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

Proceeding	91199581
Party	Defendant Christina Goerner
Correspondence Address	CHRISTINA GOERNER 196 ACTON ROAD, HODAFEL BUILDING ANNAPOLIS, MD 21403 UNITED STATES bartbags@verizon.net, lawofficesrje@aol.com
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Date	08/25/2011
Attachments	990010001ReplyToOppositionToMotion082511.pdf (12 pages)(676979 bytes)

signed by an attorney would know that an appearance does not have to be submitted.¹ The Trademark Trial and Appeal Board Manual of Procedure waives a notice of appearance in this circumstance.

Apparently believing that the best defense is an offense, opposer offensively states that either the motion or applicant's counsel is "frivolous," (Opposition, p.1), has "no basis in reality," (Opposition, p. 2), "utterly ignorant," "unaware," (Opposition, p.5), "deceptive," "misleading," "falsely implying," (Opposition, p.10), "materially incorrect," shows "ignorance," is "ridiculous" (Opposition, p.13), and "specious." (Opposition, p.14), and only highlights the nature of the opposition. This language is no substitute for a meritorious defense.

OPPOSER'S FAILURE TO CONFERENCE DISCOVERY/ "SETTLEMENT"

ISSUES

All of this comes from opposer's counsel claiming to be a trademark attorney who not only didn't serve applicant, but also didn't return applicant's attorney's telephone calls to continue a discovery/ "settlement" conference. Ms. Weeks in her opposition to the motion and declaration **has not denied** that two telephone calls were placed to her to continue discussions, she hasn't denied she did not return the calls, and that after failing to obtain a response to those calls she was sent an E-mail² on July 17, 2011 requesting her to continue the discovery/ "settlement" conference, which she also did

¹ T.B.M.P. § 114.03, par. 4.

² Cf. applicant's Exhibit A. attached.

not respond to. Ms. Weeks dead ended the discovery/ "settlement" conferencing by not responding, and so applicant filed this motion to dismiss.

**THE MOTION TO DISMISS WITH PREJUDICE AND FAILURE TO
SERVE APPLICANT**

She complains that applicant did not advise her of the motion in a telephone conference with applicant's attorney. That was not possible given the fact that the one telephone conference between counsel ended with an agreement that applicant's counsel would call back to give Ms. Weeks the markets applicant would sell into. The markets' identity comprises a mix of discovery-settlement information, in line with discovery conferencing procedures that she should have been aware of as a trademark attorney. The telephone conferencing process had not stopped at that time and motions were not even under consideration. But she failed to return applicant's counsel's two telephone calls in which he was ready to provide this information and continue discovery/ "settlement" conferencing. Applicant therefore gave her notice by E-mail that appropriate action would be taken if she didn't respond.³ Even this did not prompt her to return applicant's counsel's calls, and as stated before caused the motion to be filed.

Opposer has no explanation for the failure to serve applicant with the opposition. Proof of service has not been offered, such as a certified mail receipt from the United States Postal Service, or a receipt from an overnight carrier, such as the Federal

³ Id.

Express Receipt⁴ opponents proffered as proof of their June 16, 2011 nunc pro tunc service of the opposition, almost two months after they filed it with the Trademark Office on April 27, 2011. Seasoned trademark attorneys serve oppositions by overnight courier or certified mail⁵ to obtain written proof of service from the courier or the Postal Service. Opposers have not submitted this proof. They don't have it because they never served it due to a law office failure.

**NUNC PRO TUNC SERVICE OF OPPOSITIONS IS A NULLITY AND NOT
RECOGNIZED AS PROPER SERVICE**

The TTAB has repeatedly refused to accept nunc pro tunc service of an opposition, as pointed out in applicant's Motion to Dismiss With Prejudice.⁶ Opposer backed in this service on June 16, 2011, approximately two weeks after applicant raised the issue of lack of service in its June 3, 2011 answer to the opposition. Having been alerted by applicant's subsequent July 22, 2011 motion citing case law that prohibits nunc pro tunc service in oppositions, opposer now tries to gloss over the failure by emphasizing applicant's counsel had read the opposition. But that is the opposition applicant downloaded from the Trademark Office's electronic file on April 27, 2011 because of the TTAB notice to them; it was not opposer's copy of the opposition.

