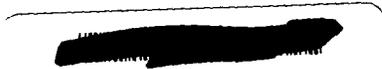


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

In re: LABCAST  
Application Serial No.: 75/813380  
Current Applicant: Varian, Inc. (Prior Applicant: VanKel Technology Group)

Opposition No. 91150161



Innovative Programming Associates, Inc.

09-30-2002

U.S. Patent & TMO/tm Mail Rcpt Dt. #61

Oppose.

v.

Varian, Inc.

Applicant

APPLICANT'S COMBINED REPLY MEMORANDUM IN SUPPORT OF APPLICANT'S  
MOTION TO DISMISS AND APPLICANT'S RESPONSE MEMORANDUM IN  
OPPOSITION TO OPPOSER'S MOTION TO RE-OPEN TESTIMONY PERIOD

I. Introduction

Opposer Innovative Programming Associates, Inc. (hereinafter "Opposer"), a corporation represented by experienced counsel, admits that it failed to take any testimony during its testimony period or to seek an extension. Excuses are provided, but no aspect of the excuses is presented pursuant to declaration or any other form of admissible evidence, as required under the Federal Rules of Civil Procedure and customary Board practice. Of equal significance, the credibility of the "excuses" is undermined by incontrovertible documents and facts, as will be explained by Applicant Varian, Inc. (hereinafter "Varian"). Opposer has also failed to apply whatever conclusory and unsupported facts it has alleged under the relevant Board precedent. It is not enough to pronounce the tautology that the standard is "excusable neglect" and conclude that Opposer's actions or inactions

are “excusable neglect”. The Board’s recent precedent, as will be explained below, provides substantial guidance in applying the relevant principles. When one applies the facts of this case to the Board’s precedent, it is obvious that Opposer is not entitled to the relief it seeks. Applicant’s motion to dismiss should be granted, and Opposer’s belated motion to re-open the testimony period should be denied.

## II. The Board’s Application of the Standard for Evaluating “Excusable Neglect”

Opposer’s brief ignores that the Board has adopted the four-part analysis of the United States Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993) for determining whether or not a moving party should be entitled to re-open a deadline in this type of situation. As stated by the Board:

In brief, the [Supreme] Court held that delays and omissions caused by negligence and carelessness cannot be deemed to be inexcusable per se. Rather, the determination of whether a party’s neglect is excusable is an equitable one which takes into account all relevant circumstances surrounding the party’s delay or omission, including the danger of prejudice to the nonmovant, the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith.

*Pumpkin, Ltd. dba Pumpkin Masters v. The Seed Corps*, 43 U.S.P.Q.2D 1582, fn. 2 (TTAB 1997).

Opposer’s response to Applicant’s motion to dismiss must fail for the sole reason that Opposer has failed to present admissible facts under the applicable standard. When one does apply the relevant facts under the standard enunciated by the Board in *Pumpkin, Ltd. dba Pumpkin Master, supra*, Opposer’s pleading is seen to be both naïve and frivolous.

## III. Opposer’s Excuses for Failing to Take Testimony

On page 2 of its motion, Opposer offers five excuses or “reasons” for its failure to take testimony. Under the holdings of *PolyJohn Enterprises Corporation v. 1-800-Toilets, Inc.*, 61

USPQ 2d 1860 (TTAB 2002) and *Pumpkin, Ltd. dba Pumpkin Masters v. The Seed Corps*, 43 U.S.P.Q.2D 1582, (TTAB 1997), not one of these “reasons” serves to excuse Opposer’s failure to take testimony or Opposer’s failure to bring a timely motion to extend its testimony period. Indeed, the circumstances resulting in the failure to submit testimony in both of these recent Board cases were much more favorable to the party seeking relief than the circumstances so inadequately presented by the Opposer in this instant motion, and yet the Board in both of these decisions refused to grant relief after applying the relevant facts to the four relevant *Pioneer Investment* factors.

