

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

Gerald A. Epling,)	
)	
Opposer,)	
v.)	Opposition No.: 154,221
)	
Star Television Productions Ltd.,)	Serial No. 76/185,172
)	
Applicant.)	
)	

**MEMORANDUM IN SUPPORT OF APPLICANT'S MOTION TO
DISMISS FOR FAILURE OF OPPOSER TO TAKE TESTIMONY**

In support of its motion to dismiss the opposition with prejudice, Star Television Productions Ltd. ("Star Television" or "Applicant") states as follows:

I. SUMMARY OF THE FACTS

On December 21, 2000, Applicant filed its application for the STAR (and star design) mark for various goods and services in International Classes 9, 16, 38, 41, and 42. Applicant's mark was published for opposition on November 12, 2002.

On December 10, 2002, Gerald A. Epling ("Epling" or "Opposer") filed a Notice of Opposition against Applicant's Class 9 goods and, in particular, "education and instruction for children." See Not. of Opp. at 2, attached as Exhibit A. Opposer purports to have common law trademark rights in the word STAR in connection with:

Computer software to control and improve computer and audio equipment sound quality; computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, and graphics; computer software for word processing; computer software for use in database management of encoded music files; educational software featuring instruction in music, computer science, psychology, learning, memory, or cognition; interactive multimedia computer programs for music editing, music playing, and word processing; computer programs, namely, language processors, interpreters, and

compilers that may be downloaded from a global computer network.

See Not. of Opp. at 2, attached as Exhibit A.

On February 14, 2003, Applicant timely filed its Answer to the Notice of Opposition. Despite being the party that initiated the action, Opposer has been inactive in this case since July 24, 2003.¹

Opposer's testimony period closed on October 23, 2003. See Order dated Jan. 6, 2003 at 2, which is attached as Exhibit B. Opposer failed to take any testimony or file a motion to extend the testimony periods prior to the close of its testimony period. Applicant's testimony period is scheduled to open on November 22, 2003. See *id.*

II. ARGUMENT

In an opposition proceeding, the opposer bears the burden of coming forward with evidence to support its case. See, e.g., *Old Nutfield Brewing Co., Ltd. v. Hudson Valley Brewing Co., Inc.*, 2002 TTAB LEXIS 507, at *11 (TTAB Aug. 6, 2002) (dismissing an opposition for failure to submit evidence during the testimony period); *Pumpkin Ltd. v. Seed Corps.*, 43 USPQ2d 1582, 1588 (TTAB 1997) (same). "Evidence is to be presented during a party's

¹ Opposer conceded Applicant's motion for leave to amend its answer to the notice of opposition, which was filed on June 30, 2003 and was granted on August 26, 2003. On July 25, 2003, Applicant served Applicant's First Set of Requests for Admission, Applicant's First Set of Interrogatories to Opposer, and Applicant's First Request for Production of Documents and Things upon Opposer. The answers were due on August 29, 2003, but, to date, Opposer has not answered or raised any objections to Applicant's outstanding discovery requests. Opposer also failed to serve any discovery requests upon Applicant.

Since filing the Notice of Opposition, Opposer's only activity was to file "Opposer's Response to Applicant's Request for More Information," which was dated May 29, 2003, and "Opposer's Additional Response to Applicant's Request for More Information," which was dated July 24, 2003. These filings were made in response to Applicant's Answer to the Notice of Opposition in apparent violation of Rule 7 of the Federal Rules of Civil Procedure, which only allows for a complaint and an answer. Opposer's filings cannot constitute evidence under 37 CFR §2.132(a) and TBMP §§702 - 706 because they were not made in the proper form and were not filed during the testimony period.

testimony period. Evidence not filed in compliance with the Trademark Rules will not be considered.” *Intrepreneurs, Inc. v. Borland Software Corp.*, 2003 TTAB LEXIS 321, at *3-4 (TTAB July 8, 2003), *citing*, 37 CFR §§2.121, 2.122, and 2.123(l); Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §701. Statements made in pleadings or the exhibits attached to pleadings are not evidence unless they are established as competent evidence during the time for taking testimony. *Intrepreneurs, Inc.*, 2003 TTAB LEXIS 321, at *5, n.9 (striking testimony submitted after the opposer’s testimony period closed); TBMP §702; TBMP §706. Failure to comply with the Board’s procedural deadlines mandates dismissal of an opposition even if the merits of the case are not addressed. *See, e.g., PolyJohn Enter. Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002) (dismissing the opposition for failure to submit evidence during the testimony period).

Pursuant to 37 CFR §2.132(a) and TBMP §534.02, an applicant in an opposition may move to dismiss if opposer’s time for taking testimony expired and the party has not taken testimony or offered any other evidence. A motion to dismiss for failure to take testimony is timely if it is filed prior to the opening of Applicant’s testimony period. 37 CFR §2.132(c). In this case, Opposer has been inactive in this case since July 24, 2003 and did not file either a motion to reset the trial dates or a motion to reopen his testimony period. Applicant’s motion is timely because Applicant’s testimony period does not open until November 22, 2003.

