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

Proceeding	91205312
Party	Defendant Norman W. McHugh
Correspondence Address	NORMAN W. MCHUGH NORMAN W. MCHUGH 280 W 113TH ST APT 5A NEW YORK, NY 10026-3399 UNITED STATES info@sundaesermon.com
Submission	Other Motions/Papers
Filer's Name	Kimberly N. Reddick
Filer's e-mail	kreddidk@rediplaw.com, djstormin@sundaesermon.com
Signature	/knr/
Date	08/10/2012
Attachments	Motion to Set Aside Notice of Default.pdf (11 pages)(211403 bytes)

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

In re Application of)
Norman W. McHugh)
Appl. No.: 85/391,069)
Published: May 1, 2012)
Trademark: SUNDAE SERMON)

Musical Directions)

 Opposer,)

 v.)

Norman W. McHugh)

 Applicant.)

Opposition No. 91205312

**Motion to Set Aside Notice of Default
and for Leave to File Answer Pending Disposition of Motion to Dismiss**

Applicant Norman W. McHugh, an individual, with his address at 280 West 113th St., #5A, New York, NY 10026 (hereinafter “Applicant”), hereby files this Motion to Set Aside the Notice of Default entered on July 13, 2012, in connection with U.S. Trademark Application No. 85/391,069 for the mark SUNDAE SERMON. Contemporaneously with the filing of this Motion, Applicant is filing a Motion to Dismiss the opposition on grounds of Opposer’s Failure of Service. Therefore, Applicant requests leave to file its Answer pending the disposition of the Motion to Dismiss.

I. The Motion to Set Aside the Notice of Default is for Good Cause.

The standard for setting aside a Notice of Default is good cause. Good cause for failure to file a timely answer is generally found when (1) the delay in filing the answer was not the result of willful conduct or gross neglect on the part of the Applicant, (2) the Opposer will not be substantially prejudiced by the delay, and (3) the Applicant has a meritorious defense to the action. *TBMP* §312.02. Applicant satisfies all of these elements.

A. Applicant's Delay in Filing the Answer was not Willful and did not Constitute Gross Neglect

The Notice of Opposition was filed electronically on May 25, 2012. The certificate of service indicates that the Opposer served a copy of the filing via facsimile or email (by agreement only) on May 25, 2012. However, Applicant neither consented to electronic service, nor received service from Opposer by facsimile, email or any other means. In fact, Applicant had absolutely no contact with the Opposer about the matter prior to the filing of the Notice of Opposition. Accordingly, Applicant submits that the Notice of Opposition should be dismissed as a nullity.

Pursuant to 37 C.F.R. §2.101(a) an opposition proceeding is commenced by filing a timely Notice of Opposition with the required fee. The notice must include proof of service on the applicant, as detailed in §§2.101(b) and 2.119. According to §2.119(b)(6), Service may be effectuated by electronic transmission, such as email or facsimile, only when **mutually agreed upon by the parties**. Opposer did not contact Applicant McHugh prior to filing its Notice of Opposition to discuss its proposed claims or to request consent to electronic service of process. Not only did Opposer not request consent, Opposer never served an electronic copy of the Notice of Opposition, as indicated in its certificate of service. Proof of service assumes actual service

on the Applicant. *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008). Accordingly, Opposer's service did not comply with 2.119, and the opposition should not have been instituted.

Notwithstanding the foregoing, Applicant received a Notice regarding the institution of the proceedings from the Trademark Trial and Appeal Board (hereinafter "the Board") on May 25, 2012. Applicant then forwarded the Notice to his attorney who had been assisting him with other business related matters, Vivian Tozaki. Once he forwarded the Notice of Opposition to the attorney, he believed she would handle the matter and contact him when necessary. Applicant was not made aware that his attorney did not respond to the Notice of Opposition, until he received the Notice of Default via email from the Board on July 13, 2012. Applicant contacted the Examining Attorney for his application, Carolyn Cataldo, via email about the Notice he received on even date, stating that he believed his attorney responded to the opposition papers. The Examining Attorney replied to the email on July 15, stating that the Office had received no response and directing Applicant to contact the Board. A copy of the email correspondence between the Examining Attorney and Applicant is attached as Exhibit A. Applicant subsequently retained Red IP Law to handle this opposition and take over prosecution of its application.

