

Member of California
and Oregon State Bars

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April 2, 2009

Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

78/029,875

Re: Message In A Bottle, Inc. vs. Cangiarella and Related Counterclaim
Opposition No. 91162780

Ladies/Gentlemen:

I am enclosing Opposer Message In A Bottle, Inc.'s Motion for Partial Reconsideration of Order Re: Motion to Strike Applicant's Notice of Reliance, along with a certificate of service on the applicant. I am also enclosing a declaration in support of the motion, also accompanied by a certificate of service. Please file these documents and render your decision on the opposer's motion.

Very truly yours,



Peter H. Smith

PHS/clf

Enclosures

cc: Mr. Roger Rojas, Message In A Bottle, Inc.

04-03-2009

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

<p>MESSAGE IN A BOTTLE, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>KEITH CANGIARELLA,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No.: 91,162,780</p> <p>Application Serial No.: 78/229,875</p> <p>Mark: MESSAGE IN A BOTTLE</p>
<p>KEITH CANGIARELLA,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>MESSAGE IN A BOTTLE, INC.,</p> <p style="text-align: center;">Registrant.</p>	<p>Counterclaim for cancellation</p> <p>Registration No.: 2,243,269</p> <p>Mark: MESSAGE IN A BOTTLE</p>
<p>OPPOSER MESSAGE IN A BOTTLE, INC.'S MOTION FOR PARTIAL RECONSIDERATION OF ORDER RE: MOTION TO STRIKE APPLICANT'S NOTICE OF RELIANCE</p>	

I. INTRODUCTION

OPPOSER MESSAGE IN A BOTTLE, INC. ("Opposer") hereby moves, pursuant to TMEP §518, for partial reconsideration of the Board's March 17, 2009 Order granting Opposer's motion to strike portions of Applicant Keith Cangiarella's ("Applicant") notice of reliance. Specifically, Opposer requests reconsideration of the portion of the order granting Applicant additional time to conduct a testimonial deposition on the grounds

that, as specified below, reopening Applicant's testimony period is an improper remedy to cure a defective notice of reliance and Opposer will be unfairly prejudiced by the additional testimony period granted.

II. FACTS

A. Procedural History

The current proceeding has been pending since October 21, 2004, when Opposer filed its opposition proceeding against Applicant. When things were finally headed toward trial in 2006, Applicant filed a motion on July 5, 2006, for summary judgment on matters where there were obviously genuine issues of material fact, namely likelihood of confusion and alleged fraud. Because of the importance of the motion, Opposer was forced to spend substantial sums in responding to it. The motion was then denied by the Board on June 18, 2007, on the basis that summary judgment was not appropriate because there were, indeed, genuine issues of material fact as to likelihood of confusion and the alleged fraud. Smith Decl. Ex. A.

Not to be deterred, Applicant then filed a second summary judgment motion on August 20, 2007, alleging that Opposer's mark was descriptive and/or generic, and also that Opposer had committed fraud (one of the grounds of the first motion). Subsequent thereto, Applicant also filed a motion to dismiss the opposition and disallow an affidavit of Roger Rojas because of an alleged dissolution of Opposer's corporation, and a motion to amend Applicant's counterclaim to include a genericness allegation. In fact, Applicant's allegation of descriptiveness was inappropriate because Opposer's registration was at that point over five years old and its Section 8 & 15 affidavits had

been filed, no allegation of genericness had been pleaded in Applicant's counterclaim, and the Board had already held that there was a genuine issue of material fact as to the alleged fraud. The Board denied the second summary judgment motion and the two additional motions of Applicant on January 28, 2008. Smith Decl. Ex. B. The Board agreed with Opposer's arguments as set forth above, and also stated that Opposer had merely changed its name rather than dissolving its corporation and that Applicant could not amend his counterclaim to assert genericness since he had unduly delayed in moving to do so. The Board made a point of saying that it would not entertain any more summary judgment motions, and that the case would then proceed to trial.

Applicant then filed a request for reconsideration on February 20, 2008, and Opposer again was required to incur additional expenses in responding. The Board wasted no time in denying the request on February 27, 2008, noting that Applicant "... merely reargued points previously raised ...". Smith Decl. Ex. C.

