

TTAB

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.

07-02-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

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 30, 2003

(Date)

Jonathan A. Hyman

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE NOTICE OF RELIANCE AND MOTION FOR LEAVE TO AMEND ADMISSIONS

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 deny Applicant's Motion To Strike Notice Of Reliance And Motion For Leave To Amend Admissions.

II. STATEMENT OF FACTS

Opposer filed the Notice of Opposition on August 28, 2002. Applicant filed an Answer to Notice of Opposition on October 21, 2002, but did not serve a copy on Opposer.

On December 4, 2002, Opposer's counsel sent a letter to Applicant and informed Applicant that "[i]f [Applicant chose] not to retain counsel in this matter, [Opposer] recommends that [Applicant] obtain a copy of the TTAB rules of procedure." See Opposer's Letter to Applicant Dated December 4, 2002, a copy of which is attached as Exhibit A.

On March 21, 2003, Opposer's counsel had a telephone conversation with a representative of Applicant, John Somers, whom is Applicant's husband. Mr. Somers informed Opposer's counsel that the Applicant would be retaining counsel to assist her in the Opposition. See Declaration of Diane Reed, a copy of which is attached as Exhibit B.

Opposer served Applicant with Opposer's First Request for Admissions, Opposer's First Interrogatories and Opposer's First Request For Production, which were sent by mail on March 28, 2003. Applicant's responses to Opposer's First Request for Admissions, Opposer's First Interrogatories and Opposer's First Request For Production were due by May 2, 2003.

On May 8, 2003, having received no discovery responses and no request for an extension, Opposer's counsel sent Applicant a letter which stated that:

[Applicant] should be aware that, until this matter settles, [Applicant is] still under an obligation to comply with the due dates set forth in [Opposer's] discovery requests and the Scheduling Order from the Trademark Trial and Appeal Board. Accordingly, you need to immediately respond to the discovery requests previously served on you, without objections.

See Opposer's Letter to Applicant Dated May 8, 2003, a copy of which is attached as Exhibit C.

In response to that May 8 letter, Applicant still did not respond to Opposer's Discovery requests, and did not request any extension of time to respond.

On May 22, 2003, Applicant informed Opposer's counsel that she had retained counsel. On May 29, 2003, Opposer's counsel spoke with Applicant's counsel, Rakesh Amin, regarding the opposition and the fact that Applicant still had not served responses to the discovery requests.

Opposer's counsel informed Mr. Amin that responses were past due and that Applicant had waived her right to object to the discovery requests. *See* Declaration of Diane Reed, a copy of which is attached as Exhibit B.

On June 5, 2003, Opposer's counsel sent Applicant's counsel a letter which stated that:

If your client does not intend to accept our settlement offer, she must immediately provide responses to our discovery requests which were mailed on March 28, 2003. We have reminded Ms. Somers several times of her obligation to respond to the discovery requests. In light of the fact that an extension was never granted, let alone requested, your client's responses are past due. Thus, your client has waived its right to object to the discovery requests. We expect to receive your client's responses by **June 12, 2003**. If we do not receive your client's responses by that date, we will be forced to file a Motion to Compel.

See Opposer's Letter to Applicant Dated June 5, 2003, a copy of which is attached as Exhibit D (emphasis in original).

On June 6, 2003, Opposer filed its Notice Of Reliance on based on Applicant's failure to serve responses to Applicant's First Request for Admission.

On June 12, 2003, Mr. Amin called Opposer's counsel and stated that he would serve Applicant's discovery responses by June 17, by facsimile. Opposer sent Applicant's counsel a letter which stated that:

[T]his is to confirm that I will receive your client's complete responses to Opposer's Interrogatories and Request for Production of Documents by Tuesday June 17, 2003. Please note that the Requests for Admission **already stand admitted**.

See Opposer's Letter to Applicant Dated June 12, 2003, a copy of which is attached as Exhibit E (emphasis added).

On June 17, 2003, Applicant filed a Motion To Strike Notice Of Reliance And Motion For Leave To Amend Admissions.

III. MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE NOTICE OF RELIANCE

A. APPLICABLE STANDARD

TBMP § 411 states that “[i]f a party upon which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect” Thus, the standard establishes that Applicant must prove that its failure to respond was the result of excusable neglect.

