

TTAB

TRADEMARK

Attorney Docket No. 000291-009701US

Date of Deposit: April 8, 2004

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TOWNSEND AND TOWNSEND AND CREW LLP

By: Marie E. Neal
Marie E. Neal

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

In re Application Serial No. 76/389,091

Applicant: NeoPets, Inc.
Filed: March 28, 2002
Published: December 10, 2003
Mark: CHIA



04-12-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

JOSEPH ENTERPRISES, INC.

Opposer,

v.

NEOPETS, INC.

Applicant.

Opposition No. 91159234

**OPPOSER JOSEPH ENTERPRISES,
INC.'S' REPLY TO APPLICANT
NEOPETS, INC.'S COUNTERCLAIM;
MOTION TO SUSPEND**

Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, Virginia 22202-3514

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Madam:

OPPOSER'S REPLY TO APPLICANT'S COUNTERCLAIM

Joseph Enterprises, Inc., hereby replies to NeoPets, Inc.'s counterclaim as follows:

In Applicant NeoPets, Inc.'s Answer to Notice of Opposition and Counterclaim,

Applicant has filed a First Counterclaim for Relief (the "Counterclaim") petitioning for

OPPOSER JOSEPH ENTERPRISES, INC.'S' REPLY TO NEOPETS' COUNTERCLAIM; MOTION TO SUSPEND

cancellation of Opposer's registered marks: CHIA (Reg. No. 2,090,156, Serial No. 75/123,119), CHIA PET (Reg. No. 2,306,061, Serial No. 75/584,901), and CHIA HERB GARDEN (Reg. No. 2,773,363, Serial No. 76/459,538) (hereafter Opposer's "CHIA Marks"). Applicant replies as follows:

1. Answering Paragraph 24 (a) of the Counterclaim, Opposer admits that during the course of prosecution of the application for the CHIA PET mark (Serial No. 75/584,901), Opposer entered a disclaimer for the term "chia." Opposer admits that it seeks to enforce trademark rights based on a likelihood of confusion and dilution. Opposer denies that the only products distributed under the CHIA mark by Opposer have been gardening kits and terra cotta planters.

2. Answering Paragraph 24 (b) of the Counterclaim, Opposer denies that its CHIA Marks are generic, or descriptive of Opposer's products. Opposer denies that the CHIA Mark have not acquired secondary meaning. Moreover, Opposer asserts that the CHIA Marks have not only acquired secondary meaning, but that the CHIA and CHIA PET marks are famous.

3. Answering Paragraph 24 (c) of the Counterclaim, Opposer denies that Opposer has abandoned the CHIA mark for Class 25 goods and that the mark was not used for the statutory period to obtain the status of incontestability.

MOTION TO SUSPEND

4. Answering Paragraph 25 of the Counterclaim, Opposer admits that Applicant has challenged Opposer's CHIA Marks in a lawsuit, *Joseph Enterprises, Inc. v. NeoPets, Inc.* (Case No. C-02-2659 JW), that is proceeding in the United States District Court, Northern District of California, identified as (hereafter the "Pending Action).

5. In the Pending Action, Opposer alleges trademark infringement, dilution, and violation of the Anti-cybersquatting Consumer Protection Act by Applicant, the defendant in the Pending Action.

6. In accordance with 37 C.F.R. §2.117, Opposer requests that the Trial and Trademark Appeal Board suspend the instant proceeding until termination of the aforementioned Pending Action.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date: April 8, 2004

BY: Mary L. Shapiro

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AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Please charge the fee of \$300.00 to Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430. Please charge any additional fees that may be due, or credit any overpayment, to our Deposit Account No. 20-1430.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Date:

4/8/07

BY:

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