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

Mailed: August 8, 2006

Opposition No. 91163307  
Opposition No. 91163331

SARAMAR, L.L.C.

v.

ARCTICSHIELD, INC.

Before Seeherman, Walters and Walsh, Administrative  
Trademark Judges.

By the Board:

Opposer, Saramar, L.L.C., filed oppositions against the  
registration of the marks X SCENT and the mark depicted  
below:<sup>1</sup>



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<sup>1</sup> Ser. No. 76509381 for the mark X SCENT for "clothing, namely, gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls," filed April 25, 2003 on the basis of applicant's bona fide intent to use the mark in commerce; and Ser. No. 76509382 for the mark X SCENT and Design, for "clothing, namely, gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls," filed April 25, 2003 on the basis of applicant's bona fide intent to use the mark in commerce.

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alleging that the marks so resemble opposer's mark "EX-SCENT," at that time a pending application,<sup>2</sup> as to cause confusion, mistake or deception. Applicant filed answers to the notices of opposition, denying the salient allegations therein and asserting certain affirmative defenses.

On March 29, 2005, opposer filed motions for summary judgment in each opposition proceeding on its pleaded ground of likelihood of confusion. Concurrently with the filing of its motions for summary judgment, opposer filed a motion to consolidate these cases. During the briefing of opposer's motion for summary judgment, opposer filed a motion to join Sara Lee Corp. as a party plaintiff, in light of Sara Lee Corp.'s status as assignee of opposer's registration No. 2913784 (which originally had been pleaded as Saramar's trademark application serial No. 78110238).<sup>3</sup> Opposers Saramar L.L.C. and Sara Lee Corp. together moved for leave to file an amended notice of opposition to plead ownership of the registration originally pleaded as an application.

On March 24, 2006, the Board consolidated these proceedings, joined opposers as party plaintiffs, granted opposers' motion to amend the notice of opposition, and

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<sup>2</sup> Application Serial No. 78110238 for the mark EX-SCENT for "thermal underwear, tops and bottoms, shirts, T-shirts, pants, turtlenecks, mock turtlenecks, underwear" issued as Reg. No. 2913784 on December 21, 2004.

<sup>3</sup> Assignment recorded at Reel/Frame Nos. 3068/0801 on April 19, 2005.

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accepted opposers' amended notice of opposition as the operative pleading in the case. The Board also gave applicant time to answer the amended notice of opposition and gave both parties additional time to file any supplemental briefs in connection with opposers' motion for summary judgment.

Applicant answered the amended notice of opposition and the parties filed supplemental briefs in connection with opposers' motion for summary judgment.

Before turning to opposers' motion for summary judgment, we address applicant's answer, which includes a counterclaim to cancel registration No. 2913784, the registration that was pleaded by opposers in their amended notice of opposition.

A defendant may attack the validity of a pleaded registration by timely filing a counterclaim. See Trademark Rule 2.106(b)(2). Here, although applicant timely filed the counterclaim, it was not accompanied by the required fee. Accordingly, we may not institute the counterclaim at this time.

Applicant is allowed until TWENTY DAYS from the mailing date of this order to submit the appropriate fee for the counterclaim, failing which the counterclaim will not be considered.

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Because the issue of whether opposers may rely on their pleaded registration for purposes of priority is germane to the motion for summary judgment, a decision on opposers' motion for summary judgment is hereby deferred.

Proceedings herein are otherwise hereby suspended.

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