The above ploys by Applicant have cost Opposer over \$13,000.00 in legal fees. See Smith Decl.

B. Motion to Strike Notice of Reliance and Sur-Reply.

On June 24, 2008, Opposer filed a Motion to Strike Applicant's Notice of Reliance. See Motion to Strike Applicant's Notice of Reliance. Opposer's motion was generally based on two grounds. First, that many of the documents sought to be introduced were not admissible via a notice. *Id.* Second, that many of the documents, while potentially admissible under a notice, were procedurally defective. *Id.* On or about July 13, 2008 Applicant filed a sur-reply to Opposer's reply to Applicant's opposition to

the motion to strike. On July 16, 2008 Opposer filed a motion to strike Applicant's sur-reply. The cost of legal fees to Opposer was approximately \$2,600.00 more in connection the motion. See Smith Decl. On or about March 17, 2009 the Board granted Opposer's motions in their entirety, but re-opened Applicant's testimony period to allow him the option of conducting a testimonial deposition. Smith Decl. Ex. D.

C. Impact On Opposer

Applicant's repeated attempts to bring spurious motions has created a significant financial burden for Opposer. Opposer's counsel estimates that responding to the above motions and filing and defending its motion to strike has cost Opposer a total of approximately \$15,600.00. (See Smith Decl.) Opposer is a small, family-owned business which has not absorbed these costs lightly, and dealing with the further costs of revisited testimony periods in the current economic climate is daunting to it.

III. ARGUMENT

A. Re-Opening Applicant's Testimony Period Is Not The Proper Remedy For A Procedurally Defective Notice Of Reliance.

When a motion to strike documents included in a notice of reliance on procedural grounds is granted, the Board may grant the non-moving party leave to re-file those documents that would have otherwise been admissible under 37 C.F.R. § 2.122 if the defects with the documents can be cured. *M-Tek, Inc. v. CVP Systems, Inc.*, 17 U.S.P.Q.2d 1070, 1073 (TTAB 1990) (documents produced in response to interrogatories may be introduced via a notice of reliance); *see also Weyerhaeuser v. Katz*, 1992 WL 280638 *4 (Trademark Tr. & App. Bd.) (official records, if designated as such and

relevance is stated, may be introduced via notice of reliance). Declarations of a party or non-party are not documents admissible under a notice of reliance. *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1722 (TTAB 1999).

In his notice of reliance, Applicant sought to introduce a number of documents that were either not admissible via a notice or were procedurally defective. *See* Opposer's Motion to Strike Applicant's Notice of Reliance filed June 24, 2008. Many of those documents, such as Applicant's declaration and internet newsgroup postings, are not admissible via a notice of reliance under any circumstances. Other documents Applicant sought to introduce, *e.g.* a state trademark registration, may be admissible via a notice if they comply with 37 C.F.R. § 2.122(e) and the Federal Rules of Evidence.

Because Applicant's declaration is not admissible via a notice of reliance it should be excluded and Applicant should not be granted additional time in which to conduct a testimonial deposition. While the permissible remedy under *M-Tek* and *Weyerhaeuser* is to allow Applicant to file a substitute notice of reliance only as to those documents that are otherwise admissible via that procedure, in light of Applicant's repeated violations of the TBMP and filing of frivolous motions, Opposer contends Applicant should not even be granted that remedy. Regardless, at the very least, Applicant should not be granted additional time in which to conduct a testimonial deposition.

As demonstrated by the procedural history of this matter, Applicant has flagrantly violated the rules of the TBMP by filing multiple frivolous motions. Responding to Applicant's two motions for summary judgment and two additional vexatious motions has already cost Opposer over \$13,000.00. (See Smith Decl.) Allowing Applicant

additional time to conduct a testimonial deposition will increase those costs even more as Applicant, based on his pattern of behavior so far, is likely to disregard the rules of the TBMP and of Federal Civil Procedure and Evidence at that deposition. This will result in significant additional expenses to Opposer in having to attend the deposition and most likely object to much of the testimony at the deposition as well as filing a motion to strike inadmissible evidence that Applicant will likely seek to introduce through his deposition.

