

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

TTAB

Serial No. 76/613881

mine design, a d.b.a. of Amal Flores
v.
Votivo, Ltd. And Votivo, LLC

Opposition No. 91178747

Plaintiff mine design's Motion To Strike Exhibits 15, 16 and 17 to the "Declaration of Steve Edmiston (1) In Opposition to Opposer's Motion For Summary Judgment And (2) In Support Of Cross-Motion For Summary Judgment"



04-21-2008

I. Introduction

By the present motion, mine design (“m.design”) respectfully requests that Exhibits 15, 16 and 17 to the “Declaration of Steve Edmiston (1) In Opposition to Opposer’s Motion For Summary Judgment And (2) In Support Of Cross-Motion For Summary Judgment” be stricken as inadmissible. In particular, the three exhibits purport to be copies of declarations submitted in a litigation between Votivo Ltd. and the Tyler Candle Company (Votivo Ltd. v. Tyler Candle Co., No. CV03-2661P (W.D. Washington)).

The admissibility of testimony from other proceedings is addressed by 37 C.F.R. § 2.122(f), which provides that “[b]y order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject [to certain conditions].” 37 C.F.R. § 2.122(f). *See also*, TBMP § 528.05(f).

Votivo failed to file a motion pursuant to 37 C.F.R. § 2.122(f) with the Trademark Trial and Appeal Board (“Board”) for an order to use said testimony from another proceeding in support of its Opposition and Cross-Motion. Votivo’s failure to file a motion pursuant to the Rule prevented m.design from properly opposing Votivo’s inappropriate submission of the testimony. Moreover, the testimony Votivo seeks to use falls outside the scope of the Rule, *inter alia*, because the Rule only permits motion to be made to use testimony that is taken in another proceeding “between the same parties or those in privity.” The testimony Votivo seeks to use is inadmissible pursuant to the Rule because m.design is in no way affiliated, associated, related, or in privity with the Tyler Candle Company. Moreover Votivo has failed to meet the burden of showing the relevancy and materiality of the testimony, which relevancy and materiality m.design also disputes.

Accordingly, m.design respectfully requests the testimony submitted by Votivo apparently derived from Votivo’s litigation with the Tyler Candle Company be ruled inadmissible and stricken.

II. Statement of Material Facts

Plaintiff respectfully submits the following facts are not in dispute.

1. Application Serial No. 76/613881 for the term “Mandarine¹” in connection with scented bath salts and scented hand lotion published for opposition on June 5, 2007.
2. m.design, a d.b.a. of Amal Flores, timely opposed registration of Application Serial No. 76/613881 on the grounds the term is generic and functional when applied to the goods listed in the application.
3. Votivo Ltd. timely filed and served an Answer.
4. At least as early as February 6, 2008, m.design filed and served a motion for summary judgment on the grounds that the term mandarin is generic ab initio as a matter of law under the primary significance test and *A.J. Canfield Co. v. Honickman*, 1 U.S.P.Q.2d 1364 (3d Cir. 1986). Paper No. 7.
5. On February 7, 2008, Votivo LLC’s motion to substitute was denied and instead Votivo LLC was joined as a party defendant. Paper No. 6.
6. On March 12, 2008, Votivo Ltd. and Votivo LLC (hereinafter Votivo) jointly opposed m.design’s motion for summary judgment and cross moved for summary judgment, alleging 1) that m.design lacked standing and 2) res judicata, including 2.a) claim preclusion and 2.b) issue preclusion.
7. Votivo’s Opposition and Cross Motion was accompanied by two affidavits, the first one by Robert E. Caldwell, Jr. and the second one by Steve Edmiston (“Edmiston Decl.”).
8. Votivo’s Edmiston Decl. was accompanied by 24 numbered exhibits, of which exhibits 15, 16 and 17 purport to be affidavits filed by Votivo Ltd. in response to a motion for summary judgment in litigation between Votivo Ltd. and the Tyler Candle Company (*Votivo Ltd. v. Tyler Candle Co.*, No. CV03-2661P (W.D. Washington)).
9. m.design was not a party to said litigation between Votivo Ltd. and the Tyler Candle Company, nor is m.design in any manner related, associated or in privity with the Tyler Candle Company.

¹ The terms “mandarin” and “mandarine” are used interchangeably herein.

10. Votivo did not file and serve a motion pursuant to 37 C.F.R. § 2.122(f) for an order permitting the use of testimony taken in another proceeding in connection with the submission of Exhibits 15, 16 and 17 to the Edmiston Decl.

