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

Liebert Corporation

Opposer,

v.

Digitronics Inventioneering Corp.

Applicant.


Opposition No. 91153525



04-20-2004

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OPPOSITION TO APPLICANT'S MOTION TO STRIKE OPPOSER'S REPLY BRIEF

and

CROSS-MOTION FOR LEAVE TO FILE A SUBSTITUTE REPLY BRIEF

Opposer, Liebert Corporation ("Liebert"), by its attorneys, opposes Applicant's motion to strike Opposer's reply brief and cross-moves for leave to file a substitute reply brief ("substitute brief").

Liebert's original reply brief ("original brief") was twenty-nine (29) pages in its entirety because counsel inadvertently misunderstood the page limit set forth in 37 C.F.R. § 2.128(b) ("§ 2.128(b)"). Indeed Liebert did limit the body of its original brief to twenty-five (25) pages based on its mistaken understanding that § 2.128(b) applies to the body of the brief only. Liebert was not

aware of its misunderstanding regarding § 2.128(b) until receiving Applicant's motion to strike on April 19, 2004. Liebert thus opposes Applicant's motion to strike its original brief as Liebert accidentally exceeded the page limitation set forth in § 2.128(b).

Indeed, Liebert has been able to proffer a substitute reply brief (attached as Exhibit A for the convenience of the Board) in total compliance with § 2.128(b) without editing or eliminating any of the body of its reply brief, simply by eliminating its unnecessary table of contents and reducing its font size to the 11 point font approved in 37 C.F.R. § 2.126. Thus, Applicant's argument that Opposer was somehow trying to circumvent the page limit falls flat.

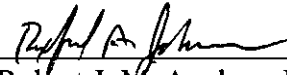
In addition, Applicant's specific gripes are groundless. Applicant incorrectly accuses Liebert of using Roman numerals to circumvent § 2.128(b). Yet, it is ordinary and customary practice to use Roman numerals to number the Table of Contents and Table of Authorities in order to distinguish these pages from the actual body of a document, a practice that Applicant's motion to strike and Applicant's trial brief employ. Applicant also improperly relies on *Consortio del Prosciutto di Parma, v. Parma Sausage Products, Inc.*, 23 U.S.P.Q.2d 1894 (T.T.A.B. 1992) as supporting its position that Opposer sought an end-run around § 2.128(b) by using too many footnotes. In *Consortio del Prosciutto*, however, the petitioner's brief contained forty-seven (47) footnotes, many of which contained "substantial discussion." *Id.* at 1894 n.3. In contrast, Liebert's original brief contains only fifteen (15) footnotes and they are used in the ordinary manner to address points ancillary to the body of the brief, not in an attempt to avoid the page limitation. Neither of these arguments provides a basis to strike Opposer's reply.

CONCLUSION

This Board should not strike Liebert's original brief for the reasons set forth above. However, in the alternative, Liebert moves leave of the Board to file the enclosed substitute reply brief. The substitute reply brief is identical to the original brief except that it omits the Table of Contents and is in 11-point type, which is acceptable under 37 C.F.R. § 2.126. These changes reduce the length of the substitute reply brief to only twenty-four (24) pages *in its entirety*. Thus, Applicant will not be prejudiced as the substitute brief contains exactly the same substantive matter. Further, the substitute reply brief will aid the Board in determining the case on the merits. Thus Liebert, in the alternative, moves for leave of the Board to submit the substitute brief that conforms to § 2.128.

Respectfully submitted,

Dated: 4/20/04 _____

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ATTORNEYS FOR OPPOSER,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served by express mail, postage prepaid, on Applicant's attorney, Jack P. Friedman, Schmeiser, Olsen & Watts, 3 Lear Jet Lane, Suite 2091, Latham, New York 12110, on this 20th day of April 2004.




EXHIBIT A

Liebert's Substitute Reply Brief

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