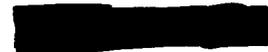


TTAB

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

----- X  
V SECRET CATALOGUE, INC., :  
and INTIMATE BEAUTY CORPORATION D/B/A : Consolidated Opposition  
VICTORIA'S SECRET BEAUTY, : No. 91,162,422  
  
Opposers, : 78/315,569  
: 78/319,291  
  
v. :  
  
RICK WOROBEK, :  
  
Applicant. :  
----- X



04-11-2005

U.S. Patent & TMO for TM Mail Rcpt Dt. #74

**PETITION FOR RECONSIDERATION**

On March 24, 2005, the Trademark Trial and Appeal Board rendered a decision in the above-identified opposition granting applicant's motion to set aside its default in answering the notice of opposition and to suspend proceedings pending the outcome of Opposition No. 91,125,739 entitled Sexy Hair Concepts, LLC v. V Secret Catalogue, Inc. on the ground that opposers did not oppose the motion. A copy of the Board's decision is attached.

Opposers, V Secret Catalogue, Inc. and Intimate Beauty Corporation d/b/a Victoria's Secret Beauty, respectfully request reconsideration of the Board's decision granting applicant's motion to suspend proceedings on the ground that opposers did in fact oppose applicant's motion to suspend as evidenced by the attached copy of Opposers' Opposition to Applicant's Motion for Suspension of Proceeding, showing

proof of mailing to the United States Patent and Trademark Office on March 1, 2005 and a certificate of service on applicant on the same date.

In addition, also attached is a copy of opposers' return postcard stamped as received by the United States Patent and Trademark Office on March 3, 2005.

Based on the foregoing, opposers respectfully request that the Board consider its opposition to applicant's motion to suspend proceedings and reconsider its decision of March 24, 2005.

Dated: New York, New York  
April 7, 2005

COLUCCI & UMANS

By Frank J. Colucci  
Frank J. Colucci  
Attorneys for Opposers  
218 East 50<sup>th</sup> Street  
New York, New York 10022  
(212)935-5700

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner For Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

Frank J. Colucci  
Signature  
04-07-05  
Date of Signature

**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing "Petition for Reconsideration" has been served by sending a true and accurate copy thereof by first class mail, postage prepaid, to applicant's attorney Claire Foley, Esq., of Christensen O'Connor Johnson Kindness PLLC, 1420 Fifth Avenue, Suite 2800, Seattle, Washington 98101-2347 this 7<sup>th</sup> day of April 2005.

Margaret R. Callaghan

ORIGINAL

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Baez/Ryan

Mailed: March 24, 2005

RECEIVED  
COLLECTOR HUMAN  
MAR 28 2005

Opposition No. 91162422

V Secret Catalogue, Inc.,

and

Intimate Beauty Corporation,  
dba Victoria's Secret Beauty

FILE

v.

Rick Worobec

Karyn K. Ryan, Interlocutory Attorney  
Trademark Trial and Appeal Board:

3/29  
50  
DLG-228  
KWC

Notice of Default Set Aside; Motion to reopen time for  
filing answer granted

On January 12, 2005, the Board sent a notice of default to applicant because no answer had been filed. On February 18, 2005, applicant filed a response to the default notice, a motion to reopen and reset his deadline for answer, and a motion to suspend proceedings.

The standard to apply in order to permit the late filing of an answer is the "good cause" standard of Fed. R. Civ. P. 55(c). We find that the circumstances recounted by applicant constitute good cause not to enter judgment by

default. See, e.g., *Perfect Film and Chemical Corporation v. The Society Ordinastral*, 172 USPQ 696 (TTAB 1972).

Moreover, we observe that the motion to reopen and reset applicant's time for answer is uncontested.

In view thereof, the notice of default is set aside. In further view thereof, applicant's motion to reopen the time for filing his answer is granted. See Trademark Rule 2.127(a).

**Proceedings are suspended**

Because the motion to suspend appears to be well-taken, and insofar as opposer has not lodged any objections to the proposed suspension, applicant's motion to suspend this proceeding pending the outcome of Opposition No. 91125739 is hereby granted. Trademark Rules 2.117(c) and 2.127(a).

Within **twenty** days after the final determination of Opposition No. 91125739, the parties should notify the Board by filing such notice in this proceeding, so that this case may be called up for appropriate action. Upon expiration of the suspension period, the Board may issue an order resuming proceedings, resetting the deadline for applicant's answer and all other appropriate dates.