In *Hewlett-Packard Co. v. Olympus Corp.*, the Federal Circuit held that:

[t]he Board properly defined excusable neglect as failure to take the proper steps at the proper time, not in consequence of the party's own carelessness, inattention, or willful disregard of the process of the court, **but in consequence of some unexpected or unavoidable hindrance or accident, or reliance on the care and vigilance of his counsel or on promises made by the adverse party.**

931 F.2d 1551, 1553, 18 U.S.P.Q.2d 1710 (Fed. Cir. 1991) (citing Opposition No. 77,043, slip op. at 3 (TTAB 1990) (citing *Black's Law Dictionary* 508 (5th ed. 1979))) (emphasis added).

In *Pioneer Investment Service Co. v. Brunswick Associates Limited Partnership*, the Supreme Court clarified the meaning of “excusable neglect,” and established a four-factor test. 507 U.S. 380 (1993). The four-factors in the *Pioneer* case are (1) the danger of prejudice to the non-movant; (2) the length of delay and its potential impact on the judicial proceeding; (3) the reason for the delay, including whether it was within the reasonable control of the movant; and (4) whether the movant acted in good faith. 507 U.S. 380 (1993).

In subsequent applications of the *Pioneer* test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was in the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin Ltd.* at 1586, footnote 7, *Atlanta-Fulton County Zoo Inc. v. Depalma* 45 U.S.P.Q.2d 1858 (T.T.A.B. 1998).

B. BURDEN TO ESTABLISH EXCUSABLE NEGLIGENCE IS ON THE MOVING PARTY

Under Fed. R. Civ. P. 6(b), applicant, as the moving party, must show that its failure to act was the result of excusable neglect.

C. APPLICANT'S FAILURE TO RESPOND TO OPPOSER'S FIRST REQUEST FOR ADMISSIONS IS NOT THE RESULT OF EXCUSABLE NEGLIGENCE

Applicant failed to respond or seek an extension to respond to Opposer's First Requests for Admissions. Applicant has not provided any argument to support that its failure to respond was the result of excusable neglect. Instead, Applicant alleges that its failure to serve responses to the Requests for Admissions is based on: (1) the erroneous statement that Opposer granted Applicant an extension to respond; and (2) the fact that Applicant has only recently hired an Attorney. In *Pumpkin, Ltd. v. The Seed Corps*, the Board carefully explained that in determining whether a party's failure amounts to "excusable neglect," it takes into account all relevant circumstances surrounding the party's omission, including whether the delay was reasonably within the control of the moving party. 43 U.S.P.Q.2d 1582, 1585-86 (T.T.A.B 1997). Because Applicant's delay was reasonably in her control, it is not the result of excusable neglect.

1. Applicant Alleges That Opposer Granted An Extension

Applicant alleges that Opposer's counsel granted an extension for Applicant to respond to the Requests for Admissions. Applicant's counsel has misstated the truth. Opposer never granted Applicant an extension to respond to the Request for Admission. In fact, by the time Applicant's counsel was allegedly retained by Applicant, the Requests for Admission were past due and already deemed admitted pursuant to TBMP 411.01. Applicant's counsel alleges that an extension was granted on June 5, 2003. See Applicant's Motion To Strike Notice Of Reliance, attached hereto as Exhibit F. Rather, on June 5, Opposer's counsel demanded of Applicant's counsel that discovery responses be served by June 12. This did not constitute an extension of

the due date. Additionally, in its letter dated June 12, 2003, Opposer notified Applicant that she had already failed to respond to Applicant's discovery, and as a result, the Requests for Admissions were deemed admitted. Applicant relies on an extension which was not granted or even requested. In light of the fact that no extension was granted, Applicant cannot be excused from timely filing responses to the Requests for Admission. Accordingly, under operation of the rules of the Board, the Requests for Admission are deemed admitted.

Further, Applicant states that her Motion to Strike should be granted "because Opposer waived the right to request Applicant's Responses to Opposer's First Request For Admissions by June 5, 2003 as the Opposer orally granted an extension on responses." See Applicant's Motion To Strike Notice Of Reliance. Applicant mistakenly presumes that her responses were due June 5. Again, Applicant's responses were due May 2. On June 5, Opposer's counsel demanded of Applicant's new counsel that responses be served no later than June 12. On June 12, Applicant's counsel notified Opposer's counsel that responses would not be served until June 17.

