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

Proceeding	91183799
Party	Plaintiff Pure Entertainment, LLC
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Submission	Reply in Support of Motion
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Date	12/11/2009
Attachments	Resp. and Reply in Support of Motion to Strike.pdf (8 pages)(692487 bytes)

motion for summary judgment because the applicant's brief "exceed[ed] the page limits set forth in Trademark Rule 2.127(a)." *Id.* at *7 n.3. Further, the Board did not allow its disregard of the applicant's brief to preclude its consideration of the opposer's summary judgment motion on the merits, ultimately deciding that summary judgment on the opposer's claims of priority of use based on its common law rights and likelihood of confusion should be granted. *Id.* at *7.

In deciding to disregard the applicant's brief in *Boucheron*, the Board relied upon *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing, Co.*, 66 USPQ2d 1220 (TTAB 2003), another one of its opinions "citable as precedent." In *Saint-Gobain Corp.*, the Board chose not to give consideration to the opposer's brief in support of its motion for summary judgment and the applicant's brief in opposition because both exceeded the twenty-five page limit mandated by Rule 2.127(a). Both parties had included with their briefs a table of contents and indexes of cases and authorities that pushed the briefs over twenty-five pages. The Board found the briefs "procedurally improper and in violation of Board rules," explaining that "should a party elect to include such information in its brief, the additional pages are considered in the page count." *Id.* at *2, *3. *Accord*, *Cooper Tech. Co. v. Denier Elec. Co., Inc.*, 89 USPQ2d 1478 (TTAB Dec. 17, 2008) (holding same); *Hertz Tech., Inc. v. Nuhertz Tech., LLC*, 2002 WL 31536508 (TTAB) (declining consideration of motion for summary judgment because its excessive page length did not comply with Rule 2.127(a); "The Board will not consider motions that are not in compliance with the rules"). The Board emphasized in *Saint-Gobain Corp.* that, although "neither party objected to the excessive length of its adversary's brief," "[t]his [page] limitation cannot be waived by action, inaction or consent of the parties." *Saint-Gobain Corp.*, 66 USPQ2d at *2. *Accord*, *Cooper Tech. Co.*, 89 USPQ2d at *2.

Applicant cites no "citable as precedent" Board decision that supports its request for leave to "re-submit" its Memorandum of Law. The opinions referenced above, which opinions are binding on the Board, refuse to consider briefs exceeding the Rule 2.127(a) page limit and do not mention, much less permit, the submission of an amended brief to remedy a party's non-compliance. These opinions also do not establish any exceptions to the page limit requirement, which is what Applicant argues here in

asserting “clerical error” and “oversight” as its excuses for violating Rule 2.127(a).

While Applicant urges the Board to view the non-binding opinions upon which it relies “for whatever persuasive value [they] may have,” the facts in those proffered cases are easily distinguishable, contrary to Applicant’s assertion that they are “virtually identical” to facts in the instant case. Two of those cases involved situations where both parties violated the page limitations of Rule 2.127(a) with respect to summary judgment pleadings, whereas here it is only Applicant. *See Wisconsin Ducks, Inc. v. Boston Duck Tours*, 2001 TTAB LEXIS 482, at *1 n1 (TTAB June 22, 2001); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 2003 TTAB LEXIS 98, at *11 (TTAB Mar. 7, 2003). In *Carefirst of Maryland*, both non-conforming briefs were stricken, but the opposer’s non-compliant substitute brief was allowed because a cover page had been included in the original brief, causing the page limit to be exceeded by one page, and because the caption and proceeding number on the cover page could have been moved to the top of the brief’s first page—which is not the case here. In the third non-citable case, the applicant was permitted to file a substitute brief in response to the summary judgment motion only because the opposer’s reply brief did not constitute a substantive response in that it consisted solely of an objection to the applicant’s non-compliance with the page limitations.³ *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 2006 TTAB LEXUS 467, at *4-*5. Not one of the non-binding cases cited by Applicant mentions Applicant’s excuses of “clerical error” or “oversight.”

In contrast to *Wisconsin Ducks* and *Carefirst of Maryland*, only Applicant has failed to comply with Rule 2.127(a)’s page requirements after having ample time and the benefit of multiple extensions to do so. And, Opposer, unlike the party in *Stuart Spector Designs*, has already filed a substantive reply to Applicant’s summary judgment response. Nothing in the non-binding opinions on which Applicant relies supports the Board granting Applicant leave to file an amended responsive brief. As discussed above, the Board’s binding precedent precludes such. Allowing a party such as Applicant to submit an amended

³ Because its initial response was perfunctory, the Board also allowed the opposer an additional twenty days in which to file a substitute brief in reply to the applicant’s substituted response. *Stuart Spector Designs*, 2006 TTAB LEXUS 467, at *4.

brief would effectively negate Rule 2.127(a), and encourage future parties to disregard, or otherwise take lightly, Rule 2.127(a)'s requirements, knowing that their non-compliance risks little since they will be permitted to file an amended brief. Such a result would not only be contrary to the Board's reasons for adopting Rule 2.127(a) but would also be patently unfair to all parties who heed its restrictions.

