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

Proceeding	91170256
Party	Defendant GOOGLE INC. GOOGLE INC. 1600 Amphitheatre Parkway Building 41 Mountain View, CA 94043
Correspondence Address	MICHAEL T. ZELLER QUINN EMANUEL URQUHART OLIVER & HEDGES 865 SOUTH FIGUEROA ST., 10TH FL LOS ANGELES, CA 90017
Submission	Opposition/Response to Motion
Filer's Name	Michael T. Zeller
Filer's e-mail	michaelzeller@quinnemanuel.com
Signature	/Michael T. Zeller/
Date	05/24/2006
Attachments	Response.pdf (6 pages)(162516 bytes)

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

In the Matter of:

Application Serial No. 76314811
For the Mark: GOOGLE
Publication Date: November 1, 2005

Opposition No. 91170256

CENTRAL MFG. CO. (INC.),

Opposer,

v.

GOOGLE INC.,

Applicant.

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE FILED ON MAY 20, 2006 RE: APPLICANT'S REPLY PAPERS

Commissioner of Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

Applicant Google Inc. ("Applicant") respectfully submits this response to Opposer's Motion to Strike. The Motion to Strike was filed by Opposer on May 20, 2006, in connection with Applicant's reply papers in further support of Applicant's Combined (1) Motion for Protective Order re: Opposer's Service and (2) Preliminary Response to Opposer's Motion to Consolidate (hereinafter, the "Motion for Protective Order").[1] In support thereof, Applicant states as follows.

Opposer's Motion to Strike argues that Applicant's filing of the Declaration of Rose Hagan with the reply on Applicant's Motion for Protective Order somehow ran afoul of Trademark Rule 2.142(d). That Rule, entitled "Time and manner of ex parte appeals," by its terms only applies to appeals from the "Examiner of Trademarks." This proceeding is not an appeal, let alone such an ex parte one. The sole authority relied upon by Opposer accordingly shows on its face that it has no application here, and the Motion to Strike is groundless for this reason alone.

Opposer's Motion to Strike also ignores that Applicant's reply and the Hagan Declaration did precisely, and quite properly, what reply papers are supposed to do: they replied to Opposer's arguments. While ignoring the bulk of the evidence showing that Opposer had engaged in "bad faith" conduct under the Board's prior decisions in Opposer's service and mailing of its Motion to Consolidate, Opposer's response principally devoted itself to claiming without supporting evidence that one of Applicant's counsel, Mike Zeller, was unable to confirm Applicant's receipt date of the Motion to Consolidate. This was, Opposer claimed in its response

[1] Applicant's Motion for Protective Order seeks an order from the Board requiring Opposer to file papers via ESTTA and to serve all further papers in this proceeding either by (a) obtaining a postmark from the U.S. Postal Service, or (b) using U.S. Postal Service Express Mail.

for the first time, because Opposer supposedly was "mailing ***and*** faxing ***all*** communications" to Applicant's in-house Senior Trademark Counsel, Rose Hagan, prior to May 3, 2006, and Mr. Zeller allegedly had no actual involvement in the matter before that time. Opposer's Response at 2 (emphasis added). Applicant's reply, and in particular the Hagan Declaration, demonstrated the falsity of Opposer's contentions, including in particular Opposer's wholly unsubstantiated claim to have faxed the Motion to Consolidate to any of Applicant's counsel. Indeed, as also pointed out by Applicant's reply, the Opposition itself attached letters that showed the falsity of Opposer's claim. Contrary to Opposer's surmise on the Motion to Strike, Applicant can scarcely respond to Opposer's contentions about such matters before Opposer had made them.

Also contrary to Opposer's unsupported argument in its Motion to Strike, courts have held that it is entirely appropriate on a reply to submit additional evidence further establishing a point that was made on an original motion so as to respond to arguments made in an opposition brief, particularly when the opposition raised challenges to the admissibility of the evidence submitted on the original motion. E.g., Jones v. R.R. Donnelley & Sons Co., 1999 WL 33257839, at *3 (N.D. Ill. 1999) (denying motion to strike where evidence submitted on reply "lends further support to" grounds raised on motion in response to contentions made in opposition); Mills v. First Federal Sav. & Loan Ass'n, 1995 WL 155036, at *1 (N.D. Ill. 1995) (denying motion to strike and noting affidavit was properly submitted on reply in response to adversary's admissibility objections to evidence that had been presented on original motion); Van Loo v. Braun, 940 F. Supp. 1390, 1395 n.1 (E.D. Wis. 1996) (denying motion to strike where additional evidence further supported contentions made in original summary judgment motion). This was the situation with the Hagan Declaration's further confirmation that Applicant -- like

the Board -- did not receive Opposer's Motion to Consolidate for some two weeks after Opposer swore that they were allegedly mailed. As is beyond dispute, that issue was squarely raised in Applicant's Motion for Protective Order. Having chosen to merely quibble about the admissibility of one piece of the evidence submitted on Applicant's Motion for Protective Order, Opposer cannot now complain that the reply provided additional evidence to establish the same point made on the original Motion for Protective Order as part of its refutation of Opposer's arguments.

Opposer's conclusory allegations of "prejudice" are without merit. Not only were Applicant's reply and the Hagan Declaration properly submitted as just shown, but Opposer fails to come to grips here with the law applicable to Applicant's Motion for Protective Order. Applicant's Motion for Protective Order provided evidence showing that (1) Opposer had unlawfully omitted the date from its postage meter stamp in connection with the service of Opposer's Motion to Consolidate, despite prior Board warnings against precisely that "bad faith" misbehavior; and (2) Opposer's certificates of service and mailing were false, including through the uncontested fact that the Board did not receive Opposer's Motion to Consolidate for almost two weeks after Opposer supposedly mailed it. S. Indus. Inc. v. Lamb-Weston Inc., 45 U.S.P.Q.2d 1293, 1295 (T.T.A.B. 1997) (fact that Board did not receive Stoller's papers until two weeks after the certificates' date was indicia under the circumstances that the date was "fraudulent.").

At that point, it was Opposer's burden to prove the actual mailing and service date of the Motion to Consolidate. Id. (stating rule and citing Stoller's failure "to provide any reasonable explanation" for discrepancies in service and mailing as ground for order barring Stoller from

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