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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 AMENDED NOTICE OF RELIANCE**

Applicant and Registrant/Respondent, Jersey Boardwalk Franchising Co., Inc. and Boardwalk Pizza, Inc. ("Applicant and Respondent"), by and through their attorneys, hereby submit this Amended Notice of Reliance, pursuant to 37 C.F.R. § 2.122(g). Applicant and Respondent's Amended 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

In its February 28, 2017 Decision, the Trademark Trial and Appeal Board (the “Board”) identified curable defects in certain exhibits initially submitted to the Board in Applicant and Respondent’s October 19, 2016 Notice of Reliance. Applicant and Respondent herein submit this Amended Notice of Reliance to cure such defects as identified by the Board.

### **Exhibits 2-6**

Exhibits 2-4 of Applicant and Respondent’s Notice of Reliance consist of briefs and accompanying exhibits that the parties filed in a civil action before the United States District Court for the District of New Jersey in support of and in opposition to a motion to dismiss. 27 TTABVue 14-182. Exhibits 5 and 6 are the District Court’s opinion and order regarding that motion. *Id.* at 183-192. Pursuant to the Board’s February 28th decision in this matter, these exhibits constitute official records that may be properly introduced via a notice of reliance pursuant to Trademark Rule 2.122(e); however, Applicant and Respondent must specify the pages of the exhibits to be read and “indicate generally the relevance of the evidence” before the exhibits may be admitted.

### *Exhibits 2 and 4*

Exhibit 2 consists of Defendant’s Memorandum of Law in Support of Motion to Dismiss Complaint, filed in the United States District Court for the District of New Jersey, in the matter of *New Jersey Turnpike Authority v. Jersey Boardwalk Franchising Co., Inc.*, Civil Action No. 2:14-cv-04589-WJM-MF. Exhibit 3 consists of Plaintiff’s Memorandum of Law in Opposition to Defendant’s Motion to Dismiss, and Exhibit 4 consists of Defendant’s Reply Memorandum of Law in Further Support of Motion to Dismiss.

These documents are relevant because they set forth a narrative of undisputed facts relevant to the instant dispute. For example, pages 1-10 of Exhibit 2, and pages 1-4 of Exhibit 4, set forth background information regarding (1) the owners of the logos in dispute, and (2) the USPTO registration history of those logos. In particular, Exhibit 2 describes previous decisions by the USPTO determining that Applicant and Respondent's logo does not conflict with that of Opposer/Petitioner New Jersey Turnpike Authority:

On August 20, 2014, the USPTO's examining attorney issued a determination that there were no conflicting marks that would bar registration [of Applicant and Respondent's Jersey Boardwalk logo] . . . This determination was made not only in the face of the GSP Registration, but also NJTA's recently-filed Petition to Cancel the Boardwalk Pizza Logo registration.

*See* Exhibit 2, p. 4.

The identity of the parties and the registration history of the logos in dispute are certainly relevant to the Board's determination in this matter. These facts provide the Board with context surrounding the production of the logos, and set forth the procedural background of this matter without unduly burdening the Board with compounding testimony. As such, Exhibits 2 and 4 should be admitted.

#### *Exhibits 5 and 6*

Exhibits 5 and 6 are District Court's opinion and order regarding the motion to dismiss briefed in Exhibits 2-4. Exhibit 5, Section I: Background (see pp. 2-3), is relevant because it sets forth the factual history of the dispute, as determined by the New Jersey District Court. The opinion also provides visual depictions of the logos at issue and relevant dates regarding USPTO registrations. Exhibit 6 is demonstrative of the procedural history of the current dispute.

The information contained in Exhibits 5 and 6 is relevant and applicable to the current dispute before the Board, which pertains to the identical logos. Exhibits 5 and 6 provide the Board with context surrounding the production of the logos, and set forth the procedural

background of this matter without unduly burdening the Board with compounding testimony. As such, Exhibits 5 and 6 should be admitted.

### **Exhibits 9 and 10**

Exhibit 9 consists of excerpts from the discovery deposition of Paul DiMatteo, Chief Executive Officer of Applicant and President of Respondent. Exhibit 10 consists of excerpts from the discovery deposition of Lauren Parratt, Chief Financial Officer of Applicant and Vice President of Respondent. As acknowledged by the Board in its most recent decision in this matter, when a party introduces portions of a discovery deposition transcript, the adverse party may submit “any other part of the deposition which should in fairness should be considered so as to make not misleading what was offered by the submitting party.” Trademark Rule 2.120(k)(4). The Board granted Applicant and Respondent an opportunity to explain why specific excerpts from Exhibits 9 and 10 are needed.