One final matter bears mentioning. Applicant's request for leave to "re-submit" its Memorandum of Law concedes that it and its Cross-Motion for Summary Judgment involve the same issues as those raised in Opposer's Motion for Summary Judgment. Applicant asserts no counterclaim in these proceedings, *see Cooper Tech. Co.*, 89 USPQ2d 1478 at *3 n.2, and Applicant's purported Cross-Motion for Summary Judgment merely responds to Opposer's summary judgment assertions that Opposer has priority of use and continuously used its mark in commerce since 1999, that likelihood of confusion exists between Opposer's mark and Applicant's marks, and that Applicant has committed fraud on the Trademark Office. Applicant has repeatedly used the tactic of filing a pleading titled a "cross-motion" in response to a motion filed by Opposer that concerns the same issues. This tactic appears also to be used by Applicant to give itself the benefit of the final word by manufacturing opportunities to submit replies in support of its purported cross-motions. The tactic has needlessly multiplied the number of pleadings associated with each motion and prolonged these proceedings. Opposer objects to every reply Applicant has filed using this tactic, all of which should be ignored, including (i) any reply Applicant may file to the purported "cross-motion" addressed by Opposer herein and (ii) Applicant's Reply Memorandum and its exhibits in support of Applicant's Cross-Motion for Summary Judgment, which Reply Memorandum should be disregarded for the additional reason that it essentially restates the arguments in its initial brief. *See Wiscon Corp. v. ACH Food Co.*, 2004 WL 2921817, at *8 & n.18 (TTAB Dec. 15, 2004) ("Reply briefs are not to be used as a reargument of points made in the main brief," citing TBMP § 502.02(b) (2nd ed. Rev. 2004)).

Applicant has failed to proffer a legitimate legal or factual basis to prevent its Memorandum of Law from being stricken or to justify Applicant being granted leave to submit an amended brief.

II. The Declaration and Affirmation of Opposer's Counsel Should Be Stricken.

Applicant does not dispute that the statements in the Affirmation and Declaration of its counsel render its attorneys witnesses in these proceedings. It contends, however, that such statements qualify as exceptions to Rule 10.63's prohibition against an attorney representing a client before the Board and also acting as a witness on that client's behalf. The two exceptions Applicant argues—that its counsel's testimony relates solely to (1) an uncontested matter and (2) a matter of formality where there is no reason to believe that substantial evidence will be offered in opposition to such testimony, *see* Rule 10.62(b)(1) & (2)—are not applicable here.

As it concerns the photographs Sussmane took of Opposer's San Francisco establishment during "his personal inspection," Opposer does indeed contest the accuracy of the images portrayed, as evidenced on page 8 of Opposer's Reply in support of summary judgment. Opposer has offered its own photographs in opposition to Sussmane's inaccurate images. *See* Reply in Support of Summary Judgment at Exhibit A (Supp. Paine Decl.), at ¶¶ 6-7 & Exs. 14 and 15; *id.* at Exhibit C (Cood Decl.), at Exs. 1 & 2. One wonders why Sussmane interjected himself as a witness in this manner when others, such as Mr. Fenech, were apparently available to inspect and take photographs of Opposer's premises and, according to Applicant, were retained by Applicant to do so.⁴ Additionally, Opposer has generally objected in its Motion to Strike to the opinionated testimony and conclusions offered by Sussmane in his Affirmation.

Opposer also adamantly disputes in its summary judgment motion Sussmane's bald, unsupported conclusion that Opposer has abandoned its mark, which is an issue to be ultimately determined by the Board and not by Sussmane, who is clearly biased on the subject. *See In re Gray, Inc.*, 3 USPQ2d 1558 (TTAB 1987) (giving counsel's affidavit "no probative value whatsoever" because, among other things, "the Board is charged with the responsibility of making an independent determination of the ultimate issue" and "giv[ing] weight to counsel's affidavit would have the effect of substituting the opinion of the

⁴ Sussmane also fails to explain why his photographs mysteriously fail to reflect Opposer's prominent use of its BUTTER mark on exterior signage plainly visible in all other photographs, including (albeit darkly) in those of Applicant's newly-found photographer.

affiant for those of the Board members assigned to hear the case,” and because it would be “subject to an incredible amount of bias”). Further, Opposer takes issue with Sussmane’s statements that Opposer’s mark was not used on its premises, clear evidence of which use has also been submitted by Opposer. *See, e.g.,* Reply in Support of Summary Judgment at Exhibit A (Supp. Paine Decl.), at ¶¶ 6-7 & Exs. 14 and 15; *id.* at Exhibit C (Cood Decl.), at Exs. 1 & 2.

