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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

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Mailed: May 28, 2004

Opposition No. 91155188

Joe J. Alfaro, Jr.

v.

Guy A. Hoffman

Before Seeherman, Walters, and Bottorff,
Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's motion (filed November 12, 2003) for summary judgment.¹ Both opposer and applicant are appearing *pro se* in this proceeding.

On February 22, 2002, Guy A. Hoffman, an individual, filed an application under Trademark Act Section 1(b) based on his assertion of a *bona fide* intention to use the mark

¹ Applicant's 30 day response period ended December 13, 2003. See Trademark Rule 2.127(e)(1). Applicant's response to opposer's motion for summary judgment includes a certificate of mailing dated January 5, 2004 and was not accompanied by a motion to reopen applicant's time to respond. However, in view of the potentially dispositive nature of the motion, applicant's response was considered.

SUPERFREAKS FUNKY DISCO REVUE in commerce in connection with services subsequently amended to "entertainment services namely live musical performances by a disco musical band" (application Serial No. 78110344).² On January 15, 2003, Joe J. Alfaro, Jr. filed a notice of opposition against application Serial No. 78110344. The Board's institution and trial order issued February 25, 2003. On March 29, 2003, applicant filed his answer.³

According to the allegations in the pleadings, which are discussed in more detail below, both opposer and applicant were performers in a musical group; the group adopted the name SUPERFREAKS; each party claims to be **the** owner of the SUPERFREAKS mark; the parties no longer perform together; and both parties wish to use the SUPERFREAKS mark in connection with separate musical entertainment services.

Aside from these allegations, the pleadings contain a confusing hodgepodge of claims, defenses, and legal theories. As a result of the filing of the motion for summary judgment, the Board has reviewed the pleadings, and

² Pursuant to a requirement made in examination, applicant disclaimed the term "FUNKY DISCO REVUE".

³ Applicant is advised that any future filings with the Board must comply with Trademark Rule 2.126(a)(1), which requires that "A paper submission must be printed in at least 11-point type and double-spaced with the text on one side only of each sheet."

sua sponte makes the following rulings as set forth below, so that both the parties and the Board know what has been pleaded in this proceeding.

The notice of opposition

Opposer's pleading lists nine grounds for opposition. Two are beyond the Board's authority. The Board's reviewing court has determined that the "valid ground" for denying registration that must be alleged and ultimately proved by an opposer must be a "statutory ground which negates the appellant's right to the subject registration." *Young v. AGB Corp.*, 152 F.3d 1377, 1381, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

Insofar as the trademark statute includes neither "unfair competition" (section 8) nor "deceptive trade practices" (section 9) as grounds for denying registration, sections 8 and 9 fail to state a claim. *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671 (TTAB 1987).

Opposer's section 6 also fails to state a claim. The notice of opposition states (section 6):

No Rights: Opposer contends that the Applicant has no rights in the Service Mark "The Superfreaks" because the Applicant's application was filed solely based on "Intent to Use" and

there is no record of competent evidence of actual use of the mark prior to the filing date of the application.

Use of the mark in commerce is not a prerequisite for an application under Trademark Act Section 1(b) based on applicant's assertion of a *bona fide* intention to use the mark in commerce.

The claim of "prior use" (section 3) fails to state a claim. Priority is not a ground for opposition, although it is an element of the ground of likelihood of confusion. See Section 2(d) of the Trademark Act. Opposer's specific allegations regarding his adoption and use of the SUPERFREAKS mark should be included as a separate paragraph within his claim of "likelihood of confusion" (section 7).

Opposer's four remaining sections do not state four different statutory claims. As best we can tell, it appears that the statutory grounds opposer may be claiming are that "applicant is not the owner of the mark" (section 4) and that applicant filed a "fraudulent USPTO application" (section 5). Opposer's claims of "not a bona fide offering of goods and services" (section 1) and "bad faith use and registration" (section 2) appear to be variations on these grounds.

In sum, the notice of opposition as a whole fails to give notice as to the issues which will be litigated in this proceeding.

