

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

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Opposition Nos. 91152945
91153093
91153719
91159969
91159998
91160031
91160041
91160064

RA Brands, LLC

v.

Frederic Remington Trust 1861

Linda Skoro, Interlocutory Attorney

In an effort to bring some coherency to these proceedings, they are being consolidated. A discussion of the consolidation follows, but first the Board will address certain fundamental requirements of Board proceedings.

Procedural Matters

(1) Filings with the Board must comport with certain requirements that are set out in Trademark Rule 2.126, 37 CFR § 2.126. In particular, they are required to have appropriate headings and captions, are to be double spaced and signed by a person authorized to represent the party. See 37 CFR §§ 2.126 and 10.14. Submissions that are not in the appropriate form

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may be refused consideration¹ at the discretion of the Board.
See TBMP § 106.03.

(2) The certificate of mailing and the certificate of service procedures are two different certificates that perform two distinct functions.² The specifics of these items are set out in Chapter 100 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP).³ It is important to note that the certificate of mailing procedure can only be used for documents mailed within the United States, and that close attention must be paid to the dates used on these certifications because they have significant legal ramifications if misused.⁴ See 37 CFR § 10.18(b)(1).

(3) There are specific ways that a party to an inter partes proceeding before the Board serves a document on every other party to the proceeding. These procedures are set out in 37 CFR § 2.119(b) and explained in Section 113.04 of the TBMP. While it is acceptable to send a courtesy copy of a filing to an adverse party by facsimile transmission,

¹ Applicant's filing of June 28, 2004, entitled "notice" is an inappropriate filing and will be given no consideration.

² It is noted that on May 17, 2004 applicant began filing "notice to TTAB" alleging non-receipt of opposer's response, filed March 8, 2004. However, that filing has a valid certificate of service addressed to Dean Shideler.

³ The manual is available on the Office web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.

⁴ In many of applicant's filings there is a significant discrepancy between the signature date and the mail room date, sufficient to call their veracity into question.

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transmission by fax does not constitute "service" under the provisions of 37 CFR § 2.119 and the paper must still be served by one of the methods specified in 37 CFR § 2.119(b).

(4) 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 inter partes proceedings, and highly recommended for a person who may not speak English as a first language, 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.

(5) It is noted that while applicant has decided to represent itself, there is no clear authorization for such representation. Applicant is a foreign trust, and filings have been made and signed by Dean Shideler, S. H. Yoo, and M. Kim. It is clear that none of these people are attorneys, Mr. Shideler goes under the title of "consultant" and actually appears more as a domestic representative; S.H. Yoo alleges he is "trustee", but there is no evidence of his legal authority as trustee, and M. Kim appears to be an administrative assistant without a title. Applicant is advised to familiarize itself with Section 114 of the TBMP and 37 CFR § 10.14(e) that provide information on the authorized

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representation of a party, as well as TBMP § 106.02 regarding signature requirements.

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. The Board further advises applicant that established Board procedures are governed by Title 37 of the Code of Federal Regulations. In particular, 37 CFR §§ 2.116 - 2.136 with more detailed explanations of Board procedures set out in the Trademark Trial and Appeal Board Manual of Procedures (TBMP), which is posted on the Office web site at www.uspto.gov. Also on the web site the public can view documents filed in TTAB proceedings by accessing TTABVUE. It is recommended that applicant thoroughly familiarize itself with these procedures.

(6) It is recommended that future filings be done electronically via the Internet through the Electronic System for Trademark Trials and Appeals (ESTTA). See 37 CFR § 2.126(c). Electronic filing provides immediate filing and entry into the record and eliminates mail delays and scanning entry into the file.

Consolidation

A review of the pleadings in the above-identified opposition proceedings indicates that the parties are the same, the marks are the same, and the proceedings involve

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substantially identical questions of fact and law.

Since the marks being opposed are the same, and inasmuch as the plaintiff has in each instance challenged the right of applicant to registration on the basis of its registrations here involved that are very similar, it is believed that these proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, the consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, the extra expense involved in conducting the proceedings individually, and hopefully reduce much of the confusion experienced so far in managing these proceedings and thereby help the Board in getting the underlying issues decided promptly. See Rule 42(a) of the Federal Rules of Civil Procedure.

The consolidated cases may be presented on the same record and briefs. See *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, n.2 (TTAB 1996). As a general rule, from this point on only a single copy of any paper or motion should be filed in the "parent" case, which is the oldest, or first-filed of the cases. In this instance it is proceeding number 91152945, but the caption of each paper filed with the Board should reference the individual proceeding numbers in its caption, with the parent case listed first. See *S Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 n.4 (TTAB 1997).

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Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the decision shall be placed in each proceeding file.

The parties are further advised that they are to periodically inform the Board if any subsequent oppositions or cancellations are instituted which involve the same parties and the same issues.

