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

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Mailed: July 13, 2012

Opposition No. 91203884

Ennis, Inc.

v.

Joel L. Beling d/b/a Supa Characters Pty Ltd

Cancellation No. 92055374

Joel L. Beling d/b/a Supa Characters Pty Ltd

v.

Ennis, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on Ennis, Inc.'s motion, filed concurrently with its answer, for a more definite statement of the claims set forth in the petition to cancel filed by Joel Beling (hereafter, Mr. Beling), acting pro se, in Cancellation No. 92055374, and Mr. Beling's motion to add a fraud claim. The motion for more definite statement is contested and the motion to add the fraud claim is not.

On February 15, 2012, Ennis Inc. (hereafter, Ennis) filed a notice of opposition with claims of priority of use and likelihood of confusion between Mr. Beling's mark COLOR WARS as used with Int. Cl. 16 and 41 goods and services, the subject of application Serial No. 85324443, and its mark COLORWORX and design, shown below, for "printing services", the subject of Registration No. 3372884.

On March 25, 2012, Mr. Beling filed his petition to cancel comprising the ESTTA petition to cancel form listing claims that Ennis' registered mark, shown below, is generic, merely descriptive, and incapable of functioning as a trademark, and ten unnumbered pages of allegations which ended with an "exhibit list" and a "notice of reliance" stating that respondent "wishes to rely on the websites referred to in the Exhibits attached to his Petition to Cancel."[1]

PROCEEDINGS ARE CONSOLIDATED

[1] The Board gives no consideration to the exhibits attached to the petition to cancel. Trademark Rule 2.122(d) plainly states that, with the exception of status and title copies of pleaded registrations, "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony."

As discussed during the discovery conference for Opposition No. 91203884, and since answers have been filed in both proceedings, Opposition No. 91203884 and Cancellation No. 92055374 are consolidated, and may be presented on the same record and briefs. Because of the overlap in legal issues, discovery limits apply to the consolidated proceeding. The Board file will be maintained in Opposition No. 91203884 as the "parent" case, but all papers filed herein must include the proceeding numbers of all consolidated cases in ascending order, and a single copy should be filed in the parent case.

MOTION FOR MORE DEFINITE STATEMENT IS DENIED

A party may move for a more definite statement of a pleading to which a responsive pleading is allowed but which is so vague or ambiguous that the party cannot reasonably prepare a response. Fed. R. Civ. P. 12(e). In support of its motion, Ennis contends that the petition to cancel which was filed with the Board has different attachments than the petition to cancel which was served upon respondent; that the attachments are incomplete; and that the attachments are erroneously described as "printouts" but merely include web addresses which cannot be accessed, and which presumably include webpage information.

Following the filing of the motion, Mr. Beling filed an amended petition to cancel on May 8, 2012 and an opposition to the motion for more definite statement on May 21, 2012. These piecemeal filings are unacceptable. From this point forward, Mr. Beling is ordered to file a single response within the fifteen day period following service of the motion provided by Trademark Rule 2.127, and to file no further papers until the Board rules on the motion.

Mr. Beling's amended petition filed May 8, 2012 appears to include the same 28 numbered allegations of the original petition, but includes the listed exhibits and each exhibit includes text rather than a reference to a webpage.[2] Mr. Beling's May 21, 2012 response contends that Mr. Beling acted promptly to rectify the problems with the exhibits to the petition. Insmuch as the issue with exhibits appears to have been corrected, Ennis' motion for a more definite statement is denied.

To avoid a recurrence of these issues, Mr. Beling is ordered to immediately review all ESTTA filings once they

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[2] With respect to the references in the petition to cancel to information located on web pages, the Board advises Mr. Beling that the Board will not seek evidence by visiting listed websites. Mr. Beling is urged to review Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 704.08(b) (Internet Materials) (3rd ed., rev. 2012) to learn how and under what circumstances the Board considers Internet evidence such as information listed on web pages. As Mr. Beling was already informed by the Board's April 26, 2012 order in the opposition, no paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. See Trademark Rule 2.123(l).

appear in the Board's electronic docket, and to ensure service of the exact filing upon Ennis.

MOTION TO FILE AMENDED PETITION TO CANCEL IS GRANTED

On June 3, 2012, Mr. Beling filed a motion to amend the petition to cancel to add a fraud claim. Ennis filed no opposition to the motion for amendment.

