

Case: PRANA-001M
Trademark Application

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

In the Matter of Trademark Application Serial No. 78/265,186

Skylark Sport Marketing Corporation,)	Opposition No.:
)	
Opposer)	
)	
vs.)	
)	
CM Management, Inc.,)	
)	
Applicant)	



09-01-2004
U.S. Patent & TMO/TM Mail Rpt Dt. #11

NOTICE OF OPPOSITION

Commissioner for Trademarks
2900 Crystal Dr.
Arlington, VA 22202-3514

Dear Sir/Madam:

In the matter of the application of CM Management, Inc., of Buffalo, New York (hereinafter "Applicant") for registration of the trademark PRANA, Application Serial No. 78/265,186, published in the Official Gazette of March 2, 2004, at TM 223, Skylark Sport Marketing Corporation, a California corporation, with offices at 2077 Las Palmas Drive, Carlsbad, California, 92009 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark shown in Serial No. 78/265,186, and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer is and has been for many years engaged in the extensive development, advertising, and marketing of adult and children's biking, hiking, climbing, and yoga clothing, namely shorts, t-shirts, sweatshirts, hats, tank tops, sweaters, jackets, trousers, eye covers for use in yoga practice, headbands, and sports bras; and climbing accessories, namely chalk bags, backpacks, and tote bags; yoga exercise accessories, namely rugs and rug holders; and yoga exercise mats and mat carriers. In connection therewith, Opposer has used, or filed federal applications with an intent-to-use, in interstate commerce, the marks PRANA and PRANA (AND DESIGN) (hereinafter collectively referred to as the PRANA TRADEMARKS) for the aforementioned products since long prior to Applicant's filing date of application serial no. 78/265,186 for the mark PRANA.

2. Since at least as early as May, 1992, Opposer has made use of its PRANA TRADEMARKS throughout the United States in interstate commerce. Since adoption of its PRANA TRADEMARKS, Opposer has continuously used those marks throughout the United States in interstate commerce.

3. Opposer has expended considerable sums in exerting every effort to maintain the highest standard of quality for its services, and has created valuable goodwill among the purchasing public under its PRANA TRADEMARKS.

4. As a result of the continuous and extensive use of the PRANA TRADEMARKS by Opposer, those marks have become and continue to function as a valuable business and marketing asset of Opposer, and serve to indicate to the trade and consuming public the services originating from Opposer and its authorized representative.

5. Opposer has obtained United States Trademark Registration No. 1,803,298, registered November 9, 1993, for the mark PRANA for the goods/services set forth in that registration, a copy of the TARR status report is attached hereto as **Exhibit 1**.

6. Opposer has obtained United States Trademark Registration No. 2,569,537, registered May 14, 2002, for the mark PRANA for the goods/services set forth in that registration, a copy of the TARR status report is attached hereto as **Exhibit 2**.

7. Opposer has obtained United States Trademark Registration No. 2,639,255, registered October 22, 2002, for the mark PRANA (AND DESIGN) for the goods/services set forth in that registration, a copy of the TARR status report is attached hereto as **Exhibit 3**.

8. Opposer has obtained United States Trademark Registration No. 2,677,150, registered January 21, 2003, for the mark PRANA for the goods/services set forth in that registration, a copy of the TARR status report is attached hereto as **Exhibit 4**.

9. Notwithstanding Opposer's rights in and to said PRANA TRADEMARKS, Applicant, on information and belief, filed an application for registration of the mark PRANA in International Class 20 on June 20, 2003 for bedding, namely, mattresses, box springs and foundations. Said application was published for opposition in the Official Gazette of March 2, 2004 at TM 223.

10. Pursuant to Trademark Rules of Practice 2.102, Opposer filed Requests to Extend Time for Filing this Notice of Opposition. The Board on July 8, 2004 issued an Order extending Opposer's deadline to file this Notice of Opposition to August 29, 2004. A copy of said Board Order is attached hereto as **Exhibit 5**.

11. Applicant's PRANA mark is confusingly similar to Opposer's PRANA TRADEMARKS and its registration and use by Applicant on the goods/services claimed in the subject application is likely to cause confusion, deception and mistake.

