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

Proceeding	91177828
Party	Plaintiff SNOCAP, INC.
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/Martin R Greenstein/
Martin R. Greenstein

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

SNOCAP, INC.,

Opposer,

v.

TODD MEAGHER,

Applicant.

Consolidated Oppositions

Opposition No.: 91-177,827

Trademark: MYSTORE

Appln No. 78/853,849

And

Opposition No.: 91-177,828

Trademark: MYSTORE.COM

Appln No. 78/853,866

OPPOSER’S REPLY TO APPLICANT’S RESPONSE TO
OPPOSER’S MOTION TO STRIKE PORTIONS OF
APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES

Opposer, Snocap, Inc., submits this brief Reply to Applicant’s Response to Opposer’s Motion to Strike Portions of Applicant’s Answer and Affirmative Defenses in each opposition (which should now be consolidated by virtue of Applicant’s unopposed Motion to Consolidate).

Motion to Strike Paragraphs 14 and 15:

Applicant argues that these paragraphs “contain public record evidence from the records of the U.S. Patent and Trademark Office”. If true (as Applicant argues), evidence should not be part of a pleading and should be stricken for that reason. Moreover, this is not even admissible “evidence” but rather an apparent proffer of evidence Applicant believes it will be entitled to introduce later, and should be stricken for that reason as well. In *McCormick & Co. v. Hygrade*

Products Corp., 124 U.S.P.Q. 16 (TTAB 1959) the TTAB held that “while applicant may in due course introduce any evidence which it considers relevant to its case, statements as to proposed evidence are not proper matters for pleading in answer to opposition; hence, listing of third party registrations and users of mark is stricken on motion”. Thus Paragraphs 14 and 15 of Applicant’s Answers should be stricken since they contain - by Applicant’s own admission - a mere listing of third party registrations which Applicant hopes to put into evidence.

Finally, Applicant’s argument based on *Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371 (TTAB 1991) simply makes no sense. Here Applicant Meagher does not currently own and has never previously owned a Federal registration for the same mark as the one opposed. Moreover, Applicant cannot rationally argue that Opposer would/could somehow be guilty of laches for not opposing a descriptive use (by an unrelated third party in this case) that occurred a decade or more before Opposer even came into existence. Laches requires some knowing failure to act - clearly an impossible standard to meet as applied to an event which long predated not only Opposer’s decision to use the descriptive phrase in question, but which long predated Opposer’s very existence. As to Applicant’s applications and any possible claim of laches as to those, the applications are based on bona fide Intent to Use (ITU), and were opposed when published. There can be no laches as to an ITU application under such circumstances - there is no action that can be taken until the mark is published.

Motion to Strike Paragraphs 18 - 20:

Applicant objects to the motion to strike paragraphs 18 - 20 on the grounds, *inter alia*, that the cited decision (*DuPont de Nemours v duPont Publishing*) is “not precedential”. Per the Board’s recent revised rules, all Board decisions may now be cited, even those previously noted as not precedential. That the decision was in a case based on likelihood of confusion, or that it followed discovery and testimony, does not in any way detract from its relevancy and

applicability on a motion to strike in this case. As with laches, there can be no estoppel or acquiescence as against an ITU application that is opposed on publication - there is no earlier opportunity to challenge such an application except by opposition.

Motion to Strike Paragraphs 22 and 23:

Applicant apparently argues that its Affirmative Defenses in paragraphs 22 and 23 are proper “so that, after discovery it is not barred from making such a defense if the facts discovered support such a defense”. Applicant is essentially conceding that he has no evidence or basis whatsoever for raising the affirmative defenses in paragraphs 22 and 23 and does so only on the hope that he may later be able to support them after discovery.

As to Applicant’s argument that Opposer lacks standing because Opposer doesn’t have “a competitive need or equal right” to use the phrase Applicant considers its mark, that standard is sometimes raised to support standing for descriptive use when there is, in fact, no such descriptive use. Here, Opposer is already using the phrase descriptively, so the issue of whether Opposer “has a competitive need” is quite moot. Opposer has no idea from where Applicant gets the supposed test of “equal right” - there is no citation and no explanation, and Opposer is not aware of any test or standard of descriptiveness which requires a finding of “equal right” to use a term in a descriptive manner.

Applicant’s attack on *James River Petroleum v Petro Shopping Centers* as “non-precedential” is similarly flawed - under current TTAB rules all decisions are precedential. The fact that it involves a case based in part on likelihood of confusion has no bearing on the motion to strike issues, and neither does the fact that the decision followed cross Motions for Summary Judgment. The same is true of Applicant’s attempt to distinguish or attack *Interpayment Services v. Docters & Thiede*.

CONCLUSION

Section 506.01 of the Trademark Board Manual of Procedure states that "... the Board grants motions to strike in appropriate cases". Opposer submits that the circumstances in this matter present an "appropriate case" within the meaning of Section 506.01 and that the Motion to Strike should be granted in its entirety.

For the foregoing reasons and the reasons explained in Opposer's Motion to Strike, Paragraphs 14, 15, 18-20 22 and 23 of Applicant's Answer and Affirmative Defenses (in each opposition) should be stricken.

September 18, 2007

Respectfully submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE PORTIONS OF APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES is being served on September 18, 2007, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to:

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