

TIAB

Docket No. 740120-179

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



In Matter of Trademark Application No. 75/936,519
Filed On: November 21, 2000



07-17-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

PUMA AG RUDOLF DASSLER SPORT)
Opposer)
v.)
MOURAD, SAMIR DBA DON REGALON)
Applicant.)

Opposition No. 123,141

02 JUL 23 AM 8:33
TRADEMARK TRIAL AND
APPEAL BOARD

MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION
AND TO EXTEND THE DISCOVERY PERIOD

Pursuant to 37 CFR 2.107 and Rule 15(a) Federal Rules of Civil Procedure, Opposer hereby moves for leave to amend the Notice of Opposition to add new paragraphs 3 and 4 and to make corresponding editorial amendments necessitated by the addition of these paragraphs in order to give Applicant fair notice of the claims asserted by Opposer, all as set forth in Second Amended Notice of Opposition attached hereto. In addition, Opposer hereby requests a one month extension of the discovery period (to seek discovery on the newly asserted claims) and all other times. If granted, the closing dates for periods within which to take action will be as follows:

- Discovery Period to Close (limited to discovery on the newly asserted claims only) : August 26, 2002
- 30 day testimony period for party in position of plaintiff to close: November 27, 2002
- 30 day testimony period for party in position of defendant to close: January 26, 2003
- 15-day rebuttal testimony period to close March 9, 2003

Background to the Motion

The Notice of Opposition was filed on February 15, 2001 and Applicant served its Answer on July 30, 2001. Since that time the parties have taken discovery by serving document requests, interrogatories and requests for admissions. On April 16, 2002 the parties filed a stipulated amendment to the Notice of Opposition and a corresponding stipulated amendment to the Answer to correct an incorrect registration number. The discovery period remains open with its closing presently set for July 26, 2002.

As a direct result of searching through documents to provide the discovery requested by Applicant, counsel for Opposer learned that Opposer had adopted and used on goods in International Class 25 a mark consisting of the letter "D" with a cat silhouette leaping through the letter "D" ("D" Design Mark). On June 11, 2002, counsel for Opposer advised counsel for Applicant of this fact and provided photocopies of catalog extracts showing use of the "D" Design Mark on footwear. Subsequently, counsel for Opposer learned that Opposer had adopted and used on goods in International Class 25 a mark consisting of the letter "P" with a cat silhouette leaping through the letter "P" ("P" Design Mark). Opposer now seeks to provide formal notice to Applicant of these claims and of Opposer's intent to assert them in this proceeding by amending the Notice of Opposition.

The Motion for Leave to Amend Should be Granted

37 CFR 2.107 provides that "[p]leadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court." Leave to amend shall be freely given when justice so requires. See FRCP 15(a). In practice, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party. See TBMP §507.02 and cases cited.

The Board typically finds no prejudice to the applicant and grants leave to amend where the discovery period is still open when the motion is filed and opposer agrees to allow applicant further time for follow-up discovery on the newly asserted claims. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Leave to amend should be granted whenever doing so will not unduly delay the trial and the non-moving party has not shown that undue prejudice would result if the motion was granted. *Microsoft Corp. v. Qantel Business*

Systems Inc., 16 USPQ2d 1732 (TTAB 1990). In the present case the proceeding is still in the discovery period and Opposer is here proposing that the discovery period be extended an additional month to allow Applicant to seek discovery on the newly asserted claims. In these circumstances the proposed amendment of the Notice of Opposition cannot possibly prejudice Applicant who will have an adequate opportunity to explore Opposer's new claims prior to the opening of the testimony phase of this proceeding.

For the foregoing reasons, Opposer respectfully urges that the motion for leave to amend be granted and that the discovery period be extended one month solely for the purpose of allowing Applicant to seek discovery on the newly asserted claims.

Respectfully Submitted,

PUMA AG RUDOLF DASSLER SPORT

Dated: 07-17-02

A handwritten signature in black ink, appearing to read "David S. Safran", is written over a horizontal line. The signature is stylized and includes a large loop at the beginning.

David S. Safran
Stuart J. Friedman
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, VA 22102
(703) 790-9110
Attorneys for Opposer



07-17-2002

U.S. Patent & TMOfc/TM Mail RcptDt. #70

Docket No. 740120-179

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

In the Matter of Trademark Application No.
75/936,519

Published On: November 21, 2000

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on

PUMA AG RUDOLF DASSLER SPORT)	
Opposer)	
v.)	Opposition No. 123,141
MOURAD, SAMIR DBA DON REGALON)	
Applicant.)	