III. Argument

A. Timeliness of Motion to Strike; Motion for Leave to File Possibly Belated Motion to Strike.

The present motion is believed to be timely pursuant to 37 C.F.R. § 2.127(e)(1); TBMP § 113.05; and 37 C.F.R. § 2.119(c). If the present motion is found to be belated, m.design respectfully hereby requests the Board consider this a motion for leave by m.design to file the present motion to strike. To the extent the present motion to strike may be belated, no prejudice should inure to Votivo, as it was Votivo's duty to file and serve evidence in support of its opposition/response and cross motion with said opposition/response and cross-motion. *See, Fed.R.Civ.P. 56; Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L.Ed.2d 265 (1986).* Even if m.design had filed and served the present motion earlier, Votivo would not have been permitted to remedy its failure to submit admissible evidence with its motion and/or opposition/response. Moreover Votivo should not be heard to complain of the possible belatedness of the present motion to strike given Votivo's own violation of the rules in the submission of the evidence, namely, Votivo's failure to properly file a motion to use the testimony as required by 37 C.F.R. § 2.122(f). Had Votivo properly filed said motion m.design would have had an opportunity to oppose said 37 C.F.R. § 2.122(f) motion, *inter alia*, on the grounds stated herein.

B. Votivo Seeks to Introduce Testimony Taken in Another Proceeding in Violation of 37 C.F.R. § 2.122(f).

The admissibility of testimony from other proceedings is addressed in 37 C.F.R. § 2.122(f), which provides that “[b]y order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject [to certain conditions].” 37 C.F.R. §2.122(f). *See also*, TBMP § 528.05(f).

Exhibits 15, 16 and 17 to the Edmiston Decl. purport to be copies of declarations submitted in a lawsuit between Votivo Ltd. and the Tyler Candle Company (Votivo Ltd. v. Tyler Candle Co., No. CV03-2661P (W.D. Washington)). Accordingly, the exhibits are testimony taken in another proceeding.

The exhibits should be stricken because Votivo failed to file a motion pursuant to 37 C.F.R. § 2.122(f) for an order to use said testimony taken in another proceeding in the present Opposition.

The exhibits should further be stricken because the testimony could not be used in the present Opposition pursuant to 37 C.F.R. §2.122(f). Said testimony fails to satisfy the requirement of the Rule that the testimony was taken in another proceeding “between the same parties or those in privity.” m.design is not the Tyler Candle Company, and is in no way affiliated, associated, related, or in privity with the Tyler Candle Company. Accordingly, said testimony cannot satisfy the “same parties or those in privity” requirement of the Rule.

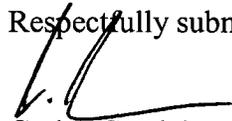
Moreover the exhibits should be stricken because Votivo has failed to address how the testimony may be “relevant and material” to the present Opposition, as required by the Rule.

IV. Conclusion

For the foregoing reasons, the present motion should be granted and the testimony from another proceeding submitted by Votivo should be ruled inadmissible, stricken and disregarded.

Dated: April 16, 2008

Respectfully submitted,



Carlos Candeloro
Reg. No. 52,691
Cal. Bar No. 194716

Attorney For Plaintiff
mine design

Correspondence Address:

Carlos Candeloro
1601 N. Sepulveda Blvd. 239
Manhattan Beach, CA 90266
Phone: (310) 498-4249
carlos@candeloro.net

Certificate of Mailing

I hereby certify that a true and complete copy of the foregoing "Plaintiff mine design's Motion For Leave To File A Possibly Belated Motion And Motion To Strike Exhibits 15, 16 and 17 to the 'Declaration of Steve Edmiston (1) In Opposition to Opposer's Motion For Summary Judgment And (2) In Support Of Cross-Motion For Summary Judgment'" has been served on Votivo, Ltd. And Votivo LLC by mailing said copy on April 16, 2008, via Express Mail Label No. EQ 641423892 US, postage prepaid, to counsel for Votivo, Ltd. and Votivo LLC at:

Mark V. Jordan
Invicta Law Group, PLLC
1000 Second Ave., Suite 3310
Seattle, Washington 98104

The original has been filed on April 16, 2008, by mailing with the United States Postal Service with sufficient postage as First-Class Mail in an envelope addressed to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451



Carlos Candeloro