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TRADEMARK TRIAL AND APPEAL BOARD
02 JUL 15 AM 12:05

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



07-08-2002

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

MARK D. TANNEN,

Opposer,

vs.

JAY MACK,

Applicant.

Opposition No.: 91151109
Serial No.: 75/845,350

BOX TTAB
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ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VA 22202-3513

Dear Sir:

TRANSMITTAL LETTER

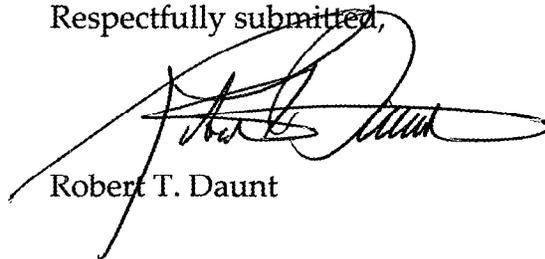
In connection with the above-referenced trademark registration application of Jay Mack, transmitted herewith are the following:

SW

- (1) Applicant's Reply to Opposer's Motion to Strike Applicant's Reply Brief and Objection to Opposer's Memorandum and Declaration in Support of Opposer's Memorandum in Opposition to Applicant's Motion for Summary Judgment - 6 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,

A handwritten signature in black ink, appearing to read 'Robert T. Daunt', written over a horizontal line.

Robert T. Daunt

RTD:pte
July 5, 2002
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Signature: *Purita T. Eugenio*
Printed Name of Person Mailing Document: PURITA T. EUGENIO

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Date of Deposit: JULY 5, 2002

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

MARK D. TANNEN,

Opposer,

vs.

JAY MACK,

Applicant.



07-08-2002

U.S. Patent & TMO/tc/TM Mail Rpt Dt. #01

Opposition No.: 91151109

Serial No.: 75/845,350

**APPLICANT'S REPLY TO OPPOSER'S MOTION TO STRIKE APPLICANT'S
REPLY BRIEF AND OBJECTION TO OPPOSER'S MEMORANDUM AND
DECLARATION IN SUPPORT OF OPPOSER'S MEMORANDUM IN
OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

Applicant, Jay Mack, replies and objects to (moves to strike) Opposer's Motion to Strike Applicant's Reply Brief in Support of His Motion to Dismiss for Lack of Subject Matter Jurisdiction or in the Alternative for Summary Judgment filed by Opposer, Mark D. Tannen, against application for registration of Applicant's trademark INTELLIWEAR, Serial No. 75/845,350, filed on December 1, 1999 and published in the Official Gazette on October 30, 2001.

Opposer Mark D. Tannen has filed a motion to strike Applicant's Reply based on the grounds that Applicant's Brief is "improper" and that it exceeds the page limits allowed under the code.

APPLICANT'S REPLY BRIEF IS PROPER UNDER THE CIRCUMSTANCES

First, Opposer asserts that reply briefs are discouraged, and alleges that "Applicant's reply merely reargues points already presented in its initial motion, or asserts new and improper technical arguments. . ." In fact, "[t]he Board may, in its discretion, entertain a reply brief if the Board finds that such a Brief is warranted under the circumstances of a particular case." TBMP § 502.03. In this case, the Opposer *for the first time*, in his MSJ Opposition, has claimed common law trademark rights. In addition, the Opposer has based this claim fully on a Declaration submitted with his MSJ Opposition, that is not admissible under any theory, and on exhibits attached thereto, which were similarly inadmissible as outlined in Applicant's Reply Brief and Objection to Opposer's MSJ Opposition. To deprive the Applicant of the opportunity to respond to these new claims and new documents contained in Opposer's MSJ Opposition would not be equitable. "The Board may entertain a reply brief if, in the Board's opinion, such a brief is necessary to permit the moving party to respond to new issues raised in, or new materials submitted with, and adversary's brief in opposition to the motion; . ." (Emphasis supplied) *Id.*

APPLICANT'S BRIEF WAS BOTH A REPLY BRIEF AND MOTION TO STRIKE

Rather than submit two lengthy documents, Applicant submitted a single, brief document of sixteen pages, rather than the thirty-five pages allowed under the rules. *See* 37 C.F.R. 2.127(a) In addition, the Opposer *did not object or move to strike* the Applicant's *Objection* to Opposer's Memorandum in Opposition to Applicant's Motion to Dismiss for Lack of Subject Matter Jurisdiction or in the alternative for Summary Judgment and Objection to the Declaration in Support

of Opposer's Memorandum in Opposition to Applicant's Motion for Summary Judgment. See "Opposer's Motion to Strike Applicant's Reply Brief in Support of his Motion to Dismiss for Lack of Subject Matter Jurisdiction or in the Alternative for Summary Judgment." The bulk of Applicant's Reply and Objection consists of facts supporting, and express motions to strike or exclude the Opposer's Opposition, and was not solely a "reply." See Applicant's Reply and Objection, specifically, paragraphs numbers 2, 6, and conclusion.

