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Ref. No. 2778-157

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Commissioner for Trademarks
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



03-06-2006

U.S. Patent & TMO/TM Mail Rcpt DL #11

Re: *American Italian Pasta Company v. Barilla G.E.R. Fratelli-Societa Per Azioni*
Opposition No. 91161373

Dear Sirs:

We enclose for filing Applicant's Reply Brief.

We believe that no fee is necessary. The Commissioner for Trademarks is hereby authorized to draw on the deposit account of Rothwell, Figg, Ernst & Manbeck, Account No. 02-2135, for any fee deemed necessary.

Respectfully submitted,

Carla C. Calcagno

CCC/jea
Enclosure

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

American Italian Pasta Company)

Opposer,)

v.)

Barilla G. E R. Fratelli-Società Per Azioni)

By change of name),)

Applicant.)

OPPOSITION NO. 91161373



03-06-2006

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APPLICANT'S REPLY BRIEF

Introduction

On February 3, 2006, Applicant filed a Request for Correction. This Request for Correction was very clear. It succinctly asked the Board to correct a clerical error in its January 4, 2006 Order granting Applicant's December 30, 2005 Consented Motion to Extend.

In response, rather than addressing the Request for Correction, Opposer's brief spends most of its time arguing the merits of another motion – Applicant's Contested November 1, 2005 Motion to Extend, which motion already was fully briefed.

Applicant files this brief response to Opposer's February 13, 2006 response for two reasons. First, Applicant wishes to clarify that the Consented Motion, filed December 30, 2005, related to testimony periods only. Second, the Board should give no consideration to Opposer's brief to the extent it re-argues the merits of Applicant's November 1, 2005 Contested Motion.

I. The December 30, 2005 Consented Motion To Extend Related to Testimony Periods Only

Unequivocally, the December 30, 2005 Consented Motion to Extend was meant to extend the testimony periods only. By its plain language, the Consented Motion related only to the parties' testimony periods. Further, the email correspondence between the parties fully supports the Consented Motion's plain language. See Exhibit A, consisting of copies of relevant portions of emails between counsel which led to the motion's filing. Counsel filed this motion only to allow them time before trial to resolve issues relating to discovery responses that were not the subject of the contested November 1, 2005 Motion to Extend the Discovery Period.


II. The Board Should Give No Consideration to Opposer's February 13, 2006 Brief to the Extent It Re-Argues the Merits of the November 1, 2005 Motion to Extend Discovery Periods

The Contested Motion to Extend the Discovery Period, filed November 1, 2005, is still pending, is disputed and was fully briefed by the parties on November 28, 2005. Nonetheless, in direct and clear violation of the Board's rules, Opposer, on December 12, 2005, filed a surreply and now seeks to get another bite at arguing that motion. Both the surreply and the entire contents of Opposer's February 13, 2006 brief -- to the extent it reargues the November 1, 2005

motion to extend ---should be given no consideration.¹

Respectfully submitted,

Barilla G. E R. Fratelli -
Società Per Azioni

By 

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¹ Based on its understanding that the Board would *sua sponte* refuse to consider the improper December 12, 2005 filing, Applicant did not previously move to strike the December 12, 2005 sur-reply. However, in the light of Opposer's further submissions on this issue, Applicant respectfully requests that the Board strike and refuse to consider each of these improper filings.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S REPLY BRIEF** was served via first-class mail, in a postage prepaid envelope, on counsel for Opposer as follows:

Thomas H. Van Hoozer, Esq.
Law Offices of Hovey Williams LLP
2405 Grand Boulevard
Suite 400
Kansas City, Mo. 64108-2519

This 6th day of March, 2006.


Joan Adair

EXHIBIT

A

Carla C. Calcagno

From: Cheryl Burbach [clb@hoveywilliams.com]
Sent: Friday, December 30, 2005 9:41 AM
To: Carla C. Calcagno
Cc: Tom Van Hoozer; Matthew Felten; Shantanu Sood
Subject: RE: Discovery responses

Carla,

Thanks for your messages. We do consent to a motion to extend the testimony periods by 30 days. We understand that you will prepare and file the motion.

With regard to the remaining issues, would it be possible to schedule a telephone call with you on Tuesday? Our office is closed Monday, and I am largely unavailable today. I am available to speak any time on Tuesday.

Cheryl Burbach
Hovey Williams LLP
2405 Grand Boulevard, Suite 400
Kansas City, MO 64108

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From: Carla C. Calcagno [mailto:ccalcagno@rothwellfigg.com]
Sent: Thursday, December 29, 2005 5:09 PM
To: Cheryl Burbach
Cc: Tom Van Hoozer; Matthew Felten; Shantanu Sood
Subject: RE: Discovery responses

Cheryl,

Thank you for your voice mail. I left one for you but thought I would send this email message in case you are a bit swamped. As I understand it from your voice mail, AIPC is agreeable to the motion below. In other words, we would be filing a consented motion to extend such that AIPCs 30 day testimony period as plaintiff in the case would close on March 2, 2006 and remaining dates would be reset accordingly. I will be happy to draft and file that motion tomorrow. Let me know if that is Ok. Also I look forward to speaking with you regarding the dates for serving the agreed new responses and language as well as setting up a time when we could discuss resolving some remaining discovery issues.

Carla