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U.S. Patent & TMOfo/TM Mail Ropt Dt. #22

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

TruServe Corporation	}	In Re Opposition No.: 124,078
	}	
Opposer,	}	
	}	
v.	}	
	}	
Advanced Impact Marketing Service, LLC	}	
	}	<u>APPLICANT'S BRIEF IN</u>
Applicant	}	<u>OPPOSITION TO OPPOSER'S</u>
	}	<u>MOTION AND MEMORANDUM</u>
	}	<u>OF LAW TO STRIKE EXHIBITS TO</u>
	}	<u>APPLICANT'S OPPOSITION BRIEF</u>

Date: June 27, 2003

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**APPLICANT'S BRIEF IN OPPOSITION TO
OPPOSER'S MOTION AND MEMORANDUM OF LAW
TO STRIKE EXHIBITS TO APPLICANT'S OPPOSITION BRIEF
Opposition No.: 124,078**

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Table of Authorities

Cases

<i>Eikonix Corp. v CGR Medical Corp</i> , 209 U.S.P.Q. 607 (T.T.A.B. 1981). 6
<i>The Maytag Co. v Luskin's Inc.</i> , 229 U.S.P.Q., 228 U.S.P.Q 747 (T.T.A.B. 1986). 7
<i>McKesson & Robbins, Inc. v Mannitone Corp.</i> , 77 U.S.P.Q. 537 (Comr., 1948). 6

Books and Treatises

ARTHUR BEST, EVIDENCE, EXAMPLES and EXPLANATIONS 90 (4 th ed. 2001) 6
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Statement of the Issues

Should the Trademark Trial and Appeal Board reject Opposer's Motion and Memorandum of Law to Strike Exhibits to Applicant's Opposition Brief?

Yes, because the Exhibits are Admissions against Interest obtained by Applicant from Opposer during discovery and the Exhibits directly contradict statements made in Opposer's Brief.

Procedural History

The service mark GREEN THUMB CLUB was filed on January 5, 2000 with the United States Patent and Trademark Office (USPTO) and given the serial number 75/886506. The mark was published on March 27, 2001 and a Notice of Opposition was filed on August 24, 2001. Applicant sent Opposer Applicant's first Request for Production of Documents (APPLICANT'S REQUEST) on October 15, 2001. Opposer requested that Applicant sign a Stipulation and Order for Protecting Confidentiality of Information Revealed during Board proceedings (STIPULATION). Applicant signed the STIPULATION and it was filed on January 11, 2002. Opposer filed a Motion to Reschedule the Discovery and Testimony Periods on April 5, 2002. The Board set the Discovery period to close July 13, 2002 and, unlike what was stated in Opposer's Motion

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and Memorandum of Law to Strike Exhibits to Applicant's Brief (MOTION TO STRIKE), the Board set the Testimony Period for plaintiff (Opposer) to close October 12, 2002. Opposer filed the Declaration of Susan Raddle on October 15, 2002. Opposer's Brief was filed on March 26, 2003. Applicant's Brief was filed on May 16, 2003. Opposer filed a Reply Brief along with a MOTION TO STRIKE on June 10, 2003.

Argument

The documents that are the subject of Opposer's MOTION TO STRIKE should be considered by the Board because these documents are admissions against interest and because they contradict statements made in Opposer's Brief. These documents were sent to applicant by Opposer in response to APPLICANT'S REQUEST, and are admissions against interest. In addition, the documents contradict statements made by Opposer in Opposer's Brief. Thus, Applicant would be unfairly prejudiced if these documents are not considered by the Board.

**I. OPPOSER'S DOCUMENTS SHOULD BE CONSIDERED BY THE BOARD
BECAUSE THESE DOCUMENTS ARE ADMISSIONS AGAINST INTEREST.**

An admission is anything a party has ever communicated (in speech, writing , or in any other way) sought to be introduced against that party at trial". ARTHUR BEST,

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EVIDENCE, EXAMPLES and EXPLANATIONS 90 (4th ed. 2001). An admission is a statement offered against a party and can be made by a person authorized by the party to make a statement concerning the subject. Fed. R. Evid 801(d)(2). Documents TS 000230, TS 002543, TS 002554, TS 002554, TS 002485, TS 002493, and TS 002752 were either signed or authorized by a representative of Opposer and are admissions against interest.

