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Filing date: **02/19/2009**

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

Proceeding	91177301
Party	Defendant Charmaine V. Jones
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Signature	/karinsegall/
Date	02/19/2009
Attachments	Charmaine Jones.pdf ( 13 pages )(399526 bytes )

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

In the Matter of Application Serial No. 76/529,077  
Published in the *Official Gazette* of May 8, 2007

CAKE DIVAS,

Opposer,

v.

CHARMAINE V. JONES,

Applicant.

Opposition No. 91177301

**APPLICANT'S APPEARANCE OF NEW COUNSEL,  
MOTION TO STRIKE AND/OR DENY OPPOSER'S MOTION  
FOR SUMMARY JUDGMENT AS UNTIMELY**

Applicant Charmaine V. Jones ("Applicant"), by and through her undersigned counsel,<sup>1</sup> hereby moves for an Order striking Opposer Cake Divas' ("Opposer") Motion for Summary Judgment, filed on January 15, 2009, as well as the accompanying exhibits and declarations of Leigh Grode and Matthew D. Klafter, as untimely for the reasons set forth in the following memorandum of law.

**MEMORANDUM OF LAW**

**I. BACKGROUND**

This is a dispute concerning competing trademark applications regarding, *inter alia*, decorative cakes. On July 11, 2003, Applicant filed with the United States Patent and Trademark Office ("USPTO") an application to register her mark "CAKEDIVA" (Ser. No. 76/529,077) based on a date of first use in commerce of June 15, 1993. Subsequently, on August

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<sup>1</sup> The undersigned have been retained by Applicant in this matter and hereby make this appearance on behalf of Applicant and request that all future correspondence be addressed to the undersigned.

6, 2003, Opposer filed with the USPTO a trademark application to register the competing mark “CAKE DIVAS” alleging as a date of first use October 15, 1998.

Thereafter, on May 8, 2007, Applicant’s application was published for opposition, and on May 15, 2007, Opposer commenced this opposition proceeding. In response, Applicant filed her Answer to the Opposition on July 25, 2007, and subsequently, the parties commenced discovery including serving and exchanging responses to interrogatories and document requests.

On December 22, 2008, Applicant’s former counsel, Lori D. Greendorfer, of the law firm of Schiff Hardin LLP, informed counsel for the Opposer, Mr. Konrad Gatien and Mr. Matthew Klafter, of the law firm of Keats McFarland & Wilson LLP, that Schiff Hardin was planning to withdraw as counsel for Applicant. *See* Declaration of Karin Segall (“Segall Dec.”) at ¶ 3, Exhibit 1. Ms. Greendorfer requested a 60-day extension of all time periods in the Opposition proceeding in order to give Applicant time to retain new counsel. *See* Segall Dec. at ¶ 3, Exhibit 1. Despite the reasonableness and fairness of Ms. Greendorfer’s request, counsel for the Opposer summarily denied Ms. Greendorfer’s request for a 60-day extension. *See* Segall Dec. at ¶ 3 Exhibit 1. Additionally, counsel for the Opposer advised that Opposer had instructed “to promptly file a motion for summary judgment” and that such motion was to be filed at the “earliest possible date.” *See* Segall Dec. at ¶ 3, Exhibit 1. Ms. Greendorfer replied by informing Opposer’s counsel that she was no longer authorized to accept service of papers in this proceeding and that she was not aware of any newly designated counsel, *see* Segall Dec. at ¶ 3, Exhibit 1, thus leaving Applicant to represent herself *pro se*, unless and until she retained new counsel.

On December 25, 2008, the Opposer’s testimony period commenced. Twenty days later, on January 15, 2009, Opposer filed its Motion for Summary Judgment and supporting

papers. At that time, Applicant had not yet retained new counsel. Applicant did not retain new counsel until January 21, 2009, when she retained Foley & Lardner LLP to represent her in this Opposition proceeding. *See* Segall Dec. at ¶ 2.

Counsel for the Opposer never sought leave from Applicant nor the Board to file its untimely Motion for Summary Judgment after the commencement of the testimony period, nor attempted to provide any explanation or excuse for its untimely filing. *See* Segall Dec. at ¶ 4.

## **II. ARGUMENT**

### **A. Applicable Law**

It is well recognized that, in proceedings before the Trademark, Trial and Appeal Board (“Board”), summary judgment motions should be filed before the first testimony period commences in order to be timely. Rule 528.02 of the Board’s Manual of Procedure requires that a “motion for summary judgment should be filed before the opening of the first testimony period, as originally set or reset,” and explicitly provides that once the first testimony period commences, “any summary judgment motion filed thereafter is untimely.” TBMP Rule 528.02; *see also* 37 C.F.R. § 2.127(e) (“A motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period...”).

