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

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| Proceeding | 91190878 |
| Party | Defendant Undisputed International LLC |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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| Center Cut Hospitality, Inc. |) | Opposition No. 91/190,878 |
| |) | |
| Opposer, |) | Mark: JOHN L. SULLIVAN |
| |) | App. No.: 77/570,821 |
| v. |) | |
| |) | |
| Undisputed International LLC |) | |
| |) | |
| Applicant. |) | |
| |) | |

REPLY TO OPPOSER’S RESPONSE TO MOTION TO STRIKE

Undisputed International LLC (“Applicant”), by and through its undersigned counsel, hereby submits this Reply to Center Cut Hospitality, Inc.’s (“Opposer”) Response to the Motion to Strike all of Paragraph 6 and a portion of Paragraph 4 of the Notice of Opposition. Although Applicant acknowledges and accepts the Trademark Trial and Appeal Board’s (“Board”) September 4, 2009 Order, it nevertheless submits this Reply in the event the Board grants Opposer’s Motion for Reconsideration also dated September 4, 2009.

I. Motions To Strike Are Warranted Under Certain Circumstances.

In its Response, Opposer states that Applicant’s Motion to Strike was “intended as a bold attempt to circumvent the discovery process[.]” Such an allegation is pure conjecture on Opposer’s part. Rather, Applicant filed its Motion to Strike because the Board has the authority to strike from a pleading any insufficient or impermissible claim (or portion thereof). *See* TBMP §506.01. Here, Applicant finds a Motion to Strike to be the appropriate tool for the two issues it has raised. Specifically, Applicant asserts that Paragraph 6 is wholly comprised of a claim which is clearly insufficient, and that Paragraph 4 contains factual allegations which are simply

impermissible. Since neither claim needs to be determined on the merits, Applicant's Motion to Strike is perfectly warranted.

II. On Its Face, JOHN L. SULLIVAN Is Not Primarily Merely A Surname.

Opposer asserts that whether JOHN L. SULLIVAN is primarily merely a surname requires investigation into the facts. Applicant submits that it absolutely does not. On its face, it is quite clear that JOHN L. SULLIVAN is not primarily merely a surname. The determination to be made here is whether a mark is primarily merely a *surname*, not primarily merely a *name*. To that end, Applicant reiterates the examples of full names from its Motion to Strike that parallel Applicant's JOHN L. SULLIVAN mark, namely, SARA LEE, JENNY CRAIG, and ELIZABETH ARDEN. Applicant notes that none of these marks was refused registration by the U.S. Trademark Office for being primarily merely a surname, and yet each mark contains a first and last name. Applicant also notes that it was unable to locate a single instance wherein an application for a full name was refused under Section 2(e)(4) of the Trademark Act. Applicant surmises that this is because a full name is simply not primarily merely a surname. In that regard, Applicant challenges Opposer to propose any instance wherein a person's surname is actually JOHN L. SULLIVAN.

Opposer insists that the Board has repeatedly rejected Applicant's argument that the inclusion of JOHN L. in Applicant's JOHN L. SULLIVAN mark clearly prevents the mark from being primarily merely a surname. In support of its position, however, Opposer only cites to Board cases containing marks with a combination of initials and a surname. In none of Opposer's citations does the mark in question also contain a Christian (or first) name, as is the case here. In further support of its position, Opposer references cases wherein two marks containing the same surname were held to be confusingly similar to each other. However, these

citations are irrelevant to the issue at hand, since a likelihood of confusion between two marks has no bearing on whether a mark is primarily merely a surname.

Opposer also insists that a five factor test must be applied to a mark in order to determine whether it is primarily merely a surname. However, this five factor test emanates from a case, *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332 (TTAB 1995), wherein only one word (BENTHIN) comprised the entire mark. If the mark in question in this proceeding were merely SULLIVAN, Applicant might agree that Opposer's five factor test could apply. However, when multiple words comprise the mark, it is quite clear that the mark cannot be primarily merely a surname and, therefore, the Board need not concern itself with a weighing of such factors.

Thus, Applicant's argument is not based on a misunderstanding of the law. Rather, Applicant merely asserts that no factual inquiries or analysis of any discoverable facts need to be considered in order for the Board to determine that JOHN L. SULLIVAN cannot, nor ever will be, primarily merely a surname. As such, Opposer's surname claim in Paragraph 6 is clearly insufficient and, based on the nature of Applicant's mark, the claim cannot be corrected. For these reasons, Applicant reiterates its request to strike Paragraph 6 of the Notice of Opposition in its entirety.

III. Opposer's Alleged Dates Of First Use Of Its Marks Are Contradictory.

Paragraph 4 of the Notice of Opposition states that "Opposers have extensively, continuously and without interruption used the Opposer's **Marks** beginning at least as early as May 10, 1996 in promoting their goods and services." **Emphasis added.** However, from the face of the registrations, not all of "Opposer's Marks" (specifically defined as the six marks recited in the Notice of Opposition) were allegedly in use as of that date. In filing this proceeding, Opposer cannot rely on the information contained in its six registrations and then unilaterally change some of that information in its arguments. Applicant finds it impermissible

to let Opposer allege different dates of first use in its pleadings. For that reason alone, Applicant moved to strike the portion of Paragraph 4 that is contradictory to the information recited in Opposer's registrations.

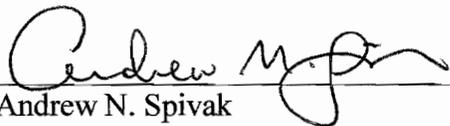
IV. Conclusion: The Board Should Grant Applicant's Motion To Strike In Its Entirety.

A review of Applicant's JOHN L. SULLIVAN mark on its face reveals that it is not primarily merely a surname, and no factual inquiries need to be made in order to determine the same. Further, Opposer cannot be allowed to base this opposition on its registrations and then subsequently alter the dates of first use in those registrations in the course of its pleadings.

For all of the reasons outlined above, Applicant respectfully reiterates its request that the Board strike Paragraph 6 of Opposer's Notice of Opposition in its entirety, and that it also strike the portion of Paragraph 4 containing contradictory first use dates.

Respectfully submitted,

Dated: September 21, 2009

By: 
Andrew N. Spivak
Attorney for Applicant

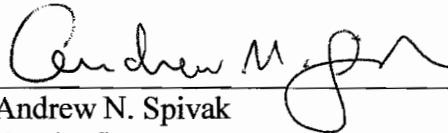
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CERTIFICATE OF SERVICE

I, Andrew N. Spivak, one of the Attorneys for Applicant, hereby certify that on this 21st day of September, 2009, a true and correct copy of the foregoing REPLY TO OPPOSER'S RESPONSE TO MOTION TO STRIKE was served via first class mail, postage prepaid upon:

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