

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

In the Matter of Application No. 76/570,501  
Of the Mark: 167 NEW BOND STREET - LONDON - (Stylized)  
Applicant: Asprey Holdings Limited Corporation

In the matter of Registration No. 2742675  
Of the Mark: BOND NO. 9

**TTAB**

-----X  
Laurice El Badry Rahme Ltd. dba :  
Laurice & Co., :  
 :  
Opposer/Registrant, :  
 :  
v. :  
 :  
Asprey Holdings Limited Corp., :  
 :  
Applicant/Petitioner. :  
-----X

Opposition No.: 91167945



06-06-2006  
U.S. Patent & TMO/TM Mail Rcpt Dt. #1

**MEMORANDUM IN OPPOSITION TO APPLICANT/PETITIONER'S  
MOTION FOR SUMMARY JUDGMENT**

Laurice El Badry Rahme Ltd. dba Laurice & Co. ("Registrant") respectfully submits this Memorandum of Law in Opposition to Petitioner's Motion for Summary and concurrently surrenders Registration No. 2,742,675 (via a status copy) for cancellation. In view of the surrender of the Registration, the Board should dismiss Applicant/Petitioner's Motion as moot.

I. Background

On November 9, 2005, Registrant filed a Notice of Opposition against Petitioner's Application Serial No. 76/570,501 for the mark ASPREY 167 NEW BOND STREET and design. The basis for the Opposition is that the mark in Serial No. 76/570,501 is confusingly similar to a "family" of trademarks owned by Registrant, including Registration No. 2,742,675 for BOND NO. 9 in Class 3<sup>1</sup>, Serial No. 76/578,912 for BOND NO. 9 NEW YORK and design in Classes 3 and 35, and Serial No. 76/512,252 for BOND NO 9 NEW YORK and design in Classes 3 and 4. As a basis for the Opposition, Registrant also relied upon common law rights derived from these "BOND NO.

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<sup>1</sup> On September 1, 2005, prior to the filing of the instant Opposition proceeding, Laurice filed an Amendment for Registration Under 37 C.F.R. Section 2.173, deleting Class 25 from the identification of goods in the Registration.

9" trademarks, as well as other trademarks in use by the Registrant, not the subject of Federal Registration or Applications. See Notice of Opposition, paragraphs 4-6, 9-12.

On January 20, 2006, Petitioner filed an Answer and a Counterclaim for Cancellation of Registration No. 2,742,675. On March 27, 2006, Registrant filed its Answer to Counterclaim for Cancellation and on April 12, 2006, Petitioner filed a Motion for Summary Judgment on Counterclaim for Cancellation. The Motion for Summary Judgment seeks cancellation of Registration No. 2,742,675 based on fraud.

II. Motion for Summary Judgment is Moot

Registrant has filed concurrently herewith a Voluntary Surrender of Registration No. 2,742,675. Registrant is of the strong belief and opinion that no fraud was involved; rather the registration is being surrendered not because a fraud was committed on the Patent and Trademark Office during procurement of said registration, but rather, based on a decision by the Registrant that the other applications cited in the Notice of Opposition, as well as the common law usages referenced therein, fully and accurately reflect the current use of the BOND NO. 9 marks by the Registrant, making the Registration unnecessary to the Registrant and also obviating the Petitioner's Motion for Summary Judgment.

Thus, even though the Registrant has surrendered Registration No. 2,742,675, it will continue to prosecute the Opposition proceeding, relying on both the common law rights asserted in the Notice of Opposition, the common law rights derived from the mark BOND NO. 9, and the marks in Application Serial Nos. 78/578,912 and 76/512,252.

In view of the foregoing, favorable action is requested, and the Motion for Summary Judgment should be deemed moot.

Respectfully submitted,

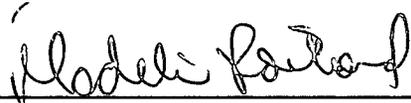
GOTTLIEB, RACKMAN & REISMAN, P.C.

