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

In the matter of Trademark Application Serial No. 78/095,980  
For the Service Mark **BOUNCE GUARD**  
Published in the *Official Gazette* on July 16, 2002



01-05-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

MJCM, L.L.C.

Opposer,

v.

F.N.B. Corporation

Applicant.

Opposition No.: 91153220

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Attn.: Trademark Trial and Appeal Board

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Signature of person mailing correspondence

Steve Lauff

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MOTION TO STRIKE

AND ALTERNATIVE MOTION FOR CONSIDERATION OF REPLY BRIEF

MJCM, L.L.C. ("Opposer") respectfully submits this *Motion to Strike and Alternative Motion for Consideration of Reply Brief* ("Motion"), moving that the Trademark Trial and Appeal Board ("Board"), pursuant to TBMP § 517, strike as not timely filed the brief of F.N.B. Corporation ("Applicant") in response to Opposer's *Motion to Compel* and *Motion to Determine Sufficiency of Objections*, which brief is entitled *Applicant F.N.B. Corporation's Brief in Response to Opposer's Motion to Compel and Motion to Determine Sufficiency of Objections* ("Response"). In the alternative, should the Board determine not to strike the Response, Opposer respectfully requests that the Board exercise its discretion and also consider Opposer's reply brief in support of Opposer's *Motion to Compel* and *Motion to Determine Sufficiency of*

*Objections*, filed with the Board concurrently with this Motion and entitled *Reply Brief in Support of Motion to Compel and Motion to Determine Sufficiency of Objections*.

### **BACKGROUND**

On November 3, 2003, Opposer filed its *Motion to Compel* and *Motion to Determine Sufficiency of Objections* in connection with Applicant's objections to almost all of Opposer's discovery in this proceeding and failure to deliver to Opposer copies of documents as agreed. On November 24, 2003, instead of responding to Opposer's motions Applicant filed a motion requesting an extension of time in which respond, entitled *Applicant FNB Corporation's Motion for Enlargement of Time to Oppose Opposer's Motions to Compel and to Determine Sufficiency of Objections* ("Motion to Extend"). On December 15, 2003, Opposer filed its *Opposer's Response to Applicant's Motion to Extend* in opposition to Applicant's Motion to Extend. Prior to the Board's decision on Applicant's Motion to Extend, Applicant filed the Response, allegedly by Express Mail on December 18, 2003. Opposer timely is filing this Motion on this fifth day of January, 2004. See 37 C.F.R. §§ 2.127(a), 2.119(c), 2.196; TBMP § 502.02(b).

### **ARGUMENT**

Pursuant to 37 C.F.R. §§ 2.127(a), 2.119(c), and 2.196 and TBMP § 502.02(b), Applicant was required to file its brief in response to Opposer's *Motion to Compel* and *Motion to Determine Sufficiency of Objections* on or prior to November 24, 2003, unless its Motion to Extend is granted by the Board. As set forth in detail by Opposer in its *Opposer's Response to Applicant's Motion to Extend*, Applicant fails in its Motion to Extend to meet its burden of establishing that the Motion to Extend should be granted.

In addition, Opposer would be irredeemably prejudiced by any attempt by Applicant, in a reply brief in support of the Motion to Extend, to belatedly meet its burden to set forth with particularity the required specific facts alleged to constitute good cause for the requested extension and to otherwise show that it is entitled to the extension. *E.g., Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1479-80 (TTAB 2000) (establish good cause); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (establish good cause and demonstrate that the requested extension is not required due to Applicant's own lack of

diligence or unreasonable delay). Under 37 C.F.R. § 2.127(a), it is established that the brief in response to a motion is the only opportunity for the responder to traverse matters presented to the Board by the movant, because “[n]o further papers . . . in opposition to a motion will be considered by the Board.” Applicant should not be allowed to file the Motion to Extend containing mere conclusory allegations lacking in factual detail that might establish good cause for granting the Motion to Extend, and then later attempt to meet its burden to set forth with the particularity the facts said to constitute good cause for the requested extension in a reply brief immune from challenge or response by Opposer.

Because of the irredeemable prejudice that Opposer would incur by the Board’s consideration of any new matter presented by Applicant in a reply brief in support of the Motion to Extend, Opposer respectfully requests that the Board refuse to consider any such reply brief if filed. Opposer further respectfully contends that it has established in its *Opposer’s Response to Applicant’s Motion to Extend* that Applicant’s Motion to Extend should be denied. If the Board denies Applicant’s Motion to Extend, then Applicant’s Response is untimely and should be stricken or given no consideration by the Board. *See* TBMP § 517.

In the alternative and without waiving or conceding any basis Opposer has or may have for opposition to Applicant’s Motion to Extend or Applicant’s Response, if the Board determines not to strike Applicant’s Response and to consider it on its merits, Opposer respectfully requests that the Board exercise its discretion and consider Opposer’s reply brief in support of Opposer’s *Motion to Compel* and *Motion to Determine Sufficiency of Objections*, filed with the Board concurrently with this Motion and entitled *Reply Brief in Support of Motion to Compel and Motion to Determine Sufficiency of Objections*. As set forth in the reply brief for which Opposer requests consideration, Applicant’s Response has introduced new issues, and Opposer respectfully contends that the Board’s decisions on Opposer’s *Motion to Compel* and *Motion to Determine Sufficiency of Objections* will be facilitated by the Board’s consideration of Opposer’s position on those new issues, along with the additional discussions presented by Opposer in its reply brief.

(Continued next page.)

**CONCLUSION**

For the reasons set forth above, Opposer respectfully moves that the Board strike Applicant's Response as not timely filed and refuse to consider it. In the alternative, Opposer respectfully requests that the Board exercise its discretion and consider Opposer's reply brief in support of Opposer's *Motion to Compel* and *Motion to Determine Sufficiency of Objections*.

Respectfully submitted,



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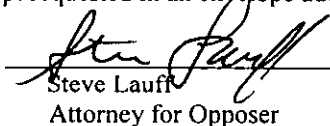
DATED: January 5, 2004

**Certificate of Service**

I hereby certify that a copy of this Motion to Strike and Alternative Motion for Consideration of Reply Brief was served on the following persons:

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Steve Lauff  
Attorney for Opposer

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

In the matter of Trademark Application Serial No. 78/095,980  
For the Service Mark **BOUNCE GUARD**  
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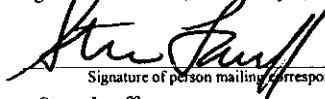
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REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL  
AND MOTION TO DETERMINE SUFFICIENCY OF OBJECTIONS

MJCM, L.L.C. ("Opposer") respectfully submits this *Reply Brief in Support of Motion to Compel and Motion to Determine Sufficiency of Objections* ("Brief") concurrently with Opposer's *Motion to Strike and Alternative Motion for Consideration of Reply Brief* ("Motion to Strike"). In the Motion to Strike, Opposer moved that the Trademark Trial and Appeal Board ("Board") strike as not timely filed the brief of F.N.B. Corporation ("Applicant") in response to Opposer's *Motion to Compel and Motion to Determine Sufficiency of Objections*, which is entitled *Applicant F.N.B. Corporation's Brief in Response to Opposer's Motion to Compel and Motion to Determine Sufficiency of Objections* ("Response"). In the alternative, Opposer is waiving or conceding any basis Opposer has or may have for opposition to the Board's denial of Applicant's motion to extend the time for filing its response to Opposer's *Motion to Strike*.

*Motion to Determine Sufficiency of Objections*, Opposer requests in the Motion to Strike that the Board exercise its discretion and consider this Brief in order that its decisions on Opposer's *Motion to Compel* and *Motion to Determine Sufficiency of Objections* will be facilitated by having before it Opposer's position on the new issues introduced by Applicant in the Response.

