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

Proceeding	91177192
Party	Defendant Martanna LLC Martanna LLC 16703 Ostenbury Court Dumfries, VA 22026
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAUTICA APPAREL, INC.,)
)
Opposer,)
) Opposition No. 91177192
v.)
)
MARTANNA LLC,)
)
Applicant.)

**APPLICANT MARTANNA L.C.’S BRIEF IN RESPONSE TO OPPOSER’S
MOTION TO STRIKE PARAGRAPH 5, AND AFFIRMATIVE
DEFENSES 1 - 5 AND 13 – 18, OF APPLICANT’S ANSWER**

Applicant Martanna L.C. (“Martanna” or “Applicant”), by counsel and for its reply to Opposer Nautica Apparel, Inc.’s (“Opposer”) motion to strike paragraph 5, and affirmative defenses 1 – 5 and 13 – 18, of Applicant’s Answer (the “Motion”)¹, states as follows:

I. Paragraph 5 of Opposer’s Notice of Opposition and Applicant’s Answer There to

Opposer alleges in paragraph 5 of its Notice of Opposition (the “Notice”) that it owns those marks listed in the table provided in paragraph 5 of the Notice. See Notice at ¶ 5, pp. 2-5. Opposer, however, is only entitled to a rebuttable presumption of ownership for those marks for which Opposer has received a certificate of registration as provided in Section 1057 of Title 15 of the United States Code. See 15 U.S.C. §§ 1057(a) and (b); see also Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 530 F.2d 1396, 1399 (CCPA 1976) (stating that 15 USC § 1057(b) accords *prima facie* effect “to the statement of ownership of the mark for which the certificate is issued.”). This presumption of ownership protects the relevant mark(s) from

¹ Opposer concedes, and Applicant agrees, that this type of motion is not normally made. Nonetheless, Opposer claims that it feels its motion “will be helpful in narrowing and limiting the issues. . . .” Motion at p.1. This kind of “narrowing” can be more efficiently addressed pursuant to discovery.

collateral attack in an opposition proceeding. See, e.g., Contour Chair-Lounge Co., Inc. v. Englander Co., Inc., 51 C.C.P.A. 833, 835-36 (CCPA1963); General Shoe Corp. v. Lerner Bros. Mfg. Co., Inc., 254 F.2d 154, 157 (CCPA 1958) (stating that the opposer “is regarded as the owner of its mark for all of the goods recited in its registrations,” “and it is not proper to consider a contention in an opposition that the opposer has not used the mark on certain goods since it involves questions which can be resolved by the Patent Office Tribunals only in a cancellation proceeding.”) (internal quotations and citation omitted).

In the instant proceeding, Opposer – by its own admission – has not received a certificate of registration for 11 of the 53 marks it alleges it owns in paragraph 5 of the Notice. (See, e.g., serial nos. 77085787 and 77085720, applications for the NAUTICA mark that are “pending” and for which no registration numbers have been issued and therefore no registration certificates have been obtained). Opposer, therefore, is not entitled to a presumption of ownership for those 11 alleged marks, and Applicant is permitted to deny in its Answer that Opposer owns those 11 alleged marks. Accordingly, Applicant amends its answer to paragraph 5 of the Notice to state as follows:

Applicant admits that Opposer has received US registration certificates, on the Principal Register, with the following pleaded registration numbers: 2697078, 3233030, 2865299, 2731466, 3114862, 2865300, 1862585, 2865229, 3232846, 3114379, 3109976, 2639939, 3170055, 2993023, 2987139, 3076597, 3076794, 3076796, 1523565, 3232827, 1580007, 2246317, 2306324, 2247914, 1464663, 2242969, 1557528, 1882757, 1553539, 3170094, 3165353, 3165351, 3168753, 3165354, 3165352 and 3165348. Applicant further admits that Opposer is entitled to a rebuttable presumption that Opposer owns those marks affiliated with the registration numbers recited herein for the uses outlined within the registration certificates for those marks. Applicant does not deny that Opposer has such ownership, but Applicant reserves its right to later assert a counterclaim and/or a petition to cancel any and/or all of the registered marks recited herein if Applicant should discover through the course of this opposition proceeding that grounds exist for cancellation of such pleaded registered marks. Applicant denies that Opposer owns the remainder of the marks listed in the table in paragraph 5 of the Notice, including those marks pleaded as having serial numbers 77085787, 77085720, 78763730, 77085766, 78963691, 78275470, 78275303, 78912365, 78713715, 77081234 and 77081223.