A. Opposer Fails to Verify or Authenticate Its Testimony, and There Is No Corroborating Documentation

These “reasons” of Opposer are not presented with any supporting evidence, not even a declaration under penalty of perjury. Under Board practice, which follows on the Federal Rules of Evidence, for testimony to be admissible in the analogous situation of a motion for a summary judgment, a party must present affidavits or declarations so that they 1) are made on personal knowledge; 2) set forth such facts as would be admissible in evidence; and 3) show affirmatively that the affiant is competent to testify to the matters stated therein. *See Consolidated Foods Corporation Foods Corporation v. Berkshire Handkerchief Co., Inc.* 229 USPQ 619 (TTAB 1986); *Cf.* FRCP 56(e) and 37 CFR Section 2.20; *Cf. Sweats Fashions Inc. v. Pannill Knitting Co.* 4 USPQ2d 1793, Fed. Cir. 1987). In this case, Opposer has presented not one affidavit or declaration. Furthermore, important details are missing. For example, one of the alleged “reasons” for Opposer having taken no action during its testimony period relates to the health of Opposer’s principal, but there is no information provided about Opposer’s principal actually being infirm and seeking medical assistance during the testimony period. For example, there is

no fact presented that the principal was not able to participate in a testimony deposition during the testimony period. Rather, there is the conclusory and unverifiable statement, not even presented under oath, without any reference to a particular chronology, that “Plaintiff has diabetes, which requires plaintiff to monitor his health.” Under Opposer’s logic, any person monitoring his health need not abide by Board deadlines or procedures.

B. Opposer Cannot Blame the Board or Applicant for Opposer’s Inability to Comprehend Board Practice and Procedures

Opposer also claims that “Plaintiff was confused as to the nature of the testimony and what it was used to be for.” “Plaintiff” is a corporation, first of all, and it is rather impossible for a corporation to be confused. In any case, it could hardly be the law that a party’s inability to understand the legal and procedural aspects of Board practice, when a party is represented by counsel admitted to practice before the Bar of New Jersey and the Patent Office Bar, is a ground for a party to ignore important Board procedures and Board deadlines. Presumably, Opposer’s counsel had the opportunity and the capacity to explain these procedures so that Opposer or Opposer’s principal would not be “confused”. If Opposer’s counsel inadequately or incorrectly explained Board procedure, then Opposer can seek redress in a different forum against its counsel, but that is not the problem of Applicant or of the Board. Furthermore, there is no testimony from Opposer, or Opposer’s counsel, to verify this conclusory and ridiculous excuse that Opposer was “confused”. In *PolyJohn Enterprises Corporation v. 1-800-Toilets, Inc.*, 61 USPQ 2d 1860 (TTAB 2002), counsel for the party seeking to re-open the testimony period submitted an affidavit explaining how and why there was some confusion about an extension of the testimony period. Notwithstanding this admissible testimony (lacking in this present case)

and the fact that it was plausible that counsel there had made a mistake, the Board found that the failure to act there was not caused by “excusable neglect”. As stated by the Board:

Both the Board and parties before it have an interest in minimizing the amount of the Board's time and resources that must be expended on matters, such as the motions decided herein, which come before the Board solely as a result of one party's failure to understand a clear and straightforward rule. The Board's interest in deterring such failure weighs against a finding of excusable neglect under the second Pioneer factor.

*Id.*

As further stated by the Board,

Even if they shared such an understanding, it was incumbent upon petitioner, as the party with the burden of moving forward, to comply with the requirements of Trademark Rule 2.120(a), or run the risk of suffering dismissal for want of prosecution.

*Id.*

Opposer here, like the petitioner in *Polyjohn*, has not made any allegation that it was unable to take any action based on circumstances beyond its control. As in *Polyjohn*, misunderstandings of procedure, or misunderstandings between counsel, cannot excuse a failure to act in a timely manner.

