

ESTTA Tracking number: **ESTTA953563**

Filing date: **02/12/2019**

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

Proceeding	92066392
Party	Defendant ERBE Elektromedizin GmbH
Correspondence Address	PHILIP G HAMPTON II HAYNES AND BOONE LLP 800 17TH STREET NW , SUITE 500 WASHINGTON, DC 20006 UNITED STATES phil.hampton@haynesboone.com 202-654-4533
Submission	Reply in Support of Motion
Filer's Name	George T. Graves
Filer's email	george.graves@haynesboone.com, philip.hampton@haynesboone.com
Signature	/s/George T. Graves/
Date	02/12/2019
Attachments	Reply in Support of Motion to Strike Motion for Summary Judgment As Un- timely.pdf(36213 bytes)

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

**In the Matter of Trademark Registration Nos. 4,236,231 and 4,686,396
For the mark SOFT COAG**

Covidien LP)	
)	Cancellation No.: 92066392
Petitioner,)	
v.)	
ERBE ELEKTROMEDIZIN GmbH)	
)	
Registrant.)	
)	

**REGISTRANT’S REPLY IN SUPPORT OF ITS MOTION TO STRIKE
PETITIONER’S MOTION FOR SUMMARY JUDGMENT AS UNTIMELY**

Registrant Erbe Elektromedizin GmbH (“Erbe”) submits its reply in support of its motion to strike Petitioner Covidien LP’s (“Covidien”) Motion for Summary Judgment (TTABVUE 24) as untimely. Because Covidien failed to file its motion before the day of the deadline for pretrial disclosures for the first testimony period, the Board should deny Covidien’s motion and strike it from the record as untimely.

Covidien’s response contains a skewed recitation of the facts and law related to the issue currently before the Board. Covidien states that the deadline for its pretrial disclosures was January 25, 2019, despite the fact that the Board has not issued an order setting such a deadline. Covidien frames its January 16, 2019 motion for an extension of time as a “stipulation” despite the fact that the word stipulation does not appear anywhere in the document. Moreover, Covidien claims that its cited authorities – both of which are non-precedential and issued more than a decade before the most recent changes to TBMP § 528.02 – make “express” holdings when Covidien’s interpretations of these findings are obsoleted inferences at best.

The first non-precedential opinion cited by Covidien – *Phillips Publishing Int’l v. Internet World Broadcasting Corp.* – is distinguishable from the current case before the Board. Opp. No. 91102098, 1998 TTAB LEXIS 347, at *3 n.3 (TTAB Sept. 15, 1998). In *Phillips*, the Opposer filed a motion to extend the discovery and testimony period (on March 28, 1997) months before it filed its motion for summary judgment (on June 27, 1997) – a substantial departure from the gamesmanship Covidien has demonstrated in this case. *Id.* Furthermore, the Board in *Phillips* was interpreting rules that are now obsolete. In *Phillips*, the Board, in its determining of the timeliness of opposer’s motion, cited the now superseded versions of TBMP § 528.02 (which stated that a motion for summary judgment *should* be filed before the opening of the first testimony period) and Trademark Rule 2.127(e) (which similarly just suggested that the motion *should* be filed before the testimony period opens). The now enforced rules, however, do not permit the discretion provided under the old rules, as both TBMP § 528.02 and Trademark Rule 2.127(e) now state that a motion for summary judgment *must* be filed before the day of the deadline for pretrial disclosures. The TBMP further notes that motions filed thereafter are untimely “even if filed prior to a day of a rescheduled deadline for pretrial disclosures for the first testimony period.” TBMP § 528.02.

Covidien’s second non-precedential case – *Brainworks, Inc. v. Brainworks LLC* – similarly does not support Covidien’s argument. Opp. No. 91150456, 2003 WL 1018103 (TTAB Mar. 6, 2003). Covidien claims that the Board in that case “expressly” stated that a summary judgment motion filed before the Board had approved a consented motion to reset the pretrial disclosure deadline was timely. However, the Board made no such “express” statement. Instead, the Board rejected an argument by opposer that its motion for summary judgment was timely because its motion to extend didn’t reset the testimony period but instead merely extended it. *Id.* at *1 n.2. And while it might be argued the Board suggested that if opposer wanted to

reset the beginning of its testimony period, it should have filed a motion to reset prior to the commencement of the testimony period, the Board did not comment on whether such a motion would have been granted or would have rendered the motion for summary judgment timely. In short, Covidien once again merely attempts to turn a suggestion from a decades-old case into binding precedent, while conveniently overlooking the fact that the rules the Board interpreted have been updated and make obsolete the interpretations cited by Covidien.

The facts and law before the Board are clear:

- A motion for summary judgment must be filed prior to the day of the deadline for pretrial disclosures for the first testimony period. TBMP § 528.02.
- The deadline for Covidien’s pretrial disclosures was January 18, 2019. TTABVUE 22.
- Covidien’s summary judgment motion was not filed until January 22. TTABVUE 24-27.

Therefore, Erbe respectfully requests that the Board strike Covidien’s Motion for Summary Judgment and deny it as untimely.

Respectfully submitted,

Date: February 12, 2019

/s/George T. Graves/
Philip G. Hampton, II
George T. Graves
Joseph Lawlor
Attorneys for Registrant
HAYNES AND BOONE, LLP
800 17th Street, NW
Washington, DC 20006
Telephone: 202.654.4533
Facsimile: 202.654.4270
phil.hampton@haynesboone.com
george.graves@haynesboone.com
joseph.lawlor@haynesboone.com

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

**In the Matter of Trademark Registration Nos. 4,236,231 and 4,686,396
For the mark SOFT COAG**

Covidien LP)	
)	Cancellation No.: 92066392
Petitioner,)	
)	
v.)	
ERBE ELEKTROMEDIZIN GmbH)	
)	
Registrant.)	
)	

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 12th day of February, 2019, a copy of the foregoing Registrant’s Reply in Support of its Motion to Strike Petitioner’s Motion for Summary Judgment as Untimely was served on the Petitioner at the following e-mail addresses of record:

jdabney@mwe.com, mhallerman@mwe.com, ksandacz@mwe.com, dciplit@mwe.com

/s/George T. Graves/

George T. Graves