The Board has updated applicant's correspondence address herein, taking note of applicant's change in counsel. If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed in writing. Trademark Rule 2.18.

\* \* \* \* \*

**Notice Regarding TTAB Electronic Resources and New Rules**

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://esta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at [www.uspto.gov](http://www.uspto.gov).
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at [www.uspto.gov/web/offices/dcom/ttab/tbmp/](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Opposers, : 78/315,569  
: 78/319,291  
  
v. :  
  
Rick Worobec, :  
  
Applicant. :  
----- X

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**OPPOSERS' OPPOSITION TO APPLICANT'S  
MOTION FOR SUSPENSION OF PROCEEDING**

Opposers, V Secret Catalogue, Inc. and Intimate Beauty Corporation  
d/b/a Victoria's Secret Beauty (collectively "Victoria's Secret") respectfully submit this  
opposition to applicant, Rick Worobec's, motion for suspension of proceedings.

Introduction

On September 13, 2004, opposers filed a consolidated notice of  
opposition to applicant's intent-to-use Applications Serial No. 78/315,569 to register the  
mark SOSEXE and Serial No. 78/319,291 to register the mark OSOSEXE, both in  
International Classes 3 and 25, filed on October 19 and 27, 2005, respectively. The  
opposition alleges in paragraph 3:

3. Opposer, V Secret Catalogue, Inc., is the owner, and  
opposer, Intimate Beauty Corporation d/b/a Victoria's  
Secret Beauty, is the exclusive user of the trademark  
SO SEXY which has been in continuous use in

interstate commerce since at least as early as April 10, 2003, on or in connection with hair care products, namely, hair conditioners, hair shampoo, hair spray, hair straightener, hair styling gel and hair styling mousse in International Class 3 (herein "the SO SEXY Mark"). Photographs depicting opposers' hair care products bearing the SO SEXY Mark are annexed hereto and made a part hereto as Opposers' Exhibit A through F, inclusive."

Paragraphs 5 and 6 of the notice of opposition allege the following:

5. Opposers' SO SEXY Mark has acquired widespread public recognition and secondary meaning among the public and the trade indicating opposers as the origin or source of the hair products bearing the SO SEXY Mark.
6. Opposers' SO SEXY Mark has priority over applicant's designations SOSEXE and OSOSEXE.

On October 8, 2004 the Trademark Trial and Appeal Board (the "Board") mailed notification of the opposition with the applicant's answer due on November 16, 2004. Applicant failed to respond to the notice of opposition and the Board mailed a notice of default judgment on January 12, 2005. On February 14, 2005, applicant filed its motion to withdraw the notice of default judgment and for suspension of proceedings.

Opposers do not oppose applicant's motion to withdraw the default judgment. However, opposers respectfully submit this opposition to applicant's motion to suspend proceedings.

#### Applicant's Motion

Applicant bases its motion to suspend proceedings on the ground that opposers' SO SEXY mark is involved in another opposition proceeding before the

Board (*Sexy Hair Concepts, LLC v. V Secret Catalogue, Inc.*, Opposition No. 91,125,739). Applicant alleges that conclusions reached in Opposition No. 91,125,739 may have a bearing upon issues in the instant proceeding, and therefore, the Board should suspend proceedings until a final determination is reached in Opposition 91,125,739.

Opposition 91,125,739 relates to opposers' SO SEXY intent-to-use Application Serial No. 78/094,035, and hence, opposers' ultimate right to register its SO SEXY mark. As discussed in further detail below, opposers' priority over applicant in the instant opposition is not based on opposers' intent-to-use '035 application, which is the subject of the Sexy Hair Concepts' opposition, nor on the filing dates of opposers' and applicant's applications to register their respective marks. The instant opposition is based on opposers' prior and continuous use of their SO SEXY mark in commerce since April 10, 2003, which date is prior to the filing dates of both of applicant's intent-to-use applications.

#### Argument

Trademark Rule 2.117(a) provides in pertinent part as follows:

- (a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

Opposers respectfully submit that the permissive language of Trademark Rule 2.117(a) makes clear that suspension is not automatic in all cases where a mark is

the subject of a prior Board proceeding. 2003 WL 152427 (Trademark Tr. & App. Bd.). Opposers respectfully submit that suspension is neither necessary nor appropriate in the instant case.

