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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION TO STRIKE APPLICANT'S SUR-REPLY MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT DISMISSING APPLICANT'S PRIOR REGISTRATION DEFENSE AND MEMORANDUM IN OPPOSITION TO APPLICANT'S CROSS-MOTION TO STRIKE OPPOSER'S REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT DISMISSING APPLICANT'S PRIOR REGISTRATION DEFENSE

I. INTRODUCTION

On March 23, 2011, Opposer filed a motion to strike Applicant's Sur-Reply Memorandum submitted in opposition to Opposer's motion for partial summary judgment dismissing Applicant's prior registration defense (hereinafter "Applicant's Sur-Reply Memorandum") on the ground that the Sur-Reply Memorandum clearly violates Rule 2.127(a) of the Trademark Rules of Practice.[1]

[1] Rule 2.127(a) provides in pertinent part that once a reply brief in support of a motion has been filed, "[n]o further papers in support of or in opposition to a motion will be considered by the Board."

On April 12, 2011, Applicant filed a paper consisting of: (1) its opposition to Opposer's motion to strike Applicant's Sur-Reply Memorandum, and (2) a "cross-motion" to strike Opposer's Reply Memorandum in support of its motion for summary judgment dismissing Applicant's prior registration defense (hereinafter collectively "Applicant's Reply Memorandum and Cross-Motion"). That paper, however, does not present any authority that recognizes some exception to the precise mandate of Rule 2.127(a). Rather, Applicant seeks to circumvent the preclusive effect of Rule 2.127(a) by filing a "cross-motion" to strike Opposer's Reply Memorandum in support of its motion for partial summary judgment dismissing Applicant's prior registration defense (hereinafter "Opposer's Summary Judgment Reply Memorandum").

As discussed below, Applicant's cross-motion to strike Opposer's Summary Judgment Reply Memorandum is untimely, procedurally inappropriate, and equally important is based on a fundamental mischaracterization of the purpose and content of that Reply Memorandum.

II. ARGUMENT

A. APPLICANT HAS NOT CITED ANY AUTHORITY REQUIRING A WAIVER OF THE CLEAR MANDATE OF RULE 2.127(a) PRECLUDING THE FILING OF A SUR-REPLY MEMORANDUM

Applicant expressly acknowledges that "the trademark rules do not provide for sur-replies." (Applicant's Reply Memorandum and Cross-Motion, p. 3). Applicant has not cited any authority which expressly recognizes a waiver or the inapplicability of Rule 2.127(a). Instead, as discussed below, Applicant is attempting to circumvent Rule 2.127(a) by filing its cross-motion to strike

Opposer's Summary Judgment Reply Memorandum. That end-run tactic, which has only further complicated and prolonged this proceeding, should not be tolerated by the Board.

B. APPLICANT'S CROSS-MOTION TO STRIKE IS AN UNTIMELY AFTERTHOUGHT

Opposer's motion for partial summary judgment seeking the dismissal of Applicant's prior registration defense was filed on January 5, 2011. Applicant filed its Memorandum in opposition to that motion on February 9, 2011 (hereinafter "Applicant's Summary Judgment Opposition Memorandum") and Opposer timely filed its Summary Judgment Reply Memorandum on February 24, 2011. Rather than moving to strike Opposer's Summary Judgment Reply Memorandum on the grounds presented in the paper filed on April 12, 2011, Applicant filed its Sur-Reply Memorandum on March 14, 2011 which plainly is precluded by Rule 2.127(a) as Applicant has acknowledged.

It was only when faced with Opposer's motion to strike Applicant's Sur-Reply Memorandum that Applicant decided to file a cross-motion to strike Opposer's Summary Judgment Reply Memorandum. That delay of almost seven weeks, from February 24, 2011 to April 12, 2011, demonstrates that Applicant's cross-motion to strike is a procedural afterthought which seeks to circumvent the clear mandate of Rule 2.127(a). The Board should not validate such tactics by even considering the cross-motion to strike under these circumstances.

C. APPLICANT'S CROSS-MOTION TO STRIKE IS PROCEDURALLY IMPROPER

Applicant's cross-motion to strike understandably fails to mention TBMP § 517 which addresses the propriety of a motion to strike a brief submitted in connection with a motion:

> "[W]hen a moving brief, an opposition brief, or a reply brief on a motion has been regularly filed, *the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof.* Rather, any objections which an adverse party may have to the contents of such a brief will be considered in its determination of the original motion, and any portions of the brief that are found by the Board to be improper will be disregarded." (Emphasis added.)

Applicant's cross-motion to strike Opposer's Reply Memorandum clearly is contrary to TBMP § 517. But equally important, as discussed below the arguments presented in Opposer's Summary Judgment Reply Memorandum are appropriately directed to points made in Applicant's Summary Judgment Opposition Memorandum.

D. THE ARGUMENTS PRESENTED IN APPLICANT'S CROSS-MOTION TO STRIKE ARE BASED ON A FUNDAMENTAL MIS-CHARACTERIZATION OF THE NATURE AND CONTENT OF OPPOSER'S REPLY MEMORANDUM

Applicant's cross-motion to strike is based on the predicate that Opposer should not be permitted to raise a "new argument" in its Summary Judgment Reply Memorandum. As discussed below, that predicate is fundamentally flawed because the "new argument" is a response to points set forth in Applicant's Summary Judgment Opposition Memorandum which clarifies the issues presented by the summary judgment motion and thus is appropriate for

inclusion in a reply memorandum. *E.g., Westrex Corp. v. New Sensor Corp.,* 83 USPQ2d 1215 (TTAB 2007); *Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha,* 66 USPQ2d 11544 (TTAB 2003).

