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

Proceeding	91196299
Party	Plaintiff Connect Public Relations, Inc.
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Opposed Mark: CONNECT
U.S. Trademark Application Serial Number: 77/714,693
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CONNECT PUBLIC RELATIONS, INC., a Utah corporation,)	
)	
Opposer)	OPPOSER'S MOTION TO STRIKE
)	
v.)	
)	
DIGITALMOJO, INC., a California corporation,)	Opposition No. 91196299
)	
Applicant.)	

Opposer Connect Public Relations, Inc. ("ConnectPR") respectfully moves the Trademark Trial and Appeal Board ("Board") to strike, and give no consideration to, Applicant's Response to Opposer's Motion for Partial Summary Judgment ("Response Brief") filed by Applicant Digitalmojo, Inc. ("Digitalmojo") for at least the reason that it exceeds the twenty-five (25) page limitation specified in Trademark Rule 2.127(a).

ConnectPR further moves the Board to strike at least Paragraphs 3 and 8 of the Declaration of Thomas Cook in Support of Applicant's Response to Opposer's Motion for Partial Summary Judgement ("Cook Declaration") because, as counsel for Digitalmojo, he is precluded from providing the expert testimony contained in those paragraphs.

ConnectPR further moves the Board to strike any and all reference to the third-party registrations listed in Paragraph 3 of the Cook Declaration and the TESS printout attached to the Cook Declaration because they were not properly made of record.

This motion is supported by the brief embodied herein.

BRIEF

I. The Board Should Strike Digitalmojo's Response Brief as it Exceeds the Page Limitation Requirement Set Forth in Trademark Rule 2.127(a)

The Board must strike the Response Brief filed by Digitalmojo as it exceeds the applicable page limit by ten (10) full pages. In particular, Trademark Rule 2.127(a) states that "[n]either the brief in support of a motion nor the brief in response to the motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary." 37 CFR § 2.127(a) (emphasis added). Further, the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") confirms that "[b]riefs in support of and in response to a motion may not exceed 25 pages in length" TBMP § 502.02(b). In fact, the TBMP explicitly states that "the Board may sua sponte strike or give no consideration to any briefs on a motion that exceed the page limit set forth in 37 CFR § 2.127." TBMP § 517.

Thus, where a brief in response to a motion for summary judgment exceeds the page limit set forth in Trademark Rule 2.127(a), the Board's remedy is to strike the brief and give its contents no

consideration when deciding the underlying motion. *See, e.g., Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003)(holding that “[n]either opposer’s motion for summary judgment nor applicant’s brief in opposition thereto [would] receive consideration” because “both parties’ briefs [were] procedurally improper and in violation of Board rules regarding page limitations of briefs on motions.”). As noted by the Board, the rationale for this remedy is that “the page limitation for briefs on motions is for the convenience of the Board and is intended to prevent the filing of unduly long briefs.” *Id.* The page limit “cannot be waived by action, inaction or consent of the parties.” *Id.*

In the present case, Digitalmojo’s Response Brief is a whopping thirty-five (35) pages. At this length, the Response Brief exceeds the page limitation set forth in Trademark Rule 2.127(a) by ten (10) pages. Without question, the Response Brief is “unduly long” and is burdensome not only to the Board, but ConnectPR as well. It would be manifestly unfair to consider Digitalmojo’s Response Brief when ConnectPR was limited to, and abided by, the twenty-five (25) page limit, and where Digitalmojo did not move the Board for permission to file a longer brief, let alone obtain any such permission.

Based upon the above, ConnectPR moves the Board to strike Digitalmojo’s Response Brief in its entirety, as it is non-compliant with the page limitation requirement set forth in Trademark Rule 2.127(a), and because the abundance of authority cited above makes clear that striking Digitalmojo’s entire brief is the proper remedy. The Board should therefore give no consideration to the contents of the Response Brief when deciding ConnectPR’s Corrected Motion for Partial Summary Judgment.