Case law also makes clear that in order for a summary judgment motion to be considered timely, it must be filed prior the commencement of the first testimony period. *See e.g. Blansett Pharmacal Co. Inc. v. Carmick Laboratories Inc.*, 25 U.S.P.Q.2d 1473 (Nov. 11, 1992) (“The rule applicable to the timeliness of summary judgment motions in Board proceedings requires that such a motion be filed prior to the commencement of the first testimony period...”); *Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing and*

*Cleaning Company*, 226 U.S.P.Q. 718 (July 26, 1985) (Noting that “a motion for summary judgment made after the commencement of the trial is untimely”) (citation omitted).

It is within the Board’s discretion to “deny as untimely any summary judgment motion” filed after the commencement of the first testimony period. TBMP Rule 528.02. Though it is within the Board’s discretion to consider an untimely motion for summary judgment, the Board’s Manual of Procedure provides that: “The Board will generally not consider a motion for summary judgment filed after the first testimony period commences unless (1) it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion), (2) was submitted by agreement of the parties (prior to the taking of any testimony), or (3) was not opposed by the nonmoving party (at least on the basis of its untimeliness). *Id.*”

**B. Opposer’s Motion for Summary Judgment Is Untimely**

In this case, Opposer’s Motion for Summary Judgment, and supporting papers, filed on January 15, 2009, is clearly untimely as it was filed after the commencement of the testimony period in this Opposition proceeding. As discussed above, it is well-settled that motions for summary judgment filed after the commencement of the testimony period, as in this case, are untimely. *See* TBMP Rule 528.02; 37 C.F.R. § 2.127(e); *Blansett Pharmacal Co. Inc.*, 25 U.S.P.Q.2d 1473 (Nov. 11, 1992); *Rainbow Carpet, Inc.*, 226 U.S.P.Q. 718 (July 26, 1985).

Here, the testimony period commenced on December 25, 2008. Under the applicable rule, in order to have been timely, Opposer was required to file its Motion for Summary Judgment, if any, before December 25, 2008. Opposer, however, did not file its Motion for Summary Judgment until after the testimony period had begun, on or about January 15, 2009. Under the circumstances, there is no question that Opposer’s Motion for Summary Judgment is untimely.

**C. The Board Should Exercise Its Discretion To Strike and/or Deny Opposer's Motion For Summary Judgment**

The Board should exercise its discretion to strike and/or deny Opposer's Motion for Summary Judgment as untimely for a number of reasons. As explained above, Opposer's Motion is clearly untimely. Even more troubling than the untimely nature of the Motion is the fact that Opposer cavalierly filed its Motion without even an attempt to seek leave to do so, and without any explanation or excuse. Opposer made no request, as far as Applicant is aware, to the Board for an exception to Rule 528.02. Opposer also made no attempt to seek Applicant's permission to file its untimely Motion. Furthermore, in Opposer's Motion for Summary Judgment, Opposer blithely ignores its failure to comply with Rule 528.02, and fails again to set forth any explanation or excuse whatsoever for the untimeliness of its Motion.

In addition, pursuant to the Board's own Manual of Procedure, the Board generally will not consider an untimely summary judgment motion unless it fits into one of three exceptions, none of which is present in the instant case. TBMP Rule 528.02. This case does not involve claim preclusion or issue preclusion; Opposer's Motion was not submitted by agreement prior to the taking of testimony; and, here, Applicant strongly opposes the Motion for Summary Judgment on the basis of its untimeliness. Finally, the timing of Opposer's filing of its Motion, shortly after Applicant's former counsel withdrew from representation and before Applicant had been able to find new counsel, raises disturbing questions regarding Opposer's motivation in filing its untimely Motion. Opposer is seeking to avoid a trial on the merits and used the period during which Applicant was without representation to file a dispositive motion rather than subject itself to the scrutiny of a trial. The issue of priority is an issue of fact that is particularly suited in this case to trial and cross examination. To attempt to dispose of this issue through a

dispositive motion would be to rob Applicant of her opportunity to tell her story and to subject Opposers to cross examination.

### III. CONCLUSION

For the foregoing reasons, Applicant Charmaine V. Jones respectfully requests that the Board strike and/or deny Opposer Cake Divas' Motion for Summary Judgment and supporting papers. In the event that the Board chooses to accept Opposer's untimely motion, Applicant requests 30 days to respond.

Respectfully submitted,

FOLEY & LARDNER LLP

By: \_\_\_\_\_

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*Attorneys for Applicant*

Dated: February 19, 2009  
New York, New York

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

In the Matter of Application Serial No. 76/529,077  
Published in the *Official Gazette* of May 8, 2007

CAKE DIVAS,

Opposer,

v.

CHARMAINE V. JONES,

Applicant.

