

TTAB

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

Liebert Corporation

Opposer,

v.

Digitronics Inventioning Corp.

Applicant.

Opposition No. 91153525



05-03-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**BOX TTAB**

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

**CERTIFICATE OF EXPRESS MAILING**

Express Mail Mailing Label No. EV4722122 US

Date of Deposit : May 3, 2004

I hereby certify that this paper and/or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Melody McCormick  
Printed Name

Signature

**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO STRIKE OPPOSER'S REPLY BRIEF**  
and  
**APPLICANT'S OPPOSITION TO OPPOSER'S CROSS MOTION FOR LEAVE TO FILE A SUBSTITUTE REPLY BRIEF**

Applicant, Digitronic Inventioning opposes Liebert's Opposition to Applicant's Motion to Strike Opposer's Reply Brief and Liebert's Cross Motion for Leave to File a Substitute Reply Brief. Pursuant to T.B.M.P. § 539, Applicant moves that no consideration be given to Liebert's substitute reply brief, which is in violation of T.B.M.P. §§ 537, 539 and 37 C.F.R. § 2.128(b).

Dated: May 3, 2004

By: Jack P. Friedman

Jack P. Friedman

Arlen L. Olsen

Attorneys for Applicant, Digitronics  
Inventioning 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.....1

II ARGUMENT.....1

    A. Because Liebert’s Cross-Motion for Leave to File a Substitute Reply Brief is Untimely and Procedurally Improper, Liebert’s Substitute Reply Brief Should Be Given No Consideration.....1

    B. Because Liebert Failed to Cite Case Precedent or Procedural Rules in Support of Legal Authority to File a Cross-Motion for Leave to File a Substitute Reply Brief Conforming to 37 C.F.R. § 2.128(b), Liebert’s Substitute Reply Brief Should Be Given No Consideration.....5

III. SUMMARY.....6

**TABLE OF AUTHORITIES**

**CASES**

*Realnet Works, Inc. v. Real Telephony, Inc.*,  
2002 TTAB 124 (2002).....1, 2, 3, 4  
*United Foods, Inc. v. United Air Lines, Inc.*,  
33 U.S.P.Q.2d 1542 (T.T.A.B.1994).....1, 2

**OTHER AUTHORITIES**

T.B.M.P. § 537.....1, 4, 5  
T.B.M.P. § 539.....1, 4  
37 C.F.R. § 2.128(b) (2003).....1, 3, 5, 6

## I. INTRODUCTION

Liebert filed a reply brief on April 4, 2004, which consisted of twenty-eight pages. Liebert did not submit a motion for leave to file a brief exceeding the page limit on or before the due date of the reply brief. On April 16, 2004, Applicant filed a motion to strike Opposer's reply brief. On April 20, 2004, Liebert filed a cross-motion for leave to file a substitute reply brief and an Opposition to Applicant's Motion to Strike Opposer's Reply Brief. Liebert has not cited any case precedent or procedural rules in support of its cross-motion for leave to file a substitute reply brief.

## II. ARGUMENT

### A. **Because Liebert's Cross-Motion for Leave to File a Substitute Reply Brief is Untimely and Procedurally Improper, Liebert's Substitute Reply Brief Should Be Given No Consideration**

In T.B.M.P. § 539, the Trademark Board provides that "if a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 C.F.R. § 2.128(b). T.B.M.P. § 539. Nevertheless, the Board points out in the footnote to the above quotation the following rule of T.B.M.P § 537:

"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 will be stricken, without leave to file a substitute brief that meets the limit" (emphasis added). T.B.M.P §§ 537, 539.

