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

Proceeding	91223546
Party	Plaintiff Heathkit Company, Inc., Heath Company, Heathkit Vintage LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. App. Serial No. 86/354,157
For the mark: HEALTHKIT
Published in the *Official Gazette of Trademarks* on Mar. 03, 2015

Heathkit Company, Inc., Heath Company, and
Heathkit Vintage LLC

Opposer- Registrant,

Apple Inc.,

Applicant- Petitioner.

Opposition No. 91223546

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

OPPOSERS' REPLY TO APPLICANT'S OPPOSITION TO MOTION TO STRIKE

Heathkit Company, Inc., Heath Company, and Heathkit Vintage LLC ("Heathkit" or "Opposers"), by its attorneys, hereby responds to Applicant's Opposition to Motion to Strike, dated February 3, 2016, filed by Applicant Apple Inc. ("Apple") as follows:

1. On November 16, 2015, Heathkit filed with the Board a Motion to Dismiss, a Motion to Strike, and an Answer to Apple's Cancellation-Counterclaims.

2. On December 7, 2015, Apple filed its responses in opposition to the motions that Opposers filed.

3. Apple's Certificates of Service recite that the responses were sent to Opposers' Counsel's current address, 830 Third Avenue, 5th Floor, New York, NY 10022. However, the mailing label of the package sent by Apple on December 7, 2015, indicates that Apple's responses were mailed to Opposers' Counsel's former address of 8 West 40th Street, 12th Floor, New York, NY 10018.

4. Apple concedes that the responses filed on December 7, 2015 were sent to the wrong address, thus rendering the Certificates of Service defective as a matter of law. See *Chocoladefabriken Lindt & Sprungli Ag.*, 91 U.S.P.Q.2d 1698 (TTAB 2009) ("To determine the correspondence address of record for an applicant or registrant, the plaintiff must check the Trademark Applications and Registrations Retrieval (TARR) system at the following web address: <http://tarr.uspto.gov>"). Apple makes the excuse that the individual preparing the envelope inadvertently used an address that appears as current owner of the asserted applications on the <http://tsdr.uspto.gov> webpage. The mistake is inexcusable, since on or before November 20, 2015, the Attorney/Correspondence Information listed on the TARR system for the relevant trademarks is 830 Third Avenue, 5th Floor, New York, NY 10022. Due to this defect in service, Opposers did not receive a copy of Apple's motions until on or about January 17, 2016. See *Aff. of Sabety* pp. 10-11.

5. Apple argues that, despite the admitted defect in the Certificates of Service, service was proper because the motions were timely filed through ESTTA, which Apple claims would have resulted in Opposers' Counsel receiving an email notification that same day.

6. Apple's position is directly contradicted by ESTTA rules. ESTTA only transmits email notifications when the TTAB issues an order, and not when an opposing party has filed papers.

Trademark Trial and Appeal Board Manual of Procedure Rule 110.09(d) clearly states that, “In addition to the requirement for a certificate of service, ESTTA papers, like all other Board filings, must actually be served upon the other parties to the proceeding in the manner designated. ESTTA does not automatically serve papers upon opposing parties or provide notice of their filing.” It could not be any plainer that Opposers were not in receipt of Apple’s responses and were not given notice that Apple had filed papers in the proceeding. *See* Aff. of Sabety pp. 13.

7. Apple next argues that Opposers somehow had constructive notice of its filings, but fails to explain how a suspension order from the TTAB, which would have been issued regardless of whether Apple filed additional papers in the proceeding, constitutes notice of a new filing. Moreover, Apple cannot cite any law which states that constructive notice is proper service. Proper service is a necessary component in any legal action, as Justice Brennan writes: “We have also clearly recognized that the Due Process Clause does prescribe a constitutional minimum: an elementary and fundamental requirement of due process in any proceeding which is to be accorded finality is notice reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections.” *See Greene v. Lindsey, 456 US 444 1982* (holding that failing to provide the appellees with adequate notice of the proceedings against them before issuing final orders of eviction constituted a deprivation of property without the due process of law).

8. Surprisingly, Apple further argues that “Opposers do not even attempt to explain how their actual receipt of a service copy of Apple’s filing at a different address could possibly cause prejudice.” As Justice Brennan pointed out, denial of Opposers’ right to “due process and the opportunity to be heard” is prejudice. *See Green v. Lindsey, 456 US 444 1982*. Apple fails to

consider that Opposers were denied the opportunity to respond to Apple's request for leave to amend, which was misleadingly included in Apple's Opposition to Motion to Dismiss Counterclaims and was not even titled as a motion. Apple also fails to consider that Opposers were denied the opportunity to respond to any pleadings that may have been included in the motions Apple submitted, since the time to answer expired before the papers were actually served on Opposers. Pursuant to 37 C.F.R s.2.127(a), "a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board...When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded" (emphasis added). That outcome is prejudice against Opposers.

9. Apple's reliance on *Mccormick Delaware, Inc. & Mccormick & Mccormick & Co., Inc.* Cancellation 28,967,2001 WL 253633 is completely misplaced. In that case, the respondent's law firm sent a copy of the motion to the petitioner via facsimile and via first class mail. Apple overlooks the critical point that the certificate of service in that case was an accurate statement and the motion was in fact mailed to the correct address. In contrast, Apple's Certificates of Service in this case contain a false statement. Apple's motions were sent to the wrong address, and Opposers' Counsel did not receive the motions until more than a month after they were mailed. In addition, Apple failed to transmit a courtesy copy of Apple's motions via email, despite the fact that the two law firms had previously exchanged correspondence via email. Thus, *McCormick*, as well as *Chocoladefabriken Lindt & Sprungli Ag.*, 91 U.S.P.Q.2d 1698 (TTAB 2009), do not support Apple's arguments.

WHEREFORE, Heathkit respectfully requests that the Board enter an order granting the Motion to Strike all of Apple's filings made on December 7, 2015 for failure to properly serve its responses on Opposers, and grant Heathkit any other additional and further relief that the Board deems proper.

In the alternative, Opposers request that the Board require Apple to properly serve their Motion for Leave to Amend and reset the calendar so that Opposers can file their opposition to that motion as well as a time period for reply to Apple's opposition to Opposers' prior motion to strike—seeing as it appears Apple believes both were incorporated into the one paper.

Respectfully submitted,

2/12/2016

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CERTIFICATE OF SERVICE

Registrant and Opposer HEATHKIT COMPANY, INC., HEATH COMPANY, AND HEATHKIT VINTAGE LLC, hereby certifies that a copy of this REPLY TO APPLICANT'S OPPOSITION TO MOTION TO STRIKE has been served upon Petitioner and Applicant APPLE INC. on this 12th day of February, 2016, by First Class U.S. Mail, postage prepaid, at the following addresses:

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