**BACKGROUND & SUMMARY**

On November 3, 2003, Opposer filed its *Motion to Compel* and *Motion to Determine Sufficiency of Objections*, along with briefs and its *Statement of Opposer's Counsel* ("Statement") in support thereof, all in connection with Applicant's objections to almost all of Opposer's discovery in this proceeding and failure to deliver to Opposer copies of documents as agreed. Allegedly by Express Mail on December 18, 2003, Applicant filed the Response prior to the Board's decision on Applicant's motion to extend the time for filing such a response.

As set forth by Opposer in its *Brief in Support of Motion to Compel*, Applicant has waived the opportunity to object to Opposer's discovery requests on their merits. Opposer asserts alternative grounds in support of that conclusion: (1) The terms of the original extensions of time granted to Applicant applied only to substantive responses and not to objections, and (2) even if the terms of the original extensions of time granted to Applicant can be construed to apply to Applicant's objections, Applicant clearly waived its right to object by seeking and accepting yet another extension of time with full knowledge that Opposer unmistakably considered extensions not to apply to Applicant's objections. *See Brief in Support of Motion to Compel* pp. 3-6 and pp. 6-7, respectively. In addition, all of the objections raised by Applicant are improper and unfounded, as set forth in detail with respect to *each* objection in the briefs supporting the *Motion to Compel* and *Motion to Determine Sufficiency of Objections*.

In the Response, Applicant only sets forth arguments with respect to certain limited issues raised by Opposer in the *Motion to Compel* and *Motion to Determine Sufficiency of Objections*. First, Applicant sets forth its position regarding the terms of the original extensions of time granted to Applicant and whether the extensions applied to objections. Opposer will not reply to the Response with respect to this issue, instead relying on the analysis in the *Brief in Support of Motion to Compel* and the Board's own conclusions about the persuasiveness of the

Response on this issue. The Response does not address seriously the merits of Opposer's contention that Applicant clearly waived its right to object by seeking and accepting yet another extension of time with full knowledge that Opposer unmistakably considered extensions not to apply to Applicant's objections, but Opposer here clarifies and reinforces the analysis of this issue in the *Brief in Support of Motion to Compel*.

Second, Applicant appears to be attempting to support the merits of its objections solely by asserting a spurious analysis of Opposer's Interrogatory No. 2. In this Brief, Opposer replies to the new matter presented by this spurious analysis and reasserts the analysis of the impropriety of all of Applicant's objections as set forth in the *Brief in Support of Motion to Compel*.

The Response also raises other new matter. First, Applicant contends that "Opposer's representation that the motion was discussed between counsel is false and should not have been made," and that the "motion should thus be denied." Response, at 6-7 (emphasis omitted). Second, Applicant contends that "[b]oth of Opposer's motions fail to contain the required certification of Rule 37(a)(2)(B)." Response, at 7. In this Brief, Opposer sets forth the basis for its statements and representations, corrects additional mischaracterizations presented in the Response, and traverses Applicant's reliance on Rule 37(a)(2)(B) of the Federal Rules of Civil Procedure.

Opposer also replies to correct certain additional mischaracterizations in the Response.

## **ARGUMENT**

### ***Applicant Waived Its Objections by Seeking and Accepting a Further Extension of Time***

The Response does not address seriously the merits of Opposer's contention that Applicant clearly waived its right to object by seeking and accepting yet another extension of time with full knowledge that Opposer unmistakably considered extensions not to apply to Applicant's objections. However, in what may be an attempt to address this issue without clearly identifying the point of its argument, Applicant tries to paint Opposer's October 7 letter as "unilateral." See Response, at 5. In the October 7 letter, Opposer clearly set forth its position that the extensions of time did not apply to objections to Opposer's discovery. See Exhibit A, at 2.

Even if Applicant could establish that the issues presented in the October 7 letter were

unilateral on the date of the letter, though, those issues would have ceased to be unilateral when Applicant asked for, accepted, and used a further extension of time granted by Opposer in an October 14 email solely on condition that the terms of the October 7 letter would govern the extension. *See* Exhibit A, at 2; Exhibit B. In particular, Opposer agreed to accept Applicant's "admissions and denials, answers to interrogatories, and copies of documents produced" up to a later date, but "that all other matters stand as stated in [the] October 7, 2003, letter." Exhibit B.

In light of Opposer's clearly stated position in its October 7 letter that any extensions resulted in waiver of Applicant's right to object to Opposer's discovery requests, Applicant has no basis, reasonable or otherwise, for thinking that the final extension of time to October 24 included an extension of time to make objections. If Applicant thought it had a meritorious basis for asserting its discovery objections prior to October 14, it could have tried to preserve that basis by observing the October 17 date set in Opposer's October 7 letter. Instead, Applicant chose to request and use a further extension with clear notice that Applicant did not consent to any further extension of time to make discovery objections. Such action by Applicant clearly constitutes waiver of its right to object to Opposer's discovery.

***All of the Objections Raised by Applicant Are Improper and Unfounded***

All of the discovery objections raised by Applicant are improper and unfounded, as set forth in detail with respect to each objection in the briefs supporting the *Motion to Compel* and *Motion to Determine Sufficiency of Objections*. Instead of responding to shortcomings of the objections as set forth by Opposer in its motions, Applicant instead presents only a spurious discussion of Opposer's Interrogatory No. 2 as a sidebar in Applicant's discussion of the waiver issue. Opposer stands by its analysis of the impropriety of all of Applicant's objections, and traverses Applicant's discussion of Interrogatory No. 2.

Application Serial No. 78/095,980 recites a plethora of widely diversified services for which the Applicant's mark is allegedly used. *See* Exhibit C. The specimen submitted in the application, however, appears to relate to just one of the recited services, banking services. *See* Exhibit D. It is certainly reasonable, therefore, to infer that the specimen submitted in the application is not a specimen for any of the other recited services, defined for purposes of the



interrogatories as the “Specified Services.” *See* Exhibit 1 to *Motion to Compel*, at 2. For the application to be valid, though, Applicant must actually be using the mark in commerce on or in connection with all of the specified services, *see* 37 C.F.R. § 2.34(a)(1)(i); TMEP § 901, and Opposer is entitled to inquire into such use of the mark by Applicant on services other than the banking services related to the submitted specimen.

Interrogatory No. 2 inquires about the Applicant’s use of its mark in connection with “each of the Specified Services for which the specimen submitted in the Application does not constitute a specimen of the Applicant’s use of the mark BOUNCE GUARD on or in connection with such Specified Service.” In particular, the interrogatory seeks information “with respect to the use of the mark BOUNCE GUARD on or in connection with such service for which Applicant relies to establish its date of first use of the mark in connection with such service as stated in the Application,” such as “a detailed description and explanation of all relevant facts and circumstances of such use, including the manner of such use by Applicant of the mark BOUNCE GUARD and complete quotation of any identification, description or explanation of such service associated with that use.” Opposer is extremely interested in learning the details of Applicant’s use of BOUNCE GUARD for mutual fund services, insurance consultation, and the numerous other alleged services. There is nothing improper, ambiguous, or vague about this interrogatory, and Applicant’s misquoting of it to inquire “as to each specimen which does not constitute a specimen of use” does not raise any genuine issue with respect to it. Response, at 4.

