

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Leo Stoller

v.

Karen Ponce

Opposition No. 91120339
to application Serial No. 75678039
filed on April 9, 1999

Leo Stoller, pro se.

Karen Ponce, pro se.

Before Seeherman, Holtzman and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Leo Stoller has opposed the application of Karen Ponce to register STEALTH SHELF, with the word "Shelf" disclaimed, as a trademark for "shelving, namely, a spacing device having four non-metal spacers attached to a rigid frame, the spacing device being used for stacking electronics

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equipment."¹ As grounds for opposition, opposer has alleged that he has priority of use of the mark STEALTH in numerous classes of goods and services including on similar goods as those of applicant; that opposer has used STEALTH as a trade name, corporate name, service mark and trademark since at least 1981; that applicant made no bona fide use of her mark in commerce prior to the filing of her application; that opposer owns a number of registrations for STEALTH and marks in which STEALTH is a component, as well as for applications for STEALTH marks; that applicant's use of STEALTH SHELF for her identified goods is likely to cause confusion with opposer's marks and name; that applicant's statement in her application that she had a bona fide intent to use her mark in commerce was false and fraudulent; that at the time applicant signed her application she was aware that another party had a right to use the mark on the same or similar goods; that applicant's drawing of her mark in her application is not a substantially exact representation of the mark, and does not show the mark as intended to be used in connection with the goods; that applicant's mark is merely descriptive or deceptively misdescriptive of her goods; that applicant's mark does not function as a trademark, but as a functional configuration; that

¹ Application Serial No. 75678039, filed April 9, 1999, based on an asserted bona fide intention to use the mark in commerce.

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applicant's mark is a mere design which does not function as a mark "separate and apart from its display thereon."

In her answer, applicant denied the salient allegations of the notice of opposition.

Opposer and applicant both filed briefs, and opposer filed a reply brief.² Both parties were present at an oral hearing before the Board.³

Before discussing the substantive issues in this proceeding, there are several pending motions which we must address. On September 17, 2002, opposer, Leo Stoller, filed a motion to amend the notice of opposition to join or substitute Central Mfg. Co., noting that in another proceeding before the Board, No. 91117894, the Board granted such a motion. However, the circumstances in the two proceedings are very different. Unlike Opposition No. 91117894, in this case the question of whether Central Mfg.

² Applicant has objected to the exhibits attached to opposer's trial brief as not being properly in the record. We agree. None of the exhibits has been considered.

³ At the oral hearing it was discovered that both opposer's reply brief and the "Testimonial Deposition" of Leo Stoller had not been associated with the file, and the Board had no indication that they had ever been received. Opposer provided copies of these documents; the Notice of Reliance accompanying the testimonial deposition bears a certificate of mailing and a certificate of service dated September 13, 2002, and the reply brief bears a certificate of mailing and certificate of service dated April 17, 2003. Applicant was given the opportunity to advise the Board as to whether she had ever received copies of the Stoller deposition or the reply brief and, if not, whether she wished to object to them as having not been served on her. No word having been received from applicant, we have considered the deposition and the reply brief to be part of the file. We discuss the admissibility of the deposition infra.

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Co. should be an opposer was answered in the negative by Leo Stoller himself earlier in this proceeding. The original notice of opposition identified the opposer as "Leo Stoller, d/b/a Central Mfg. (a Delaware Corporation)." Opposer was advised by the Board, in an order dated March 15, 2001, that because a corporation is a separate and distinct legal entity from its owners or shareholders, opposers were allowed thirty days to pay an additional opposition fee or to inform the Board which entity would go forward with the matter, failing which Central Mfg. would be dropped as a named opposer. Leo Stoller then informed the Board, on March 28, 2001, that he would be the opposer. Thus, opposer had the opportunity to join or substitute Central Mfg. Co. in the early stages of this proceeding, and he specifically declined to do so. Instead, he waited until discovery was closed to file his motion. To grant such a motion at this point would clearly be prejudicial to applicant, as well as against the interests of judicial economy. The motion to join or substitute Central Mfg. Co. is therefore denied.