Under less egregious circumstances, the Board has dismissed cases. *See, e.g., Old Nutfield Brewing Co., Ltd.*, 2002 TTAB LEXIS 507, at *6-13 (granting a motion to dismiss even though the opposer never received applicant’s timely filed answers, neither side served discovery, and the parties engaged in settlement negotiations); *PolyJohn Enter. Corp.*, 61 U.S.P.Q.2d at 1860-62 (granting the motion to dismiss when the opposer mistakenly believed

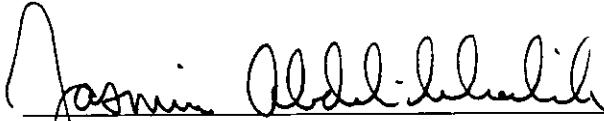
that the extension of time for responses to written discovery also extended the timeframe for the testimony periods). Accordingly, the Board should dismiss this opposition proceeding with prejudice.

III. CONCLUSION

For the reasons stated herein, the Board should dismiss this Opposition with prejudice for Opposer's failure to take testimony during its testimony period.

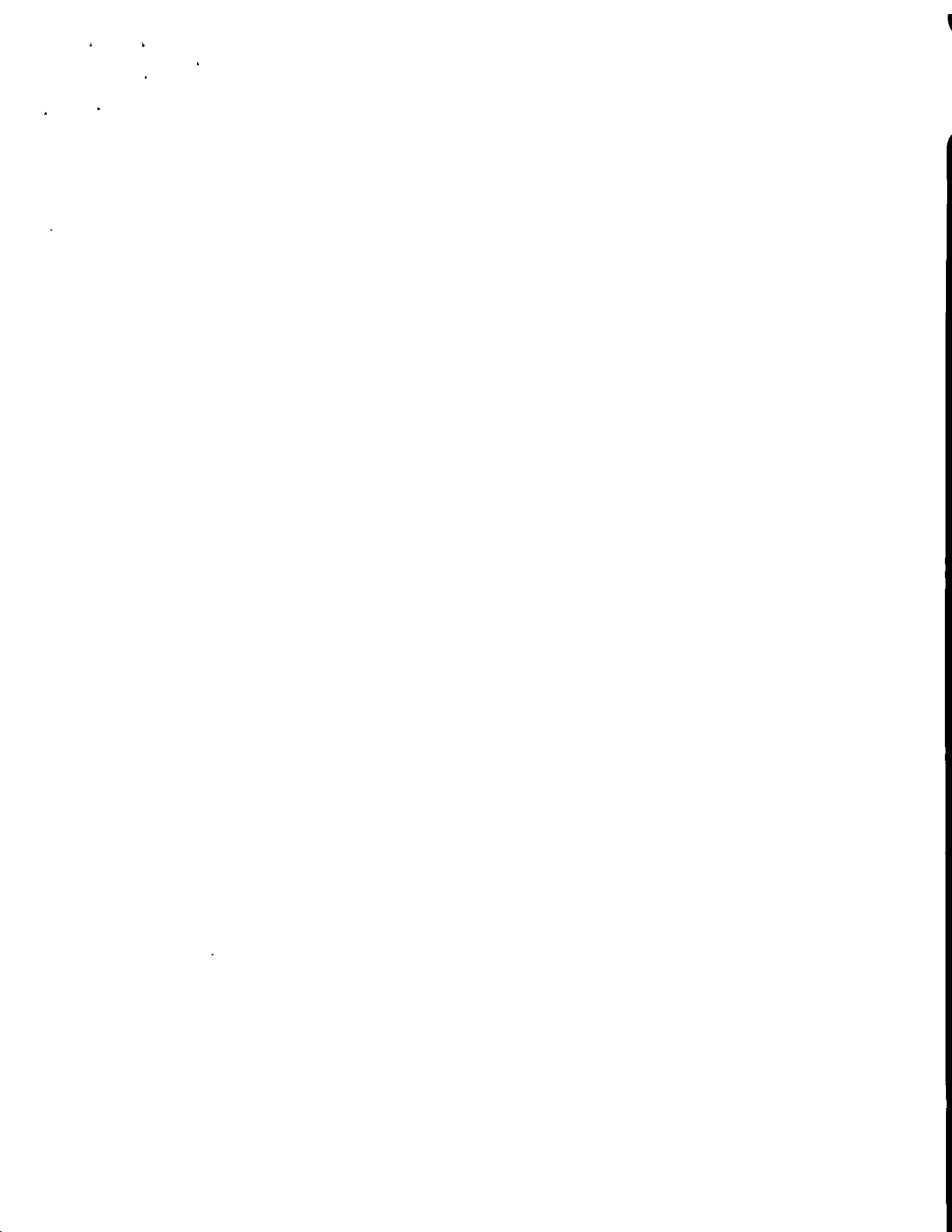
Respectfully submitted,

Dated: November 17, 2003



One of the Attorneys for Applicant, STAR
TELEVISION PRODUCTIONS LTD.

