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

Proceeding	91163331
Party	Plaintiff SARMAR , L.L.C. ,
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SARAMAR, L.L.C.,)	
)	
Opposer,)	Opposition No.: 91163307
)	Mark: X SCENT [and design]
v.)	
)	Opposition No.: 91163331
ARCTICSHIELD, INC.,)	Mark: X SCENT
)	
Applicant.)	

**OPPOSER SARAMAR’S REPLY IN SUPPORT OF
ITS MOTION FOR SUMMARY JUDGMENT**

This is a straightforward case. There can be no dispute that Opposer Saramar LLC (“Opposer”) has priority over Applicant ArcticShield, Inc. (“Applicant”) by virtue of Opposer’s earlier-filed application. There also can be no dispute that Opposer’s “EX-SCENT” mark is confusingly similar to Applicant’s “X SCENT” mark. In its Response to Opposer’s Motion for Summary Judgment, Applicant raises disingenuous arguments aimed at distraction rather than genuine issues of material fact. Accordingly, Opposer’s Motion should be granted.

A. Opposer need not amend its Notice of Opposition.

Applicant’s unsupported assertion that Opposer must amend its Notice of Opposition to plead its issued registration is without merit and has no bearing on the issue of summary judgment. The Board may properly consider Opposer’s registration for purposes of summary judgment because Opposer submitted a status and file copy of its registration as part of its summary judgment motion. *See, e.g., Bongrain Int’l American Corp. v. Moquet Ltd.*, 230 USPQ 626, 626 n.3 (TTAB 1986). Moreover, in cases such as this, where a pleaded application matures into a registration after the Notice of Opposition is filed, the Board may treat the pleadings as amended to include the registration. *See, e.g., PEI Licensing, Inc. v. Ellis*, 2005 WL 548064, *3 (TTAB Feb. 24, 2005); *Bell South Intellectual Property Corp. v. VCS Technologies*,

Inc., 2004 WL 1576470, *6 n.3 (TTAB June 30, 2004) (non-precedential cases, cited for informational purposes only).

B. There are no genuine issues of material fact regarding priority.

There is no question that Opposer's intent-to-use application was filed prior to Applicant's intent-to-use application and that Opposer therefore has priority over Applicant. The temporary and unintentional abandonment of Opposer's application is immaterial because the application was properly revived – as evidenced by the resulting issuance of Opposer's registration. *See* TMEP at § 1208.01(d). Likewise, Applicant's dates of first use for its marks are immaterial because they occurred after the filing date of Opposer's application. *Id.* at § 1208.01; 37 C.F.R. § 2.83(a). Thus, these issues have no bearing on summary judgment.

Applicant's repeated assertions that it is somehow the senior applicant are simply false. Opposer is clearly the senior applicant because of its earlier filing date. In fact, the Trademark Office was specifically required to suspend Applicant's application upon revival of Opposer's application, although it failed to do so:

1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival

When an abandoned application is revived or reinstated (*see* TMEP §§1712.01, 1713 and 1714 *et seq.*), the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks have been approved for publication or registration, and place the search strategy in the file.

If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application that the earlier-filed application has been revived, if necessary. ***If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (see TMEP §1504.04(a)) and suspend the application pending disposition of the earlier-filed application that was revived or reinstated.***

If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the revived or reinstated application under

§2(d), even though the application for the registered mark was filed after the revived or reinstated application. The Office does not have the authority to cancel the registration.

TMEP § 1208.01(d) (emphasis added). Opposer respectfully submits that had the examining attorney followed the procedures of TMEP § 1208.01(d), then Applicant's application never would have been approved, and this Opposition never would have been necessary.

Moreover, Opposer's Petition for Revival of its application raises no questions of material fact. Opposer filed a *sworn declaration* that the abandonment was unintentional, which the Trademark Office accepted in reviving the application and issuing the registration, and which the Board should now consider as an un rebutted declaration in support of Opposer's summary judgment motion. *See* Exhibit 5 to Opposer's Motion. Applicant's bald accusations that the declaration is untrue are disingenuous and unsupportable. Applicant should not be permitted to conduct a fishing expedition in the face of a sworn declaration, forcing Opposer into extensive and unnecessary discovery in a proceeding that ideally should not even be taking place, when it is clear from the record evidence that Opposer unintentionally filed its Request for Extension of Time to File a Statement of Use *one day late*, mistakenly believing that it was due one week later. *See* Exhibit 3 to Opposer's Motion.

C. There are no genuine issues of material fact regarding likelihood of confusion.

Contrary to Applicant's assertions, no reasonable fact finder could find that Applicant's "X SCENT" and "X SCENT and design" marks are not confusingly similar to Opposer's "EX-SCENT" mark. The marks are identical in sound and connotation, and are virtually identical in spelling. Both marks have the identical dominant portion, preceded by identical beginning sounds conveying the same connotation, *i.e.*, masking scents. Also, the respective goods are nearly identical as they include highly similar types of clothing in International Class 25. Tellingly, the PTO even initially rejected Applicant's applications over

Opposer's application when it was still pending, based on a potential likelihood of confusion.
See Exhibit 9 to Opposer's Motion.

Moreover, as noted in Opposer's opening brief and the cases cited therein, the Federal Circuit and TTAB have consistently held that the question of likelihood of confusion can be determined on summary judgment. *See* Opposer's Motion at Section III.B.

D. Conclusion

For the foregoing reasons and those set forth in its initial brief, Opposer respectfully requests that its Motion For Summary Judgment be granted and that Applicant's marks be denied registration.

Respectfully submitted,

Dated: May 17, 2005



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that he caused the foregoing **OPPOSER SARAMAR'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT** to be served on counsel for Applicant on May 17, 2005, by first-class mail, postage prepaid, at the following address:

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