Applicant also alleges that it "was represented that Applicant had time to decide whether to settle before having to answer Opposer's First Request For Admissions." See Applicant's Motion To Strike Notice Of Reliance. If Applicant wished to suspend its time for filing responses to the Request for Admissions, she should have sought and obtained Opposer's consent, or filed a motion with the Board for suspension of the Opposition proceedings on the grounds that the parties were in settlement negotiations. In *Old Nutfield Brewing Company, Ltd. V. Hudson Valley Brewing Company, Inc.*, the Board, in analyzing the third *Pioneer* factor regarding the reason for delay when it was alleged that the parties were negotiating a possible settlement, held that:

[u]ltimately, however, it makes little difference whether the parties did or did not discuss settlement after the notice of opposition was filed. Discovery and trial dates in a Board proceeding are not suspended automatically, but will only be extended or suspended upon motion. The Board is liberal in granting reasonable

extensions or suspension of trial dates when parties are engaged in serious bilateral settlement discussions. **However, a party which fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk, and should not expect that such relief will be granted retroactively, particularly -- as here -- over the opposing party's objection.**

65 U.S.P.Q.2d 1701, 2002 WL 1832021, *4 (TTAB 2002).

Likewise, in *Atlanta-Fulton County Zoo*, Opposer also argued that its failure to act was the result of the fact that the parties were in settlement negotiations. However, the Board held that “[a]s regards opposer's contention that the parties were continuing to explore settlement possibilities during opposer's testimony period, it is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay.” 45 U.S.P.Q.2d 1859.

Thus, in light of the fact that an extension of time to respond to the Request for Admission was not granted, let alone asked for, Applicant cannot rely on mere settlement negotiations or discussions regarding extensions for its failure to respond to the Request for Admissions. Because the failure to timely serve responses to the Requests for Admissions was under the control of Applicant, her failure to comply with the rules of the Board is not the result of excusable neglect.

2. Applicant's Failure To Hire Counsel Does Not Constitute Excusable Neglect

Applicant also states that “the Applicant did not even have an attorney until recently and was misled by Opposer as to time to answer.” Applicant's new counsel, Rakesh Amin, was hired on at least May 22, 2003. At all times prior to and after the filing of the Notice of Opposition, Applicant was aware of the fact that she should hire counsel to represent herself. This is evidenced by the numerous times Opposer informed Applicant that she should obtain counsel. Applicant's reliance on her failure to hire counsel as her reason for not responding to the Requests for Admission is clearly a consequence of the party's own carelessness, inattention, or

willful disregard of the process of the court. As such, Applicant should not be allowed to overcome her failure to comply with the rules of the Board based on her carelessness, inattention, or willful disregard in not diligently hiring counsel in this matter. The decision not to obtain counsel was made consciously, on the basis of free knowledge of the issues involved. Thus, Applicant cannot claim mistake, inadvertence, surprise, or excusable neglect. Accordingly, Applicant should not be deemed to benefit from her decision or indecision not to timely hire counsel in the opposition, especially in light of Opposer's counsel's numerous requests to do so.

In *Atlanta-Fulton County Zoo*, the Board addressed an Opposer's motion to reopen its testimony period for failure to timely present evidence. The board held that:

opposer's failure to timely present evidence during the prescribed testimony period was due to circumstances wholly within its control. Indeed, opposer neither contends that it was unaware of the discovery and trial deadlines nor that it was in any way prevented from taking action. As such, the critical inquiry is whether opposer's oversight in filing a motion to extend is excused by its participation in other matters regarding this case.

45 U.S.P.Q.2d at 1859.

Furthermore, Applicant's failure to hire counsel is not the consequence of some unexpected or unavoidable hindrance or accident, or reliance on the care and vigilance of her counsel or on promises made by the adverse party. Accordingly, Applicant's failure to hire counsel does not constitute excusable neglect and cannot be the bases for a Motion to Strike. The failure to timely hire counsel is not an excuse for not complying with the rules of procedure of the Board. Applicant's failure to timely respond to the request for Admission was the result of her own inaction. As Applicant has chosen to ignore the applicable rules, Applicant's request should be denied.

Further, Opposer never “misled” Applicant. Rather, Opposer’s counsel reminded Applicant of her obligation to respond. Applicant has not otherwise contended that she was unaware of the discovery deadline, nor that she was in any way prevented from taking action.