Opposer has moved for reconsideration of the Board order dated July 17, 2002, and specifically the Board's trial order stating that discovery was closed. This motion is also denied. No purpose would be served at this stage of the proceeding to allow opposer to take additional discovery. Moreover, in view of our reasons for dismissing

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this opposition proceeding, as discussed hereafter, opposer has suffered no prejudice by the Board's not allowing additional time for discovery in its July 17, 2002 order.

Applicant has moved for sanctions, and opposer has opposed the motion and has cross-moved for sanctions. Much of applicant's motion is, in actuality, an objection to opposer's testimony depositions, and this objection will be discussed in connection with that testimony. With respect to the request for sanctions, applicant contends that opposer signed certificates of service with false statements as to the date of service, as shown by the postmark dates on such documents.⁴ Opposer has cross-moved for sanctions on the basis that applicant failed to provide a "safe harbor" to opposer. Opposer contends that applicant should have given opposer an opportunity for correction in order for opposer to "withdraw its pleading." Opposer contends that sanctions should be imposed against applicant for the filing of its "frivolous" motion under Rule 11.

With respect to applicant's contentions that opposer has falsely asserted service dates in two of its

⁴ Applicant also points out that opposer's motion for reconsideration filed August 16, 2002 identifies opposer as "potential opposer" instead of "opposer," and that on August 20, 2002 opposer served on applicant notices to take testimony by deposition in which the signature line identified the signer of "Leo Stoller d/b/a Central Mfg." (although opposer is correctly identified in the caption of the proceeding). We consider these misidentifications to be in the nature of typographical errors, and deny applicant's motion for sanctions on this basis.

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certificates of service that are belied by the postmark dates on the envelopes for those papers, opposer has not provided any explanation as to the discrepancies between the dates shown in the certificates of service and the dates stamped on the respective envelopes by the U. S. Postal Service. Nor has opposer offered to withdraw these papers. However, because applicant did not comply with the safe harbor provisions of Fed. R. Civ. P. 11, we decline to impose sanctions on opposer. We also deny opposer's cross-motion for sanctions. It is true that applicant had previously been advised, in connection with her motion for sanctions because of "unfounded claims" in opposer's notice of opposition, as to the "safe" harbor" provisions of Rule 11. However, because applicant is acting pro se, and this is presumably the first Board proceeding in which she has been involved (unlike opposer), and because her complaint in the current motion differs in nature from the prior motion, we decline to enter any sanctions against applicant. In particular, we believe that opposer's suggested sanction of denying applicant the registration of her mark would be too harsh a sanction in these circumstances.

Opposer has captioned its brief on appeal as "trial brief and request for leave to amend the complaint to conform to the evidence." Opposer has not indicated in his brief in what manner he believes the notice of opposition

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should be amended (nor has any evidence been submitted which would warrant any amendment), and therefore the request for leave to amend the complaint is denied.

Finally, on September 5, 2003, after briefing was completed, opposer filed a request that the Board take judicial notice of the Board's decision in Opposition No. 120,339, in which opposer herein was the opposer. Although the Board may take judicial notice of decisions it has rendered, there is nothing in this decision that may be considered pertinent to the present proceeding. That is, any findings of fact in that opinion would be limited to that proceeding; this is a separate proceeding, involving a different defendant, and opposer must therefore establish in this proceeding any fact on which he wishes to rely. Nor is the decision in the prior proceeding relevant for any conclusions of law, since that decision was specifically marked as "Not Citable as Precedent of the TTAB."

This brings us to the evidence in the present proceeding. The file of applicant's application is automatically of record. See Trademark Rule 2.122(b). Applicant has not made any evidence of record.

Opposer has submitted the "testimonial depositions" of Leo Stoller and Gene Marculis. Applicant has objected to this evidence on a number of bases. Prior to the taking of the depositions, applicant contended that she was not given

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adequate notice, and that both depositions were noticed for the same time, in contravention of Trademark Rule 2.123(c).⁵ Applicant has continued to object to any consideration of the testimony depositions, both in her trial brief and at the oral hearing. In her brief, applicant also makes the point that none of the attachments to the testimony depositions was authenticated.