If the represented amendment herein to Applicant's answer to paragraph 5 of the Notice is not sufficient to effect an amendment to Applicant's answer, Applicant moves the Trademark Trial and Appeal Board (the "Board") to amend its Answer accordingly.

II. Applicant Withdraws Certain of Its Defenses

Applicant withdraws its defenses numbers 2 – 4, 13, and that portion of defense number 17 that asserts abandonment, functionality, and fair use defenses. If the representation within this Brief is not sufficient to amend Applicant's Answer to reflect the withdrawal of the noted defenses, Applicant moves the Board to allow Applicant to amend its Answer accordingly.

III. To the Extent that Opposer is Not Claiming That Applicant's "GET NAUTI" Mark Consists of or Comprises Matter That is Immoral, Deceptive or Scandalous, Applicant Withdraws Its Fifth Defense

The form Notice of Opposition filled out by Opposer and generated by the Board states that Opposer's grounds for opposition include "[d]eceptiveness" pursuant to section 2(a) of the Trademark Act. Further, Opposer does not specify pursuant to what authority and/or sections of the Trademark Act it brings its claims in its Notice. Applicant, therefore, asserted its defenses based on its reading of the form Notice of Opposition and Opposer's Notice as plead. Applicant withdraws its fifth defense to the extent that Opposer contends that Opposer is not claiming that Applicant's "GET NAUTI" mark consists of or comprises material that is immoral, deceptive, or scandalous.

IV. It is Not the Proper Time for Opposer to Challenge Applicant's Fourteenth Through Sixteenth Defenses

An answer may include the defenses of "unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense." TBMP. § 311.02(b). Applicant, therefore,

permissibly plead the defenses contained in defense numbers fourteen through sixteen. Opposer does not dispute that these defenses are permissible. Instead, Opposer attempts to argue that these defenses lack sufficient evidentiary support. It is not the proper time for Opposer to challenge these defenses.

Opposer's Motion concerning these defenses involves a factual dispute. No discovery has been taken yet in this proceeding. The record is not full enough given the posture of this proceeding for a fair analysis of Opposer's argument to be made. Opposer's argument may be appropriate for a motion for summary judgment after discovery has been taken, but not at this early stage. To allow Opposer to challenge these defense would prejudice Applicant in its defense of this opposition proceeding. Opposer's Motion should be denied.²

V. Applicant's Eighteenth Defense is Properly Plead

Opposer does not cite to any authority that disallows Applicant to reserve the right to assert certain defenses as set forth in paragraph 18 of Applicant's Answer. Instead, Opposer inappropriately uses its Motion as a forum to argue its case on the merits. As discussed in Section IV above, it is not the right time for Opposer to assert such an argument. Opposer's Motion should be denied.

² Similarly, Opposer argues in its Motion that Applicant's defenses of "good faith" and "erosion" should be struck because Opposer does not understand these defenses. See Notice at ¶ 17, p. 8. Opposer does not cite to any authority that disallows Applicant to assert these defenses. These defenses are more appropriately the subject of a motion after the parties have engaged in discovery.

Respectfully submitted,
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Dated: July 11 , 2007

CERTIFICATE OF SERVICE

I certify that on this day, July 11, 2007, a true and correct copy of the foregoing was sent via first-class mail, postage pre-paid, to:

Stephen L. Baker
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