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

Proceeding	91164764
Party	Defendant The Brinkmann Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED, Opposer, v. THE BRINKMANN CORPORATION, Applicant.	Opposition No. 91164764

APPLICANT BRINKMANN'S COMBINED (1) OPPOSITION TO OPPOSER'S MOTION TO STRIKE SUR-REPLY AND (2) CROSS-MOTION TO STRIKE OPPOSER'S REPLY RE MOTION FOR PARTIAL SUMMARY JUDGMENT TO DISMISS APPLICANT'S PRIOR REGISTRATION AFFIRMATIVE DEFENSE

Applicant The Brinkmann Corporation ("Brinkmann") hereby files this combined (1) opposition to the motion to strike Applicant's sur-reply filed by Opposer Brink's Network, Incorporated ("Brink's Network"), and (2) cross-motion to strike Opposer's reply in support of Opposer's motion for partial summary judgment to dismiss Applicant's prior registration affirmative defense.

Applicant Brinkmann filed its sur-reply on March 14, 2011 in order to address a new argument made in Opposer Brink's Network's reply filed on February 24, 2011. For the reasons set forth below, either Applicant's sur-reply should be considered by the Board or Opposer's reply should be stricken in its entirety.

I.

STATEMENT OF FACTS

Opposer Brink's Network filed a motion for partial summary judgment on January 5, 2011 to dismiss Applicant Brinkmann's affirmative defense of prior registration against Opposer's claim of dilution against Applicant. The grounds for Opposer's motion were, *inter alia*, that Applicant's defense was inapplicable because the marks and goods asserted as prior registrations were not identical to the mark and goods applied for in Applicant's present application, as required under *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), and that furthermore, Applicant did not own the third party registrations asserted by Applicant.

Applicant filed its opposition to Opposer's motion on February 9, 2011, explaining that Applicant's prior registration defense is a modified *Morehouse* defense that does not require Applicant's ownership of the prior registrations, and that in any event, Applicant owned three of the asserted prior registrations. Furthermore the modified *Morehouse* defense does not require identical goods because the defense is against Opposer's dilution claim, not its likelihood of confusion claim.

On February 24, 2011, Opposer filed a reply, bringing up a new argument that Applicant is required to demonstrate use of the third party registrations, as required by the dilution factor in section 43(c)(2)(B)(iii) of the Trademark Act, rather than responding to Applicant's position that the modified *Morehouse* prior registration defense does not require common ownership of prior registrations or identity of goods in the dilution context.

Applicant filed a sur-reply on March 14, 2011, in order to address the new argument raised by Opposer in its reply.

II.

DISCUSSION

While Applicant Brinkmann acknowledges that the trademark rules do not provide for sur-replies, fairness dictates that Opposer Brink's Network should not be allowed to raise a new argument for the first time in its reply brief. The Board has the authority to disregard all of the arguments made by Opposer in its reply brief.

A. The Board Should Exercise Its Discretionary Right To Strike Opposer's Reply Brief

Under the Trademark Rules of Practice, reply briefs are not an automatic right. 37 C.F.R. § 2.127(a). "The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere argument of the points made in the main brief. Thus, it remains within the Board's discretion whether to consider a reply brief." TTABMP § 502.02(b), citing *No Fear Inc. v. Rule*, 54 USPQ.2d 1551, 1553 (TTAB 2000); *Wells Fargo & Co. v. Lundeen & Assocs.*, 20 USPQ.2d 1156, 1157 (TTAB 1991) ("[W]hile the Board has exercised its discretion to consider such a brief in circumstances where, in fairness, the moving party must be allowed an opportunity to respond to the allegations of the non-moving party's brief, we see no such circumstances here."). In the past, the Board has exercised that discretion when a reply brief clarified the issues under consideration. *Seculus da Amazonia S/S v. Toyota Jidosha Kaubshiki Kaisha*, 66 USPQ.2d 1154, 1156 n.4 (TTAB 2003) (reply brief considered because it clarified the issues under consideration).

In the present proceeding, Opposer has filed a reply brief that not only fails to clarify the issues under consideration, but confuses them by raising a new and irrelevant argument to Applicant's prior registration defense.