  
George Gottlieb  
Attorney for Registrant  
270 Madison Avenue  
New York, NY 10016  
(212) 684-3900

**CERTIFICATE OF MAILING**

I hereby certify that this MEMORANDUM IN OPPOSITION TO APPLICANT/PETITIONER'S MOTION FOR SUMMARY JUDGMENT, is being deposited with the United States Postal Service as first class mail in a postage prepaid envelope addressed to: Commissioner for Trademarks, Box TTAB - No Fee, P.O. Box 1451, Alexandria, Virginia 22313-1451 on June 2, 2006.

Dated: June 2, 2006

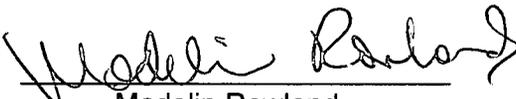
  
\_\_\_\_\_  
Madelin Rowland

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing MEMORANDUM IN OPPOSITION TO APPLICANT/PETITIONER'S MOTION FOR SUMMARY JUDGMENT, was served on Glenn A. Gundersen, Esq., Applicant/Petitioner's counsel of record on June 2, 2006, via first class mail, postage prepaid, addressed as follows:

Glenn A. Gundersen, Esq.  
Terence A. Dixon, Esq.  
Dechert LLP  
Cira Centre  
2929 Arch Street  
Philadelphia, PA 19104-2808

Dated: June 2, 2006

  
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Madelin Rowland

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

In the Matter of Application No. 76/570,501  
Of the Mark: 167 NEW BOND STREET - LONDON - (Stylized)  
Applicant: Asprey Holdings Limited Corporation

In the matter of Registration No. 2,742,675  
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Laurice El Badry Rahme Ltd. dba Laurice & Co.,	X	
Opposer/Registrant,	:	Opposition No.: 91167945
v.	:	
Asprey Holdings Limited Corp.,	:	
Applicant/Petitioner.	:	
	X	

**VOLUNTARY SURRENDER OF REGISTRATION NO. 2742675  
UNDER TRADEMARK ACT SECTION 7(E), 37 C.F.R. SECTION 2.134(a)**

Laurice El Badry Rahme Ltd. dba Laurie & Co., through its undersigned counsel, hereby surrenders Registration No. 2,742,675 for the trademark BOND NO. 9 for fragrances, namely perfumes, colognes and room fragrances. Enclosed is a certified copy of the registration.

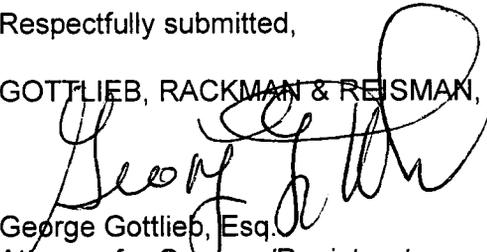
The trademark registration is the subject of a Counterclaim for Cancellation and Motion for Summary Judgment on Counterclaim for Cancellation in connection with Opposition No. 91167945. In view of the voluntary surrender of registration, it is maintained that the Counterclaim for Cancellation and the Motion for Summary Judgment are moot.

It is noted that the Class 25 goods were previously deleted, see TESS report attached.

Dated: June 2, 2006

Respectfully submitted,

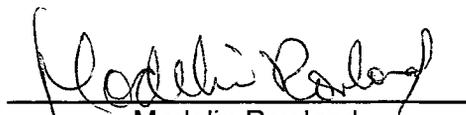
GOTTLIEB, RACKMAN & REISMAN, P.C.

  
George Gottlieb, Esq.  
Attorney for Opposer/Registrant  
270 Madison Avenue  
New York, NY 10016  
(212) 684-3900

**CERTIFICATE OF MAILING**

I hereby certify that this VOLUNTARY SURRENDER OF REGISTRATION NO. 2742675 UNDER TRADEMARK ACT SECTION 7(E), 37 C.F.R. SECTION 2.134(a), is being deposited with the United States Postal Service as first class mail in a postage prepaid envelope addressed to: Commissioner for Trademarks, Box TTAB - No Fee, P.O. Box 1451, Alexandria, Virginia 22313-1451 on June 2, 2006.