In terms of Opposer's allegation that Applicant asserted "new and improper technical arguments," Applicant concedes only that arguments submitted by the Applicant were in response to *new issues and documents submitted by the Opposer*, which is precisely the purpose of such a brief. Opposer has submitted no facts, no evidence and no theories to support his contention that *any* arguments submitted by the Applicant were "improper."

OPPOSER'S CLAIM OF AN EXCESSIVE BRIEF LENGTH IS ERRONEOUS

Secondly, the Opposer has objected to Applicant's Brief on the basis that a reply brief should not exceed ten pages in length. As mentioned above, the brief submitted was both a reply brief, and an objection or "motion to strike" Opposer's Memorandum and Declaration, which was void and inadmissible for a number of reasons as outlined in Applicant's Reply and Objection. A ten page maximum is allowed for a reply brief, and twenty-five pages for a motion to strike. See 37 C.F.R. 2.127(a) Fully nine pages of the document submitted by Applicant (from page 2 through 10) deal strictly with supporting the objection or motion to strike the Opposer's Declaration. This leaves a total of seven pages of actual "reply brief" some of which also discusses striking the Opposer's Declaration. As nine pages submitted is within the 25 page limit for a motion, and seven pages is within the 10 page limit for a reply, Opposer's Motion to Strike on this basis is mere hyperbole.

Certainly, in the interest of judicial economy, a brief consisting of sixteen pages instead of the thirty-five pages allowed under the rules is not excessive. In the alternative, if the Board should decide to Strike Applicant's Brief, Applicant respectfully requests leave to file a separate reply or objection (motion to strike) or both.

**OPPOSER'S THIRD SUBMISSION OF OPPOSER'S DECLARATION IS NOT
ADMISSIBLE UNDER 37 C.F.R. 2.127(e)(1)**

Opposer has re-submitted, for the third time, the declaration of Mark D. Tannen, the Opposer's "Exhibit A" to his motion. In doing so, Opposer has submitted a declaration that appears identical with the second declaration that was submitted on May 28, 2002, except for the attestation by the declarant, which is apparently in response to Applicant's Objection/Motion to Strike and Reply Brief and correction of a typographical error in paragraph seven of the declaration (changing the word "won" to "own"). In spite of the fact that the attestation *now* states "under penalty of perjury that the foregoing is true and correct," the body of the declaration still asserts facts "on information and belief" contrary to the Federal Rules, and contains exhibits which are similarly not admissible as detailed in Applicant's Objection/Motion to Strike and Reply Brief.

The attachment of this *third* declaration appears to be an attempt on the part of the Opposer to circumvent 37 C.F.R. 2.127(e)(1) which states that a reply brief in a Motion for Summary Judgment is the last brief allowed, and that "[n]o further papers in support of or in opposition to a motion for summary judgment will be considered by the Board." Applicant therefore moves to strike this document as improperly submitted under 37 C.F.R. 2.127(e)(1).

CONCLUSION

In conclusion, Applicant Jay Mack respectfully requests that the Board deny Opposer's Motion to Strike Applicant's Reply Brief and strike Opposer's "Supplemental Corrected Declaration" submitted as "Exhibit A" to Opposer's Motion to Strike. In the alternative, if the Board should decide to Strike Applicant's Brief, Applicant respectfully requests leave to file a separate reply or objection (motion to strike) or both.

Date: July 5, 2002

Respectfully submitted,



Robert T. Daunt, Esq.

Mark W. Good, Esq.

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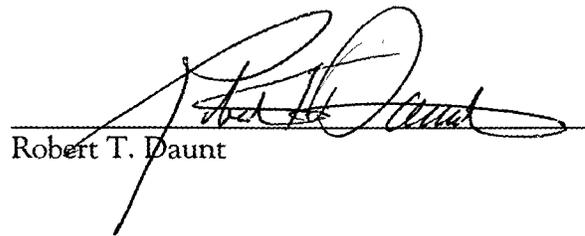
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Attorneys for Applicant,
JAY MACK

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S REPLY TO OPPOSER'S MOTION TO STRIKE APPLICANT'S REPLY BRIEF AND OBJECTION TO OPPOSER'S MEMORANDUM AND DECLARATION IN SUPPORT OF OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT was mailed FIRST CLASS mail, postage prepaid, this 5th day of July, 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