As stated in TBMP § 114.01, "Because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that an attorney familiar with trademark law represent a party." Applicant has chosen to ignore that advice. He should not be rewarded for doing so by being allowed to conduct a testimonial deposition that should have been conducted prior to the expiration of his testimony period.

IV. CONCLUSION

For the reasons set forth above, Opposer respectfully requests the Board to reconsider that portion of its March 17, 2009 order allowing Applicant additional time to conduct his testimonial deposition. This proceeding needs to be brought to trial.

Respectfully submitted,

MESSAGE IN A BOTTLE, INC.

By its attorney,



PETER H. SMITH
1535 J Street, Suite A
Modesto, CA 95354
(209) 579-9524

Date: April 2, 2009

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer Message In A Bottle, Inc.'s Motion for Partial Reconsideration of Order Re: Motion to Strike Applicant's Notice of Reliance was mailed first-class mail, postage prepaid, to Keith Cangiarella, 33 N. Harrington Drive, Fullerton, California 92831, on April 2, 2009.

Dated: April 2, 2009



PETER H. SMITH

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

MESSAGE IN A BOTTLE, INC., Opposer, v. KEITH CANGIARELLA, Applicant.	Opposition No.: 91,162,780 Application Serial No.: 78/229,875 Mark: MESSAGE IN A BOTTLE
KEITH CANGIARELLA, Petitioner, v. MESSAGE IN A BOTTLE, INC., Registrant.	Counterclaim for cancellation Registration No.: 2,243,269 Mark: MESSAGE IN A BOTTLE
DECLARATION OF PETER H. SMITH	

I, Peter H. Smith, being duly sworn, make the following declaration in support of Opposer Message In A Bottle, Inc.'s Motion for Partial Reconsideration of Order Re: Motion to Strike Applicant's Notice of Reliance, filed simultaneously herewith:

1. I am an attorney at law, duly licensed to practice law in the State of California, and am the attorney for opposer herein, Message In A Bottle, Inc. ("Opposer").

2. I filed the original opposition proceeding herein for Opposer on or about October 21, 2004.

3. On or about July 5, 2006, Keith Cangiarella, the applicant herein ("Applicant"), filed a motion for summary judgment. In my view, the motion was frivolous, but due to the importance of the motion, I spent over 25 hours preparing Opposer's response, and the cost to Opposer for legal fees was approximately \$6,325.00. The Trademark Trial & Appeal Board ("TTAB") denied the motion on June 18, 2007, as set forth in Exhibit A hereto.

4. Applicant filed a second motion for summary judgment on August 20, 2007, a motion to dismiss the opposition proceeding and disallow an affidavit of Roger Rojas on October 10, 2007, based on an alleged dissolution of Opposer's corporation, and a motion to amend Applicant's counterclaim to include a genericness allegation on October 26, 2007. Again, in my view, these motions were frivolous, but due to their importance, I spent almost 20 hours responding to the second summary judgment motion and about 4.6 hours responding to the other two motions. The total cost to Opposer in legal fees was approximately \$6,063.00. All of Applicant's motions were denied by the TTAB in a decision dated January 28, 2008, a copy of which is attached hereto as Exhibit B.

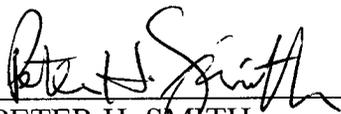
5. On February 20, 2008, Applicant filed a request for reconsideration of the Board's decision of January 28, 2008. I spent approximately 2.55 hours preparing a response to this request, and the cost to Opposer in legal fees was approximately \$638.00.

The TTAB denied the request on February 27, 2008, and a copy of its denial is attached hereto as Exhibit C.

6. On May 27, 2008, Applicant filed a notice of reliance herein. Due to the deficiencies in the notice, I filed a motion to strike on behalf of Opposer on June 24, 2008. Applicant filed a reply, to which I replied, and the Applicant filed a further sur-reply. The cost to Opposer for legal fees in connection with these matters was approximately \$2,600.00. Robert Coggins, Interlocutory Attorney for the TTAB, granted Opposer's motion to strike in a decision dated March 17, 2009, a copy of which is attached hereto as Exhibit D.