A motion for leave to file a brief exceeding the page limit will be considered where the motion is timely and in the event the Trademark Board denies the motion, a party will be allowed to submit a substitute brief. *See United Foods, Inc. v. United Air Lines, Inc.*, 33 U.S.P.Q.2d 1542, 1542 (T.T.A.B. 1994); *See also* T.B.M.P §§ 537. Timeliness requires that the motion for leave to

file an overlength brief “be submitted on or before the date the brief is due.” T.B.M.P. § 537; *See United Foods, Inc. v. United Air Lines, Inc.*, 33 U.S.P.Q.2d 1542, 1542 (T.T.A.B. 1994); *See also Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB 124 (2002). For example in *United Foods v. United Air Lines, Inc.*, the petitioner filed a reply brief exceeding the page limit of twenty-five pages. *United Foods v. United Air Lines, Inc.*, 33 U.S.P.Q. 2d 1542, 1542 (T.T.A.B. 1994). Accompanying petitioner’s reply brief was a motion for leave to file a brief exceeding the page limit. *United Foods*, 33 U.S.P.Q. 2d at 1542. The Board determined that the accompanying motion for leave to file a brief exceeding the page limit was timely because the motion was filed with the reply brief on or before the due date of the reply brief. *See United Foods*, 33 U.S.P.Q. 2d at 1542. The Board considered the petitioner’s accompanying motion for leave to file a brief exceeding the page limit because the petitioner’s motion was timely. *See United Foods*, 33 U.S.P.Q. 2d at 1542. Although the Board denied the petitioner’s motion, the Board allowed the petitioner leave to file a substitute brief conforming to the page limit because of the timeliness of petitioner’s motion. *See United Foods*, 33 U.S.P.Q. 2d at 1543. The Board also indicated that “if a party files a brief in excess of the relevant limit, 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** (emphasis added).” *United Foods*, 33 U.S.P.Q. 2d at 1542.

Liebert’s situation is unlike the situation in the *United Foods* decision because Liebert failed to submit a timely motion for leave to file a brief exceeding the page limit with Liebert’s overlength reply brief. Liebert filed its reply brief on April 4, 2004. On April 20, 2004, Liebert filed a cross-motion to a substitute reply brief. Liebert should not be allowed to submit a substitute reply brief as the petitioner was allowed to do in *United Foods*, because Liebert failed to submit a timely motion

for leave file a brief exceeding the page limit on or before the date that the reply brief was due.

A party will not be granted leave to file a substitute brief where the party files a brief exceeding the page limit without submitting a timely motion for leave to file a brief exceeding the page limit. *See Realnet Works, Inc. v. Real Telephony, Inc.*, 2002 TTAB 124, \*5-6 (2002). For example, in *Realnet Works, Inc. v. Real Telephony, Inc.*, the opposer filed a brief in opposition to the applicant's summary judgment motion. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*3. The page limit for such a motion is twenty-five pages according to 37 C.F.R. § 2.127(a). *See Realnet Works, Inc.*, 2002 TTAB 124, at \*4. The page limit includes table of contents, index of cases, description of the record, statement of issues, recitation of facts, argument and summary. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*4. The body of opposer's brief in *Realnet Works, Inc.* consisted of twenty-four pages. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*4. However, the table of contents and table of authorities in opposer's brief amounted to four pages. *See Realnet Works, Inc.*, 2002 TTAB 124, \*3. The table of contents and table of authorities were numbered using Roman numerals. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*3-4. The opposer's brief was a total of twenty-eight pages, including the table of contents, table of authorities and body of the brief. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*4-5. The Board struck the opposer's brief since the brief exceeded the page limit and the brief was filed without an accompanying motion for leave to exceed the page limit. The Board determined that opposer's brief was procedurally improper. *See Realnet Works, Inc.*, 2002 TTAB 124, at \*5-6. Furthermore, the Board refused to grant the opposer leave to file a substitute brief **because the opposer submitted a twenty-eight page brief without an accompanying motion for leave to file a brief exceeding the page limit.** *See Realnet Works, Inc.*, 2002 TTAB 124, at \*5-6.

Liebert should not be allowed to submit a substitute brief because like the opposer in *Realnet Works, Inc.*, Liebert filed a brief exceeding the page limit without an accompanying motion for leave to file a brief exceeding the page limit. Liebert submitted its reply brief on April 5, 2004. No motion for leave to file a brief exceeding the page limit accompanied the reply brief, which was filed on April 5, 2004. Liebert filed a cross-motion for leave to file a substitute reply brief on April 20, 2004. Liebert failed to submit a timely motion for leave to file a reply brief, exceeding the page limit, before or on the due date of the reply brief. Applicant argues that the cross-motion filed April 20, 2004 is untimely since the cross-motion was filed after the due date of Liebert's reply brief. Applicant argues that Liebert's cross-motion for leave to file a substitute reply brief is untimely and procedurally improper in light of *Realnet Works, Inc.*, T.B.M.P. § 537, T.B.M.P. § 539 of the Trademark Board Manual Procedure. Therefore, Applicant respectfully requests the Board to find that the cross-motion is untimely and procedurally improper. Furthermore, Applicant requests that Board's disregard Liebert's substitute reply brief because of Liebert's failure to timely submit a motion for leave to file a brief exceeding the page limit.

