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

Proceeding	91182564
Party	Defendant Duke, Lana
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Attachments	Motion for Extension of Time to File Answer - 3-28-2008.pdf ( 6 pages )(488291 bytes )

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UNITED STATES PATENT AND TRADEMARK OFFICE  
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Sizzler USA Franchise, Inc.	)	
	)	Application Serial No. 78/932669
vs.	)	Opposition No. 91/182564
	)	
Lana Duke	)	

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**MOTION FOR EXTENSION OF TIME TO FILE ANSWER**

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Pursuant to Rule 6(b) of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.127(a), Lana Duke (“Duke” or “Respondent”) hereby requests an extension of time in which to file an answer to the Opposition filed against Duke’s application to register the mark “IF IT DOESN’T SIZZLE, SEND IT BACK” by Sizzler USA Franchise, Inc. (“Sizzler” or “Opponent”). This motion is timely as it is filed before March 31, 2008, the deadline set by the rules for filing an answer.<sup>1</sup>

*Procedural History*

On July 19, 2006, Duke filed an application (the “Application”) to register the mark “IF IT DOESN’T SIZZLE, SEND IT BACK” (the “Mark”) in Class 43 for restaurant services. As grounds for the Application, Duke specified Sections 1(a), 44(d) and 44(e) of the Act.<sup>2</sup> The claims under Section 44 were based upon the registration for the Mark that Duke had obtained in Canada. After several office actions, the Application was approved on December 19, 2007 for

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<sup>1</sup> See Notice of Trial Dates sent February 20, 2008 by the Board.

<sup>2</sup> The application has shown in the Trademark Document Retrieval System now shows that the only filing bases were Section 1(a) and Section 44(d). The original application did specify the additional Section 44(e) and the application was subsequently amended by the Examining Attorney to delete Section 44(e). See Facts, *infra*.

publication and was published in the *Official Gazette* on January 2, 2008. Two different parties, Ruth's Chris Steak House, Inc. ("RCSH") and Sizzler, filed documents at the Trademark Trial and Appeal Board (the "Board" or the "TTAB") regarding this Application.

RCSH filed a request on February 20, 2008 for an extension of time in which to file an opposition which was granted through March 22, 2008. RCSH filed a further extension request on March 20, 2008 which was granted through May 21, 2008. Also on February 20, 2008, Sizzler filed an opposition against the Application. The opposition alleges that the registration of the Mark will infringe on Sizzler's pleaded registrations and cause dilution. Duke must file an answer to this opposition by March 31, 2008.

#### *Facts*

Duke operates two RCSH restaurants in Texas and two RCSH locations in Canada, all pursuant to franchise agreements with RCSH. It is in connection with the offering of these restaurant services that Duke is using the Mark specified in the Application. RCSH learned of the application in December 2007 and upon its publication, contacted Duke to obtain an assignment of the Mark and the underlying Application from Duke to RCSH. Duke agreed in late February to assign the Mark and the Application to RCSH.

Before this could be effected, however, it was determined that the Section 44(e) basis for filing the Application must be removed as RCSH as the assignee would be ineligible to claim the benefits of Section 44(e), thus nullifying any assignment that included that basis. *See Trademark Manual of Examining Procedure* ("TMEP") § 1006. To be able to claim the benefits of Section 44(e), RCSH must establish that the country that issued the relevant registration, which here is Canada, is the assignee's country of origin. *Id.* RCSH's country of origin is the United States, and is, therefore, ineligible to take advantage of the Section 44(e) benefits. Thus, the parties

determined that to have a legitimate assignment to RCSH, Duke must amend the application to remove the Section 44(e) filing basis, while leaving the filing bases under Section 1(a) and Section 44(d)<sup>3</sup>.

On March 6, 2008, Duke filed a request with the USPTO Post Publication Amendments/ Corrections Division to remove the Section 44(e) filing basis from the Application, while leaving the Section 1(a) and Section 44(d) claims intact. Because of the imminent deadline to file the answer to the opposition filed by Sizzler, Duke's counsel also telephoned the Examining Attorney left a message indicating that a request for deletion of the Section 44(e) filing basis had been filed and asking that the deletion be made as soon as possible. The Examining Attorney apparently made the change in the Application even though the Application had already been published for opposition and thus was under the jurisdiction of the Post-Publication Division. It was unclear from the documents in the Trademark Document Retrieval system that this had in fact occurred. Duke had even less clarity on the matter when a few days later the TARR system reported that the request had been converted to a Petition to the Director – without any action or request on the part of Duke. As of today, the TARR system indicates that the application was “Assigned to the Petitions Staff” on March 15, 2008 and it appears that a Petition is still pending, although TARR is showing that the only bases for the application are Section 1(a) and 44(d).

