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

Proceeding	91219616
Party	Plaintiff Prudential Insurance Company of America
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Date	03/14/2016
Attachments	2016-03-14 Opposers M_Clarify.pdf(24015 bytes )

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

In Re: Application Serial No. 86/184,144  
For the Mark: ROCK SOLID INVESTMENT  
Filed: February 4, 2014  
Published in the Official Gazette: August 5, 2014

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The Prudential Insurance Company of America	)	
	)	
Opposer	)	
	)	
v.	)	Opp. No. 91-219,616
	)	
Daryl Bank	)	
	)	
Applicant	)	

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

**OPPOSER’S MOTION TO CLARIFY**

Opposer The Prudential Insurance Company of America respectfully submits this motion to clarify that the Report and Recommendation entered into the record by Applicant Daryl Bank on March 8, 2016, through the filing, captioned “Notice of District Court Determination,” is in fact, not a District Court determination. Accordingly, the Notice should not be used as a basis to lift the suspension in the Board proceeding.

On February 4, 2016, Opposer filed with the United States District Court for the Southern District of Florida its Motion to Enforce Subpoenas, for Sanctions against Applicant (“District Court Motion”). Per the Board’s order of January 20, 2016, 13 TTABVUE, Opposer filed a copy of the same with the Board. 14 TTABVUE. Subsequently, the Board issued a suspension until final disposition of the District Court proceedings and further ordered the parties

to notify the Board within twenty days “after the District Court’s determination of Opposer’s motion for sanctions.” 15 TTABVUE (emphasis added). The order further provided that “[s]uch notification to the Board should include a copy of the District Court’s order.” *Id.* (emphasis added).

On February 17, 2016, Magistrate Judge Frank J. Lynch, Jr. issued a Report and Recommendation (“R&R”) regarding Opposer’s District Court Motion, recommending to the District Court that Opposer’s motions be denied. The Magistrate further recommended that the Motion to Enforce Subpoenas be denied “without prejudice to pursuing the discovery anew and that the Motion for Sanctions be denied without prejudice to seeking sanctions relief from the United States Trademark Trial and Appeal Board.” Attachment to 16 TTABVUE, at 6.

Applicant’s counsel, Mark Terry, on March 7, 2016, contacted Opposer’s counsel inquiring whether Opposer would agree to filing a joint motion to notify the Board of the R&R. *See* Exhibit A. Opposer’s counsel, Donna Gonzales, indicated to Mr. Terry that such filing was premature, since the R&R is not a “District Court determination,” as indicated by the Board in its February 24, 2016 order. *See id.* This is especially true, since Opposer has filed with the District Court objections to the R&R, and the District Court has yet to rule on the objections. Ms. Gonzales further explained that the Board’s order regarding the notification was primarily in contemplation of whether the suspension in the Board proceeding should be lifted. *See id.* Despite counsel’s explanation, Mr. Terry filed the R&R with the Board under a filing, captioned “Notice of District Court Determination.”

Opposer seeks to clarify the record to establish that the recommendations contained in the Magistrate’s report are not considered a “determination by a District Court” until such recommendations are adopted by the District Court Judge. Therefore, out of abundance of

caution and because of the mischaracterized caption of Applicant's filing, Opposer is filing the present motion to explain its position as to why the R&R is not a District Court order and thus should not be considered a determination by the District Court. For these reasons, Opposer declined to join Applicant's filing.

WHEREFORE, Opposer respectfully requests the Board maintain the suspension of the proceedings until the District Court issues its final determination on Opposer's Motion to Enforce.

Date: March 14, 2016

Respectfully submitted,

LATHROP & GAGE LLP

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ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE AND ONLINE SUBMISSION**

I hereby certify that a true and correct copy of this Motion to Clarify was filed online with the Trademark Trial and Appeal Board using the ESTTA this 14<sup>th</sup> day of March, 2016. Further, I hereby certify that the above document was deposited in the U.S. Mail, with sufficient first class postage prepaid, on the 14<sup>th</sup> day of March, 2016, addressed to Opposer's attorney of record:

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By: /s/ Amy Brozenic  
Amy Brozenic