With respect to Sussmane’s role in Applicant’s “previous defense of its trademark as well as the series of events leading up to the initiation of this action,” Applicant similarly cannot deny that such transforms Sussmane into a witness, particularly where a non-attorney representative of Applicant, who would unquestionably be a witness, could have just as easily offered testimony about the topic instead of Sussmane. Opposer’s request to strike this testimony itself demonstrates its contested nature.

The same is true for Spierer’s Declaration as it pertains to Applicant’s defense of its mark and Spierer’s claimed “due diligence.” Spierer’s statements regarding “due diligence” are indisputably contested by Opposer, and Opposer has offered an abundance of evidence questioning the fact, extent and adequacy of any “due diligence” by Applicant relevant to the instant case. *See* Reply in Support of Summary Judgment at 2-3; *id.* at Exhibit A, at ¶¶ 11-12 & Exs. 21 and 22. *See also* Opposer’s Response to Applicant’s Request for Rule 56(f) Continuance, at ¶ 14; Motion for Summary Judgment at 21-22 & Ex. 2. Applicant does not dispute that Spierer was not admitted to practice law when he purportedly conducted much of this supposed due diligence, but Applicant fails to explain why it and Spierer present Spierer’s testimony on that topic in Spierer’s capacity as an attorney for Applicant. *See* Cross-Motion for Summary Judgment at Exhibit 2 (Spierer Decl.), at ¶ 1. Applicant is now apparently attempting to backtrack by characterizing Spierer’s services as his “personal actions” without any further explanation of why or in what capacity Spierer would have been conducting such due diligence in the first place. Spierer previously offered testimony regarding his due diligence in his capacity as an attorney for Applicant in the Affidavit of Craig M. Spierer for Continuance to Conduct Discovery Pursuant to FRCP §56(f) on file in this proceeding.

Even if Sussmane and Spierer may have personal knowledge of the matters in their respective

Affirmation and Declaration, the fact remains that they occupy the role of witnesses since Applicant relies upon their statements and knowledge on issues in this proceeding. Applicant had a choice to make—either to agree that any statements in its attorneys’ Affirmation and Declaration beyond those merely authenticating the exhibits should be given no consideration or to concede that its counsel should be required to withdraw. Since Applicant’s counsel has not yet withdrawn, Applicant has necessarily chosen to have the Board disregard the statements in Sussmane’s Affirmation and Spierer’s Declaration, and it would be improper for the Board to give them any weight. *See In re Gray*, 3 USPQ2d 1558 (“As counsel here has not withdrawn [as required by 37 CFR §10.63], it would be improper for us to give any weight to his affidavit”).

III. All Statements In The Declaration Of Robert Fenech Beyond Those Authenticating Documents Should Be Disregarded.

Robert Fenech indisputably has not been identified by Applicant as a witness in these proceedings; therefore, all statements in his Declaration beyond those authenticating the photographs attached to it should be disregarded. Opposer does not dispute the accuracy of the first photograph attached to Fenech’s Declaration, which, unlike Sussmane’s photographs, contains a clear and correct depiction of Opposer’s exterior sign. However, because the images in the remaining pictures attached to Fenech’s Declaration are too dark to determine whether they are accurate, Opposer reserves the right to dispute them should legible copies be provided. Further, Fenech’s photographs were taken on November 16, 2009, long after the October 16, 2009 due date of Applicant’s response to Opposer’s summary judgment motion and, for the reasons discussed above, the photographs should not be permitted because they are part of an impermissible reply pleading.⁵

For all of the reasons set forth above and in Opposer’s Motion to Strike, Opposer requests that its Motion to Strike be granted, and that Applicant’s Cross-Motion for Leave to Re-Submit be denied, along

⁵ Fenech’s Declaration and photographs are also utterly irrelevant to Applicant’s response to Opposer’s Motion to Strike (except for perhaps serving as an implicit confession by Applicant that Sussmane’s photographs are inaccurate and they serve to make Sussmane a witness due to his commentary about them) and should be ignored in connection with its adjudication.

with all other relief deemed appropriate.

Respectfully submitted,

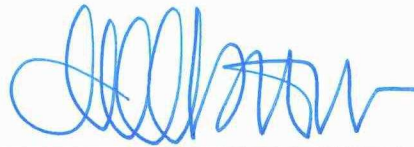
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CERTIFICATE OF SERVICE

I hereby certify and declare under penalty of perjury that I served a true and correct copy of this document upon counsel for Applicant Butter Licensing, LLC, by depositing such copy with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Kenneth Sussmane, Keith Sklar, Craig Spierer, McCue Sussmane & Zapfel, P.C., 521 5th Avenue, 28th Floor, New York, New York 10175-2199, on the 11th day of December, 2009.



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