⁴ August 11, 2011 opposition to motion, Exhibit A

⁵ Ameriprise Financial, Inc. v. Thrivent Financial for Lutherans, Opposition No. 91181329, 1-2 (T.T.A.B. July 29, 2008),

⁶ Applicant's July 26, 2011 Motion to Dismiss With Prejudice, pp. 3-6

Opponents attempt to characterize this June 16, 2011 nunc pro tunc submission as an effort made “in an abundance of caution. . . .” But they knew applicant had the opposition in hand since the first 12 paragraphs of applicant’s June 3, 2011 answer address the opposition and paragraph 13 informs opposers that applicant had obtained the opposition from the Trademark Office. They were clearly informed applicant had their opposition on June 3, and there was no need to serve the opposition again, unless opposers were attempting to back it in with their nunc pro tunc submission on June 16. The facts show that their June 16 service was not done out of “an abundance of caution.” It only shows a failure to make proper service.

Even though the TTAB provided notice of the opposition it does not amount to service. The TTAB has pointed out that they no longer act as a process server for oppositions, as was the practice under the old rules,⁷ but rather the new rules place this burden on the opposer, and improper service nullifies the opposition.

THE TIMELINESS OF APPLICANT’S MOTION TO DISMISS

Opposer argues that applicant cannot move to dismiss for insufficient service because they did not file their motion in sufficient time. Applicant, however, raised the

⁷ Schott AG v. Scott, 88 U.S.P.Q.2d (BNA) 1862, 1862 (T.T.A.B. 2008) (dismissing the opposition proceedings as a nullity for failure to comply with service requirements of 37 C.F.R. §2.101).

issue of insufficient service in paragraph 13 of their answer, and as such it is preserved under Fed. R. Civ. P. 12 (b).⁸ Applicant points out the Rule does not appear to mandate the filing of a motion, but only that a motion “may” be filed to assert a defense. The rule also discusses the preservation of defenses, noting no defense or objection is waived by joining it with one or more other defenses or objections in a responsive pleading. Prior to making this pronouncement the Rule does say that certain motions must be filed before pleading, but that only confuses the intent of the Rule. In one instance it says that the defense is preserved if raised in a pleading, and in another it says the defense has to be made by motion before filing a responsive pleading. A reasoned analysis of the Rule would allow any defense raised in a pleading to be asserted in the proceedings.

THE TELEPHONE CONFERENCE COVERING DISCOVERY/ “SETTLEMENT”

Applicant does not have to get involved in time consuming and expensive motion practice if the subject of the dispute can be resolved in a more efficient way, which applicant attempted in the discovery/ “settlement” negotiations. When opposer did not respond, applicant was forced to file the Motion to Dismiss With Prejudice.

⁸ Fed.R.Civ. P. 12 (b) Every defense or a claim for relief in a civil proceeding must be asserted in the responsive pleadings, if one is required. But a party may assert the following defenses by motion: . . .

(5) insufficient service of process;. . .

No defense or objection is waived by joining it with one or more other defenses or objections in a responsive pleading. . . . (emphasis added)

In referencing the July 5, 2011 discovery/ "settlement" conference Ms. Weeks mentions several times that applicant's counsel advised her that he read the opposition. Applicant's counsel did so since she was only raising issues that were almost verbatim identical to the position taken in the opposition, and that more important matters had to be discussed such as applicant's markets as well as other trademark applicants opposer had filed actions against. All are intertwined issues in the discovery/ "settlement" procedure. For example, if opposer knows applicant's prospective markets they could seek discovery on outlets, personnel to contact, pricing information and so on, but this could also be an area where the parties would be able to discern there would be little overlapping of the marks and the basis for restricting the reach of their respective marks could be the basis for a settlement. Similarly discovery/ "settlement" issues regarding other oppositions would give applicant an opportunity to examine the posture of both parties in the opposition to determine any inconsistencies in opposer's position and to also determine the broad usage of HUDSON as a trademark to scope out a settlement agreement between the parties as to areas they could or could not enter to avoid marketplace confusion.