The foregoing facts are true of my own knowledge. I am competent to testify to such facts, and would so testify if I appeared before the Board as a witness.

Dated: April 2, 2009



PETER H. SMITH

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Declaration of Peter H. Smith was mailed first-class mail, postage prepaid, to Keith Cangiarella, 33 N. Harrington Drive, Fullerton, California 92831, on April 2, 2009.

Dated: April 2, 2009



PETER H. SMITH

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: June 18, 2007

Opposition No. 91162780

GOLD SHELLS, INC.

v.

KEITH CANGIARELLA

Before Hohein, Drost, and Walsh,
Administrative Trademark Judges.

By the Board:

Keith Cangiarella ("applicant") seeks to register the mark MESSAGE IN A BOTTLE¹ for "novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing" in International Class 16.

Gold Shells, Inc. ("opposer") has opposed registration of applicant's mark on the grounds that applicant's applied-for mark so resembles opposer's registered mark that it is likely to cause confusion, mistake, or deception of

¹ Application Serial No. 78229875, filed on March 25, 2003, alleging March 10, 1998 as a date of first use and June 10, 1998 as a date of first use in commerce.

Opposition No. 91162780

prospective consumers under Section 2(d) of the Lanham Act and consists of matter which may falsely suggest a connection between applicant and opposer in violation of Sections 2(a). In its notice of opposition, opposer pleaded ownership of the mark MESSAGE IN A BOTTLE² for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others" in International Class 38.

Applicant, in his answer, has denied the salient allegations of the notice of opposition and asserted certain affirmative defenses. In addition, applicant asserted a counterclaim to cancel opposer's pleaded registration on the ground of fraud in obtaining its registration. Opposer, in its answer to applicant's counterclaim, has denied the salient allegations thereof and asserted various affirmative defenses.

This case now comes up for consideration of applicant's motions (filed July 5 and 6, 2006) for summary judgment in his favor on the ground of likelihood of confusion and with respect to the cancellation of opposer's pleaded registration on the ground of fraud. Opposer filed a combined response to both motions.

² Registration No. 2243269, issued May 4, 1999, alleging January 16, 1999 as the date of first use anywhere and in commerce.

Opposition No. 91162780

Summary judgment is an appropriate method of disposing of cases that present no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). Here, applicant, as the moving party, has the burden of demonstrating the absence of any genuine issue of material fact, and that he is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 852, 23 USPQ2d 1471 (Fed. Cir. 1992).

After reviewing the arguments and supporting evidence, we find that applicant has failed to meet his burden of establishing that there are no genuine issues of material fact and that he is entitled to judgment as a matter of law. At a minimum, genuine issues of material fact exist as to whether the parties' respective goods and services are similar in nature, whether they travel in similar channels of trade, and to what extent they are marketed to overlapping classes of customers. Additionally, genuine

Opposition No. 91162780

issues of material fact exist as to opposer's intent to commit fraud in the procurement of its pleaded registration.

In view thereof, applicant's motions for summary judgment are hereby denied.³

Proceedings herein are resumed. See Trademark Rule 2.127(d). Discovery has closed. Trial dates are reset as follows.

THE PERIOD FOR DISCOVERY TO CLOSE: CLOSED

Testimony period for plaintiff in the opposition to close: (opening thirty days prior thereto) 9/21/2007

Testimony period for defendant in the opposition and as plaintiff in the counterclaim to close: (opening thirty days prior thereto) 11/20/2007

Testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close: (opening thirty days prior thereto) 1/19/2008

Rebuttal testimony period for plaintiff in the counterclaim to close: (opening fifteen days prior thereto) 3/4/2008

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

³ The parties should note that the evidence submitted in connection with applicant's motions for summary judgment is of record only for consideration of the motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Opposition No. 91162780

Brief for plaintiff in the opposition shall be due: 5/3/2008

Brief for defendant in the opposition and as
Plaintiff in the counterclaim shall be due: 6/2/2008

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due: 7/2/2008

Reply brief (if any) for plaintiff in the
counterclaim shall be due: 7/17/2008

In each instance, a copy of the transcript of
testimony, together with copies of documentary exhibits,
must be served on the adverse party within thirty days after
completion of the taking of testimony. Trademark Rule
2.125.

