TTAB

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

APPLICANT'S REPLY IN SUPPORT OF ITS MOTION FOR A MORE DEFINITE STATEMENT AND MOTION TO SUSPEND PROCEEDINGS

Applicant John Jacob Carlisle ("Applicant") respectfully submits this reply in support of its motion for a more definite statement and motion to suspend all proceedings not germane to said motion.

It is Applicant's position 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/or motion to dismiss. Applicant does not know and should not be left to guess 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.

In response to Applicant's motion, Opposer contends that Applicant merely seeks discovery through its motion in order to determine the information known to Opposer establishing that Applicant is not the true owner of the mark as of the filing of the application. (Opposer's Br. p. 2). Opposer submits that Applicant need only admit

or deny the allegations contained in Paragraph 5, and that nothing further is required of Applicant to prepare and file an answer. Opposer also maintains that Applicant has conceded Opposer's standing and that Opposer has stated a claim upon which relief may be granted. Finally, Opposer contends that there is no reasonable basis to suspend proceedings because Applicant's motion is not potentially dispositive.

As an initial matter, Applicant does not concede Opposer's standing nor any other alleged claims in the Notice of Opposition. Rather, Applicant has challenged the sufficiency of Opposer's pleading under Fed. R. Civ. P. 12(e), which provides that if a pleading 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 filing a responsive pleading. TBMP § 505.01.

Further, contrary to Opposer's assertion, Applicant is not seeking discovery through its motion for a more definite statement. Rather, Applicant seeks very basic facts or statements of information and belief that will allow Applicant to prepare a responsive pleading. Also, Opposer omits that a "responsive pleading" may include affirmative allegations and/or a motion to dismiss. This is not a simple matter of Applicant admitting or denying vague allegations in a Notice of Opposition. How can Applicant formulate a responsive pleading, **including affirmative defenses or a motion to dismiss**, when Applicant does not know the factual basis of Opposer's claim of a lack of a bona fide intent to use?

It is also telling that Opposer, in its response to Applicant's motion, stated that Applicant lacks a bona fide intent to use the mark as of the filing of the application because "Applicant was not the true owner of the mark as of the filing date of the

application." (Opposer's Brief, p. 2). Does this statement form the basis for Opposer's allegation of a lack of a bona fide intent-to-use? Is the ground for opposition that Applicant is not the "owner" of a mark that is the subject of an intent-to-use application? If so, is this a valid ground for opposition against an intent-to-use application? Marilyn Carano et al v. Vina Concha Y Toro S.A., 2003 TTAB LEXIS 263 (TTAB June 5, 2003) (Trademark Act Section 1(a) requires a claim of "ownership" of a mark whereas Section 1(b) only requires an assertion of a bona fide intent to use a mark in commerce and that applicant believes that he or she is entitled to use the mark for which registration is sought).

In short, this is the very type of basic information that Applicant requires in order to prepare a responsive pleading, including but not limited to interposing affirmative defenses and/or filing a motion to dismiss. Surely, Opposer cannot seriously claim that Applicant is seeking discovery when it is so obvious that Opposer itself is uncertain of the grounds for opposition. Moreover, it is the Opposer, not Applicant, who is aggressively pursuing discovery -- even during the pendency of this motion -- hoping to fish out facts to support a valid ground for opposition.

Finally, with respect to the motion to suspend proceedings, Trademark Rule 2.117 provides that proceedings may be suspended pending disposition of a potentially dispositive motion **or** upon a showing of good cause. Applicant has requested that all proceedings not germane to the motion for a more definite statement be suspended pending disposition of the motion.

As stated in Applicant's main brief, good cause has been shown for suspension inasmuch as the grounds for opposition remain unclear, and Applicant has yet to file a

responsive pleading. TBMP §§ 505.01 and 510.01. Applicant should not be required to respond to discovery or appear for depositions until the Board rules on the motion, and until Applicant is certain of the grounds for opposition. It is unreasonable to expect Applicant to respond to discovery or defend a deposition when Applicant does not know the grounds for opposition, and thus cannot know whether the questions asked during discovery are relevant to the claims or defenses of a party as required under Fed. R. Civ. P. 26(b)(1).

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: July 15, 2003

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing APPLICANT'S REPLY IN SUPPORT OF ITS MOTION FOR A MORE DEFINITE STATEMENT AND MOTION TO SUSPEND PROCEEDINGS was served on July 15, 2003, by U.S. mail, first-class postage pre-paid, in an envelope addressed to:

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