UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

WINTER

Mailed: June 7, 2007

Opposition No. 91175439

Heraeus Kulzer GmbH

v.

Absher, Mark

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

The Board instituted this opposition proceeding on January 31, 2007, making defendant's answer due by March 12, 2007. On March 27, 2007, the Board sent notice of default to defendant because neither an answer nor a motion to extend time to answer had been associated with the proceeding file. On April 9, 2007, defendant, acting *pro se*, filed a response to the Board's notice of default.[1] Defendant's response appears to be an "answer" to the notice of opposition and indicates defendant's intent to defend in this proceeding inasmuch as defendant sets forth various arguments regarding why he should be issued a trademark registration.

[1] Defendant's response was not accompanied by proof of service on opposer as required by Trademark Rule 2.119. The requirement for service is discussed later in this order. Accordingly, for purposes of expediency, a copy of defendant's response is attached to this order.

A defendant who fails to file its answer in the time set is in default. *See* Trademark Rule 2.106(a). The standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the Fed. R. Civ. P. 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it. *See Paolo's Associates Limited Partnership v. Paolo Bodo*, 21 USPQ2d 1899 (Comm'r 1990); *and Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556 (TTAB 1991).

In the present case, defendant's failure to file a timely answer does not appear to be the result of willful conduct or gross neglect, but of misunderstanding of the nature of the proceedings before the Trademark Trial and Appeal Board. Inasmuch as the proceeding is not far advanced, there does not appear to be substantial prejudice to the opposer as a result of defendant's delay; and, by responding, albeit inaccurately and without service to opposer, defendant has shown he intends to defend the opposition. Moreover, because the law favors deciding cases on their merits, the Board is reluctant to grant judgments of default and tends to resolve all doubts by setting aside default. *See Paolo's Associates, supra*.

In view of defendant's continued interest in this case, notice of default is **discharged**.

REQUIREMENTS FOR AN ANSWER TO THE NOTICE FOR OPPOSITION AND ORDER:

A reading of defendant's response to the Board's notice of default reveals that it is argumentative in nature. Defendant's response, thus, is not a responsive pleading (an "answer") to the notice for opposition. As such, it does not comply with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable this proceeding by Trademark Rule 2.116(a). Fed. R. Civ. P. 8(b) provides, in part:

> A party shall state 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. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

The notice for opposition filed by opposer herein consists of **eight** numbered paragraphs setting forth the basis of opposer's claim of damage. In accordance with Fed. R. Civ. P. 8(b), it is incumbent on defendant to answer the notice for opposition by admitting or denying the allegations contained in each paragraph. Ordinarily, a defendant will use the same paragraph numbering format found in the complaint (notice),

i.e. eight. If defendant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, he should so state and this will have the effect of a denial.

In view of the foregoing, defendant is allowed until THIRTY DAYS from the mailing date of this order in which to file an answer which complies with Fed. R. Civ. P. 8.[2]

NATURE OF AN OPPOSITION PROCEEDING

Defendant is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts

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[2] Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged.

Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

on _____(Date)
_____(Signature)
_____(Typed or printed name)

underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.**

REQUIREMENT FOR SERVICE ON ADVERSE PARTY OF ALL PAPERS FILED

Defendant's response to the notice of opposition and notice of default does not indicate proof of service of a copy of the response on counsel for opposer as required by Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which defendant may subsequently file in this proceeding, including its answer to the notice for opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with

Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

> The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated.

LEGAL REPRESENTATION IS STRONGLY ENCOURAGED

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 an opposition or opposition proceeding 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.

All parties may refer to the The Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark

Rules of Practice, both available on the USPTO website, *www.uspto.gov*.

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.

ALL PARTIES MUST COMPLY WITH BOARD DEADLINES; PROCEEDINGS SUSPENDED:

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). Defendant is strongly advised to obtain counsel to present his interest in this proceeding but must, in any event, file an answer to the notice for opposition **THIRTY DAYS** from the mailing date of this order, as set forth earlier in this order. Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**December 10, 2007**
Thirty-day testimony period for party in position of plaintiff to close:	**March 9, 2008**
Thirty-day testimony period for party in position of defendant to close:	**May 8, 2008**
Fifteen-day rebuttal testimony period to close:	**June 22, 2008**

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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