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

Proceeding	91209617
Party	Defendant Debra Wiseberg
Correspondence Address	DEBRA WISEBERG d/b/a BRAM WARREN CO 18100 SW 50TH ST SOUTHWEST RANCHES, FL 33331 1012 UNITED STATES bramwarren@bramwarren.com
Submission	Other Motions/Papers
Filer's Name	Debra Wiseberg
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Signature	/Debra Wiseberg/
Date	07/31/2015
Attachments	Applicant's Reply to Opposer's Response to Applicant's Motion to Suspend Proceedings and Verification of Counterclaim Fee Paid.pdf(2761043 bytes)

Applicant's reply to Opposer's request that the Board require the Applicant pay the statutory fee for filing a counterclaim twice

The Applicant's counterclaim against the Opposer was never dismissed. The Board in their decision dated July 18, 2014 granted the Applicant until August 14, 2014 to amend her counterclaim against the Opposer. The Board's July 18, 2014 decision stated that the counterclaim would be dismissed only if the Applicant did not file an amendment to the counterclaim by August 14, 2014. The Applicant filed such amendment on August 14, 2014 and as such the counterclaim was never dismissed. On September 4, 2014, the Opposer filed a Motion to Dismiss or, in the Alternative, Motion to Strike Applicant's Amended Counterclaims. The Board deemed in their decision to such motion dated January 20, 2015 that the generic ground in the amended counterclaim to cancel the Opposer's registered trademark "Xikar", Us Registration No. 2200215 was sufficiently pled and the Opposer filed an answer to such amended pleading on February 9, 2015. The Applicant's Amended Counterclaim dated August 14, 2014 is an amended pleading and not a new counterclaim action. The counterclaim was not dismissed and the Applicant is not required to pay the statutory fee to file a counterclaim twice.

In response to the Opposer's request that I be required to pay the statutory fee for filing a counterclaim twice, I have looked through the statutes to confirm there are no additional fees due. I can't find a statute that requires an additional payment to amend a pleading and 37 CFR § 2.6 does not list a fee for filing an amendment to a pleading. The statutory counterclaim fee was paid by my predecessor in interest Bram Warren Company, a Florida corporation in April 2013. I'm the successor in interest and a substitute party for Bram Warren Company, a Florida corporation and not a joined party, so no additional fee should be due from the Applicant. There is no statute that states a substitute party must pay an additional filing fee.

Applicant's reply to Opposer's statement that "Applicant has not served or otherwise provided any verification or proof of any payment to Opposer"

The Applicant's private correspondence with the USPTO, TTAB dated July 10, 2015 which included the Applicant's proof of payment of the statutory counterclaim fee in April 2013 was not intended by the Applicant to be made part of the public record and as such the Applicant did not serve the Opposer with a copy of my private correspondence with the USPTO, TTAB. The evidence supplied by the Applicant as proof of the payment of the statutory counterclaim fee is irrelevant to this proceeding. The only relevant fact as it pertains to the statutory counterclaim fee is that such fee was paid in April 2013 and the proof of such payment has no relevance on this proceeding. The Applicant's July 10, 2015 letter to the USPTO, TTAB contained confidential and private business information and was not meant for the Opposer or public view. The Applicant did not include this information in her motion to suspend proceedings for 20 days and verification of counterclaim fee paid because of the nature of such information and instead stated for the record within such motion that such statutory counterclaim fee was paid in April 2013 and that proof had been sent to the USPTO, TTAB. I decided not to file such information into the public record even under confidential cover (redacted) because such information has no relevancy on this proceeding and is only a private matter between the Applicant and the USPTO, TTAB. I respectfully request that the Applicant's private correspondence to the USPTO, TTAB dated July 10, 2015, received by the USPTO, TTAB on July 13, 2015, filed of record on July 14, 2015 and listed as filing 43 in this matter be removed or otherwise completely redacted from the public record as such contains confidential and private business information not meant for the Opposer or public view.

