

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: July 7, 2017

Cancellation No. 92065911

Joseph Valenti

v.

Nero World, LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

Proceedings are suspended pending the disposition of Respondent's motion (filed May 29, 2017) to dismiss the notice of opposition for failure to state a claim for relief.¹

On June 19, 2017, Petitioner filed three separate papers: a motion to deny the motion to dismiss for failure to serve a copy on Petitioner; a motion for default judgment; and a substantive response to the motion to dismiss.

The motion for default judgment is procedurally inappropriate and will be given no consideration. Respondent was entitled to challenge the legal sufficiency of the notice of opposition in lieu of filing an answer. *See* Fed. R. Civ. P. 12(b). Because the deadline for filing an answer or motion is set by rule, and the deadline for filing a notice of opposition is set by statute, the failure to provide proof of service for a motion filed in lieu of an answer does not make Respondent's motion a nullity, but the failure

¹ Respondent's change of address also filed May 29, 2017 is noted and the Board records have been updated to reflect this change.

to serve a notice of opposition does make the notice of opposition a nullity. *See Springfield Inc. v. XD*, 86 USPQ2d 1063 (TTAB 2008) (for lack of service “opposer's notice of opposition should not have received a filing date, and this proceeding should not have been instituted”). The filing of the motion was sufficient to avoid default.

The motion to deny the motion to dismiss for failure to serve a copy on Petitioner also is procedurally inappropriate and will be given no consideration. While Trademark Rule 2.119 requires service, the rule does not require or suggest that the failure to serve a single paper is a potentially-dispositive action which cuts off Respondent's ability to defend the registration. Rather, the Board has the discretion to order the movant to serve the motion and to reset the non-movant's time to respond before considering the merits of the motion. Of course, the repeated failure to serve papers, like any deliberate violation of the Board's rules, may result in sanctions, including entry of judgment.

Here, Petitioner filed a substantive response to the motion to dismiss. In view of Petitioner's acknowledgement of the motion to dismiss, the Board sees no need to require service. Accordingly, as of the filing date of the motion to dismiss, proceedings are suspended pending disposition of the motion.² Any paper filed during the pendency of this motion which is not germane thereto will be given no consideration. *See* Trademark Rule 2.127(d).

² When a party timely files a potentially dispositive motion, the proceeding is suspended with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order. *See* Trademark Rule 2.127(d).

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The parties should note that the schedule for the discovery conference, initial disclosures and discovery is also suspended by this order and will be reset in the event that the Board resumes proceedings. TBMP § 401.01.

The motion to dismiss will be decided in due course.