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12-10-2002

U.S. Patent & TMO/TM Mail Rpt Dt #40

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

Applicant: Star Television Productions Limited LIMITED LIABILITY COMPANY
BR.VIRGIN ISLANDS Craigmuir Chambers P. O. Box 71 Road Town, Tortola
BR.VIRGIN ISLANDS

Serial No.: 76185172

Filed: December 21, 2000

Trademark: STAR

Published: November 12, 2002

Law Office: TMO Law Office 113

Opposition No. _____

02 DEC 24 11:30

Notice of Opposition

Gerald A. Epling, an individual, opposes the IC009 registration of "STAR" by Star Television Productions Limited, as represented in SN 76185172.

Express Mail mailing label No. E11244472962115
Date of Deposit Dec. 10, 2002
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Dr., Arlington, VA 22202-3513. I also certify that a copy of this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to: Paula J. Krasny, Baker & McKenzie, One Prudential Plaza, Chicago, Illinois 60601
Gerald A. Epling
(Type or Print Name of Person Mailing Paper or Fee)
Gerald A. Epling
(Signature of Person Mailing Paper or Fee)

ATTENTION: TTAB BOX Fee
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

12/20/2002 KGIBBONS 00000122 76185172

01 FC:6402

300.00 DP

COMPLAINT

I have been using the word, "STAR" as a trademark for my software, artwork, computer programs, and various writings; which include but are not limited to: educational software, graphical representations, entertainment software, and informational resources, since 1990. If allowed to proceed, the IC009 filing by Star Television Productions Limited would unfairly tap into the good will and benefit that I have been able to build and enjoy over the last several years through the connection of my trademark "STAR" with my products. By example, my STAR™ music editor and player program has been recognized as edutainment and is in the same market that Star Television Productions would like to register my trademark in. Particularly, "education and instruction for children..." (See the full text of the IC009 filing by Star Television Productions shown below.)

"IC 009 US 021 023 026 036 038. G & S: Computers, **computer** terminals, **computer** keyboards and printers for use in processing, logging, storing, transmission, display, reception, input, output or print-out of non-pictorial or graphical data in data warehouses; **computer software** for use in the field of telecommunications for broadcasting purposes; **computer** memories; **computer** interfaces; microprocessors; modems; digital optical transmission apparatus and instruments, namely, digital optical transmission engines; blank video tapes and cd-roms; pre-recorded videos in the form of discs and cassettes, and pre-recorded cd-roms, all featuring or relating to television and radio programs pertaining to or featuring music, comedy, drama, interviews, documentaries, news, current affairs, exercise and fitness, health, fiction, sports, leisure, motoring, religion, law, crime, cartoons, animation, games, quizzes, cookery, nature, gardening, politics, culture, travel, natural history, social; issues, education and instruction for children, language teaching, mathematics, geography, history, geology, biology, technology, science and the arts."

I claim the right to the continued use of "STAR" in connection with things that I have done before including:


Computer software to control and improve **computer** and audio equipment sound quality **Computer software** to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, and graphics **Computer software** for word processing **Computer software** for use in database management of encoded music files Educational **software** featuring instruction in music, **computer** science, psychology, learning, memory, or cognition Interactive multimedia **computer** programs for music editing, music playing, and word processing **Computer** programs, namely, language processors, interpreters, and compilers that may be downloaded from a global **computer** network.

With the advent of the internet as a communications medium the differences between a televised or radio transmitted presentation and a web-based presentation are trivial in the minds of many consumers. Consider the number of television programs that are now available on the internet as webcasts, or the number of talk-radio programs that are available over the internet, or the number of television and radio stations that use the

internet to transmit their programming. My work in connection with the STAR trademark has been available on the internet for years. There is a conflict in the intended use of "STAR" by Star Television Productions and my preexisting use of "STAR". The use of "STAR" by Star Television Productions is likely to cause confusion in the minds of people in general and especially in the minds of those who are accustomed to my software bearing the STAR trademark. Therefore, I oppose the registration of "STAR" by Star Television Productions.

Date: December 10, 2002

Respectfully,


Gerald A. Epling, Ph.D.
P.O. Box 250205
Plano, TX 75025-0205

cc: Paula J. Krasny
Attorney for Potential Registrant
Baker & McKenzie
One Prudential Plaza
Chicago, Illinois 60601

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CERTIFICATE OF MAILING AND PROOF OF SERVICE

I hereby certify that the foregoing

1. **Applicant's Motion To Dismiss With Prejudice For Failure Of Opposer To Take Testimony**

and

2. **Memorandum in Support of Applicant's Motion To Dismiss With Prejudice For Failure Of Opposer To Take Testimony**


have been deposited as first class mail with the United States Postal Service, postage prepaid, in an envelope addressed to:

Commissioner for Trademarks
Attn: TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3513

and the recipient of record

Gerald A. Epling
P.O. Box 2244
Frisco, TX 75034-0041

on the 17th day of November, 2003.


Jasmine C. Abdel-khalik