

TTAB

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

Liebert Corporation

Opposer,

v.

Digitronics Inventioneering Corp.

Applicant.

Opposition No. 91153525



04-16-2004

U.S. Patent & TMO/TM Mail Rpt. Ct. #22

BOX TTAB

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

MOTION TO STRIKE OPPOSER'S REPLY BRIEF

Digitronics Inventioneering, Applicant moves to strike the reply brief of Liebert Corporation, Opposer pursuant to T.B.M.P. § 539 on the grounds that Liebert Corporation has submitted a reply brief exceeding the page limitation and failed to move for leave to file a brief exceeding the page limitation on or before the due date of the reply brief in violation of 37 C.F.R. § 2.128 and T.B.M.P. § 537.

Dated: 04/16/2004

By: Jack P. Friedman

Jack P. Friedman

Arlen L. Olsen

Attorneys for Applicant, Digitronics
Inventioneering Corporation

SCHMEISER, OLSEN & WATTS

3 Lear Jet Lane, Suite 201

Latham, New York 12110

Telephone: (518) 220-1850

Facsimile: (518) 220-1857

TABLE OF CONTENTS

I.	INTRODUCTION.....	3
II.	ARGUMENT.....	3
	A. Liebert’s Reply Brief Should Be Given No Consideration Because Liebert Submitted a Reply Brief That Exceeds the Page Limitation and Liebert Failed to Make a Motion for Leave to File an Overlength Brief.....	3
	B. Liebert’s Reply Brief Should Be Stricken Because Liebert Attempted to Circumvent the Page Limitation by Using Roman Numerals to Number Pages of the Table of Contents and Table of Authorities After Exceeding the Page Limitation.....	5
	C. Liebert’s Reply Brief Should Be Stricken Since Liebert Sought To Circumvent the Page Limitation Through the Use of Numerous Single-Spaced Footnotes Containing Substantial Discussion.....	8
III.	SUMMARY.....	9

TABLE OF AUTHORITIES

CASES

<i>Conorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.</i> , 23 U.S.P.Q.2d 1894 (T.T.A.B.1992).....	8
<i>Realnet Works, Inc. v. Real Telephony, Inc.</i> , 2002 TTAB 124 (2002).....	4, 5, 6, 7
<i>United Foods, Inc. v. United Air Lines, Inc.</i> , 33 U.S.P.Q.2d 1542 (T.T.A.B.1994).....	4, 5, 7

OTHER AUTHORITIES

T.B.M.P. § 537.....	3, 4, 5
T.B.M.P. § 539.....	3
37 C.F.R. § 2.128(b) (2003).....	3, 4, 6, 7, 8

I. INTRODUCTION

On April 5, 2004, Liebert filed a reply brief, which consists of twenty-eight pages. Liebert did not move to file a brief exceeding the page limitation pursuant to T.B.M.P. § 537 on or before the due date of the reply brief. Liebert numbered pages of the table of contents and table of authorities with Roman numerals. The reply brief contained large paragraphs of single-spaced footnotes. Applicant has moved to strike Liebert's reply brief.

II. ARGUMENT

A. Liebert's Reply Brief Should Be Given No Consideration Because Liebert Submitted a Reply Brief That Exceeds the Page Limitation and Liebert Failed to Make a Motion For Leave to File an Overlength Brief

Opposer's reply brief should be stricken because Opposer's reply brief exceeds twenty-five pages. *See* T.B.M.P. § 539. According to 37 C.F.R. § 2.128, the reply brief may not exceed twenty-five pages in its entirety. *See* 37 C.F.R. § 2.128 (2003); *See also* T.B.M.P. § 537. The page limitation includes the "table of contents, index of cases, description of record, statement of issues, recitation of facts, argument and summary..." 37 C.F.R. § 2.128; *See also* T.B.M.P. § 537. Section 2.128 provides as follows:

"A main brief on the case shall not exceed fifty-five pages in length in its entirety, including table of contents, index of cases, description of record, statement of issues, recitation of facts, argument and summary; and a reply brief shall not exceed twenty-five pages in its entirety." 37 C.F.R. § 2.128

