

TTAB

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



06-30-2003

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

DALLAS BASKETBALL LIMITED,

Opposer,

v.

JOHN JACOB CARLISLE,

Applicant.

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Opposition No.: 91156064

Assistant Commissioner for Trademarks
TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3514

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

BACKGROUND

Dallas Basketball Limited, Opposer in the above-referenced proceeding, files this Response to Applicant's Motion for a More Definite Statement and Motion to Suspend Proceedings as follows:

1. John Jacob Carlisle, Applicant, filed Application Serial No. 76/165,865 for the mark DEEP 3 & DESIGN and on March 6, 2003, Dallas Basketball Limited, Opposer, filed its Notice of Opposition to said application. Applicant appears to concede Opposer's standing to bring this action and that Opposer has stated a claim upon which relief can be granted; however, Applicant claims that the Board should order a more definite statement of the grounds for the opposition.

2. In the Notice of Opposition, Opposer states in paragraph number 5: “Additionally, Opposer contends that Applicant failed to have a bona fide intention to use to use his mark in commerce when Applicant filed his intent-to-use application.” Applicant’s counsel had contacted counsel for Opposer requesting confirmation that the only ground for opposition was that the Applicant failed to have a bona fide intent to use the mark in commerce when the application was filed. By copy of the letter attached as Exhibit B to Applicant’s Motion, counsel for Opposer confirmed that the only ground at this time is that the Applicant failed to have a bona fide intent to use the mark in commerce when the application was filed. Thus, Opposer’s counsel stated in Exhibit B that the application was not filed in the name of the true owner of the mark.

3. In its motion, Applicant submits that the allegations in paragraph number 5 of the Notice of Opposition are so vague and ambiguous that Applicant cannot prepare a responsive pleading or fairly formulate a defense.

4. Opposer submits that its pleadings are sufficient and that Applicant’s motion is not well taken and should be denied.

ARGUMENTS

A fair reading of Applicant’s motion establishes that Applicant is merely seeking discovery in order to determine the information known to Opposer which would establish that Applicant was not the true owner of the mark as of the filing of the application. This is not permitted under the rules of the Trademark Trial and Appeal Board’s or the Federal Rules of Civil Procedure. Pursuant to Section 505.01 of the TBMP, a motion for more definite statement may not be used to obtain discovery and the only information which a movant may obtain is that which it needs to make its responsive pleading. Due to the fact that Applicant merely needs to admit or deny the allegations

contained in the Notice of Opposition, if Applicant believes that he had a bona fide intent to use the mark as of the filing date of the application, he merely needs to deny the allegations in paragraph 5. It is not Opposer's duty to provide the documentary evidence in Opposer's possession to substantiate the allegations in the Notice of Opposition.

Interestingly, Applicant does not challenge the fact that Opposer has stated a claim upon which relief can be granted, rather Applicant states that Opposer has failed to provide the factual details forming the basis for its claim. It is not necessary that Opposer provide detailed explanations for the basis underlying the allegations in its Notice of Opposition.

In support of its contention that Opposer must specify the reasons for its claim in the Notice of Opposition, Applicant cites Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993). That case did not involve a motion for more definite statement but rather it involved a motion to dismiss for failure to state a claim upon which relief can be granted or, alternatively, for summary judgment. In that case, the opposer sought to amend its Notice of Opposition to add a new ground, namely:

“Upon information and belief Applicant did not have a bona fide intention to use the mark in commerce on the specified services when it filed this and its other applications covering CBM and JCBM for the many goods specified therein.” Id, at 1504.

The Board held that Opposer had stated a claim upon which relief could be granted and further felt that there was a genuine issue as to material facts so that the motion for summary judgment was denied. Accordingly, the Board granted the amendment set forth above which is very similar to the allegation in the instant Notice of Opposition. Applicant has made it clear that it is not contending that Opposer has failed to state a claim under Rule 12 (b)(6) but rather claims that the statement in paragraph 5 is too vague to prepare a meaningful responsive pleading. Pursuant to

TBMP Section 318.02(a), defendant need only to admit or deny each of the allegations contained in the Notice of Opposition. Accordingly, if Applicant believes that he indeed had a bona fide intent to use the mark at the time of the filing of the application, all Applicant need do is deny the allegations contained in paragraph 5. Nothing further is required for Applicant to prepare and file its answer and thus, Applicant's Motion for More Definite Statement should be denied.

With regard to Applicant's request that this proceeding be suspended, Opposer respectfully requests that this proceeding not be suspended since Applicant's Motion for More Definite Statement is not a potentially dispositive motion. There is no reasonable basis for delaying these proceedings any further or delaying the discovery already served upon Applicant by Opposer.

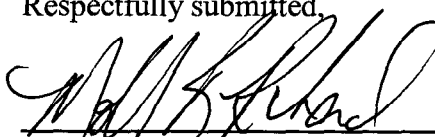
CONCLUSION

Applicant's Motion for More Definite Statement and Motion to Suspend Proceedings should be denied on the basis that Opposer has stated the minimum grounds required under the Rules and has stated a claim on which relief can be granted. Applicant is able to admit or deny all of the allegations contained in the Notice of Opposition, including paragraph number 5, without any further detailed information from Opposer. It is evident that Applicant is merely seeking to obtain discovery which is not the purpose of a Motion for Definite Statement. Further, it is evident that Applicant is seeking to avoid legitimate discovery by requesting a suspension of these proceedings.

WHEREFORE, Opposer respectfully requests that Applicant's Motion for a More Definite Statement and Motion for Suspension be denied.

Date: June 25, 2003

Respectfully submitted,



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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

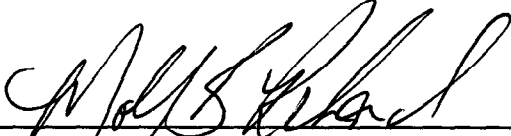
The undersigned certifies that a true and correct copy of the foregoing **Opposer's Response to Applicant's Motion for a More Definite Statement and to Suspend Proceedings** was forwarded to Mark Sommers, Counsel for Applicant, at Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., 1300 I Street, N.W., Washington, D.C. 20005-3315 on June 25, 2003.



Molly Buck Richard

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service at first-class mail postage pre-paid in an envelope addressed to: Assistant Commissioner for Trademarks, TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on this the 25th day of June, 2003.



Molly Buck Richard