3. Remaining Pioneer Factors

(a) Applicant Has Not Acted In Good Faith

Applicant has not set forth any contentions that she has acted in good faith. In fact, in making its motion, Applicant has acted in bad faith by misstating the truth by wrongly asserting that an extension of time to respond to the Requests for Admission was asked for and granted. Accordingly, Applicant’s motion is being brought with unclean hands, and she should not be allowed to benefit from her counsel’s misstatement of the truth.

(b) The Danger Of Prejudice To The Non-Movant and The Length Of Delay And Its Potential Impact On The Judicial Proceeding

Opposer respectfully submits that, in light of Applicant’s bad faith in bringing this motion, and the fact that the delay is not the result of excusable neglect, but merely caused by Applicant’s own inaction, the remaining factors should not be determinative on the matter. Nevertheless, Opposer respectfully submits that if Applicant’s Motion To Strike, or in the alternative Motion For Leave to Amend, is granted, the Board will be setting a dangerous precedent which will allow parties to delay in responding to discovery, or presumably take any action, until the party hires an attorney and not suffer any consequences. While Opposer recognizes that *pro se* parties are granted some leeway in proceedings, *pro se* parties are still subject to the same rules and procedures as parties represented by counsel. If Applicant’s motions are granted, the Board would presumably be allowing for two sets of discovery deadlines and rules depending on whether a party is represented in a matter or not. The adoption

of such a policy by the Board would result in prejudice to all parties represented by counsel in oppositions and cancellations against *pro se* parties before the Board.

IV. MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF OPPOSER'S RESPONSE TO APPLICANT'S MOTION FOR LEAVE TO AMEND ADMISSIONS

As an alternative to its Motion to Strike, Applicant has also filed a Motion For Leave To Amend Admissions. TBMP § 525 states that:

[a]ny matter admitted under FRCP 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. This applies both to matters expressly admitted; **and to those deemed admitted for failure to timely respond to a request for admission, where there is no persuasive showing that the failure to timely respond was the result of excusable neglect.**

Id. (citing FRCP § 6(b) and 36, and TBMP §§ 411.01 and 411.04) (internal citations removed) (emphasis added).

Accordingly, the standard for determining whether leave to amend answers to admissions for failing to timely respond to request for admissions is the “excusable neglect” standard discussed above. Applicant relies on its same allegations raised in its Motion to Strike for its Motion For Leave to Amend. As discussed, Applicant’s excuses in its Motions do not constitute excusable neglect. Thus, Applicant’s Motion For Leave to Amend should be denied.

IV. CONCLUSION

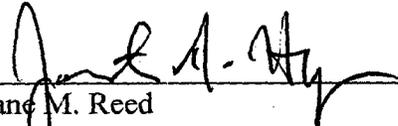
Opposer therefore requests that Applicant’s Motion To Strike Notice Of Reliance And Motion For Leave To Amend Admissions should be denied and stricken as untimely and baseless. Additionally, Opposer requests that Opposer’s First Request for Admissions stand deemed admitted. In the event the Board grants Applicant’s Motion To Strike Notice Of Reliance And Motion For Leave To Amend Admissions, Opposer respectfully requests that the discovery period **not** be reopened and that the Opposition proceedings continue to proceed under the dates

set forth in the Motion On Consent For Extension Of Testimony Dates submitted on June 26, 2003.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6.30.03

By: 

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

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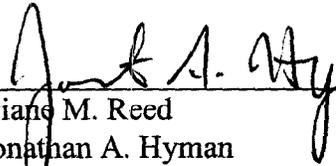
EXHIBITS

- Exhibit A Opposer's Letter to Applicant Dated December 4, 2002
- Exhibit B Declaration of Diane Reed
- Exhibit C Opposer's Letter to Applicant Dated May 8, 2003
- Exhibit D Opposer's Letter to Applicant Dated June 5, 2003
- Exhibit E Opposer's Letter to Applicant Dated June 12, 2003.
- Exhibit F Applicant's Motion To Strike Notice Of Reliance

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE NOTICE OF RELIANCE AND MOTION FOR LEAVE TO AMEND ADMISSIONS** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 30, 2003, addressed as follows:

Rakesh M. Amin, Esq.
WEAVER & AMIN
217 North Jefferson Street, Suite 602
Chicago, Illinois 60661