12. Applicant's use of the mark PRANA interferes with Opposer's use of its PRANA TRADEMARKS and dilutes the strength of Opposer's trademarks and use of, or registration of, the mark PRANA by Applicant will seriously damage Opposer.

13. Applicant failed to advise the United States Patent and Trademark Office of its actual intended use of the mark PRANA and in so doing, practiced fraud on the Patent and Trademark Office in attempting to obtain allowance of the mark PRANA.

WHEREFORE, Opposer believes that it will be damaged by said registration and prays that registration of the mark PRANA to Applicant be denied.

The filing fee for this Opposition in the amount of \$300.00 (one international classes) is enclosed and this Opposition is enclosed herewith in triplicate. Opposer's representative authorizes the charging of any additional fees to its Deposit Account No. 19-4330.

Respectfully submitted,

STETINA BRUNDA GARRED & BRUCKER

Dated: August 30, 2004

By: 

Kit M. Stetina, Reg. No. 29,445
75 Enterprise, Suite 250
Aliso Viejo, CA 92656
(949) 855-1246

Counsel for Opposer
Skylark Sport Marketing Corporation

ATTORNEY DOCKET NO: PRANA-001M
SERIAL NO.: 78/265,186
MARK: PRANA

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:

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

on August 30, 2004



(Signature)

Sarah E. Gundert
(Typed name of person signing certificate)

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

1. Notice of Opposition of 4 Pages, with Exhibits 1, 2, 3, 4 and 5 in Triplicate;
2. Check in the Amount of \$300 for Filing Fee;
3. Transmittal, in Triplicate; and
4. A postcard to acknowledge receipt.



09-01-2004

EXHIBIT 1

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-08-30 13:02:43 ET

Serial Number: 74286614

Registration Number: 1803298

Mark (words only): PRANA

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2003-02-25

Filing Date: 1992-06-19

Transformed into a National Application: No

Registration Date: 1993-11-09

Register: Principal

Law Office Assigned: LAW OFFICE 15

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-02-27

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Skylark Sport Marketing Corporation

Address:

Skylark Sport Marketing Corporation
2077 Las Palmas Drive
Carlsbad, CA 92009
United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 025

adult and children's biking, hiking, and climbing clothing; namely, shorts, T-shirts, sweatshirts, hats,

tank tops, and trousers

First Use Date: 1992-05-00

First Use in Commerce Date: 1992-05-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

USPTO Reference Number: Z1230627

International Registration Number: (NOT AVAILABLE)

International Registration Date: (DATE NOT AVAILABLE)

Original Filing Date with USPTO: 2004-03-27

International Registration Status: Irregularity Received From IB (Response Required)

Date of International Registration Status: 2004-06-23

International Registration Renewal Date: (DATE NOT AVAILABLE)

Irregularity Reply by Date: 2004-09-22

Madrid History:

08-27-2004 - 10:15:26 - Response To Irregularity Reviewed And Accepted

08-17-2004 - 14:48:23 - Irregularity Response Received From Applicant

06-23-2004 - 13:10:28 - Irregularity Received From IB (Response Required)

04-01-2004 - 09:04:48 - Manually Certified

03-30-2004 - 14:10:02 - New Application For IR Received

PROSECUTION HISTORY

2003-08-21 - PAPER RECEIVED

2003-02-25 - First renewal 10 year

2003-02-25 - Section 8 (10-year) accepted/ Section 9 granted

2002-11-13 - Combined Section 8 (10-year)/Section 9 filed

2002-11-13 - PAPER RECEIVED

1999-01-08 - Section 8 (6-year) accepted & Section 15 acknowledged

1998-11-12 - Section 8 (6-year) and Section 15 Filed

1993-11-09 - Registered - Principal Register

1993-08-17 - Published for opposition

1993-07-16 - Notice of publication

1993-06-07 - Approved for Pub - Principal Register (Initial exam)

1993-05-06 - Correspondence Received In Law Office

1993-01-05 - Non-final action mailed

1992-11-17 - Previous allowance count withdrawn

1992-11-13 - Approved for Pub - Principal Register (Initial exam)