"If a party files a brief that exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief is stricken, without leave to file a substitute brief that meets the limit." T.B.M.P. § 537. An opposer should make a motion for leave to file a reply brief

exceeding the page limit on or before the due date of the reply brief. 37 C.F.R. § 2.128; *See also* T.B.M.P. § 537; *See also United Foods, Inc. v. United Air Lines, Inc.*, 33 U.S.P.Q.2d 1542, 1543 (T.T.A.B. 1994). “The rules of the page limitations are for the benefit of the Board, and only with the Board’s permission, timely sought, will a brief of the length exceeding those limitations be accepted.” *Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB 124, *5 (2002).

In *United Foods, Inc. v. United Air Lines, Inc.*, during a cancellation proceeding, the petitioner sought to file a thirty-page reply brief exceeding the page limitation provided in 37 C.F.R. § 2.128. *United Foods, Inc. v. United Air Lines, Inc.*, 33 U.S.P.Q.2d 1542, 1542 (T.T.A.B. 1994). Along with the thirty page reply brief, the plaintiff filed a motion to submit an overlength brief pursuant to T.B.M.P. § 537. *United Foods, Inc.*, 33 U.S.P.Q.2d at 1542. In a motion in opposition to the petitioner’s reply brief, the respondent argued that the petitioner’s reply brief should be stricken because the petitioner had not made a motion for leave to file a reply brief exceeding the page limit prior to submitting the thirty page reply brief. *United Foods, Inc.*, 33 U.S.P.Q.2d at 1542. The Trademark and Appeal Board determined that the petitioner had made a timely motion because the petitioner filed a motion with the reply brief on or before the due date of the reply brief. *United Foods, Inc.*, 33 U.S.P.Q.2d at 1542. Although the motion was timely, the Board denied petitioner’s motion to exceed the page limit after considering petitioner’s arguments and relevant factors for allowing additional pages. *United Foods, Inc.*, 33 U.S.P.Q.2d at 1543.

Where a timely motion for leave to file a brief exceeding the page limit is denied, the petitioner “will be allowed time to file a conforming brief” as a substitute. *United Foods, Inc.*, 33 U.S.P.Q.2d at 1542-1543; *See also* T.B.M.P. § 537. For example, in *United Foods, Inc.*, the

petitioner was allowed fifteen days from the Board's decision to file a substitute reply brief conforming to the page limitations of 37 C.F.R. § 2.128(b) because the petitioner submitted a motion for leave to file a brief exceeding the page limit. *See United Foods, Inc.*, 33 U.S.P.Q.2d at 1542-1543; *See also* T.B.M.P. § 537. In *United Foods, Inc.*, the Board noted that where "a party files a brief in excess of the relevant limit of the rule, without having filed a timely motion for leave to exceed the limit of the rule, then the brief shall be stricken without leave to file a substitute." *United Foods, Inc.*, 33 U.S.P.Q.2d at 1543; *See also* T.B.M.P. § 537.

Unlike the petitioner in *United Foods, Inc.*, who submitted a motion for leave to file a brief exceeding the page limit, Liebert did not make a timely motion for leave to file a reply brief exceeding the page limit. Liebert filed the reply brief on April 4, 2004. Liebert did not make a motion for leave to exceed the page limit before submission of the reply brief. Furthermore, Liebert did not include such a motion with its reply brief on or before the date that Liebert's reply brief was due. Therefore, Liebert's reply brief should be stricken and time should not be allowed for submission of a brief conforming to the page limitations of 37 C.F.R. § 2.128(b).

