

D PETER HOCHBERG CO LPA

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NO:212

Attorney Docket DX-3 (#90545)

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

In the Matter of:

Application Serial No. 75/701,707
Mark: Drawing of a Marine Heat Exchanger
Published in the Official Gazette at Page TM 400 on May 9, 2000

DURAMAX MARINE, LLC)
)
Opposer,)
)
v.)
)
R.W. FERNSTRUM & COMPANY,)
)
Applicant)

Opposition No. 119,899

03 MAR 17 AM 9:30
FEDERAL BUREAU OF INVESTIGATION

NOTICE OF DEPOSITION

To: Samuel D. Littlepage, Esq. Via Facsimile/Mail Confirmation: 1 (202) 659-1559
Dickinson Wright PLLC
1901 "L" Street, N.W., Suite 800
Washington, D.C. 20036-3541

Attorneys for Applicant

PLEASE TAKE NOTICE that Opposer Duramax Marine, LLC, pursuant to Rule 30 of the Federal Rules of Civil Procedure, will take the deposition, upon oral examination, of Paul W. Fernstrum commencing on April 22, 2003, beginning at 9:00 o'clock, a.m., at the Law Offices of Frederick C. Kramer, Suite 201, Suntrust Bank Building, 950 North Collier Boulevard, Marco Island, Florida 34145, for use in the trial of the above-captioned matter. Such deposition is for use in preparation for trial in the above-captioned matter and such other purposes permitted by applicable rules.

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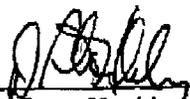
The deposition will take place before a Notary Public or other officer authorized by law to administer oaths and will continue from day to day until completed, with such adjournments as to time and place as may be necessary or mutually agreed upon by counsel for the parties.

You are invited to attend and cross-examine the witness.

Dated this 7th day of March, 2003.

Date: March 7, 2003

By: _____


D. Peter Hochberg
Counsel for Opposer
D. Peter Hochberg Co., L.P.A.
The Baker Building 6th floor
1940 East Sixth Street
Cleveland, Ohio 44114
(216) 771-3800

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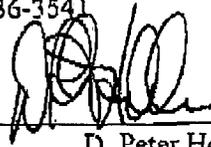
CERTIFICATE OF SERVICE

I hereby certify that the foregoing "NOTICE OF DEPOSITION" was served on the attorney for applicant via facsimile and first class, postage prepaid, U.S. mail on the date noted below to:

Samuel D. Littlepage, Esq.
Dickinson Wright PLLC
1901 "L" Street, N.W., Suite 800
Washington, D.C. 20036-3541

Date: March 7, 2003

By: _____


D. Peter Hochberg

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OPPOSER'S REQUEST FOR PRODUCTION OF DOCUMENTS

Please take notice that pursuant to Rule 30(b)(5) and 34 of the Federal Rules of Civil Procedure, Deponent Paul Fernstrum, an employee of Applicant, R. W. FERNSTRUM & COMPANY, is required to produce documents and tangible things as requested below at the deposition examination.

The following request for production of documents is to be interpreted and responded to in accordance with the "Definitions" set forth below:

DEFINITIONS

The following definitions apply to each Request:

- a) The term "document" as used in these Requests includes (without limitation and irrespective of whether original, copy or draft) all documents, objects, contracts, agreements, memoranda, assignments, licenses, minutes of meetings, books of

account, order, statements, computation sheets, reports, photographs, drawings of any kind, layouts, art work, tracings, blueprints, sketches, charts, schematic diagrams, catalogs, brochures, computer programs and print outs and tapes and magnetic disks, books, papers, files, purchase orders, bills, invoices, accounts, canceled checks, ledgers, correspondence, inter-office communications, communications of any kind, letters, notes (in pencil, ink, or typewritten), including notes of records of oral communications, notebooks, telcxc's, telegrams (and other messages) audio or video tapes, and advertising or promotional material, instructions, or material of any kind, whether or not the document is privileged or within Applicant's possession, control, or custody, as well as all drafts thereof and all copies bearing any notations not appearing on the original.

- b) "Opposer" means Duramax Marine, I.I.C.
- c) "Applicant" and "Fernstrum" means Applicant, R.W.

FERNSTRUM & COMPANY, including related companies within the meaning of Section 45(d) of the Trademark Act of 1946 (15 U.S.C. 1127), its predecessors in interest, successors, divisions, subsidiaries, affiliates, licensees, franchises and all officers, directors, employees, attorneys, consultants, agents, servants, accountants and all other persons or entities acting on behalf of or representing R.W. FERNSTRUM & COMPANY.

