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

UNIVERSITY OF SOUTHERN CALIFORNIA, Opposer, v. UNIVERSITY OF SOUTH CAROLINA, Applicant.	Opposition No. 125,615 Serial No. 75/358,031 Mark: **SC (Stylized)** Filed: September 16, 1997 Published: May 18, 1999
UNIVERSITY OF SOUTH CAROLINA, Petitioner, v. UNIVERSITY OF SOUTHERN CALIFORNIA, Respondent.	Opposition No. 125,615 Reg. No. 1,844,953 Mark: **SC (Word Mark)** Registered: July 12, 1994

OPPOSER AND CROSS-RESPONDENT'S OPPOSITION TO MOTION TO STRIKE REPLY IN SUPPORT OF MOTION TO DISMISS AND OPPOSITION TO "ALTERNATIVE" SUR-REPLY

Opposer and Cross-Respondent University of Southern California ("California") hereby opposes the request of Applicant and Cross-Petitioner University of South Carolina ("Carolina") that the Board strike California's reply papers on grounds that the arguments raised therein fail to raise or introduce any new issues. California also opposes Carolina's alternative request to file a sur-reply (in which Carolina seeks to respond to the very pleading that Carolina otherwise seeks to strike based on an alleged lack of new argument).

I. OPPOSITION TO MOTION TO STRIKE OPPOSER AND CROSS-RESPONDENT'S REPLY IN SUPPORT OF MOTION TO DISMISS

California Clarified the Record and Answered Arguments in Its Short Reply Brief: The mere fact that Carolina seeks to file a sur-reply is itself striking proof that California's reply brief clarified the record and answered Carolina's arguments. Had California done nothing more than reiterate its previous points as Carolina alleges, Carolina would not have felt the need to seek a filing that is specifically excluded by the applicable regulations.

California's choice to file a reply was appropriate. Unlike sur-reply briefs, reply briefs are *not* prohibited. A number of situations justify the filing of a reply, including (i) responding to new issues, (ii) clarifying complex issues, or (iii) answering certain arguments against the motion to assist the Board in arriving at a just conclusion. TMBP § 502.03.

In its reply brief, California raised at least the following new points that were not addressed in the moving papers:

- Although Carolina cites two cases that mention the word "insignia," neither of those cases considered whether initials could constitute insignia under any circumstance, much less whether initials could constitute insignia under the restrictive meaning of 15 U.S.C. § 1052(b).

- Although Carolina alleges that a one paragraph 1920 case supports its position, that case was decided on substantially different facts, and this Board may take official notice of the fact that subsequent practice shows the limitations of that 1920 case.[1]

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[1] Carolina also objects to the filing of California's Supplemental Request for Official Notice on the grounds that California has sought to introduce new evidence. In fact, a major portion of the Supplemental Request for Official Notice was merely a submission to this Board of

[Footnote continued on next page]

- Although Carolina argues that it objects only to the word mark "SC" and not to other third-party uses of "SC," the acceptance of other third-party uses conclusively proves that "SC" cannot be uniquely associated with the state of South Carolina as would be required under 15 U.S.C. § 1052(a).

- Although Carolina argues that California may have misled the Trademark Examiner by an implication that all of its goods were first used by 1978, such a misconception would not be a "but for" cause of registration and therefore could not be the basis for a fraud claim.

- Although Carolina argues that California may have inappropriately failed to specify on the affidavit the specific goods on which the mark was first used in 1978, such a "minor technical defect in the affidavit" would not justify invalidating a technically good trademark, particularly where the PTO accepted the affidavit.

These arguments fit into all three of the classifications identified by TMBP § 502.03: they respond to new issues; they clarify complex issues; and they answer certain arguments against the motion so as to assist the Board in arriving at a just conclusion on the motion. TMBP § 502.03.

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additional information about various "SC" registrations already identified in the original Request for Official Notice. California believes that its original submission was adequate (and provided more than adequate notice to Carolina of the matters being relied upon), and California provided the additional information merely to address the format concerns that Carolina had expressed. The remainder of the Supplemental Request for Official Notice is evidence directly responsive to Carolina's citation of the 1920 case, and is therefore plainly appropriate for a reply. TMBP § 502.03

II. OPPOSITION TO APPLICANT AND PETITIONER'S "ALTERNATIVE" SUR-REPLY

In the event Carolina's motion to strike California's reply is not granted, Carolina requests that the Board entertain a "sur-reply." California opposes Carolina's sur-reply because the Trademark Rules of Practice clearly prohibit the filing of a sur-reply in opposition to a motion:

> [A] reply brief, if filed, shall be filed within 15 days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion will be considered by the Board.

37 C.F.R. § 2.127(a), *emphasis added.*

In accordance with the clear language of the Trademark Rules, California respectfully requests this Board ignore Carolina's sur-reply as a matter of law.

III. CONCLUSION

For the reasons discussed above, Carolina's motion to strike should be denied, and Carolina's "alternative" sur-reply should be ignored as a matter of law.

Dated: January 15, 2003

Respectfully submitted,

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Opposition No. 125,615

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER AND CROSS-RESPONDENT'S OPPOSITION TO MOTION TO STRIKE REPLY IN SUPPORT OF MOTION TO DISMISS AND OPPOSITION TO "ALTERNATIVE" SUR-REPLY** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 15th day of January, 2003.

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CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10

I hereby certify that on January 15, 2003, the attached **OPPOSER AND CROSS-RESPONDENT'S OPPOSITION TO MOTION TO STRIKE REPLY IN SUPPORT OF MOTION TO DISMISS AND OPPOSITION TO "ALTERNATIVE" SUR-REPLY** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

BOX TTAB – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
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Mandy Robertson-Bora

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