B. Liebert's Reply Brief Should Be Stricken Because Liebert Attempted to Circumvent the Page Limitation By Using Roman Numerals to Number Pages of the Table of Contents and Table of Authorities After Exceeding the Page Limitation

A party's brief was stricken where the party filed an overlength brief and failed to move for leave to file an overlength brief. In *Realnet Works, Inc. v. Real Telephony, Inc.*, the opposer filed an opposition against the applicant's use of the mark REALAUDIO on the basis of dilution of a family of marks including the term REAL. *Realnet Works, Inc.*, 2002 TTAB LEXIS 124, *3. *See Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB 124, at *5-6 (2002). Furthermore,

the opposer challenged use of the applicant's mark due to likelihood of confusion. *See Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB 124, at *5-6 (2002). The opposer filed a brief in opposition to applicant's summary judgment motion. *See Realnet Works, Inc.*, 2002 TTAB LEXIS 124, *2. The opposer's brief exceeded twenty-five pages. *See Realnet Works, Inc.*, 2002 TTAB LEXIS 124, at *2. The opposer's argument encompassed twenty-four pages. *See Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB LEXIS 124, at *3 (2002). Nevertheless, the opposer's argument within twenty-five pages, was preceded by four additional pages. The four additional pages were numbered using Roman numerals. *See Realnet Works, Inc.*, 2002 TTAB LEXIS 124, at *3. The four additional pages contained a table of contents and index of cases. *See Realnet Works, Inc.*, 2002 TTAB LEXIS 124, at *3. Section 2.128 specifically provides that the table of contents and table of authorities are included in the page limitation. *See* 37 C.F.R. § 1.128. The court determined that the opposer's brief was "procedurally improper and that the opposer's use of Roman numerals in the page numbers of its brief" was "an impermissible attempt to circumvent Board rules regarding page limitations of briefs." *Realnet Works, Inc.*, 2002 TTAB LEXIS 124, at *5-6. Therefore, in *Realnet Works, Inc.* the opposer's brief was stricken. *See Realnet Works, Inc.*, 2002 TTAB LEXIS 124, at *6.

The facts of *Realnet Works, Inc.* are similar to the present matter. Like the opposer in *Realnet Works, Inc.*, Liebert is opposing Applicant, Digitronic Inventioning Corporation's mark **SITETRAK** on the basis of alleged likelihood of confusion and dilution of a famous family of marks, including **SITESCAN**, **SITEMASTER**, **SITENET**, **SITELINK**, and **SITENET ENERGY MASTER**. Liebert submitted a reply brief, which was twenty-eight pages. Liebert's introduction, argument and summary encompassed twenty-five pages of the

brief. Liebert's did not include the table of contents and table of authorities in the twenty-five pages, which Liebert numbered. Rather, Liebert numbered the table of contents and table of authorities using Roman numerals similar to what was done in *Realnet Works, Inc. v. Real Telephony, Inc.* The table of contents and table of authorities in Liebert's reply brief constitute three pages. Liebert impermissibly used Roman numerals to circumvent the page limitation of 37 C.F.R. § 2.128(b) in a similar manner to what the opposer did in *Realnet Works, Inc.* Thus, Liebert's reply brief should be stricken in the same manner as the opposer's brief was stricken in the *Realnet Works, Inc.* decision.

The Board considers several factors in determining whether a plaintiff may submit an overlength brief. The Board considers the "novelty or complexity of the issues in the case." *United Foods, Inc. v. United Air Lines, Inc.*, 33 U.S.P.Q.2d 1542, 1543 (T.T.A.B. 1994). Additionally, the Board considers whether the record is voluminous. *See United Foods, Inc.*, 33 U.S.P.Q.2d at 1543. Parties may be allowed to file briefs exceeding the page limitations "when the record is lengthy." *United Foods, Inc.*, 33 U.S.P.Q.2d at 1543. When a party fails to use the fifty-five pages allowed for a main brief, an argument for an overlength brief due to the length of the record may be unpersuasive. *See United Foods, Inc.*, 33 U.S.P.Q.2d at 1543.

Similar to the petitioner in *United Foods, Inc.*, Liebert did not take advantage of the number of pages allowed for the main brief. Liebert used twenty-nine pages for its main brief. Since Liebert did not utilize more of the fifty-five pages allowable for the main brief, use of twenty-nine pages undercuts a possible argument that an overlength brief is needed because of voluminous size of the record. In addition, Liebert did not submit a motion for leave to file a brief exceeding the page limit as has been explained supra in Section A.