Opposition No. 91177301

**DECLARATION OF KARIN SEGALL**

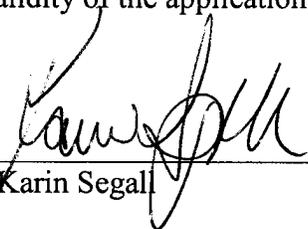
I, Karin Segall, declare pursuant to 37 C.F.R. § 2.20:

1. I am an attorney with the firm of Foley & Lardner LLP, representing Applicant in connection with the captioned proceeding. I have personal knowledge of the material facts stated herein and I make and submit this Declaration in support of Applicant's Motion to Strike and/or Deny Opposer's Motion for Summary Judgment as Untimely.
2. The firm of Foley & Lardner LLP was retained to represent Applicant in this proceeding on January 21, 2009.
3. Attached as Exhibit 1 hereto is a true and correct copy of an email exchange dated December 22, 2008 as contained within the correspondence file of Applicant's prior counsel.
4. Upon information and belief, Opposer's counsel did not request leave of Applicant or Applicant's prior counsel to file its untimely motion for summary judgment.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these

statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or document or any registration resulting therefrom

Dated: February 19, 2009

By:   
Karin Segall

# **Exhibit 1**

**Greendorfer, Lori D.**

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**From:** Greendorfer, Lori D.  
**Sent:** Monday, December 22, 2008 3:19 PM  
**To:** 'Matthew Klafter'  
**Cc:** Anthony M. Keats; Konrad Gatien  
**Subject:** RE: Cakediva, Opposition No. 91177301

Dear Matthew,

We are not authorized to accept service of any further papers in this proceeding, including your planned summary judgment motion. We are not aware of any newly designated counsel. Thank you.

Regards,  
Lori

**Lori D. Greendorfer | Schiff Hardin LLP**  
900 Third Avenue, 24th Floor  
New York, New York 10022

**Direct: 212.745.0814**  
**Fax: 212.753.5044**  
**Email: [Lgreendorfer@schiffhardin.com](mailto:Lgreendorfer@schiffhardin.com)**

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**From:** Matthew Klafter [mailto:[MKlafter@kmwlaw.com](mailto:MKlafter@kmwlaw.com)]  
**Sent:** Monday, December 22, 2008 2:51 PM  
**To:** Greendorfer, Lori D.  
**Cc:** Anthony M. Keats; Konrad Gatien  
**Subject:** RE: Cakediva, Opposition No. 91177301

Dear Ms. Greendorfer,

Thank you for your courtesy correspondence of today's date in which you informed our office that Schiff Hardin may be withdrawing as litigation counsel for Ms. Jones in connection with the above-referenced proceeding. Please note that based on the discovery exchanged between the parties, it is our client's position that your client does not have the rights she claims to have for the CAKEDIVA mark. Thus, our client has instructed us to promptly file a motion for summary judgment. As such, we cannot agree to the extension you have requested below, and we will file the motion at the earliest possible date. Please confirm whether you are authorized to accept the motion on behalf of Ms. Jones or whether we should serve the motion upon Ms. Jones (or her newly designated counsel, if you are aware of any such designation). Please note that if your firm does in fact withdraw as counsel, then assuming an extension to respond to the motion is requested by new counsel, we will consider the request at the appropriate time.

Sincerely,

Matt Klafter

Matthew D. Klafter

12/22/2008

KEATS McFARLAND & WILSON LLP  
9720 Wilshire Boulevard  
Penthouse Suite  
Beverly Hills, California 90212  
Telephone: (310) 248-3830  
Facsimile: (310) 860-0363  
Direct: (310) 777-3736

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**From:** Greendorfer, Lori D. [mailto:LGreendorfer@schiffhardin.com]  
**Sent:** Monday, December 22, 2008 10:20 AM  
**To:** Konrad Gatien; Matthew Klafter  
**Subject:** Cakediva, Opposition No. 91177301

Dear Konrad and Matthew,

Schiff Hardin is planning on withdrawing as counsel for the Applicant from the above referenced proceeding within the next week or so. Under these circumstances, we would like to request your agreement to a 60-day extension of all time periods in this proceeding in order to give the Applicant time to retain new counsel. As of this time, Schiff Hardin still represents Ms. Jones, the Applicant, in connection with any settlement discussions of this matter.

Please let me know at your earliest convenience your response to the above request and please do not hesitate to contact me if you have any questions. Thank you.

Regards,  
Lori

**Lori D. Greendorfer | Schiff Hardin LLP**  
900 Third Avenue, 24th Floor  
New York, New York 10022

**Direct: 212.745.0814**  
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12/22/2008

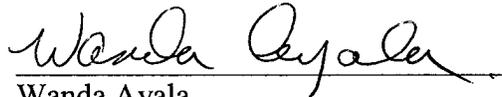
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT'S APPEARANCE OF NEW COUNSEL, MOTION TO STRIKE AND/OR DENY OPPOSER'S MOTION FOR SUMMARY JUDGMENT in Opposition No. 91177301 was served by first-class mail on the 19<sup>th</sup> day of February 2009 upon Opposer's correspondent of record, as follows:

Anthony M. Keats, Esq.  
Keats McFarland & Wilson LLP  
9720 Wilshire Blvd., Penthouse Suite  
Beverly Hills, CA 90212

  
Wanda Ayala