

TAB

Attorney Docket: 08631.0007

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

DALLAS BASKETBALL LIMITED)
)
) Opposer,)
)
) v.)
)
) JOHN JACOB CARLISLE)
)
) Applicant.)
)

Opposition No. 91156064
Serial No. 76/165,865
Mark: DEEP 3 and Design



06-18-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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TELEPHONE ROOM

**APPLICANT'S MOTION FOR A MORE DEFINITE STATEMENT
AND MOTION TO SUSPEND PROCEEDINGS**

Applicant John Jacob Carlisle ("Applicant") respectfully requests that the Board order Opposer Dallas Basketball Limited ("Opposer") to file and serve an amended pleading with a more definite statement of the grounds for opposition under Fed. R. Civ. P. 12(e). Applicant also requests that all proceedings not germane to the motion for a definite statement be suspended pending disposition of the motion.

I. BACKGROUND

On March 6, 2003, Opposer filed a notice of opposition against Applicant's application Serial No. 76/165,865 for the mark DEEP 3 and Design for "shirts, baseball caps, shorts, pants, socks, sweat suits, jackets, sweatshirts, sweatpants, bandanas, shoes, writs bands, hand bands, winter sock hat, visors, gloves and scarves."

The Notice of Opposition contains five (5) Paragraphs. Paragraph No. 1 of the Notice of Opposition contains allegations pertaining to Applicant and the subject

Application. Paragraph Nos. 2-4 of the Notice of Opposition appear to relate to Opposer's standing to bring this action. Paragraph No. 5 of the Notice of Opposition, on the other hand, appears to be the only allegation that may relate to Opposer's ground for opposition. Paragraph No. 5 reads:

5. Additionally, Opposer contends that Applicant failed to have a bona fide intention to use his mark in commerce when Applicant filed its intent-to-use application.

On April 23, 2003, the Board issued an order instituting the opposition and setting Applicant's time to answer up to and including June 2, 2003, and setting discovery to open May 13, 2003. The institution order was forwarded directly to Applicant.

On May 23, 2003, Opposer noticed Applicant's discovery deposition, including an informal request for documents to be produced at the deposition. The deposition was scheduled for June 18, 2003, in San Antonio, Texas.

On May 28, 2003, Applicant contacted the undersigned regarding the opposition, and forwarded a copy of the Notice of Opposition and trial schedule to counsel.

On May 29, 2003, counsel for Applicant contacted counsel for Opposer to request a sixty (60) day extension of time to file an answer. Counsel for Applicant explained that she had just assumed responsibility for the opposition, and that an extension of time was needed to confer with Applicant and to review the Notice of Opposition.

On May 29-30, 2003, counsel for the respective parties corresponded with each other regarding, among other things, information about Applicant, the deadline for filing an answer, and deposition schedules.

On June 2, 2003, Applicant filed an extension of time to file an answer up to and including June 16, 2003 on the ground that counsel for Applicant had just assumed responsibility for the case; that additional time was needed to confer with Applicant and prepare a responsive pleading; and that a two week extensive was all that Opposer was prepared to grant.

On June 4, 2003, counsel for Applicant called counsel for Opposer to clarify the legal grounds for the opposition. In particular, Applicant was concerned whether the word "*Additionally*" in Paragraph No. 5 of the Notice of Opposition meant that there was more than one ground for opposition. Further, counsel for Applicant sought clarification about the factual basis for Opposer's claim in Paragraph No. 5 that "Applicant failed to have a bona fide intention to use his mark in commerce when Applicant filed its intent-to-use application Applicant." Because Applicant had previously sent Opposer evidence of his actual use of the mark in commerce shortly after filing his intent to use application, counsel for Applicant questioned Opposer's factual basis to support the allegation. In addition, counsel for Applicant noted that the request for production of documents attached to the notice of deposition did not comply with Fed. R. Civ. P. 34.

On June 5, 2003, Opposer served a proper Request for Production of Documents under Fed. R. Civ. P. 34, and an accompanying letter regarding possible deposition dates.

On June 6, 2003, counsel for Applicant sent a letter to counsel for Opposer to follow-up on the telephone conference of June 4, 2003. A copy of this letter is attached as Exhibit A.

