

**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.)	Opposition No. 119,899
)	
R.W. FERNSTRUM & COMPANY,)	
)	
Applicant)	

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO STRIKE OPPOSER’S
NOTICE OF RELIANCE**

Opposer Duramax Marine, L.L.C. (hereinafter referred to as “Duramax Marine” or “Opposer”), through its undersigned counsel, hereby responds to Applicant R.W. Fernstrum & Company’s (hereinafter referred to as “Fernstrum” or “Applicant”) brief entitled “Applicant’s Motion to Strike Opposer’s Notice of Reliance.”

I. Section D of Opposer’s Notice of Reliance

Applicant’s attorneys state in section I of their brief that Opposer seeks to introduce into evidence documents produced in response to Opposer’s Second Request for Production of Documents. They further state that said documents produced in



response to a request for production of documents are not admissible through a notice of reliance.

While it has been held that a party may not introduce into evidence by notice of reliance alone documents produced in response to a request for production of documents and things, the Board has also held that such documents are admissible pursuant to Trademark Rule 37 CFR 2.120(j)(3)(i), if they are produced for inspection by a party in lieu of answering interrogatories. *M-Tek, Inc. v. CVP Systems, Inc.*, 17 USPQ2d 1070, 1073 (T.T.A.B. 1990). In this instance, the documents attached as part of Section D of Opposer's Notice of Reliance were produced in response to Opposer's interrogatories. (see Document entitled "Applicant's Revised Response to Opposer's First Set of Interrogatories and Initial Requests for Production of Documents to Applicant" at tab D of Opposer's Notice of Reliance, where it states "All documents identified or requested to be identified in response to Interrogatory Nos. 1 through 32 ... and all documents to which Applicant referred in answering those interrogatories," a copy of which is also attached herewith as Exhibit A).

It is also the practice of the Board if, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party which filed the notice of reliance time within which to cure the defect. (see T.B.M.P. §532, p. 123). Accordingly, Opposer should be granted an opportunity to correct any deficiencies in its notice of reliance, such as 20 days from the mailing date of the Board's order on this matter. *M-Tek, Inc. v. CVP Systems, Inc.* at 1073.

In addition and importantly, the documents attached as part of Section D of Opposer's Notice of Reliance are also entered into evidence as part of the discovery deposition of R.W. Fernstrum & Company under F.R.C.P. 30(b)(6) by Sean Fernstrum, Vice President of Operations for R.W. Fernstrum & Company, and attached as part of Section E of Opposer's Notice of Reliance, to which Applicant's counsel did not object. 37 CFR 2.120(j)(1) provides that the discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, may be offered in evidence by an adverse party. 37 CFR 2.120(j)(3)(i) provides that a discovery deposition which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed. See also TBMP §704.09, p. 72-75 (2nd ed. 2003). Moreover, Applicant's counsel stipulated as to the authenticity of these documents during Sean Fernstrum's deposition (page 202, lines 5-9 (Vol. I), a copy of which is also attached herewith as Exhibit B).

In view of the foregoing, the documents attached as part of Section D of Opposer's Notice of Reliance should not be stricken and Applicant's Motion to Strike said documents should not be granted. Alternatively, Opposer respectfully submits that Applicant's motion to strike is moot in view of said documents being admissible into evidence as an exhibit to the discovery of R.W. Fernstrum & Company under F.R.C.P. 30(b)(6) by Sean Fernstrum, Vice President of Operations for R.W. Fernstrum & Company, and attached as part of Section E of Opposer's Notice of Reliance.

II. Section F of Opposer's Notice of Reliance

Applicant's attorneys also move the Board, in Section II of their brief, to strike numerous official records from being entered as evidence in the present proceeding.

The documents include the following:

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.

Opposer submits that in this instance, striking the aforementioned official records is not an appropriate remedy. Alternatively, an opportunity to correct any deficiencies in its notice of reliance is the appropriate remedy and it is respectfully requested that the

same be granted, as discussed above. *M-Tek, Inc.* at 1073. See also *Kal Kan Foods, Inc. v. Hacht Sales and Marketing, Ltd.*, 1999 TTAB LEXIS 558 (T.T.A.B. 1999) where the applicant sought to rely on official records and failed to comply with the requirements for submitting an official record under a notice of reliance in that the copy of the transcript had not been properly authenticated and no statement of relevance was presented. In that instance, “the applicant was allowed time ‘to perfect its supplemental notice of reliance by submitting a certified copy of the transcript,’ along with ‘a statement of its relevance,’” in a timely manner.

The Opposer also wishes to point out that each of the following official records cited in the Notice of Reliance includes the stamp of the respective court on the first page, thereby attesting to each document’s authenticity:

ONR – 2: “Petition for Damages,” Civil District Court for the Parish of Orleans – Case No. 97-20937;

ONR – 3: “Order and Reasons,” United States District Court Eastern District of Louisiana – Case No. 97-3974;

ONR – 10: Complaint for Trademark Infringement, Trade Dress Infringement, Unfair Competition and Dilution, Civil Action No. 97-3657, dated November 24, 1997;

ONR – 11: Complaint – Civil Action No. 2:00-CV-194, Western District of Michigan; and

ONR – 12: Donovan Marine, Inc.’s First Amended and Supplemented Complaint, Civil Action No. 97-3974, Eastern District of Louisiana.