#### *Exhibit 9*

In their Notice of Reliance, Opposer/Petitioner submitted a lengthy set of excerpts from the deposition testimony of Paul DiMatteo, Chief Executive Officer of Applicant and President of Respondent. Opposer/Petitioner expressly characterizes these excerpts as relevant to one or more of the following issues:

similarities between the marks at issue in these proceedings, Registrant’s and Applicant’s knowledge of NJTA’s Garden State Parkway Logo, unauthorized use of NJTA’s intellectual property by Registrant and/or Applicant, the nature of the goods and services upon which Registrant’s Mark and Applicant’s Mark are used, the abandonment of Registrant’s Mark by Registrant, the decision to seek federal registration of Registrant’s Mark and Applicant’s Mark, NJTA’s priority of use, Registrant’s and Applicant’s pattern of activity designed to connect their businesses with the NJTA and the state of New Jersey, and the Applicant’s bad faith.

Each of the excerpts from Mr. DiMatteo's deposition that Applicant and Respondent submit in their Notice of Reliance are also relevant to one or more of these issues, and provide clarification for the misleading excerpts that Opposer/Petitioner submitted. More specifically:

- Tr. 39:8-40:6; 41:21-42:6; 94:1-13; 110:3-18; 113:23-114:4; and 129:14-130:1 refute the alleged "pattern of activity designed to connect [Respondent's] businesses with the NJTA";
- Tr. 49:24-51:7; and 53:2-15 describe more fully "the nature of the goods and services upon which Registrant's Mark and Applicant's Mark are used";
- Tr. 74:9-19; 75:2-25; 77:9-78:18; and 113:23-114:4 address the lack of "similarities between the marks at issue in these proceedings";
- and Tr. 82:10-17; 87:3-25; 98:21-99:5; and 113:23-114:4 rebut mischaracterizations of deponent's testimony implying that Applicant acted "bad faith."

By submitting deposition testimony by the same witness regarding the very same issues to which the opposition's deposition excerpts apply, and providing context so as to make those excerpts "not misleading," the deposition excerpts of Mr. DiMatteo that Applicant and Respondent submit in their Notice of Reliance fall squarely within the parameters of Trademark Rule 2.120(k)(4).

*Exhibit 10*

In their Notice of Reliance, Opposer/Petitioner submitted a lengthy set of excerpts from the deposition testimony of Laureen Pratt, Chief Financial Officer of Applicant and Vice President of Respondent. Opposer/Petitioner expressly characterizes these excerpts as relevant to one or more of the following issues:

[U]nauthorized use of NJTA's intellectual property by Registrant and/or Applicant, the goods and services upon which Registrant's Mark and Applicant's Mark are used, the abandonment of Registrant's Mark by Registrant, and Registrant and Applicant's search for responsive documents relevant to these proceedings.

Each of the excerpts from Ms. Parratt's deposition that Applicant and Respondent set forth in their Notice of Reliance are also relevant to one or more of these issues, and provide clarification for the misleading excerpts that Opposer/Petitioner submitted. More specifically:

- Tr. 31:20-32:8 provides clarity regarding the goods and services upon which Registrant's Mark and Applicant's Mark are used; and
- 37:15-23; 41:9-12; 51:6-16 and 57:3-9 refute the implication that Applicant and Respondent engaged in the unauthorized use of NJTA's intellectual property.

By submitting deposition testimony by the same witness regarding the very same issues to which the opposition's deposition excerpts apply, and providing context so as to make those excerpts "not misleading," the deposition excerpts that Applicant and Respondent submit in their Notice of Reliance fall squarely within the parameters of Trademark Rule 2.120(k)(4).

### CONCLUSION

Applicant and Respondent demonstrate herein that the exhibits described above are relevant, properly submitted, and should be admitted by the Board through the foregoing Amended Notice of Reliance.

Dated: March 15, 2017

Respectfully submitted,

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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 Amended Notice of Reliance was served via email and first class mail on the attorney for New Jersey Turnpike Authority, Ronald L. Israel, Chiesa Shahinian & Giantomasi, PC, One Boland Drive, West Orange, New Jersey 07052, risrael@csglaw.com.

/s/Justin M. Klein  
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Dated: March 15, 2017