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

Proceeding	91169106
Party	Plaintiff OS Asset, Inc. and Outback Steakhouse of Florida, Inc. OS Asset, Inc. and Outback Steakhouse of Florida, Inc. ,
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Submission	Motion for Default Judgment
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UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Application Serial No. 78/407,551  
Published In The *Official Gazette*, October 11, 2005

OS Asset, Inc. and	)	
Outback Steakhouse of Florida, Inc.	)	Opposition No. 91169106
	)	
Opposers,	)	
	)	
v.	)	
	)	
Ronnie D. Fife	)	
	)	
Applicant.	)	
	)	

**OPPOSERS' MOTION FOR DEFAULT JUDGMENT OR, IN THE ALTERNATIVE,  
FOR JUDGMENT ON THE PLEADINGS**

Opposers OS Asset, Inc. and Outback Steakhouse of Florida, Inc., (“Opposers” or “Outback”) respectfully move the Trademark Trial and Appeal Board (“the Board”) under Fed. R. Civ. P. 55 and 37 C.F.R. § 2.106(a) for a Default Judgment against Registrant Ronnie D. Fife (“Applicant”) in the above-entitled action. The Board ordered Applicant to file an Answer complying with Fed. R. Civ. P. 8(b), 37 C.F.R. § 2.119, and all other applicable rules and Board practices, by January 10, 2007. Applicant failed to do so. The Board should therefore enter judgment by default against Applicant.

In the alternative, if the Board deems the letter that Applicant filed outside the deadline to be a timely-filed “Answer,” Opposers hereby move for judgment on the pleadings under Fed. R. 12(c). The letter Applicant filed as his “Answer” does not fairly meet Opposers’ allegations, and does not deny them. Applicant therefore admits Opposers’ allegations, making judgment in favor

of Opposers appropriate. Therefore, if the Board finds Applicant has in fact “answered,” Opposers respectfully move for judgment on the pleadings. The bases for this motion are set forth in the attached memorandum in support.

Respectfully submitted,



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## MEMORANDUM IN SUPPORT

### **I. INTRODUCTION**

In response to a Board Order requiring Applicant to file an Answer or other responsive pleading within thirty days, Applicant filed, more than thirty days later, not an Answer or other responsive motion but a letter purporting to be in opposition to entry of default. The letter does not deny the allegations in the Notice of Opposition. The Board should therefore enter default judgment against Applicant, or, in the alternative, judgment on the pleadings in favor of Opposers.

### **II. FACTS AND PROCEDURAL HISTORY**

Opposers operate and franchise the well-known and highly successful OUTBACK STEAKHOUSE restaurant chain. Doc. No. 1, Notice of Op., ¶ 3. There are over 700 Outback restaurants in the United States, and over 100 more in twenty other countries. *Id.* Outback has adopted and uses many well-known marks, including “OUTBACK,” for a variety of goods and services in addition to its restaurant services. *Id.* ¶ 4. Outback has registered with the USPTO over thirty-three OUTBACK-related marks, at least six of which are in International Class 25. *See id.* ¶ 4 and chart. Opposers first used the OUTBACK mark in 1988, and since then have highly publicized it. *Id.* ¶¶ 6-7. Outback has acquired much notoriety and a most valuable reputation under its OUTBACK-related marks. *Id.* ¶ 6. Outback opposes Applicant’s attempt to register THE CALIFORNIA OUTBACK and Design as a trademark for “shirts and hats promoting the California Outback (Central Valley)” in International Class 25. *See id.* ¶ 2.

Outback’s February 8, 2006, Notice of Opposition asks the Board to refuse Applicant’s registration of THE CALIFORNIA OUTBACK for two independent reasons: (1) Applicant’s use of that mark is likely to confuse the public into believing that Applicant’s goods are affiliated

with Outback; and (2) Applicant's use of that mark will dilute Opposers' OUTBACK-related marks, in violation of 15 U.S.C. § 1125(c). Doc. No. 1, ¶¶ 9-13.

Specifically, in Count I of their Notice of Opposition, Opposers allege that: (1) Applicant's THE CALIFORNIA MARK and Design mark, if used by Applicant for its specified goods, is a reproduction, copy, and colorful imitation of the OUTBACK-related marks; (2) Applicant's use of its mark is likely to cause confusion, mistake, or deception with respect to the origin of the goods, misleading the public into believing that Applicant's goods have been produced, sold, sponsored, approved, or licensed by Outback or are in some way affiliated with Outback; (3) any such confusion would injure Opposers; (4) any defect in Applicant's goods would negatively impact and seriously injure Outback's reputation, established through its use of the OUTBACK-related marks. *Id.* ¶ 9.

In Count II, Opposers allege that: (2) the OUTBACK-related marks are distinctive and famous; (2) Outback has used the OUTBACK-related marks for over sixteen years throughout the United States and the world, and they are well-known to the consuming public; (3) one or more of the OUTBACK-related marks has been registered on the USPTO's principal registry since 1988; (4) the public generally associates and identifies the OUTBACK-related marks with Outback; (5) Applicant's mark dilutes the OUTBACK-related marks under 15 U.S.C. § 1125(c), by diminishing Outback's ability to identify and distinguish its products and services. *Id.* ¶¶ 12-13.

Applicant did not file an Answer in response to Opposers' February 28, 2006, Notice of Opposition, nor a motion to extend his time to do so, so the Board *sua sponte* noticed default on June 30, 2006, ordering Applicant to show cause within thirty days why the Board should not

enter judgment by default. Doc. No. 4, Notice of Default. In response, Applicant submitted a one-page, two-paragraph letter, addressed “To whom it may concern,” and received by the Board on July 20, 2006. Doc. No. 5, Applicant’s Letter, Received July 20, 2007.

Applicant’s letter urged the Board not to enter judgment by default because: (1) a USPTO attorney that he spoke with told him that “you can not trademark a geographical area”; (2) Applicant did not see how an individual could confuse a kangaroo with a picture of California; (3) Applicant’s organization is licensed by the City of Oakdale to sell merchandise promoting indigenous styles and outdoor adventures; (4) Applicant’s organization seeks to preserve natural resources and promote outdoor adventures, not operate a restaurant. *Id.*

The Board construed this letter as a motion to set aside default, which it granted. Doc. No. 6, Order of December 11, 2006, p. 1-2. In its Order, the Board forgave Applicant his initial misunderstanding about what the rules required of him, but indicated that it would henceforth expect Applicant to familiarize himself with and follow the relevant procedural rules. *Id.* at 3 (“Applicant is reminded that he will be expected to comply with all applicable rules and Board practices during the remainder of this case.”). The Board expressly told Applicant that his Answer must:

[C]onstitute a responsive pleading to the notice of opposition, rather than argument more in the nature of a brief on the case. . . . The notice of opposition filed by opposer consists of 13 paragraphs setting forth the basis of opposer’s claim of damage. In accordance with Fed. R. Civ. P. 8(b) it is incumbent on applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph.

*Id.* at 2-3. In addition to Rule 8(b), which the Board quoted for Applicant’s convenience, the Board specifically directed Applicant’s attention to Title 37 of the Code of Federal Regulations,

and Trademark Rule 2.119. *Id.* at 3-4. The Board ordered Applicant to file his Answer by January 10, 2007. *Id.* at 2 (granting thirty days from mailing date of December 11, 2006).

Applicant did not file an Answer admitting or denying the allegations in each paragraph of Opposers' Notice of Opposition, as the Board instructed. Rather, he re-filed a slightly-edited but substantively identical version of his prior letter urging the Board not to enter judgment by default. *See* Doc. No. 7, Applicant's Letter, Received January 16, 2007. Despite the Board's admonition, the letter – to the extent it is relevant at all – contains “argument . . . in the nature of a brief on the case.” In addition, though the Board expressly told Applicant that in future he must comply with Trademark Rule 2.119, the filing does not contain a signed statement containing the date and manner of service. Rather, it contains a screen shot from the United States Post Office website, which does not identify to whom the “item” referenced was delivered or what that item was. *Id.*

Finally, though the Board instructed Applicant to *file* his Answer within thirty days of the mailing date of its Order, which was December 11, 2006, the letter was not received by the Board until January 16, 2007, and was not entered on the docket until January 22, 2007. Therefore, more than thirty days elapsed between the mailing of the Board's Order and the filing of Applicant's letter.

