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November 16, 2011

29172.00012

VIA EXPRESS MAIL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attn: TTAB

Re: L'HOMME LIBRE - Appln. Ser. No. 85/081,235

Dear Sir/Madam:

Enclosed please Applicant's Request for Reconsideration of Board's Order Granting Motion to Extend Time to Oppose and Declaration of Bradford E. Young in Support of Applicant's Request for Reconsideration of Board's Order Granting Motion to Extend Time to Oppose for the above referenced mark.

Please stamp and return the enclosed postcard to indicate receipt.

Sincerely,



Edith R. Lopez
Paralegal

ERL



11-16-2011

U.S. Patent & Trademark Office Report 01-#72

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

In the Matter of Application Serial No. 85/081,235
Published in the Official Gazette on June 21, 2011
Mark: L'HOMME LIBRE
Applicant: L'Oréal (UK) Limited
Examining Attorney: Giancarlo Castro
Law Office: 110

**APPLICANT'S REQUEST FOR RECONSIDERATION
OF BOARD'S ORDER GRANTING MOTION TO EXTEND TIME TO OPPOSE**

Pursuant to Sections 210 and 211.01 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), applicant L'Oréal (UK) Limited ("Applicant") requests reconsideration of the Board's October 18, 2011 order granting an extension of time for Reginald Holmes to oppose registration of Applicant's L'HOMME LIBRE trademark, Serial Number 85/081,235 ("Applicant's Mark").

Applicant's Mark was published for opposition on June 21, 2011. On July 20, 2011, Reginald Holmes ("Holmes") sought additional time to oppose Applicant's Mark by filing a request for a 90-day extension on the basis that "the potential opposer needs additional time to investigate the claim." That request was granted, and Holmes's time to file a notice of opposition was extended to October 19, 2011. On October 17, 2011, Holmes filed a request for an additional 60 days ("Second Extension Request"), on the grounds that (1) he had obtained applicant's consent, and (2) extraordinary circumstances, namely:

Potential Opposer, Reginald Holmes C/O. OF DBA. L'HOMME
APPAREL & ACCESSORIES and Owner of REGISTERED
MARK: "L'HOMME" = REGISTRATION # 3523179 and
PENDING MARK: "L'HOMME" = SERIAL # 85012915 NEEDS
ADDITIONAL TIME TO INVESTIGATE, COLLECT
EVIDENCE, AND RESEARCH CASE LAWS THAT DISPLAYS
THE DELIBERATE AND MALICIOUS INTENT OF

TRADEMARK INFRINGEMENT BY "L'OREAL (UK) LIMITED. In closing, I RESPECTFULLY ASK OF THE BOARD AS A REGISTERED TRADEMARK OWNER THE ABILITY/RIGHT TO PREVENT OTHERS AND THIRD PARTIES FROM USING MY REGISTERED TRADEMARK BY USE OF A LETTER, LETTERS, AND OR WORD AS WELL AS WORDS THAT DOES NOT "OBVIATE" THE REGISTERED MARK: "L'HOMME". Sincerely, Mr. Reginald Holmes

As set forth in more detail below, neither of the claimed bases for Holmes's requested extension of time to oppose exists. Applicant therefore requests that the Board's October 18, 2011 order granting an extension of time to oppose be rescinded and that the opposition period for Applicant's Mark be terminated.

A. APPLICABLE STANDARDS

A party seeking an extension of time to oppose a trademark application for more than 30 days must demonstrate good cause for such an extension. 37 C.F.R. § 2.102(c)(1). After receiving extensions of time totaling 90 days, a party may file one final request for an additional 60 day extension. 37 C.F.R. § 2.102(c)(3). The Board will grant such a final request *only* upon consent or stipulation by the applicant or its authorized representative, or a showing of extraordinary circumstances. *Id.* By expressly identifying the particular circumstances by which potential opposers may obtain an extension of time beyond 90 days, it has been determined that failure to obtain consent or demonstrate extraordinary circumstances is a basis for denying a request for an additional extension of time to oppose. *See id.*

B. HOLMES DID NOT OBTAIN APPLICANT'S CONSENT

Holmes claims that Applicant consented to the Second Extension Request. Applicant did not. As set forth more fully in the accompanying declaration of Bradford E. Young, Holmes never contacted Applicant's attorneys. *See Young Decl.* ¶¶ 3-7. He simply represented to the

Board that he had obtained Applicant's consent. No such consent was ever granted. *Id.* ¶¶ 4-7. Nor is Holmes permitted to claim implied or theoretical consent. TBMP § 207.03 ("Consent to an extension of time must be express.").