C. Evidence Demonstrates That Opposer and Its Counsel Really Understood the Significance of the Close of the Testimony Period, But Intentionally Allowed the Deadline to

Pass

1. Contrary to the unsupported allegations in Opposer's brief, the facts here show that both Opposer and Opposer's counsel were very much aware of Opposer's deadline for submitting testimony. Submitted as Exhibit 1 of the Appendix is a letter dated July 17, 2002 from Opposer's counsel to Applicant's counsel. In this letter, Opposer's counsel requested that Applicant stipulate to permit Opposer to take the testimony deposition of Opposer's principal

during Applicant's testimony period. In a letter dated July 19, 2002 submitted as Exhibit 2, Applicant's counsel rejected this proposal outright, leaving no doubt that if Opposer wished to take a testimony deposition, that Opposer needed to do so during Opposer's testimony period. It is therefore incredible that Opposer now claims that "Plaintiff" corporation was "confused", or that any of the other so-called reasons offered should be taken seriously by anyone. There is no showing that the failure to act before the deadline was caused by circumstances that were beyond the control of the party seeking relief, as expressly required by the Board in *Polyjohn, supra*. The documents, and the circumstances, tell a different story, namely, that Opposer had considered different options concerning presenting testimony, and then decided on a course of action, or, in this case, on a course of inaction.

2. It should also be pointed out that Applicant has brought a counterclaim under Section 18 to restrict the identification of goods in Opposer's registration. In an Order of the Board mailed on March 19, 2002, the Board rejected Opposer's motion to dismiss that counterclaim. As noted in Exhibit 3 of the Appendix, in May, 2002, Opposer was reminded that Opposer had a serious downside if Opposer continued with the prosecution of this case. It is therefore extremely plausible that Opposer intentionally decided not to proceed with the taking of testimony during its testimony period. In any case, Opposer, for reasons only Opposer and its counsel are privy to, has now had a change of heart about whether or not to proceed with the prosecution of this case. This change of heart comes much too late, and it comes with no adequate justification.

3. Similarly, Opposer's argument that Opposer's principal believed that the parties were negotiating a settlement is not believable, based on the documents. Submitted as Exhibit 3 is an email message dated May 6, 2002 from Applicant's counsel to Opposer's counsel. In that message, Applicant's counsel was clear that Opposer's principal was to cease all further

discussions concerning settlement and concerning collaborative efforts with Applicant's principal. (Gordet Declaration and Exhibit 3) Opposer's principal had abused a window of opportunity opened by Applicant's CEO for the parties to directly discuss a creative settlement, but Opposer's principal made unreasonable demands, including unreasonable demands for monetary compensation that cannot even be awarded in this administrative proceeding. (Gordet Declaration and Exhibit 3) As noted, the instructions from Applicant's counsel that Opposer's principal was to cease having direct contact with Applicant was dated May 6, 2002, prior to the close of discovery and long prior to the close of Opposer's testimony period. After the May 16, 2002 message appearing at the top of Exhibit 3, there were no further settlement discussions between counsel, or the parties. (Gordet Declaration) A self-serving bare allegation in a brief (not even under penalty of perjury) that Opposer allowed the testimony period deadline pass because Opposer believed that there was hope for settlement is ludicrous.

#### IV. Good Faith, or Lack Thereof, Is a *Pioneer* Factor, and Goes Against Opposer

Opposer's claim, contrary to the documentation, that Opposer believed that settlement was in the offing, smacks of bad faith. Under *Pumpkin Masters*, good faith is one of the factors for the Board to evaluate to see if the testimony period should be re-opened. The inadequacies and incompleteness of Opposer's response to Applicant's motion to dismiss, and Opposer's own belated motion, speak volumes about Opposer's lack of good faith in instituting this present proceeding, and in now belatedly trying to re-institute it after abandoning it. Opposer's entire position makes no sense, and as the Board articulated in *Polyjohn, supra*, it behooved Opposer to make sure that the case proceeded, regardless of any prospects for settlement, if Opposer did not wish to have its case dismissed for want of prosecution.