- d) "Person affiliated with Fernstrum" means any person who is now or has ever been an officer or director or, employed by, under the control of, under contract with, or a representative of Fernstrum.

REQUESTS

1. All advertising and promotional material distributed by and used by Applicant featuring a picture, photograph or drawing of Applicant's one-piece keel cooler(s).
2. All advertising and promotional material distributed by and used by Applicant featuring a picture, photograph or drawing of Applicant's one-piece keel cooler(s) and comparing and/or contrasting Applicant's one-piece keel cooler(s) with that of Opposer or with any other competitor.
3. All documents that describe or explain the making, manufacturing, production, or construction of Applicant's one-piece keel cooler(s) having rectangular fore and aft headers.
4. All documents that describe or explain any design, making, manufacturing, production, or construction of Applicant's one-piece keel cooler(s) having rectangular fore and aft headers.
5. All drawings, blue prints, printed designs, technical specifications and photographs used by Applicant in connection with the design, manufacture, inspection and sale of keel coolers of Applicant.
6. All documents that describe or explain the problems or perceived problems that will be encountered by Applicant in advertising and promoting its one-piece keel cooler(s) if Opposer advertises or promotes its one-piece keel cooler with beveled fore and aft headers, but not depicting the beveled fore and aft headers.

7. All documents explaining why one-piece keel coolers having rectangular fore and aft headers are superior in function to one-piece keel coolers having beveled fore and aft headers.

8. All documents explaining why one-piece keel coolers having beveled fore and aft headers are not superior in function to one-piece keel coolers having rectangular fore and aft headers.

9. All documents explaining why one-piece keel coolers having beveled fore and aft headers are superior in function to one-piece keel coolers having rectangular fore and aft headers.

10. All documents explaining why one-piece keel coolers having rectangular fore and aft headers are not superior in function to one-piece keel coolers having beveled fore and aft headers.

11. All documents (including invoices) evidencing the sale of one-piece keel coolers having rectangular headers since August 5, 1999.

12. All documents objecting to the design or configuration of the one-piece keel coolers having beveled fore and aft headers of Opposer.

13. All documents related to Applicant, or any person associated with Applicant or with any related company of Applicant objecting to any advertising, promotions, pictures, photographs or drawings of the one-piece keel cooler having beveled fore and aft headers of Opposer.

14. All documents relating to violations by R.W. Fernstrum & Company of the Settlement and Mutual Release Agreement signed by R.W. Fernstrum & Company, East Park Radiator & Battery Shop, Inc., Duramax, Inc., and Donovan Marine, L.L.C.

15. All documents relating to violations by East Park Radiator & Battery Shop, Inc., Duramax, Inc., and/or Donovan Marine, L.L.C. of the Settlement and Mutual Release Agreement signed by R.W. Fernstrum & Company, East Park Radiator & Battery Shop, Inc., Duramax, Inc., and Donovan Marine, LLC.

16. All documents explaining or referring to why Opposer would or would not be able to show drawings or photographs of its one-piece keel coolers if the mark in application Serial No. 75/701,707 were registered.

17. All documents explaining or referring to why Applicant would or would not be bring suit upon Opposer for displaying and demonstrating Opposer's one-piece keel cooler if the mark in application Serial No. 75/701,707 were registered.

18. All documents explaining or referring to why Applicant would or would not be bring suit upon Opposer for trademark infringement for publishing photographs and/or drawings of Opposer's one-piece keel cooler if the mark in application Serial No. 75/701,707 were registered.

19. All surveys, market studies, competitive research and/or investigations relating to or referring to Applicant's keel cooler(s) that is the subject of the mark in application Serial No. 75/701,707.

20. All surveys, market studies, competitive research and/or investigations referring to any comparisons and/or contrasts between Applicant's keel cooler(s) having rectangular fore and aft headers and the one-piece keel cooler having beveled fore and aft headers of Opposer.

21. All internal memoranda prepared by any present or former director, officer, manager, partner, or employee of Applicant, or any company related to

Applicant, which refers to, or in any manner mentions, Applicant's mark in application Serial No. 75/701,707.

22. All photographs, pictures, or drawings of Opposer's one-piece keel coolers which Applicant believes Opposer would not be prohibited from showing if Applicant is allowed to obtain a federal trademark registration for the drawing that is the subject of application Serial No. 75/701,707.