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

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EXHIBIT A

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

1900 Avenue of the Stars
Suite 1425
Los Angeles CA 90067
Tel 310-551-3450
Fax 310-551-3458
www.kmob.com

Jonathan A. Hyman
jhyman@kmob.com

December 4, 2002

VIA FEDERAL EXPRESS

Ms. Julie Somers
31 Jonquil Drive
Guntersville, Alabama 35976

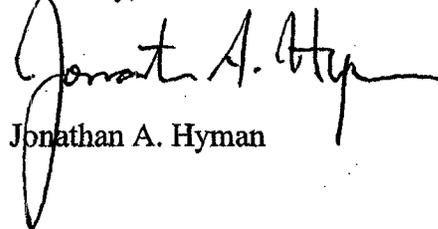
Re: Infringement of SOMERS Trademarks
Opposition No.: 152,840
Our Reference No.: THIGHM.047TIS/M

Dear Ms. Somers:

We have not yet received your response to our letter of September 24, 2002, a copy of which is enclosed for your review. Please inform us if you are interested in reaching an amicable resolution to this matter. Otherwise we will recommend that our client proceed by conducting discovery in the opposition proceeding. Additionally, we note that you have filed an Answer to our Notice of Opposition. However, we have not yet received a copy of your Answer. You should be aware that the Trademark Trial and Appeal Board ("TTAB") rules of procedure require that you serve a copy of the Answer on the plaintiff by certificate of service. If you choose not to retain counsel in this matter, we recommend that you obtain a copy of the TTAB rules of procedure.

We look forward to receiving your response. If you have any questions regarding this matter please have your attorney contact us, or if you are not represented by an attorney, you may contact us directly.

Sincerely,



Jonathan A. Hyman

Enclosure

cc: Diane M. Reed, Esq.
Natalie B. Rodriguez

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Exhibit A Page 1 of 7

Orange County
949-760-0404

San Diego
619-235-8550

San Francisco
415-954-4114

Riverside
909-781-9231

San Luis Obispo
805-547-5580

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Intellectual Property Law

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Jonathan A. Hyman
jhyman@kmob.com

September 24, 2002

VIA FEDERAL EXPRESS

Ms. Julie Somers
31 Jonquil Drive
Guntersville, Alabama 35976

Re: Infringement of SOMERS Trademarks
Opposition No.: 152,840
Our Reference No.: THIGHM.047TIS/047M

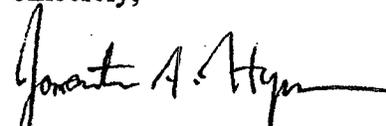
Dear Ms. Somers:

As you may be aware, we filed a Notice of Opposition on behalf of our client Thighmaster World Corporation and its related companies SLC and Port Carling (collectively referred to as "Thighmaster World") against your Application Serial No. 76/255,860 to register the SOMERSEASONS GREETINGS ASHLEY & Design mark. A courtesy copy of our Notice of Opposition is attached for your reference.

Thighmaster World still wishes to resolve this matter amicably, if possible. Accordingly, we request that you agree to cease all use of the SOMERSEASONS GREETINGS ASHLEY & Design mark, or any other mark that may be confusingly similar to our client's marks, and expressly abandon your pending trademark application.

The demands asserted in this letter are without prejudice to and with full reservation of all other rights or remedies our client may have in this matter. We look forward to receiving your response. If you have any questions regarding this matter please have your attorney contact us, or if you are not represented by an attorney, you may contact us.

Sincerely,


Jonathan A. Hyman

Enclosure

cc: Diane M. Reed, Esq.
Rachel E. Lehrer
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Exhibit A Page 2 Of 7

Orange County
949-760-0404

San Diego
619-235-8550

San Francisco
415-954-4114

Riverside
909-781-9231

San Luis Obispo
805-547-5580

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As grounds of opposition, it is alleged:

1. Opposer is the owner of the mark SOMERS and several other marks which are variations of the mark SOMERS or incorporate the mark SOMERS, including SUZANNE SOMERS, SOMERS, SOMERSIZE, SUZANNE SOMERS COLLECTION, and SOMERSWEET. Opposer's SOMERS family of marks including, but not limited to, the SUZANNE SOMERS, 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. Since at least as early as 1954, Ms. Somers has been appearing in television shows and motion pictures including, but not limited to, Three's Company, American Graffiti, Step By Step, The Suzanne Somers' Show, The Simpsons, and Say It Ain't So.

