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

COLUMBIA INSURANCE COMPANY and  
H.H. BROWN SHOE COMPANY, INC.,

Opposers,

vs.

LENWORTH ALEXANDER HYATT,

Applicant.

01-27-2003  
U.S. Patent & TMO/TM Mail Rpt Dt. #30

Opposition No. 91151757

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**RESPONSE TO APPLICANT'S MOTION FOR  
JUDGMENT FOR PLAINTIVE'S FAILURE TO PROVE  
CASE AND REPLY TO APPLICANT'S RESPONSE  
TO OPPOSERS' MOTION FOR SUMMARY JUDGMENT**

Opposers Columbia Insurance Company ("Columbia") and H.H. Brown Shoe Company, Inc. ("H.H. Brown") (Columbia and H.H. Brown shall hereinafter collectively be referred to as "Opposers"), by their attorneys, hereby submit their response to Applicant Lenworth Alexander Hyatt's ("Applicant") Motion for Judgment for Plaintiff's (sic) Failure to Prove Case.<sup>1</sup>

<sup>1</sup> In the absence of a formal Response to Opposers' original Motion for Summary Judgment, Opposers are treating Mr. Hyatt's Motion as both a response to their Motion and a cross-motion for summary judgment.

9

I. **RESPONSE TO CROSS-MOTION**

A. **Applicant's Motion Should Be Denied In its Entirety**

**Applicant's Motion Should Be Stricken As Untimely**

In his Motion, Applicant asserts that Opposers (there referred to as "Plaintive") have failed to prosecute the instant opposition, and seeks dismissal of the opposition on that ground. In support, he notes that "Plaintive (sic) has not taken any evidence, or offered any evidence in support of Opposition No. 151,757." The basis for Applicant's assertion and motion is 37 C.F.R. § 2.132(a) and (b).

The section of the Trademark Rules referred to by Applicant refers to a failure to take testimony. Clearly, this case has not yet reached that stage. In fact, the discovery period will not otherwise close (absent the pending summary judgment motions) until March 15, 2003. Thus, on its face, Applicant's motion should be stricken as untimely. Nevertheless, since Opposers are treating Applicant's Motion as a response to their own motion for summary judgment, they submit the following reply:

B. **Applicant Has Not Demonstrated That Genuine Issues Of Material Fact Exist**

To avoid a finding of summary judgment, the non-moving party must demonstrate that material issues of fact exist. Rule 56(e). By reviewing each of the nine sentences comprising Applicant's Response, it becomes clear that Applicant has not met his burden, and that summary judgment is appropriate.

Applicant's first paragraph states that Opposers' attorneys filed a motion for summary judgment **after failing to respond to Defendant's Request to Produce Documents and Things**. This argument is flawed.

Since Opposers filed a potentially dispositive motion (namely, one for summary judgment), under TTAB rules, the action is suspended pending disposition of that motion. See 37 C.F.R. § 2.127(d) ("When any party files . . . a motion or summary judgment . . . the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order."). Accordingly, when their motion for summary judgment was filed, their obligation to respond to Applicant's outstanding discovery requests ceased.<sup>2</sup> Clearly, no issue exists here.

The second sentence notes that "custodian for Opposers (sic) attorneys retrieve from the United States Post Office Certified Mail which contain Applicant / Defendant, Request to Produce Documents and Things." While Opposers do not dispute the veracity of Applicant's statement, it is irrelevant. As discussed above, Opposers, as a result of their filing a motion for summary judgment, were not required to respond to Applicant's outstanding discovery.

In the third sentence, Applicant asserts that "Opposers' attorneys failed to comply with a thirty (30) day period granted in which to reply to Request to Produce Documents and Things." First, Opposers' deadline by which to respond to said discovery requests

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<sup>2</sup> Of course, if the Board dismisses the parties' motions and restarts this action, Opposers' obligation to respond to the outstanding discovery will be reinstated as well.

was January 6, 2003<sup>3</sup> – four days **after** Applicant filed his motion. Second, as already discussed in detail, no response was necessary due to the filed summary judgment motion.

In the fourth and fifth sentences, Applicant attempts to make hay from what are obviously typographical errors. Logically, it would make no sense for Opposers to seek summary judgment against its own interest. Furthermore, the body of the brief amply demonstrates why Opposers' motion should be granted. Once the typographical errors are corrected, this issue disappears.

In sentence six, Applicant argues that since Opposers' counsel did not put in a Notice of Appearance until August 14, 2002, any discovery served upon it prior to that date should be deemed non-existent. This argument also fails.

There is no requirement, in either the Federal Rules of Civil Procedure or the Trademark Rules, requiring counsel representing parties to submit Notices of Appearance. Rather, they are filed by counsel to notify both the Board and the adversary about a change in counsel, which, in turn, allows for efficient correspondence between the parties or between the Board and the parties.