With respect to whether opposer provided adequate notice for the testimony depositions, applicant has acknowledged that she received the notices on August 26, 2002 for depositions that were scheduled for September 4, 2002. We consider such notice to be adequate.

Opposer also scheduled both testimony depositions for 12:00 on September 4, 2002. This is a technical violation of Trademark Rule 2.122(c), which provides, inter alia, that "No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available." However, because both depositions were scheduled for the same place, and apparently were taken one after the other (the

⁵ Applicant filed this as a combined motion, and captioned it as a motion for sanctions. As a result, the Board did not recognize the time-sensitive nature of the motion. Applicant is advised that the preferable procedure to object to testimony depositions before they are taken is to file a motion to quash, identified as such, and to contact the Board by telephone to advise the interlocutory motions attorney that an immediate ruling is required.

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"transcripts" of the depositions do not indicate the time at which they were taken), there was no prejudice to applicant. That is, applicant was not required to defend two different depositions taking place at the same time. Thus, these objections are overruled.

However, the so-called testimony submitted by opposer is not admissible as evidence and cannot be considered. Each of the "testimonial depositions" submitted by opposer are essentially the same. They appear to have been prepared by Mr. Stoller, rather than a court reporter. The "Direct Examination" of opposer consists of the following "question" by Leo Stoller: "I am submitting into evidence the attached affidavit of Leo Stoller in support of the Opposer's Opposition." It is signed before Jack B. Brodnicki, identified as a Notary Public for the State of Illinois. Attached to it is the Affidavit of Leo Stoller which, again, is signed before a notary public.

The "deposition" of Gene Marculis consists of the following questions and answers on "Direct Examination" taken by Leo Stoller:

Q. Mr. Marculis, I am submitting to you a true and correct copy of an affidavit which I would like you to identify. Have you seen that affidavit before?

A. Yes.

Q: Is that your signature at the bottom of the affidavit?

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A. Yes.

Q. I would like to submit the attached affidavit and offer it into evidence in support of the Opposer's case.

This is followed by the sentence, "I do subscribe and make oath that the same is a true and correct copy of my affidavit so given as aforesaid," below which is Mr. Marculis's signature. It was subscribed and sworn to before Jack B. Brodnicki, a notary public for the State of Illinois. Attached to it is the "Affidavit of Gene Marculis," also notarized by Jack B. Brodnicki, as a notary public.

Opposer is seeking to submit as testimony the affidavits of himself and of Gene Marculis. However, affidavits may be submitted as evidence only if stipulated to by the parties. See Trademark Rule 2.123(b). There is clearly no stipulation by applicant to the submission of Mr. Stoller's and Mr. Marculis's affidavit as evidence; on the contrary, applicant has continued to object to opposer's entire submissions.

We note that these affidavits purport to be submitted as exhibits to the so-called testimony depositions. However, opposer cannot circumvent the proper method for making evidence of record in such a fashion. Trademark Rule 2.123(b) clearly states that the testimony of a witness may be submitted in the form of an affidavit by written

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agreement of the parties, and subsection (1) of that rule states that evidence not obtained and filed in compliance with Trademark Rule 2.123 will not be considered. Because there is no agreement by applicant to opposer's submission of affidavit evidence, and because applicant has not treated this evidence of record (by which we could deem it to have been stipulated into the record) and, moreover, has continued to object to it, we find that this affidavit evidence is inadmissible.

We would also point out that the "testimony depositions" do not appear to have been taken as prescribed by Trademark Rule 2.123. Subsection (e)(2) of that rule provides, in part:

The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties.