Sexy Hair Concepts opposed the SO SEXY application on the grounds that the mark SO SEXY is confusingly similar to its SEXY HAIR name and mark and its alleged "family" of SEXY marks. The outcome of Opposition No. 91,125,739 will apply solely to V Secret Catalogue, Inc.'s right to register the mark SO SEXY. Thus, if Sexy Hair Concepts is successful in its opposition, V Secret Catalogue, Inc.'s '035 application to register the mark SO SEXY will not mature to registration, and opposers will lose priority to the filing date of their '035 application which is November 19, 2001.

In the instant proceeding, opposers have opposed applicant's right to register his applications SOSEXE and OSOSEXE based on opposers' prior and continuous use of the SO SEXY mark for hair care products since April 10, 2003, which date is prior to the filing dates of applicant's applications, namely, October 10, 2003 and October 27, 2003, respectively. Therefore, since the instant proceeding is not based on opposers' intent-to-use '035 application and its priority date of November 19, 2001, which is the subject of the Sexy Hair Concepts opposition, any determination in that opposition would have no bearing on the instant proceeding. Under 15 U.S.C. §1052(d), a trademark relied on by an opposer in an opposition need not be registered, *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S. P.Q. 24 (CCPA 1976).

While the Board is empowered to determine the right to register a trademark, the Board is not authorized to determine the right to use a trademark, although the Board's finding either of a likelihood of confusion or of no likelihood of confusion may be entitled to weight in a subsequent civil action between the parties. Nor, may it decide broader questions of infringement or unfair competition. 15 U.S.C. §§ 1067, 1068, 1070 and 1092. *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 U.S.P.Q. 2d 1857, 1858 (TTAB 2002), *affd*, 300 F. 3d 1333, 66 U.S.P.Q. 2d 1811 (Fed. Cir. 2003). Therefore, the Board's adjudication of the Sexy Hair Concepts' opposition will only affect opposers' right to register their SO SEXY mark. It will have no impact upon V Secret Catalogue, Inc.'s and Intimate Beauty Corporation d/b/a Victoria's Secret Beauty's right to use the SO SEXY mark in commerce. Thus, unless applicant is related to, in privity with, or a licensee of the opposer, Sexy Hair Concepts, which upon information and belief, it is not, applicant has no basis on which to rely upon the outcome of Opposition No. 91,125,739.

#### Conclusion

Accordingly, for the foregoing reasons, opposers respectfully request that the Board deny applicant's motion to suspend this opposition proceeding. Moreover, since it is likely to be at least another year or more until a final decision is rendered in Opposition No. 91,125,739, and since the marks and goods involved in the instant opposition are virtually identical, postponing the inevitable by suspending proceedings

would not appear to be in the best interest of justice and fairness.

Dated: New York, New York  
March 1, 2005

COLUCCI & UMANS

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner For Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

Frank J. Colucci  
Signature  
03-01-05  
Date of Signature

By Frank J. Colucci  
Frank J. Colucci  
Attorneys for Opposers  
218 East 50<sup>th</sup> Street  
New York, New York 10022  
(212) 935-5700

**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing "Opposer's Opposition to Applicant's Motion for Suspension of Proceeding" has been served by sending a true and accurate copy thereof by first class mail, postage prepaid, to applicant's attorney, Claire Foley, Esq., of Christensen O'Connor Johnson Kindness PLLC, 1420 Fifth Avenue, Suite 2800, Seattle, Washington 98101-2347 this 1st day of March, 2005.

Georganna M. Callaghan

**EXHIBIT A**



SEX

RIFY  
ADITIO  
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ORIAS 5

**EXHIBIT B**

SO  
SEX

TRIFYL  
MAMPOG  
for oily hair

3oz./300  
MANS STC



**EXHIBIT C**

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BY  
THE  
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**EXHIBIT D**



SOSEY

**EXHIBIT E**

SO SEXY

**EXHIBIT F**

Y

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D69-228

HON. COMMISSIONER OF PATENTS:

We are forwarding herewith Opposers' Opposition to Applicant's Motion for Suspension of Proceeding on the application of SECRET CATALOGUE, SERIAL NO. 78/315,569 <sup>Opp. # 91,162,422</sup> and INTIMATE BEAUTY CORPORATION D/B/A VICTORIA'S SECRET BEAUTY <sup>78/319,291</sup> filed v. Rick Worobec ; MAR 28 2005

Kindly have the Mail Room stamp this card and return it to us, so that we may know the above has been fully received.

**ORIGINAL**  
 Respectfully,  
*[Signature]*  
 [Name] & Umans



03-04-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #32