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

Proceeding	91219067
Party	Defendant Jersey Boardwalk Franchising Co., Inc.
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NEW JERSEY TURNPIKE
AUTHORITY,

Opposer,

v.

JERSEY BOARDWALK FRANCHISING
CO., INC.

Applicant.

Opposition No. 91219067 (parent)

Application No. 86/268,185

NEW JERSEY TURNPIKE
AUTHORITY,

Petitioner,

v.

BOARDWALK PIZZA, INC.,

Registrant/Respondent.

Cancellation No. 92059657

Registration No. 4,056,183

Issued on November 15, 2011

**JERSEY BOARDWALK FRANCHISING CO., INC. AND BOARDWALK PIZZA,
INC.'S OPPOSITION TO NEW JERSEY TURNPIKE AUTHORITY'S MOTION TO
STRIKE EXHIBITS 2-10 OF JERSEY BOARDWALK FRANCHISING CO., INC. AND
BOARDWALK PIZZA, INC.'S NOTICE OF RELIANCE**

Applicant and Registrant/Respondent, Jersey Boardwalk Franchising Co., Inc. and Boardwalk Pizza, Inc. ("Jersey Boardwalk" or "Defendants"), by and through their attorneys, hereby submit their Opposition to New Jersey Turnpike Authority's Motion to Strike Exhibits 2-10 of Respondent's Notice of Reliance. Defendants' Notice of Reliance properly complies with the procedural requirements of the Rules of Practice in Trademark Cases and as such the exhibits identified therein are admissible.

ARGUMENT

I. Defendants' Exhibits 5 and 6

Under the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 704.07, "[a] party that wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period." Defendants' Exhibit 5, a copy of The Opinion of William J. Martini granting Defendants' Motion to Dismiss, and Defendants' Exhibit 6, the Order granting Defendants' Motion to Dismiss and dismissing Plaintiff's Complaint for lack of personal jurisdiction, both constitute "official records" and are therefore admissible.

In *Safer Inc. v. OMS Investments Inc.*, in holding that a document obtained from the Internet may be admitted into evidence pursuant to a Notice of Reliance, the Board specifically indicated that its own "Office[] files are in electronic form and accessible to all via the Internet, and to that extent they are both *official records* and in general circulation." 94 USPQ2d 1031, 1038 (TTAB 2010) (emphasis added); *see also Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000) (copy of Board's decision on summary judgment in prior opposition admissible under Notice of Reliance). As Plaintiffs indicate in their Motion to Strike, the Opinion and Order that Defendants submit as Exhibits 5 and 6 of their Notice of Reliance were previously submitted to the Board in response to the Board's request. These records are publicly available on the Board's website at Proceeding No. 92059657 TTABVUE Document No. 24. (See Plaintiff's Motion to Strike Exhibits 2-10 of Jersey Boardwalk's Notice of Reliance, p. 3, f.n. 1). Thus, as official Board records publicly available on the Internet,

Defendants' Exhibits 5 and 6 constitute official records and are properly submitted under Defendants' Notice of Reliance.¹

II. Exhibits 7 and 8

Defendants' Exhibits 7 and 8 are transcript excerpts and exhibits from the trial testimony of James O'Hern, Chief Operating Officer and Deputy Executive Director of NJTA. These transcripts and exhibits are properly submitted under Defendants' Notice of Reliance pursuant to TBMP § 704.13: "Testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material . . . The purpose of the rule is to offer a party a means for introducing testimony from a prior proceeding without having to call a witness to authenticate the testimony." Mr. O'Hern's trial testimony was given in a related suit between the same parties. As described in detail in Defendants' Notice of Reliance, this testimony and the exhibits thereto are relevant to a variety of issues surrounding the claim.

Plaintiffs argue that this evidence is duplicative. Plaintiff's argument is misguided. The Board disfavors the introduction of cumulative and irrelevant evidence because such evidence "impedes the orderly administration of the case, and obscures the impact of truly relevant evidence." TBMP § 702.05 (2016). By calling the Board's attention to specific exhibits and excerpts from Mr. O'Hern's testimony, Defendants aim to assist the Board in reviewing the

¹ Jersey Boardwalk's Notice of Reliance Exhibit 2 (Defendant's Memorandum of Law in Support of Motion to Dismiss Complaint Pursuant to Fed. R. Civ. P. 12(b)(1) for Lack of Subject Matter Jurisdiction, Fed. R. Civ. P. 12(b)(2) for Lack of Personal Jurisdiction and Fed. R. Civ. P. 12(b)(6) for Failure to State a Claim Upon Which Relief May Be Granted); Exhibit 3 (Plaintiff's Memorandum of Law in Opposition to Defendants' Motion to Dismiss); and Exhibit 4 (Defendant's Reply Memorandum of Law in Further Support of Motion to Dismiss Complaint Pursuant to Fed. R. Civ. P. 12(b)(1) for Lack of Subject Matter Jurisdiction, Fed. R. Civ. P. 12(b)(2) for Lack of Personal Jurisdiction and Fed. R. Civ. P. 12(b)(6) for Failure to State a Claim Upon Which Relief May Be Granted) are respectfully submitted to the Board merely for the purpose of providing context to the Opinion and Order included as Exhibits 5 and 6 of the Notice of Reliance.

relevant evidence in an efficient manner by sparing the panel the arduous task of reviewing the entire transcript in search of the relevant excerpts. To the extent that the Board deems Defendants' Exhibits 7 and 8 as improperly duplicative, the Board may review the full transcript of Mr. O'Hern's testimony, which was submitted to the Board in connection with NJTA's case in chief, as required by 37 C.F.R. § 2.123(h).

