

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

EJW

Mailed: June 30, 2014

Opposition No. 91214086

Starbuzz Tobacco Inc.

v.

Philip Melnick

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up on opposer's combined motion (filed February 4, 2014¹) to vacate the Board's January 27, 2014 order and for default judgment for failure to file an answer. Opposer's motion is fully briefed insofar as applicant filed a response thereto.

On January 27, 2014, the Board issued an order by its electronic filing system (ESTTA) granting applicant's "consent motion" filed on the same date for a ninety-day extension of time to file his answer. Opposer, by its motion, states that it did not consent to applicant's motion and so advised applicant by email (a copy of which is attached to the subject motion). Opposer thus requests that the Board vacate the order granting the extension of time and

¹ The Board's consideration of opposer's motion was delayed due to the submission of a withdrawal of counsel request by applicant's prior counsel, which was addressed in the Board's order mailed on June 26, 2014.

enter default judgment against applicant for failure to timely file an answer or a proper motion for an extension of time to file an answer.

In response, applicant contends that he received opposer's verbal agreement to an extension of ninety days on January 16, 2014, but admitted that opposer had requested that applicant should send his request for an extension via email. Applicant did not send the email as requested by opposer, not understanding that the consent to the extension was contingent on receiving the request in writing. Should the Board vacate its order dated January 27, 2014, applicant requests that the Board accept a late-filed answer.² Applicant did not file an answer with his response.

In view of opposer's virtually immediate email to applicant stating that opposer had not agreed to the consented extension of time, and applicant's statement that opposer had requested a written request for the extension of time, the Board finds that opposer indeed may not have agreed to the ninety-day extension of time for applicant to file an answer. In view thereof, the Board's order mailed January 27, 2014, granting the extension of time to applicant is hereby **VACATED**. Accordingly, the answer due date remains January 28, 2014, as set forth in the Board's December 19, 2013 institution order.

² To the extent that applicant argues the merits of this case (*i.e.*, "motion for summary judgment," said arguments are untimely and have not been considered. *See* Trademark Rules 2.127(e)(1) and 2.128.

Insofar as applicant failed to submit an answer by January 28, 2014, and has yet to file an answer, applicant is in default. See Fed. R. Civ. P. 55(a). However, insofar as the Board has not yet given applicant, until now, notice that he is in default, opposer's motion for default judgment is premature and is **deferred**.

Applicant is allowed until **THIRTY (30) DAYS** from the mailing date of this order to submit a proper answer in this proceeding (see below), failing which opposer's motion for default judgment may be granted, the opposition may be sustained, and registration may be refused.

This proceeding remains otherwise **SUSPENDED**.



The following information is provided as a courtesy to applicant:

Nature of an Opposition Proceeding

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **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.

Legal Representation Is Strongly Encouraged

It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent him or herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

It is recommended that applicant obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's trademarks page: <http://www.uspto.gov/main/trademarks.htm>. The Board's main webpage, <http://www.uspto.gov/web/offices/dcom/ttab/>, includes information on the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to The Trademark Trial and Appeal Board Manual of Procedure (the TBMP).

Further, all Board proceedings and other information regarding the Trademark Trial and Appeal Board may be accessed at the following URLs: <http://ttabvue.uspto.gov/ttabvue/> and <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

Form of Answer

Applicant must file a proper answer in response to the notice of opposition. Said answer must comply with Federal Rule 8(b). Fed. R. Civ. P. 8(b) provides, in part:

A party shall state in short and plain terms the party's defenses to each claim asserted and shall **admit or deny** the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

The notice of opposition filed by opposer herein consists of **twenty-two (22)** numbered paragraphs setting forth the bases of opposer's claim(s) of damage. In accordance with Federal Rule 8(b), applicant must answer the notice of opposition by admitting or denying the allegations contained in each paragraph. Ordinarily, the applicant (or defending party) will use the same paragraph numbering format found in the complaint (notice of opposition), *i.e.* in this case, one through twenty-two (1-22). If applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, he should so state and this will have the effect of a denial.

Requirement for Service on Adverse Party of All Papers Filed

Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicant may file in this proceeding (including for applicant, the answer required herein) must be accompanied by “proof of service” of a copy on the adverse party or the adverse party’s counsel if one is appointed.

"Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service. This written statement should take the form of a “certificate of service” which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated.

All Parties Must Comply with Board Deadlines

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). **Strict compliance with the Trademark Rules of**

Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, *whether or not they are represented by counsel.*

Applicant's Correspondence Address

Applicant is reminded that it is his responsibility to ensure that the Board³ has his current correspondence address. *See* TBMP § 117.07 (2014) (If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party).

Mailed Submissions to the Board; Using ESTTA is Encouraged

Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing (see sample in footnote⁴). The actual

³ When an *inter partes* proceeding is not pending before the Board, registrant must maintain a current address with the Trademark Office.

⁴ Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States
Postal Service with sufficient postage as
first-class mail in an envelope addressed to:

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

on _____ (Date)

_____ (Signature)

_____ (Typed or printed name)

date of receipt by the Office will be used for all other purposes, *including electronically filed documents*.

The Board encourages the use of Electronic System for Trademark Trials and Appeals (ESTTA), available through the USPTO website, for the filing of all documents with the Board. See the following URL: <http://estta.uspto.gov/>.

General Information on Discovery Conferences

Applicant is referred to the Board's institution order in this proceeding and to the following URL:

http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf, see, e.g., pp. 42245, 42246, 42248 and 42252. During the conference, the following topics must be discussed:

- (1) the nature of and basis for their respective claims and defenses;
- (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and;
- (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case.

Either party may request the participation of the Board in the discovery conference. See Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2).

Information on Initial Disclosures

The parties are referred to the following web addresses to obtain information regarding initial disclosures:

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

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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).

