

ESTTA Tracking number: **ESTTA211133**

Filing date: **05/13/2008**

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

Proceeding	92049029
Party	Defendant Review Publishing Limited Partnership
Correspondence Address	Glenn A. Gundersen DECHERT LLP Cira Centre, 2929 Arch Street Philadelphia, PA 19104 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
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Date	05/13/2008
Attachments	TASTE OF SOUTH JERSEY reply brief (motion to dismiss).pdf (6 pages) (1546536 bytes)

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

DAVID. J. LONG, JR.	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92/049,029
	:	
REVIEW PUBLISHING	:	
LIMITED PARTNERSHIP	:	
	:	
Registrant.	:	

REGISTRANT'S REPLY BRIEF

Registrant, Review Publishing Limited Partnership, moved to dismiss this proceeding on the grounds that Petitioner, David J. Long, Jr., filed a cancellation petition without serving Registrant with a copy of this petition in the manner required by Rules 2.111(b) and 2.119(b). Petitioner filed multiple legal briefs and supporting affidavits in response to Registrant's motion.¹ Rule 2.127(a) states that a party is only allowed to file a single brief in response to a motion. Registrant respectfully submits that the Board should only consider the first brief that Petitioner filed in response to the motion to dismiss and ignore any subsequent filings. Although Mr. Long is representing himself in this proceeding, even *pro se* litigants are required to comply with the rules governing this proceeding.

Even if the Board decides to consider all of the Petitioner's briefs, they fail to provide any factual or legal basis for allowing this proceeding to continue. Petitioner filed his

¹ These filings have been entered into the record as docket items 5, 6, 7, 8, 9, and 11, and are referred to herein as "Docket [number] at p[age] [number] of [number]" or "Docket [number], ¶ [number]."

cancellation petition on March 18th. There is no dispute that Petitioner sent a copy of this petition to the Registrant and the Registrant's attorney by electronic mail, and there is no dispute that Registrant and Registrant's attorneys received these transmissions. However, Petitioner has failed to provide any evidence demonstrating that Registrant or Registrant's attorneys agreed to accept service of process through electronic delivery. Because Registrant never agreed to accept electronic service, the cancellation petition was improperly filed and this proceeding should not have been instituted.

Petitioner claims that he corrected this mistake by sending the Registrant another copy of his cancellation petition by certified mail. However, Petitioner put this document in the mail on April 25th – more than a month after he filed his cancellation petition. A cancellation petition must be served on the same date that the petition is filed with the Board. Providing service at some future date is not sufficient.

Finally, Petitioner argues that this proceeding should be allowed to move ahead, because Registrant is already aware of the cancellation petition, and in fact, has referred this matter to its attorneys. The fact that Registrant is aware of the cancellation petition is irrelevant, because this proceeding was never properly instituted. The fact that Registrant's attorneys have filed a formal response to the cancellation petition is irrelevant, because attorneys may appear before the Board solely for the purpose of challenging the sufficiency of the plaintiff's service of process.

ARGUMENT

There is no evidence that Registrant ever agreed to accept service of process through electronic delivery – either before or after the cancellation petition was filed. In fact, Petitioner admits that he attempted to contact the Registrant “at least one year prior to filing his petition to cancel,” but did not receive a response to his alleged inquiries. (Docket 6 at p. 2 of 3.)

Petitioner claims that Registrant's attorney, Glenn A. Gundersen, “agreed to receive correspondence by electronic submission from the [Petitioner]” before the Petitioner filed his

cancellation petition on March 18th. (Docket 9, ¶ 2; Docket 11 at p. 2 of 13.) The only evidence that Petitioner offered in support of this claim is a receipt, which indicates that he sent an email to Mr. Gundersen on March 18th at 4:38 p.m. and that Mr. Gundersen opened this message on March 18th at 5:21 p.m. (See Docket 5 at p. 7 of 7; Docket 11 at p. 8 of 13.) In other words, Petitioner claims that Mr. Gundersen agreed to accept electronic service, because he opened an email message that happened to contain a copy of the cancellation petition.² That obviously is not correct. Rule 2.119(b)(6) states that service may only be made by “[e]lectronic transmission when mutually agreed upon by the parties.” When the Board implemented this rule, it specifically stated that a petitioner “may not serve its complaint . . . on a defendant by e-mail unless the defendant has agreed with the [petitioner] to accept such service” Final Rule, 72 Fed. Reg. 42,242, 42,243 (Aug. 1, 2007). If a petitioner could force a registrant to accept electronic service by sending an unsolicited email to the Registrant or the Registrant’s attorney, Rule 2.119(b)(6) would be meaningless. At best, this receipt only proves that Mr. Gundersen received a copy of the cancellation petition via electronic email. It does not prove that he agreed to accept electronic service, or that the Petitioner discussed this issue with Mr. Gundersen before he filed his cancellation petition. Moreover, Petitioner has not offered any letters, emails, or other written correspondence from Mr. Gundersen or any of the Registrant’s attorneys indicating that they agreed to accept service via electronic means.³

² Petitioner submitted similar receipts which indicate that he sent the same email to three of Registrant’s employees on March 18th at 4:38 p.m., and that Registrant’s employees opened this message on March 18th at 7:32 p.m. and on March 19th at 10:07 a.m. (See Docket 5 at p. 6 of 7; Docket 8 at p. 2 of 2; Docket 11 at p. 9, 10 of 13.) Petitioner does not claim that these employees agreed to accept service by electronic means either before or after the cancellation petition was filed.

