; nor did the Board find it clear in the notice of opposition that opposer intends to allege an alternate claim of non-use under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).⁵

³ Opposer was also informed that his exhibits attached to the notice of opposition will not be considered as evidence to support his claim. See Trademark Rules 2.122(c) and 2.122(d), 37 C.F.R. §§ 2.122(c) and 2.122(d).

⁴ The Board also stated that the wording "either/or" renders the allegations in paragraphs 16, 19, 22, 25 and 28 of the notice of opposition to be speculative in nature. In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer pleads factual content that allows the Board to draw a reasonable inference that the opposer has standing and that a valid ground for the opposition or cancellation exists. In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise[s] a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010), citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555-56, (2007).

⁵ An application is void *ab initio* if the applied-for mark was not in use in commerce at the time of the filing of the application. See, e.g., *Justin Industries, Inc. v. D.B. Rosenblatt, Inc.*, 213 USPQ 968, 974-75 (TTAB 1981) (application void where application filed before first order or sale and delivery of the goods of the mark occurred); *Intermed*

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Further, noting opposer's detailed allegations regarding the appearance of the applied-for mark in the application drawing page when compared to the appearance of the mark shown on the specimens of use, opposer was reminded that to the extent that opposer may have sought to allege that there was examiner error with respect to the consideration of applicant's specimens of use (during both the initial examination and post-registration), it is well-settled that allegations directed to *ex parte* examination issues fail to state a proper ground for an *inter partes* proceeding. See *Demon Int'l LC v. William Lynch*, 86 USPQ2d 1058 (TTAB 2008), citing *Century 21 Real Estate v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of *ex parte* examination).

Finally, because a misstatement of the date of first use in a use-based application is not a proper basis of a fraud claim so long as there is use of the applied-for mark as of the filing date of the application, the Board ordered that **paragraphs 14, 17, 20, 23 and 26 of the notice of opposition are stricken from opposer's pleading.** See Fed. R. Civ. P. 12(f). See also *Hiraga v. Arena*, 90 USPQ2d 1102,

Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977) (application void where the INTERMED mark had never been used in the United States on or prior to the filing date in association with the services described in the application).

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1107 (TTAB 2009) ("... if the mark was in use in commerce as of the filing date, then the claimed date of first use, even if false, does not constitute fraud because the first use date is not material to the Office's decision to approve a mark for publication").

- ***Answer including Affirmative Defenses***

The Board noted that applicant's answer complied with Trademark Rule 2.106(b)(1). However, the Board also reviewed applicant's affirmative defenses.

An affirmative defense assumes the allegations in the complaint to be true but, nevertheless, constitutes a defense to the allegations in the complaint. An affirmative defense does not negate the elements of the cause of action; it is an explanation that bars the claim. *Gwin v. Curry*, 161 F.R.D. 70, 71 (N.D. Ill. 1995) (the affirmative defense concept codifies the common law plea in confession and avoidance: "Each defendant either expressly or impliedly treats the factual allegations in a complaint as true, but then goes on to assert new matter that eliminates or limits the defendant's ordinary liability stemming from those allegations"), *citing Black's Law Dictionary*, p. 297 (6th ed. 1990).

In this case, applicant's asserted affirmative defenses would apply if opposer proves his claim of fraud at trial,

Opposition No. 91200327

but the facts comprising the affirmative defenses excuse applicant from liability. Applying these tenets to applicant's affirmative defenses, for the following reasons, the Board ordered that **all five affirmative defenses are stricken**. See Fed. R. Civ. P. 12(f).

1. First Affirmative Defense - The notice of opposition fails to state a claim upon which relief can be granted.

Failure to state a claim upon which relief can be granted is not an affirmative defense; nor has applicant filed a timely motion under Fed. R. Civ. P. 12(b)(6). In any event, opposer's allegations of fraud state a claim upon which relief can be granted (see, e.g., not. of opp. ¶¶s 10-13, 15, 18, 21, 24, 27, 33, 34, 35, 41, 50, 52, 53, 54, 55, 57-60, and 62, and unnumbered⁶ paragraphs on pp. 13 and 15). See Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a). See also *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); and *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 137 (TTAB 2009).