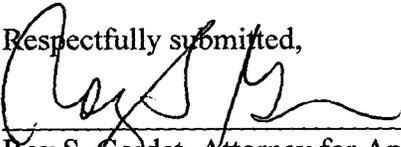
#### V. Lack of Prejudice to Applicant Does Not Outweigh the Other Factors

Opposer makes the argument that Applicant has not been prejudiced because witnesses are still available, etc., so therefore relief should be granted. However, this factor is but one of the four *Pioneer* factors, and, as explained by the Board in *Pumpkin Masters, supra*, is not enough by itself to permit a party to ignore Board procedures or to outweigh the three remaining *Pioneer* factors when those factors, in equity, militate against a finding of excusable neglect. Were it otherwise, any party could ignore Board rules and deadlines, and claim that there was no prejudice to its adversary, so there should be no consequence. This is especially true where the party seeking relief has failed to submit admissible evidence that it was unable to avoid its oversight, and where the documentary evidence, as here, demonstrates that the party itself and its counsel were very well aware of their testimony period deadlines, but chose not to act. Obviously Applicant is prejudiced that it must continue to litigate a frivolous opposition proceeding where the subject marks, LABCAT and LABCAST, make decidedly different commercial impressions, and the respective marks are used in different classes and on different goods and services. As emphasized by the Board in denying the petition for relief in *Polyjohn, supra*, Opposer here does not contend that circumstances actually prevented it from taking testimony or from bringing a timely motion for an extension based on extenuating circumstances. Opposer has had a change of strategy, and flouting of the Board's procedures, to the detriment of the Board and of Applicant, should not be condoned.

#### VI. Conclusion

Opposer's motion has no merit. It lacks evidentiary foundation. It lacks citation to the most applicable Board precedent. It eschews analysis of the critical factors for determining

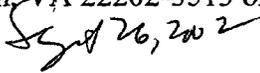
whether failure to act was the result of "excusable neglect" rising to the level that the Board, sitting in equity, should re-open testimony periods. A careful analysis, based on the admissible facts submitted by Applicant, demonstrates that Applicant's motion to dismiss for failure to present testimony should be granted, and Opposer's motion to re-open its testimony period should be denied. Applicant's application for its mark should now proceed to registration.

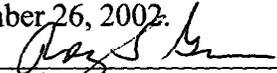
Respectfully submitted,  
  
\_\_\_\_\_  
Roy S. Gordet, Attorney for Applicant, Varian, Inc.

Roy S. Gordet  
Attorney at Law  
98 Battery Street, Suite 601  
San Francisco, CA 94111  
Tel. 415-627-0300  
Fax 415-627-9020

#### CERTIFICATE OF MAILING

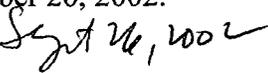
I certify that this document is being deposited with the United States Postal Service, First Class postage pre-paid, addressed to Commissioner of Trademarks, Attn: TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513 on September 26, 2002.

Dated: 

  
\_\_\_\_\_  
Roy S. Gordet

#### CERTIFICATE OF SERVICE

I certify that I served a copy of this document on Opposer by mailing it with the United States Postal Service, First Class postage pre-paid, addressed as follows:  
Charles F. Manero, Woodbridge & Associates, P.O. Box 592, Princeton, NJ 08542-0592 on September 26, 2002.

Dated: 

  
\_\_\_\_\_  
Roy S. Gordet

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

In re: LABCAST

Application Serial No.: 75/813380

Current Applicant: Varian, Inc. (Prior Applicant: VanKel Technology Group)

Opposition No. 91150161



09-30-2002

U.S. Patent & TMO/tm Mail Rcpt Dt. #61

Innovative Programming Associates, Inc.

Opposer

v.

Varian, Inc.

