

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

Mailed: June 12, 2008

Opposition No. 91175319

Intuitive Surgical, Inc.

v.

DaVinci Radiology Associates,
P.L.

Linda Skoro, Interlocutory Attorney

This case now comes up on applicant's motions to strike opposer's reply brief and amended reply brief to its motion for summary judgment, filed May 30 and June 11, 2008, respectively. Opposer has responded.

On May 28, 2008 counsel for opposer left a voice mail message stating she had mistakenly filed an overlength reply brief, believing leave to do so had been obtained, and inquiring into how to obtain leave or file a shortened brief. Opposer's brief was timely filed that day. I responded¹ to Ms. Hirth's inquiry on May 29, 2008:

From: Skoro, Linda
Sent: Thursday, May 29, 2008 1:19 PM
To: 'mhirth@sheppard.com'
Subject: Opposition No. 91175319
Ms. Hirth,

¹ As the office telephone system was not working properly, I responded via email. It does appear, however, that I failed to provide Ms. Hirth's full email address.

Thank you for your inquiry. I think at this point you should file a motion for leave to file a corrected brief that is within the allowed page limit and attach the shortened brief as well. Frequently opposing parties will move to strike your overlength brief altogether and this will save everyone time.

Thank you for your inquiry.

Linda Skoro
Interlocutory Attorney
Trademark Trial and Appeal Board

On May 30, 2008 opposer filed a substitute reply brief within the page limit, albeit a day late.

As provided in Section 539 of the TBMP, if a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 CFR § 2.128(b).

Because opposer's original reply brief was timely filed, inquiry had been made and it was a technical breach of the rule, time would have been allowed to correct it. In that it is more important to have substance prevail over form, applicant's motions to strike each of opposer's reply briefs are hereby denied. To the extent that the first filed brief is over the page limit, the brief filed May 30, 2008 will be the one given consideration.

Proceedings otherwise remain suspended pending a decision on the motion for summary judgment.