On June 16, 2003, and after Applicant began drafting this motion, counsel for Applicant received a letter from counsel for Opposer dated June 11, 2003. A copy of the letter is attached as Exhibit B. According to counsel for Opposer, the only ground for opposition at this time is that Applicant "failed to have a bona fide intent to use the mark in commerce when the application was filed and thus, the application was not filed in the name of the true owner of the mark." Opposer also stated that if, during the course of the proceeding, it learns that Applicant had a bona fide intent to use the mark as of the filing date, it would withdraw the opposition.

II. ARGUMENT

Fed. R. Civ. P. 12 (e) provides that "if a pleading to which a responsive pleading is permitted is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the party may move for a more definite statement before interposing a responsive pleading." Both the Federal Rules and TBMP § 505.01 further provide that a motion for a more definite statement must point out the defects in the pleading, the details desired to have pleaded, and indicate that the movant is unable to frame a responsive pleading without the information. A motion for a more definite statement must be filed within the time for, and before, the moving party's responsive pleading. TBMP § 505.01

As noted above, Applicant does not challenge the sufficiency of Paragraph Nos. 1-4 of the Notice of Opposition under Fed. R. Civ. P. 12. Applicant submits, however, that the allegations contained in Paragraph No. 5 of the Notice of Opposition are so vague and ambiguous that Applicant is unable to prepare a responsive pleading or fairly

formulate its defense, including any appropriate affirmative defenses, and trial strategy in this case.

In particular, Paragraph No. 5 merely parrots the bare minimum statutory language under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), by alleging that "Applicant failed to have a bona fide intention to use his mark in commerce when Applicant filed its intent-to-use application." Although this minimum language may state a claim under Fed. R. Civ. P. 12(b)(6), Opposer has failed to provide any factual details or even statements of information and belief for this claim, and Applicant is therefore unable to prepare a meaningful responsive pleading. Fed. R. Civ. P. 12(e). Applicant simply does not know, from the pleadings, why Opposer claims that Applicant lacks the sufficient bona fide intent to use the mark as of the filing date of the Application.

Opposer has not alleged, for example, that upon information and belief, Applicant lacks sufficient documentary evidence necessary to prove Applicant's bona fide intent to use. Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993). Nor does Applicant believe that Opposer can make such an allegation in view of the documentary evidence Applicant provided to Opposer prior to the commencement of this opposition.

Moreover, although Opposer's letter dated June 11, 2003 suggests that its claim of a lack of a bona fide intent is based upon Opposer's information and belief that "the application was not filed in the name of the true owner of the mark," this additional detail is not set forth in the Notice of Opposition. Opposer should be made to amend the Notice of Opposition to provide more detailed information on the ground for opposition. On this point, Applicant does not seek Opposer's trial strategy, discovery

from Opposer, nor work product from counsel. Rather, Applicant merely seeks additional facts or statements of information and belief that will allow Applicant a fair opportunity to prepare a responsive pleading, including any relevant affirmative defenses. In short, Applicant should not be left to guess what facts or information and belief form the basis of Opposer's ground for opposition.

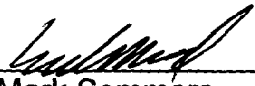
Lastly, Applicant respectfully requests that all proceedings not germane to the motion for a more definite statement be suspended pending disposition of the motion. Trademark Rules 2.117 and 2.127. Applicant submits that good cause has been shown for suspension inasmuch as the ground for opposition remain unclear, and Applicant has filed this motion for a more definite statement before the filing of a responsive pleading as required under the rules. TBMP § 505.01.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that its motion for a more definite statement and motion to suspend proceedings be granted.

Respectfully submitted,

Dated: June 16, 2003



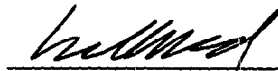
Mark Sommers
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Washington, D.C. 20005-3315
(202) 408-4000

Counsel for Applicant

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing APPLICANT'S MOTION FOR A MORE DEFINITE STATEMENT AND MOTION TO SUSPEND PROCEEDINGS was served on June 16, 2003, by U.S. mail, first-class postage pre-paid, in an envelope addressed to:

Molly Buck Richard
Thompson & Knight LLP
1700 Pacific Avenue
Suite 3300
Dallas, Texas 75201-4693



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail postage pre-paid in an envelope addressed to: Commissioner for Trademarks, BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on this day June 16, 2003



EXHIBIT A



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CONFIRMATION

MARK SOMMERS
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June 6, 2003

Molly Buck Richard, Esq.
Thompson & Knight LLP
1700 Pacific Avenue, Suite 3300
Dallas, Texas 75201-4693

BY FACSIMILE

Dallas Basketball Limited v. John Jacob Carlisle
Opposition No.: 91156064
Our Reference: 08631.0007

Dear Molly:

This follows our telephone conference of June 4, 2003.