4. Ms. Somers has received numerous awards and honors including, but not limited to, People's Choice Award, Best Female Performer in a New TV Series, *Three's Company* (1978); Las Vegas Entertainer of the Year (1984); People's Choice Award, Best Female Performer in a New TV Series, *Step By Step* (1992); National Council on Alcoholism: Humanitarian Award (1992); and National Association of American Drug Counselors: President's Award (1993).

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, 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

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as a unit therewith, ice cream makers, food and diet products, jewelry, apparel and exercise equipment and 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 marks **SUZANNE SOMERS** and **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. By reason of Opposer's widespread and continuous use of Ms. Somers' name, image, likeness, celebrity, and endorsement, Opposer has rights of publicity in the name, image, likeness, celebrity and endorsement of Ms. Somers throughout the United States. Opposer's rights of publicity are representative of the extensive economic value built up by Opposer through substantial time and effort in advertising and promotion.

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.

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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**, **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 Opposer's mark **SOMERS**. 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. Opposer relies on the right of publicity of Ms. Somers as set forth above. In view of the similarity of Applicant's **SOMERSEASONS GREETINGS ASHLEY** and Design mark and Opposer's rights of publicity in the name, image, likeness, celebrity and endorsement of Ms.

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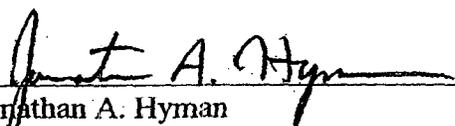
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Somers, Opposer alleges that Applicant's mark so resembles Ms. Somers' name, image, likeness, celebrity and endorsement as to be likely to falsely suggest a connection with Opposer in violation of Section 2(a) of the Trademark Act, and to be likely to identify a particular living individual in violation of Section 2(c) of the Trademark Act.

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: 8.28.02

By: 
Jonathan A. Hyman
Diane M. Reed
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(310) 551-3450
Counsel for Port Carling Corporation, Opposer

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082702

EXHIBIT B

Mark: **SOMERSEASONS GREETINGS & Design**
Opposition No.: **91,152,840**

5. On May 29, 2003, I spoke with Applicant's counsel, Rakesh Amin, regarding the opposition and the fact that Applicant still had not served responses to the discovery requests. I informed Mr. Amin that responses were past due and that Applicant had waived her right to object to the discovery requests.

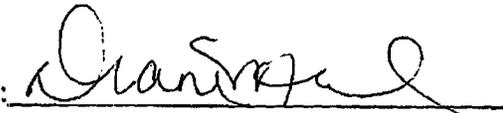
DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the registration resulting therefrom, declares that all statements made of her own knowledge are true and all statements made on information and belief are believed to be true.

Date: _____

6/27/03

By: _____



Diane M. Reed
Attorney for Opposer,
Port Carling Corporation

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062703

EXHIBIT C

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street
Fourteenth Floor
Irvine, CA 92614
Tel 949-760-0404
Fax 949-760-9502
www.kmob.com

Diane M. Reed
dreed@kmob.com

May 8, 2003

VIA FEDERAL EXPRESS

***OFFER OF COMPROMISE PURSUANT TO RULE 408
OF THE FEDERAL RULES OF EVIDENCE***

Mr. John Somers
10859 Emerald Coast Parkway West
PMB 422
Destin, FL 32550

Re: Infringement of SOMERS Trademarks
Opposition No.: 152,840
Our Reference No.: THIGHM.047M

Dear Mr. Somers:

Further to our telephone conversation on April 25, 2003, I have further discussed the proposed resolution with our client. Our client has decided that it cannot accept any use or registration of the SOMERS mark by your company. The only resolution acceptable to our client is for you to change your trademark to not include "Somers." Our client is willing to pursue this matter until it obtains a satisfactory resolution.

If you agree to sign a settlement agreement now in which you agree to expressly abandon your pending application and agree not to use or register the SOMERS mark, our client will allow you a six-month "phase-out" period in which you can sell your existing inventory of products and materials which include the SOMERS mark. If you do not agree to settle this matter on the foregoing terms, our client will pursue further legal action.

You should be aware that, until this matter settles, you are still under an obligation to comply with the due dates set forth in our discovery requests and the Scheduling Order from the Trademark Trial and Appeal Board. Accordingly, you need to immediately respond to the discovery requests we previously served on you, without objections.

