



12-10-2002

U.S. Patent & TMO/TM Mail Rpt. Dt. #40

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Signature: *Purita T. Eugenio*

Printed Name of Person Mailing Document: **PURITA T. EUGENIO**

Express Mail Label Number: **EU375712878US**

Date of Deposit: **DECEMBER 10, 2002**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>MARK D. TANNEN,</p> <p>Opposer,</p> <p>vs.</p> <p>JAY MACK,</p> <p>Applicant.</p>
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Opposition No.: 91151109
Serial No.: 75/845,350

Vertical stamp: RECEIVED... 12/10/02

APPLICANT'S OBJECTION TO THE DECLARATION OF PAUL J. REILLY IN FURTHER SUPPORT OF OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Applicant, Jay Mack, objects to Opposer's Declaration of Paul J. Reilly (dated November 20, 2002) in Further Support of Opposer's Memorandum in Opposition to Applicant's Motion for Summary Judgment.

Opposer's Attorney, Paul J. Reilly, has filed a declaration that is neither proper, nor permitted under the TTAB rules. Further, Opposer has established a pattern in this case of submitting materials not permitted under TTAB rules in a wholesale rejection of TTAB administrative procedures.

OPPOSER'S SUBMISSION OF THIS DECLARATION IS NOT ADMISSIBLE

UNDER 37 C.F.R. 2.127(a)

Opposer has submitted, the declaration of Opposer's Attorney, Paul J. Reilly, in contravention of 37 C.F.R. 2.127(a). 37 C.F.R. 2.127(a) states that after the filing of a reply brief to a motion: "No further papers in support of or in opposition to a motion will be considered by the Board." The reply brief in this case was filed with TTAB on July 8, 2002. Approximately four and one-half (4 ½) months later, on November 20, 2002, Opposer filed the declaration in question. As such, the declaration should not be considered by the TTAB.

OPPOSER'S DECLARATION IS NOT ADMISSIBLE UNDER FRCP 56(e)

The Reilly Declaration is not based on personal knowledge as required by FRCP 56(e) and as such is not admissible. "Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence and shall show affirmatively that the affiant is competent to testify to the matter stated therein." FRCP 56(e), *see also* TBMP § 528.05(b). The Reilly Declaration asserts claims and facts which are obviously not within the personal knowledge of the declarant, to wit: "It is reasonable to conclude that Opposer's evidence of the use of the mark AI AMERICAN INTELLIWARE and Design was sufficient for Intellware Systems' to forgo pursuing its claim of abandonment against Opposer." [Reilly Declaration, Paragraph 3]

Because this statement is pure speculation and not based on personal knowledge, it is not admissible under FRCP 56(e). "Affidavits which are inadequate under rule 56(e) must be disregarded." *G. D. Searle & Co. v Chas. Pfizer & Co.* (1956, CA7 Ill) 231 F2d 316, 318, 109 USPQ 6.

“Rule 56(e) states that ‘supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein.’ Thus, statements outside the affiant’s personal knowledge or statements that are the result of speculation or conjecture or merely conclusory do not meet this requirement.” *Stagman v. Ryan*, 176 F.3d 986, 995, 1999 U.S. App. LEXIS 8578, 161 L.R.R.M. (BNA) 2204, 138 Lab. Cas. (CCH) P58637, 51 Fed. R. Evid. Serv. (CBC) 1549, 51 Fed. R. Evid. Serv. (CBC) 1551 (7th Cir. Ill. 1999)

As such, the Reilly Declaration is not admissible in its entirety for this reason alone and should be not be considered by the Board.

OPPOSER’S DECLARATION CONTAINS STATEMENTS
WHICH ARE FALSE AND SHOULD BE STRICKEN

As indicated above, in Paragraph 3 of Reilly’s Declaration, he states “It is reasonable to conclude that Opposer’s evidence of the use of the mark AI AMERICAN INTELLIWARE and Design was sufficient for Intelliware Systems’ to forgo pursuing its claim of abandonment against Opposer. Not only is this statement not within the personal knowledge of Reilly, it is devoid of any factual basis, and is false.

Attached herewith as Exhibit A is the Declaration of Jeffrey M. Becker dated December 8, 2002. Becker was the attorney that represented IntelliWare Systems, Inc., and filed a petition to cancel the Opposer’s mark. [Exhibit A, Paragraph 1] Becker has reviewed the declaration of Paul J. Reilly dated November 20, 2002, as well as the Opposer’s papers. [Exhibit A, Paragraph 2] Becker continues to believe that the Opposer has abandoned its “AI INTELLIWARE and Design” mark. [Exhibit A, Paragraph 3] Finally, alleged use of the mark “AI INTELLIWARE and Design” was unrelated to the non-prosecution of IntelliWare Systems’ petition to cancel. [Exhibit A, Paragraph

4] Therefore, the statement as to evidentiary support for use of the Opposer's mark is patently false, and should not be considered by the Board.