### **III. ARGUMENT**

#### **A. The Board Should Enter Judgment by Default in Favor of Opposer**

“If no answer is filed within the time set, the opposition may be decided as in case of default.” 37 C.F.R. § 2.106(a). In accordance with Federal Rule of Civil Procedure 55, if a defendant in a proceeding before the Board fails to answer within the time allotted, the Board

may issue a notice of default under Rule 55(a). TTAB Manual of Procedure (“TBMP”) §§ 312.01, 508. The defendant must then within twenty days show cause why the Board should not enter judgment against it by default. TBMP § 312.01. Notice of default need not come from the Board: the Plaintiff may move for a default judgment, in which case the motion serves as a substitute for the Board’s issuance of a notice of default. *Id.* Opposers have so moved because Applicant has not filed an Answer within the time set by the Board. This is so for two reasons: his filing was untimely, and his filing was not an “answer or other responsive pleading.”

1. Applicant’s Letter is Untimely

Applicant’s letter, filed on January 16, 2007, at the earliest, was not timely. The Board’s Order, mailed December 11, 2006, ordered Applicant to *file* his Answer or other responsive pleading within thirty days of the mailing-date of the order, i.e., by January 10, 2007.<sup>1</sup> Yet, the Board did not receive Applicant’s letter until January 16, 2007, as indicated by the time stamp in the lower right corner of the cover page. Doc. No. 7.<sup>2</sup> Applicant therefore failed to file his Answer within the thirty days the Board gave him.<sup>3</sup>

Because Applicant has failed to timely respond to Outback’s Notice of Opposition, the Board should enter judgment by default. This is the second time Applicant has failed to timely respond; the Board excused Applicant’s misunderstanding once, but expressly told him it would

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<sup>1</sup> Trademark Rule 2.119(c), which enlarges the time in which to take certain actions by five days where the time is keyed to the mailing of a paper from one party to another party, “does not apply to an action that must be taken by a party within a time set in a communication from the Board.” TBMP § 113.05 (“Thus, for example, when a Board action notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day.”)

<sup>2</sup> The letter also contains no indication of when Applicant mailed it to the TTAB, nor any averment that it was timely mailed.

<sup>3</sup> Trademark Rule 2.119(c) preempts application of Fed. R. Civ. P. 6(e), which extends certain deadlines by three days. But, even if Rule 6(e) applied here, the deadline would be January 13, 2007, which Applicant still failed to meet.

expect and enforce full compliance with the rules – several of which it specifically identified and quoted for Applicant – and with the Board’s procedures, in the future. Applicant cannot show good cause to excuse his complete disregard for the rules – and for the Board’s express instructions – this second time. Outback therefore respectfully asks the Board to enter judgment by default against Applicant.

2. Applicant’s Letter is Not an Answer or Other Responsive Pleading

Fed. R. Civ. P. 8(b) requires a responding party to:

[S]tate 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. . . . Denials shall fairly meet the substance of the averments denied.

The Board in its December 11, 2006, Order quoted this passage for Applicant and expressly instructed him to admit or deny the allegations contained in each paragraph of the Notice of Opposition. Doc. No. 6, p. 3. The Board specifically told Applicant that an Answer is not a “brief on the case.” *Id.* at 2.

Yet, Applicant submitted as his “Answer” a cut-and-paste of his previous letter in opposition to entry of judgment by default. The document purports to be a “second opposition statement written in order to comply with Trademark Rule 2.119,”<sup>4</sup> and substantively begins: “[j]udgment by default should not be entered . . . .” Doc. No. 7. The document does not specifically address each of Outback’s allegations; it does not admit or deny each paragraph of the Notice of Opposition. This rehash of a letter written in opposition to entry of default does not constitute an “Answer” under Rule 8(b).

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<sup>4</sup> Trademark Rule 2.119 relates to “Service and signing of papers.”

Nor is the letter an “other responsive pleading.” It does not challenge the jurisdiction or venue of this proceeding, does not challenge sufficiency of process, or of service, and does not claim failure to join a necessary party. *See* Fed. R. Civ. P. 12(b)(1)-(5), (7). The letter is also not a Rule 12b(6) motion for failure to state a claim upon which relief may be granted. Such a motion must argue that if all the facts in Opposers’ complaint are true, Opposers still are entitled to no relief under any set of facts that could be proven. TBMP § 503.02 (citing cases). Applicant’s letter, which was originally drafted in opposition to default, makes no such argument.