As discussed, we are unclear of the legal grounds for your opposition and we asked you to identify the legal grounds. In particular, we asked you to confirm whether the allegation in Paragraph 5, that reads "*Additionally, Opposer contends that Applicant failed to have a bona fide intention to use this mark in commerce when Applicant filed its intent-to use application,*" was the only ground for opposition (in contrast to allegations of standing). You refused to advise us if you intended to plead any other legal ground.

Next, we asked about the factual basis for your claim that our client failed to have a bona fide intention to use the mark, given that we previously forwarded you documents evidencing our client's *use* shortly after filing its *intent to use* application. Since we provided you with evidence of our client's actual use of the mark shortly after filing its *intent to use* application, we questioned whether you had a factual basis sufficient to support your allegation. We also offered you safe harbor to withdraw your pleading. Failing your withdrawal, you are on notice that we reserve our right to file a sanctions motion absent your having a factual basis at the time you filed the opposition sufficient under Rule 11 to support your claims that our client had no bona fide intent when our client filed its application, or at any other time up to and after it actually used the mark.

Molly Buck Richard, Esq.
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FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

We also discussed your notice of deposition of John Jacob Carlisle and its inclusion, as Schedule A, of a request for production of documents at the deposition. Your "Schedule A" request does not comply with Fed. R. Civ. P. 34 or the Trademark Rules. Accordingly, we requested that you serve a request for production of documents under the applicable rules. We are now in receipt of your request for production of documents in compliance with Fed. R. Civ. P. 34 and we will respond accordingly.

Finally, we will provide our client's current mailing address and check schedules for a mutually agreeable date for the deposition of John Jacob Carlisle. In the meantime, we also asked that you check the availability of Mr. Mark Cuban and Mr. Richard Hart, since these individuals we know already are material witnesses with knowledge of facts relevant to this matter.

We look forward to hearing from you.

Sincerely,



Mark Sommers

MSS/jkv

cc: Linda McLeod
Montia Givens Pressey

EXHIBIT B

THOMPSON & KNIGHT LLP

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June 11, 2003

Mr. Mark Sommers
Finnegan, Henderson, Farabow,
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1300 I Street, N.W.
Washington, D.C. 20005-3315

Re: Dallas Basketball Limited
v. John Jacob Carlisle
Our File: 502498.000001

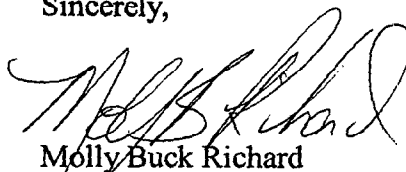
Dear Mark:

I am responding to your letter of June 6, 2003. At this time, the only ground for our opposition is that your client failed to have a bona fide intent to use the mark in commerce when the application was filed and thus, the application was not filed in the name of the true owner of the mark. See TBMP Section 308.02(a). Obviously, once I take your client's deposition, it is possible that there may be additional grounds for our opposition but until that time, this is the ground on which we have based our opposition.

In the second paragraph of your letter, you asked for the factual basis of our claim. Obviously, it is not necessary for me to prove my case at this early stage of the proceeding, nor am I required to disclose our strategy or work product. Obviously, as this case progresses if we believe that your client did indeed have a bona fide intent to use the mark as of the filing date, we will take the necessary steps to withdraw our opposition if no additional grounds exist for proceeding. Accordingly, we do not believe that it is necessary for us to withdraw our pleading.

With regard to the deposition of Mr. Carlisle, I look forward to obtaining his address and available dates for his deposition. Once we have obtained dates for Mr. Carlisle's deposition, I will determine when Mr. Cuban and Mr. Hart are available thereafter.

Sincerely,



Molly Buck Richard

MBR:dvc
c: Dallas Basketball Limited
502498 000001 Dallas 1603030.1

RECEIVED

JUN 16 2003

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.