SECOND AMENDED NOTICE OF OPPOSITION

PUMA AG RUDOLF DASSLER SPORT, a corporation of Germany, located at Würzburger Strasse 13, D-91074 Herzogenaurach, Germany, (hereinafter, Opposer) believes that it will be damaged by registration of the mark shown in Trademark Application No. 75/936,519 and hereby opposes the same. The grounds for oppositon are as follows:

1. Opposer is the owner of U.S. Trademark Registration No. 1,354,044, registered August 13, 1985, for a design mark comprised of a leaping cat silhouette, as shown in Exhibit A attached to this Notice of Opposition, for goods which include, *inter alia*, "Clothing-Namely, Leisure Shoes, Boots, House Slippers, Sports Shoes, Sports and Leisure Clothing-Namely, Training Suits, Shorts, Sweaters, Pullovers, T-Shirts, Tennis Wear, Ski Wear, Leisure Suits, All Weather Suits, Wind Resistant Jackets, Slickers, Stockings, Soccer Socks, Gloves, Caps, Headbands, Bathing

Trunks and Bathing Suits” in International Class 25.

2. Opposer is the owner of U.S. Trademark Registration No. 1,039,274, registered May 11, 1976, for a design mark comprised of a leaping cat silhouette on a square background, as shown in Exhibit B attached to this Notice of Opposition, for goods which include, *inter alia*,: “Football Shoes; Baseball Shoes; Training Shoes; Track Shoes; Boxing Shoes; Basketball Shoes; Soccer Shoes; Tennis Shoes; Bathing Shoes; Sneakers; Golf Shoes; Ski Boots; Tennis Garments For Men- Namely, Tricot Shirts, Shorts; Socks; Overalls For Men; Sweatsuits For Men; Sweat Shirts For Men; Sport Shorts For Men” in International Class 25.

3. Since long prior to March 4, 2000, the filing date of Serial No. 75/936,519, Opposer adopted and commenced use of a leaping cat silhouette, either alone or in combination with other words and/or designs, as a trademark in connection with the marketing, promoting, offering for sale and selling of various items of clothing in the United States. The leaping cat silhouette, either alone or in combination with other words and/or designs, has since been continuously used by Opposer in connection with the marketing, promoting, offering for sale and selling of clothing items in the United States and is now in such use.

4. Since long prior to March 4, 2000, the filing date of Serial No. 75/936,519, Opposer adopted and commenced use of a design trademark comprised of the letter “D” with cat silhouette leaping through the letter “D” (“D” Design Mark), as shown in Exhibit C attached to this Notice of Opposition, for clothing, namely, shirts and footwear in International Class 25. Opposer first used the “D” Design Mark in U.S. commerce at least as early as the Fall of 1993 and has continuously used the “D” Design Mark in U.S. commerce to the present. On May 30, 2002, Opposer filed a U.S. trademark application directed to the “D” Design Mark for use on goods in International Class 25.

5. At least as early as June, 2001, Opposer adopted and commenced use of a design trademark comprised of the letter “P” with cat silhouette leaping through the letter “P” (“P” Design Mark), as shown in Exhibit D attached to this Notice of Opposition, for clothing, namely T-shirts in International Class 25.

6. As a result of the extensive use and advertising by Opposer of the trademarks referred to in paragraphs 1-5 hereof, said marks have become extremely well known as symbolic of Opposer and Opposer has built up valuable goodwill in said marks such that the marks have come to identify Opposer's goods, including clothing, and distinguish Opposer's good, including clothing, from the related goods of others.

7. The goods identified by Applicant in Application Serial No. 75/936,519, are either the same, substantially included within or closely related to the goods on which Opposer has previously used and now uses the trademarks referred to in paragraphs 3-5 hereof and to the goods recited in Opposer's registrations referred to in paragraphs 1 and 2 hereof.

8. The mark for which Applicant seeks registration in Application Serial No. 75/936,519 (hereinafter "Applicant's Mark"), is composed of the silhouette of a leaping cat, which resembles a puma, passing through the legs of the letter "V". Applicant's Mark is substantially identical or equivalent to or creates the same or substantially the same commercial impression in the minds of prospective purchasers as the trademarks referred to in paragraph 3-5 hereof previously used by Opposer and Opposer's registered marks referred to in paragraphs 1 and 2 hereof, and is likely when applied to the goods of Applicant identified in Serial No. 75/936,519, to cause confusion, or to cause mistake, or to deceive, all to Opposer's damage.