1992-10-26 - Examiner's Amendment Completed

1992-10-09 - Non-final action mailed

1992-08-31 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

PETER H KARLEN (Attorney of record)

PETER H KARLEN
PETER H KARLEN APLC
1205 PROSPECT ST STE 400
LA JOLLA CA 92037

EXHIBIT 2

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-08-30 13:03:08 ET

Serial Number: 76129851

Registration Number: 2569537

Mark (words only): PRANA

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-05-14

Filing Date: 2000-09-18

Transformed into a National Application: No

Registration Date: 2002-05-14

Register: Principal

Law Office Assigned: LAW OFFICE 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-09-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

- 1. Skylark Sport Marketing Corporation
- Address:**
 Skylark Sport Marketing Corporation
 2077 Las Palmas Drive
 Carlsbad, CA 92009
 United States
Legal Entity Type: Corporation
State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 025
 Yoga clothing, namely, shorts, pants, tops, hats, headbands and eye covers for use in yoga practice

First Use Date: 1993-01-00

First Use in Commerce Date: 1993-01-00

Basis: 1(a)

International Class: 028

yoga mat carriers

First Use Date: 1999-03-00

First Use in Commerce Date: 1999-03-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-08-21 - PAPER RECEIVED

2002-05-14 - Registered - Principal Register

2002-02-19 - Published for opposition

2002-01-30 - Notice of publication

2001-09-29 - Approved for Pub - Principal Register (Initial exam)

2001-09-28 - Examiner's Amendment Completed

2001-09-19 - Non-final action mailed

2001-04-30 - Correspondence Received In Law Office

2001-03-12 - Non-final action mailed

2001-03-08 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

Peter H. Karlen, Esq (Attorney of record)

PETER H. KARLEN, ESQ

PETER H. KARLEN, A PROFESSIONAL LAW CORP
1205 PROSPECT ST STE 400
LA JOLLA CA 92037-3613

EXHIBIT 3

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-08-30 13:03:52 ET

Serial Number: 76336501

Registration Number: 2639255

Mark



(words only): PRANA

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-10-22

Filing Date: 2001-11-09

Transformed into a National Application: No

Registration Date: 2002-10-22

Register: Principal

Law Office Assigned: LAW OFFICE 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-01-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Skylark Sport Marketing Corporation

Address:

Skylark Sport Marketing Corporation
2077 Las Palmas Drive

Carlsbad, CA 92009

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 025

adult and children's biking, hiking, climbing, and yoga clothing, namely shorts, T-shirts, sweatshirts, hats, tank tops, sweaters, jackets, trousers, eye covers for use in yoga practice, headbands, and sports bras

First Use Date: 1993-01-00

First Use in Commerce Date: 1993-01-00

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The translation of "PRANA" means "BREATH OF LIFE" in Sanskrit.

Prior Registration Number(s):

1803298

2003284

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-08-21 - PAPER RECEIVED

2002-10-22 - Registered - Principal Register

2002-07-30 - Published for opposition

2002-07-10 - Notice of publication

2002-05-09 - Approved for Pub - Principal Register (Initial exam)

2002-02-12 - Correspondence Received In Law Office

2002-02-07 - Non-final action mailed

2002-02-04 - Case file assigned to examining attorney

2002-01-17 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

Peter H. Karlen (Attorney of record)

PETER H. KARLEN
PETER H. KARLEN, A PROFESSIONAL LAW CORP
1205 PROSPECT ST., STE. 400
LA JOLLA CA 92037

Phone Number: 858 454 9696

Fax Number: 858 777 3393

EXHIBIT 4

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-08-30 13:03:29 ET

Serial Number: 76336500

Registration Number: 2677150

Mark (words only): PRANA

Standard Character claim: No

Current Status: Registered.

