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Filing date: **01/05/2005**

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

Proceeding	91162868
Party	Plaintiff NICOLE LAMBERT ,
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Signature	/patrick t. perkins/
Date	01/05/2005
Attachments	Memo and Default motion with Exhibit A.pdf (12 pages)

connection with the goods identified in the application, is likely to cause confusion, cause mistake or to deceive the public into the belief that the goods offered under Applicant's mark come from or are otherwise authorized or sponsored by Opposer and its mark LES TRIPLES THE TRIPLETS and design in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and therefore not entitled to registration. Opposer based the opposition on *both* its Federal Trademark Registration No. 2,251,561 *and* its common law rights in the mark.

Applicant's Answer to the Notice of Opposition was due on December 22, 2004. Applicant failed to file an Answer. Demonstrating its awareness that the opposition had been instituted, Applicant filed a Motion to Suspend the proceedings pending the outcome of a cancellation (Cancellation No. 92041371 the "Cancellation"), filed by Applicant against Opposer's valid trademark Registration No. 2,251,561, claiming that the outcome in the Cancellation will have bearing on the opposition. The Cancellation was commenced on December 20, 2002, and trial briefing was completed by both parties on September 16, 2004. The parties are now awaiting a decision of the Board. Applicant's argument is without merit.

In the Cancellation, Applicant claims that Opposer has abandoned its rights in its registration by failing to use its mark, in connection with the goods *covered by that registration*, namely "stationary, notebooks, memorandum books, pen and pencil cases made of cardboard or paper, writing paper, folders made of paper, cardboard or plastic for filing, pencils and pens," in Class 16 and "dolls" in Class 28. The Cancellation is limited to those goods identified in the registration for those specific classes.

Applicant has previously conceded, as set forth in the Declaration of Donna M. Ruggiero submitted herewith as Exhibit "A" ("Ruggiero Dec."), that Opposer has used the mark in

connection with goods beyond those listed in its registration. In addition, Applicant concedes in its Reply Brief filed in the Cancellation that Opposer has made ongoing efforts to secure licensees to market additional products under the mark. (Ruggiero Dec. ¶5). Not at issue in the Cancellation are Opposer's common law rights in the mark built up through its many years of use in connection with characters, literary works, and other goods related to such literary works, from which Opposer enjoys significant common law rights. The Board's decision will be limited to those specific goods identified in the registration. Regardless of what transpires in the Cancellation, the basis for Opposer's opposition is unaffected. Applicant's motion completely ignores this central fact.

ARGUMENT

I. APPLICANT HAS DEFAULTED BY FAILING TO TIMELY FILE AN ANSWER TO THE NOTICE OF OPPOSITION AND DEFAULT JUDGMENT IS APPROPRIATE.

Upon the timely filing of a Notice of Opposition, the Board may institute opposition proceedings and subsequently issue its trial order. A period of not less than thirty (30) days from the mailing date of the trial order must be granted applicant within which to file its answer. However, it is the general practice of the Board to grant a defendant in an opposition proceeding forty (40) days from the date of mailing the trial order in which to file an answer. 37 CFR § 2.105, TBMP § 310.03(a). The time for filing an answer may be extended by stipulation of the parties approved by the Board, by motion granted by the Board, or by order of the Board. TBMP § 310.03(c); see also Fed. R. Civ. P. 6(b) and TBMP § 509. As an alternative to seeking an extension of time to file an answer, a defendant may make a motion to dismiss or for summary judgment if it can show that there are no genuine issues of material fact and is entitled to judgment as a matter of law. See TBMP § 528.02.

Here, upon the filing of the Notice of Opposition, the Board instituted these proceedings and on November 12, 2004 issued its trial order indicating therein that Applicant's answer was due by December 22, 2004. Applicant failed to timely file an Answer, has neither sought nor obtained an extension of the term for answering or otherwise responding to the complaint, and has not made a motion to dismiss or for summary judgment. Thus, Applicant has failed to comply with the Federal rules and the rules of the Trademark Office.