9. Upon information and belief, Applicant has made no use of Applicant's Mark prior to March 4, 2000, the filing date of Serial No. 75/936,519.

10. Opposer's leaping cat trademarks referred to in paragraph 3 hereof have had extensive national exposure for decades, being prominently apparent on National Football League team uniforms, and on clothing worn by numerous athletic stars, over the years. As a result of the extensive use and advertising of Opposer's marks and the publicity associated with their use by well known athletes and teams for many years, Opposer's leaping cat marks have become famous. Registration and use by Applicant of Applicant's Mark will dilute the distinctive quality of

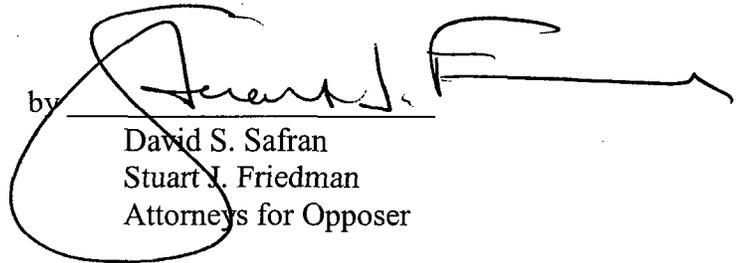
Opposer's leaping cat marks, all to Opposer's damage.

11. Opposer has used a variety of puma type cat marks for clothing over the years in addition to those of the registrations cited in paragraphs 1 and 2, as is reflected by U.S. Trademark Registration Nos. 1,475,983; 1,356,742; and 1,095,276. As a result, the public has come to associate puma type cat marks, generally, with Opposer. Registration and use of the Applicant's Mark will affect Opposer's right to continue to freely use puma type cat marks and will dilute the public's association of puma type cat marks with Opposer.

WHEREFORE, Opposer respectfully prays that this Opposition be sustained and that issuance of a registration based upon application Serial No. 75/936,519 be refused.

PUMA AG RUDOLF DASSLER SPORT

by

A handwritten signature in black ink, appearing to read "David S. Safran", is written over a horizontal line. The signature is stylized and somewhat cursive.

David S. Safran
Stuart J. Friedman
Attorneys for Opposer

NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, Virginia 22102
Telephone: (703) 790-9110

Int. Cls.: 18, 25 and 28



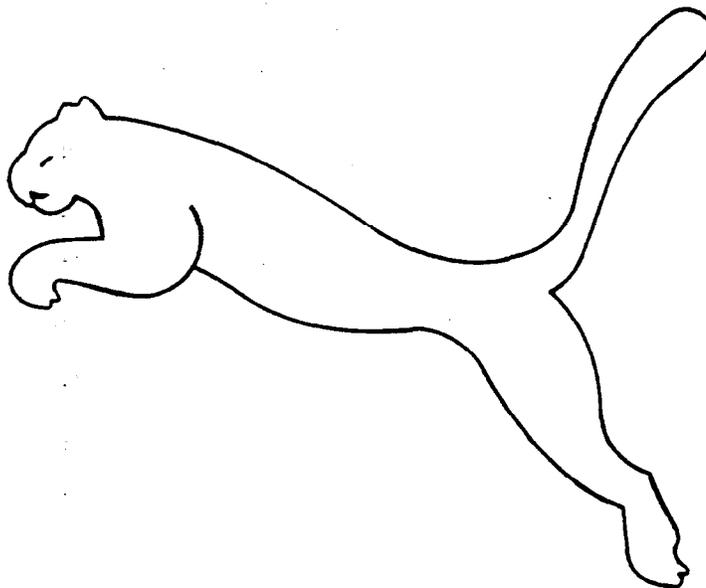
Prior U.S. Cls.: 3, 22 and 39

United States Patent and Trademark Office

Reg. No. 1,354,044

Registered Aug. 13, 1985

**TRADEMARK
PRINCIPAL REGISTER**



PUMA-SPORTSCHUHFABRIKEN RUDOLF
DASSLER KG (FED REP GERMANY LIMITED PARTNERSHIP)
HERZOGENAURACH, FED REP GERMANY

FOR: GENERAL PURPOSE CARRYALL BAGS FOR SPORTS EQUIPMENT, TRUNKS AND TRAVELLING BAGS, IN CLASS 18 (U.S. CL. 3).