Date of Status: 2003-01-21

Filing Date: 2001-11-09

Transformed into a National Application: No

Registration Date: 2003-01-21

Register: Principal

Law Office Assigned: LAW OFFICE 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-03-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Skylark Sport Marketing Corporation

Address:

Skylark Sport Marketing Corporation
2077 Las Palmas Drive
Carlsbad, CA 92009
United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 018

CLIMBING ACCESSORIES, NAMELY CHALK BAGS, BACKPACKS, AND TOTE BAGS

First Use Date: 1992-05-00

First Use in Commerce Date: 1993-01-00

Basis: 1(a)

International Class: 027

YOGA EXERCISE ACCESSORIES, NAMELY RUGS AND RUG HOLDERS

First Use Date: 1997-06-00

First Use in Commerce Date: 1999-12-00

Basis: 1(a)

International Class: 028

YOGA EXERCISE MATS

First Use Date: 1997-06-00

First Use in Commerce Date: 1999-12-00

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: "PRANA" means "breath of life" in Sanskrit.

Prior Registration Number(s):

1803298

2569537

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-08-21 - PAPER RECEIVED

2003-01-21 - Registered - Principal Register

2002-10-29 - Published for opposition

2002-10-09 - Notice of publication

2002-08-19 - Approved for Pub - Principal Register (Initial exam)

2002-08-14 - Examiner's Amendment Completed

2002-07-17 - Correspondence Received In Law Office

2002-07-17 - PAPER RECEIVED

2002-02-22 - Non-final action mailed

2002-02-15 - Case file assigned to examining attorney

2002-02-14 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

Peter H. Karlen (Attorney of record)

PETER H. KARLEN
PETER H. KARLEN, A PROFESSIONAL LAW CORP
1205 PROSPECT ST., STE. 400
LA JOLLA CA 92037

Phone Number: 858 454 9696

Fax Number: 858 777 3393

EXHIBIT 5

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: July 8, 2004

Applicant: CM Management, Inc.
Serial No.: 78265186
Filed: 06/20/2003
Mark: PRANA

78265186

KIT M. STETINA
STETINA BRUNDA GARRED & BRUCKER
75 ENTERPRISE, SUITE 250
ALISO VIEJO, CA 92656

Michelle Greenfield, Legal Assistant:

The request for a one month extension of time to oppose filed June 29, 2004, on behalf of Skylark Sport Marketing Corporation, is noted. The requested extension of time is not in accordance with the Trademark Rules as amended. The rules, as amended, specifically provide that an extension will be granted for specific amounts of time. No extension can be granted for times other than those delineated in the rules as indicated below.

Extensions of time to oppose may be granted only as provided in Trademark Rule 2.102:¹

(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

(1) A person may file a first request for either a thirty-day extension of time, which will be granted

¹ Trademark Rule 2.102 was recently amended. See, Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55,748 (Sept. 26, 2003). The amended rule applies to any potential opposer which filed its first extension of time against a particular application on or after November 2, 2003. *Id.*

upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

(2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorize representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.

Because potential opposer's extension request includes [applicant's consent/a showing of extraordinary cause], its request is granted to the extent that potential opposer is allowed until August 29, 2004 [**Calculate date not to exceed 180 days**] in which to file an opposition. No further extensions will be permitted.

Note that the Board will not suspend the time for filing a notice of opposition for any reason. TBMP § 209.01 (2d ed. June 2003).

.oOo.

LAW OFFICES
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FACSIMILE II (949) 716-8197

www.stetinalaw.com

Writer's Direct E-mail:

August 30, 2004



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

09-01-2004

U.S. Patent & TMOs/TM Mail Rcpt Dt. #11

RE: Skylark Sport Marketing Corporation v. CM Management, Inc.
Serial No.: 78/265,186
Our Reference: PRANA-001M

Dear Sir/Madam:

Enclosed for filing are the following:

1. Notice of Opposition of 4 pages, with Exhibits 1, 2, 3, 4 and 5 in Triplicate;
2. Check in the Amount of \$300 for Filing Fee;
3. Certificate of Mailing; and
4. A postcard to acknowledge receipt.

Please charge any additional cost to our Deposit Account Number 19-4330. This letter is enclosed herewith in triplicate.

Respectfully submitted,

STETINA BRUNDA GARRED & BRUCKER

Date: August 30, 2004

By: 
Kit M. Stetina, Reg. No. 29,445
Counsel for Opposer

Customer No.: 007663
Encls.