In the instant action, Opposers' counsel took responsibility for this matter in May 2002, when Opposers' entire trademark portfolio was transferred to it. The fact that Opposers' new counsel did not immediately file a Notice of Appearance is a technical issue, and did not cause harm to either Applicant or Opposers.

However, if Applicant was confused by the fact that one law firm had filed the Notice of Opposition and another served discovery requests, he had several options --- none of which was to simply ignore them. He could have written or called either firm to

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<sup>3</sup> This date takes into account the five additional days allowed due to service by mail.

learn which firm was properly representing Opposers. Alternatively, he could have simply responded to the requests, sending them to the firm that issued them. Finally, he could have affirmatively objected to their submission prior to or at the time they were due. Instead, Applicant did nothing. To reward Applicant for failing to timely respond, object or even acknowledge the outstanding discovery is not what the procedural aspects of an opposition proceeding are designed to do.

In the seventh sentence, Applicant asserts that “[a]ttorneys for Opposers have failed to prove by United States Postal Confirmation that Opposers served Interrogates (sic), Request for Production of Documents and Requests for Admissions to Applicant on July 22, 2002.” Opposers’ proof consists of the Certificates of Service which accompanied the various discovery requests. Copies of those Certificates are annexed hereto as Exhibit A.

Tellingly, Applicant does not complain that he never received the various requests, only that Opposers have no proof they were served. The Certificates of Service annexed to this Response constitute sufficient proof of service under the Trademark Rules. *See* 37 C.F.R. § 2.119(b)(4). Moreover, since Applicant clearly received Opposers’ Motion for Summary Judgment, it can be concluded that he also received the discovery requests which form the basis for Opposers’ motion.

Sentences 8 and 9 simply do not make any sense. Presumably, Applicant wanted to state that there were issues of material fact. However, he has submitted nothing to controvert Opposers’ assertions concerning the discovery requests and Applicant’s failure to reply thereto. It is black letter law that a party opposing a summary judgment motion must to more than merely assert that material facts exist. *See Rule*

56(e) Fed. R. Civ. P. (“When a motion for summary judgment is made and supported as provide in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party’s pleading, but the adverse party’s response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. **If the adverse party does not so respond summary judgment, if appropriate, shall be entered against the adverse party.**” (emphasis added) ). Applicant submitted nothing at all to controvert Opposers’ statements in their motion. Thus, summary judgment is warranted here.

Finally, in sentence nine, Applicant makes reference to Rules 56(a) and (b), and even quotes therefrom. However, the quote in question is not from the Rules cited by Applicant. Nevertheless, Opposers have pleaded the issues required to allow this Honorable Board to find summary judgment in their favor.

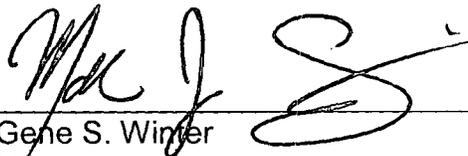
#### **IV CONCLUSION**

In his response, Applicant has made no showing whatsoever that a genuine issue of material fact exists. Instead, he notes the existence of two typographical (and illogical) errors in Opposers’ moving papers. In addition, he claims that Opposers’ counsel’s delay in submitting a formal Notice of Appearance eliminated his need to serve a timely objection

or response. Applicant's claim is without merit, and Opposers' motion should be granted in its entirety.

Dated: January 22, 2003

Respectfully submitted,

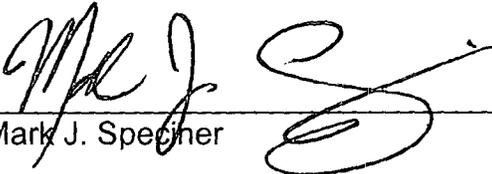
A handwritten signature in black ink, appearing to read 'Mark J. Speciner', written over a horizontal line.

