

TTAB

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April 8, 2008

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

#76613881

RE: Mine Design v. Votivo, Ltd. And Votivo LLC
Opposition No.: 91178747
Substitute sheets for document filed by m.design on April 1, 2008

Dear Mr. Baxley,

Please accept the following substitute sheets that correct typographical errors in m.design's April 1, 2008 filing:

- pg.
- i. corrects Conclusion page from "2" to "22";
 - ii. adds a comma "," between 10 and 12 in *Canfield* cite;
 2. corrects "use" to "used" in footnote 1;
 3. adds "hand lotion" in line 16 after the word "scented";
 13. adds a period "." in line 22 after "2728815";
 19. changes "could have not opposed" to "could not have opposed" in line 26.

The brief surely includes other typographical mistakes. However undersigned would greatly appreciate if the enclosed sheets are substituted to correct at least these. If you have any questions or comments, feel free to give me a call or send me an email.

Sincerely,



Carlos Caneloro

Enclosures (6)
substitute sheets for pages i, ii, 2, 3, 13 and 19

cc: Mark Jordan (w/ enclosures)



04-14-2008

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I. Introduction

Mine Design (hereinafter m.design) opposed application Serial No. 76/613881 (hereinafter “application”) to register the term “mandarine”¹ in connection with scented bath salts and hand lotion, which application m.design respectfully submits was erroneously allowed by the Trademark Office. m.design moved for summary judgment on the issue of genericness, requesting the Board consider the law of genericness as it is developing in the Courts of Appeals for several Circuits, including the Second and the Third Circuits. In particular, m.design requested the legal analysis and policy issues discussed in *A.J. Canfield Co. v. Honickman*, 1 U.S.P.Q.2d 1364, 1378 (3d Cir. 1986) be considered by the Board in connection with the registrability of the term “mandarin” in connection with scented bath salts and scented hand lotion.

Oddly, while m.design's brief mainly focuses on the primary meaning test and the reasoning in *Canfield* and how they apply to the present case, a discussion of *Canfield* is conspicuous by its absence from Votivo's Memorandum in Opposition to m.design's motion for summary judgment. Not a paragraph, not a sentence, not a word addressing *Canfield* can be found in Votivo's Memorandum. Votivo has no answer to *Canfield*, a case that would hold Votivo's mark generic ab initio as a matter of law.

Lacking an answer on the merits, Votivo attempts to distract the court from the issue at hand with a massive volume of irrelevant documents filed in support of a “cross-motion” for summary judgment, alleging lack of standing and *res judicata*. m.design respectfully submits Votivo's cross motion for summary judgment should be denied as it is procedurally improper and substantively untenable.

Motions for summary judgment may only address issues properly raised in the pleadings. TBMP § 528.07(b). In its cross-motion for summary judgment, Votivo alleges m.design lacks standing to contest Votivo's application. However the issue of standing was not raised by Votivo in the pleadings, and, accordingly, cannot be addressed by way of a motion for summary judgment. Votivo's motion also makes a half-hearted attempt to argue *res judicata* based on previous litigation between

¹ The terms “mandarin” and “mandarine” are used interchangeably.

the parties. Again, these issues were not raised in Votivo's answer, which instead pleaded *res judicata* based on Votivo's existing "Mandarine" registrations, an allegation that, incidentally, is contrary to law. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 160 U.S.P.Q. 715 (CCPA 1969).

In addition to being procedurally improper, the arguments raised by Votivo in its cross motion for summary judgment lack merit. Votivo attempts to make much of the fact that Judgment was entered against m.design in *Votivo v. Mine Design I* (USDC CD Cal., Case No. CV 03-6017 involving the terms "red currant" and "soku lime"). However the case was not decided on the merits, but was rather a default judgment. Mr. Flores, a non-attorney, was attempting to defend himself pro se in the case, and was held in default by the court after accidentally missing the first scheduling conference. Undersigned entered the case at the time the court was entering the default judgment. The second case *Votivo v. Mine Design II* (USDC CD Cal. CV 05-2942 involving the term "tall grass") was dismissed with prejudice during the discovery phase, after undersigned made Votivo's counsel aware of *Canfield*, and that continued prosecution of the infringement action with knowledge that the alleged mark was invalid could result in Votivo owing m.design attorney's fees under the "exceptional case" standard provided in the Lanham Act. In any event, the term "mandarin" was not asserted by Votivo in either case, nor did either case involve scented bath salts or scented hand lotion. Thus neither case could give rise to *res judicata* in connection with the present opposition.

Votivo also argues that because of the settlement agreement between the parties and the injunction entered by the District Court m.design lacks standing to oppose Votivo's application. However, as explained in section III.B.2.c. below, when properly interpreted in light of the settlement agreement between the parties, the injunction only precludes m.design from using "trademarks" listed in the injunction, and then, only while said trademarks remain registered with the United States Patent and Trademark Office ("PTO"). In the present opposition m.design raises the issue whether "mandarin" can serve as a trademark in connection with scented bath salts and scented hand lotion. If the Board herein decides that the term cannot serve as a trademark, pursuant to the settlement agreement m.design would be free to use the term in connection with the sale of said items.

Federal Trademark Registration is an important right, as it provides its holder with prima facie evidence of the validity of the registered mark and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate. 15 U.S.C. 1057(b). As explained by Judge Rich in *DeWalt, Inc. v. Magna Power Tool Corp.*, 129 U.S.P.Q. 275 (CCPA 1961):

The evidentiary value of a Principal Register registration under Section 7(b) of the statute [15 U.S.C. 1057(b)] makes it a potent weapon in litigation and this, plus the respect in which business [people] hold certificates of Federal registration, makes such a registration an encouragement to suits and other types of harassment which would be much less likely to occur in its absence.

DeWalt, 129 U.S.P.Q. at 281.

Given the weight accorded Federal Trademark Registrations by the courts and the general public, the U.S. Patent and Trademark Office should endeavor to limit, where possible, the registration of terms that are generic in connection with the goods and services specified in the application. m.design's motion for summary judgment should accordingly be granted.

B. Response In Opposition to Votivo's Cross-Motion For Summary Judgment

1. Votivo's Cross-Motion For Summary Judgment Is Procedurally Improper, Inter Alia; Because It Is Directed Solely To Issues Not Raised In Votivo's Answer

A party may not obtain summary judgment on an issue that has not been pleaded. TBMP § 528.07(b). Votivo, Ltd. filed an Answer that raised two defenses: failure to state a claim and estoppel based on Votivo's prior Reg. No. 2728815. Now, Votivo, Ltd. cross-moves for summary judgment based on lack of standing and res judicata based on the previous litigation between the parties. Neither ground was raised in Votivo, Ltd.'s Answer. Votivo, Ltd.'s motion for summary judgment should accordingly not be considered.

Votivo, LLC moved to be added and was added to the action by an order dated Feb. 8, 2008. However Votivo, LLC has yet to file an Answer. Accordingly, Votivo, LLC has also not raised any defenses and thus could not have raised a defense for which it moves for summary judgment. Votivo,