CASE LAW SUPPORTS DISMISSAL OF THE OPOSITION WITH PREJUDICE

Opposer's counsel attempts to distinguish the three cases cited in the Motion to Dismiss With Prejudice⁹ on the grounds that "the opposers [in those cases] did not serve a copy of the notice of opposition to applicant on the day on which the opposition

⁹ Lucasfilm Ltd. v. BiodroidEntm'(/, Lda., Opposition No. 91191104 (TTAB Sept. 15, 2009), SchottAG v. Scott, Opposition No. 91184245 (TTAB November 13, 2008), and Springfield, Inc. v. XD, Opposition No. 91180596 (TTAB February 7, 2008),

was filed with the TTAB. . . .” (Opposition to Motion to Dismiss With Prejudice, p.9) The present facts are the same as in those three cases. Here opposer did not make proper service, clearly evidenced by a lack proof of service (mail receipt or overnight courier receipt) and an attempt to back in service with the nunc pro tunc submission made almost two weeks after they learned of the failure to serve applicant.

DISCOVERY AND SETTLEMENT CONFERENCES ARE COEXTENSIVE

Discovery and settlement issues are considered as falling in the same category and both are to be raised in the discovery conference.¹⁰ The Board has adopted a modified form of the disclosure practices included in Federal Rule 26 and followed by federal district courts. According to the Board, the discovery practices have been found to enhance settlements, promote the greater exchange of information and documents, and increase procedural fairness and the likelihood that cases will be determined on the merits of a fairly-created record.¹¹

Applicant’s Motion to Dismiss for failure to conduct “settlement” negotiations is in essence a motion to dismiss for failure to cooperate in discovery conferences, i.e., discovery/”settlement” and should be granted since the two are coextensive and go to the thrust of the discovery provisions of the Trademark Rules.

¹⁰ 37 C.F.R. § 11.120 (a). “discovery,” “settlement” is controlled by F.R. Civ. P. 26 in modified form.

¹¹ See Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242, 42,242 (Aug. 1, 2007)

REQUEST FOR RELIEF

Applicant repeats its request for relief that the opposition should be dismissed with prejudice for failure to properly serve the opposition on applicant; opposer's failure to conduct bona fides discovery/ "settlement" negotiations, the overall weakness of the mark HUDSON standing alone, and HUDSON CLOTHING, LLC's monopolistic filing of multiple oppositions. Case law, Title 37 of the Code of Federal Regulations, § 2.120 (g) (1), and Fed. R. Civ. P. 37 (b) (2) empower the Board to dismiss the action.

Dated: August 25, 2011

Respectfully Submitted,

/ Robert J. Eichelburg /

Robert J. Eichelburg, Reg. 23,057
Attorney for APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that on the day indicated below, that a true copy of the foregoing Reply was served by overnight courier (Federal Express) on counsel for opposer at the following address of record:

Rita Weeks
McDermott Will & Emery LLP
600 13th Street NW
Washington, D.C. 20005

by delivering a copy to that courier in a properly prepared mailing envelope bearing Federal Express tracking number 7951 2117 7769.

/Robert J. Eichelburg/

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Annapolis, MD
(410) 295-1508

Date: August 25, 2011

**APPLICANT CHRISTINA GOERNER'S REPLY TO OPPOSER'S OPPOSITION
TO MOTION TO DISMISS**

Exhibit A

[Print](#)

Subject Hudson v. Goerner ESTTA 91199581
From: Catherine Hudson <bartbags@verizon.net>
Sent: Jul 17, 2011 03:10:27 PM
To: RWeeks@mwe.com

Hi Rita,

We placed several phone calls to your office last week and have not received a return call. The last and only settlement conference call was on July 5, 2011.

If we do not hear from your office by Wednesday this week, July 20, 2011, we will understand that your party has chosen to discontinue with settlement and wishes to proceed with discovery. We will inform the court and proceed accordingly.

Sincerely,

Christina Goerner