A fabricated claim of consent constitutes sufficient grounds to rescind an order granting an extension of time to oppose. *See, e.g., Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 U.S.P.Q.2d 1210, 1212-13, 1214 (T.T.A.B. 2001) (granting motion to dismiss opposition and issuing sanctions against the opposer, finding that opposer acted improperly and in bad faith by filing two requests to extend the time to oppose that falsely stated that applicant had consented). Here, Applicant never consented.

C. HOLMES FAILED TO DEMONSTRATE THE EXTRAORDINARY CIRCUMSTANCES NECESSARY TO EXTEND HIS TIME TO OPPOSE

In addition to falsely alleging that Applicant consented to an additional 60 day extension, Holmes alleged that an additional 60 days were required based on "extraordinary circumstances shown." Specifically, the Second Extension Request states that "[p]otential opposer believes that extraordinary circumstances are established for this request by:" (1) the fact that Holmes claims to be the owner of a registration for L'HOMME for various types of clothing in International Class 25 and a pending application for L'HOMME for various types of bags, backpacks, luggage and other carriers in International Class 18; and (2) Holmes's claimed need for "additional time to investigate, collect evidence, and research case laws that displays the deliberate and malicious intent of trademark infringement by "L'Oreal (UK) Limited." Neither owning a registration nor needing time to perform factual and legal research constitutes extraordinary circumstances sufficient to warrant extending the time to oppose beyond 120 days.

Holmes's first claim of extraordinary circumstances – the fact that he claims to own a federal trademark registration and a pending trademark application – falls far short of “extraordinary.” Many, if not most, opposition proceedings are instituted by owners of federal registrations. Moreover, the registration cited by Holmes issued in 2008, and there were no apparent changes in the status of that registration since June 2011 when Applicant's Mark was first published or during the period of Holmes's first 120 day extension. Ownership of a trademark registration does not meet the extraordinary circumstances requirement of 37 C.F.R. § 2.102(c)(3). *See, e.g., In re Su Wung Chong*, 20 U.S.P.Q.2d 1399, 1400 (Comm'r 1991) (owner of federal registration for MIDO lacked any exceptional circumstances to justify extension of period to oppose application to register MIDO PRODUCTS, even where counsel for registration owner was unable to get in touch with owner of trademark application).

Holmes's second claim of extraordinary circumstances – that he “needs additional time” to investigate, collect evidence, and research case laws – also fails to meet the extraordinary circumstances standard. As the TBMP states, “[e]xtraordinary circumstances are those which are beyond what is usual or ordinary, for example, fire, extreme weather or death. Settlement negotiations between the parties, the filing of a letter of protest by the potential opposer, the pendency of a post-publication amendment, or civil litigation between the parties do not constitute extraordinary circumstances.” TBMP § 207.03.

Every notice of opposition relies upon certain facts, evidence and/or research. There is nothing extraordinary about Holmes' need to obtain that information. There also is no reason why Holmes did not collect that information during the first 120 day extension. The grounds on which that extension was granted was his claimed need for “additional time to investigate L'Oreal, collect important data/information for my defense against L'Oreal, and put together a

'plan of defense' against L'Oreal and its subsidiary companies." The grounds for Holmes's Second Extension Request were essentially the same. The need to collect information is not extraordinary – it is present in every opposition proceeding. *C.f. In re Societe des Produits Nestle S.A.*, 17 U.S.P.Q.2d 1093, 1094 (Comm'r 1990) (settlement negotiations do not constitute extraordinary circumstances because "they are often utilized prior to determining whether to file a notice of opposition").

