

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

By Frank J. Colucci /fk

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Gregory J. Colucci

Signature

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Date of Signature

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.

Georgina M. Callaghan

EXHIBIT A

SO
SEXY

CLARIFYING
CONDITIONER

for oily hair

10 fl. oz. / 300 ml

VICTORIA'S SECRET

EXHIBIT B

SO
SEXY

CLARIFYING
SHAMPOO
for oily hair

10 fl. oz. / 300 ml.
VICTORIA'S SECRET

EXHIBIT C

SO SEXY

SOFT
ENGLING
SHELL

5 fl. oz. 50 ml

NET WT. 50g

EXHIBIT D

SO SEXY

NATURAL
HOLD
HAIRSPRAY

Net Wt. 6.7 oz 200g

MADE IN USA

EXHIBIT E

SO SEXY

VOLUMIZING
MOUSSE

Net Wt. 6.7 oz / 200 g

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EXHIBIT F



VICTORIA'S SECRET

SO SEXY

PERFUMING
ESSENCE

SO SEXY

PERFUMING
ESSENCE

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