Exhibit C Page 1 of 2

San Diego
619-235-8550

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
909-781-9231

San Luis Obispo
805-547-5580

Mr. John Somers

May 8, 2003

Page -2-

Due to the upcoming deadlines in the opposition and the seriousness of this matter, we request that you respond to the above proposal within three days of receipt of this letter. If you fail to respond to this proposal, our client will continue to proceed with the opposition and will consider further appropriate legal action.

We look forward to receiving your response. If you have any questions regarding this matter please have your attorney contact us, or if you are not represented by an attorney, you may contact us. The demands asserted in this letter are without prejudice to and with full reservation of all other rights or remedies our client may have in this matter.

Sincerely,

Diane M. Reed / JHH
Diane M. Reed

cc: Jonathan A. Hyman, Esq.
Brenda R. Heavill

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050703

EXHIBIT D

June 5, 2003

VIA FACSIMILE

**OFFER OF COMPROMISE PURSUANT TO RULE 408
OF THE FEDERAL RULES OF EVIDENCE**

Rakesh M. Amin, Esq.
WEAVER & AMIN
217 North Jefferson Street, Suite 602
Chicago, Illinois 60661

Re: Infringement of SOMERS Trademarks
Opposition No.: 152,840
Our Reference No.: THIGHM.047M

Dear Mr. Amin:

Further to our telephone conversation on June 2, 2003, our client is not interested in discussing any settlement proposal that includes payment of money to your client. Your client has been aware of our objections to her use of "Somers" since at least September of last year. We are not going to reimburse her for any investment she has made in the mark since then. Nor will we reimburse her for any investment in adopting the mark in the first place. We expect that cost of your client's investment to date has been in developing content and design for the cards, and not in developing the trademark. Our client will not be the source of a windfall profit to her for selecting a trademark that she is not entitled to use.

Our prior offer of a reasonable complete phase-out period, based upon a full-disclosure of your client's inventory, is still open but will expire in one (1) week. If your client does not accept this offer, we will pursue all rights and remedies to which our client is entitled.

If your client does not intend to accept our settlement offer, she must immediately provide responses to our discovery requests which were mailed on March 28, 2003. We have reminded Ms. Somers several times of her obligation to respond to the discovery requests. In light of the fact that an extension was never granted, let alone requested, your client's responses are past due. Thus, your client has waived its right to object to the discovery requests. We expect to receive your client's responses by June 12, 2003. If we do not receive your client's responses by that date, we will be forced to file a Motion to Compel.

Exhibit D Page 1 of 5

Rakesh M. Amin, Esq.

June 5, 2003

Page -2-

Furthermore, in light of the long delays by your client in this matter, we will not consent to an amendment of the Answer or the reopening the discovery period.

Additionally, we are in our Testimony period and intend to take a testimony deposition of Jim England. Enclosed is a Notice of Deposition for Mr. Jim England, which we have scheduled for June 25, 2003. Please let us know if you plan to attend this deposition.

We look forward to receiving your response.

Sincerely,

Diane M. Reed JHH
Diane M. Reed

cc: Jonathan A. Hyman, Esq.

Brenda R. Heavill

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060503

The oral examination of this witness will continue from day to day until completed. You are invited to attend and cross-examine the witness if you so desire.

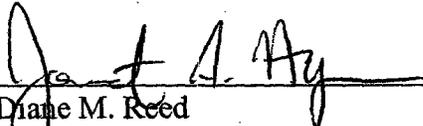
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

6-2-03

By: _____


Diane M. Reed
Jonathan A. Hyman
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Opposer
PORT CARLING CORPORATION

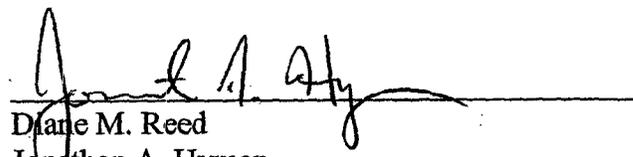
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060403

Exhibit D Page 4 of 5

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF DEPOSITION OF JIM ENGLAND** upon Applicant's counsel by facsimile and by depositing one copy thereof in the United States Mail, first-class postage prepaid on June 2, 2003, addressed as follows:

Rakesh M. Amin, Esq.
WEAVER & AMIN
217 North Jefferson Street, Suite 602
Chicago, Illinois 60661



Diane M. Reed
Jonathan A. Hyman
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Opposer
PORT CARLING CORPORATION

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060403

EXHIBIT E

June 12, 2003

BY FACSIMILE

Rakesh Amin, Esq.
WEAVER & AMIN
217 North Jefferson Street, Suite 602
Chicago, IL 60661

Re: Port Carling Corp. v. Julie Somers
Opposition No.: 152,840
Our Reference No.: THIGHM.047M

Dear Rakesh:

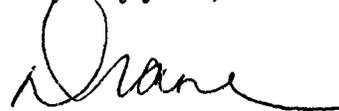
I spoke to my client this morning following our telephone conversation. I wanted to let you know that my client will not be making any settlement counter-offer at this time.