As a pro se Applicant, McHugh did not understand or appreciate the deadlines set by the Board and relied on his attorney to timely file the appropriate response. However, there was apparently a grave miscommunication between Applicant and his previous counsel, such that the Notice of Opposition was not addressed in a timely fashion and an Answer was never filed. As a result, it is clear that Applicant did not intentionally disregard the deadline to respond.

In view of the foregoing, Applicant's failure to timely answer was not willful and did not constitute gross negligence.

B. The Opposer will not be substantially prejudiced by the delay

In this case, the Opposer will not be prejudiced by the delay in response. Applicant's delay in responding to the Notice of Opposition has not caused Opposer to expend any time, money or resources to compel Applicant's Answer. If the Board sets aside the Notice of Default, Opposer will have ample opportunity to make its case. Further, Applicant's delay in filing its Answer is due in part to Opposer's own failure to effectuate proper service and satisfy the requirements for instituting an opposition proceeding. Accordingly, it is submitted that Opposer has not been and will not be substantially prejudiced.

C. Applicant has a meritorious defense to the Notice of Opposition

The showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint. *TBMP* §312.02. Applicant has a meritorious defense to the Notice of Opposition in that it is the exclusive owner of the SUNDAE SERMON mark, Opposer has no legitimate rights in the mark and has not and will not suffer any loss due to registration of Applicant's mark. These and other defenses will be set forth in Applicant's Answer. However, at this time, it is believed that the opposition is null and void, as Opposer failed to effectuate service to Applicant's address of record. Instead, Opposer falsely set forth in its certificate of service that it was authorized to serve Applicant through electronic means, when it in fact had no such authorization. Further, Opposer never served the Notice of Opposition, electronically or otherwise. Accordingly, Applicant is filing a Motion to Dismiss the opposition on these grounds. Should Applicant's

Motion to Dismiss be denied, Applicant requests leave to file its answer to the Notice of Opposition according to a scheduling order to be set by the Board.

According to the Trademark Trial and Appeal Board Manual of Procedure, the Board may exercise its sound discretion in determining with to enter a Default Judgment. *TBMP* §312.02.

“In exercising that discretion, the Board must be mindful of the fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant.”

Keeping in mind that it is the policy of the law to decide cases on their merits, the Board should liberally construe the statute in the instant matter and grant the Motion. Applicant has demonstrated good cause for why the answer was not timely filed. Applicant was not properly served, its attorney never filed any responsive papers, Opposer will not be substantially prejudiced, Applicant has a meritorious defense and is contemporaneously filing responsive papers to the Notice of Opposition in the form of a Motion to Dismiss for Lack of Service. In view of the foregoing, Applicant respectfully prays that the Motion to Set Aside Default be granted.

II. Applicant Requests Leave to File its Answer, Pending Disposition of the Motion to Dismiss.

Applicant believes that Opposer has failed to properly serve Applicant pursuant to 37 C.F.R. 2.101 and 2.119. Further, it is believed that the Opposer’s lack of service is incurable, given that the opposition period has expired and that no extension requests were filed. Consequently, Applicant believes it may not be necessary to file an Answer in this case, as it should be dismissed as a nullity. Applicant respectfully requests that the Board grant Applicant leave to file its Answer, should it become necessary, pending disposition of the Motion to


Dismiss. Should the motion be denied, Applicant is prepared to file its Answer and defend the Opposition according to a scheduling order set by the Board.