The Board allows a party leave to submit a substitute reply brief in two situations. The first provision allows a party to submit a substitute brief where the party has filed a motion for leave to file a brief exceeding the page limit before the submission of an overlength brief and the motion is denied. *See* T.B.M.P. § 537.

According to *See* T.B.M.P. § 537:

“The preferred practice, when a **timely** motion for leave to exceed the page limit is filed, is that the proposed overlength brief not be filed with the motion....If the motion is denied, the Board, in its decision, will allow time for the filing of a brief

and specify the number of additional pages granted” (emphasis added). T.B.M.P. § 537.

Alternatively, the second provision allows a party to submit a substitute reply brief where the party submits a motion for leave to file a brief exceeding the page limit, accompanying an overlength brief, and the motion is denied. *See* T.B.M.P. § 537. Pursuant to T.B.M.P. § 537, “if a proposed overlength brief is filed with the motion” and “the motion is denied, the overlength will be given no consideration, and the Board will allow time for the filing of a brief which conforms to the page limit set out in 37 C.F.R. § 2.128(b).

Liebert failed to submit a timely motion for leave to file an overlength brief before the submission of Liebert’s reply brief on April 4, 2004. Liebert also failed to submit a motion for leave to file an overlength brief with the submission of Liebert’s reply brief on April 4, 2004. Therefore, Liebert cannot benefit from the first or second provision of T.B.M.P. § 537.

**B. Because Liebert Failed to Cite Case Precedent or Procedural Rules in Support of Legal Authority to file a Cross-Motion for Leave to File a Substitute Reply Brief Conforming to 37 C.F.R. § 2.128(b), Liebert’s Substitute Reply Brief Should Be Given No Consideration**

In Liebert’s Cross-Motion For Leave to File a Substitute Reply Brief, Liebert addressed the issue of excessive footnotes raised by Applicant in Applicant’s Motion to Strike Opposer’s Reply Brief. Liebert analyzed the legal authority regarding excessive footnotes raised in Applicant’s Motion to Strike Opposer’s Reply Brief. However, Liebert failed to cite case precedent or procedural rules for a basis on of legal authority to submit a cross-motion for leave to file a substitute brief conforming to the page limit for reply briefs pursuant to 37 C.F.R. § 2.128(b). Liebert states that it was unaware of the misunderstanding regarding 37 C.F.R. § 2.128(b) until receiving

Applicant's Motion to Strike Opposer's Reply Brief. However, Liebert cites no legal authority to support that a misunderstanding of procedural rules allows a party to submit an untimely cross-motion for leave to file a substitute reply brief conforming to 37 C.F.R. § 2.128(b). Thus, the Board should not consider Liebert's substitute reply brief.


### III. SUMMARY

In conclusion, Liebert's substitute reply brief should be given no consideration since Liebert filed an untimely and procedurally improper motion to submit a substitute reply brief and Liebert failed to cite legal precedent or procedural rules for legal authority to file a cross-motion for leave to file a substitute brief conforming to the page limit.

Respectfully submitted,

SCHMEISER, OLSEN & WATTS

Dated: May 3, 2004

By:   
Jack P. Friedman  
Arlen L. Olsen  
Attorneys for Applicant, Digitronics  
Invention Engineering 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 **APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO STRIKE OPPOSER'S REPLY BRIEF** and **APPLICANT'S OPPOSITION TO OPPOSER'S CROSS MOTION FOR LEAVE TO FILE A SUBSTITUTE REPLY BRIEF** was served by Express Mail, postage prepaid, on Opposer's attorney, Scott J. Garber, Jr., Howrey Simon Arnold & White, LLP, 750 Bering Drive, Houston, TX 77057, on this 3<sup>rd</sup> day of May 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