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

Proceeding	91204897
Party	Defendant Laguna Lakes Community Association, Inc.
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Attachments	Reply in Support of Motion to Dismiss.pdf(30465 bytes)

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

<p>John Gerard Marino,</p> <p style="padding-left: 100px;">Opposer,</p> <p>v.</p> <p>Laguna Lakes Community Association, Inc.,</p> <p style="padding-left: 100px;">Applicant.</p>	<p>)</p>	<p>Consolidated Opp. No. 91/204,897 91/204,941</p> <p>REPLY IN SUPPORT OF MOTION TO DISMISS FOR FAILURE TO PROSECUTE UNDER 37 CFR § 2.132(a)</p>
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I. Deficiencies with the Opposition and Affidavits.

Applicant, Laguna Lakes Community Association, Inc. (“Laguna Lakes”), filed its Motion to Dismiss for Failure to Prosecute on June 9, 2014. Thereafter, Opposer, John Gerard Marino (“Marino” or “Opposer”), filed his opposition on June 17, 2014 [TTABVUE No. 54], followed by two affidavits on June 19, 2014 – one by his counsel [TTABVUE No. 55] and one by him [TTABVUE No. 56]. Both affidavits are deficient and wanting.

The affidavit of Marino’s counsel is a near word-for-word restatement of paragraphs 1-6 of Marino’s opposition, and is in any event defective and of no legal force given that “John Gerard Marino,” and not his counsel, was sworn under oath by the notary public. *See* 55 TTABVUE at p. 3.¹ The affidavit also purports to have been served on June 17, 2014, when in fact it was served and filed two days later on June 19. *Id.* Opposing counsel’s affidavit contends that Opposer “intended to simply submit his own Declaration and to file a Notice of Reliance including deposition transcripts of previous depositions taken of the LLCA Board.” *See* 55 TTABVUE at p. 2; *see also* 54 TTABVUE at ¶3 (same). However, this is directly contrary to

¹ Suspiciously, opposing counsel also claims the opposition proceeding is “based upon [his] prior use of the mark.” Regardless of whether Opposer or his counsel is *claiming* prior use, there is absolutely no *evidence* in the trial record whatsoever, let alone *evidence* regarding prior use. And as explained herein and in Laguna Lakes’ moving paper, none of the evidence Opposer desires an extension to file is proper trial evidence.

Opposer's Pretrial Disclosures, which do not disclose any declaration testimony or the use of any deposition transcripts. *See* 51 TTABVUE, Ex. D to Declaration attached thereto.

Opposer's affidavit is much the same as his counsel's affidavit, but adds that his counsel did not advise him that he needed to have his Declaration finalized by May 30, 2014 and blames his counsel for the "failure to get together the subject Declaration and Notice of Reliance." *See* 56 TTABVUE at ¶¶5-6. For his part, Opposer's counsel concedes the failings were his "fault" and tries to fall on the sword for his client. *See* 55 TTABVUE at p. 3.

II. Law and Argument.

Good cause can be found nowhere in Opposer's opposition or the two affidavits filed in support thereof. Placing aside his failure to identify declaration testimony in his Pretrial Disclosures, Opposer entirely ignores, for example, that declaration testimony of witnesses may only be provided into the record when agreed to in writing by the parties. *See* TBMP § 703.01(b). "Inasmuch as the parties did not enter into a written agreement to allow testimony by such means," declaration testimony is "improper" and can be given no evidentiary weight. *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) (providing that declaration cannot be submitted in lieu of testimony deposition absent a stipulation of the parties). Laguna Lakes and Opposer never agreed in writing that "the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit or declaration." TBMP § 703.01(b); *see* Declaration [attached to 51 TTABVUE] at ¶9. Opposer's failure to file a reply in support of his motion [50 TTABVUE] indicates his concession to the validity of this argument.

