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

Proceeding	92053355
Party	Plaintiff Strike King Lure Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Trademark Registration of Wyman von Mohr & Associates
For the Mark: ROCKET FISHING ROD
Registration No.: 3,500,147
Registered: September 9, 2008
Int’l Class(es): 28

Strike King Lure Company)	Attorney Docket No. 99,059B
(a Tennessee corporation),)	
)	
Petitioner,)	
)	
v.)	TTAB Cancellation No. 92053355
)	
Wyman von Mohr & Associates,)	Attorney Docket No. 5369-92
)	
Registrant.)	

PRECAUTIONARY RESPONSE OF
PETITIONER STRIKE KING LURE COMPANY
TO REGISTRANT’S MEMORANDUM OF LAW IN SUPPORT OF
REGISTRANT’S MOTION TO COMPEL DISCOVERY
AND PRETRIAL DISCLOSURES

1 This response is being submitted simply as a precaution to Registrant’s Memorandum of
2 Law filed via the ESTTA of the TTAB on April 5, 2012. For reasons discussed below, it is
3 believed that Registrant’s Memorandum of Law is moot and that settlement is underway and that
4 this cancellation action can be resolved by agreement between the parties.

5 On April 5, 2012, Registrant filed a Memorandum of Law (T.T.A.B. D.E. 14)
6 accompanied Registrant’s Declaration of Lisa A. Ferrari (T.T.A.B. D.E. 15). Neither the ESTTA
7 Docket History, nor the emails from the ESTTA just after 10:00 pm CDT on April 5, 2012, nor
8 the service copy received by Petitioner’s undersigned attorney by email from Registrant’s
9 attorney moments later on April 5, 2012, contained a Motion to Compel, only Registrant’s

1 Memorandum of Law and the supporting Declaration of Lisa A. Ferrari. Again, as discussed
2 below, while it is believed that such a Motion to Compel is moot, this response is made as a
3 precaution.

4 **Facts**

5 Registrant's statement of the facts is, by and large, accepted. Initial discussions between
6 Petitioner's attorney and Registrant's attorneys indicated that settlement of this matter would be
7 possible with an appropriate restriction of goods for the parties and if appropriate steps could be
8 taken to prevent confusion. Petitioner is unaware of any actual confusion that has occurred, and
9 the only reason that this cancellation action was filed was because of the Trademark Examining
10 Attorney's position, during the prosecution of Petitioner's reinstatement application 77/944567
11 to reinstate its registration for the mark ROCKET SHAD for fishing lures sold to adult anglers,
12 that Petitioner's mark was likely to be confused with Registrant's mark ROCKET FISHING
13 ROD for its fishing rods for children and juniors, who are not purchasers of Petitioner's goods.

14 It is still believed that settlement is possible and likely between the parties.

15 The undersigned attorney's eighty-nine year old mother has had a series of ongoing
16 health issues that still continue. The undersigned attorney, the sole attorney in a single-person
17 office, has to spend time each week responding to his mother's health issues and to take her to
18 doctors and to the emergency room at the hospital. She has been in and out of the hospital and
19 this week has had a heart event monitor fitted as her cardiologist tries to diagnose her health
20 issues. Because she is deaf in one ear and almost deaf in the other, the undersigned attorney has
21 to take her for even routine doctor's appointments and tests so that there can be effective
22 communication with the doctors and nurses.

23 Additionally, beginning in November 2011, the building landlord for the undersigned
24 attorney's office building suddenly and unexpectedly requested that the undersigned attorney

1 move his small one-person office from one suite in our building to another so that the building
2 landlord could consolidate some smaller offices to create space for a large tenant. The
3 undersigned attorney had to box up his office for the sudden move, relocate, and arrange for
4 telephone and network wiring in the new office space so that the office could be re-established in
5 the new suite, a process that was complicated by mishandling by AT&T of the telephone, fax,
6 and internet line transfers from the old to the new suite and which resulted in the office being
7 without communications capability for much of December 2011.

8 The re-establishment of an operating office continues, accompanied by ongoing work in
9 the ceiling on the HVAC system, involving new ducting and the like.

10 On March 28, 2012, the undersigned attorney received an inquiry from Registrant's
11 attorney inquiring as to Petitioner's discovery responses, and Petitioner's attorney, upon
12 investigation, realized that Registrant's discovery requests had inadvertently been sent with other
13 files during the office relocation out to a storage facility in Collierville, Tennessee, and the
14 undersigned attorney spent that afternoon searching through boxes in the storage facility and
15 located the discovery requests and notified Registrant's attorney. Responses were prepared and
16 revised in consultation with Petitioner and its undersigned attorney, and documents were
17 compiled for production.

18 Registrant's attorney indicated that Registrant would make a motion to compel discovery
19 if responses and production were not received by April 5, 2012. Petitioner's undersigned
20 attorney contacted Registrant's attorney on April 5, 2012, indicated that the final document
21 assembly was underway, and asked if Registrant would accept electronic delivery of the
22 discovery responses and production by email, and Registrant's attorney indicated that would be
23 acceptable.

24 While completing the document assembly that night, Petitioner's attorney was surprised

1 to received Registrant’s Memorandum of Law and Declaration from the ESTTA, followed
2 minutes later by the emailed service from Registrant’s attorney. Petitioner’s undersigned
3 attorney immediately responded to Registrant’s attorney with surprise and began forwarding the
4 discovery responses and production.

