

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

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

Opposition No. 119,899

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TRADEMARK TRIAL AND APPEAL BOARD

**APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE**

Applicant R. W. Fernstrum & Company, by its attorneys, moves to strike Sections D and F of Opposer Duramax Marine, LLC's Notice of Reliance filed May 28, 2004 (the last day of Opposer's testimony period). This motion to strike is based on procedural defects in Opposer's Notice of Reliance and, therefore, a motion to strike is appropriate. TBMP §§532 and 707.02(b) (2<sup>nd</sup> ed. 2003). Applicant reserves its right to raise substantive objections to the evidence in its brief on the case. *Id.*

**I. Section D Of Opposer's Notice Of Reliance**

In Section D of its Notice of Reliance, Opposer seeks to introduce into evidence documents produced in response to Opposer's Document Request No. 1 and documents produced in response to Opposer's Second Request For Production Of Documents pursuant to Trademark Rule 2.120(k). First, there is no Rule 2.120(k).

Second, documents produced in response to a request for production of documents are not admissible through a notice of reliance. Trademark Rule 2.120(j)(3)(ii).

[A] party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by a notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR §2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding - - see TBMP §§704.04 and 704.08).

TBMP §704.11, p. 700-474 (2<sup>nd</sup> ed. 2003).

In view of the foregoing, the documents attached as part of Section D of Opposer's Notice Of Reliance should be stricken and given no consideration.

## II. Section F Of Opposer's Notice Of Reliance

Opposer seeks to introduce official records pursuant to Trademark Rule 2.122(e).

Applicant moves to strike the following "official records":

1. Court's Ruling Regarding Motion for Preliminary Injunction, Case No. 2:00-CV-194, dated December 5, 2000, Western District of Michigan;
2. Petition for Damages, Civil District Court for the Parish of Orleans – Case No. 97-20937;
3. Order and Reasons, United States District Court, Eastern District of Louisiana – Case No. 97-3974;
4. Complaint for Trademark Infringement, Trade Dress Infringement, Unfair Competition, and Dilution, Civil Action No. 97-3657, dated November 24, 1997;
5. Complaint – Civil Action No. 2:00-CV-194, United States District Court, Western District of Michigan;

6. Donovan Marine, Inc.'s First Amended and Supplemented Complaint, Civil Action No. 97-3794, United States District Court, Eastern District of Louisiana; and,

7. R.W. Fernstrum & Company's Answer and Counterclaim Against Donovan Marine, Inc., Civil Action No. 97-3794, United States District Court, Eastern District of Louisiana.

Trademark Rule 2. 122(e) provides, in relevant part, as follows:

The notice shall specify the printed publication . . . or the official records and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence.

In its Notice of Reliance, Opposer failed to specify the pages to be read and to indicate the relevance of the material being offered. The requirements that Opposer specify the pages to be read and to indicate the relevance of the material being offered is especially pertinent in the case *sub judice* because the relevance of these "official records" is not readily apparent. None of the "official records" were referenced in Opposer's Notice Of Opposition (As Amended), nor do these "official records" reference the mark sought to be registered. *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 U.S.P.Q. 881, 883 (T.T.A.B. 1979).

In addition, the "official records" have not been properly authenticated. "Official records" may be authenticated in the following ways:

1. FED.R.CIV.P. 44(a) provides that an official record kept within the United States may be evidenced by an "official publication thereof or by a copy attested by the officer having the legal custody of the record";

2. FRE 901(b)(7) provides that "public records" may be authenticated by evidence that a writing is from the public office where items of this nature are kept.

The proponent of the evidence need only show that the office from which the records were taken is the legal custodian of the records.

Legal custodianship can be shown in the following ways:

- A certificate of authority from the public office.
- The testimony of an officer who is authorized to attest to custodianship.
- The testimony of a witness with knowledge that the evidence is in fact from a public office authorized to keep such a record.

5 Weinstein's Federal Evidence §901.10[2] (2004); and,

3. FRE 902 authorizes the Board to treat a certified copy of a public record as properly authenticated.

Opposer did not file certified copies of the "official records", nor has Opposer introduced the testimony or a certificate from the custodian of records authenticating the documents. Accordingly, the "official records" have not been properly authenticated. *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 U.S.P.Q. 658, 664 (T.T.A.B. 1977) (official records comprising a deed of realty and confirmatory assignment were not properly authenticated and, therefore, were not considered as part of the record).

Moreover, there is nothing in the record to indicate that the "official records" came from the records of the relevant courts as opposed to being Opposer's own file copies. The "official records" referred to Rule 2.122(e) are records prepared by a public

Opposition No. 119,899

officer in the performance of his/her duty. *Hard Rock Café International (USA) Inc. v. Elsea*, 56 U.S.P.Q.2d 1504, 1058 (T.T.A. B. 2000) (applicant's file copy of brief filed in a Board proceeding is not an official record); *The Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 U.S.P.Q. 579, 580 n.5 (T.T.A.B. 1979); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 U.S.P.Q. 905, 906, n.5 (T.T.A.B. 1985).

In view of the facts that Opposer has not indicated the pages of the "official records" to read, has not indicated the relevance of the "official records", and has not properly authenticated the "official records", Applicant's Motion To Strike Opposer's Notice of Reliance should be granted and the "official records" should be given no consideration.

### III. Conclusion

For the reasons set forth above, Applicant's Motion To Strike Opposer's Notice Of Reliance should be granted and the documents attached in Section D and the "official records" attached in Section F of the Notice Of Reliance should be given no consideration.

**R.W. FERNSTRUM & COMPANY**

Date: June 3, 2004



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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on this 4<sup>th</sup> day of June, 2004, a true and correct copy of the foregoing ***APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE*** was served via certified U.S. mail, return receipt requested, on:

D. Peter Hochberg, Esquire  
**D. Peter Hochberg Co., L.P.A.**  
The Baker Building  
Sixth Floor  
1940 East Sixth Street  
Cleveland, Ohio 44114

A handwritten signature in cursive script, appearing to read "Regina Matz", is written over a horizontal line.