

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Taylor

Mailed: October 2, 2003

Opposition No. 91155077

Genetics Institute, LLC

v.

Joar Opheim

Jyll S. Taylor, Attorney:

On August 11, 2003, the Board issued a notice of default in this case. In a timely response, applicant indicated that a response to the notice of opposition was mailed via first class mail on June 16, 2003, but apparently was not received by the Board.¹ Applicant included a copy of the answer with the response.

In view of the foregoing, the notice of default is set aside.

Turning the substance of the answer, during the pleading stage of a proceeding, the parties are simply to state the relevant facts, as they see them, and which they

¹ Applicant's communication does not indicate that a copy of the same was served on counsel for opposer, as required by Trademark Rule 2.119. This rule is more fully explained later in this order. In order to expedite this matter, a copy of said communication is attached to opposing counsel's copy of this order, but strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

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will attempt to prove during trial. A reading of the answer reveals, however, that it is argumentative and more in the nature of a brief on the case than a pleading responsive to the notice opposition.

As noted above, the answer must be a "pleading" directly responsive to the notice of opposition. The notice of opposition consists of an opening paragraph, **five (5)** separately numbered paragraphs, and a closing "prayer" for relief. Each of the numbered paragraphs contains one or more allegations of fact. It is incumbent on applicant to respond to each allegation, using correspondingly numbered paragraphs, by either admitting the truth of the allegation or denying that the allegation is true. If applicant is without sufficient information to form an opinion as to the truth or falsity of a particular allegation, then applicant may say so without risk; such a response is considered to have the same effect as a denial.

In view of the foregoing, applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to file a proper answer herein which complies with Fed. R. Civ. P. 8.

The above referenced rules on filing a responsive pleading are set forth in Rule 8(b) of the Federal Rules of Civil Procedure. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and

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Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. Applicant should note that Patent and Trademark Rule 10.14 permits any person to represent itself in a Board proceeding, though it is generally advisable for a person unfamiliar with the above-referenced rules to secure the services of an attorney familiar with such matters.

If applicant does not retain counsel, then applicant will have to familiarize himself with the rules governing this proceeding. Strict compliance with the Trademark Rules and all other applicable rules is expected of all parties, even those representing themselves.

The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). There are other rules in part one of Title 37, relevant to filing of papers, meeting due dates, etc., that are also applicable to this case. The CFR and the Federal Rules of Civil Procedure, are likely to be found at most law libraries, and may be available at some public libraries. If applicant wishes to obtain a copy of Title 37 of the CFR, it may be ordered for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.²

² Additional information may be obtained in The Trademark Trial and Appeal Board Manual of Procedure (TBMP), which is available on the World Wide Web at <http://www.uspto.gov>.

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One rule that applicant must pay particular attention to is Trademark Rule 2.119. That rule requires that a party filing any paper with the Board during the course of a proceeding must serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. With the paper that is filed with the Board, the party filing the paper must include "proof of service" of the copy. "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.

Also, applicant should note that any paper it is required to file herein must be received by the Patent and Trademark Office by the due date, unless one of the filing procedures set forth in Patent and Trademark Rules 1.8 and 1.10 is utilized. These rules are in part one of Title 37 of the previously-discussed Code of Federal Regulations.

As noted above, applicant has until 30 days from the mailing date of this order to file a proper answer to the notice of opposition. A copy must be sent to opposer's counsel, whose name and address is set forth below. Proof of service must be included with the answer.

Discovery and trial dates are reset as indicated below.

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Discovery and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE: March 31, 2004

30-day testimony period for party
in position of plaintiff to close: June 29, 2004

30-day testimony period for party
in position of defendant to close: August 28, 2004

15-day rebuttal testimony period
to close: October 12, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.

Opposer's Counsel:

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