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Filing date: **11/16/2007**

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

| | |
|---------------------------|--|
| Proceeding | 91179911 |
| Party | Defendant Sporting Goods Intelligence, Inc. |
| Correspondence Address | Richard S. Schurin Gottlieb, Rackman & Reisman, P.C. 270 Madison Avenue New York, NY 10016 UNITED STATES |
| Submission | Other Motions/Papers |
| Filer's Name | Richard S. Schurin |
| Filer's e-mail | rschurin@grr.com |
| Signature | /Richard S. Schurin/ |
| Date | 11/16/2007 |
| Attachments | Reply - Motion to Suspend - 11-15.pdf (7 pages)(133060 bytes) |

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

| | | |
|------------------------------------|---|-------------------------|
| Formula4Media, LLC, |) | |
| |) | |
| Opposer, |) | Opposition No. 91180049 |
| |) | Serial No. 78/958601 |
| v. |) | |
| |) | MARK: SGI THE MAGAZINE |
| Sporting Goods Intelligence, Inc., |) | |
| |) | |
| Applicant. |) | |
| ----- |) | |
| Formula4Media, LLC, |) | |
| |) | |
| Opposer, |) | Opposition No. 91179911 |
| |) | Serial No. 77/026,496 |
| vi. |) | |
| |) | |
| Sporting Goods Intelligence, Inc., |) | MARK: SGI |
| |) | |
| Applicant. |) | |
| ----- |) | |

**APPLICANT'S REPLY MEMORANDUM IN FURTHER SUPPORT OF MOTION
TO SUSPEND**

Pursuant to 37 C.F.R. §2.127(a) and TBMP § 502.02(b), Applicant Sporting Good Intelligence, Inc. ("SGI"), submits this Memorandum in Reply to the Opposition filed by Opposer Formula4Media, LLC ("F4M").

ARGUMENT

The arguments offered by F4M in opposition to SGI's Motion to Suspend are both factually incorrect and legally meritless.

F4M's first argument -- that SGI filed its applications after requesting that the Arbitrator determine ownership of the same marks -- is false and legally

irrelevant to this Motion to Suspend. In fact, SGI's arbitration demand is for the collection of unpaid royalties, and F4M thereafter asserted a counterclaim challenging the SGI's ownership of the licensed marks. (See, Exhibit A - SGI's Demand for Arbitration and F4M's Counter-Demand).¹ Moreover, the issue of who first raised the ownership issue in Arbitration is of absolutely no relevance to this Motion to Suspend. Rather, the fact that is relevant to this Motion, is that the Arbitration will be deciding trademark ownership and perhaps other issues such as whether under Section 2.03 of the License Agreement, F4M even has the right to challenge SGI's applications – and that the Arbitration decision will assuredly “have a bearing on the issues before the Board.” (TBMP §510.02(a)).

The fact that the Arbitration will be deciding all of these issues has now been further confirmed, since on October 29, 2007 the State Court in New York dismissed all of F4M's claims in that action in favor of the Arbitration. A copy of this decision is attached hereto as Exhibit D. Accordingly, all issues relevant to matters relating to these marks will be decided in the Arbitration.

F4M's second argument – that SGI has never used nor does it own the trademarks at issue - is equally false and irrelevant to this Motion to Suspend.

¹ Of course, there is no real issue of ownership of these marks since F4M acknowledges SGI's ownership rights in the License Agreement. (See, Exhibit B – License Agreement) Specifically, Section 2.03 of the License Agreement provides, in pertinent part, as follows:

“SGI retains ownership of the Trademark. F4M acknowledges SGI's exclusive right, title and interest in and to the Trademark and any registrations that have issued or may issue thereon, and will not at any time do or cause to be done any act of this contesting or in any way impairing or tending to impair part of such right, title and interest. “

Section 2.03 of Exhibit A.

Obviously, F4M's licensed use inured to the benefit of SGI, and testimony of Applicant's principal in the Arbitration to that effect is irrelevant to this Motion to Suspend. Once again, this entire "issue" has absolutely no relevance to this Motion to Suspend, which has as its nexus the prior pendency of another proceeding where many of the same issues are already being litigated.