Moreover, Opposer notes again that Applicant made no specific objections to Opposer’s Interrogatories Nos. 1-5 or 10-17, Opposer’s First Request for Production Nos. 1-7 or 10, or Opposer’s Second Request for Production Nos. 1-3, has yet to explain how its general objections apply to those requests, but has yet to provide responsive discovery thereto. Opposer mooted any concern about confidentiality by delivering the Board’s standardized protective agreement to Applicant prior to its service of objections. *See* TBMP § 412.02; Exhibits 15-17 to Statement.

In addition, numerous of Opposer’s requests cannot possibly inquire into confidential material. For example, request 10 of the First Request for Production asks for “any and all ‘printed publications,’ as such term is used in TBMP § 704.08 (2d ed. June 2003), that are in

Applicants possession or control and in which Applicant has advertised or promoted any Specified Service in connection with the mark BOUNCE GUARD.” See Exhibit 2 to Statement; see also corresponding Interrogatory No. 16, in Exhibit 1 to Statement. Section 704.08 of the TBMP uses the term “printed publication” to refer to “publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding,” as does the corresponding section 37 C.F.R. § 2.122(e) of the Rules of Practice. And, although not usually necessary to have a specimen for each service, the examining attorney of the application was entitled to request additional specimens for the other recited services, and applicant would be required to deliver such specimens for inclusion in the public record. See TMEP § 904.01(a). To the extent not requested in the First Request for Production, Opposer sought such specimens in its Second Request for Production. Applicant has yet to provide any such documents.

Accordingly, Applicant has not met its burden of showing that its objections to Opposer’s discovery requests are proper. See, e.g., *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

***No Basis for Denying Motions for Alleged Failure to Discuss Motions with Applicant***

Applicant contends that “Opposer’s representation that the motion was discussed between counsel is false and should not have been made,” and that the “motion should thus be denied.” Response, at 6-7 (emphasis omitted). Applicant further contends that “[b]oth of Opposer’s motions fail to contain the required certification of Rule 37(a)(2)(B).” Response, at 7. Regardless of the mischaracterizations presented in the Response, Opposer has a valid basis for its statements and representations. Moreover, Applicant’s reliance on Rule 37(a)(2)(B) of the Federal Rules of Civil Procedure is misplaced.

The Federal Rules of Civil Procedure relating to discovery apply in this proceedings, except as otherwise provided in Trademark Rule 2.120. See 37 C.F.R. § 2.120(a); 1159 TMOG 14 (“Thus, where the Board has its own rule concerning a particular matter of practice or procedure, that rule governs . . .”). Rule 37(a) of the Federal Rules of Civil Procedure, therefore, is inapplicable because it is pre-empted by Trademark Rule 2.120(e) and (h). As set

forth in 37 C.F.R. § 2.120(e)(1) and (h)(1), “The motion [to compel or determine sufficiency of objections] must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference *or* correspondence, to resolve with the other party or the attorney therefor *the issues* presented in the motion and has been unable to reach agreement.” (Emphasis added). Thus, the entire discussion in Sections III and IV of the Response is based on Applicant’s erroneous conclusion as to the governing rules; not only was Opposer under no obligation to present the motion to compel to Applicant prior to filing it, Opposer had the option of presenting the *issues* presented in the motion by *correspondence* alone, instead of a discussion or conference with Applicant’s counsel.

In each of its motions and supporting briefs concerning Applicant’s discovery abuses, Opposer has incorporated by reference the attached “written *Statement of Opposer’s Counsel* that Opposer’s counsel has made a good faith effort, by conference and correspondence, to resolve with counsel for Applicant the issues presented in th[e] Motion and has been unable to reach agreement.” Applicant has made its confidentiality concerns a central issue of the dispute, and that issue was raised during a telephone conference between the parties’ respective counsel on October 24, 2003, as set forth in paragraph 14 of the Statement. In addition, Opposer’s counsel sent a letter on October 28, 2003, confirming that Opposer and its counsel would be bound to the Board’s standardized protective agreement and asking for compliance by Applicant to its discovery obligations. *See* Exhibit E. In particular, the October 28 letter stated that by serving a single denial along with untimely and unfounded objections to everything else, Applicant had “not come close to meeting its obligations under the Federal Rules of Civil Procedure and the rules of practice before the Board.” The October 28 letter continued by pointing out the illusory nature of Applicant’s commitment to produce documents at the office of Applicant’s counsel, and how such production was a breach of Applicant’s agreement to copy and deliver documents.

Applicant’s counsel responded that Opposer’s October 28 letter was “unacceptable,” that she considered Applicant’s discovery production to be appropriate, and that Opposer’s discovery ordeal in this case has been “standard and unremarkable.” Exhibit F. Moreover, Applicant appears to believe that further delay by moving “dates back by a new or amended institution

order” will be acceptable to Opposer. *Id.* Although Applicant’s counsel stated that she would “review the draft [of the protective agreement] timely and have no doubt that you will get your documents,” as of the date of filing this Brief Opposer has yet to receive Applicant’s concerns or comments concerning the Board’s standardized protective agreement executed and delivered by Opposer to Applicant on October 24, and has yet to receive any documents or any commitment by Applicant as to when to expect the documents.

Applicant has repeatedly delayed the time for producing discovery, raised a last minute assertion of confidentiality concerns without any explanation of what was confidential, and asserted that Applicant’s sabotage of Opposer’s timetable in this proceeding was a “standard and unremarkable discovery exchange,” even though it forced an unwanted delay in Opposer’s testimony period. Accordingly, Opposer does not believe that good faith requires any more than its October 24 discussion and accommodation concerning confidentiality and its October 28 letter complaining about Applicant’s objections to all of Opposer’s requests but for one admission, and failure to provide copies of documents as promised. Although Applicant claims that a discussion would have mooted Opposer’s motions, since Applicant was served with the motions it has had full opportunity to explain its objections and reach an agreement with Opposer as contemplated by Rule 2.120, but has not done so and has not even responded with its concerns about the Board’s standardized protective agreement. Moreover, at the time of filing this Brief, Applicant has still not set forth the specific bases for its objections even to the Board, despite the fact that Applicant bears the burden of setting them forth with particularity.

Moreover, there are clearly non-confidential responsive documents (*e.g.*, specimens) that have not been provided to Opposer. Accordingly, there is a material breach of any extension agreement, and because of that breach Applicant should not be allowed to rely on any extension agreement nor be given any consideration when it argues that it has been proceeding amicably, courteously, cooperatively, and in good-faith.

Thus, Opposer contends that it has complied with its obligations of good faith under Rule 2.120(e) and (h), given the history of this proceeding.

***Mischaracterizations in the Response***

The Response makes numerous mischaracterizations for which the Board should consider Opposer's reply. First, Applicant alleges that "Opposer filed selected Exhibits in an effort to cast a one-sided, yet very incomplete, background" and presents its Exhibit 1 in connection with that allegation. Response, at 2. In connection with Exhibit 1 to the Response, however, substantially corresponding exhibits are presented with the Statement filed with the *Motion to Compel* and *Motion to Determine Sufficiency of Objections*. See Exhibits 5, 9, 12, and 14 to the Statement, attached to this Brief for convenience as Exhibit G. In fact, Exhibit 1 to the Response provides the email of Applicant's counsel dated October 14, 2003, but by failing to present the response of Opposer's counsel, Applicant itself has presented a one-sided, incomplete context. Compare Exhibit 14 to the Statement.

Second, Applicant condemns Opposer for citing to its "own statements as 'evidence.'" In its *Motion to Compel* and *Motion to Determine Sufficiency of Objections*, Opposer did cite to particular paragraphs of its Statement, but each such paragraph of the Statement itself referred to one or more evidentiary exhibits of the Statement where required or appropriate to support Opposer's arguments. Thus, Opposer clearly did not omit "any other form of evidence."