"A party who has not answered within the prescribed time is in default." *Identicon Corporation v. Williams*, 195 U.S.P.Q. 447, 448 (TTAB 1977). The Applicant has the burden of showing good cause why default judgment should not be entered against it. *See* TBMP § 508. The standard for determining whether default judgment should be entered against the defendant for its failure to timely file an answer is set out in Fed.R.Civ.P. 55(c), and requires that the defendant show good cause why default judgment should not be entered against it. TBMP § 508; *see also* § 312. If Applicant cannot demonstrate that its failure to answer was not the result of willful conduct or gross neglect, default judgment must be entered. TBMP § 312.02; *DeLorme Publishing Co. v. Eartha's Inc.*, 60 U.S.P.Q. 2d 1222, 1223 (TTAB 2000). The courts have held that although default judgment is a harsh remedy it is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. *Unicut Corporation v. Unicut, Inc.*, 222 U.S.P.Q. 341, 344 (TTAB 1984).

A. Applicant's Failure to Answer is Willful and/or Constitutes Gross Neglect.

It is obvious that Applicant was aware of the deadline for filing its Answer, yet it chose not to proceed according to the Trademark Office Rules or the Federal Rules of Civil Procedure. Applicant's improper Motion to Suspend does not save it from default since only an Answer or

in the alternative, a Motion to Dismiss, a Motion for Summary Judgment or a Motion to Extend the Time in which to file its Answer, could have satisfied its obligation. *See* TBMP § 528.02; TBMP § 310.03(c); **see also** Fed. R. Civ. P. 6(b) and TBMP § 509. It is not necessary that the Board find that the Applicant acted in bad faith, but only that the Applicant acted deliberately in failing to file its Answer. *Gucci America Inc. v. Gold Center Jewelry*, 48 U.S.P.Q.2d 1371, 1374 (2d Cir. 1998); *DeLorme*, 60 U.S.P.Q. 2d at 1224 (willful conduct shown where although applicant may not have intended that proceedings be resolved by default, applicant admittedly intended not to answer).

Applicant demonstrated willful conduct by failing to file any one of these acceptable documents and by filing an improper motion in its place. At very least, Applicant's conduct is grossly negligent.

B. Applicant Failed to File a Request For an Extension of Time to Answer.

A Motion to Extend Time to Answer must be set forth with particular facts constituting good cause for the requested extension. Mere conclusory allegations without factual details are not sufficient. TBMP § 509.01(a). Under the standard set by the Trademark Rules of Practice, Applicant's 'catch all' alternative request for an extension cannot prevail here as Applicant has failed to meet its burden. Applicant has failed to articulate any cause, let alone good cause, for an extension.

Even assuming that Applicant believed that its motion constitutes a Motion to Extend, which it does not, it is black letter law that a party that relies on the filing of a request for

extension of time in lieu of meeting a filing date does so at his/her peril. If such a request is denied after the due date, there is no automatic extension while it is pending. To hold otherwise would allow counsel to manipulate the due date. *Sheeran v. Merit Systems Protection Bd*, 746 F.2d 806, 807 (CAFC 1984).

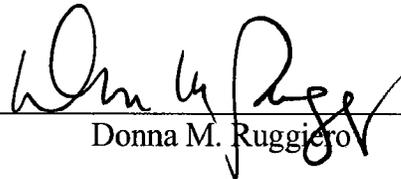
For the foregoing reasons, Opposer requests that Default Judgment be entered against Applicant for failure to timely file an Answer to the Notice Opposition by the deadline, December 22, 2004.