F4M's final argument – that SGI has waived its Right to Arbitrate – is once again misleading, false and irrelevant to this Motion to Suspend. This argument is misleading and false because F4M fails to inform the Board that this was already rejected in Arbitration. Specifically, in a decision of the Arbitrator dated August 29, 2007 on SGI's Motion to Dismiss, a copy of which is included as part of Exhibit C, the Arbitrator rejected F4M's theory. In her decision, the Arbitrator specifically found that SGI's filings of trademark Oppositions in the TTAB were in response to the illicit actions of F4M, and were taken to preserve the status quo, and that accordingly, there was no waiver of Arbitration. Once again, this issue, and F4M's efforts to now "appeal" the Arbitrator's decision in this forum are simply irrelevant to this Motion to Suspend.

CONCLUSION

As discussed herein, all of F4M's arguments in opposition to SGI's Motion to Suspend are without merit. Therefore, and for the reasons stated herein and

in SGI's prior Motion papers, SGI's Motion to Suspend these proceedings pending the final determination of ownership should be granted.

Respectfully submitted,
GOTTLIEB, BACKMAN & REISMAN P.C.

Dated: November 15, 2007




Richard S. Schurin
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(212) 684-3900
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Reply n Further Support of Motion to Suspend, was served on Philip Weiss, Esq., Opposer's counsel of record on November 15, 2007, via first class mail, postage prepaid, addressed as follows:

Philip Weiss
Weiss & Weiss
300 Old Country Road, Suite 251
Mineola, N.Y. 11501

Dated: November 15, 2007
New York, New York



R. SCHURIN

EXHIBIT D

SHORT FORM ORDER

**SUPREME COURT - STATE OF NEW YORK
COUNTY OF NASSAU**

PRESENT:

HON. IRA B. WARSHAWSKY,

Justice.

TRIAL/IAS PART 12

**FORMULA 4 MEDIA LLC, MARK SULLIVAN,
JEFF NOTT, TROY LEONARD and JEFF GRUENHUT,**

Plaintiffs,

INDEX NO.: 013825/2007
MOTION DATE: 09/18/2007
MOTION SEQUENCE: 001

-against-

**JOHN HORAN and SPORTING GOODS
INTELLIGENCE, INC.,**

X X X

Defendant.

The following papers read on this motion:

| | |
|---|---|
| Order to Show Cause, Affirmation, Affidavit & Exhibits Annexed..... | 1 |
| Affirmation of Catherine B. Silliman Pursuant to the Rules of the Commercial Division..... | 2 |
| Affirmation of Catherine B. Silliman for Assignment to Commercial Division & Exhibit Annexed..... | 3 |
| Affirmation in Opposition of Richard S. Schurin..... | 4 |
| Reply Affirmation in Support of Catherine B. Silliman..... | 5 |

This motion by plaintiff for an order staying arbitration before the American Arbitration Association under File No.: 18 133 01172 06 is denied. This court has no authority to review the procedural elements of a claim already submitted to arbitration, with the exception of questions of limitation of time or for preliminary injunctive relief, or to pass upon the merits. CPLR §§ 7501, 7502 (b) and (c); Susquehanna Valley Central School District v. Susquehanna Valley Teachers' Assoc., 101 A.D2d 933 (3d Dept. 1984).

Accordingly, the action is dismissed.

Dated: October 29, 2007



J.S.C.

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SHORT FORM ORDER

**SUPREME COURT - STATE OF NEW YORK
COUNTY OF NASSAU**

PRESENT:

HON. IRA B. WARSHAWSKY,

Justice.

TRIAL/IAS PART 12

**FORMULA 4 MEDIA LLC, MARK SULLIVAN,
JEFF NOTT, TROY LEONARD and JEFF GRUENHUT,**

Plaintiffs,

**INDEX NO.: 013825/2007
MOTION DATE: 10/05/2007
MOTION SEQUENCE: 002**

-against-

**JOHN HORAN and SPORTING GOODS
INTELLIGENCE, INC.,**

X X X

Defendants.

The following papers read on this motion:

| | |
|---|---|
| Notice of Motion, Memorandum of Law, Affirmation & Exhibits Annexed..... | 1 |
| Affirmation in Opposition of Catherine B. Silliman & Exhibits Annexed..... | 2 |
| Affirmation in Reply of Richard S. Schurin & Exhibits Annexed..... | 3 |
| Supplemental Opposition of Catherine B. Silliman..... | 4 |
| Affirmation of Philip Weiss in Support of Plaintiffs' Opposition to Defendants' | |
| Motion to Dismiss..... | 5 |

This motion by defendants for an order dismissing the complaint is denied as moot. See Order dated October 29, 2007 (denying plaintiffs' application to stay arbitration and dismissing the claim).

Dated: November 1, 2007



J.S.C.

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