On March 26, 2008, an examiner from the Post-Publication Division staff contacted Duke's counsel requesting clarification as to exactly what was being requested since it appeared that the Examining Attorney had already removed the Section 44(e) basis. Counsel is currently in the process of attempting to determine whether the Section 44(e) basis has indeed been removed and whether the action by the Examining Attorney, apparently without jurisdiction, is still valid such that an assignment from Duke to RCSH can be effected. Obviously, RCSH and Duke are

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<sup>3</sup> RCSH is eligible to take advantage of the benefits under Section 44(d) because it is a US assignee. TMEP § 1006.

loathe to execute an assignment of the Mark and Application that could potentially be null and void in the event it is determined that the action of the Examining Attorney was in fact not final or taken with proper jurisdiction.

*Argument*

**I. Duke requires an extension so that RCSH can take over the full defense of Sizzler's Opposition from the beginning and TTAB resources are not wasted.**

The Board will grant extensions of time in which to take prescribed action upon the request of the party with the deadline, when that party sets forth facts that show good cause to allow it additional time in which to take the necessary action. *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") § 509.01(a). The party must also show that the request is not necessitated by the party's "own lack of diligence or unreasonable delay in taking the required action..." *Id.*

Here, Duke has diligently pursued the necessary actions to make the Application at issue assignable to RCSH. Unfortunately, those efforts have not resulted in the favorable result desired in the time frame allotted by the Board's pleading schedule. To the extent that it is most desirable to Duke and RCSH that RCSH be the sole party in this Opposition from the beginning and have total control over the direction and management of the proceeding, an extension of time in which to file the answer until RCSH has become the assignee of the Application and the Mark is the only way for RCSH and Duke to achieve this goal. Otherwise, Duke will have to file an answer that may or may not comport with RCSH's own litigation strategy, thus hamstringing RCSH down the road in terms of possible claims, defenses and other unforeseeable issues. An extension of time is therefore warranted. Permitting a brief extension will also avoid a waste of TTAB time and resources in addressing motions or other procedural matters during the

remaining period while Duke will still be the owner of the mark, and avoid unnecessarily complicating the record.

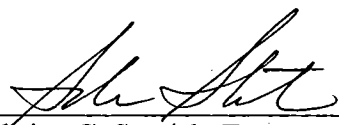
Duke's counsel, along with RCSH's counsel, attempted to contact and left a voice mail with Opposer's counsel to seek a mutual suspension or uncontested motion for extension of time. However, Opposer's counsel has not responded. Thus, Duke is filing this motion unilaterally.

*Conclusion*

Duke has set forth, with particularity, facts that show she has good cause to seek and receive this extension. Duke has diligently pursued the necessary avenues to avoid this contingency, but due to factors outside of her control, has been unable to complete the necessary process in the time required. Therefore, Duke respectfully requests that the Board GRANT this request for an extension of time in which to file an answer until fifteen (15) business days after recordation of the assignment of the Mark and Application from Duke to RCSH has been made at the PTO. Duke and RCSH will be prepared to promptly execute and record such assignment as soon as the Section 44(e) issues have been resolved.

Respectfully submitted,  
SHERIDAN ROSS P.C.

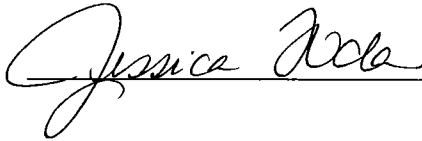
Date: 3-28-08

  
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**CERTIFICATE OF SERVICE**

I, Jessica Foda, do hereby certify that a copy of the foregoing Motion For Extension of Time to File Answer was served by first class mail, postage prepaid, on the 28<sup>th</sup> day of March 2008, directed to:

Rod S. Berman  
Jessica C. Bromall  
Jeffer, Mangels, Butler & Marmaro LLP  
1900 Avenue of the Stars, Seventh Floor  
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