Evidence may be introduced at times other than the appropriate trial period as admissions against interest. *Eikonix Corp. v CGR Medical Corp.*, 209 U.S.P.Q. 607 (T.T.A.B. 1981); *McKesson & Robbins, Inc. v Mannitone Corp.*, 77 U.S.P.Q. 537 (Comr., 1948).

Documents TS 000230, TS 002752, and TS 002753 concern GREENTHUMB registered marks 0592913 and 0592914. These documents were received by Applicant from Opposer in response to Applicant's Request for Production of Documents (APPLICANT'S REQUEST). Documents TS 000230 and TS 002752 indicate that marks 0592913 and 0592914 are owned by Milburn Peat Company, Inc. and that Milburn assigned the rights to Opposer to use the mark GREEN THUMB on fertilizer. Thus, Milburn still owns the rights to the GREEN THUMB marks for soil products and other soil amenities. This is consistent to what is found in the Trademark Electronic Search System (TESS), which indicates that the GREEN THUMB marks 0592913 and 0592914 are owned by Milburn Peat Company.

Documents TS 002485 and TS 002572, supplied by Opposer in response to APPLICANT'S REQUEST, suggest that Opposer was aware that GREEN THUMB was

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a weak mark. In addition, Document 002485 indicates that Opposer was aware that the GREEN THUMB mark was an identifier of certain products but that the GREEN THUMB mark does not extend to services. In support of this, documents TS 002543, 002554, and TS 002493 indicate that Opposer's registered trademarks identified lawn and garden items. Thus, these documents indicate that Opposer's GREEN THUMB marks do not extend to services.

The present case can be distinguished from *The Maytag Co. v Luskin's Inc.* 228 U.S.P.Q 747 (T.T.A.B. 1986) in that the evidence attached to applicant's brief in *Maytag* were registrations supplied by applicant and did not consist of statements against interest supplied by Opposer during Discovery. By way of contrast, in the present case the documents attached to Applicant's brief were documents supplied by Opposer in response to APPLICANT'S REQUEST.

II OPPOSER'S DOCUMENTS SHOULD BE CONSIDERED BY THE BOARD BECAUSE THEY ARE DOCUMENTS SUPPLIED TO APPLICANT BY OPPOSER IN RESPONSE TO APPLICANT'S REQUEST, AND CONTRADICT STATEMENTS MADE IN OPPOSER'S BRIEF.

Opposer has made statements in Opposer's Brief that are factually misleading based on documents that Opposer supplied to Applicant in response to APPLICANT'S REQUEST. Documents TS 000230 and TS 002752 indicate that Milburn Peat Co. owns registered marks 0592913 and 0592914. The goods identified by these marks are soil products and other soil amenities. This evidence directly contradicts the

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statement -- "There is no evidence about any similar marks on similar goods" -- contained in Opposer's brief. (Opposer's Brief, p14 ln. 9).

Documents TS 002572 and TS 002485 contradict the statement -- "the GREEN THUMB mark has come to identify Opposer as the source of lawn and garden goods and services under that name. -- *Raddle Dec.* 10, 11." (Opposer's Brief p 2, ln 20), made in Opposer's Brief. Opposer endeavors to claim that its GREEN THUMB mark extends to services when Opposer's documents clearly indicate that its GREEN THUMB marks do not extend to services. This is further supported by documents TS 002543, 002554, and TS 002493, which state that Opposer has registered trademarks on lawn and garden items.

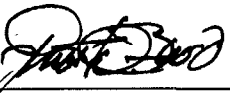
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Conclusion

For the reasons set forth above, Applicant respectfully requests that the Board reject Opposer's Motion to Strike Applicant's Exhibits to its brief.

Respectfully submitted,

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DATED: June 27, 2003

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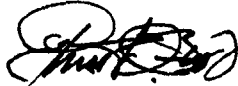
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CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing Applicant's Brief In Opposition To Opposer's Motion And Memorandum Of Law To Strike Exhibits To Applicant's Opposition Brief is being served on Opposer on the undersigned date, by mailing the same by first class postage addressed to Opposer's attorney of record as follows:

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Date of Signature: June 27, 2003