Third, the Response raises the issue of settlement discussions, asserting that such discussions were "ongoing and detailed." Opposer has remained willing to settle this dispute, but has always been skeptical that mutually agreeable terms could be reached and has always been adamant that the proceeding should not be delayed by illusory settlement discussions. See Exhibit H; Exhibit A, at 2, and Exhibit B. Moreover, any settlement discussions are irrelevant to Applicant's obligations relating to discovery. Cf. *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1926-28 (TTAB 1999).

Fourth, the Response at page 6 states that Exhibit 9 to the Statement "confirms that in the event of lateness, the parties will seek a resetting of the institutional order." In fact, that exhibit merely states Applicant's unilateral agreement that it "will consent to a resetting of dates." Exhibit I. Opposer has never agreed to delay this proceeding. See Exhibit A, at 2; Exhibit B.

Fifth, in its attempt to appear cooperative with discovery in this matter, Applicant asserts that it "was out of sheer courtesy that Applicant agreed to give authentic documents so as to save

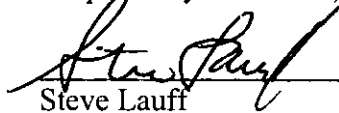
the trip of Opposer's counsel to take a deposition solely to authenticate documents." Response, at 7. To begin, the notice of taking Applicant's deposition included six subject matters, one of which was authentication of documents. *See* Exhibit K. In addition, Opposer was at all times willing, able, and prepared to conduct the noticed deposition, and agreed to cancel the deposition only after being urged to do so by Applicant's counsel and only on condition that Applicant copy, authenticate, and deliver documents to Opposer. *See* Exhibit E, at 2 ("at your urging"); Exhibit L (agreement to copy & stipulate); Exhibit M (cancel travel in reliance).

Sixth, although relegated to a footnote, Applicant states that "[t]here is no objection to producing documents as set forth in Applicant's response to request for document production. It was simply requested that a confidentiality agreement be in place in order to protect the transmission of confidential materials to the Opposer." Applicant's Statement, at 7 n.1. As explained above, though, Applicant has had the Board's standardized protective agreement, executed by Opposer's counsel, in hand prior to serving its objections to Opposer's discovery. Every extension of time received by Applicant was subject to the agreement to copy and deliver documents to Opposer, but to date Applicant has neither explained why it's alleged confidential information requires terms of protection that exceed those provided by the standardized protective agreement, nor provided any discovery to Opposer.

### **CONCLUSION**

For the reasons set forth above, Opposer respectfully requests that the Board grant to Opposer the relief requested in its *Motion to Compel* and *Motion to Determine Sufficiency of Objections* and such other relief as the Board determines appropriate.

Respectfully submitted,



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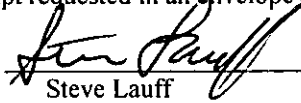
DATED: January 5, 2004

**Certificate of Service**

I hereby certify that a copy of the Reply Brief in Support of Motion to Compel and Motion to Determine Sufficiency of Objections, to which this Certificate is attached, was served on the following persons:

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by depositing such copy on January 5, 2004, with the United States Postal Service as certified first-class mail, return receipt requested in an envelope addressed as above and bearing sufficient postage.

  
\_\_\_\_\_  
Steve Lauff  
Attorney for Opposer





October 7, 2003

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Re: *MJCM, LLC v. F.N.B. Corporation, Opposition No. 91/153,220 before the  
Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office*

Dear Ms. Whitelaw:

In your October 2, 2003, email to me, you state "Since we are holding discovery at this moment for both sides pending settlement discussion, may I suggest we seek a short suspension, otherwise we will need to seek to reset discovery dates based upon our earlier discussions." I am responding to correct the inaccuracies presented by that statement.

With respect to discovery, MJCM timely filed requests for admissions, interrogatories, and two sets of requests for production, and timely noticed the discovery deposition of F.N.B. Corporation. F.N.B. Corporation did not serve any requests for admissions, interrogatories, requests for production, or other discovery within the discovery period.

As set forth in my letter to you dated August 27, 2003, you and I agreed that the discovery deposition of F.N.B. Corporation was canceled, that F.N.B. Corporation would deliver to me copies of the documents responsive to MJCM's requests for production, and that all documents produced in connection with discovery could be made be made of record in this matter. The time allowed for F.N.B. Corporation to deliver the copies of documents responsive to MJCM's requests for production was extended from September 5, 2003, to September 12, 2003. My August 27, 2003, letter also set forth our agreement on provisions that allow MJCM to serve on F.N.B. Corporation discovery requests after the discovery period, but except for those provisions I have not agreed to any extension of the time in which either party may serve discovery requests on the other party, and have not agreed to a general extension of the discovery period in this matter. The discovery period expired on September 8, 2003, without F.N.B. Corporation taking any discovery, and MJCM does not consent any belated discovery requested by F.N.B. Corporation.

Ms. Whitelaw  
October 7, 2003  
Page 2

On August 28, 2003, we agreed by email correspondence that you could extend the time for providing responses to MJCM's requests for admissions and interrogatories until September 12, 2003, subject to the other provisions of my August 27, 2003, letter.

In a September 11, 2003, telephone discussion, you indicated to me that you were experiencing some difficulty in meeting the September 12, 2003, date we had earlier agreed would apply to F.N.B. Corporation's delivery to me of its admissions and denials, answers to interrogatories, and production of documents. During the September 11 call, I indicated that I would accept discovery responses and document production delivered within a reasonable time after the agreed date, and that a rescheduling request of the trial dates would not be required based on the fact that you would deliver the discovery within a reasonable time. I did not agree during that discussion or at any other time to any stay of discovery responses or to any holding of discovery.

Over three weeks have elapsed since September 12, 2003, which certainly constitutes a reasonable period of time for F.N.B. to provide to me its admissions and denials, answers to interrogatories, and copies of documents responsive to MJCM's First Request for Admissions, First Set Of Interrogatories, and First Request for Production. In addition, production of documents by F.N.B. Corporation in response to MJCM's Second Request for Production is due by October 13, 2003, to the extent that such documents are not subject to earlier production in response to MJCM's First Request for Production.

I remain willing to be reasonably accommodating with respect to the time of F.N.B. Corporation's delivery of its admissions and denials, answers to interrogatories, and copies of documents. Accordingly, if delivered to my office by October 17, 2003, I will accept any of F.N.B. Corporation's admissions and denials, answers to interrogatories, and copies of documents without objection as to the timeliness of the service or delivery thereof. With respect to any admissions and denials, answers to interrogatories, copies of documents, and other discovery responses not delivered to my office by October 17, 2003, or not delivered at all, MJCM reserves the right to raise and pursue any and all objections and other remedies available to it.

MJCM, moreover, has not waived, conceded, or otherwise limited, and has reserved the right to raise and pursue, any and all objections or remedies available to it with respect to any objection F.N.B. Corporation may have or make with respect to MJCM's First Request for Admissions, First Set Of Interrogatories, and First Request for Production. In particular and without limitation, by failing to serve objections by September 5, 2003, F.N.B. Corporation has forfeited its right to object to MJCM's First Request for Admissions, First Set Of Interrogatories, and First Request for Production on their merits.

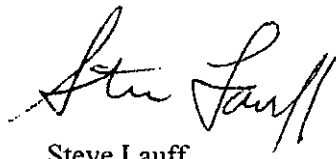
With respect to settlement discussions, on September 24, 2003, I sent to you a proposed basis of settlement. You have still not indicated whether your client is interested in proceeding with discussions on that basis, however. MJCM is not willing to request any suspension or rescheduling of the proceedings of this case without first establishing that there is a good-faith agreement to proceed with bona fide settlement discussions on that basis. The proposed basis is

Ms. Whitelaw  
October 7, 2003  
Page 3

not complex, and by now your client should be able to confirm whether it wants to proceed in good faith with bona fide settlement discussions on that basis. If we do commence such settlement discussions, there is no reason that the discussions cannot be concluded, successfully or unsuccessfully, within a short time.