Applicant

DECLARATION OF ROY S. GORDET IN SUPPORT OF MOTION TO DISMISS FOR  
FAILURE TO TAKE TESTIMONY AND IN OPPOSITION TO OPPOSER'S MOTION TO  
RE-OPEN TESTIMONY PERIODS

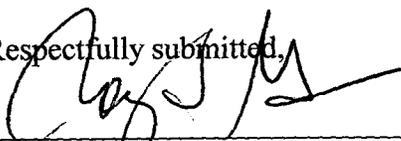
I Roy S. Gordet, under penalty of perjury, declare as follows:

1. I am admitted to the Bars of the States of New York and California, and I am counsel of record for Applicant Varian, Inc. in this proceeding.
2. Submitted as Exhibit 1 in "Applicant's Appendix of Exhibits" ("Appendix") is a true and correct copy of a letter dated July 17, 2002 from Charles Manero, counsel for the Opposer, wherein counsel made the unusual request that Opposer be permitted to postpone the taking of Opposer's testimony deposition during Opposer's testimony period, and instead be permitted to take such testimony during Applicant's testimony period.

3. Submitted as Exhibit 2 in the Appendix is a letter dated July 19, 2002, in which I flatly rejected this unusual request.
4. As noted, the letters submitted as Exhibits 1 and 2 were exchanged prior to the close of Opposer's testimony period, indeed with sufficient time for Opposer to take testimony depositions. It should be noted that all of the timing issues, or problems, as the case may be, were created by Opposer's own decisions or lack of diligence.
5. Submitted as Exhibit 3 of the Appendix is an email message from Richard C. Woodbridge, counsel for Opposer to me dated May 16, 2002. As noted, counsel for Opposer confirmed that he had forwarded my message dated May 12, 2002, which also appears in Exhibit 3, to his client. In my message of May 12, 2002, I had emphasized that Opposer has "a major downside in the form of having the description of goods of its registration restricted pursuant to our counterclaim, a point confirmed expressly by the TTAB in its prior decision in this case."
6. Also appearing in Exhibit 3 are other emails in a thread between Opposer's counsel and myself. As far back as an email message from myself to Opposer's counsel dated May 6, 2002, the principal of Opposer, Morton Cohen, was informed that he was to have no further direct contact with any persons at Applicant regarding collaborative efforts and settlement possibilities. It is therefore unbelievable for Opposer to now claim that Mr. Cohen did not proceed with testimony because he thought a settlement was in the offing. There were no discussions of settlement between my office and Opposer's counsel after May 16, 2002. My email dated May 12, 2002 (included within the thread of Exhibit 3) did not receive a substantive response.

I declare under the penalty of perjury under the laws of the United States of America that the

foregoing is true and correct.

Respectfully submitted,  


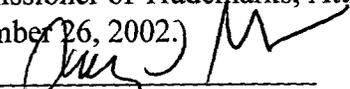
Roy S. Gordet, Attorney for Applicant, Varian, Inc.

Roy S. Gordet  
Attorney at Law  
98 Battery Street, Suite 601  
San Francisco, CA 94111  
Tel. 415-627-0300  
Fax 415-627-9020

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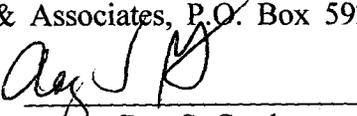
Dated:

Sept 26, 2002 ✓   
Roy S. Gordet

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Charles F. Manero, Woodbridge & Associates, P.O. Box 592, Princeton, NJ 08542-0592 on September 26, 2002.

Dated:

Sept 26, 2002 ✓   
Roy S. Gordet

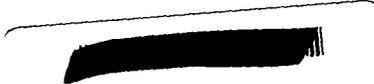
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Innovative Programming Associates, Inc.

09-30-2002  
U.S. Patent & TMO/TM Mail Rpt Dt. #61

Opposer

v.

Varian, Inc.

Applicant

APPLICANT'S APPENDIX OF EXHIBITS IN SUPPORT OF MOTION TO DISMISS FOR  
FAILURE TO TAKE TESTIMONY AND IN OPPOSITION TO OPPOSER'S MOTION TO  
RE-OPEN TESTIMONY PERIODS

<u>Exhibit</u>	<u>Description</u>
1	Letter dated July 17, 2002 from Opposer's counsel to Applicant's counsel
2	Letter dated July 19, 2002 from Applicant's counsel to Opposer's counsel
3	Thread of email correspondence between Applicant's counsel and Opposer's counsel dated from May 6, 2002 through May 16, 2002.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roy S. Gordet", written over a horizontal line.