³ Petitioner submitted a fax cover sheet dated March 13th, which was addressed to Mr. Gundersen and the three of Registrant’s employees. (Docket 5, p. at 4 of 7.) Petitioner has not provided any evidence that this fax was actually sent, such as a confirmation receipt or a fax transmission report. Even if Petitioner faxed a copy of the cancellation petition to Mr.

Petitioner claims that Mr. Gundersen contacted the Petitioner by telephone “on or around March 18, 2008,” but he has not offered any evidence to support that claim. (Docket 6 at p. 2 of 3.) The claim is in fact false. Registrant has submitted declarations from its attorneys confirming that they did not speak with the Petitioner between February 1st and March 18th (the date that the petition was filed), and as such, they could not – and did not – agree to accept service of that petition via electronic means. (See Declaration of Glenn A. Gundersen, ¶¶ 1, 3; Declaration of Hal Borden, ¶¶ 1, 3.) In addition, Registrant’s attorneys have conducted a search of their email system for incoming and outgoing emails between Registrant’s law firm and the email addresses that Petitioner provided in his cancellation petition. This search confirms that Registrant’s attorneys did not send any email messages to the Petitioner between February 1st and May 13th. (See Gundersen Decl. ¶ 2; Borden Decl. ¶ 2; Declaration of Erik Bertin, ¶ 4 & Exs. A, B, & C thereto.)⁴

Petitioner claims that he received a telephone call from Registrant’s attorney, Hal Borden, on March 19th at approximately 10:40 a.m., and that Mr. Borden “agree[d] for his firm, DECHERT LLP, to receive correspondence by Electronic submission from the [Petitioner] pursuant to Rule 2.119(b)(6).” (Docket 9, ¶ 3; Docket 11, ¶ 3.) Mr. Long has mischaracterized the substance of this conversation. Petitioner told Mr. Borden that he publishes a magazine called “Taste of South Jersey.” Mr. Borden asked the Petitioner to send him a copy of this publication via electronic mail, although the Petitioner declined to do so until he has discussed this matter with an attorney. However, Mr. Borden never agreed to accept electronic service of the cancellation petition or any other document filed in this proceeding. (Borden Decl. ¶¶ 1, 3.)

Gundersen and the Registrant’s employees, that does not prove that these recipients agreed to accept service through this type of electronic transmission.

⁴ The Declarations of Glenn A. Gundersen, Hal E. Borden, and Erik Bertin are being filed contemporaneously with Registrant’s Reply Brief.

The fact that this conversation took place on March 19th -- the day after the cancellation petition was filed -- confirms that Mr. Borden could not have agreed to accept electronic service before the cancellation petition was filed. Moreover, if Mr. Borden had agreed to accept electronic service, it is likely that Petitioner would have sent a copy of the cancellation petition directly to Mr. Borden. Registrant's attorneys have demonstrated that Petitioner never exchanged any email messages with Mr. Borden. (Borden Decl. ¶ 2; Bertin Decl. ¶ 4 & Ex. A thereto.)

Petitioner claims that the motion to dismiss should be denied as moot, because he sent a second copy of the cancellation petition to the Registrant and the Registrant's attorneys by certified mail. (Docket 6 at p. 2 of 3; Docket 9, ¶ 4; Docket 11, ¶ 2.) Petitioner has submitted tracking receipts which confirm that he did not put these copies in the mail until April 25th -- more than a month after he filed his cancellation petition with the Board. (*Compare* Docket 9, ¶ 4 *and* Docket 11, ¶ 6 *with* Bertin Decl. ¶ 5 & Ex. D thereto.) "The requirement of the rules is for proof of service, not a promise to make service at some time in the future." *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008) (precedential decision). In this case, Petitioner sent a copy of the cancellation petition to the Registrant by electronic mail, but he did not bother to find out if the Registrant would be willing to accept service by electronic means. Petitioner's belated attempt to fix this mistake by sending the cancellation petition by certified mail is improper, because the service copy was not mailed on the same date that the petition was filed.

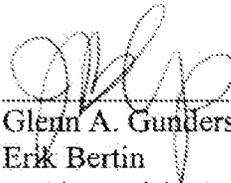
Finally, Petitioner argues that the motion to dismiss should be dismissed as moot, because Registrant is actually aware of the cancellation petition and has referred this matter to its attorneys. (Docket 11, ¶¶ 1, 2.) Petitioner misunderstands the basis for this motion. There is no dispute that Registrant actually received copies of the cancellation petition via electronic mail, and is aware of the fact that the Board has instituted a cancellation proceeding based upon that petition. The issue is that Registrant never agreed to accept service by electronic mail. As such, the cancellation was improperly filed and the Board should not have instituted this proceeding.

The fact that Registrant has referred this matter to its attorneys is irrelevant, because an attorney may appear before a court or other tribunal solely for the purpose of challenging the sufficiency of the plaintiff's process under Fed. R. Civ. P. 12(b)(5) without subjecting the defendant to the jurisdiction of the court. *Joyce v. Joyce*, 975 F.2d 379, 386 (7th Cir. 1992).

CONCLUSION

In view of the foregoing, the proceeding should be dismissed.

Respectfully submitted,



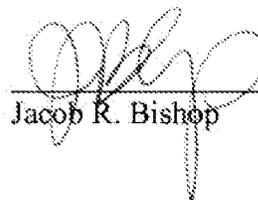
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REVIEW PUBLISHING
LIMITED PARTNERSHIP

Dated: May 13, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Registrant's Reply Brief has been duly served by mailing such copy first class, postage prepaid, to David J. Long, Jr., 2050 Delsea Drive, Sewell, NJ 08080 on May 13, 2008.



Jacob R. Bishop