Applicant's reply to Opposer's statement that the filing of the Applicant's motion to suspend proceedings for 20 days and verification of counterclaim fee paid, the Opposer's response to such motion and the Opposer's motion could have been avoided

The Applicant did not request the Opposer's consent to my motion to suspend proceedings for 20 days and verification of counterclaim fee paid because the Applicant was addressing the payment of the statutory counterclaim fee and the Applicant had a time constraint issue. The Applicant filed the motion to suspend proceedings for 20 days and verification of counterclaim fee paid on July 10, 2015 to conform to the Board's order dated July 1, 2015 that "Applicant is allowed until ten (10) days from the mailing date of this order in which to submit the required fee" because "the USPTO records indicate that Applicant did not submit the required statutory fee for filing a counterclaim".

A motion had to be filed in this matter, whether consented or not, in order to suspend the proceedings and postpone the trial dates and the Applicant needed to address the payment of the statutory counterclaim fee within a limited time frame. Since a motion had to be filed in either circumstance to suspend proceedings and extend the trial dates, I find the Opposer's counsel's statement that the Applicant's motion, their response to my motion and the Opposer's motion for suspension of proceedings and extension of time could have been avoided if I had contacted them, a misrepresentation of fact. In addition, as shown by the Opposer's response to my motion, the Opposer has opposed my verification of the statutory counterclaim fee being paid and has requested that the Applicant be required to pay the statutory fee for filing a counterclaim a second time and that is not consenting to the Applicant's motion. After I filed my motion to suspend proceedings stating I was unable to attend to this proceeding at the time, the Opposer's council proceeded to leave the Applicant a telephone message requesting my consent to their motion for suspension of proceedings and extension of time. The Opposer's council then

proceeded to state in their response to my motion to suspend proceedings for 20 days and verification of counterclaim fee paid and their motion for suspension of proceedings and extension of time, that they were unable to reach² the Applicant and that I did not respond to their telephone message requesting my consent to their motion to suspend proceedings and extend time. I filed a motion to suspend proceedings because I needed to prepare for and attend a trade show in another state and I was unable to attend to this proceeding during this interval. I not only defend against the Opposer's meritless opposition proceeding against my registration for the "Cicar" trademark as a pro se litigant, I handle all business and design matters for my business, and sculpt (I created the original sculptures for the Cicar™ Leaf Series and my two newest pieces the Cicar™ Crest Series and the Caraman™). The time I have spent on this proceeding has delayed the expansion of my business and it is very reasonable that I took time to prepare for and attend a trade show for my business and the filing of my motion informed both the Opposer and the Board of my inability to attend to this proceeding during this time.

REQUEST

The Applicant's motion as it pertains to suspension of the proceedings is no longer an issue because the time I requested for the proceeding to be suspended has expired. The Applicant respectfully requests the Board grant her request to postpone all trial dates in this matter. In addition, the Applicant respectfully requests that the Board correct the record in this matter to reflect payment of the statutory fee for filing a counterclaim and remove from the record the Applicant's private correspondence with the USPTO, TTAB dated July 10, 2015, filed of record on July 14, 2015 and listed as filing No. 43 in this matter.

²The Opposer's counsel left one telephone message for the Applicant.

Dated: July 31, 2015

Respectfully submitted,

By: 

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CERTIFICATE OF FILING

I hereby certify that the Applicant's reply to Opposer's response to the Applicant's motion to suspend proceedings and verification of counterclaim fee paid was filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board by ESTTA on July 31, 2015.

By: 

Debra Wiseberg

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Applicant's reply to Opposer's response to the Applicant's motion to suspend proceedings and verification of counterclaim fee paid was sent to the counsel for the Opposer by the United States Postal Service, first class mail on July 31, 2015 to the following address:

Ginnie C. Derusseau
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Leawood, KS 66206

By: 

Debra Wiseberg