Background

On November 2, 1999 applicant filed numerous applications for registration of the mark, FREDERIC REMINGTON, the difference in the applications are the goods and services on which the mark is being used.⁵ As each was published, opposer filed timely notices of opposition. When the first three of these proceedings were instituted, applicant was represented

⁵ Serial No. 76080801 for "backpacks" in Class 018 [Opp. No. 91152945]; Serial No. 76080805 for "Ribbons and embroidery" in Class 026 [Opp. No. 91153093]; Serial No. 76080802 for "Tequila" in Class 033 [Opp. No. 91153719]; Serial No. 76080812 for "Entertainment, namely production of motion pictures and television shows" in Class 041 [Opp. No. 91159969]; Serial No. 76080808 for "Glass bottles sold empty and porcelain figurines" in Class 021 [Opp. No. 91159998]; Serial No. 76080806 for "Paper goods consisting of business materials, business cards, stationary, envelopes, labels, gift cards, flat works, cartons, gift boxes, gift bags, gift wraps, ribbon, string tags, catalogs describing products for sale, product brochures, gift card envelopes, postcards, playing cards, flashcards" in Class 016 [Opp. No. 91160031]; Serial No. 7680804 for "Entertainment in the nature of on-going variety television programs, organizing cultural events and activities, commemorative events, functions and ceremonies" in Class 041 {Opp. No. 91160041}; and Serial No. 76080809 for "Plastic parts for vehicles, namely automotive

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by counsel who, despite having trouble communicating with applicant's representative, filed answers, but then withdrew from representation. Applicant was allowed time to find new counsel or decide to represent itself.⁶

In the parent proceeding, Opp. No. 91152945, applicant informed the Board that it intended to represent itself on February 23, 2004⁷ and on April 2, 2004 proceedings were resumed and trial dates were reset. In the interim, on March 18, 2004,⁸ applicant, in a pleading signed by S.H. Yoo, Trustee, filed what was characterized as a "motion to dismiss opposition"⁹. However, on April 21, 2004 the filing was dismissed as untimely, since an answer had already been filed, and the merits of the motion were not addressed. By a corrective order on April 27, 2004, the Board addressed the

exterior and interior extruded decorative and protective trim" in Class 012 [Opp. No. 91160064].

⁶ As indicated earlier, there remains some representation issues that need to be resolved by applicant to enable this matter to progress.

⁷ It is noted that this filing was signed by Dean S. Shideler as "in propria persona" for "THE TRUST". There is no evidence of record that Mr. Shideler is an attorney and thereby permitted to represent the trust or is a trustee who would be representing itself. No further filings will be accepted or considered that are signed by Mr. Shideler.

⁸ While this filing bears a mailroom date of March 18, 2004, it contains a certificate of mailing date and signature date of January 31, 2004.

⁹ This filing confuses many legal principles. The confusion is evidenced by the timing of the filing of a motion to dismiss, confusing the legal standard for motions for summary judgment with motions to dismiss, and attaching an unidentified document that applicant later stated was in error. There also was no certificate of service.

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attachment to the March 18, 2004 "motion to dismiss" informing the parties that the motion would be treated as a motion for summary judgment due to the submission of "evidence" outside the record and proceedings were suspended.¹⁰

On May 17, 2004, applicant objected to the Board's conversion of the motion to dismiss to one for summary judgment, causing the Board in an order mailed May 27, 2004, to repeat its denial of the "motion to dismiss" as untimely, reset dates, and further provide the parties 30 days to respond to outstanding discovery.

On the same day, opposer responded to the converted motion for summary judgment by objecting to it. The response was acknowledged by the Board and the Board repeated that the motion was to be given no further consideration.

At this point, discovery in the parent case closed on June 30, 2004.¹¹

Motions to Dismiss

In virtually all of these proceedings applicant has filed a document it entitled "motion to dismiss". There have been a series of these motions filed in February and March 2004; a

¹⁰ Opposer informed the Board that it did not receive any relevant attachments and therefore is unable to respond fully to the filing as a motion for summary judgment. As this motion is not being given any further consideration, opposer's concerns are noted.

¹¹ Given the Board's delay in addressing these cases, the discovery period will be extended as set forth later in this order.

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series filed as a consolidated document in May 2004; and another round of them in June 2004.

From what can be understood from these filings, the grounds for these motions range from allegations that opposer has failed to state a claim upon which relief can be granted; that opposer lacks standing to bring the action; that there can be no likelihood of confusion; and that the notice of opposition was untimely.

The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. While it may be filed after an answer is filed, it must be raised by some means other than a motion to dismiss.¹² In all these proceedings, an answer has been filed, thereby making a motion to dismiss inappropriate and itself, untimely. Accordingly, they are all denied as untimely.¹³

Discovery

It is apparent that applicant's lack of familiarity with inter partes proceedings will quickly lead to discovery issues. The Board notes that as one of the attachments to

¹² For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, or by a motion for summary judgment. See Fed. R. Civ. P. 12(b)(2).

¹³ If these motions were decided on their merits, the decision would be denial. Opposer has standing by virtue of its claimed registrations and states a claim through its allegations of a likelihood of confusion. Applicant's argument that the notice of oppositions are untimely is in error. All notices of opposition were timely filed through the use of the certificate of mail procedure. See 37 CFR § 2.197.

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applicant's "motion to dismiss" filed March 18, 2004 in this proceeding, was "Applicant's Motion for Extension of Time to Answer Opposer's First set of Interrogatories and Requests for Production of Documents" that belonged to another proceeding brought by a different opposer.¹⁴

In an effort to avoid future discovery issues coming before the Board, the parties are advised that the Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those that do not.¹⁵ Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. See Fed. R. Civ. P. 26(g). The Federal Rules of Civil Procedure allow for a 30-day response period to discovery requests and any time extensions other than the trial dates set by the Board, should be negotiated between the parties. Motions to compel should be a last resort when discovery needs are not satisfied.

In the light of the foregoing, discovery and trial dates are hereby reset as indicated below.

¹⁴ This document was improperly signed by Mr. Shideler and can be given no consideration, even if it belonged in this proceeding.

¹⁵ See Chapter 400 of the TBMP for a thorough discussion of discovery.

DISCOVERY PERIOD TO CLOSE:	10/31/2004
Thirty-day testimony period for party in position of plaintiff to close:	1/29/2005
Thirty-day testimony period for party in position of defendant to close:	3/30/2005
Fifteen day rebuttal testimony period to close:	5/14/2005

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.

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