2. Second Affirmative Defense - Opposer lacks standing.

Lack of standing is not an affirmative defense. Standing is an element of opposer's claim insofar as opposer must prove standing as part of his case. Nonetheless, the Board noted opposer's allegation (not. of opp. at 2) that

⁶ The Board reminds opposer that all paragraphs in a pleading must be numbered. Fed. R. Civ. P. 10(b); Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a).

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his application has been suspended pending disposition of the application involved herein. When the opposed application has been cited as a potential bar to opposer's registration, opposer has standing to oppose. See *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008). See also *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

3. Third and Fourth Affirmative Defenses - Unclean Hands and Equitable Estoppel.

The equitable defense of estoppel (as well as laches) is generally unavailable in an opposition proceeding.⁷ Further, equitable defenses, including unclean hands, are not available against claims of fraud or abandonment, since it is in the public interest to prohibit registrations procured or maintained by fraud, and to remove registrations of abandoned marks from the register. See, e.g., *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990), *recon. denied*, 18 USPQ2d 1322 (TTAB 1990); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989); and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497,

⁷ See, e.g., *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 n.3 (TTAB 1999) ("the U.S. Court of Appeals for the Federal Circuit has held that in trademark opposition and cancellation proceedings, laches begins to run when the mark in question is published for registration").

Opposition No. 91200327

1499 (TTAB 1986).

Additionally, even if the unclean hands and estoppel defenses were available, applicant's asserted defenses are comprised of a single conclusory allegation, thus, provide insufficient detail to give opposer fair notice of the bases for said defenses. See Fed. R. Civ. P. 8(b)(1)(a) and 12(f).

4. Fifth Affirmative Defense - Opposer has failed to mitigate damages.

The term "damage" as used in Sections 13 and 14 of the Trademark Act concerns only a party's standing to file an opposition or petition to cancel, respectively. Furthermore, a party may establish its standing to oppose or to petition to cancel by showing that it has a real interest in the case, that is, a personal interest beyond that of the general public. There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. See *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *International Order of Job's Daughters v. Lindeburg & Co.*, 727 Fd.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984).

- *Other Topics of Conference*
 - *Parties' Stipulation*

The parties agreed to confer during the sixty-day suspension period on the issue of applicant's use of the applied-for mark in commerce; applicant agreed to submit to opposer evidence of his use of the mark; and both parties agreed to provide an informal list of discovery questions to the other, after applicant produced evidence of use to opposer.

The parties are reminded that they may agreed to various other stipulations during the pendency of the proceeding. By way of example, the parties may agree or stipulate *in writing* to the following measures to facilitate the progress of this proceeding:

- Discovery depositions may be taken by telephone and/or video conference;
- Discovery depositions may be submitted in lieu of testimony depositions;
- That the parties may have additional time to respond to discovery requests;⁸

⁸ Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. See TBMP §§ 403.01 and 501.02 (3d ed. 2011).

Opposition No. 91200327

- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- Testimony affidavits of witnesses may be submitted instead of testimony depositions;
- That documents are deemed authenticated; and/or
- That a notice of reliance can be filed after the testimony periods are closed.

See TBMP §§ 403.01, 501, 704.03(b) and 705 (3d ed. 2011).

The parties may also agree to serve documents filed with the Board by electronic mail. See Trademark Rule 2.119(a)(6), 37 C.F.R. § 2.119(a)(6). While not required, it is recommended that such a stipulation also be set forth in writing.

The Board also mentioned its *Accelerated Case Procedure* (ACR)⁹ and reminded the parties that the Board's standard protective order applies to this proceeding and may be modified by the parties in writing; and that a motion for summary judgment may be not be filed nor may any discovery be served until the parties' initial disclosures are served.

The parties are also reminded that each party has a duty to preserve material evidence and to avoid spoliation of

⁹ See <http://www.uspto.gov/trademarks/process/appeal/acrognoticerule.pdf>.

evidence.¹⁰

Should the parties seek additional information on initial disclosures, they may obtain additional information regarding initial disclosures at the following sources:

http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf

and to <http://edocket.access.gpo.gov/2006/pdf/06-197.pdf> or to

http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf.

See Notice of Final Rulemaking ("Miscellaneous Changes to Trademark Trial and Appeal Board Rules") in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006) (pages 2498 and 2501).

Proceeding Suspended; Trial Dates Reset

As set forth at the beginning of this order, this proceeding is **SUSPENDED** until sixty days from the date of the parties' discovery conference. In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, **proceedings shall resume on OCTOBER 31, 2011, without further notice or order from the Board, upon the schedule set out below.**

¹⁰ "While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request." *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D.Pa. 2007) (addressing law firm's failure to preserve temporary electronic files).