If F.N.B. Corporation is serious about settling this matter, we should proceed promptly to conclude the settlement.

Regards,

A handwritten signature in black ink, appearing to read "Steve Lauff", written in a cursive style.

Steve Lauff



**Stephens, Suzanne**

---

**From:** Lauff, Steven  
**Sent:** Tuesday, October 14, 2003 6:44 PM  
**To:** 'TRADEMARK4@aol.com'  
**Cc:** Dodd, Jeff; Hoeg, Matt  
**Subject:** RE: BOUNCE GUARD 10/24/03

Hello Jennifer,

I am confirming my agreement by telephone today to accept F.N.B. Corporation's admissions and denials, answers to interrogatories, and copies of documents produced in response to MJCM's requests for production, if delivered to Federal Express on or before 10/24/03 for delivery to my office no later than 10/27/03. I continue to maintain that all other matters stand as stated in my October 7, 2003, letter to you.

I also confirm that I will deliver to my client your proposal to settle this matter by my client taking a license from your client or accepting your client's promise not to sue in connection with the mark. I advised, however, that I do not think my client will be amenable to settlement on either basis.

I will also pass on your renewed request for a suspension of the proceedings in this case. Except for my agreement to accept F.N.B. Corporation's admissions and denials, answers to interrogatories, and copies of documents produced in response to MJCM's requests for production if delivered to my office by 10/27/03, however, there currently is no agreement to extend or stay any time or any party's obligation in this proceeding.

Regards,

Steve Lauff

W: 713.220.4732  
Fax: 713.238.7395  
slauff@akllp.com

Andrews Kurth LLP  
600 Travis, Suite 4200  
Houston, Texas 77002

\*\*\*\*\*

This message and all attachments to it are confidential and proprietary, and also may be privileged or otherwise protected from disclosure. If you are not the intended recipient, or an employee or agent authorized to receive this message and deliver it to the intended recipient, you may not further copy, display, distribute, disseminate, modify, perform, or otherwise use this communication or any of its attachments. You may not directly or indirectly act or refrain from acting based on, or otherwise use for any purpose whatsoever, the data or information contained in this communication or any of its attachments. You are requested please to telephone or email the sender regarding the misdirection of this communication, to delete this message and all attachments from all systems and transmission and storage media to which you have such control, and to destroy all embodiments of this message and its attachments in your possession or under your control. Thank you.

\*\*\*\*\*

-----Original Message-----

**From:** TRADEMARK4@aol.com [mailto:TRADEMARK4@aol.com]  
**Sent:** Tuesday, October 14, 2003 5:55 PM

1/5/2004

**To:** Lauff, Steven

**Cc:** debbie@whitelawfirm.com; litigation@whitelawfirm.com; j@whitelawfirm.com

**Subject:** BOUNCE GUARD 10/24/03

We have agreed that your request to receive discovery response by 10/17/03 is amended to request service by me, FedEx, on or before 10/24/03.

We also continued our discussion of settlement possibilities and asked you to have your client consider something closer to license from us, or other aspects that we discussed. We also think a suspension would facilitate the discussion.

You said you would return to me after having a chance to speak with your client after Friday.

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-01-05 08:19:26 ET

Serial Number: 78095980

Registration Number: (NOT AVAILABLE)

Mark (words only): BOUNCE GUARD

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2002-10-25

Filing Date: 2001-11-30

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: TMO LAW OFFICE 116

Attorney Assigned:  
KON ELISSA GARBER Employee Location

Current Location: 845 -TTAB

Date In Location: 2002-10-30

---

#### LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. F.N.B. Corporation

**Address:**

F.N.B. Corporation  
One F.N.B. Boulevard  
Hermitage, PA 16148  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Florida

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#### GOODS AND/OR SERVICES

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banking services; financial services in the nature of an investment security services, financial analysis and consultation, financial clearing houses, financial information in the nature of rates of exchange, financial exchange, financial forecasting, financial guarantee and surety, financial information provided by electronic means, financial management, financial planning, financial portfolio management, financial research, financial valuation of personal property and real estate, loan financing, lease-purchase financing, financing services, financial portfolio management, financial valuation of personal property and real estate; and Investment services, namely investment brokerage, capital investment consultation, commodity investment advice, fund investment consultation, investment consultation, financial investment in the field of securities, financial services in the nature of an investment security, funds investment, mutual funds investment, real estate investment, commodity investment advice, investment advice, investment brokerage, investment clubs, capital investment consultation, investment management, maintaining escrow accounts for investments, investment of funds for others; Insurance services, namely insurance underwriting and extended warranty contracts in the fields of life, health, accident, fire, marine, medical, pre-paid health care, legal services; insurance administration in the field of life, health, accident, fire, marine, medical, pre-paid health care, legal services; insurance agencies in the fields of life, health, accident, fire, marine, medical, pre-paid health care, legal services; appraisals for insurance claims of personal property, real estate; insurance brokerage, consultation, subrogation and actuarial services in the fields of life, health, accident, fire, marine, medical, pre-paid health care, legal services; Investment services, namely capital investment, and fund Investment consultation, investment consultation; commodity investment advice, investment advice, investment management; investment and financial investment in the field of real estate, securities; financial services in the nature of an investment security; investment of funds, mutual funds, and real estate; investment brokerage, investment clubs; financial services in the nature of an investment security; maintaining escrow accounts for investments; and mutual fund services; information services for all of the foregoing provided via a global computer network

**International Class:** 036

**First Use Date:** 2001-11-23

**First Use in Commerce Date:** 2001-11-23



**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2002-10-25 - Opposition instituted for Proceeding

2002-08-21 - Extension of time to oppose - Filed

2002-07-16 - Published for opposition

2002-06-26 - Notice of publication

2002-04-22 - Approved for Pub - Principal Register (Initial exam)

2002-04-17 - Case file assigned to examining attorney

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

Jennifer L. Whitelaw (Attorney of record)

JENNIFER L. WHITELOW  
LAW OFFICES OF JENNIFER L. WHITELOW  
3838 TAMiami TRl N FL 3  
NAPLES, FL 34103-3590  
United States  
**Phone Number:** 941-262-1001  
**Fax Number:** 941-261-0057

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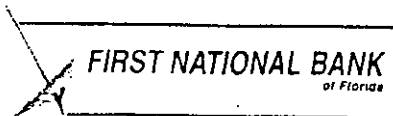


ORIGINAL SPECIME.

Internet Transmission Date:  
2001/11/30

Serial Number:  
78095980

Filing Date:  
2001/11/30



November 23, 2001

Customer Name  
Customer Address  
Customer Address Line 2  
City, State, Zip

Dear Customer Name:

At First National Bank of Florida, we continually strive to provide our customers with the most innovative and economical services available to simplify your financial life. As part of this commitment, we are pleased to share an exciting new service that will add value to your checking account at no additional cost.

On Monday, December 3, 2001, we will automatically enroll you in a new service called Bounce Guard. This program will provide overdraft coverage for your account up to \$500.00 saving you time, money, and hassle. This new service will:

- Eliminate the embarrassment of returned checks and the need to pay merchant penalty fees for NSF checks
- Provide confidence that your checks will be paid despite honest errors in balancing your checkbook
- Extend your cash base for emergencies
- Cover necessary withdrawals until payday

The primary advantage of Bounce Guard is that your combined checks and service charges up to \$500 will not "bounce". This service will be available when you write checks or transfer funds through a bank representative. The available balance of your Bounce Guard limit will be reduced by any NSF fees when overdrafts are paid.

