

TTAB

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

NY-EXOTICS, INC.

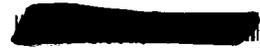
Petitioner

vs.

EXOTICS.COM, INC.

Respondent

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12-23-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

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PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND RESPONSE TO RESPONDENT'S RULE 56(f) MOTION

Petitioner NY-Exotics, Inc. ("NY-Exotics") hereby files its Reply to Respondent's Opposition (Respondent's Opp.) to Petitioner's Motion for Summary Judgment and Response to Respondent's Rule 56(f) motion, as follows:

A. Respondent's Rule 56(f) Motion should be denied

In conjunction with its opposition to Petitioner's Motion for Summary Judgment ("Petitioner's Motion"), Respondent has requested additional time in which to conduct discovery pursuant to Fed. R. Civ. P. 56(f). The Board should deny Respondent's Rule 56(f) motion because it does not meet the criteria set forth by the TTAB Manual of Procedure (TBMP).

Section 528.06 of the TBMP states that a party seeking to conduct additional discovery

pursuant to Rule 56(f) must support its request by an affidavit or declaration signed by the party or its counsel, setting forth the reasons for requesting the additional time. Respondent has failed to comply with this requirement.

Furthermore, instead of filing its request in a separate paper, Respondent has “buried” its Rule 56(f) request in its response on the merits to Petitioner’s Motion as a “throw away” alternative to its response. This is specifically prohibited by the TBMP and is grounds for denial of a Rule 56(f) motion. *See* TBMP § 528.06; *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 U.S.P.Q.2d 2009 (TTAB 2002) (Rule 56(f) motion denied where opposer filed a response to the motion for summary judgment on the merits).

For the reasons set forth above, Respondent’s Rule 56(f) motion should be denied.

B. Petitioner’s Motion for Summary Judgment should be granted

1. Respondent has not disputed the material facts

In its opposition to Petitioner’s Motion, Respondent has not specifically indicated the particular material facts in dispute or pointed to concrete evidence that shows the facts in dispute. Specifically, Respondent has not rebutted the undisputed facts set forth in Petitioner’s Motion with countering supported evidence, but rather has improperly rested on mere denials and conclusory assertions, which have been submitted in the forms of multiple affidavits. *See* TBMP § 528.01; *Sweats Fashion Inc. v. Pannill Knitting Co.*, 4 U.S.P.Q.2d 1793, 1797 (“[M]ere conclusory statements and denials do not take on dignity by placing them in affidavit form.”). Inasmuch as Respondent has not submitted sufficient evidence to create a genuine factual dispute with respect to the core undisputed material facts at issue in the proceeding, namely, the license agreement between Petitioner and Exotics USA LLC, the breach of the license agreement by Exotics USA LLC and subsequent termination and Respondent’s use of Petitioner’s advertisement as a specimen for Respondent’s registration, a reasonable fact finder would not decide in favor of Respondent. Therefore, there are no genuine issues of material to be tried and

Petitioner's Motion should be granted.

2. Respondent has raised previously unalleged issues

A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. *See* TBMP § 528.07(b); *Perma Ceram Enterprises, Inc. v. Preco Industries Ltd.*, 23 U.S.P.Q.2d 1134, 1135 n.2 (TTAB 1992) (no consideration given to three unpleaded grounds asserted by a non-movant in response to a motion for summary judgment). Respondent has raised several unalleged issues for the first time in its response to Petitioner's Motion, including without limitation, Petitioner's President's attempted takeover of Exotics.com and the pendency of civil proceedings in state court. *See* Respondent's Opp. at pp. 5-7. The pendency of a civil law suit in which Petitioner is neither a party nor a witness or which does not otherwise involve the Petitioner, is irrelevant to the Board's consideration of Petitioner's Motion, but more importantly is nothing more than a ploy on the part of Respondent to divert the Board's attention away from the core issues in this proceeding. Therefore, the Board should disregard the unalleged claims and defenses raised by Respondent in its opposition to Petitioner's Motion.

3. Respondent has the burden of proving its affirmative defenses

Although Respondent has raised certain affirmative defenses in its answer to Petitioner's cancellation petition, it has failed to meet its burden of proving these defenses. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) (no requirement that moving party support its motion with affidavits or other similar materials negating the opponent's claim but may be based on non-movant's failure to make sufficient showing as to its own case on which it has burden of proof). Respondent has not produced any information during the discovery period in proof of its affirmative defenses nor has it provided concrete evidentiary support for these defenses in its opposition to Petitioner's Motion. Furthermore, Respondent's pleading of various affirmative defenses in its answer does not include sufficient detail to give Petitioner fair notice of the basis

of the defense. See *McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45, 47 (TTAB 1985). Additionally, Respondent has failed to plead the affirmative defense of fraud (Respondent's Sixth Affirmative Defense) with the degree of particularity required by Fed. R. Civ. P. 9. Inasmuch as Respondent has failed to make a sufficient showing on its affirmative defenses on which it has the burden of proof, Petitioner is not required to negate Respondent's bald assertions.

4. Respondent's improper reliance on non-binding precedent

Throughout its opposition brief, Respondent has improperly relied on all manner of improper non-binding precedent including California state cases. Indeed, Respondent has failed to cite a single TTAB, Federal Circuit or U.S. Supreme court case in its opposition to Petitioner's Motion. Therefore, Respondent's legal arguments hold little, if any, weight and should be disregarded by the Board in their entirety.

C. Conclusion

For the foregoing reasons, Petitioner respectfully requests the Board to grants its Motion for Summary Judgment.

Respectfully submitted,

Date: _____

12/23/03


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ATTORNEYS FOR PETITIONER
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing "Petitioner's Motion for Summary Judgment and Memorandum in Support" was served on Registrant's attorney of record via United States first-class mail, postage prepaid, on this 23rd day of December 2003, as follows:

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