Opposition No. 91200327

Should this proceeding resume, opposer is allowed until **THIRTY DAYS** from the date of resumption to file an amended pleading which clarifies opposer's fraud claim and currently insufficient non-use¹¹ and abandonment claims, failing which the proceeding will go forward only on the fraud claim set forth in notice of opposition of record. If opposer files an amended pleading, as discussed herein, applicant is allowed until **THIRTY DAYS** from the date of service thereof to file an amended answer. All remaining trial dates are reset as follows:

Proceeding Resumes	10/31/2011
Amended Notice of Opp. Due, if Any	11/30/2011
Discovery Opens	11/30/2011
Initial Disclosures Due	12/30/2011
Expert Disclosures Due	4/28/2012
Discovery Closes	5/28/2012
Plaintiff's Pretrial Disclosures Due	7/12/2012
Plaintiff's 30-day Trial Period Ends	8/26/2012
Defendant's Pretrial Disclosures Due	9/10/2012
Defendant's 30-day Trial Period Ends	10/25/2012
Plaintiff's Rebuttal Disclosures Due	11/9/2012
Plaintiff's 15-day Rebuttal Period Ends	12/9/2012

¹¹ Opposer was reminded that "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Opposition No. 91200327

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.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.



EXHIBIT B

To: Suarez, Victor (info@thetrademarkcompany.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77886135 - DERBY OF SAN FRANCISCO - N/A
Sent: 8/26/2010 12:27:42 PM
Sent As: ECOM117@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77/886135

MARK: DERBY OF SAN FRANCISCO

77886135

CORRESPONDENT ADDRESS:
MATTHEW SWYERS
THE TRADEMARK COMPANY
344 MAPLE AVE W STE 151
VIENNA, VA 22180-5612

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Suarez, Victor

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:
info@thetrademarkcompany.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 8/26/2010

This Office action is in response to applicant's communication filed on August 6, 2010.

Registration previously was refused based on the requirement for a disclaimer. Registration was alternatively refused under Trademark Act Sections 2(a) and 2(e)(3).

Registration was also refused based on requirements for information and for a description of the mark. A prior-filed, pending application also was cited as a potential bar to registration under Section 2(d).

Applicant responded to all refusal(s) and/or requirement(s). With the exception of the disclaimer requirement, all previous refusal(s) and/or requirement(s) are withdrawn. In this regard, the disclaimer contains a typographical issue. Meanwhile, the citation of the prior-filed pending application must be continued.

SUMMARY OF ISSUES that applicant must address:

- Requirement for an acceptable disclaimer.

Please note that the citation of the prior-filed, pending application also is continued below.

Prior-filed, Pending Application

Please note that the filing date of pending Application Serial No. 77847073 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Meanwhile, applicant must respond to the requirement(s) set forth below.

Disclaimer Required

Applicant kindly provided a disclaimer. However, "Francisco" was accidentally misspelled (this may be because the examiner's suggestion also contained the misspelling, and she apologizes for any inconvenience).

Applicant must disclaim the descriptive wording "SAN FRANCISCO" as to "shirts, sweatshirts, jackets, pants" and "DERBY OF SAN FRANCISCO" as to "hats" apart from the mark as shown because it merely describes features of the goods. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). As applicant is aware, a "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark; it does not affect the appearance of the mark. TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive, generic, or primarily geographically descriptive of the goods and/or services, which is wording or an illustration that others would need to use to describe or show their goods and services in the marketplace. 15 U.S.C. §1052(e); *see* TMEP §§1209.03(f), 1212.02(a), 1213.03 *et seq.*

In this case, "San Francisco" is a city in Northern California and applicant is located in Millbrae in the San Francisco area. Derby" is a type of hat (see definitions attached to the previous Office action). "Of"

To: Suarez, Victor (info@thetrademarkcompany.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77886135 - DERBY OF SAN FRANCISCO - N/A
Sent: 3/16/2010 11:43:52 AM
Sent As: ECOM117@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/886135

MARK: DERBY OF SAN FRANCISCO

CORRESPONDENT ADDRESS:

MATTHEW SWYERS
THE TRADEMARK COMPANY
344 MAPLE AVE W STE 151
VIENNA, VA 22180-5612

77886135

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Applicant must respond to the following requirement(s) and/or refusal(s) set forth below.