III. Exhibits 9 and 10

Exhibits 9 and 10 are excerpts from the discovery depositions of Jersey Boardwalk officers Paul DiMatteo and Lauren Parratt. Where a party offers into evidence the discovery deposition of an adverse party, the opposing party may introduce under a Notice of Reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. 37 C.F.R § 2.120(j)(4); TBMP § 704.09. This is precisely the nature of Jersey Boardwalk's submissions here.

In Plaintiff's Notice of Reliance, submitted on July 21, 2016, NJTA submits as Exhibit 10 excerpts from the Oct. 21, 2015 discovery deposition of Jersey Boardwalk C.E.O. Paul DiMatteo. The deposition excerpts that NJTA submits create the misleading impression that Mr. DiMatteo deliberately coopted the NJTA logo. For example, NJTA's exhibit includes the presumptive statement, "So now that we have established that you have infringed our client's marks, we can proceed with the deposition," and boldly redacts the witness's response. This is precisely the misleading type of excerpt that the Board's rules, as well as basic notions of fairness, allow the opposing party to rebut by submitting additional discovery deposition testimony through its Notice of Reliance.

The excerpts that Jersey Boardwalk submits directly rebut the mischaracterization that Mr. DiMatteo's testimony "established" trademark infringement. For example, the excerpts in Exhibit 9 demonstrate that Mr. DiMatteo did not have the NJTA logo in mind when designing the Jersey Boardwalk logo. *See, e.g.*, DiMatteo Tr. 74:9-13 (Q: Why did you put the geographic shape of New Jersey in the middle of a circle? A: Because that's who I am. That's where I'm from.); 75:9-12 (Q: Would it be fair to say that the reason that you put pizza in the middle is because you had in your mind the word parkway through the middle? A: Absolutely not.); 78:9-12 (Q: The word pizza goes through the middle just like the word parkway does, right? A: No, different too. Different size, different lettering, different everything.).

Similarly, Defendants properly submit Exhibit 10, the discovery deposition testimony of Lauren Parratt, in order to correct misleading excerpts from Ms. Parratt's testimony that NJTA submitted in its Notice of Reliance. For example, one excerpt included in NJTA's Notice of Reliance exhibits includes Ms. Parratt answering in the negative when asked whether she implemented a "formal process" for preserving emails after receiving a cease and desist letter from the NJTA. Plaintiff's Notice of Reliance, Exhibit 22, Parratt Tr. 22:18-23:4. NJTA rebuts the misleading inference that Ms. Parratt improperly disregarded the cease and desist letter by including testimony from Ms. Parratt that she, in fact, had not read the cease and desist letter. Defendants' Notice of Reliance, Exhibit 10, Parratt Tr. 51:6-10. Defendants also rebut the misleading suggestion that Ms. Parratt carelessly disregarded her legal obligations by including testimony that Jersey Boardwalk had previously changed its name to avoid a trademark issue. Parratt Tr. 41:9-12 ("[W]e changed (the name) to Jersey Boardwalk because we did a Google search and somebody had Boardwalk.").

Accordingly, the discovery deposition testimony that Jersey Boardwalk submits as evidence in Exhibits 9 and 10 of its Notice of Reliance is properly submitted under TBMP § 704.09 as rebuttal to opposing counsel's submissions of incomplete and misleading discovery transcript testimony from Mr. DiMatteo and Ms. Parratt.

CONCLUSION

Despite New Jersey Turnpike Authority's attempt to prevent the Board from reviewing relevant evidence that will assist the Board in reaching a fair and just decision in this matter, Jersey Boardwalk has demonstrated that the exhibits they submit to the Board are relevant, properly submitted, and should not be stricken.

Dated: November 29, 2016

Respectfully submitted,

/s/ Justin M. Klein

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing Jersey Boardwalk Franchising Co., Inc. and Boardwalk Pizza, Inc.'s Opposition to New Jersey Turnpike Authority's Motion to Strike Exhibits 2-10 of Jersey Boardwalk Franchising Co., Inc. and Boardwalk Pizza, Inc.'s Notice of Reliance was served via email and first class mail on the attorney for New Jersey Turnpike Authority, Ronald L. Isreal, Chiesa Shahinian & Giantomasi PC, One Boland Drive, West Orange, New Jersey 07052, risrael@csglaw.com.

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Dated: November 29, 2016