D. CONCLUSION

For the foregoing reasons, Applicant requests that the Board's October 18, 2011 order extending the time to oppose be rescinded, that the time to oppose registration of Applicant's Mark be terminated, and that a federal registration for Applicant's Mark be issued forthwith.

Dated: November 16, 2011

Respectfully submitted,

PAUL HASTINGS LLP

By: 
Robert L. Sherman
Bradford E. Young

75 East 55th Street
New York, NY 10022
212-318-6000

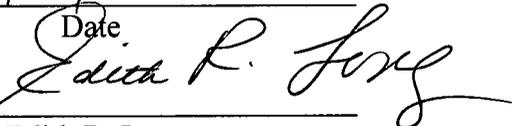
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as express mail, in an envelope addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

on 11/16/11
Date



Edith R. Lopez

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

In the Matter of Application Serial No. 85/081,235
Published in the Official Gazette on June 21, 2011
Mark: L'HOMME LIBRE
Applicant: L'Oréal (UK) Limited
Examining Attorney: Giancarlo Castro
Law Office: 110

**DECLARATION OF BRADFORD E. YOUNG
IN SUPPORT OF APPLICANT'S REQUEST FOR RECONSIDERATION
OF BOARD'S ORDER GRANTING MOTION TO EXTEND TIME TO OPPOSE**

BRADFORD E. YOUNG declares, on information and belief, that:

1. I am a member of the bar of the State of New York and an associate attorney in the law firm of Paul Hastings LLP, attorneys for applicant L'Oréal (UK) Limited ("Applicant"), and submit this declaration in support of Applicant's request for reconsideration of the Board's order granting a potential opposer's motion to extend time to oppose.
2. I am one of four "other appointed attorneys" listed on trademark application Serial No. 85/081,235 for L'HOMME LIBRE (the "Application").
3. I have never spoken or communicated with Reginald Holmes or anyone claiming to represent Reginald Holmes or L'Homme Apparel & Accessories, potential opposer. I have never received any telephone call, email, letter, facsimile or other form of communication from Reginald Holmes, L'Homme Apparel & Accessories or anyone claiming to represent Reginald Holmes or L'Homme Apparel & Accessories.
4. I never consented to Reginald Holmes' request for an extension of time to oppose registration of Applicant's L'HOMME LIBRE mark.

5. I have spoken with Robert Sherman, who is listed as the Domestic Representative for the Application. Mr. Sherman has no recollection and no record or ever having spoken or communicated with, received any form of communication from, or granted any form of consent to Reginald Holmes, L'Homme Apparel & Accessories or anyone claiming to represent Reginald Holmes or L'Homme Apparel & Accessories.

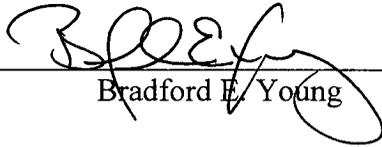
6. I have spoken with Natalie Furman, one of the "other appointed attorneys" listed on the Application. Ms. Furman never spoke or communicated with, received any form of communication from, or granted any form of consent to Reginald Holmes, L'Homme Apparel & Accessories or anyone claiming to represent Reginald Holmes or L'Homme Apparel & Accessories.

7. Daren Garshelis and Michael Watson, the remaining two attorneys listed as "other appointed attorneys" on the Application, are no longer employed by Paul Hastings LLP. Mr. Garshelis left the employ of Paul Hastings LLP long before potential opposer requested the subject extension. Mr. Watson was not assigned to this Application. Upon information and belief, neither Mr. Garshelis nor Mr. Watson ever spoke or communicated with, received any form of communication from, or granted any form of consent to Reginald Holmes, L'Homme Apparel & Accessories or anyone claiming to represent Reginald Holmes or L'Homme Apparel & Accessories.

8. On November 10, 2011, Applicant and its attorneys first became aware of the grounds for Mr. Holmes's request for an additional 60 day extension to oppose the Application, which included "consent" and "extraordinary circumstances." Applicant's request for reconsideration promptly followed.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information and belief.

Dated: November 16, 2011



Bradford E. Young

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as express mail, in an envelope addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

on 11/16/11
Date


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