

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Taylor
2002

Mailed: September 3,

Opposition No. 91122244

Converse, Inc.

v.

American Outpost, LLC

Before Seeherman, Chapman and Bottorff,
Administrative Trademark Judges.

By the Board:

On March 14, 2002, after considering applicant's express abandonment without the written consent of opposer (filed February 4, 2002), the Board issued an order entering judgment against applicant, sustaining the opposition and refusing registration to applicant of involved application Serial No. 75/559,216 pursuant to Trademark Rule 2.135.¹ This case now comes up on applicant's request for reconsideration of that decision.

In support of its request, applicant argues that its abandonment and its request to terminate the opposition were filed pursuant to a written agreement between the

¹ Trademark Rule 2.135 provides that if, in an inter partes proceeding, the applicant files an abandonment without the

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parties. Applicant included copies of correspondence between the parties' counsel evidencing the purported agreement.

Opposer has opposed applicant's request for reconsideration, arguing that applicant misstates the settlement agreement reached between the parties and mischaracterizes the content of the parties' correspondence. Opposer essentially argues that, contrary to applicant's position, the confirmation letter does not contain opposer's written consent to the abandonment. Rather, opposer contends that its letter shows that opposer merely accepted the express offer contained in applicant's letter of December 21, 2001, namely, to abandon the involved application. Opposer further argues that applicant never asked for opposer's consent, and that considering the procedural posture of the case at the time of the settlement, the filing of an express abandonment would have the prejudicial effect applicant now wishes to avoid.

Opposer therefore maintains that the matter has been settled according to the terms of applicant's letter and the motion for reconsideration should be denied.

Motions for reconsideration, as provided in Trademark Rule 2.127(b), permit a party to point out any error the

written consent of every adverse party to the proceeding,

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Board may have made in considering the matter initially. It is noted that the express abandonment did not reference or include the above-noted correspondence, nor did it contain even an allegation of opposer's consent thereto. Considered within the framework of Trademark Rule 2.135, which governs the abandonment of applications involved in inter partes proceedings, opposer's written consent was required.

Looking to the letters, in a December 21, 2001 letter from applicant's counsel, Brian H. Opalko, to opposer's counsel, Matthew Himich, Mr. Opalko states in pertinent part:

If Converse will agree not to oppose American Outpost's use or registration of the mark registered under Registration No. 2,289,980 in Class 35 for retail store services, American Outpost will agree not to use this mark on clothing and will cancel Class 25 from the registration. American Outpost will also agree to abandon the two applications involved in the oppositions.

Mr. Himich, in a January 10, 2002 "confirmation" letter, states:

Converse has authorized us to accept the offer contained in your letter of December 21, 2001. To save costs, we can allow the correspondence to evidence the parties' agreement without a formal written agreement. Please provide us service copies of your motions when they are filed with the

judgment shall be entered against applicant.

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Board. From the current procedural posture of these matters, it appears that it is not necessary for Converse to file any motion with the Board to effect the terms of this settlement. However, if necessary, Converse will agree to do so in the future to allow the parties to carry out their obligations as detailed in your December 21 letter.

After reviewing applicant's express abandonment and the parties' correspondence concerning the abandonment, we find no reason to deviate from the Board's earlier disposition. Specifically, we find nothing within the four corners of applicant's offer of settlement and opposer's confirmation letter that could be construed as opposer's written consent to applicant's abandonment of its application. Applicant's offer to abandon the involved application appears to have been conditioned on opposer's agreement not to oppose applicant's use and registration of the mark, AMERICAN OUTPOST and design, which is the subject of Registration No. 2,289,980. Additionally, there is no indication that the parties even discussed whether the application would be abandoned with or without opposer's consent. In short, the communication is silent on that matter. Accordingly, and by operation of Trademark Rule 2.135, judgment is appropriate inasmuch as applicant filed its express abandonment of application Serial No. 75/559,216 without the written

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consent of opposer. See *Grinnell Corp. v. Grinnell Concrete Pavingstones Inc.*, 14 USPQ2d 2065 (TTAB 1990).

In view of the foregoing, applicant's motion for reconsideration is denied and the Board's March 14, 2002 order stands as issued.