FOR: CLOTHING—NAMESLY, LEISURE SHOES, BOOTS, HOUSE SLIPPERS, SPORTS SHOES, SPORTS AND LEISURE CLOTHING—NAMESLY, TRAINING SUITS, SHORTS, SWEATERS, PULLOVERS, T-SHIRTS, TENNIS WEAR, SKI WEAR, LEISURE SUITS, ALL

WEATHER SUITS, WIND RESISTANT JACKETS, SLICKERS, STOCKINGS, SOCCER SOCKS, GLOVES, CAPS, HEADBANDS, BATHING TRUNKS AND BATHING SUITS, IN CLASS 25 (U.S. CL. 39).

FOR: BALLS FOR SPORTS, IN CLASS 28 (U.S. CL. 22).

OWNER OF FED REP GERMANY REG. NO. 971,711, DATED 10-14-1977, EXPIRES 10-14-1987.

SER. NO. 292,728, FILED 1-12-1981.

FRANCIE R. GOROWITZ, EXAMINING ATTORNEY

Int. Cl.: 18, 25, 28

Prior U.S. Cl.: 3, 22, 39

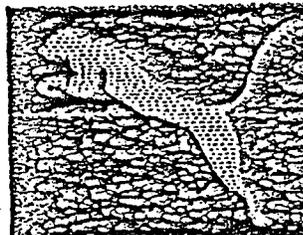
United States Patent Office

Reg. No. 1,039,274

Registered May 11, 1976

TRADEMARK

Principal Register



Puma-Sportschuhfabriken Rudolf Dassler KG (German company)
Wurzburger Strasse 13
D-8522, Herzogenaurach, Germany

For: SHOPPING BAGS, KNAPSACKS, BRIEF CASES, ATTACHE CASES AND HANDBAGS, in CLASS 18 (U.S. CL. 3).

For: FOOTBALL SHOES; BASEBALL SHOES; TRAINING SHOES; TRACK SHOES; BOXING SHOES; BASKETBALL SHOES; SOCCER SHOES; TENNIS SHOES; BATHING SHOES; SNEAKERS; GOLF SHOES; SKI BOOTS; TENNIS GARMENTS FOR MEN—NAMELY, TRICOT SHIRTS, SHORTS; SOCKS; OVERALLS FOR MEN; SWEATSUITS FOR MEN; SWEAT SHIRTS FOR MEN; SPORT SHORTS FOR MEN; FOOTBALL SHOULDER PADS; FOOTBALL LEG PADS—in CLASS 25 (U.S. CL. 39).

For: SPORTS GOODS—NAMELY, FOOTBALL LEG PADS AND FOOTBALL SHOULDER PADS, BALLS, SOCCER BALLS, TENNIS BALLS, SKIS, TENNIS RACKETS, TABLE TENNIS BATS, PING-PONG BALLS, BADMINTON RACKETS, SHUTTLECOCKS, JAVELINS, ROLLERSKATES, INDIAN CLUBS, SPORTS HOOPS AND DISCUS—in CLASS 28 (U.S. CL. 22).

First use April 1968; in commerce August 1969.
The drawing is lined for the color silver, but applicant does not intend to limit the scope to the silver color.
Owner of U.S. Reg. Nos. 797,843, and 903,072.

Ser. No. 19,649, filed Apr. 24, 1974.

LENORE LADY, Examiner

Applicant:

PUMA AG Rudolf Dassler Sport

Address:

Wuerzburger Str. 13,
D-91074 Herzogenaurach, Federal Republic of Germany

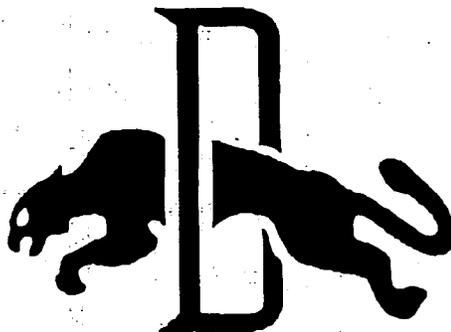
Date of First Use:

At least as early as Fall, 1993

Date of First Use in Interstate Commerce: At least as early as Fall, 1993

Goods:

CLOTHING, NAMELY, SHIRTS; AND FOOTWEAR in Int.
Class 25





CERTIFICATE OF SERVICE

It is hereby certified that copies of the foregoing:

1. Motion For Leave to Amend Notice of Opposition and to Extend the Discovery Period;
2. Second Amended Notice of Opposition

were mailed by first class mail, postage prepaid, on July 17, 2002 to:

Lee Fredric Sharra, Esq.
TROJAN LAW OFFICES
9250 Wilshire Blvd.
Suite 325
Beverly Hills, CA 90212
(310) 777-8399