C. Liebert’s Reply Brief Should Be Stricken Since Liebert Sought To Circumvent the Page Limitation Through the Use of Numerous Single-Spaced Footnotes Containing Substantial Discussion

“Although the Board has not yet had need to adopt the Federal Circuit’s rule that footnotes, too must be double-spaced,” the Board has “cautioned that single-spaced footnotes are not to be used as a subterfuge to avoid the page limitations set forth in Trademark Rule 2.128.” *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 U.S.P.Q.2d 1894, 1896, n. 3 (T.T.A.B. 1992). In *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, the petitioner, an organization for certifying ham originating in Parma, Italy, was seeking cancellation of the registration of respondent’s mark PARMA BRAND on the basis that the mark was geographically deceptive. *See Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1895. Petitioner’s main brief contained fifty pages of text. *See Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1896, n. 3. The table of contents and table of cases encompassed four additional pages. *See Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1896 n. 3. The petitioner’s fifty-four page main brief did not exceed the page limit because 37 C.F.R. 2.128(b) limits the main brief to fifty-five pages. *See Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 U.S.P.Q.2d 1894, 1896 n. 3 (T.T.A.B. 1992). However, there were forty-seven single-spaced footnotes, which contained “substantial discussion.” *Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1896 n. 3. The Board did not strike the petitioner’s brief but the Board cautioned the use of single-spaced footnotes in such a manner. *Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1896 n. 3.

As in *Consorzio del Prosciutto di Parma*, Liebert used several single-spaced footnotes in its reply brief and some footnotes consisted of large paragraphs containing substantial discussion.

In Liebert's reply brief footnotes 4, 5, 9, 13 and 15 each contain eight to ten lines of argument. Footnote 10 consists of fourteen lines of argument. Liebert's reply brief contains roughly twenty-three lines per page. The lines of all single-spaced footnotes in Liebert's reply brief total eighty-nine. Liebert's footnotes amount to **3 lines short of 4 double-spaced pages**. Liebert is allowed only twenty-five pages for a reply brief pursuant to 37 C.F.R. § 2.128. The additional four double-spaced pages resulting from the substantial use of single-spaced footnotes constitute 16% overage of the page limit of twenty-five. Furthermore, considering the **additional three pages** resulting from the use of Roman numerals for numbering the table of contents and table of authorities, Liebert's reply brief is **thirty-one pages**. Since Liebert used single-spaced footnotes in addition to including excessive pages, numbered with Roman numerals, the reply brief should be stricken.

III. SUMMARY

In conclusion, the reply brief should be stricken and Liebert should not be allowed to submit a conforming brief since Liebert filed an overlength reply brief, failed to move for leave to file an overlength brief, numbered excessive pages using Roman numerals, and included substantial single-spaced footnotes.

Respectfully submitted,

SCHMEISER, OLSEN & WATTS

Dated: 04/16/2004

By: Jack P. Friedman

Jack P. Friedman

Arlen L. Olsen

Attorneys for Applicant, Digitronics

Inventioneering Corporation

3 Lear Jet Lane, Suite 201

Latham, New York 12110

Telephone: (518) 220-1850

Facsimile: (518) 220-1857

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **MOTION TO STRIKE OPPOSER'S REPLY BRIEF** and **BRIEF IN SUPPORT OF MOTION TO STRIKE** was served by Express Mail, postage prepaid, on Opposer's attorney, Scott J. Garber, Howrey Simon Arnold & White, LLP, 750 Bering Drive, Houston, TX 77057 on this 16th day of April 2004.

By: *Jack P. Friedman*
Jack P. Friedman
Arlen L. Olsen
Attorneys for Applicant, Digitronics
Invention Engineering Corporation
SCHMEISER, OLSEN & WATTS
3 Lear Jet Lane, Suite 201
Latham, New York 12110
Telephone: (518) 220-1850
Facsimile: (518) 220-1857