It will be your responsibility to make regular sufficient deposits to clear any negative balances in order to retain your Bounce Guard privilege. We will continue to notify you by mail when an overdraft occurs, and your account will be charged the standard non-sufficient funds fee of \$30.00 for each service chargeable item that overdraws your account. If you currently have our Overdraft Protection service, an overdraft transfer from your Overdraft Protection account will be initiated before your Bounce Guard limit is accessed.

Bounce Guard is simply one more way in which First National Bank of Florida can assist you with your financial needs. If you have additional questions or do not want to take advantage of this service, please contact our Customer Service Center toll free at 1-866-791-0301.

Sincerely,

A handwritten signature in dark ink, appearing to read "Robert C. George".

Robert C. George  
President & CEO

1150 CLEVELAND STREET  
CLEARWATER, FLORIDA 33755  
(727) 441-3447

The applicant has submitted required color specimen.  
The USPTO has printed only one copy of the specimen,  
and extra copies can be produced in-house as needed.



October 28, 2003

VIA FACSIMILE (239) 261-0057  
VIA EXPRESS MAIL, NO. ER156807246US  
VIA EMAIL TO [TRADEMARK4@aol.com](mailto:TRADEMARK4@aol.com) AND TO [j@whitelawfirm.com](mailto:j@whitelawfirm.com)

Jennifer L. Whitelaw, Esq.  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103

Re: *MJCM, LLC v. F.N.B. Corporation, Opposition No. 91/153,220 before the  
Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office*

Dear Ms. Whitelaw:

The April 11, 2003, order of the Trademark Trial and Appeal Board reset the close of the discovery period in the above matter to September 8, 2003. MJCM, LLC ("MJCM") served its First Request for Admissions, First Set Of Interrogatories, and First Request for Production on F.N.B. Corporation ("FNB") on August 1, 2003, and its Second Request for Production on September 8, 2003. The times allowed by the Federal Rules of Civil Procedure and the rules of practice before the Board for responding to MJCM's discovery requests has long-since expired. As explained in my October 7, 2003, letter to you, MJCM was willing to reasonably cooperate with FNB in allowing extra time to make *substantive* discovery responses. In addition, I rearranged my October 24, 2003, schedule in order to respond to your last-minute concern about a protective agreement by preparing and delivering to you the Board's standard protective agreement well in advance of the time you deposited with Federal Express your October 24, 2003, correspondence to me.

Given the multiple extensions that MJCM has allowed FNB to provide *substantive* discovery responses and my accommodation of your last-minute confidentiality concern, I expected MJCM's substantial cooperation to be honored by FNB delivering *substantive* discovery responses in your October 24, 2003, correspondence to me. Instead, the only substantive discovery response FNB provided was a denial of request number 11 of MJCM's First Request for Admissions. The rest of the correspondence essentially comprises untimely and unfounded objections. Because FNB's objections are untimely, the objections cannot now be interposed by FNB, but even if FNB could now raise the objections, its response does not come close to meeting its obligations under the Federal Rules of Civil Procedure and the rules of practice before the Board.

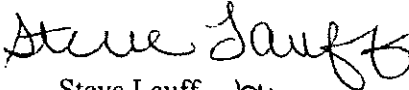
Jennifer L. Whitelaw, Esq.  
October 28, 2003  
Page 2

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With respect to documents that you promised would be copied, authenticated, and delivered to me, you instead stated in your October 24, 2003, correspondence that inspection of "documents not confidential, privileged or otherwise objectionable" would be permitted at your office in Naples, Florida. However, your correspondence went on to clearly state that a "representation that [FNB] will produce any non-privileged, responsive document . . . is not a representation to [MJCM] that any such documents exist." As you know, I originally planned to come to Naples during the discovery period to inspect documents that would be produced in connection with the deposition of FNB, but at your urging canceled those plans and the deposition of FNB in reliance on your copying, authenticating, and sending such documents to me. Thus, your invitation now to make a speculative trip to Naples is unwelcome, inappropriate, and a material breach of your earlier agreement to provide copies of those documents.

Because FNB has completely failed to reciprocate MJCM's cooperation in connection with discovery in this matter, I must now insist that FNB provide, without objection, complete responses to MJCM's First Request for Admissions, First Set Of Interrogatories, First Request for Production, and Second Request for Production. Such response must include the delivery to me of authenticated copies of all documents responsive to each request for production. If by noon on Friday, October 31, 2003, I do not have in my possession FNB's complete responses as set forth above, I shall be forced to file with the Board a motion to compel such responses and to grant such further relief to which MJCM may be entitled.

Sincerely,

  
Steve Lauff by SBS

cc: Jeff C. Dodd (Firm)  
Matthew L. Hoeg (Firm)



**Stephens, Suzanne**

---

**From:** TRADEMARK4@aol.com  
**Sent:** Tuesday, October 28, 2003 4:52 PM  
**To:** Stephens, Suzanne  
**Cc:** Lauff, Steven; litigation@whitelawfirm.com; debbie@whitelawfirm.com  
**Subject:** Re: Letter attached/BOUNCE GUARD

In a message dated 10/28/2003 4:42:46 PM Eastern Standard Time, SuzanneStephens@andrewskurth.com writes:

| I've attached a letter from Steve Lauff. Please let me know if you have any trouble opening it.

If it is the same letter we received by fax today, then here is the response.

October 28, 2003

Steve:

Your letter of today is most unacceptable. We responded appropriately to your requests, and have already, before you wrote the letter, agreed to give you authenticated documents. You provided no means with which to protect the confidentiality of the documents you requested until Friday, October 24, 2003, when you emailed to me a first proposed draft. You insisted that I respond to that draft by Monday. I have just concluded a mediation this evening and have not been able to review the draft you just sent. I will review the draft timely and have no doubt that you will get your documents. I have already agreed to move dates back by a new or amended institution order, so both the tone and the content of letter are uncalled for. There is no reason for hysteria surrounding what is truly a standard and unremarkable discovery exchange with counsel who has been completely agreeable and cooperative with you at all times. The Board will honor a party's right to confidentiality. Your threatened motion to compel does not persuade me that there is any merit to it.

We are working to review and, if acceptable, to sign, your draft. We will provide documents when we are sure they will be properly handled pursuant to such an agreement.

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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1/5/2004





**Stephens, Suzanne**

---

**From:** Lauff, Steven  
**Sent:** Thursday, August 28, 2003 4:03 PM  
**To:** 'TRADEMARK4@aol.com'  
**Subject:** RE: Discovery responses/MJCM vs. FNB/BOUNCE GUARD

Hi Jennifer,

The letter did not address RAs and Interrogs, based on my assumption that the normal timing would apply to those (September 5). I have no objection to extending the normal timing for responses to the RAs and Interrogs, as long as the rest of the discovery provisions of my August 27 letter apply to those responses as well as to the production under the request for production. Would you like September 12 to apply to RAs and Interrogs also?

Regards,

Steve Lauff

W: 713.220.4732  
Fax: 713.238.7395  
slauff@akllp.com

Andrews & Kurth L.L.P.  
600 Travis, Suite 4200  
Houston, Texas 77002

-----Original Message-----

**From:** TRADEMARK4@aol.com [mailto:TRADEMARK4@aol.com]  
**Sent:** Thursday, August 28, 2003 3:46 PM  
**To:** Lauff, Steven  
**Cc:** debbie@whitelawfirm.com; litigation@whitelawfirm.com  
**Subject:** Discovery responses/MJCM vs. FNB/BOUNCE GUARD

Steve - Your letter is unclear as to the timing of the RA's and Interrogatories - May I understand that all outstanding responses are due together (September 12, 2003)?