Roy S. Gordet, Attorney for Applicant, Varian, Inc.

Roy S. Gordet  
Attorney at Law  
98 Battery Street, Suite 601  
San Francisco, CA 94111  
Tel. 415-627-0300  
Fax 415-627-9020

CERTIFICATE OF MAILING

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Dated: Sept 26, 2002

Roy S. Gordet  
Roy S. Gordet

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Charles F. Manero, Woodbridge & Associates, P.O. Box 592, Princeton, NJ 08542-0592 on September 26, 2002.

Dated: Sept 26, 2002

Roy S. Gordet  
Roy S. Gordet

tabbies  
**EXHIBIT**  
/

(P)

# WOODBRIIDGE & ASSOCIATES, P. C.

*Domestic and International  
Patents, Trademarks and Copyrights*

P.O. Box 592  
Princeton, New Jersey 08542-0592

Telephone: (609) 924-3773  
Facsimile: (609) 924-1811

E-mail: [firm@njiplaw.com](mailto:firm@njiplaw.com)  
Web Site: [www.njiplaw.com](http://www.njiplaw.com)

Richard C. Woodbridge

Stuart H. Nissim\*  
John W. Yakimow†  
Charles F. Manero

*Counsel*  
Dennis J. Helms

\*MD Bar Only  
†IL & MI Bars Only

July 17, 2002

Via First Class Mail  
Fax.: (415) 255-0343 and  
e-mail: [rsgordet@earthlink.net](mailto:rsgordet@earthlink.net)

Roy Gordet, Esq.  
530 Bush Street, Suite 601  
San Francisco, CA 94108

**Re: Innovative Programming Associates, Inc**  
**v.**  
**Varian, Inc.**  
**Opposition No. 91150161**  
**Your File No.: 156-13**  
**Our File No.: 2509-105Opp.**

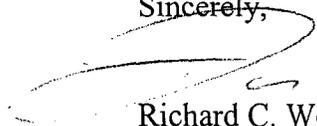
Dear Roy,

We have reviewed the schedule for the above case and have noted that your opportunity to take testimony of any witnesses ends on October 1, 2002. We would like to know if you plan on taking the testimony of our client Mort Cohen. If so please give us a few dates and the proposed location where the testimony will be taken so that we can have our client look at them to see when he is available.

We would also like to know if you have any objections to us taking testimony at the same place and time instead of scheduling another meeting. If you agree to this arrangement, we would need your consent for an extension of time to take testimony.

We look forward to hearing from you soon. Please contact us if you have any questions.

Sincerely,



Richard C. Woodbridge

*Charles Manero*

Charles Manero

cc./ Mort Cohen

EXHIBIT

tabbles

2



ROY S GORDET

*Attorney at Law*

520 BUSH STREET . SUITE 601 . SAN FRANCISCO . CA 94108  
TEL 415.255.1165 . FAX 415.255.0343

By Facsimile and U.S. Mail

July 19, 2002

Richard C. Woodbridge  
Charles F. Manero  
Woodbridge & Associates, P.C.  
P.O. Box 592  
Princeton, NJ 08542-0592

Re: Innovative Programming Associates, Inc. v. Varian  
Opposition No. 91150161  
RSG Ref. No. 156-13  
Your Ref. No. 2509-105 Opp.

Dear Charles and Dick:

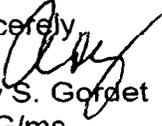
This is in response to your letter of July 17, 2002 concerning the taking of the deposition of Mr. Cohen.

First, we have not yet decided whether we will be taking the deposition of Mr. Cohen during Applicant's testimony period. It would depend on the nature of the testimony presented by Opposer. As soon as we have decided if we will take Mr. Cohen's deposition during Applicant's testimony period, we will present you with several alternative dates early in the testimony period, assuming that we will have decided to take his deposition.