II. THE ISSUES IN THE PENDING CANCELLATION ARE IRRELEVANT TO AND HAVE NO BEARING UPON THIS OPPOSITION.

Applicant seeks to suspend the opposition based on 37 C.F.R. § 2.117(a), which provides “[w]henver 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.” (Emphasis added); *see also* TBMP § 510.02(a). The decision to suspend the opposition proceedings is *discretionary* and resides solely with the Board. The power to do so flows from the Board’s inherent authority to schedule disposition of the cases before it. TBMP §§ 510.01, 510.02(a). *See also Opticians Association of America v. Independent Opticians of America, Inc.*, 14 U.S.P.Q.2d 2021 (D.N.J. 1990), *rev’d on other grounds*, 17 U.S.P.Q.2d 1117 (3d Cir. 1990). Suspension is not automatic; it should be granted “only after both parties have been heard on the question and the Board has carefully reviewed the pleadings [in the civil suit] to determine if the outcome thereof will have a bearing on the question of the rights of the parties in the Patent Office proceedings.”). *Martin Beverage Co. v. Colita Beverage Corp.*, 169 U.S.P.Q. 568, 570 (TTAB 1971).

Certificate of Service

I hereby certify that a copy of the foregoing **OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND and CROSS-MOTION FOR DEFAULT JUDGMENT FOR FAILURE TO ANSWER** was sent to Julie B. Seyler, Esq. at Abelman, Frayne & Schwab, 150 East 42nd Street, New York, New York 10017, by prepaid first class mail, this 5^h day of January, 2005.



Donna M. Ruggiero

EXHIBIT A

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

In the Matter of Serial No. 75/983237

(Our Ref: NLAM USA TC 03/01377)

Filing Date: July 15, 1997

Mark: THE TRIPLETS ANNA TERESA HELENA (and Design)

Published in the *Official Gazette*: September 7, 2004

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NICOLE LAMBERT :
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 Opposer, :
 :
 - against - :
 : Opposition No. 91-162868
 CROMOSOMA, S.A. :
 :
 Applicant. :
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**DECLARATION OF DONNA M. RUGGIERO IN SUPPORT OF OPPOSER'S
MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND AND
MOTION FOR DEFAULT JUDGMENT FOR FAILURE TO ANSWER**

I, Donna M. Ruggiero, under penalty of perjury, declares as follows:

1. I am an associate with the firm Fross Zelnick Lehrman & Zissu, P.C. ("Fross Zelnick"), attorneys for Opposer Nicole Lambert ("Lambert"), and currently awaiting admission to the Bar of the State of New York. I make this Declaration in support of Opposer's Memorandum in Opposition to Applicant's Motion to Suspend and Motion for Default Judgment for Failure to Answer. I make this Declaration based on my personal knowledge.

Background

2. This Declaration is being submitted with respect to the evidence previously submitted to the Board by Opposer in its Trial Brief filed on August 25, 2004 in connection with Cancellation No. 92-041371 filed by Cromosoma, S.A., against Lambert, and currently pending in the TTAB.
3. The purpose of submitting this Declaration is to establish that Applicant has previous knowledge of Opposer's common law rights in the mark in connection with goods in addition to those which are the subject of Registration No. 2,251,561.

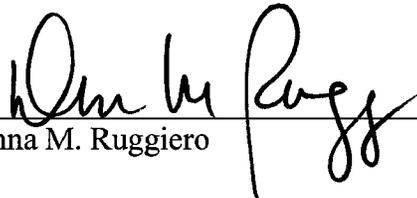
Evidence

4. In the Cancellation, Opposer has put forth the following examples as evidence of use of the mark in connection with the following products:
 - a. Licensing book distributed at the 2002 Licensing Fair.
 - b. Stationery and leather goods, such as bags.
 - c. Perfumes and cosmetics.
 - d. Footwear.
 - e. Prints and posters.
 - f. Tape dispensers.
 - g. Snow globes.
 - h. Book, entitled "The Triplets," published in 2004.

5. Applicant, in its Trial Brief filed on September 14, 2004 in the Cancellation, conceded that Opposer has made ongoing efforts to secure licenses to market products bearing its mark (see Trial Brief at page 8).

I declare under penalty of perjury that the foregoing is true and correct.

Dated: January 5, 2005



Donna M. Ruggiero

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