B. Opposer Should Not Be Allowed To Raise A New Argument In Its Reply Brief

In its Reply, Opposer Brink's Network argues for the first time that the prior registration defense asserted by Applicant Brinkmann against Opposer's dilution claim is inapplicable because Applicant has not submitted evidence of third party use of various BRINKS marks, as required under the dilution analysis factor in section 43(c)(2)(B)(iii) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B)(iii). Opposer should not be allowed to bring up in reply a new issue that is irrelevant to Applicant's prior registration defense. *See, e.g., Redmond Prods., Inc. v. ETS, Inc.*, 1998 TTAB LEXIS 337, *2 n.4 (Sept. 18, 1998) (Board did not consider petitioner's trial reply brief because it raised issues not previously raised by either party nor pleaded in the petition to cancel.). Opposer's practice is unfair and does not allow Applicant to properly respond to Opposer's new argument. *See, e.g., Hard Rock Café Licensing Corp. v. Thamas D. Elsea*, 1996 TTAB LEXIS 493, * 1 (Apr. 18, 1996) ("We have not considered applicant's [reply brief and attached supporting exhibits because] [c]onsideration of these materials now, without allowing opposer to address them with argument and evidence, would be unfair."); *Florists' Transworld Delivery, Inc. v. Fresh Intellectual Properties, Inc.*, 2001 TTAB LEXIS 138, *5 (Feb. 9, 2001) (New evidence submitted with movant's reply not allowed because "[s]uch piecemeal prosecution is not permitted."); *Keystone Retaining Wall Systems Inc. v. Westrock, Inc.*, 22 USPQ.2d 1001, 1008 (D. Ore. 1991) (granting motion to strike supplemental affidavit contained in defendant's reply brief because "[p]laintiff was not afforded an opportunity to respond to this evidence, or to address the issue" it pertained to); *KB Home v. Antares Homes Ltd.*, 83 USPQ.2d 1341, 1344 (N.D. Tex. 2007) (granting defendant's motion to strike plaintiff's reply brief containing new argument, filed in lieu of defendant's request to file sur-reply, because the reply brief "deprive[d] the nonmovant of a meaningful opportunity to

respond.") (quoting *Spring Indus., Inc. v. American Motorists Ins.*, 137 F.R.D. 238, 239 (N.D. Tex. 1991); *e2Interactive Inc. v. Blackhawk Network Inc.*, 97 USPQ.2d 1293, 1294 (W.D. Wis. 2010) ("A reply brief is an opportunity to address arguments raised in the opposing party's response, not a chance to introduce new lines of arguments or facts that a movant failed to introduce earlier."). To hold otherwise is a denial of Applicant's due process rights.

C. **If The Board Considers Opposer's Reply Brief, In Fairness The Board Should Also Consider Brinkmann's Sur-Reply Brief**

Opposer Brink's Network should not be allowed to present a new argument for the first time in a reply brief. If the Board considers Opposer's new argument, then it is only fair that the Board consider Applicant Brinkmann's response in its sur-reply in order for the Board to have a clear understanding of the issue at hand. *See, e.g.*, *Soot v. General Electric Co.*, 5 USPQ.2d 1930, 1932-1933 (S.D.N.Y. 1987) (Court granted defendant's motion to strike plaintiff's reply brief, having first directed defendant to file a sur-reply response addressed solely to any new issues raised in plaintiff's reply.). Applicant otherwise has no opportunity, such as oral argument before the Board, to fairly address the new argument raised by Opposer. This is in contrast to cases such as *United Foods, Inc. v. United Air Lines, Inc.*, 33 USPQ.2d 1542 (TTAB 1994), in which the Board granted a respondent's motion to strike a petitioner's overly-long reply brief and ordered filing of substitute brief (not to include any new arguments not already raised in stricken brief). In that case, the Board noted that "[t]o the extent that respondent's claim of prejudice from the now-stricken reply brief relates to alleged improper rebuttal, *respondent will be able to address this issue during the oral argument*." *Id.* at 1543 (emphasis added). In Applicant's present circumstances, no such opportunity exists, which is why Applicant's sur-reply was filed.

III.

CONCLUSION

For the reasons set forth above, Applicant Brinkmann respectfully respects that the Board consider the arguments made in Applicant's sur-reply or to pay no consideration to the new argument made in Opposer Brink's Network's reply.

Dated: April 12, 2011

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CERTIFICATE OF SERVICE

This is to certify that I have this day, April 12, 2011, caused to be served a copy of the foregoing APPLICANT BRINKMANN'S COMBINED (1) OPPOSITION TO OPPOSER'S MOTION TO STRIKE SUR-REPLY AND (2) CROSS-MOTION TO STRIKE OPPOSER'S REPLY RE MOTION FOR PARTIAL SUMMARY JUDGMENT TO DISMISS APPLICANT'S PRIOR REGISTRATION AFFIRMATIVE DEFENSE by placing a copy in the United States Mail, postage pre-paid, addressed to counsel for Opposer as follows:

Alan S. Cooper, Esq.
Wiley Rein LLP
1776 K Street, N.W.
Washington, DC 20006

Susan Hwang