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

<b>Proceeding</b>	91163999
<b>Party</b>	Defendant Thomas P. Muchisky Muchisky, Thomas P. 13250 Lakefront Drive Earth City, MO 63045
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<b>Submission</b>	Applicant's Reply to Opposer's Opposition to Applicant's Motion to Dismiss
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<b>Date</b>	03/30/2005
<b>Attachments</b>	Applicant's Reply to Opposer's Opposition to Applicant's motion to dismiss.pdf ( 4 pages )

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

SYBARITIC, INC.,	)	
	)	
Opposer,	)	Opposition No.: 91163999
	)	Serial No. 78/282,661
v.	)	
	)	
THOMAS P. MUCHISKY,	)	
	)	
Applicant.	)	

**APPLICANT’S REPLY TO OPPOSER’S  
OPPOSITION TO APPLICANT’S MOTION TO DISMISS**

This reply supplements Applicant’s Motion to Dismiss For Failure To State A Claim Upon Which Relief Can Be Granted, filed March 7, 2005, in order to respond to new issues raised in, and new materials submitted with, Opposer’s Opposition to Applicant’s Motion to Dismiss.

**STANDING**

In Opposer’s Opposition to Applicant’s Motion to Dismiss, Opposer has stated “Being prevented from using a hand held massage applicator in commerce, which is a product that Sybaritic has sold and sells in commerce” constitutes a “reasonable belief” of damage. In its Notice of Opposition, however, Opposer stated that it will be damaged because “it may not be able to use a similarly configured” applicator in commerce. Opposer did not claim that it has sold or is selling a massage applicator which is the same as or similar to the design covered by Applicant’s application either in its Notice of Opposition or in its Opposition to the Motion to Dismiss. Although Opposer did not expressly allege that any likelihood of confusion exists between Applicant’s mark and Opposer’s “massage applicator”, it apparently attempts to do so now by implication. In

fact, the product sold by Opposer might consist of any number of different configurations of hand-held massage applicators. Therefore, Opposer has not alleged any facts demonstrating that it has standing to oppose registration of Applicant's mark.

Sybaritic attempts to establish that it has a real interest in this proceeding by incorporating in the Opposition a copy of a complaint for trademark infringement filed against it by a third party, which is a licensee of Applicant. That complaint alleges infringement of several trademarks which are different from the trademark at issue in this opposition. Yet Sybaritic claims that it believes it will also "be sued on the present application if it becomes a registration." There has not been any threat of infringement, nor has any infringement suit been filed, with regard to the mark covered by the Applicant's application in the instant opposition. Sybaritic, therefore, cannot claim that it has standing based on some unsupported belief. Since it is apparent that the complaint and exhibits submitted with the Opposition clearly constitute matters that are outside the pleading, Applicant objects to such material and requests that such material be excluded by the Board

Sybaritic's statement as to what Applicant's attorney "believes" is totally outside the issues in this opposition.

Applicant submits that Opposer has not established that it has standing in this opposition.

#### NO VALID GROUND FOR OPPOSING REGISTRATION

The "de facto/de jure" functionality test set out in Opposer's Opposition was eliminated when the Trademark Act was amended as of October 30, 1998. Therefore, this distinction is no longer made in "Office actions which refuse registration based on

functionality” TMEP §1202.02(a)(iii)(B). Rather, the test is whether the design as a whole is functional.

By questioning a “material of construction” in the description of the mark, Sybaritic attempts to circumvent the functionality standard prescribed by the Trademark Act as mentioned above, namely, whether the product design is functional as a whole. The concise description of Applicant’s mark in its application does not establish functionality.

With reference to Opposer’s comments concerning the “functional aspects” of Applicant’s design, the fact that the overall design contains some features that are functional does not preclude protection for the overall design (Restatement (Third) of Unfair Competition §17, comment b (1995)). Opposer is entitled to adopt the functional features.

Therefore, Opposer has not established any valid grounds for the opposition.

#### CONCLUSION

Opposer clearly has not established its standing to maintain the opposition, and there is no valid ground for denying registration of Applicant’s mark. Therefore, Opposer’s opposition should be dismissed.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS is being served via first class U. S. Mail, postage prepaid, this 30th day of March, 2005, upon the following:

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/Nora G. Schomogy/