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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1/5/2004

**Stephens, Suzanne**

---

**From:** TRADEMARK4@aol.com  
**Sent:** Thursday, September 11, 2003 10:14 AM  
**To:** Lauff, Steven  
**Subject:** MJCM vs. FNBCorp - BOUNCE GUARD

Steve:

Thanks for speaking with me today concerning the above matter. I understand that you will confer with your client again concerning settlement. We are trying to get documents compiled, authenticated and transmitted to you by tomorrow but may not make it on time. We will serve the discovery responses together as we discussed and as we also discussed, if we are late we will consent to a resetting of dates in the institution order.

PS: Would you mind confirming what the initials MJCM stand for? Thanks.

I will update you shortly.

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
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1/5/2004

**Stephens, Suzanne**

---

**From:** TRADEMARK4@aol.com  
**Sent:** Thursday, October 02, 2003 10:26 AM  
**To:** Lauff, Steven  
**Cc:** debbie@whitelawfirm.com; litigation@whitelawfirm.com  
**Subject:** BOUNCE GUARD

Steve - Since we are holding discovery at this moment for both sides pending settlement discussion, may I suggest we seek a short suspension, otherwise we will need to seek to reset discovery dates based upon our earlier discussions.

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
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Facsimile: 239-261-0057  
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1/5/2004

**Stephens, Suzanne**

---

**From:** Lauff, Steven  
**Sent:** Tuesday, October 14, 2003 6:44 PM  
**To:** 'TRADEMARK4@aol.com'  
**Cc:** Dodd, Jeff; Hoeg, Matt  
**Subject:** RE: BOUNCE GUARD 10/24/03

Hello Jennifer,

I am confirming my agreement by telephone today to accept F.N.B. Corporation's admissions and denials, answers to interrogatories, and copies of documents produced in response to MJCM's requests for production, if delivered to Federal Express on or before 10/24/03 for delivery to my office no later than 10/27/03. I continue to maintain that all other matters stand as stated in my October 7, 2003, letter to you.

I also confirm that I will deliver to my client your proposal to settle this matter by my client taking a license from your client or accepting your client's promise not to sue in connection with the mark. I advised, however, that I do not think my client will be amenable to settlement on either basis.

I will also pass on your renewed request for a suspension of the proceedings in this case. Except for my agreement to accept F.N.B. Corporation's admissions and denials, answers to interrogatories, and copies of documents produced in response to MJCM's requests for production if delivered to my office by 10/27/03, however, there currently is no agreement to extend or stay any time or any party's obligation in this proceeding.

Regards,

Steve Lauff

W: 713.220.4732  
Fax: 713.238.7395  
slauff@akllp.com

Andrews Kurth LLP  
600 Travis, Suite 4200  
Houston, Texas 77002

\*\*\*\*\*

This message and all attachments to it are confidential and proprietary, and also may be privileged or otherwise protected from disclosure. If you are not the intended recipient, or an employee or agent authorized to receive this message and deliver it to the intended recipient, you may not further copy, display, distribute, disseminate, modify, perform, or otherwise use this communication or any of its attachments. You may not directly or indirectly act or refrain from acting based on, or otherwise use for any purpose whatsoever, the data or information contained in this communication or any of its attachments. You are requested please to telephone or email the sender regarding the misdirection of this communication, to delete this message and all attachments from all systems and transmission and storage media to which you have such control, and to destroy all embodiments of this message and its attachments in your possession or under your control. Thank you.

\*\*\*\*\*

-----Original Message-----

**From:** TRADEMARK4@aol.com [mailto:TRADEMARK4@aol.com]  
**Sent:** Tuesday, October 14, 2003 5:55 PM

1/5/2004

**To:** Lauff, Steven

**Cc:** debbie@whitelawfirm.com; litigation@whitelawfirm.com; j@whitelawfirm.com

**Subject:** BOUNCE GUARD 10/24/03

We have agreed that your request to receive discovery response by 10/17/03 is amended to request service by me, FedEx, on or before 10/24/03.

We also continued our discussion of settlement possibilities and asked you to have your client consider something closer to license from us, or other aspects that we discussed. We also think a suspension would facilitate the discussion.

You said you would return to me after having a chance to speak with your client after Friday.

Jennifer Whitelaw  
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Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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## **Stephens, Suzanne**

---

**From:** Lauff, Steven  
**Sent:** Wednesday, September 24, 2003 2:47 PM  
**To:** 'TRADEMARK4@aol.com'  
**Subject:** RE: BOUNCE GUARD

Hi Jennifer,

As we discussed today, please confer with your client about the following possibility, which is offered solely for purposes of exploring potential terms of settlement of the opposition proceeding:

In settlement of MJCM's opposition to FNB's registration of the mark BOUNCE GUARD, FNB would assign to MJCM the mark BOUNCE GUARD and all goodwill represented by the mark with respect to banking services, financial analysis and consultation services relating to banking services, and information processing and provision services relating to any of the foregoing. MJCM would in turn grant FNB an exclusive, royalty free, nontransferable license to use the mark in connection with those services that it performs. In connection with the license, MJCM would be receptive to FNB's proposal for reasonable quality control provisions.

At this time, MJCM prefers to keep the trial set in the Board's order dated April 11, 2003.

Best Regards,

Steve Lauff

W: 713.220.4732  
Fax: 713.238.7395  
slauff@akllp.com

Andrews & Kurth L.L.P.  
600 Travis, Suite 4200  
Houston, Texas 77002





**Stephens, Suzanne**

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**From:** TRADEMARK4@aol.com  
**Sent:** Thursday, September 11, 2003 10:14 AM  
**To:** Lauff, Steven  
**Subject:** MJCM vs. FNBCorp - BOUNCE GUARD

Steve:

Thanks for speaking with me today concerning the above matter. I understand that you will confer with your client again concerning settlement. We are trying to get documents compiled, authenticated and transmitted to you by tomorrow but may not make it on time. We will serve the discovery responses together as we discussed and as we also discussed, if we are late we will consent to a resetting of dates in the institution order.

PS: Would you mind confirming what the initials MJCM stand for? Thanks.

I will update you shortly.

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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1/5/2004



OMITTED



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

*In the matter of* Trademark Application Serial No. 78/095,980  
For the Service Mark BOUNCE GUARD  
Published in the *Official Gazette* on July 16, 2002

MJCM, LLC

Opposer,

v.

F.N.B. Corporation

Applicant.

Opposition No.: 91153220

**NOTICE OF TAKING THE DEPOSITION OF F.N.B. CORPORATION**

To: Applicant F.N.B. Corporation, through its attorneys of record, Jennifer L. Whitelaw, Esq., and Margaret L. McMorrow, Esq., 3838 Tamiami Trail North, Third Floor, Naples, Florida 34103

Please take notice that Opposer MJCM, LLC ("Opposer"), pursuant to Trademark Trial and Appeal Board Manual of Procedure § 404 (2d ed. June 2003) and Federal Rule of Civil Procedure 30, will take in the above-entitled action the discovery deposition by oral examination of F.N.B. Corporation ("Applicant").

This notice is accompanied by Opposer's First Request for Production ("Request for Production") made in compliance with TBMP § 406 (2d ed. June 2003) and Federal Rule of Civil Procedure 34 for the production of documents and tangible things at the taking of the deposition.