Briefs shall be filed in accordance with Trademark
Rules 2.128(a) and (b). An oral hearing will be set only
upon request filed as provided by Trademark Rule 2.129.

Goodman

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

Mailed: January 28, 2008

Opposition No. 91162780

Message in a Bottle, Inc.
f/k/a/ Gold Shells, Inc.

v.

Keith Cangiarella

Before Hohein, Drost and Walsh, Administrative Trademark
Judges.

By the Board:

This case now comes up on the following motions:

- 1) applicant's second motion for summary judgment,
filed August 20, 2007;
- 2) applicant's motion to dismiss the opposition and to
disallow the affidavit of Roger Rojas, filed
October 10, 2007; and
- 3) applicant's motion to amend his petition to cancel,
filed October 26, 2007.¹

We turn first to applicant's motion to dismiss based on
applicant's assertion that opposer Gold Shells Inc. "ceased
to exist" and that "opposer's predecessor failed to notify
the Board or the USPTO and has forfeited its rights to
oppose."

¹ The Board construes this filing as a motion to amend the
counterclaim.

Opposition No. 91162780

In response, opposer advises that applicant's assumption that opposer has dissolved is false, inasmuch as it "simply changed its name to Message In A Bottle, Inc. which has no effect on the present proceeding."

Inasmuch as opposer has not been dissolved but effected a change of name, applicant's motion to dismiss is denied. The Board has changed the title of this proceeding to reflect opposer's new name. Opposer is advised that recordation of the change of name with the Assignment Branch of the Office is advisable because it facilitates proof of ownership of its pleaded registration. TBMP § 514 (2d. ed. rev. 2004).

We turn next to applicant's motion for leave to amend his counterclaim so as to add claims of genericness and descriptiveness.

It is opposer's position that it is "too late" for applicant to amend the pleadings to add a claim of genericness and, with respect to the descriptiveness claim, such issue is "moot" because this ground is unavailable inasmuch as opposer's pleaded registration is over five years old.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice

Opposition No. 91162780

requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). In deciding applicant's motion for leave to amend, the Board must consider whether there is any undue prejudice to opposer and whether the amendment is legally sufficient. See *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). With regard to prejudice, the timing of the motion for leave to amend is a major factor in determining whether opposer would be prejudiced by allowance of the proposed amendment. See TBMP § 507.02 and cases cited therein.

With regard to applicant's request for leave to amend to add a mere descriptiveness claim,² we agree with opposer that this ground for cancellation is unavailable as the opposition was filed on October 21, 2004, which is more than five years after the May 4, 1999, issuance date of opposer's pleaded registration. Under the Trademark Act, a mere descriptiveness claim must be filed within five years from the date of registration of a mark. See 15 USC § 1064 and TBMP § 307.02. Therefore, applicant's motion to amend to

² With regard to applicant's assertion that it has already pleaded descriptiveness and/or genericness in the original counterclaim, we cannot agree. Applicant's allegation "that the Registrant Roger Rojas intentionally mischaracterized his goods as 'telecommunication services' with the intent to avoid a potential descriptiveness refusal" goes only to applicant's fraud claim.

Opposition No. 91162780

add the mere descriptiveness ground to the counterclaim is denied as legally insufficient.

With regard to the ground of genericness, we find that applicant unduly delayed in asserting such a claim. In the instant case, applicant's request to amend the counterclaim comes nearly three years after the original counterclaim was filed. We find that applicant has offered no sufficient justification as to why he failed to raise the genericness claim sooner. See e.g., *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001) (motion to amend to add dilution claim eight months after filing notice of opposition denied due to undue delay). Moreover, it is apparent that prejudice would result from allowance of such a late motion as it would inject a new issue into the case on the eve of trial.³

Accordingly, applicant's motion to amend to add the counterclaim to add claims of mere descriptiveness and genericness is denied.

