

TTAB



03-28-2002

U.S. Patent & TMO/c/TM Mail Ropt Dt. #58

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

THE WILLIAM CARTER COMPANY)

Opposer,)

v.)

H.W. CARTER & SONS, INC.)

Applicant.)

Opposition No. 114,616

Mark: CARTER'S WATCH THE WEAR

Serial No. 75/454,768

Assistant Commissioner of Trademarks
ATTN: BOX TTAB NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that the documents identified on these papers as the MOTION TO STRIKE EVIDENTIARY MATTER FROM APPLICANT'S TRIAL BRIEF in Opposition No. 114,616 is being deposited with the United States Postal Service "Express Mail to Addressee" service, label No. EL89584476US, under 37 C.F.R. 1.10 on the date indicated and is addressed to the Assistant Commissioner of Trademarks, BOX TTAB NO FEE, on the 28th day of March, 2002.

Name: Paul D. Collier

Signature

Paul D Collier

SC

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

THE WILLIAM CARTER COMPANY)	
)	
)	Opposition No. 114,616
Opposer,)	
)	
)	Mark: CARTER'S WATCH THE
)	WEAR
)	
H.W. CARTER & SONS, INC.)	
)	Serial No. 75/454,768
)	
Applicant.)	

MOTION TO STRIKE EVIDENTIARY MATTER FROM APPLICANT'S TRIAL BRIEF

Pursuant to TBMP §§ 540, 801.05, Opposer, The William Carter Company, by its counsel, requests that the Trademark Trial & Appeal Board strike evidentiary material that Applicant, H.W. Carter & Sons, submitted in its trial brief for Opposition No. 114,616 because this evidence was not properly made of record during the testimony period. TBMP § 540 ("Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party."). "If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise." *Id.* Opposer respectfully requests that the Board grant this motion, and strike from Applicant's trial brief for Opposition No. 114,616 that evidence that HWC did not properly make of the record.

In its Manual of Procedure, the Board outlines specific procedures for entering evidence into the record so that the parties may rely on this evidence in drafting their testimony briefs. TBMP §§ 700-718. In accordance with these rules, Opposer submitted notices of reliance, took and submitted trial testimony transcripts, and obtained Applicant's stipulation to the entry of certain evidence. Applicant, on the other hand, submitted no evidence at all. By

failing to submit its evidence during the testimony period, Applicant cannot now rely on – and the Board cannot consider – that “evidence” that Applicant submits with its trial brief for the first time. 37 C.F.R. 2.123(l) (“Evidence not obtained and filed in compliance with these sections will not be considered.”); TBMP § 702 (“[N]o paper, document, exhibit, etc. will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.”).¹

Specifically, the Board must disregard the following evidence:

- U.S. Trademark Registration No. 272,354 (“CARTER’S WATCH THE WEAR” graphical mark for “overalls, pants, coats, jackets, and aprons;” HWC Ex. A; HWC Brief at 17-18);²
- U.S. Trademark Registration No. 2,315,028 (“CARTER’S WATCH THE WEAR” mark for “mens’ and ladies’ pajamas, nightgowns, nighshirts, bathrobes, sleepwear, intimate apparel namely, bed jackets, cover-ups, loungewear and underwear;” HWC Ex. A; HWC Brief at 17-18);
- Sample advertising of applicant and selected exhibits from the deposition of Norman Moskowitz (HWC Ex. C; HWC Brief at 3);³
- U.S. Trademark Registrations for “DEANA CARTER” and “KERRY CARTER” (HWC Ex. D; HWC Brief at 4);⁴
- Definition of “booties” from Webster’s II New Riverside University Dictionary (HWC Brief at 1, 13);
- Statistical analysis of trademark applications that list socks and/or footwear (HWC Brief at 22); and
- U.S. Trademark Registrations for “ABSORBA,” “HEALTH-TEX” and “GERBER” (HWC Brief at 22).⁵

¹ Opposer has raised other evidentiary objections with respect to Applicant’s trial brief in its reply briefs.

² The methods for entering into evidence a party’s own registration, which Applicant did not follow for any of its four registrations, are disclosed in TBMP § 703.02(a).

³ Opposer submitted a Notice of Reliance during its testimony period that contained portions of Mr. Moskowitz’ deposition testimony and two of the deposition exhibits. Opposer’s Notice of Reliance Pursuant to 37 C.F.R. §§ 2.120, 2.122. Opposer’s Notice of Reliance, however, did not include the deposition exhibits that Applicant attached to its trial brief as Exhibit C. Applicant had the opportunity to counter-designate portions of Mr. Moskowitz’ deposition testimony and deposition exhibits with its own Notice of Reliance during its testimony period, but it did not do so. 37 C.F.R. § 2.120(j)(4).

⁴ The methods for entering into evidence a third party’s registrations, which HWC did not follow for all but two of the third party registrations on which it relies, are disclosed in TBMP § 703.02(b).

To allow Applicant to rely on this evidence would not only run contrary to the Board's evidentiary rules, but would unduly prejudice Opposer by changing the evidence of record after it has submitted its trial brief. *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1012 n.18 (TTAB 1984) (refusing to consider evidence that was first introduced with parties' opening brief because it was not "properly made of record during the testimony period").

⁵ HWC cites to its motion for summary judgment as support for this evidence, but HWC's motion for summary judgment and its accompanying exhibits are not of record.

Dated: March 28, 2002

Respectfully submitted,



Neil S. Hirshman (Reg. No. 36,829)

Mary E. Zaug

Paul D. Collier

KIRKLAND & ELLIS

200 East Randolph Drive

Chicago, Illinois 60601

(312) 861-2000


Attorneys for Opposer

The William Carter Company

CERTIFICATE OF SERVICE

The undersigned certifies that the **MOTION TO STRIKE EVIDENTIARY MATTER FROM APPLICANT'S TRIAL BRIEF** in Opposition No. 114,616 was served upon the Attorney for Applicant, by depositing true and correct copies thereof with The United States Postal Service, Express Mail service, label No. EL 8958447-5245 on the 28th day of March, 2002, to the Applicant's attorney at:

Gail E. Nickols, Esq.
GRAHAM CAMPAIGN P.C.
36 W. 44th Street
New York, NY 10036



Neil S. Hirshman
Mary E. Zaug
Paul D. Collier
KIRKLAND & ELLIS
200 E. Randolph Drive, Suite 5300
Chicago, Illinois 60601
(312) 861-2000

Attorney for Opposer,
THE WILLIAM CARTER COMPANY