Thus, as you can appreciate, we are not in a position to stipulate that Opposer can take Mr. Cohen's deposition during Applicant's testimony period. I have never heard of such a procedure, I might add, although presumably it is something that the parties could stipulate to. We decline, however, to do so.

If you wish to discuss this matter, please do not hesitate to contact me.

Sincerely,

  
Roy S. Gordet  
RSG/ms

cc: Hunter L. Auyang by facsimile

tabbles®  
EXHIBIT  
3

**Roy S. Gordet**

---

**From:** Richard C. Woodbridge  
**Sent:** Thursday, May 16, 2002 3:30 PM  
**To:** 'Roy S. Gordet'  
**Subject:** RE: LABCAST TM Opposition

Roy -

I have your email and have passed it on to the client. Thanks, Dick Woodbridge

-----Original Message-----

**From:** Roy S. Gordet [mailto:rsgordet@earthlink.net]  
**Sent:** Sunday, May 12, 2002 2:11 PM  
**To:** Richard C. Woodbridge  
**Cc:** Charles Manero; hunter.auyang@varianinc.com; rsgordet@earthlink.net  
**Subject:** RE: LABCAST TM Opposition

Dick:

The logic of your position breaks down because Varian did not seek this confrontation. No way, contrary to your implication. We also believe that your client "would not have filed this opposition if it wasn't an obvious threat" is a faulty premise, and is irrelevant besides. LABCAST is not even close to a threat to your client's trademark rights, and if your client believed that it was, that was a misguided belief. Varian is not going to make IPA whole for its poor judgment in starting this proceeding. By logic, Varian is as much, not more, entitled to have IPA pay Varian's costs and attorneys fees as vice-versa. It is time to move on, and each side has to bear its own costs and attorneys fees as the cost of being a trademark owner within this social and legal system we are operating in. The law does not provide for attorneys fees in this situation, and if it did, Varian would be insisting on payment as a condition for settlement, a point you should weigh carefully in the event IPA is considering filing an action in Federal court. As for this TTAB proceeding, your client has a major downside in the form of having the description of goods of its registration restricted pursuant to our counterclaim, a point confirmed expressly by the TTAB in its prior decision in this case. A prompt settlement is in both parties' best interest.

Sincerely,  
 Roy

-----Original Message-----

**From:** Richard C. Woodbridge [mailto:rcw@njiplaw.com]  
**Sent:** Sunday, May 12, 2002 10:36  
**To:** 'Roy S. Gordet'  
**Cc:** Charles Manero; Mort Cohen (E-mail); MORTON S. COHEN (E-mail)  
**Subject:** RE: LABCAST TM Opposition

Roy -

Thanks for the email. We understand all of that. Our position is that our client didn't seek this confrontation. We would not have filed the opposition if it wasn't an obvious threat. Obviously the TTAB doesn't award fees - our point is that our client has been put in a position of paying to protect itself and it would be appropriate for Varian to pay our client's expenses that were incurred because of Varian's mistakes - it would also settle this matter early rather than latter as the parties continue to run up lawyers expenses for depositions, TTAB appearances, etc. It's an ethical, practical point we are making not a misunderstanding of the law. Dick W.

-----Original Message-----

**From:** Roy S. Gordet [mailto:rsgordet@earthlink.net]  
**Sent:** Friday, May 10, 2002 3:17 PM  
**To:** Richard C. Woodbridge

9/20/2002

**Cc:** hunter.auyang@varianinc.com  
**Subject:** RE: LABCAST TM Opposition

Dick,

In view of the fact that your client would never be awarded attorneys fees before either the TTAB or in a Federal Court, even setting aside our differing views of the merits of your client's position, it is unrealistic for your client to expect any payment whatsoever.