Furthermore, as explained in Laguna Lakes' response to Opposer's motion to treat non-party deposition testimony as evidence, Opposer is not entitled to file any non-party deposition

testimony given that there is no stipulation of the parties approved by the Board, and no exceptional circumstances exist per 37 CFR § 2.120(j). See 51 TTABVUE at pp. 5-6. Moreover, though neither was identified in his Pretrial Disclosures and thus would be improper trial evidence on these grounds, Opposer did not need Board permission to file the discovery depositions of Patrick Tardiff and Robert Hajicek under 37 CFR § 2.120(j); any neglect on Opposer or his counsel to take the nominal amount of time to file these already prepared documents during his trial period is inexcusable. *Id.* at pp. 6-8. Opposer's failure to file a reply in support of his motion [50 TTABVUE] indicates his concession to the validity of this argument.

Although Opposer references Board precedent providing that “[t]he law favors determination of cases on the merits,” *Ctrl Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ.2d 1300 (TTAB 1999),² Opposer ignores that in *Ctrl Systems*, the Board denied a request similar to the one made by Opposer in this case. In particular, the Board denied a motion to set aside judgment and reopen the case that argued that “an attorney's actions or inaction can provide the basis for a finding of excusable neglect sufficient to set aside a judgment rendered against the attorney's client.” *Id.* (citing *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992)). The Board recognized that *General Motors* “is no longer good law” because **“it is well settled that the client and the attorney share a duty to remain diligent in prosecuting or defending the client's case; that communication between the client and attorney is a two-way affair; and that action, inaction or even neglect by the**

² Opposer also cites *Florists' Transworld Delivery, Inc. v. McAfee*, 1999 LEXIS 582 (TTAB 1999), but that case is of no accord here because it concerns a motion to permit the late filing of answers to requests for admission during the discovery stage. Unlike in *Florists' Transworld Delivery, Inc.*, this matter is well into the trial phase and the burden is on Opposer “as the party who brought this action . . . to move this proceeding forward pursuant to Board rules and regulations.” 22 TTABVUE at p. 6.

client's chosen attorney will not excuse the inattention of the client so as to yield the client another day in court.” *Id.* (emphasis added).

In this case, Opposer attests that “[a]t no time did [his] counsel in this matter advise [him] that [he] needed to have finalized [his] declaration in this matter by May 30, 2014, or [he] would have done so . . .” *See* 56 TTABVUE at ¶5. However, under *Ctrl Systems Inc.*, “it is well settled that the client and the attorney share a duty to remain diligent in prosecuting or defending the client's case; that communication between the client and attorney is a two-way affair.” 52 USPQ.2d 1300. As demonstrated in Laguna Lakes’ moving paper, neither Opposer nor his attorney have been diligent in prosecuting this case. *See* 52 TTABVUE at pp. 2-4. Furthermore, “inaction or even neglect by the client's chosen attorney will not excuse the inattention of the client so as to yield the client another day in court.” 52 USPQ.2d 1300. Consequently, it is not “good cause” for Opposer’s counsel to fall on the sword for his client and claim that “[t]he failure to get the subject Declaration and Notice of Reliance prior to May 30, 2014, was [his] fault,” and “was no fault of Opposer.” *See* 55 TTABVUE at pp. 2-3.

III. Conclusion.

Following Board rules and procedure, which Opposer and his counsel have repeatedly failed to do, is not “a technicality.” Laguna Lakes contests the extension sought by Opposer that he requested with only hours left in his trial period on the good faith basis that none of the evidence Opposer wishes to file is proper trial evidence; as such, though the extension requested by Opposer may be short, it would be futile and thus is unwarranted. As explained in Laguna Lakes’ moving paper, under *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997), Opposer can cite no good cause or excusable neglect to justify his or his counsel’s

conduct. In accordance with 37 CFR § 2.132(a) and TBMP § 534.02, the Board should dismiss these consolidated oppositions with prejudice and enter judgment against Opposer.

Respectfully submitted,

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Dated: July 2, 2014

CERTIFICATE OF SERVICE

I hereby certify that on the 2nd day of July, 2014, a copy of the foregoing was served by e-mail upon:

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