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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PORT CARLING CORPORATION, Opposer, v. JULIE SOMERS, Applicant.	Opposition No. 91,152,840 Serial No.: 76/255,860 I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on June 26, 2003 (Date) Jonathan A. Hyman

OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION TO DELETE CLAIMS AND CAUSES OF ACTION

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

ATT: BOX TTAB NO FEE

Dear Sir:

I. INTRODUCTION

PORT CARLING CORPORATION (hereinafter "Opposer") hereby requests that the Trademark Trial and Appeal Board (hereinafter the "Board") grant Opposer's Motion For Leave To Amend Notice Of Opposition To Delete Claims And Causes Of Action filed in connection with the above-identified Opposition proceeding.

II. STATEMENT OF FACTS

Opposer filed a Notice of Opposition against JULIE SOMERS' (hereinafter "Applicant") U.S. Trademark Application Serial No. 76/255,860 for the mark SOMERSEASONS GREETINGS ASHLEY & Design on September 3, 2002. Applicant filed an Answer to Notice of Opposition on October 23, 2002. The discovery period closed on March 30, 2003. However, Applicant did not conduct any discovery during the discovery period. Applicant's testimony period has not yet opened. Opposer now files this Motion For Leave to allow it to amend its Notice of Opposition to **delete** certain claims and causes of action. In particular, Opposer wishes to delete its reliance on the mark SOMERS by itself, as well as its Right of Publicity cause of action under Sections 2(a) and 2(c) of the Trademark Act. A copy of Opposer's Amended Notice of Opposition is attached hereto as Exhibit A.

III. MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF OPPOSER'S MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION

A. APPLICABLE STANDARD

TBMP § 507.01 states that "the primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted." Furthermore, TBMP § 507.01 states that a party may amend its pleading "only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires."

Consistent therewith, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See* Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503 (TTAB 1993); and United States Olympic Committee v. O-M Bread Inc., 26 U.S.P.Q.2d 1221 (TTAB 1993).

B. OPPOSER'S PROPOSED AMENDMENTS TO THE NOTICE OF OPPOSITION DELETE CLAIMS AND CAUSES OF ACTION AND ARE NOT PREJUDICIAL TO THE APPLICANT

TBMP § 507.02 states that "[t]he timing of a motion for leave to amend under FRCP 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment." In this instance, the timing of the amendment will not prejudice the Applicant. Opposer proposes to delete certain opposition bases. The Applicant has not conducted any discovery and her testimony period has not opened.

Further, by deleting the claims and causes of action, Opposer is narrowing the scope of opposition. If anything, this will benefit the Applicant. Additionally, the proposed amendment will preserve judicial economy by conserving the Board's time in not having to address claims or causes of action that the Opposer has determined are not necessary to the opposition.

The Board has granted amendments to pleadings to add causes of action in numerous cases, for numerous reasons, and has allowed such amendments because there was no prejudice to the Applicant. *See* TBMP § 507 and cases cited therein. In those instances, the Board found no prejudice because Applicant was granted time, or had time to conduct discovery on the newly added issues. Further, under Fed. R. Civ. P. 15(a), it is within the discretion of the Board to deny leave to amend where new claims radically shift the nature of the opposition, requiring the applicant to engage in substantial new discovery or to undertake an entirely new course of argument late in the case. *See* Lockheed Martin Corp. v. Network Solutions, Inc., 175 F.R.D. 640 (C.D. Cal. 1997). In this instance, Opposer is not adding any new claims The deletion of claims and causes of action does not shift the nature of the opposition nor does it require Applicant to engage in additional discovery. The proposed amendment does not have a prejudicial effect on Applicant because there are no new issues for which Applicant needs to take

discovery. Applicant was previously on notice of Opposer's remaining claims by virtue of the originally filed Notice of Opposition.

Opposer's proposed amendments have quite the opposite effect of creating prejudice. By amending the Notice of Opposition, Opposer has streamlined the case and will save the parties' time and expense in addressing claims which Opposer no longer wishes to rely on in the opposition.

C. OPPOSER'S PROPOSED AMENDMENTS TO THE NOTICE OF OPPOSITION DELETE CLAIMS AND CAUSES OF ACTION WHICH ARE NOT ESSENTIAL TO THE OPPOSITION

Opposer's proposed amendments to the Notice of Opposition delete claims and causes of action which are not essential to the opposition. In doing so, Opposer still maintains its causes of action under Section 2(d) of the Trademark Act and still maintains standing and legal grounds for the opposition as stated in the originally filed Notice of Opposition. The deletion of the claims and causes of action do not affect Opposer's ability or grounds to oppose Applicant's application, or Applicant's ability to defend the opposition.