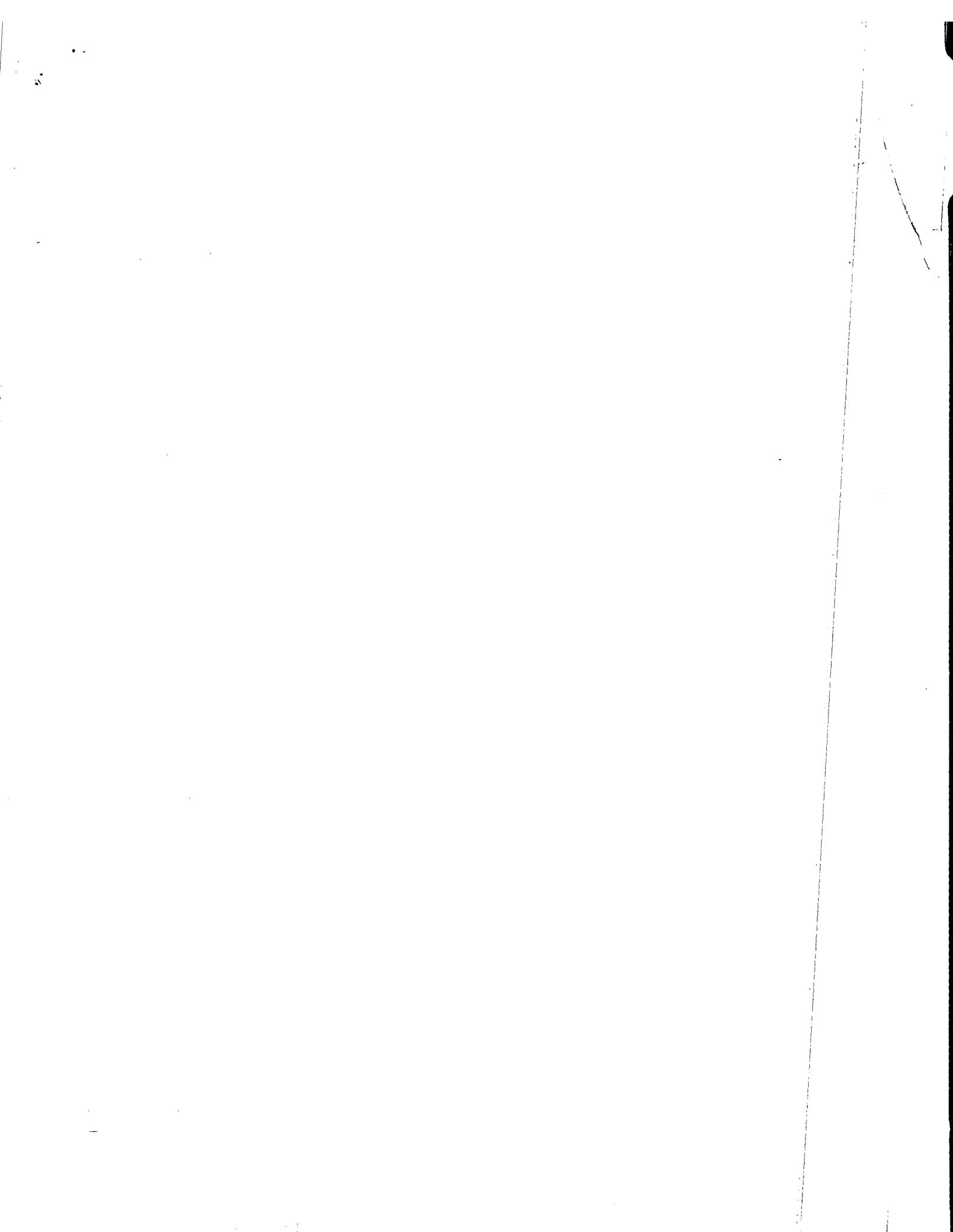
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986 Bedford Street  
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Attorneys for Opposers

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing Response To Applicant's Motion For Judgment For Plaintive's Failure To Prove Case And Reply To Applicant's Response To Opposers' Motion For Summary Judgment was served this 22<sup>nd</sup> day of January, 2003, via First-Class mail to:

Lenworth Alexander Hyatt  
P.O. Box 4864  
Hollywood, FL 33083

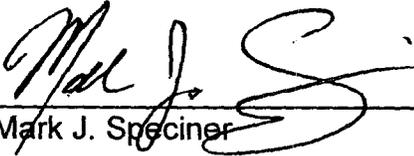
  
\_\_\_\_\_  
Mark J. Spechner



CERTIFICATE OF SERVICE

I hereby certify that on this 22<sup>nd</sup> day of July, 2002, I placed a true and correct copy of the foregoing Opposer's First Set of Requests to Admit to applicant by placing same in the U.S. mail, postage prepaid, addressed to:

Lenworth Alexander Hyatt  
P.O. Box 4864  
Hollywood, FL 33083

  
Mark J. Speciner

CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of July, 2002, I placed a true and correct copy of the foregoing Opposer's First Set of Interrogatories to Applicant to Applicant by placing same in the U.S. mail, postage prepaid, addressed to:

Lenworth Alexander Hyatt  
P.O. Box 4864  
Hollywood, FL 33083

  
\_\_\_\_\_  
Mark J. Speciner

CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of July, 2002, I placed a true and correct copy of the foregoing Opposer's First Requests for Production to Applicant to opposing counsel by placing same in the U.S. mail, postage prepaid, addressed to:

Lenworth Alexander Hyatt  
P.O. Box 4864  
Hollywood, FL 33083

  
Mark J. Speciner