Upon review of the existing pleading, Mr. Beling's claims that Ennis' registered mark is generic, merely descriptive, and incapable of functioning as a trademark as applied to Ennis' services are legally insufficient, and all suffer from the same deficiency. The registered mark is not the term COLORWORX but the mark shown above, which comprises the term COLRWORX and a design element. See Montecash LLC v. Anzar Enterprises Inc., 95 USPQ2d 1060, 1062-63 (TTAB 2010) ("Thus, the claim that a mark is generic for the goods or services, or a portion thereof, is unavailable where it is clear that the mark is composed of a design element and is not generic as a whole.").

The petition to cancel includes no allegations addressing the design element in the mark. That is, the petition to cancel must either plead that both the term COLORWORX and the design element are generic, merely descriptive, and incapable of functioning as a trademark as applied to Ennis' services, or must plead that a portion of the mark is generic, merely

descriptive, and incapable of functioning as a trademark as applied to Ennis' services, and that the registration should be cancelled in the absence of a disclaimer of that portion. Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545, 1547 (TTAB 1990), aff'd on other grounds 21 USPQ2d 1142 (Fed. Cir. 1991).

If Mr. Beling also pleads a fraud claim, the claim must specify that Ennis made material misrepresentations regarding its exclusive right to use the mark COLORWORX and design, and not just the term COLORWORX. Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. "A plaintiff claiming that the declaration or oath in a defendant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that (4) applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office,

intended to procure a registration to which it was not entitled." Qualcomm Inc. v. FLO Corp., 93 USPQ2d 1768, 1770 (TTAB 2010).

Mr. Beling's motion to amend the petition to cancel is granted, and he is ordered to file an amended petition to cancel with legally sufficient claims in compliance with this order within THIRTY DAYS of the mailing date of this order.

Ennis is ordered to file an answer to the amended petition to cancel within THIRTY DAYS of the date of service.

MOTION TO COMPEL IS DENIED WITHOUT PREJUDICE

On July 8, 2012, Mr. Beling filed a motion to compel supplementary discovery responses in the opposition. Belting's motion to compel is five ESTTA filings, TTABVUE entries 8-12. TTABVUE #8 includes documents 1-110 produced by Ennis, and another copy of Mr. Beling's motion to amend the petition to cancel. TTABVUE #9 includes Mr. Beling's discovery requests served May 10, 2012, and Ennis' written responses served June 11, 2012. TTABVUE #10 includes opposer's supplement to its initial disclosures, another copy of its amended petition to cancel, a copy of the notice of opposition, email correspondence regarding the amendment of the petition to cancel, and documents 111-220 produced by Ennis. TTABVUE #11 includes a partial motion to compel consisting of eight unnumbered pages, an exhibit list of

correspondence intended to support Mr. Beling's statement that he made a good faith effort to resolve the discovery dispute before filing the motion with the Board (but does not include the listed correspondence), and Ennis' annual reports for 2001 and 2002. TTABVUE #12 includes Ennis' annual report for 2006, and a page informing the Board that Ennis' other annual reports are too large to load onto ESTTA.

Because the motion to compel is incomplete and fails to comply with the Board's rules inasmuch as it does not establish Mr. Beling's good faith effort to resolve the dispute, it is denied without prejudice.[3]

With respect to any subsequent motion to compel, the Board advises Mr. Beling as follows:

a) The pages of any motion or response must be numbered. Page limits are strictly enforced.

b) Where, as here, a party is making a multi-part filing, the motion must be the first part filed. The Board should not have to search for the motion.

c) Mr. Beling is ordered to refrain from duplicative filings and unnecessary enlargement of the record. That is, if Mr. Beling chooses to file another motion to compel, he cannot submit again the exhibits already of record. Any new motion to compel must refer to the

[3] Pursuant to Trademark Rule 2.120(e), a motion to compel discovery "must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement." The list of dates and titles of correspondence without the correspondence itself is insufficient to establish the necessary good faith effort.

> exhibits already submitted (for example, 92055374, TTAVBUE #11, page 45 of 67). Any papers filed which do not comply with this requirement will be given no consideration.

With the exception of the need to respond to, and to meet and confer regarding the sufficiency of responses to, discovery requests already served, proceedings herein are suspended pending receipt of the amended petition to cancel and answer. No other papers may be filed and no new discovery requests may be served.

Ennis is ordered to inform the Board by phone at the number listed above when its answer has been filed. At that time the Board will reset dates in this consolidated proceeding.

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