We now turn to applicant's second motion for summary judgment in his favor on the grounds of mere descriptiveness, genericness, and fraud.

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is

³ In this regard, it is noted that applicant's second motion for summary judgment was filed one day before opposer's testimony period was scheduled to open.

Opposition No. 91162780

entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

With respect to the grounds of mere descriptiveness and genericness, since we have denied applicant's motion to amend, applicant's second motion for summary judgment as to those grounds is based on unpleaded claims. A party may not obtain summary judgment on unpleaded claims. See Fed. R. Civ. P. 56(a) and 56(b); and *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994). In view thereof, applicant's second motion for summary judgment is denied with respect to the grounds of mere descriptiveness and genericness.

With respect to applicant's second motion for summary judgment on the ground of fraud, we have carefully considered the arguments and evidence presented; however, we find, as we did previously, that genuine issues of material fact exist with respect to applicant's claim of fraud.⁴

⁴ We note that "[a]s a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." See *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Opposition No. 91162780

Accordingly, applicant's second motion for summary judgment is denied as to the ground of fraud.⁵

Additionally, the Board finds that no further summary judgment motions are warranted in this proceeding and that this case should accordingly proceed to trial. Therefore, the parties are advised that the Board will not entertain any further motions for summary judgment.

Proceedings herein are resumed. Trial dates are reset as follows:

Discovery period:	CLOSED
30-day testimony period for plaintiff in the opposition to close:	March 25, 2008
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	May 24, 2008
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	July 23, 2008
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	September 6, 2008
Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	November 5, 2008
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	December 5, 2008

⁵ Applicant's motion to disallow the affidavit of Roger Rojas, submitted in opposition to applicant's motion for summary judgment is denied. The Board notes that the declaration filed with the Board is properly signed and stamped by the notary public and, as noted previously, Gold Shells Inc. was not dissolved but merely effected a change of name.

Opposition No. 91162780

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due:

January 4, 2009

Reply brief (if any) for plaintiff in the
Counterclaim shall be due:

January 19, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * * *

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242 FinalRuleChart.pdf>

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31,

Opposition No. 91162780

2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 27, 2008

Opposition No. 91162780

Message In A Bottle, Inc.
f/k/a Gold Shells, Inc.

v.

Keith Cangiarella

Before Hohein, Drost and Walsh,
Administrative Trademark Judges

By the Board:

On January 28, 2008, the Board issued an order wherein, among other things, it denied Cangiarella's motion for leave to amend his counterclaim to add a ground of genericness thereto. On February 20, 2008, Cangiarella filed a motion for partial reconsideration of that order. Although opposer/counterclaim defendant Message In A Bottle, Inc.'s ("Message") time to respond thereto has not lapsed, the Board, in its discretion, elects to decide the motion for partial reconsideration at this time.¹

Cangiarella asks that the Board reconsider its denial of the motion for leave to amend his counterclaim and allow him to add a genericness ground thereto. Cangiarella argues

¹ On February 21, 2008, the Board suspended this case pending its decision on Cangiarella's motion for partial reconsideration.

Opposition No. 91162780

that he had been represented by an attorney in this case in whose competence he had "faith and trust;" and that, after he began representing himself several years into this case, he acted as quickly as possible upon becoming aware that a genericness claim could be raised herein. Accordingly, Cangiarella contends that "[t]he Board would not want to prejudice [him] for acting pro se" and asks that the Board reconsider the January 28, 2008 order and allow him to add the genericness ground to his counterclaim.

The premise underlying a motion for reconsideration under Trademark Rule 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in the order it issued. Such a motion may not properly be used to reargue points presented in a brief on the original motion. See TBMP Section 518 (2d ed. rev. 2004).

