

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

wbc

Mailed: May 21, 2014

Opposition No. 91207895

Hokie Objective Onomastics  
Society LLC

v.

Virginia Polytechnic Institute  
and State University

**Before Kuhlke, Cataldo and Masiello,  
Administrative Trademark Judges**

**By the Board:**

This case now comes up on opposer's request for reconsideration and suspension, filed February 24, 2014 ("RFR").<sup>1</sup> The motion has been fully briefed.

***Request for Reconsideration***

The Board's January 8, 2014 order ("Prior Order") 1) denied applicant's October 28, 2013 motion for summary judgment and 2) *sua sponte* reviewed opposer's fraud claim found in paragraphs 27-28 of the July 1, 2013 amended notice of opposition ("amended opposition"), finding the fraud claim to be insufficiently pleaded and struck from the amended opposition paragraphs 27-28. Opposer seeks reconsideration of the Board's strike of paragraphs 27-28 in the Prior Order.

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<sup>1</sup> Applicant's motion to compel filed March 24, 2014 and opposer's motion to strike/partial summary judgment filed April 8, 2014 are noted and, as indicated in the Board's April 18, 2014 order, the Board will reset remaining briefing dates for those motions.

Central to opposer's motion is that the Board erred in its analysis of the fraud claim because opposer was not seeking to bring a claim of fraud but was instead bringing "a claim pursuant to 15 U.S.C. § 1068 for rectification of the Register." *See* RFR p. 2.

A request for reconsideration requires that the Board consider whether "based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." TBMP § 518 (3d ed. rev.2 2013). A request for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in a brief on the original motion." *Id.*

Paragraphs 27-28 of the amended opposition allege:

27. The 1901 date of first use in commerce asserted in the Application is false and lacks any foundation in historical fact.

28. Pursuant to 15 U.S.C. § 1068, which in opposition proceedings grants to the Director the power, as exercised through the Board, to "rectify with respect to the register the registration of a registered mark," the Application, if granted, must be rectified so that its asserted date of first use in commerce has a foundation in historical fact.

Opposer argues that it is not seeking to bring a claim of fraud but instead, is seeking to rectify the dates of first use in applicant's application under 15 U.S. C. § 1068.

15 U.S.C. § 1068 states, in pertinent part:

[T]he Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter

may be established in the proceedings ... However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

Even under opposer's Section 18 theory, the allegations in paragraphs 27-28 do not form the basis of a separate claim.<sup>2</sup> However, upon review of the pleading, they do serve to amplify opposer's genericness and descriptiveness claims. In particular in regard to the allegations pertaining to the genesis of the term HOKIE and the use of the term, including the timeperiod. *See Amended Notice of Opp.* ¶¶ 22-24.

In view thereof, after carefully considering the parties' arguments, inasmuch as paragraphs 27-28 in the amended opposition are, at a minimum, amplifications of opposer's asserted claims of genericness and descriptiveness, opposer's request for reconsideration is hereby **granted**. Paragraphs 27-28 in the amended opposition will not be stricken from the pleading.

### ***Pending Motions***

On March 24, 2014, applicant filed a motion to compel responses to certain written discovery regarding applicant's affirmative defenses of estoppel and unclean hands. Thereafter, on April 8, 2014, opposer filed a motion to strike applicant's affirmative defenses or, in the alternative, a motion for partial summary judgment

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<sup>2</sup> We note that under 15 U.S.C. § 1068 the Board may grant the relief requested under appropriate circumstances. *Cf. 8440 LLC v. Midnight Oil Co. LLC*, 59 USPQ2d 1541, (TTAB 2001); *Sigrune Marlene Chapman v. Mill Valley Cotton*, 17 USPQ2d 1414 (TTAB 1990). Moreover, pursuant to Trademark Rule 2.133(b), if the Board "finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party."

regarding applicant's affirmative defenses. Opposer also filed a response to applicant's motion to compel on April 8, 2014 essentially arguing that, to the extent the Board grants opposer's motion to strike or opposer's alternative motion for partial summary judgment, applicant's motion to compel would be deemed moot and, therefore, should be denied.

The Board first notes that opposer's motion to strike applicant's affirmative defenses is untimely inasmuch as the motion was not filed within 21 days from the date applicant filed its answer to opposer's amended notice of opposition. *See* TBMP § 506.02. Accordingly, the Board will give no further consideration to opposer's motion to strike.

Further, opposer's motion for partial summary judgment, which was filed subsequent to applicant's motion to compel, is not germane to the discovery dispute set forth in applicant's motion to compel. In view thereof, opposer's motion for partial summary judgment is **denied without prejudice** and will be given no further consideration at this time. *See generally* Trademark Rule 2.120(e)(2).

Finally, because opposer did not file a substantive response to applicant's motion to compel on the merits, opposer is allowed until **twenty (20) days** from the mailing date of this order in which to respond on the merits to applicant's motion to compel.

A reply brief in support of applicant's motion to compel, if filed, must be filed in accordance with Trademark Rule 2.127.

Proceedings otherwise remain suspended pending the disposition of applicant's motion to compel. The parties are precluded from filing any further papers in this matter pending the disposition of applicant's motion to compel, except to the extent indicated above.