Best regards,  
Roy

Roy S. Gordet  
Attorney at Law  
530 Bush Street, Suite 601  
San Francisco, CA 94108  
Tel. 415-255-1165  
Fax 415-255-0343  
rsgordet@ncal.verio.com

-----Original Message-----

**From:** Richard C. Woodbridge [mailto:rcw@njiplaw.com]  
**Sent:** Friday, May 10, 2002 10:55 AM  
**To:** 'Roy S. Gordet'  
**Cc:** Mort Cohen (E-mail); Judy Geiser; Charles Manero  
**Subject:** RE: LABCAST TM Opposition

Roy -

We have your email and have passed it along to our client. I must say I am very disappointed that Varian doesn't seem to understand or care about the web linking issue or the costs that this opposition has made our client bare to protect its rights.  
Dick Woodbridge

-----Original Message-----

**From:** Roy S. Gordet [mailto:rsgordet@earthlink.net]  
**Sent:** Monday, May 06, 2002 4:52 PM  
**To:** Richard C. Woodbridge; 'Roy S. Gordet'  
**Cc:** Charles Manero; hunter.auyang@varianinc.com  
**Subject:** LABCAST TM Opposition

RSG Ref. 156-13

FOR RICHARD C. WOODBRIDGE

Hello Dick,

Hunter L. Auyang, Director of Intellectual Property at Varian, Inc., has requested that I inform you that Al Lauer has received the letter dated April 29, 2002 from Morton Cohen, and that Mr. Lauer is disappointed that your client has continued to insist on his demands about website linking and a monetary payment as part of a comprehensive settlement. The counter-offer of your client's April 29, 2002 letter is rejected. I feel compelled to briefly point out two of the fallacies of Mr. Cohen's letter; first, IPA has a serious downside based on

our meritorious counterclaim to require an amendment to the overly broad description of goods in your client's registration, and second, that whatever the outcome of this opposition, the decision of the TTAB will not require Varian, Inc. to cease using the mark LABCAST. The TTAB is not so empowered.

Furthermore, in light of Mr. Cohen's position, I have been further requested to inform you that Mr. Cohen should under NO circumstances contact John Sullivan, or anyone else at Varian, concerning potential collaborative business projects. If Mr. Cohen desires to contact anyone at Varian, Inc., he is only authorized to contact Hunter L. Auyang, tel. 650-424-5078.

If you would like to discuss the substance of the case or settlement, please do not hesitate to contact me.

Sincerely,

Roy  
Roy S. Gordet  
Attorney at Law  
530 Bush Street, Suite 601  
San Francisco, CA 94108  
Tel. 415-255-1165  
Fax 415-255-0343  
rsgordet@ncal.verio.com



TTAB

ROY S GORDET

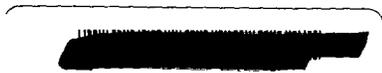
Attorney at Law

530 BUSH STREET . SUITE 601 . SAN FRANCISCO . CA 94108  
TEL 415.255.1165 . FAX 415.255.0343

TRANSMITTAL LETTER

September 26, 2002

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



09-30-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #61

Re: Opposition No. 91150161 Against Application  
Serial No. 75813380 for the Mark LABCAST  
Attorney Docket 156-13

Dear Madam:

Enclosed please find the following:

- 1) Applicant's Combined Reply Memorandum in Support of Applicant's Motion to Dismiss and Applicant's Response Memorandum in Opposition to Opposer's Motion to Re-Open Testimony Period
- 2) Declaration of Roy S. Gordet
- 3) Applicant's Appendix of Exhibits, including Exhibits 1-3
- 4) A self-addressed postcard to acknowledge receipt

02 OCT -7 : 10:44  
TRADEMARK TRIAL AND APPEAL BOARD

Please endorse the self-addressed postcard and return it to the undersigned attorney for Applicant/Respondent and Cross-Petitioner. As noted in the accompanying documents, all correspondence in this matter should be directed to the undersigned attorney for Applicant. Please reference our Docket No. 156-13.

Your attention to this matter will be appreciated.

Sincerely,

Roy S. Gordet

RSG/mw  
Enclosures