Applicant's Summary Judgment Opposition Memorandum argues that Applicant is relying on a "modified" *Morehouse* defense that is applicable to a dilution claim under § 13(a). However, that Memorandum does not cite any direct authority for the proposition that there is some recognized "modified" *Morehouse* defense in a dilution context, but instead focuses on what Applicant believes are "fundamental dilution principles and case law" which it argues support such a new defense. (Applicant's Summary Judgment Opposing Memorandum, p. 2.[2]) Accordingly, it was necessary for Opposer to address Applicant's contention that there should be some "modified" prior registration defense which is applicable to a dilution claim and the only opportunity to do so was the Reply Memorandum which Applicant now belatedly and improperly seeks to strike. Opposer's basic argument, as summarized below, clearly is responsive to Applicant's Summary Judgment Opposition Memorandum which attempts to articulate some basis for its "modified" *Morehouse* defense and thus is appropriately included in a Reply Memorandum.

In determining whether dilution is likely, the Board considers the six relevant factors set forth in § 43(c)(2)(B). *E.g., 7-Eleven Inc. v. Wechsler,* 83 USPQ2d 1715 (TTAB 2007). The key factor in the present context is § 43(c)(2)(B)(iii) which is the extent to which the owner of the famous mark is

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[2] Indeed, Applicant expressly has acknowledged that the position it is advancing "may be a case of first impression." (*Id.,* p. 14.)

engaging in substantially exclusive use of the mark alleged to be diluted.[3] Recent Board decisions addressing the § 43(c)(2)(B)(iii) factor have held that third-party registrations are not a sufficient evidentiary predicate for determining that the plaintiff's mark has not been diluted. *Coach Services, Inc. v. Triumph Learning LLC,* 96 USPQ2d 1600, 1614 (TTAB 2010) (third-party registrations of marks cannot support a finding that such registrations have had some negative impact on consumer perception of the opposer's mark); *7-Eleven Inc. v. Wechsler,* 83 USPQ2d at 1729 (applicant's reliance on third-party registrations is insufficient to preclude a finding of dilution).[4] Thus, Applicant's reliance on registrations as the predicate for its "modified" *Morehouse* defense is fundamentally flawed and should be rejected by the Board because the existence of such registrations -- as distinguished from evidence of actual use of those marks -- is not a legitimate evidentiary basis for challenging either fame or dilution.[5] Opposer could not realistically respond to Applicant's position that

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[3] At p. 11 of Applicant's Summary Judgment Opposition Memorandum, Applicant specifically acknowledged that the § 43(c)(2)(B)(iii) factor should be considered in determining whether dilution is likely.

[4] Such a conclusion is analogous to, and fully consistent with, the well-settled principle in a § 2(d) likelihood of confusion context that evidence consisting only of third-party registrations is not an acceptable basis for challenging the strength of the plaintiff's mark because such registrations are not evidence of use of those marks or that they have had some restrictive impact on the scope of protection of the plaintiff's mark. *E.g., San Fernando Electric Mfg. Co. v. JFD Electronics Component Corp.,* 565 F.2d 682 (CCPA 1977); *Tektronix Inc. v. Daktronics, Inc.,* 534 F.2d 915 (CCPA 1976); *In re Helene Curtis Industries, Inc.,* 305 F.2d 492 (CCPA 1962).

[5] Although Applicant's Sur-Reply Memorandum, at p. 4, refers to the use of the marks which are the subject of Applicant's prior registrations, the "modified" *Morehouse* defense pleaded in ¶ 28 of Applicant's Answer to the Third Amended Notice of Opposition does not refer or even allude to use of any of the marks

there should be a "modified" *Morehouse* defense until Applicant articulated the substantive legal basis for that position in Applicant's Summary Judgment Opposition Memorandum. Accordingly, Opposer's Summary Judgment Reply Memorandum is responsive to an argument presented by Applicant and therefore is appropriate for inclusion in a Reply Memorandum.

Based on the arguments presented in Applicant's Summary Judgment Opposition Memorandum and Opposer's Summary Judgment Reply Memorandum, there is an ample basis for the Board to resolve the issue of whether there is some "modified" *Morehouse* prior registration defense applicable to a dilution claim under § 13(a) of the Federal Trademark Act based on those papers alone.

III. CONCLUSION

For all the reasons stated above, it is respectfully submitted that Opposer's motion to strike Applicant's Sur-Reply Memorandum should be granted and that Applicant's cross-motion to strike Opposer's Summary Judgment Reply Memorandum should be denied.

BRINK'S NETWORK, INC.

April 22, 2011

By: _____

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which are the subject of Applicant's Registration Nos. 1,153730, 2,779,986 and 3,797,964 or the marks shown in the third-party registrations pleaded in ¶ 28.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Reply Memorandum in Support of Opposer's Motion to Strike Applicant's Sur-Reply Memorandum in Opposition to Opposer's Motion for Summary Judgment Dismissing Applicant's Prior Registration Defense and Memorandum in Opposition to Applicant's Cross-Motion to Strike Opposer's Reply Memorandum in Support of Opposer's Motion for Summary Judgment Dismissing Applicant's Prior Registration Defense was served on the following counsel of record for Applicant by depositing the same in the U.S. Mail, first class mail postage prepaid, this 22nd day of April, 2011:

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