In view of the foregoing, the aforementioned documents attached as part of Section F of Opposer's Notice of Reliance should not be stricken and Applicant's Motion to Strike said documents should not be granted. If deemed necessary by the Board, the Opposer respectfully moves the Board to allow the Opposer the opportunity to acquire and file those official records which the Board states should be properly authenticated, and to state the pages to be read, and to indicate the relevance thereof.

Respectfully submitted,

Date: June 18, 2004
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By: 
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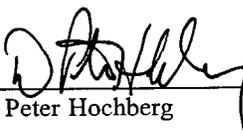
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE" was served via first class, postage prepaid, U.S. mail upon:

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

ATTORNEYS FOR APPLICANT

Date: June 18, 2004

By: 
D. Peter Hochberg

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class mail in an envelope addressed: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA, 22202-3513, on the date noted below:

Date: June 18, 2004

By: 
D. Peter Hochberg

EXHIBIT A

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

DURAMAX MARINE, L.L.C.,

Opposer,

v.

R.W. FERNSTRUM & COMPANY,

Applicant.

Opposition No. 119,899

**APPLICANT'S REVISED RESPONSE TO OPPOSER'S FIRST SET
OF INTERROGATORIES AND INITIAL REQUESTS FOR
PRODUCTION OF DOCUMENTS TO APPLICANT**

Applicant R.W. Fernstrum & Company hereby sets forth its revised response to Opposer's "First Set of Interrogatories And Initial Requests For Production Of Documents" in the above-styled action and states as follows:

GENERAL OBJECTIONS

1. Applicant objects to Opposer's interrogatories and document requests to the extent that they purport to request information protected from disclosure by any privilege, including the attorney-client privilege and the attorney work product privilege.

2. Applicant objects to any use in the interrogatories, either directly or indirectly, of the phrase "person" or "persons", or any other term or phrase intended to include employees, consultants, experts, investigators, insurers or attorneys, the identities of which may not be known to Opposer or to Applicant.

Interrogatory No. 31

Indicate all installation publications of Applicant having a perspective drawing of the marine heat exchanger sold under the name GRIDCOOLER.

Answer:

Pursuant to the February 5, 2003 Order of the Trademark Trial and Appeal Board, Applicant supplements its response. Opposer's attention is directed to Document Nos. 15 - 20, 24 - 28, 29 - 30, 31 - 36, 37 - 44, 45 - 56, 117 - 129, 147 - 158, 235-246, and 268-277.

Document Request No. 1

All documents identified or requested to be identified in response to Interrogatory Nos. 1 through 32 served simultaneously herewith and all documents to which Applicant referred in answering those interrogatories.

Response

Pursuant to the February 5, 2003 Order of the Trademark Trial and Appeal Board, Applicant supplements its response. Opposer's attention is directed to Document Nos. 1 - 296. (see 1-296 of Dep. Ex. No. 3 of Sean Fernstrum)

EXHIBIT B

IN RE: Duramax Marine, LLC

Opposer,

v.

Opposition No. 119,899

R. W. Fernstrum & Company,

Applicant.

DEPOSITION OF: Sean Fernstrum

I have read the foregoing transcript of my deposition given on April 15, 2003 and April 16, 2003, and it is true, correct, and complete, to the best of my knowledge, recollection and belief, except for the list of corrections, if any, attached to this transcript on a separate sheet.


Sean Fernstrum

Date: 5-28, 2003

County of)
ss)
State of Michigan)

The foregoing instrument was acknowledged before me this 28th day of May, 2003, by Sean Fernstrum who is personally known to me or who has produced _____ as identification.


Notary Public

My comission expires: 4-5-2004

DC 71119-37 85421

VIRGINIA K. EWALDT
NOTARY PUBLIC MENOMINEE CO., MI
MY COMMISSION EXPIRES Apr 5, 2004

1 ~~MR. HOCHBERG: Okay. We're on.~~

2 MR. BERGSMAN: One thing that we--we said is--

3 Are we on?

4 ~~COURT RECORDER: We're on.~~

5 MR. BERGSMAN: Okay. Is we're gonna stipulate
6 that the--that the documents produced by Fernstrum in
7 response to the Document Requests by Duramax are authentic
8 documents of Fernstrum. We're gonna stipulate to the
9 authenticity.

10 ~~BY MR. HOCHBERG:~~

11 Q Before you testified that once a customer of Fernstrum
12 fills out the recommendation sheet, you tell--you tell him
13 the kit cool--the Keel Cooler that is best suited to his
14 request. Is that correct?

15 A I believe so, yes.

16 Q And, then I asked you what happens after that. Or I did--
17 maybe I didn't ask you about what happens after that.
18 What does happen after you tell him the--the best Keel
19 Cooler for his recommendation--for--for his question, I
20 mean.

21 A The balls in his court, so to speak. They either place an
22 order or don't place an order.

23 Q Now, if they place an order, what--what does Fernstrum do
24 at that point?

25 A ~~Once the order is taken, the cooler will be scheduled to~~