Regarding the time for Mr. England's deposition, he has had a scheduling change and thus, would not be available to start the deposition until about 3:00 p.m. (5:00 your time). Thus, we would like to move Mr. England's deposition to Thursday June 26 at 10:00 a.m. Please let me know if that is acceptable.

Finally, this is to confirm that I will receive your client's complete responses to Opposer's Interrogatories and Requests for Production of Documents by Tuesday June 17, 2003. Please note that the Requests for Admission already stand admitted.

If you would like to discuss any of these matters, please fee free to call me.

Very truly yours,



Diane M. Reed

cc: Port Carling Corp.
Jonathan A. Hyman, Esq.

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Exhibit E Page 1 Of 1

EXHIBIT F

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

PORT CARLING CORPORATION,)	Opposition No: 91,152,840
Opposer,)	Serial No. 76/255860
)	Mark: SOMERSEASONS
v.)	GREETINGS ASHLEY
)	International Class: 16 Paper Goods
JULIE SOMERS,)	and Printed Matter
Applicant.)	Published: April 30, 2002
)	

BOX TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

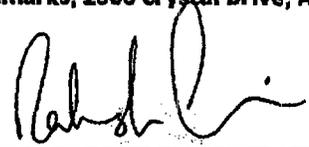
**MOTION TO STRIKE NOTICE OF RELIANCE AND IN THE ALTERNATIVE MOTION
FOR LEAVE TO AMEND ADMISSIONS TO REFLECT THE ATTACHED ANSWERS
TO OPPOSER'S REQUEST FOR ADMISSIONS**

Applicant/Petitioner, Julie Somers ("Applicant"), hereby moves to strike Opposer's Notice of Reliance as the Opposer waived the right to request Applicant's Responses to Opposer's First Request For Admissions by June 5, 2003 as the Opposer orally granted an extension on responses. It was represented that the Applicant had time to decide whether to settle before having to answer Opposer's Request for Admissions. The allegations in the Notice of Reliance are false, inconsistent and frankly bewildering considering the fact that extensions were sought and granted. The Applicant will answer discovery but does not agree that the extensions were not sought and granted and that the Applicant not responding to the First Set of Request for Admissions constitutes admissions by the Applicant. Moreover, the Applicant did not even have an attorney until recently and was misled by Opposer as to time to answer.

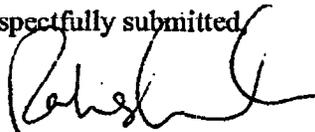
In view of the foregoing, and because this motion is filed promptly after retaining an Attorney, it is submitted that the Motion To Strike Notice Of Reliance be granted and In The Alternative to grant Applicant's Motion For Leave To Amend Admissions To Reflect the attached Applicant's Objections and Responses to Opposer's First Set of Requests for Admissions.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service via first class mail in an envelope addressed to: BOX TTAB - FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

June 17, 2003
Date


Signature

Respectfully submitted,



Rakesh M. Amin
Attorney for Applicant

Date: June 17, 2003

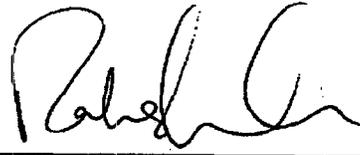
Weaver & Amin
217 North Jefferson Street
Suite 602
Chicago, IL 60661
Phone: (312) 466-0077
Fax: (312) 466-0088

CERTIFICATE OF SERVICE

I, Rakesh M. Amin, hereby certify that I caused the foregoing **MOTION TO STRIKE NOTICE OF RELIANCE AND IN THE ALTERNATIVE MOTION TO REQUEST TO AMEND ADMISSIONS TO REFLECT ATTACHED ANSWERS** to be served via U.S. Mail, first class postage pre-paid, to:

Jonathan A. Hyman, Esq.
Knobbe, Martens, Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

this 17th day of June, 2003.



Rakesh M. Amin