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

Proceeding	92046928
Party	Plaintiff BILLION DOLLAR SMILE, LTD.
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Date	08/24/2009
Attachments	BDResponse.pdf (4 pages)(312644 bytes)

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

Billion Dollar Smile, Ltd.,	§	Cancellation No.: 92046928
	§	
Petitioner,	§	Mark: MILLION DOLLAR SMILE
	§	
v.	§	Registration No. 3,084,967
	§	
William M. Dorfman,	§	Date of Issue: April 25, 2006
	§	
Registrant.	§	

United States Patent and Trademark Office
 Trademark Trial and Appeal Board
 P.O. Box 1451
 Alexandria, VA 22313-1451

PETITIONER’S RESPONSE TO
REGISTRANT’S MOTION TO STRIKE

Petitioner, by and through its undersigned attorneys, files this response to Registrant’s Motion to Strike. In support of this response, Petitioner respectfully shows the Board as follows:

I. ARGUMENT

Respondent complains that in Petitioner’s “Description of the Record” contained in Petitioner’s Trial Brief, Petitioner misrepresents that the record does not reflect any Testimony by Registrant. The following is a listing of the Prosecution History in the case as it appears in the on-line record of the case:

#	Date	History Text
43	08/06/2009	FINAL BRIEF ON MERITS FOR DEFENDANT(S)
42	08/06/2009	D’S MOTION TO STRIKE
41	07/02/2009	BRIEF ON MERITS FOR PLAINTIFF
40	03/23/2009	DEFENDANT’S NOTICE OF RELIANCE
39	01/26/2009	TESTIMONY FOR PLAINTIFF
38	01/22/2009	TRIAL DATES SET
37	01/21/2009	PLAINTIFF’S NOTICE OF RELIANCE

36 01/19/2009 STIPULATION RE: EVIDENCE
35 09/20/2008 PROCEEDINGS RESUMED
34 05/08/2008 P'S REPLY IN SUPPORT OF MOTION
33 05/05/2008 D'S OPPOSITION/RESPONSE TO MOTION
32 04/28/2008 SUSPENDED PENDING DISP OF OUTSTNDNG MOT
31 04/25/2008 P'S MOTION TO COMPEL DISCOVERY
30 04/09/2008 CHANGE OF CORRESPONDENCE ADDRESS
29 04/04/2008 TRIAL DATES RESET
28 04/02/2008 P'S MOTION TO COMPEL DISCOVERY
27 03/28/2008 PL'S MOT. FOR SUMM. JUDGMENT DENIED
26 09/07/2007 D'S OPPOSITION/RESPONSE TO MOTION
25 09/07/2007 D'S OPPOSITION/RESPONSE TO MOTION
24 09/07/2007 D'S OPPOSITION/RESPONSE TO MOTION
23 09/07/2007 D'S OPPOSITION/RESPONSE TO MOTION
22 08/30/2007 P'S REPLY IN SUPPORT OF MOTION
21 08/10/2007 D'S OPPOSITION/RESPONSE TO MOTION
20 08/10/2007 D'S OPPOSITION/RESPONSE TO MOTION
19 08/10/2007 D'S OPPOSITION/RESPONSE TO MOTION
18 07/16/2007 SUSPENDED
17 07/09/2007 P'S MOTION FOR SUMMARY JUDGMENT
16 07/09/2007 P'S MOTION FOR SUMMARY JUDGMENT
15 07/09/2007 P'S MOTION FOR SUMMARY JUDGMENT
14 07/09/2007 P'S MOTION FOR SUMMARY JUDGMENT
13 07/09/2007 P'S MOTION FOR SUMMARY JUDGMENT
12 06/14/2007 CHANGE OF CORRESPONDENCE ADDRESS
11 06/09/2007 TRIAL DATES REMAIN AS SET
10 06/07/2007 D'S MOT TO SUSP PEND DISP OUTSTNDNG MOT
9 06/06/2007 D'S OPPOSITION/RESPONSE TO MOTION
8 05/18/2007 P'S MOTION TO AMEND PLEADING/AMENDED PLEADING
7 04/17/2007 MOT TO ACCEPT LATE ANSWER GRANTED; NOTICE OF DEFAULT SET ASIDE; ANSWER ACCEPTED; TRIAL DATES REMAIN
6 04/16/2007 D'S RESPONSE TO BOARD ORDER/INQUIRY
5 03/19/2007 NOTICE OF DEFAULT
4 01/11/2007 PART 2 OF 2; EXHIBITS FOR PETITION TO CANCEL
3 01/23/2007 PENDING, INSTITUTED
2 01/23/2007 NOTICE AND TRIAL DATES SENT; ANSWER DUE:
1 01/11/2007 FILED AND FEE

As is clearly evident from the formal record of the Prosecution History, no Testimony by the Registrant appears in the Prosecution History listing. Petitioner did nothing but recite the status of the official record.

Notably, Registrant did file a Notice of Reliance, but as is clear from 37 C.F.R § 2.122(e), such a Notice of Reliance is used to introduce printed publications and official records. There is a separate evidentiary mechanism for introducing trial testimony in *inter partes* cases. See 37 C.F.R § 2.123. While it has been held that materials improperly offered under 37 CFR § 2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object to their introduction or itself treats the materials as being of record¹, in this case, Petitioner did object in its Trial Brief.

Moreover, in its Motion to Strike, Registrant takes exception to the fact that Petitioner does not believe Registrant has provided any evidence to support Registrant's position, seemingly complaining about Petitioner's opinion of Registrant's evidence. In short, the fact that Petitioner does not believe Registrant has even begun to establish evidence sufficient to remove a common phrase from the everyday vernacular is not a basis for a Motion to Strike.

Finally, regardless of the veracity of Registrant's statements in its Motion to Strike, the granting of such a Motion would have an overly severe penalty on Petitioner, denying it the opportunity to have the issues and the evidence fairly considered on the merits by the Board.

II. PRAYER

Petitioner respectfully asks this Board to deny the Motion in its entirety.

¹ See, for example, *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1309 n.4 (TTAB 1990) (improper subject matter but adverse party expressly agreed to its authenticity and accuracy); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1997 n.2 (TTAB 1986) (improper subject matter and improper rebuttal considered where no objection was raised); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 59 nn.3 & 4 (TTAB 1984) (improper subject matter deemed stipulated into record where no objection was raised).

Respectfully submitted,

JACKSON WALKER L.L.P.

/Mark A. Tidwell/

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CERTIFICATE OF SERVICE

I certify that on August 21st, 2009, a copy of this document and its attachments was served on the following, via certified, first-class mail:

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/Mark Tidwell/

Mark Tidwell

CERTIFICATE OF FILING

I certify that the foregoing Petitioner's Response to Registrant's Motion to Strike is being filed electronically with the United States Patent and Trademark Office's Electronic System for Trademark Trials and Appeals (ESTTA) on this 21st day of August, 2009.

/Mark Tidwell/

Mark Tidwell