

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514**

Mailed: August 10, 2004

Opposition No. 91119899

DURAMAX MARINE, LLC

v.

R.W. FERNSTRUM & COMPANY

Cindy B. Greenbaum, Attorney:

This case now comes up on applicant's motion to strike on procedural grounds Sections D and F of opposer's first notice of reliance. The parties have fully briefed the issues.

Applicant's responses to opposer's document requests (Section D) are not admissible through a notice of reliance. Trademark Rule 2.120(j)(3)(ii). Although a party may make of record by notice of reliance an interrogatory answer, including documents provided as all or part of an interrogatory answer, that is not the situation here. Moreover, as opposer notes in its response to the motion to strike, opposer also submitted the documents as part of Section E of the notice of reliance, to which applicant did not object. Accordingly, the documents comprising Section D

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of opposer's first notice of reliance are hereby stricken from the record as improperly submitted and duplicative.<sup>1</sup>

Applicant also has objected to the seven pleadings and court orders in various civil litigations that opposer included as part of Section F of its first notice of reliance.<sup>2</sup> The seven items are not admissible because they are neither printed publications, such as books and periodicals, available to the public, nor official records, as contemplated by Trademark Rule 2.122(e). See cases cited in TBMP §§704.08 and 707.02(b)(2)(2d ed. rev. 2004). Opposer should have introduced these documents in connection with the competent testimony of a witness, rather than by notice of reliance. See, e.g., *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983).

In addition, as applicant notes, opposer did not specify the pages to be read or indicate the relevance of

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<sup>1</sup> The Board notes that Section D of opposer's first notice of reliance does not include any of the "pertinent enclosures and exhibits" or the document entitled "A Survey of Secondary Meaning of the Shape and Appearance of the Fernstrum Keel Cooler Tubing" referenced in the notice of reliance. Inasmuch as opposer states that said documents also were submitted as part of Exhibit E to the first notice of reliance, there is no need for opposer to submit the documents again. Moreover, inasmuch as the documents submitted as Section D of opposer's first notice of reliance are not admissible under notice of reliance, and because the Board also struck said documents as duplicative, opposer's request for leave to file an amended notice of reliance with respect to Section is denied.

<sup>2</sup> Section F of the opposer's first notice of reliance also includes five patents and the file history of U.S. Application No. 75382250, to which applicant raises no objection.

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the material being offered. Moreover, opposer did not properly authenticate the documents. That is, opposer neither filed certified copies of the disputed material, nor introduced the testimony or a certificate from the custodian of records authenticating the documents. *Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc.*, 195 USPQ 658, 664 (TTAB 1977). A stamp of the respective court on the first page of each of the disputed items does not confirm that those items are official records rather than copies from opposer's own files.

Accordingly, the disputed material, namely, (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 Supplemental Complaint, Civil Action No. 97-3974, United States District Court, Eastern District of

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Louisiana; and (7) R.W. Fernstrum & Company's Answer and Counterclaim Against Donovan Marine, Inc., Civil Action No. 97-3974, United States District Court, Eastern District of Louisiana, are hereby stricken from the record.

With respect to the seven stricken documents, Section F of opposer's first notice of reliance is defective on its face, and because the underlying documents are inadmissible as "printed publications" or "official records." Inasmuch as opposer cannot entirely cure Section F of the first notice of reliance, opposer's request for leave to do so is denied.

In summary, applicant's motion to strike is GRANTED.