Cangiarella has merely reargued points previously raised in support of his motion for leave to amend his counterclaim and has failed to persuade us that denial of his request to add a genericness ground to his counterclaim was in error. Rather, the Board remains of the opinion that Cangiarella unduly delayed by waiting nearly three years after the initial counterclaim was filed to seek to add the genericness ground thereto and that prejudice to Message would result from Cangiarella being allowed to add that ground on the eve of trial. The failure of Cangiarella's

Opposition No. 91162780

former attorney to seek to add the genericness counterclaim earlier in no way entitles Cangiarella to add that ground at this late juncture. See, e.g., *Williams v. The Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975), *aff'g* 181 USPQ 409 (TTAB 1974).

In view thereof, Cangiarella's request for partial reconsideration of the January 28, 2008 order is denied. Proceedings herein are resumed. Testimony periods are reset as follows.

30-day testimony period for
plaintiff in the opposition to close: April 4, 2008

30-day testimony period for defendant in the opposition
and as plaintiff in the counterclaim to close: June 3, 2008

30-day testimony period for defendant
in the counterclaim and its rebuttal testimony
as plaintiff in the opposition to close: August 2, 2008

15-day rebuttal testimony period for plaintiff
in the counterclaim to close: September 16, 2008

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: November 15, 2008

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: December 15, 2008

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition is due: January 14, 2009

Opposition No. 91162780

Reply brief (if any) for plaintiff in the
counterclaim shall be due:

January 29, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 17, 2009

Opposition No. 91162780

Message In A Bottle, Inc.
f/k/a Gold Shells, Inc.

v.

Keith Cangiarella

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on opposer's motion (filed June 24, 2008) to strike applicant's testimonial declaration and the exhibits attached thereto, and opposer's motion (filed July 16, 2008) to strike applicant's sur-reply. On March 16, 2009, at approximately 2:15 p.m. Eastern time, the Board exercised its discretion to conduct a telephone conference to determine the outstanding motions. Participating in the conference were Keith Cangiarella, applicant, appearing *pro se*; Peter Smith, counsel for opposer; and the above-signed Board attorney responsible for resolving interlocutory matters in these cases.

During the conference, the Board considered the statements made and questions raised by both parties, as well as the supporting motions and record of this case. The Board presumes familiarity with the issues, and for the sake

Opposition No. 91162780

of efficiency this order does not summarize the parties' arguments in the motions, or the statements or questions raised during the telephone conference. Instead, this order lists the decisions made by the Board.

Motion to Strike Testimonial Declaration

Opposer's motion to strike is granted. Accordingly, applicant's testimony declaration and the exhibits attached thereto, which were submitted with applicant's notice of reliance, will be given no further consideration by the Board. Applicant's exhibits H, I, J¹, J¹, and A --which exhibits are the subject of applicant's notice of reliance, were submitted separately from (though concurrently with) the testimonial deposition, and were not the subject of opposer's motion to strike --remain in evidence and will be accorded whatever probative value they may have.

Motion to Strike Sur-Reply

Opposer's motion to strike is granted. Accordingly, applicant's sur-reply in opposition to the motion to strike the testimonial declaration was given no consideration.

¹ Applicant labeled two separate exhibits attached to the notice of reliance as Exhibit J: a "combined affidavit of use and incontestability" and "opposer's responses to applicant's request for admissions." These remain in evidence. The Board notes that applicant also attached an Exhibit J to his testimonial declaration; however, as noted *supra*, the declaration and the exhibits attached thereto (including the additional Exhibit J which purports to be a fictitious business name statement) are stricken.

Schedule Reset

Testimony periods are reset as follows to allow applicant time in which to conduct a testimonial deposition should applicant so choose.²

30-day testimony period for
plaintiff in the opposition to close: Closed

30-day testimony period for defendant in the opposition
and as plaintiff in the counterclaim to close: May 18, 2009

30-day testimony period for defendant
in the counterclaim and its rebuttal testimony
as plaintiff in the opposition to close: July 17, 2009

15-day rebuttal testimony period for plaintiff
in the counterclaim to close: August 31, 2009

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: October 30, 2009

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: November 29, 2009

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due: December 29, 2009

Reply brief (if any) for plaintiff in the
counterclaim shall be due: January 13, 2010

² This is not an order compelling a testimonial deposition. Dates are reset to allow applicant to conduct his own testimonial deposition should he so choose.

Opposition No. 91162780

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>