The deposition shall commence at 9:00 a.m. on September 5, 2003, at the offices of Donovan Court Reporting, 2668 Airport Road South, Naples, Florida 34112, or such other time and place as the parties may stipulate. Documents should be produced for inspection at that time, with examination of deponents on the record commencing at 1:00 p.m.

The deposition shall involve the examination of one or more officers, directors, or managing agents, or other persons who consent to testify on Applicant's behalf. The examination shall cover matters generally relating to or concerning:

- (1) Trademark Application Serial No. 78/095,980,
- (2) the adoption and use of the BOUNCE GUARD mark by Applicant,

**Opposition No.: 91153220**

(3) Applicant's general trademark policies and procures and other trademarks as may relate to this action,

(4) authentication of the documents produced pursuant to the Request for Production,

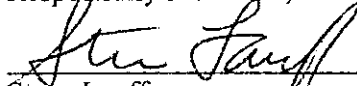
(5) the subject matter and substance of the documents produced pursuant to the Request for Production, and

(6) other matters that are the subject of any of requests for admissions set forth in Opposer's First Request for Admissions in this action or that are the subject of any interrogatory set forth in Opposer's First Set of Interrogatories in this action, or both.

Applicant shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. The persons so designated shall testify as to matters known or reasonably available to Applicant.

The deponents are hereby notified to appear and take such part in the foregoing examination. The taking of the deposition will continue from day to day until complete. You are cordially invited to attend and cross-examine.

Respectfully submitted,



Steve Lauff

Texas Bar No. 24013011

John Courtney

Texas Bar No. 04892200

Andrews & Kurth L.L.P.

600 Travis Street, Suite 4200

Houston, Texas 77002-3090

(713) 220-4732

Fax: (713) 220-4285

Attorney Docket No. 142238

DATED: August 1, 2003


***Opposition No.: 91153220***

**CERTIFICATE OF SERVICE**

I hereby certify that an original copy of this Notice of Taking the Deposition of F.N.B. Corporation was served on the following persons:

Jennifer L. Whitelaw, Esq.  
Margaret L. McMorrow, Esq.  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103

by depositing such copy on August 1, 2003, with the United States Postal Service as certified first-class mail, return receipt requested in an envelope addressed as above and bearing sufficient postage.

  
\_\_\_\_\_  
Steve Lauff  
Attorney for Opposer





August 27, 2003

**VIA FACSIMILE 239 261-0057 (W/O ATTACHMENTS)**  
**VIA EXPRESS MAIL NO. ER156807189**  
**VIA EMAIL mail@whitelawlegalgroup.com (W/O ATTACHMENTS)**

Jennifer L. Whitelaw, Esq.  
3838 Tamiami Trail North  
Third Floor  
Naples, Florida 34103

Re: *MJCM, LLC v. F.N.B. Corporation, Opposition No. 91/153,220 before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office*

Dear Ms. Whitelaw:

I am writing to confirm my understanding of our discussion by telephone on August 19, 2003, and, with respect to the matters we discussed, to propose details that were not addressed during the call. Based on our discussion and the discovery proceedings to date in this matter, I propose as follows:

1. You and I agree to cancel the scheduled discovery deposition of F.N.B. Corporation.
2. Instead of producing documents in connection with the discovery deposition of F.N.B. Corporation, you will send me copies of all documents that are subject to production pursuant to the "Opposer's First Request for Production."
3. You will send the copies provided under item 2 above so that I have the copies by September 5, 2003 (the date scheduled for the discovery deposition of F.N.B. Corporation), or at least by September 12, 2003.
4. If the copies sent under item 2 above do not arrive at my office by September 5, 2003, you will honor and comply with any additional discovery requests made by MJCM, LLC, that are served on you within three days of the day that such documents arrive at my office, even though such additional requests may be served subsequent to the close of the formal discovery period in this matter.
5. If additional requests under item 4 above include requests for production of documents, you will send me copies of the documents subject to such requests.

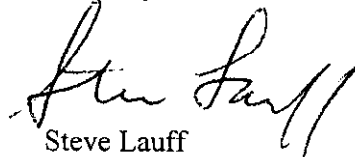
6. The timing of your responses to additional discovery under items 4 and 5 above will comply with the timing that would be required by applicable rules for discovery requests served on September 8, 2003, the closing date of the discovery period.
7. I will provide you with copies of all documents that are subject to requests for production served by F.N.B. Corporation on MJCM, LLC, during the discovery period in this matter in accordance the Trademark Trial and Appeal Board Manual of Procedure and other applicable rules.
8. F.N.B. Corporation and MJCM, LLC, will stipulate that the documents obtained under Federal Rule of Civil Procedure 34 and the associated Trademark Trial and Appeal Board rules may be made of record in this matter by the party obtaining such documents.
9. All other discovery issues will remain subject to the applicable rules, unless we mutually agree to contrary provisions.

I would like to timely cancel the reservations I have made in connection with the planned deposition of F.N.B. Corporation, and therefore would appreciate your prompt reply to the foregoing proposals.

As we agreed during our discussion, I am enclosing with this letter copies of the documents I found in our files for the prosecution of U.S. Trademark Application Serial No. 76/200,144 and No. 75/574,469 at the U.S. Patent and Trademark Office. I cannot provide any assurances that our files are complete with respect to the prosecution of either mark.

My client's schedule has prevented me from discussing the substance of any potential settlement of this matter. However, I look forward to receiving any proposal for settlement of this matter that you or your client may propose.

Sincerely,



Steve Lauff

Two Enclosures (by Express Mail)

cc: Mr. Joseph Gillen  
Jeff C. Dodd, Esq. (Firm)  
John P. Courtney, Esq. (Firm)



**Stephens, Suzanne**

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**From:** Lauff, Steven  
**Sent:** Wednesday, August 27, 2003 5:37 PM  
**To:** 'TRADEMARK4@aol.com'  
**Cc:** 'j@whitelawfirm.com'  
**Subject:** RE: MJCM, LLC v. FNB Corp/ Letter attached from Steve Lauff

Hi Jennifer;

The file wrappers are coming by express mail; you should have them tomorrow.

I will cancel my reservations relating to the deposition in reliance on your agreement below to the terms of my letter today, but with some misgivings--I was looking forward to visiting Naples.

Best Regards,

Steve Lauff

W: 713.220.4732  
Fax: 713.238.7395  
slauff@akllp.com

Andrews & Kurth L.L.P.  
600 Travis, Suite 4200  
Houston, Texas 77002

-----Original Message-----

**From:** TRADEMARK4@aol.com [mailto:TRADEMARK4@aol.com]  
**Sent:** Wednesday, August 27, 2003 5:16 PM  
**To:** Stephens, Suzanne  
**Cc:** Lauff, Steven; j@whitelawfirm.com; debbie@whitelawfirm.com; litigation@whitelawfirm.com  
**Subject:** Re: MJCM, LLC v. FNB Corp/ Letter attached from Steve Lauff

In a message dated 8/27/2003 12:09:42 PM Eastern Standard Time,  
SuzanneStephens@andrewskurth.com writes:

I have attached a letter from Steve Lauff, Esq. Please let me know if you have any trouble opening the attachment.

Thank you,

Suzanne Stephens

Steve - You may cancel your flight. I appreciate the trademark files wrappers but they don't seemed to be attached to your letter. Did they get sent separately?

Jennifer Whitelaw  
WHITELAW LEGAL GROUP  
Intellectual Property and Related Causes  
3838 Tamiami Trail North

1/5/2004

Third Floor  
Naples, Florida 34103  
239-262-1001  
Facsimile: 239-261-0057  
j@whitelawfirm.com

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