

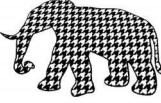
ESTTA Tracking number: **ESTTA623252**

Filing date: **08/25/2014**

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

Proceeding	92057550
Party	Plaintiff Board of Trustees of The University of Alabama and Paul W. Bryant, Jr.
Correspondence Address	ALICIA GRAHN JONES KILPATRICK TOWNSEND STOCKTON 1100 PEACHTREE ST STE 2800 ATLANTA, GA 20309-4530 UNITED STATES aljones@ktslaw.com, chenn@ktslaw.com, hhenderson@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com, tibrown@ktslaw.com
Submission	Other Motions/Papers
Filer's Name	Alicia Grahn Jones
Filer's e-mail	aljones@ktslaw.com, hhenderson@ktslaw.com, cgenteman@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com
Signature	/Alicia Grahn Jones/
Date	08/25/2014
Attachments	2014.08.25 Petitioners' Motion to Strike First Notice of Reliance.pdf(164782 bytes)

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

BOARD OF TRUSTEES OF THE)	
UNIVERSITY OF ALABAMA and)	Cancellation No. 92057550
PAUL W. BRYANT, JR.,)	
)	
Petitioners,)	Mark:
)	
)	
)	
v.)	Registration No. 3,993,520
)	
RICHARD DIAZ,)	
)	
)	
Registrant.)	

**PETITIONERS’ MOTION TO STRIKE
REGISTRANT’S FIRST NOTICE OF RELIANCE**

Petitioners Board of Trustees of the University of Alabama (the “University”) and Paul W. Bryant, Jr. (“Bryant, Jr.”) (collectively, “Petitioners”) respectfully request that the Board strike Registrant’s First Notice of Reliance as untimely and inappropriate.

I. INTRODUCTION AND FACTUAL BACKGROUND

On July 11, 2013, Petitioners petitioned to cancel Registrant’s mark because it is likely to cause confusion with Petitioners’ Marks and creates a false association with Petitioners. Dkt 1. Petitioners subsequently moved to amend the Petition to Cancel to allege additional claims of nonuse with respect to certain goods identified in Registrant’s houndstooth elephant registration (the “Registration”). Dkt. 7. The Board granted that motion and reset the trial dates. Dkt. 8. Pursuant to the schedule provided by the Board, Registrant’s testimony period begins on December 1, 2014, and closes on December 30, 2014. *Id.* In order to assert additional trademarks recently acquired by the University, Petitioners filed a second Motion to Amend on June 6, 2014. Dkt. 9 Upon receiving Registrant’s Motion for Summary Judgment (Dkt. 10), the

Board suspended all proceedings and indicated that filings unrelated to Registrant's Motion for Summary Judgment and Petitioners' Motion for Leave to File a Second Amended Petition would not be considered. Dkt. 11. Notwithstanding the fact that the proceedings have been suspended and that, even under the prior scheduling order Registrant's testimony period does not open until December 1, 2014, Registrant filed its First Notice of Reliance on August 5, 2014. Dkt. 19.

II. ARGUMENT AND CITATION OF AUTHORITY

“A party seeking to make evidence of record by notice of reliance must follow the rules and case law; if material cannot be made of record by notice of reliance, it will not be considered.” *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 U.S.P.Q.2d 1213, 1216 (T.T.A.B. 2011). Section 704 of the Trademark Board Manual of Procedure (“TBMP”) provides that “[c]ertain types of evidence may [instead] be made of record filing the materials with the Board under cover of one or more notices of reliance *during the testimony period of the offering party*.” TBMP § 704.02 (emphasis added). Here, Registrant's First Notice of Reliance plainly fails to satisfy the procedural requirements for submission of documents because it is both premature and seeks to submit declaration testimony into the record without the prior consent of Petitioners.

A. Registrant's First Notice of Reliance Is Premature.

“A notice of reliance must be submitted during the testimony period of the offering party.” *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (T.T.A.B. 2009). *See also*, TBMP 704.02. Registrant's First Notice of Reliance was filed on August 5, 2014 (Dkt. 19) – more than a month after the Board suspended all proceedings and more than four months before Registrant's testimony period would have opened under the previous scheduling order. Thus, it is untimely and Exhibits 1 and 2 of Registrant's Response to Petitioners' Motion to Strike and Exhibits 2 and 3 of Registrant's Reply in Support of its Motion

for Summary Judgment should not be made part of the summary judgment or trial record because Registrant's First Notice of Reliance is premature and untimely. Registrant will have ample opportunity to make Exhibits 1 and 2 of its Response to Petitioners' Motion to Strike part of the trial record during its testimony period. As discussed in greater detail below, the affidavit testimony contained in Exhibits 2 and 3 of Registrant's Reply in Support of Registrant's Motion for Summary Judgment is not only untimely, it cannot be submitted under a notice of reliance without the written consent of the Petitioners.

B. Registrant's First Notice of Reliance Seeks to Submit Declaration Testimony into the Record Without Petitioners' Consent

TBMP 703.01(b) makes clear that the testimony of witnesses should be taken by deposition upon oral examination *unless* the parties stipulate in writing that testimony of a witness may be submitted in the form of an affidavit. *See also*, 37 C.F.R. § 1.123(b). Moreover, the Board consistently strikes affidavit testimony submitted under a notice of reliance when the parties have not stipulated to such a submission in writing. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 U.S.P.Q.2d 1424, 1427 (T.T.A.B. 2013) (affidavit and accompanying exhibits stricken where parties have not stipulated to the submission of testimony via affidavit); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 U.S.P.Q.2d 1912, 1914 (T.T.A.B. 2007) (same); *Calypso Tech. Inc. v. Calypso Capital Mgmt LP*, 100 U.S.P.Q.2d 1213, 1216-1219 (T.T.A.B. 2011); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1403-04 n.9 (T.T.A.B. 1998) (same). Here, Petitioners' have not stipulated to the submission of the declaration testimony of Registrant Richard Diaz (Exhibit 2) or the declaration testimony of Michael J. Douglas (Exhibit 3) in a notice of reliance. Therefore, the affidavit testimony of Mr. Diaz and Mr. Douglas submitted in a notice of reliance should not be made part of the summary judgment or trial record.

III. CONCLUSION

Registrant's First Notice of Reliance is untimely and also seeks to submit declaration testimony into the record without Petitioners' written consent. Accordingly, Petitioners respectfully request that the Board grant their Motion to Strike Registrant's First Notice of Reliance.

Dated: August 25, 2014

Respectfully submitted,

/Alicia Grahm Jones/

Alicia Grahm Jones

Harris W. Henderson

Crystal C. Genteman

KILPATRICK TOWNSEND & STOCKTON LLP

1100 Peachtree Street

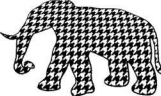
Suite 2800

Atlanta, Georgia 20309-4530

(404) 815-6500

Attorneys for Petitioners

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

BOARD OF TRUSTEES OF THE)	
UNIVERSITY OF ALABAMA and)	Cancellation No. 92057550
PAUL W. BRYANT, JR.,)	
)	
Petitioners,)	Mark:
)	
)	
)	
v.)	Registration No. 3,993,520
)	
RICHARD DIAZ,)	
)	
)	
Registrant.)	

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PETITIONERS' MOTION TO STRIKE REGISTRANT'S FIRST NOTICE OF RELIANCE was served on Registrant on August 25, 2014 via first class mail to:

Michael J. Douglas
Friedman, Dazzio, Zulanas & Bowling, P.C.
3800 Corporate Woods Drive
Birmingham, Alabama 35242

/Alicia Grahn Jones/
Counsel for Petitioners

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing PETITIONERS' MOTION TO STRIKE REGISTRANT'S FIRST NOTICE OF RELIANCE is being filed electronically with the TTAB via ESTTA on this day, August 25, 2014.

/Alicia Grahn Jones/
Counsel for Petitioners