Although Mr. Marculis's "deposition" is in a question-and-answer format, it appears that the "testimony" was not taken before a court officer, with the questions and answers recorded in their regular order. The deposition was scheduled for noon on September 4, 2002, and the notary's stamp shows that the document was signed before the notary

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on September 4, 2002. Thus, it appears that the "transcript" was prepared in advance of the so-called deposition, and was not a transcript of questions and answers that were asked and answered at the "deposition." This is further shown by the "legal" language purported to be said by Mr. Marculis at the end of his deposition: "I do subscribe and make oath that the same is a true and correct copy of my affidavit so given as aforesaid." We do not find it credible that Mr. Marculis would speak in this manner.

In view of the September 4, 2002 date shown by notary's acknowledgement, Mr. Stoller's "deposition" also appears to have been prepared in advance, rather than being recorded before an officer designated by Rule 28 of the Federal Rules of Civil Procedure. See Trademark Rule 2.123(d).

As opposer points out in his reply brief, applicant did not move to strike opposer's testimony from the record. It is possible, of course, that applicant believed that her earlier objection to the taking of the depositions made the filing of a motion to strike unnecessary. In any event, we do not regard the rule for taking testimony by having questions and answers recorded by an officer to be a merely technical requirement, which had to be seasonably raised by applicant. Rather, such a procedure goes to the very heart of the taking of an oral deposition; it is obviously not an oral deposition if the witness simply is shown a written

document and signs it in the presence of a notary public. Therefore, we find that opposer's failure to comply with this rule for taking oral depositions provides a further basis for our not considering the "depositions" of opposer and of Mr. Marculis.

In general, opposer has not complied with the rules in connection with testimony taken by depositions upon oral examination. For example, opposer has utterly failed to follow the requirements of Trademark Rule 2.123(f):

(f) Certification and filing of deposition.

(1) The officer shall annex to the deposition his certificate showing:

(i) Due administration of the oath by the officer to the witness before the commencement of his deposition;

(ii) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his presence;

(iii) The presence or absence of the adverse party;

(iv) The place, day, and hour of commencing and taking the deposition;

(v) The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.

Although these requirements may be waived, Rule 2.123(f) states that such a waiver must be reflected in the certificate:

(2) If any of the foregoing requirements in paragraph (f)(1) of this section are waived, the certificate shall so state.

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Here, however, no certificates whatsoever were filed in connection with Mr. Stoller's and Mr. Marculis's depositions.

We find opposer's failure to comply with this rule surprising since Mr. Stoller, even though he is appearing pro se, has been involved in other proceedings at the Board. The failure to submit the required certificate, which would require, inter alia, the name of the person by whom the deposition was taken down, lends further support to our view that the paper submitted as a testimony deposition was prepared prior to the witnesses' appearance at the "deposition." (We would also point out that, because there is no certificate, we cannot determine whether the notary public who witnessed the signatures administered the oath to each witness before his "deposition" and whether the notary public is an officer before whom the deposition could be taken, that is, an officer within the meaning of Rule 28 of the Federal Rules of Civil Procedure.

Although opposer has failed to comply with this section of Rule 2.123, we do not consider the depositions inadmissible on this basis. Applicant did not object to the lack of certificates for the depositions (perhaps because she is acting pro se and is unfamiliar with the way transcripts of testimonial depositions in Board proceedings normally appear). As a result, opposer did not have an

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opportunity to cure the deficiency by submitting the required certificates, assuming he could do so. Therefore, it is not for this reason, but for the other reasons discussed previously, that we deem the "testimonial depositions" to be inadmissible.

Because opposer has not submitted any admissible evidence, we find that opposer has not demonstrated his standing in this proceeding. The standing question is a threshold inquiry made by the Board in every inter partes case. The opposer must establish that he has "a real interest, a personal stake, in the outcome of the proceeding and is more than a mere intermeddler." *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Because there is no evidence whatsoever in this proceeding, opposer has not shown his standing.

Nor is there any evidence in support of the grounds pleaded in opposer's notice of opposition or argued in his trial brief. Accordingly, opposer has failed to demonstrate that he is entitled to judgment on any of these grounds.

Decision: The opposition is dismissed.