While the letter expresses Applicant’s personal disbelief that anyone could confuse a picture of a kangaroo for a picture of California, this does not amount to a legal argument in the nature of a Rule 12(b)(6) motion. In any event, the Notice of Opposition does not claim that consumers will mistake a kangaroo for the state of California; it claims that Applicant’s use of the word OUTBACK will lead customers to believe that Opposers made, sold, licensed, or are affiliated with Applicant’s products, *and* that Applicant’s use of the proposed mark will dilute the distinctiveness of Opposers’ famous mark. Applicant does not argue that his use of THE CALIFORNIA OUTBACK mark will not cause confusion as a matter of law, or that it will not dilute Opposers’ marks as a matter of law. Applicant cites no authority in support of his positions, which appear to be based on his own opinion or assessment of the case. Doc. No. 7. The letter is therefore not an “other responsive pleading.”

Because Applicant has not timely filed an “Answer” or an “other responsive pleading” as the Board instructed, Outback is entitled to judgment by default. The Board should not permit Applicant to disregard the rules and procedures that everyone who wishes to register a trademark must follow. As the Board expressed in its December 11, 2006, Order, those who wish to seek a

registration must learn and follow the rules. It would not be fair to the Board or to Opposers to permit Applicant to continue to file letters that fail to comport with the rules, outside the time set for filing. There is no “good cause” for such behavior, and judgment by default is the appropriate result.

**B. Opposers are Entitled to Judgment on the Pleadings**

In the event that the Board finds that Applicant’s January 16, 2007, letter *is* a timely-filed Answer, Opposers are entitled to judgment on the pleadings, because Applicant has admitted Opposers’ allegations by failing to deny them. Under Rule 8(b), an answer must admit or deny each and every allegation in the Notice of Opposition. Denials must fairly meet the substance of the averments denied. Fed. R. Civ. P. 8(b). Any allegations that the answer does not expressly deny are conclusively admitted. Fed. R. Civ. P. 8(d). Under Fed. R. Civ. P. 12(c), “after the pleadings are closed but within such time as not to delay the trial, any party may move for judgment on the pleadings.” In proceedings before the Board, a Rule 12(c) motion is timely if filed before opening of the first testimony period. TBMP § 504.01. The motion tests only the undisputed facts in the pleadings. *Id.*

Here, Applicant’s “Answer” does not contain denials that fairly meet the Opposers’ allegations. In fact, while the “Answer” states that there are no similarities other than the common use of “Outback,” that statement is itself an admission of one of the key facts underlying Opposers’ claims. The “Answer” does not deny *any* of the facts necessary for Outback to prevail on either of its claims. Specifically, as to Count I, Applicant does not deny Outback’s claims that: Outback has registered several OUTBACK-related marks in Class 25; that Outback has achieved notoriety and a most valuable reputation through its OUTBACK-related marks; that Applicant’s use of the word “Outback” will cause customers to be confused


about the origin or affiliation of Applicant's goods; or that registration of THE CALIFORNIA OUTBACK would damage Opposers. As to Count II, the letter does not deny that: Opposers' OUTBACK-related marks are distinctive and famous; the public generally associates the OUTBACK-related marks with Outback; or that Applicant's use would dilute the distinctive quality of Opposers' OUTBACK-related marks.

Because he has failed to deny these allegations, Applicant has admitted them. These facts are therefore undisputed and conclusively established, entitling Outback to judgment on the pleadings. In the event that the Board finds that Applicant has filed a timely Answer, Opposers respectfully ask the Board to enter judgment in their favor, based on the admissions contained in that Answer.

#### **IV. CONCLUSION**

Applicant has not timely filed an answer or other responsive pleading, and cannot show good cause for that failure. The Board should therefore enter judgment by default against Applicant and deny his registration of the mark THE CALIFORNIA OUTBACK. If the Board finds Applicant did timely file an Answer, that Answer fails to deny Opposers' allegations, thereby admitting them. Based on these admissions, the Board should enter judgment against Applicant on the grounds that his use of THE CALIFORNIA OUTBACK will cause confusion as to the origin of Applicant's products and/or dilute Outback's famous OUTBACK-related marks.

Respectfully submitted,

  
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Outback Steakhouse of Florida, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Opposers' Motion for Default Judgment or, In the Alternative, for Judgment on the Pleadings, was served on Applicant this 15th day of May, 2007 by United States Mail, postage-prepaid, at 5000 Chalmer Way, Denair, CA 95316 and by email at rfife@cali-outback.com.

  
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Kristopher J. Armstrong

**CERTIFICATE OF FILING**

I hereby certify that the foregoing Opposers' Motion for Default Judgment or, In the Alternative, for Judgment on the Pleadings, was electronically filed this 15th day of May, 2007, through the Electronic System for Trademark Trials and Appeals.

  
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Kristopher J. Armstrong