

ESTTA Tracking number: **ESTTA173995**

Filing date: **11/09/2007**

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

Proceeding	91169059
Party	Defendant Lappert's Ice Cream, Inc.
Correspondence Address	SUSAN G. O'NEILL HANSON, BRIDGETT, MARCUS, VLAHOS & RUDY 425 MARKET STREET, 26th FLOOR SAN FRANCISCO, CA 94105 UNITED STATES soneill@hansonbridgett.com
Submission	Other Motions/Papers
Filer's Name	Garner K. Weng
Filer's e-mail	ipfilings@hansonbridgett.com, gweng@hansonbridgett.com, mdougherty@hansonbridgett.com
Signature	/Garner K. Weng/
Date	11/09/2007
Attachments	Lappert's Request to Set Aside Default and Answer.pdf ( 9 pages )(279035 bytes )

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

In the Matter of Trademark Application No. 76/624,588  
Trademark: KAUAI PIE  
Published in the Official Gazette on January 24, 2006

LAPPERT'S, INC.  Opposer  v.  LAPPERT'S ICE CREAM, INC.  Applicant	Opposition No. 91169059  APPLICANT LAPPERT'S ICE CREAM, INC.'S REQUEST TO SET ASIDE NOTICE OF DEFAULT
--	---

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P. O. Box 1451  
Alexandria, VA 22313-1415

**APPLICANT LAPPERT'S ICE CREAM, INC.'S REQUEST TO SET ASIDE THE  
NOTICE OF DEFAULT ISSUED BY THE TRADEMARK TRIAL AND APPEAL  
BOARD UNDER FED. R. CIV. P. 55(a) AND  
REQUEST FOR SUSPENSION OF THE OPPOSITION UNDER 37 CFR § 2.117(c)**

Pursuant to Fed. R. Civ. P. 55(c) and TBMP § 312.02, Applicant Lappert's Ice Cream, Inc. hereby requests that the Notice of Default issued by the TTAB on October 10, 2007 be set aside. This request is being submitted on the ground that the parties have entered into a written settlement agreement that resolved the substance of this pending opposition proceeding before expiration of the time period set to file an Answer and are still engaged in discussions regarding the implementation of the terms of that agreement as it relates to this opposition proceeding—and that this constitutes good cause why judgment by default should not be entered against Applicant.

The written settlement agreement provides, in part, that as between Applicant Lappert's Ice Cream, Inc. and Opposer Lappert's, Inc. regarding the KAUAI PIE mark (the "Mark") that is the subject of the Application that is the subject of this Opposition Proceeding:

- Applicant has exclusive rights in and to the Mark in the continental United States (including its airspace and surrounding waters);
- Opposer has exclusive rights in and to the Mark in the State of Hawaii (including its airspace and surrounding waters);
- Applicant will be withdrawing the Application that is the subject of this Opposition proceeding;
- Opposer will be able to file a concurrent-use application for the Mark, indicating Applicant's rights as set forth in the agreement as an exception to its claim of rights.

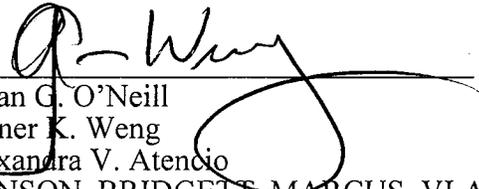
Applicant, Lappert's Ice Cream, Inc. understood the written settlement agreement to imply, indicate, or include Opposer Lappert's, Inc.'s consent to its withdrawal of Serial No. 76/624,588, including under TBMP § 602.01 and 37 C.F.R. § 2.135; and Applicant has asked Opposer to sign a separate written consent to the withdrawal of Serial No. 76/624,588 for a filing to be made with the Board here. Applicant understands Opposer to be discussing this request with its counsel and has not yet received Opposer's answer to this request.

Applicant therefore submits that its delay in filing an Answer was not the result of willful conduct or gross neglect, the plaintiff will not be substantially prejudiced by the delay, and Applicant has meritorious defenses to the opposition, as indicated in its Answer attached here as Exhibit A.. Accordingly, Applicant respectfully asks the Board to set aside its Notice of Default—and to accept its late-filed Answer, filed herewith as Exhibit A, or in the alternative, to allow Applicant up to and through November 23, 2007 to file its Answer in this proceeding

(which time may also allow Applicant and Opposer to implement the terms of their written settlement agreement such that no Answer is necessary).

Dated: November 9, 2007

Respectfully submitted,

By: 

Susan G. O'Neill

Garner K. Weng

Alexandra V. Atencio

HANSON, BRIDGETT, MARCUS, VLAHOS

& RUDY, LLP

Attorneys for Applicant LAPPERT'S ICE  
CREAM, INC.

425 Market Street, 26th Floor,

San Francisco, CA 94105

(415) 995-5870; fax: (415) 541-9366

E-mail: gweng@hansonbridgett.com

Certificate of Service

I hereby certify that a true copy of the foregoing LAPPERT'S ICE CREAM, INC.'S REQUEST TO SET ASIDE THE NOTICE OF DEFAULT ISSUED BY THE TRADEMARK TRIAL AND APPEAL BOARD UNDER FED. R. CIV. P. 55(a) AND REQUEST FOR SUSPENSION OF THE OPPOSITION UNDER 37 CFR § 2.117(c), was served on Opposer LAPPERT'S, INC., by First Class Mail, postage prepaid, this 9th day of November 2007 to Opposer's attorneys:

Douglas A. Winthrop  
HOWARD RICE NEMEROVSKI CANADY FALK & RABKIN  
A Professional Corporation  
Attorneys for LAPPERT'S, INC.  
Three Embarcadero Center, Seventh Floor  
San Francisco, CA 94111-4024



Latricia Baltodano, Assistant to  
Garner K. Weng  
Attorneys for Applicant  
LAPPERT'S ICE CREAM, INC.