WHEREFORE, Applicant respectfully prays that Motion to Set Aside the Notice of Default and for leave to file the Answer, pending disposition of the Motion to Dismiss, be granted.

Respectfully submitted,

NORMAN W. MCHUGH

Dated: August 10, 2012

By: 

Kimberly N. Reddick
Attorney for Applicant, DC Bar

RED IP LAW PLLC
1701 Pennsylvania Ave., NW
Suite 300
Washington, DC 20006
Telephone: (202) 957-0500
E-mail: kreddick@rediplaw.com

CERTIFICATE OF SERVICE

I certify that on this 10th day of August, 2012, a copy of the foregoing Motion to Set Aside Notice of Default and for Leave to File Answer was served, by First Class Mail, on Opposer at the following address of record:

Ms. Marsh Reid-Burnett
Musical Directions
244 Madison Ave., Suite 172
New York, NY 10016



Kimberly Reddick, Esq.

EXHIBIT A

----- Original Message -----

Subject: Re: [FWD: TTAB Order - Do Not Reply By E-mail. Mail Box Not

Monitored - proceeding 91205312]

From: "Sundae Sermon Events" <info@sundaesermon.com>

Date: Mon, July 16, 2012 8:33 am

To: "Cataldo, Carolyn" <Carolyn.Pendleton@USPTO.GOV>

Thanks again for all your help
please pardon typos

From: "Cataldo, Carolyn" <Carolyn.Pendleton@USPTO.GOV>

Date: Sun, 15 Jul 2012 17:56:05 -0400

To: 'info@sundaesermon.com' <info@sundaesermon.com>

Subject: RE: [FWD: TTAB Order - Do Not Reply By E-mail. Mail Box Not Monitored - proceeding 91205312]

Hi Norman:

Unfortunately, there is nothing in the electronic file that shows a response was filed. You do have 30 days from July 13 to rectify this situation. Your application is out of my jurisdiction, and is now in the jurisdiction of the Trademark Trial and Appeal Board (TTAB). You, or your attorney, will need to contact them directly regarding this matter. The attorney at the TTAB who is handling your case is:

GEORGE

POLOGEO (571)272-9659

RGIS

Good luck,
Carolyn

From: info@sundaesermon.com
[<mailto:info@sundaesermon.com>]

Sent: Friday, July 13, 2012 2:44 PM
To: Cataldo, Carolyn
Subject: [FWD: TTAB Order - Do Not Reply By E-mail. Mail Box Not Monitored - proceeding 91205312]

Hi Carolyn,

I've forwarded this email in regards to a possible default of my application. It states that I didn't respond but my attorney has responded to the oppositions attorney. Please can you advise me.

Norman McHugh
Sundae Sermon
85391069

----- Original Message -----

Subject: TTAB Order - Do Not Reply By E-mail. Mail Box Not Monitored - proceeding 91205312
From: ESTTA@uspto.gov
Date: Fri, July 13, 2012 7:50 am
To: info@sundaesermon.com

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

Proceeding No. 91205312

07/13/2012

IMPORTANT NOTICE

The Trademark Trial and Appeal Board (TTAB) has issued an order in this proceeding. To see the order, click on the link below or paste the URL into the address box of your browser.

<http://ttabvue.uspto.gov/ttabvue/v?>

pno=91205312&pty=OPP&eno=4

This order contains important information which you should review immediately. A response may be required and trial dates may have changed. In some cases, this will be the only notification of this order you will receive. An e-mail copy of the order itself will not be sent.

If you are unable to view the order, call the TTAB for technical assistance at 571-272-8500. Do not use the reply button to respond to this message by e-mail.

The entire public file of this proceeding may be viewed at <http://ttabvue.uspto.gov>.

Papers in Board proceedings may be filed electronically with ESTTA at <http://estta.uspto.gov>.

Further information is available at the TTABs web page at [http:// www.uspto.gov](http://www.uspto.gov).