CONCLUSION

In conclusion, Applicant Jay Mack respectfully requests that the Board not consider the Declaration of Paul J. Reilly based on the fact that its filing was not permitted by TTAB rules or the Federal Rules of Civil Procedure, and that the declaration contains statements which are not based on personal knowledge of the declarant.

In the alternative, if the Board should decide to consider Reilly's declaration, Applicant respectfully requests that the Board consider this brief and accompanying Exhibit as irrefutably contradicting Reilly's declaration, and proving Reilly's declaration false.

Respectfully submitted,



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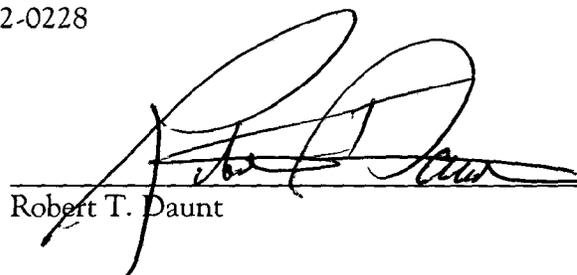
Date: December 10, 2002

Attorneys for Applicant,
JAY MACK

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S OBJECTION TO THE DECLARATION OF PAUL J. REILLY IN FURTHER SUPPORT OF OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT was mailed FIRST CLASS mail, postage prepaid, this 10th day of December, 2002 on Opposer's counsel:

Paul J. Reilly, Esq.
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza, 44th Floor
New York, NY 10112-0228



Robert T. Daunt

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Signature: *Purita T. Eugenio*
Printed Name of Person Mailing Document: PURITA T. EUGENIO
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vs.

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12-10-2002

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Opposition No.: 91151109

Serial No.: 75/845,350

**DECLARATION OF JEFFREY M. BECKER IN SUPPORT OF APPLICANT'S
OBJECTION TO THE DECLARATION OF PAUL J. REILLY IN FURTHER
SUPPORT OF OPPOSER'S MEMORANDUM IN OPPOSITION TO
APPLICANT'S MOTION FOR SUMMARY JUDGEMENT**

I, Jeffrey M. Becker, declare:

1. I am an attorney associated with the law firm of Haynes and Boone, LLP, in Dallas, Texas. While representing IntelliWare Systems, Inc., I filed a petition to cancel the Mark (AI AMERICAN INTELLIWARE and Design) of the Opposer in this action, in the matter *Intelliware Systems, Inc. v. Mark D. Tannen*, Cancellation No. 31,660. As such, I am intimately familiar with the petition to cancel, and the reasons

why the petition to cancel was not prosecuted by my client.

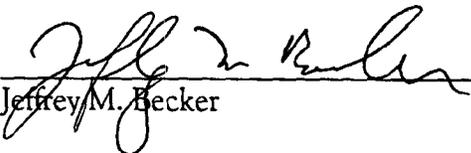
2. I have had an opportunity to review the declaration of Paul J. Reilly dated November 20, 2002 as well as the Opposer's initial opposition papers.

3. I continue to hold the opinion that the Opposer has abandoned the Mark (AI AMERICAN INTELLIWARE and Design) and as such, the Opposer has no Trademark rights in that Mark.

4. The reason my client did not pursue prosecution in its petition to cancel had nothing to do with any alleged showing of use of the Mark AI AMERICAN INTELLIWARE and Design by Opposer.

Pursuant to 28 U.S.C. § 1746, I, Jeffrey M. Becker, further declare under penalty of perjury that the foregoing is true and correct.

Date: December 8, 2002

By: 
Jeffrey M. Becker

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Dear Sir:

TRANSMITTAL LETTER

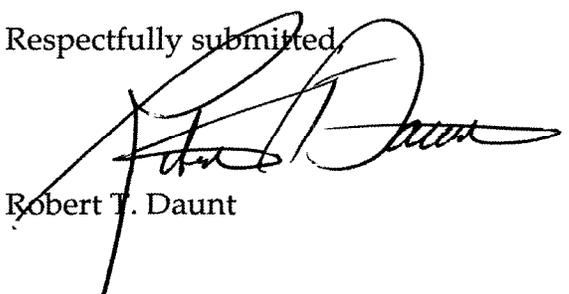
In connection with the above-referenced trademark registration application of Jay Mack, transmitted herewith are the following:

(1) Applicant's Objection to the Declaration of Paul J. Reilly in Further Support of Opposer's Memorandum in Opposition to Applicant's Motion for Summary Judgment - 7 pages; and

(2) Postcard.

Please date-stamp the enclosed postcard and return same to the undersigned in acknowledgment of receipt of all transmitted materials.

Respectfully submitted,


Robert T. Daunt

RTD:pte
December 10, 2002
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