Dated: June 2, 2006

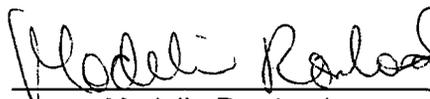
  
Madelin Rowland

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing VOLUNTARY SURRENDER OF REGISTRATION NO. 2742675 UNDER TRADEMARK ACT SECTION 7(E), 37 C.F.R. SECTION 2.134(a), was served on Glenn A. Gundersen, Esq., Applicant/Petitioner's counsel of record on June 2, 2006, via first class mail, postage prepaid, addressed as follows:

Glenn A. Gundersen, Esq.  
Terence A. Dixon, Esq.  
Dechert LLP  
Cira Centre  
2929 Arch Street  
Philadelphia, PA 19104-2808

Dated: June 2, 2006

  
Madelin Rowland



United States Patent and Trademark Office

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### Record 1 out of 1

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#### Typed Drawing

**Word Mark** BOND NO. 9  
**Goods and Services** IC 003. US 001 004 006 050 051 052. G & S: fragrances, namely, perfumes, colognes and room fragrances. FIRST USE: 20021028. FIRST USE IN COMMERCE: 20021028

(ABANDONED) IC 025. US 022 039. G & S: clothing, namely, dresses, skirts, pants, blazers, scarves and neckties. FIRST USE: 20021231. FIRST USE IN COMMERCE: 20021231

**Mark Drawing Code** (1) TYPED DRAWING

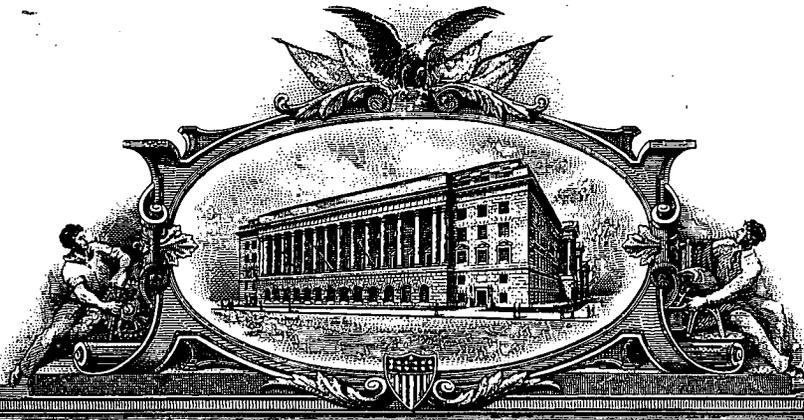
#### Design Search Code

**Serial Number** 75981311  
**Filing Date** February 28, 2001  
**Current Filing Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** July 16, 2002  
**Registration Number** 2742675  
**Registration Date** July 29, 2003  
**Owner** (REGISTRANT) LAURICE & CO. CORPORATION NEW YORK 9 Bond Street New York NEW YORK 10012  
**Attorney of Record** BARBARA H LOEWENTHAL  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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1468722



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

May 24, 2006

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,742,675 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *July 29, 2003*  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**



*T. Wallace*  
**T. WALLACE**  
Certifying Officer

**Int. Cls.: 3 and 25**

**Prior U.S. Cls.: 1, 4, 6, 22, 39, 50, 51, and 52**

**United States Patent and Trademark Office**

**Reg. No. 2,742,675**

**Registered July 29, 2003**

**TRADEMARK  
PRINCIPAL REGISTER**

**BOND NO. 9**

LAURICE & CO. (NEW YORK CORPORATION)  
9 BOND STREET  
NEW YORK, NY 10012

FOR: FRAGRANCES, NAMELY, PERFUMES, CO-  
LOGNES AND ROOM FRAGRANCES, IN CLASS 3  
(U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 10-28-2002; IN COMMERCE 10-28-2002.

FOR: CLOTHING, NAMELY, DRESSES, SKIRTS,  
PANTS, BLAZERS, SCARVES AND NECKTIES, IN  
CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 12-31-2002; IN COMMERCE 12-31-2002.

SN 75-981,311, FILED 2-28-2001.

PAUL F. GAST, EXAMINING ATTORNEY