In accordance with Fed. R. Civ. P. 8(a) and 10(b), opposer is directed to amend his pleading to state "short and plain" grounds for opposing registration of application Serial No. 78110344.⁴ The amended notice of opposition must include each averment in a separate numbered paragraph, and must delete redundant claims, legally insufficient claims, and claims over which the Board has no jurisdiction. Opposer is further advised that, if he includes a pleading of fraud, he must plead this ground with particularity. Opposer is allowed until 30 days from the mailing date on

⁴ Opposer is advised that the notice of opposition corresponds to the complaint in a court proceeding, and the form of the notice of opposition should comply with Fed. R. Civ. P. 10(b), which states:

All averments of claim or defense shall be made in numbered paragraphs, the contents of each of which shall be limited as far as practicable to a statement of a single set of circumstances; and a paragraph may be referred to by number in all succeeding pleadings. Each claim founded upon a separate transaction or occurrence and each defense other than denials shall be stated in a separate count or defense whenever a separation facilitates the clear presentation of the matters set forth.

this order to submit an amended pleading, failing which this opposition will be dismissed.⁵

The answer

Applicant's answer is argumentative and more in the nature of a brief on the case than a responsive pleading to the notice of opposition. As such, it does not comply with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable to this proceeding by Trademark Rule 2.116(a).⁶

In accordance with Fed. R. Civ. P. 8(b) it is incumbent on an applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph. If an applicant is without sufficient knowledge or

⁵ Notwithstanding references to attachments in the notice of opposition, no accompanying documents have been associated with the Board's proceeding file. Therefore, if opposer wishes to attach exhibits to his notice of opposition, copies should be submitted with the amended notice of opposition. Opposer is advised, however, that, with the exception of status and title copies of any pleaded registrations, attaching exhibits to pleadings does not make them of record.

⁶ Rule 8(b) provides, in pertinent 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.

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.

As set forth above, opposer has 30 days from the date of this order in which to file his amended notice of opposition. Applicant is allowed until 30 days from the date listed in opposer's certificate of service (of the amended notice of opposition) to file his answer, failing which the Board may enter notice of default.

Opposer's motion for summary judgment

As set forth above, the Board finds that opposer's pleading does not give adequate notice to applicant as to the issues to be litigated in this proceeding. Applicant's answer does not specifically admit or deny the allegations of the complaint. Opposer's arguments in support of his motion for summary judgment are not tied to specific pleaded claims.

Opposer has the burden of demonstrating the absence of genuine issues of material fact and opposer's entitlement to summary judgment as a matter of law. However, this is impossible where there is insufficient notice of the pleaded claims. Therefore, opposer's motion for summary judgment is denied without prejudice. Once opposer files

his amended pleading, and applicant files his answer, opposer may renew his motion for summary judgment.⁷

Parties Without Legal Representation

Both parties are advised to familiarize themselves with Board procedure. It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition 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.

Because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any

⁷ Notwithstanding references to attachments in opposer's motion for summary judgment, no accompanying documents have been associated with the Board's proceeding file. Therefore, if opposer renews his motion, he should submit any exhibits in support thereof. The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See, for example, *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

exhibits thereto, are then submitted to 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. See Trademark Rule 2.123(1), and TBMP §717.

It is recommended that both parties obtain copies of (i) the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and (ii) The Trademark Trial and Appeal Board Manual of Procedure, both of which are available on the U. S. Patent and Trademark Office website at www.uspto.gov.

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.

Discovery and Trial Dates Reset

DISCOVERY to close	November 28, 2004
30-day testimony period for party in position of plaintiff to close:	February 26, 2005
30-day testimony period for party in position of defendant to close:	April 27, 2005
15-day rebuttal testimony period for party in position of plaintiff to close:	June 11, 2005

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. Trademark Rule 2.125.

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

E-Government Initiatives at the Trademark Trial and Appeal Board:

TTAB forms for electronic filing are now available at <http://estta.uspto.gov>.

Images of TTAB proceeding files can be viewed using TTABVUE at <http://ttabvue.uspto.gov>.

Changes:

Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.