

ESTTA Tracking number: **ESTTA709013**

Filing date: **11/17/2015**

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

Proceeding	92059305
Party	Plaintiff MWR Holdings, LLC
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Date	11/17/2015
Attachments	Motion to Strike.pdf(243601 bytes)

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

MWR HOLDINGS, LLC,

Petitioner,

v.

THEODORE A. STONER,

Registrant.

Cancellation No. 92059305

Mark: BONGO BI-LINGO BUDDY

Reg. No.: 3,700,403

Registered: October 20, 2009

PETITIONER'S MOTION TO STRIKE

Pursuant to TBMP § 517, Petitioner MWR Holdings, LLC ("Petitioner"), by its undersigned counsel, hereby moves the Trademark Trial and Appeal Board (the "Board") to strike certain portions of Registrant Theodore A. Stoner's ("Stoner") Reply in Support of its Counter-Motion for Summary Judgment (D.E. # 21) (hereinafter, the "Stoner Reply"). Specifically, in the Stoner Reply, Stoner introduced new evidence for the first time, without providing Petitioner the opportunity to examine and reply to this evidence. Stoner's actions violate the concepts of and the Board should disregard this new evidence when considering Stoner's cross-motion for summary judgment.

BACKGROUND

On September 16, 2015, Stoner filed an opposition brief to a pending motion for summary judgment, and in the same document raised his own cross-motion for summary judgment. Along with Stoner's cross-motion for summary judgment, Stoner included the purported evidence upon which he was relying. On October 21, 2015, Petitioner filed its

opposition to Stoner's cross-motion for summary judgment, enclosing its own evidence and arguments.

On November 10, 2015, Stoner filed his reply in support of his cross-motion for summary judgment. Enclosed to the Stoner Reply was the Affidavit of Theodore A. Stoner, dated November 10, 2015. This affidavit had never been disclosed to Petitioner, and alleged facts that had not appeared in any documents produced by Stoner up to that point, other than unsupported attorney argument by counsel for Stoner. The Affidavit referenced no underlying factual material or documents, and simply consisted of a series of self-serving statements made by Stoner. The following "facts" from the Affidavit were disclosed in no other evidence:

- (from Stoner Affidavit ¶ 1) "The current mark BONGO BI-LINGO BUDDY is used in connection with "Entertainment in the nature of live theatrical performances by mixed media of live characters, puppetry and animation for children; Organizing cultural events for children; Education services, namely, providing professional training in the field of bilingual learning" in International Class 41...."
- (from Stoner Affidavit ¶ 2) "I selected and adopted the BONGO BI-LINGO BUDDY mark in connection with the Stoner Services at least as early as June 8, 2004 and began using the BONGO BI-LINGO BUDDY mark in connection with the Stoner Services in interstate commerce at least as early as June 8, 2004."
- (from Stoner Affidavit ¶ 3) "I began using the mark in good faith that there was no party that had prior rights to the mark."
- (from Stoner Affidavit ¶ 5) "On September 1, 2009 I filed a Statement of Use with the knowledge that I had been using the mark since at least as early as June 8, 2004."

- (from Stoner Affidavit ¶ 6) “Furthermore, I have rendered the Stoner Services in connection with the BONGO BI-LINGO BUDDY Mark for the last 11 years at various tradeshows, various children’s institutions (most recently summer of 2015), and festivals throughout several different states and regions of the United States and abroad.”

ARGUMENT

A summary judgment movant must provide the nonmoving party with notice and a reasonable opportunity to respond. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 326 (1986). There is cause for concern where a movant presents new arguments or evidence for the first time in a summary judgment reply brief, particularly if the District Court intends to rely upon that new information in granting summary judgment to the movant. *Beaird v. Seagate Tech., Inc.*, 145 F.3d 1159, 1164 (10th Cir. 1998) (noting that “when a moving party advances in a reply new reasons and evidence in support of its motion for summary judgment, the nonmoving party should be granted an opportunity to respond.”). In this case, Stoner has submitted a new Affidavit for the first time in the Stoner Reply, giving Petitioner no opportunity to rebut the (yet again) unsupported statements made in that Affidavit. Fundamental fairness requires that the Board either disregard Stoner’s Affidavit, or provide Petitioner with an opportunity to respond to the new material. *See Provenz v. Miller*, 102 F.3d 1478, 1483 (9th Cir. 1996) (calling a result “unfair” in which a moving party was permitted to submit new evidence in their summary judgment reply without affording the non-movant an opportunity to respond).

In addition, under Fed. R. Civ. P. 6(c)(2), “[a]ny affidavit supporting a motion must be served with the motion.” The inclusion of additional evidentiary matter with a summary judgment reply should only be allowed in the exceptional case. *Plenger, et al. v. Alza Corp.*, 11 Cal. App. 4th 349 (Cal. App. 1992). In this case, Stoner has provided no explanation for his

delay in providing this Affidavit except as a substitute for its previous evidence in case the Board finds he did not submit sufficient evidence with his moving papers. (See Stoner Reply at p. 7: “Moreover even assuming, *en arguendo*, that Registrant did not previously submit sufficient evidence to prove Registrant’s continuous use of Registrant’s Mark, Registrant has now included an Affidavit in support of same which demonstrates that Registrant has continuously been using the mark in interstate commerce since first beginning to use the mark.”). Stoner had an obligation to make its case and include any supporting Affidavits in its moving papers. Stoner has failed to do that and the Affidavit and any references to the Affidavit in the Stoner Reply should be disregarded by the Board.

CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board disregard the Affidavit of Theodore A. Stoner submitted as Exhibit 1 to Stoner’s Reply in Support of his Counter-Motion for Summary Judgment, and any reference to that Affidavit in the Reply. Alternatively, Petitioner requests leave from the Board to address the substance of the Affidavit.

Dated: November 17, 2015

GREENBERG TRAURIG, LLP

By:  _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITIONER'S MOTION TO STRIKE has been served on Theodore A. Stoner by mailing said copy on November 17, 2015, via First Class Mail, postage prepaid to:

Matthew H. Swyers
The Trademark Company PLLC
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Michele Amelio