23. All documents showing sketches, drawings or pictures used for the manufacture by Applicant of all or part of its keel cooler(s).

24. All documents showing sketches, drawings or pictures used for the inspection of keel coolers manufactured by Applicant of all or part of its keel cooler(s).

25. All documents which have been distributed to or by Applicant's employees, officers and/or sales representatives and which show sketches, drawings or pictures of all or part of its keel cooler(s).

26. All sketches or drawings in Applicant's possession or under its control relating to "retro fit" keel coolers.

27. All documents concerning, relating to or referring to any visual similarities between a keel cooler of Applicant and a keel cooler of Opposer.

28. All internal memoranda prepared by any present or former director, officer, manager, partner or employee of Applicant which refers to the configuration of Applicant's keel cooler(s).

29. All internal memoranda prepared by any present or former director, officer, manager, partner or employee of Applicant which refers to the configuration of Opposer's keel cooler.

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- 30. All different drawings and "specs" of the keel cooler(s) of Applicant.
- 31. All documents setting forth the comments of any third parties concerning (a) the design or visual appearance of the Applicant's keel cooler(s); (b) the design or visual appearance of Opposer's keel cooler; and (c) any similarities between the Applicant's keel cooler(s) and Opposer's keel cooler.
- 32. All "communications" between Applicant and any person concerning or relating to any investigation to be conducted by, or on behalf of, Applicant regarding trade or consumer perception of: (a) Applicant's keel cooler(s); or (b) Opposer's keel cooler.

Respectfully submitted,

Date: March 7, 2003

By:  _____
 D. Peter Hochberg
 Reg. No. 24,603

D. PETER HOCHBERG CO., L.P.A.
 The Baker Building - 6th Floor
 1940 East 6th Street
 Cleveland, Ohio 44114
 (216) 771-3800

DPII/ck

AS FOR A FIRST AFFIRMATIVE DEFENSE

The Notice of Opposition fails to state a cause of action upon which relief may be granted in law or in equity.

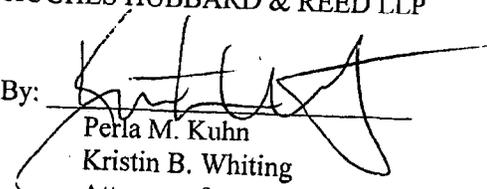
WHEREFORE, Applicant respectfully requests that the Board dismiss the Notice of Opposition in its entirety and allow Applicant's mark CABSHA to subsist on the Principal Register.

Dated: New York, New York
January 13, 2003

Respectfully submitted,

HUGHES HUBBARD & REED LLP

By:


Perla M. Kuhn
Kristin B. Whiting
Attorneys for Applicant

One Battery Park Plaza
New York, New York 10004
(212) 837-6550

Sections 8 and 15 declarations were filed; and lacks knowledge or information sufficient to form a belief as to whether the Registration is in fact "incontestable."

3. Denies the allegations contained in paragraph 3 of the Notice of Opposition.
4. States that Opposer's allegation that "There is no issue as to priority" is a legal conclusion as to which no response is required; admits that Applicant filed its Intent to Use Application on July 30, 2001 and that the United States Patent and Trademark Office records dated August 6, 2002 and attached as Exhibit A to the Notice of Opposition, purport to show that Opposer's Registration No. 1,302,879 was granted on October 30, 1984, that the date of the first use in commerce for that mark was on December 29, 1982; lacks knowledge or information sufficient to form a belief as to the actual date of first use for Opposer's Mark and denies the remaining allegations contained in paragraph 4 of the Notice of Opposition.
5. Denies that Arcor filed an application for CABSHA "Notwithstanding Health Valley's long prior right in the CASBAH Mark," and admits the remaining allegations in paragraph 5 of the Notice of Opposition.
6. Denies the allegations contained in paragraph 6 of the Notice of Opposition.
7. Denies the allegations contained in paragraph 7 of the Notice of Opposition.
8. Admits that Arcor would obtain a prima facie exclusive right to use CASHBA for "Chocolate, chocolate bars, chocolate covered nuts, chocolate candies, chocolate coated cookies, wafers, coated sandwich cookies, cookies, bonbons in International Class 30" if its application for registration is granted, and denies the remaining allegations contained in paragraph 8 of the Notice of Opposition.