D. OPPOSER'S PROPOSED AMENDMENTS TO THE NOTICE OF OPPOSITION TO DELETE CLAIMS AND CAUSES OF ACTION DO NOT CAUSE A DELAY IN THE PROCEEDING

Opposer's proposed amendments to the Notice of Opposition to delete claims and causes of action do not cause a delay in the opposition proceeding. In fact they have the opposite effect. By deleting claims on which Opposer does not wish to rely, Opposer has narrowed the scope of the applicable issues which will allow the parties to conduct testimony on only the issues on which Opposer wishes to rely. Thus, the granting of leave to amend will alleviate the necessity of conducting testimony on issues on which Opposer does not wish to rely. In light of this fact, the result of the amendment will be not to cause a delay.

E. OPPOSER'S PROPOSED AMENDMENTS TO THE NOTICE OF OPPOSITION ARE NOT OF THE TYPE THAT REQUIRE REOPENING OF APPLICANT'S DISCOVERY PERIOD

In light of the fact that Opposer is merely deleting claims and causes of action from its Notice of Opposition, the proposed amendments are not of the type which would require the reopening of Applicant's discovery period. Because the amendment is a deletion, the proposed amendments do not add any issues which Applicant did not have opportunity on which to serve and obtain discovery. In fact, Applicant chose not to conduct any discovery during the discovery period, and should not be granted a chance to do so in light of Opposer's proposed deletions.

IV. CONCLUSION

In light of the fact that Opposer's proposed amendments to the Notice of Opposition do not add or amplify any issues to those originally pleaded in the Notice of Opposition, the amendments will not cause prejudice to Applicant, nor will they delay the proceedings. Opposer therefore requests that its Motion For Leave To Amend Notice Of Opposition be granted.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6·26·03

By: _____

Diane M. Reed
Jonathan A. Hyman
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1900 Avenue of the Stars, Suite 1425
Los Angeles, CA 90067
(310) 551-3450
Counsel for Opposer,
PORT CARLING CORPORATION

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION TO DELETE CAUSES OF ACTION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 26, 2003, addressed as follows:

Rakesh M. Amin, Esq.
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062303

EXHIBIT A

THIGHM.047M TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PORT CARLING CORPORATION, Opposer, v. JULIE SOMERS, Applicant.	)	Opposition No. 91,152,840 Serial No.: 76/255,860 I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on June 26, 2003 (Date) Jonathan A. Hyman

AMENDED NOTICE OF OPPOSITION

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

ATT: BOX TTAB NO FEE

Dear Sir:

Opposer, Port Carling Corporation, a California corporation (hereinafter referred to as "Opposer"), located and doing business at 23679 Calabasas Road, PMB 664, Calabasas California 91302, believes that it will be damaged by registration of the mark shown in Application Serial No. 76/255,860, filed May 14, 2001 (the "'860 Application"), by Julie Somers, an individual, (hereinafter referred to as "Applicant") and hereby opposes same. A description of Applicant's mark is as follows:

MARK: SOMERSEASONS GREETINGS ASHLEY and Design
SERIAL NO.: 76/255,860
FILED: May 14, 2001
PUBLISHED: April 30, 2002
GOODS: greeting cards, Christmas cards, occasion cards, art prints, art print reproductions, comic strips, cartoons, gift wrapping paper, and other related paper products, namely, stationery, note pads, bookmarks and mailing labels in International Class 16.

As grounds of opposition, it is alleged:

1. Opposer is the owner of several marks which are variations of the mark SOMERS or incorporate the mark SOMERS, including **SUZANNE SOMERS, SOMERSIZE, SUZANNE SOMERS COLLECTION**, and **SOMERSWEET**. Opposer's SOMERS family of marks including, but not limited to, the **SUZANNE SOMERS, SOMERSIZE, SUZANNE SOMERS COLLECTION**, and **SOMERSWEET** marks are hereinafter collectively referred to as the "SOMERS Marks."

2. Opposer is a marketing, manufacturing, promotion and licensing company and has the authority to use Ms. Suzanne Somers' name, image, likeness, celebrity, and endorsement.

3. Ms. Suzanne Somers is a well known actress, model, author, dietician and fitness trainer, and is a spokeswoman for various products and services under the mark **SUZANNE SOMERS.**

4. [Deleted]

5. Opposer uses the Internet domain name <www.suzannesomers.com>. Since at least as early as July 15, 1997, Opposer has operated a website which prominently bears the **SUZANNE SOMERS, SOMERSIZE, SUZANNE SOMERS COLLECTION**, and **SOMERSWEET** marks, and through which Opposer offers for sale, markets, and distributes various consumer products including, but not limited to, books, videos, audio tapes, jewelry, jewelry boxes, furniture, food, candy and diet items, clothing, footwear, aprons, exercise products and equipment, cosmetics and skin care products, which website is located at the domain name <www.suzannesomers.com>.