Hanson Bridgett, Marcus, Vlahos & Rudy, LLP  
425 Market Street, 26th Floor  
San Francisco, CA 94105

EXHIBIT A  
APPLICANT LAPPERT'S ICE CREAM, INC.'S ANSWER  
TO THE NOTICE OF OPPOSITION

Opposition No. 91169059

Applicant Lappert's Ice Cream, Inc.'s Request to Set Aside Notice of Default

Serial No. 76/624,588

Mark: KAUAI PIE

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

In the Matter of Application Serial No. 76/624,588  
Mark: KAUAI PIE  
Published in the Official Gazette on: January 24, 2006

LAPPERT'S, INC.  Opposer  v.  LAPPERT'S ICE CREAM, INC.  Applicant	Opposition No. 91169059  APPLICANT LAPPERT'S ICE CREAM, INC.'S ANSWER TO NOTICE OF OPPOSITION
--	---

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1415

**APPLICANT LAPPERT'S ICE CREAM, INC.'S ANSWER  
TO NOTICE OF OPPOSITION**

Applicant Lappert's Ice Cream, Inc. ("Applicant"), by and through its attorneys, pursuant to 37 C.F.R. 2.126, responds to the Notice of Opposition filed by Lappert's Inc. ("Opposer") as follows:

1. In response to Paragraph 1 of the Notice of Opposition, Applicant admits each and every allegation contained in this paragraph.
2. In response to Paragraph 2 of the Notice of Opposition, Applicant denies each and every allegation contained in this paragraph.
3. In response to Paragraph 3 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in this paragraph—and on that basis denies each and every allegation contained in this paragraph.

4. In response to Paragraph 4 of the Notice of Opposition, Applicant alleges that it and Opposer were engaged in litigation in federal court that related in part to the Mark; Applicant alleges that it and Opposer settled that case in a mutually acceptable way; Applicant alleges that it has rights in the Mark in the continental United States (including its airspace and surrounding waters); and Applicant alleges that Opposer has rights in the Mark in the State of Hawaii (including its airspace and surrounding waters). Except as so alleged, Applicant denies each and every other allegation contained in Paragraph 4 of the Notice of Opposition.

5. In response to Paragraph 6 of the Notice of Opposition, Applicant admits that the Mark is "KAUAI PIE" and that it and Opposer both engage in the sale of ice cream and coffee. Except as so expressly admitted, Applicant denies each and every other allegation contained in Paragraph 5 of the Notice of Opposition.

6. In response to Paragraph 6 of the Notice of Opposition, Applicant hereby incorporates its responses to Paragraphs 1 through 5 of the Notice of Opposition.

7. In response to Paragraph 7 of the Notice of Opposition, Applicant denies each and every allegation contained in this paragraph.

8. In response to Paragraph 8 of the Notice of Opposition, Applicant denies each and every allegation contained in this paragraph.

### **DEFENSES**

In further response to the Notice of Opposition, and without accepting the burden of proof on any matter that should rest with Opposer, Applicant Lappert's Ice Cream, Inc. asserts the following defenses:

#### **First Defense**

The Opposition fails, in whole or in part, because Oppose has consented, acquiesced, and

agreed to Applicant's rights in the Mark—at least in the continental United States (including its airspace and surrounding waters).

**Second Defense**

The Opposition fails, in whole or in part, because there is no likelihood of confusion between Opposer's Mark and the mark in Application Serial No. 76/624,588.

**Third Defense**

The Opposition fails, in whole or in part, because Opposer has failed to plead or otherwise establish the fame of its mark as defined in the Trademark Dilution Revision Act of 2006, H.R. 683, 109th Cong. § 2 (2006).

**Fourth Defense**

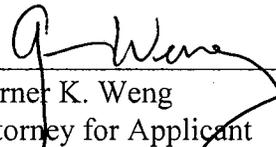
As Applicant lacks sufficient knowledge or information to form a belief as to whether it may have additional separate or affirmative defenses not stated in this Answer to the Notice of Opposition, Applicant reserves the right to assert additional separate or affirmative defenses based on further discovery, investigation, or analysis.

**PRAYER FOR RELIEF**

Applicant prays that the subject opposition be dismissed in its entirety.

Dated: November 9, 2007

Respectfully submitted,

  
Garner K. Weng  
Attorney for Applicant  
Hanson Bridgett Marcus Vlahos & Rudy  
425 Market Street, 26th Floor  
San Francisco, CA 94111

Certificate of Service

I hereby certify that a true copy of the foregoing APPLICANT LAPPERT'S ICE CREAM, INC.'S ANSWER TO NOTICE OF OPPOSITION was served on Opposer LAPPERT'S, INC., by U.S. First Class Mail, postage prepaid, this 9th day of November 2007 to Opposer's attorneys:

Douglas A. Winthrop  
HOWARD RICE NEMEROVSKI CANADY FALK & RABKIN  
A Professional Corporation  
Attorneys for LAPPERT'S, INC.  
Three Embarcadero Center, Seventh Floor  
San Francisco, CA 94111-4024

  
\_\_\_\_\_  
Latricia Baltodano, Assistant to  
Garner K. Weng  
Attorneys for Applicant  
LAPPERT'S ICE CREAM, INC.

Hanson Bridgett, Marcus, Vlahos & Rudy, LLP  
425 Market Street, 26th Floor  
San Francisco, CA 94105