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

Proceeding	91187238
Party	Plaintiff Herbn Tonics, LLC
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Attachments	REPLY Summary Judgment for Opposition_2.pdf (12 pages)(493795 bytes) Reply Exhibit A.pdf (9 pages)(538325 bytes) Reply Exhibit B.pdf (1 page)(17326 bytes) Mizrahi Declaration.pdf (3 pages)(35724 bytes)

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

Herbn Tonics, LLC)
)
 Opposer,)
)
 v.)
)
 Tianna Owen,)
 Applicant.)

Opposition No. 91187238

**REPLY IN SUPPORT OF OPPOSER'S
MOTION FOR SUMMARY JUDGMENT
AND OPPOSITION TO APPLICANT'S
CROSS-MOTION FOR SUMMARY JUDGMENT**

Applicant's opposition/cross motion is devoid of any facts or law which militates against finding in favor of Opposer on summary judgment. Applicant offers no compelling reason in which to deny Opposer's motion. In essence, Applicant attempts to manufacture issues of material fact when none exist.

Applicant's opposition and cross-motion for summary judgment is more aptly viewed as a motion for reconsideration of the Board's September 23, 2009 Order denying Applicant's motion for leave to amend its answer and denying, in part, Applicant's motion under Fed. R. Civ. P. 56(f) – relating to the topic of Opposer's bona fide intention to use the mark that is the subject of Opposer's STIMULITE application. Such a motion for reconsideration is both misplaced and untimely. Indeed, 37 C.F.R. § 2.127(b) is clear: "Any request for reconsideration or modification of an order or decision issued on a motion must be filed within one month of the date thereof ..." Therefore, Applicant having failed to comply with the clear directive of the Code of Federal Regulations, its entire cross-motion and argument relating to Opposer's supposed lack of "bona fide intent to use" should be dismissed out of hand.

The Board should also note that Applicant did not attempt to state an affirmative defense of "lack of bona-fide intent-to-use" until a few days before the close of discovery and only after the filing of Opposer's underlying motion herein. Applicant's dilatory tactics should not be rewarded. It was within the Board's discretion to deny Applicant's Motion to Amend on the ground of un-timeliness alone, an issue raised in Opposer's opposition to Applicant's Motion to Amend and discussed by the Board at the hearing on that motion as an alternative ground for denial. Any further delay and proceedings in this case, naturally, will prejudice Opposer.

Regardless, Opposer is not duty-bound to respond to Applicant's allegations regarding Opposer's alleged lack of intent-to-use its mark as this issue is not before the Board in

this case, as it is not a defense in this case. Indeed in its answer, Applicant declined to make any challenge to the validity of Opposer's pending application. This is so, in spite of Applicant's counsel's threat during the initial meeting of counsel to delve into Opposer's bona fide intention to use the STIMULITE mark during discovery.¹

Applicant's gripes regarding Opposer's responses to Applicant's voluminous discovery requests are similarly misplaced. As can be seen from the discovery requests attached to Applicant's response to Opposer's motion for summary judgment and cross-motion for summary judgment, numerous requests are directed to areas that lie outside of the permitted scope of discovery set forth in the Board's September 23, 2009 Order. Specifically, the Board forbade Applicant from delving into Opposer's bona fide intent to use the mark that is the subject of Opposer's application, noting that it was "not necessary to respond to Opposer's motion for summary judgment and, therefore, Applicant's request for such 56(f) discovery is denied." (*See* Board's September 23, 2009 Order, at p. 6.)

By way of example only, Applicant's interrogatory No. 41 requests that Opposer "identify the date on which you intend to begin using Your Mark in Commerce in the United States." Similarly, Applicant's interrogatory No. 46 requests that Opposer "identify all documents concerning the decision to develop a product or service to be used in conjunction with Your Mark" and "identify all documents concerning the decision to file Your Application." These are just but a few examples of many improper discovery requests that clearly lie outside the scope of admissible discovery pursuant to the Court's Order.

¹ At the very least, in the unlikely event that the Board permits Applicant to now raise the defense of "lack of bona fide intent to use" at this late juncture, then Opposer respectfully requests that the Board rule on the issue of "likelihood of confusion" raised by Opposer's underlying Motion for Summary Judgment and permit only limited discovery into the issue of intent to use and permit an additional motion for summary judgment to decide the issue of priority.

For the foregoing and following reasons, and those set forth in Opposer's moving papers, Applicant's arguments in an effort to raise material questions of fact regarding likelihood of confusion, are equally misplaced.

1. **The Marks at Issue Are Indeed Virtually Identical**

A simple review of the two marks STIMULITE and STEMULITE reveals that they are, indeed, virtually identical. They are both comprised of a single word that differs only by a single letter, a similarly sounding vowel. The fact is that "e" and "i" are very close sounding vowels in the context of the two marks. One need only pronounce the respective marks quickly in order to aptly demonstrate the virtual identity between the two marks and the way that they are pronounced and viewed, for that matter. Additionally, the subject marks are each comprised of the same number of syllables. Moreover, Applicant's hand waving regarding alleged differences is belied by the fact that there have been numerous instances of actual confusion between the two – even before Opposer has launched its product on the market!

It is also worthy of note that Applicant has elected to only discuss the first syllable of each of the two marks, in connection with its contention that the two marks have entirely different connotations. But, when the marks are looked at as a whole, they both also share, in addition to the other aspects, the suffix "ulite." This suffix gives conveys the meaning of "lightening up" or "making light," a connotation present in both of the marks, despite Applicant's attempts to distance itself from the "light" aspect of its mark. Significantly, Applicant did not elect to call its mark "STEMULATE," but "STEMULITE," in order to highlight the fact that the Applicant's goods used in connection with this mark results in, at the very least, loss of fat and making one more fit – a similar connotation conveyed by Opposer's mark. This fact can readily be observed in Applicant's own literature. (See **Exhibit A**, printouts

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