

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

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Mailed: February 23, 2012

Opposition No. 91200818

George A. Powell

v.

Just Bones Boardwear Limited
Liability Company

Yong Oh (Richard) Kim, Interlocutory Attorney:

On February 21, 2012, the Board held an oral hearing on applicant's motion to strike or, alternatively, for a more definite statement filed on August 30, 2011. The motion is contested. Kurt Koenig, Esq., appeared as counsel for opposer and Melanie Holloway, Esq., appeared as counsel for applicant.

As confirmed during the hearing, applicant seeks to strike portions of paragraphs 2 through 5 in the complaint to the extent that they refer to marks beyond those encompassed by the federal registrations pleaded by opposer.¹ Alternatively, applicant seeks more definite statements concerning the marks upon which opposer bases its claims of priority, likelihood of confusion, and dilution.

¹ Opposer has pleaded nine registrations, all of which contain the literal element BONES.

For its part, opposer confirmed that it is relying on the marks in its pleaded registrations as well as marks under common law to support its claims, the latter of which includes three types of marks: 1) marks consisting of just a literal element containing the term BONES, 2) marks that combine a literal element containing the term BONES with a design element, and 3) marks that consist wholly of bone designs. It is opposer's contention that the phrases "and related marks," "and variations thereof," "various 'bones design' marks" and "the trademarks incorporating the term BONES" encompass opposer's registered and common law marks and are sufficient to give applicant notice of the marks upon which opposer relies to support its claims in the notice of opposition.

Decision

It is incumbent upon opposer to specifically plead the marks, registered or not, that form the basis of its claims. *See, e.g., Monorail Car Wash, Inc. v. McCoy*, 178 USPQ 434, 436, n.1 (TTAB 1973). While phrases such as "related marks" and "variations thereof" may be acceptable in the context of opposer's pleaded registrations, such descriptions fail to give applicant adequate notice of the marks relied upon by opposer in the context of opposer's unlisted common law marks. Without a list or other specification as to what common law marks opposer is relying on, such descriptions are open-ended and are therefore insufficient to apprise applicant of the marks upon

which opposer relies in bringing the opposition. This is particularly true where opposer is relying on design marks. Merely pleading "various 'bones design' marks, such as skulls with bone designs" does not give notice of the particular mark or marks relied upon by opposer. Without sufficient notice of the basis for opposer's claims, applicant is clearly at a disadvantage in mounting a defense. As opposer is uniquely aware of the marks that form the basis of its claims, it must, accordingly, identify them.

Applicant's motion is hereby **GRANTED** and opposer is given leave to amend its notice of opposition to identify and graphically depict, where applicable, the common law marks upon which it relies, failing which any references to marks beyond those federally registered marks listed in the notice of opposition will be stricken.

Dates are **RESET** as follows:

Amended Notice of Opposition Due	3/23/2012
Time to Answer	4/22/2012
Deadline for Discovery Conference	5/22/2012
Discovery Opens	5/22/2012
Initial Disclosures Due	6/21/2012
Expert Disclosures Due	10/19/2012
Discovery Closes	11/18/2012
Plaintiff's Pretrial Disclosures Due	1/2/2013
Plaintiff's 30-day Trial Period Ends	2/16/2013
Defendant's Pretrial Disclosures Due	3/3/2013
Defendant's 30-day Trial Period Ends	4/17/2013
Plaintiff's Rebuttal Disclosures Due	5/2/2013
Plaintiff's 15-day Rebuttal Period Ends	6/1/2013

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.

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