Disclaimer Required

Applicant must insert a disclaimer of "SAN FRANCISCO" as to "shirts, sweatshirts, jackets, pants" and "DERBY OF SAN FRANCISCO" as to "hats" in the application because the wording describes features of the goods. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). **More specifically, "San Francisco" is a city in Northern California and applicant is located in Millbrae in the San Francisco area (see attached definitions and information on Millbrae).**

Derby" is a type of hat (see attached definition). It is presumed that applicant's goods include hats. Alternatively, if the goods do not include derby hats, then "derby" is misdescriptive as to the "hats."

The following is the accepted standard format for a disclaimer:

No claim is made to the exclusive right to use "SAN FRANCISCO" as to "shirts, sweatshirts, jackets, pants" and "DERBY OF SAN FRANCISCO" as to "hats" apart from the mark as shown.

TMEP §1213.08(a)(i).

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, **is merely descriptive, deceptively misdescriptive, primarily geographically descriptive**, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark. See TMEP §1213.10.

Alternatively, Mark is Geographically Deceptive and Primarily Geographically Deceptively Misdescriptive

Alternatively, if the goods do not originate in the San Francisco area, registration is refused because the applied-for mark consists of or includes geographically deceptive and primarily geographically deceptively misdescriptive matter in relation to the identified goods and/or services. Trademark Act Sections 2(a) and 2(e)(3), 15 U.S.C. §1052(a), (e)(3); see *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *In re Cal. Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); TMEP §§1210, 1210.01(b)-(c).

EXHIBIT C

Marina Lewis

From: Marina Lewis
Sent: Friday, August 19, 2011 4:27 PM
To: 'Kurt Leyendecker'
Subject: RE: Murta v. Suarez
Attachments: Applicant's Request for Board Participation in Discovery Conference.pdf

Dear Kurt:

We have today requested the participation of our assigned interlocutory attorney, Jennifer Krisp, (or other personnel assigned by the TTAB) in the parties' discovery conference. A courtesy copy of our request is attached. Since we will have to accommodate Ms. Krisp's schedule, I will call her early next week to determine when she might be available to participate in our call prior to August 30, 2011.

On a related note, we are willing to stipulate that the parties are permitted to serve future papers electronically via e-mail. If you and your client also agree to electronic service, please let me have confirmation of your consent by return e-mail, as well as your preferred e-mail address for service of process. You may serve papers electronically to my e-mail address at mlewis@dergnoah.com, with copies to mdergosits@dergnoah.com, trau@dergnoah.com, and tmdocketing@dergnoah.com.

With regard to your stated intention of motion practice directed to Applicant's Answer, please provide us with the factual and/or legal basis for Opposer's position on the motion to strike the Applicant's Answer as non-responsive. Once we have received it, we will review it and schedule a time to have a telephone conference with you to see whether it can be resolved without formal motion practice.

Concerning your suggestion that there has been any kind of Rule 11 violation in the filing of Applicant's Answer and Affirmative Defenses, we take these allegations very seriously. At a minimum, we request that you provide us with the required twenty-one day notice of your position. See TBMB Section 527.02.

Regards,
Marina

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From: Kurt Leyendecker [mailto:kurt@coloradoiplaw.com]
Sent: Friday, August 19, 2011 11:57 AM
To: Marina Lewis
Subject: Murta v. Suarez

Marina:

As you are aware, we are required to have a Discovery Conference on or before 8.30.2011. This email is to inquire about your availability later next week. As of right now, I am free most anytime Wednesday and Friday but I can work something in on Thursday as well. Of course, all this is subject to change until we schedule a time as my schedule tends to fill up a day or two ahead of any particular date.

Let me know what is good for you and I will go ahead and schedule it.

Also, I am going to be filing a Motion to Strike the Answer as being non-responsive and in violation of Rule 11. I have a phone call into Jennifer Krisp to see if she would prefer we utilize a telephone conference to discuss and possibly resolve the matter prior to me filing a written motion. I will, of course, let you know if she would first prefer a conference otherwise expect to see a written motion soon. Of course, if you would like to discuss the matter with me directly, feel free to call.

I look forward to receiving your preference as to a time for our Discovery Conference.

Have a great weekend,

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