5 Petitioner’s law office hosts its own email and DNS server for its domain, as it has since
6 reconstruction of its office building following a fire that destroyed its office, and the entire floor
7 of our office building, in 2005. Prior to April 5, 2012, and continuing to the present, Petitioner’s
8 internet-facing server (behind its networking firewall) is believed to be under an intermittent
9 Denial-of-Service attack that its networking firewall attempts to mitigate and/or address. The
10 afternoon and night of April 5, 2012, that attack resumed, and caused the networking firewall to
11 “crash” repeatedly as the last of the discovery responses were being sent (and attempted to be
12 sent) to Registrant’s attorney. Even having to repeatedly interrupt the discovery document
13 assembly process to address this problem and get the email server back “on line”, Petitioner’s
14 attorney was able to deliver all Bates-numbered documents and the Interrogatory Responses to
15 Registrant’s attorney on April 5, 2012, and the written responses to the Requests for Production
16 and the Initial Disclosures followed shortly after midnight after the Denial-of-Service problems
17 were able to be stabilized and the networking firewall was able to be kept from “crashing” by
18 adding appropriate firewall “rules” to block the flood of attacking packets.

19 The discovery responses are believed to be fully responsive. Voluminous sales data and
20 other highly-confidential documents requested by Registrant has been made available for
21 inspection subject to entry of an appropriate protective order.

22 On April 6, 2012, Petitioner’s undersigned attorney also electronically delivered to
23 Registrant’s attorney a detailed draft settlement agreement and an appropriate proposed
24 protective order, similar to the TTAB’s model protective order but modified so that some highly-

1 confidential documents could be provided for review for outside counsel eyes only. The
2 proposed settlement agreement is believed to be along the lines previously discussed with
3 Registrant's attorney. Registrant's attorney acknowledged receiving the above, and stated to
4 Petitioner's attorney on April 6 that "We will review and get back to you."

5 In short, Registrant's Memorandum of Law, interpreted to be a Motion to Compel, is
6 respectfully believed to be moot in view of what are believed to be full discovery responses and
7 production provided to Registrant three weeks ago.

8 Petitioner's undersigned attorney had expected that Registrant's attorney would "get
9 back" to Petitioner's attorney with any requested changes to the protective order and settlement
10 agreement so that this matter could be closed and Registrant's Motion to Compel could be
11 withdrawn as moot, but has not heard further from Registrant's attorney, and assumes that
12 Registrant, who is believed to be outside the United States and in Canada, is still discussing those
13 documents with its attorneys. Petitioner respects that discussion that is assumed to be occurring,
14 and has no desire to escalate the discovery process or cause Registrant to incur the expense of
15 escalated litigation while settlement still seems to be possible.

16 Petitioner respectfully believes that Registrant has not been prejudiced in any way by this
17 unfortunate delay. Appropriate just cause is believed to have been shown for the delay,
18 especially in view of the fact that settlement is still believed to be possible for this matter.

19 Petitioner has been and still is a market leader for at least the past forty-five years in
20 fishing lure goods sold to adult anglers throughout the United States, and has used its mark
21 ROCKET SHAD for fishing lures in commerce continuously throughout the United States since
22 at least as early as July 31, 1999, and such use continues. Petitioner's ROCKET SHAD mark
23 was registered as U.S. Registration 2464463 on June 26, 2001, and inadvertently became
24 canceled in March 2008 because of Petitioner's inadvertent failure to file a Declaration of

1 Continued Use under Section 8 of the Trademark Act. Upon discovery of the cancellation of its
2 U.S. Registration 2464463 for the mark ROCKET SHAD, Petitioner promptly filed its
3 reinstatement application 77/944567 to reinstate registration of mark ROCKET SHAD. The
4 cancellation of Petitioner's registration 2464463 did not alter Petitioner's extensive common law
5 rights in and to its mark and the goodwill associated therewith resulting from its long and
6 continued use throughout the United States, and Petitioner's priority date for its mark is well
7 prior to Registrant's stated priority date. Until receiving the first Office Action from the U.S.
8 Patent and Trademark Office on June 2, 2010, because of the non-overlap of goods and
9 respective target purchasers, Petitioner was unaware of Registrant or its mark ROCKET
10 FISHING ROD, and still believes, as Registrant's attorney has indicated, that an appropriate
11 settlement agreement could ensure that confusion would not be likely to occur.

12 Accordingly, in view of the fact that full responses were made to Registrant's discovery
13 requests three weeks ago such that Registrant's Motion to Compel is believed to be moot, and in
14 view of what are believed to be ongoing settlement efforts, Petitioner requests that the Board
15 hold a ruling on Registrant's Motion to Compel in abeyance until such time as settlement
16 negotiations are concluded or else become improbable.

Respectfully submitted,

STRIKE KING LURE COMPANY,
Petitioner

Date: April 27, 2012

By: /Russell H. Walker/

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***Certificate of Mailing and of Electronic Filing
under 37 C.F.R. § 2.197 (formerly 37 C.F.R. § 1.8)***

I hereby certify that the foregoing **PRECAUTIONARY RESPONSE** is being electronically submitted by me via the Internet to the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office using the ESTTA Electronic Filing System on April 27, 2012, and that a copy of the foregoing **PRECAUTIONARY RESPONSE** is being deposited with the United States Postal Service as U.S. First Class Mail, postage prepaid, on April 27, 2012 in an envelope addressed to the attorneys of record for Registrant:

Edward M. Weisz, Esq. and Lisa A. Ferrari, Esq.
Cohen, Pontani, Lieberman & Pavane, LLP
227 Park Avenue
New York, NY 10172

and that a copy of the foregoing **CONSENTED MOTION** is also being emailed to Edward M. Weisz, Esq. ("EWeisz@cplplaw.com") and to Lisa A. Ferrari, Esq. ("LFerrari@cplplaw.com") on April 27, 2012.

Electronic Signature of Person Transmitting:	/Russell H. Walker/
Typed Name of Person Transmitting:	Russell H. Walker U.S.P.T.O. Registration No. 35,401
Electronic Signature of Person Mailing:	/Russell H. Walker/
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