6. Since at least as early as February 6, 1997, Opposer has been marketing, promoting and selling books, pre-recorded video and audio tapes featuring exercise programs and providing information on diet, nutrition, weight control, and exercise, and printed materials sold as a unit therewith, and other products under the mark **SOMERSIZE**.

7. Since at least as early as April 1991, Opposer has been marketing, promoting and selling jewelry under the mark **SUZANNE SOMERS COLLECTION.**

8. Since at least as early as May 2001, Opposer has been marketing, promoting and selling food and diet products under the mark **SOMERSWEET**.

9. Since at least as early as December 1992, Opposer has been marketing, promoting and selling food and diet products, books, videos, jewelry, clothing, hand bags, tote bags,

accessories, footwear, and exercise equipment and products under the mark **SUZANNE SOMERS**.

10. Opposer has used its SOMERS Marks throughout the United States and such use has been continuous since at least as early as the dates of first use listed above. By reason of Opposer's widespread and continuous use of the SOMERS Marks, Opposer has common law rights in all of the SOMERS Marks throughout the United States. Opposer's SOMERS Marks are symbolic of extensive goodwill and recognition built up by Opposer through substantial time and effort in advertising and promotion.

11. Opposer, through a license with Ms. Somers, has used and currently uses Ms. Somers' name, image, likeness, celebrity, and endorsement since at least as early as the dates of first use listed above.

12. Opposer is the owner of U.S. Trademark Registration No. 2,279,616 for the mark **SOMERSIZE** for "pre-recorded video and audio tapes featuring exercise programs and providing information on diet, nutrition, weight control, and exercise, and printed materials sold as a unit therewith in Class 9." Opposer's Registration No. 2,279,616 is based on an application filed in the U.S. Patent and Trademark Office on December 22, 1995. Said registration issued on September 21, 1999. Opposer first used the mark shown in this registration on the identified goods at least as early as February 6, 1997.

13. Opposer is also the owner of U.S. Trademark Registration No. 2,268,387 for the mark **SUZANNE SOMERS COLLECTION** for "jewelry in Class 14." Opposer's Registration No. 2,268,387 is based on an application filed in the U.S. Patent and Trademark Office on December 1, 1997. Said registration issued on August 10, 1999. Opposer first used the mark shown in this registration on the identified services at least as early as April 1991.

14. Applicant's '860 Application was filed May 14, 2001. Opposer's Registrations recited in paragraphs 12 and 13, are based on applications filed in the U.S. Patent and Trademark Office prior to the filing date of Applicant's application. Opposer's Registrations recited in paragraphs 12 and 13 were issued by the U.S. Patent and Trademark Office prior to the filing date of Applicant's application. Said Registrations are valid and subsisting. Further, Opposer's common law rights in each of the SOMERS Marks predate the filing date of Applicant's '860 Application. Therefore, Opposer's rights in the marks **SUZANNE SOMERS, SOMERSIZE, SUZANNE SOMERS COLLECTION**, and **SOMERSWEET** predate and are superior to

Applicant's rights in the SOMERSEASONS GREETINGS ASHLEY and Design mark shown in the '860 Application.

15. Applicant's mark SOMERSEASONS GREETINGS ASHLEY and Design is identical or confusingly similar to Opposer's SOMERS Marks in that it incorporates identically at least a portion of Opposer's SOMERS Marks. Applicant seeks registration of its mark for consumer paper products in Class 16. Thus, it is likely that Applicant will engage in offering the same types of consumer products on which Opposer uses its SOMERS Marks which are covered by Registration Nos. 2,279,616 and 2,268,387, and its common law rights.

16. Opposer relies on its Registration Nos. 2,279,616 and 2,268,387, and on its common law rights in each of the SOMERS Marks, as set forth above. In view of the similarity of Applicant's SOMERSEASONS GREETINGS ASHLEY and Design mark and Opposer's SOMERS Marks and the related nature of the respective goods and/or services, Opposer alleges that Applicant's mark so resembles Opposer's SOMERS Marks as to be likely to cause confusion or to cause mistake or to deceive, or to dilute Opposer's marks in violation of Section 2(d), 43(a), and 43(c) of the Trademark Act.

17. [Deleted]

WHEREFORE, Opposer prays that Application Serial No. 76/255,860 be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6·26·03

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **AMENDED NOTICE OF OPPOSITION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 26, 2003, addressed as follows:

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