II. **The Board Should Strike Paragraphs 3 and 8 of the Cook Declaration As Constituting Inadmissible Expert Testimony from Digitalmojo's Counsel**

ConnectPR respectfully requests that the Board must strike at least Paragraphs 3 and 8 of the Cook Declaration because Applicant's counsel impermissibly attempts to offer expert testimony on the merits of the case. First, Applicant's counsel states the following in Paragraph 3:

I conducted a search of the United States Patent and Trademark Office's (the "USPTO's") web site at the time dm's application was being examined, and I then identified over 24 active registrations on the Principal Register consisting of the term CONNECT. In addition, there are literally thousands of applications and registrations which include the term "CONNECT" or its close variants. [See attached TESS database printout of first page of list from the USPTO web site.] The list below identified 23 live registrations for mark CONNECT for use with services that are commonly purchased by a large percentage of the consumer population.

Paragraph 3 then goes on to list the registrations found by Applicant's counsel in the search that he conducted. Applicant's counsel states the following in Paragraph 8:

In reviewing documents produced by ConnectPR in this opposition action, I have come to the following conclusion: While ConnectPR asserts it "has actually offered and provided the services of promoting the goods and services of others over the Internet," discovery documents show ConnectPR has actually provided the services of assisting ConnectPR's clients to promote the client's goods and services over the Internet under the client's marks, and nothing in such documents show ConnectPR has used ConnectPR's marks to offer or provide the services of promoting the goods and services of its clients over the Internet.

Clearly, Paragraphs 3 and 8 fall within the realm of expert testimony. For example, in Paragraph 3, Applicant's counsel states that: "The list below identified 23 live registrations for mark CONNECT for use with services that are commonly purchased by a large percentage of the consumer population." This statement contains Applicant's counsel's opinion about which services are "commonly purchased by a large percentage of the consumer population." This is impermissible expert testimony by Applicant's counsel.

Paragraph 8 is even more troublesome as Applicant's counsel states that after reviewing the documents produced by ConnectPR, that he has come to a "conclusion" regarding ConnectPR's use of its marks. Applicant's counsel then goes on to impermissibly state his "conclusion." Again, Applicant's counsel cannot proffer his "conclusion" as this matter falls completely within the realm of expert testimony. Applicant's counsel was not disclosed as an expert witness. If Applicant's counsel wants to provide expert testimony, he should withdraw as counsel from this matter and Applicant should disclose him as an expert.

In short, the Board should strike at least Paragraphs 3 and 8 from the Cook Declaration as they contain impermissible expert testimony from Applicant's counsel.

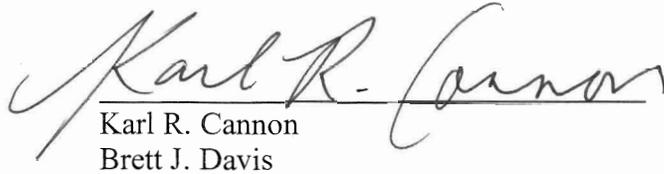
III. **The Board Should Strike Any and All Reference to the Third-party Registrations Relied Upon by Digitalmojo Because the Registrations Were Not Properly Made of Record**

Pursuant to TBMP § 528.05(d), "[a] party may make a third-party registration of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy. A copy printed from the USPTO's TESS or TARR database likewise is sufficient for this purpose." In the present case, although Digitalmojo provided a printed reference list of third-party registrations as an attachment to the Cook Declaration, Digitalmojo failed to include actual copies of the third-party registrations. Therefore, the Board should strike any and all reference to the third-party registrations relied upon by Digitalmojo, including those listed in Paragraph 3 of the Cook Declaration and the TESS printout, because the third-party registrations were not properly made of record, as required by the rules.

IV. **Conclusion**

Based upon the above, Opposer ConnectPR requests that its Motion to Strike be granted.

Respectfully submitted this 9 day of January, 2012.



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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing **Motion to Strike** to be served, via first class mail, postage prepaid, on this 9 day of January, 2012 to:

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