

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

In the matter of Trademark Application Serial No. 76/613881
For the Mark MANDARINE
Published in the Official Gazette JUNE 5, 2007

MINE DESIGN D/B/A/ OF AMAL FLORES
(U.S.),

Opposers,

v.

VOTIVO, LTD., a Washington corporation,

Applicant,

VOTIVO, LLC, a South Carolina Limited
Liability Company,

Defendant

APPLICANT'S AND DEFENDANT'S MOTION TO
SUSPEND PROCEEDINGS AND MOTION TO
EXTEND DISCOVERY PERIOD

Opposition No. 91178747

MOTION TO SUSPEND PROCEEDINGS AND TO
EXTEND DISCOVERY PERIOD

I. INTRODUCTION

Come now Applicant VOTIVO, Ltd., and Defendant VOTIVO, LLC (hereafter, collectively, "VOTIVO"), and moves the Board for an order suspending these proceedings and an order extending the discovery period in this matter.

II. EVIDENCE

The evidentiary support for VOTIVO's Motion to Suspend Proceedings and Extend Discovery Period includes (1) the Declaration of Steven W. Edmiston in



10-09-2008

Support of Motion to Suspend Proceedings and Extend Discovery Period, and exhibits thereto, and (2) the pleadings and records otherwise on file herein.

III. FACTS

Simultaneous with the filing this motion to suspend proceedings, VOTIVO has filed a Motion for Reconsideration of the Board's September 19, 2008 Order denying VOTIVO's Cross-Motion for Summary Judgment, pursuant to Fed. R. Civ. P. 56(c) and 37 C.F.R. §2.127(b). See Declaration of Steve Edmiston in Support of Motion to Suspend Proceedings and Extension of Discovery, ¶ 3. The Board's September 19, 2008, Order also lifted the suspension of proceedings and provided approximately twenty-one days to complete discovery.

In addition, the parties have now re-instituted proceedings in *Votivo, Ltd. v. Mine Design*, Case No. CV-05-2942-DT, in the United States District Court, Central District of California, in connection with the enforcement of the Permanent Injunction entered therein against Mine Design by the federal district court. In that case, VOTIVO has filed a pending Application for an Order to Show Cause Why Mine Design Should Not Be Held in Contempt. Edmiston Decl., Ex. 1.

IV. LEGAL AUTHORITY

Proceedings before the Trademark Trial and Appeal Board may be suspended for a variety of reasons, including for good cause shown upon motion. See Trademark Rule 2.117(c), 37 C.F.R. §2.117(c). While proceedings will not automatically be suspended upon the filing of a motion for reconsideration, the Board generally suspends proceedings upon the filing of any potentially dispositive motions,

and proceedings resume if the case is not disposed of as a result of the motion. Trademark Rule 2.117(d), 37 C.F.R. §2.117(d). Proceedings may also be suspended by the Board when there is a pending civil action which may be dispositive of, or have a bearing on, the proceedings proposed to be suspended. See Trademark Rule 2.117(a), 37 C.F.R. §2.117(a). Finally, an extension of the discovery period should be granted for good cause. Trademark Rule 2.120(a), 37 C.F.R. §2.117(a).

V. ARGUMENT

Good cause exists to suspend these proceedings because VOTIVO's Motion for Reconsideration and its federal district court action are a potentially dispositive of this matter. If the Board grants the Motion for Reconsideration, Mine Design's Opposition shall be dismissed, and these proceedings will terminate. Further, counsel for Mine Design in these proceedings before the Board has taken the position before the federal district court that a suspension of these proceedings is appropriate. Edmiston Decl., Ex. 2.

VOTIVO believes that its Motion for Reconsideration should lead to the termination of this Opposition. However, in the event that the Board denies the Motion for Reconsideration, VOTIVO will require limited discovery prior to the beginning of the testimony period. Good cause exists to extend the discovery period in this matter in the event that the Motion for Reconsideration is denied. VOTIVO has appropriately used the limited period granted by the Board for the completion of discovery to timely prepare its Motion for Reconsideration. Edmiston Decl., ¶ 5.

Further, no prior extensions have been sought by either party to this action. Edmiston Decl., ¶ 7. Therefore, VOTIVO respectfully requests that in the event its Motion for Reconsideration is denied, the discovery period in this matter be extended for 45 days to permit the parties to proceed with limited discovery in this matter prior to the beginning of the testimony period. Judicial economy will be served by such an orderly resolution of the issues.

V. RELIEF REQUESTED

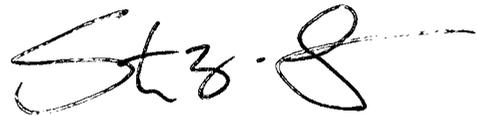
VOTIVO requests that its Motion be granted, and that the Board (1) order a suspension of these proceedings pending determination of VOTIVO's Motion for Reconsideration, and, in the event VOTIVO'S Motion for Reconsideration is denied, (2) order a forty-five day extension of the discovery period in this matter.

Respectfully Submitted,

DATED: October 9, 2008.

INVICTA LAW GROUP, PLLC

By



Mark V. Jordan, WSBA No. 18461
Steven W. Edmiston, WSBA No. 17136
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Attorney for Applicant

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37 C.F.R. §1.10

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Mr. Carlos Candeloro
1601 N. Sepulveda Blvd. 239
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Katy M. Albritton

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In the matter of Trademark Application Serial No. 76/613881
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MINE DESIGN D/B/A/ OF AMAL FLORES
(U.S.),

Opposers,

v.

VOTIVO, LTD., a Washington corporation,

Applicant,

VOTIVO, LLC, a South Carolina Limited
Liability Company,

Defendant

DECLARATION OF STEVE EDMISTON IN
SUPPORT OF MOTION TO SUSPEND
PROCEEDINGS AND TO EXTEND DISCOVERY
PERIOD

Opposition No. 91178747

Steven W. Edmiston, declares and states as follows:

1. I am counsel of record for the Applicant/Defendants. I have personal knowledge of the following facts, and am competent to testify thereto.
2. I make this declaration in support of VOTIVO, Ltd.'s, and VOTIVO, LLC's Motion to Suspend Proceedings and to Extend Discovery Period.
3. Simultaneous with the filing this motion to suspend proceedings, VOTIVO has filed a Motion for Reconsideration of the Board's September 19, 2008

Order denying VOTIVO's Cross-Motion for Summary Judgment, pursuant to Fed. R. Civ. P. 56(c) and 37 C.F.R. §2.127(b).

4. The parties to this matter have now re-instituted proceedings in *Votivo, Ltd. v. Mine Design*, Case No. CV-05-2942-DT, in the United States District Court, Central District of California, in connection with the enforcement of the Permanent Injunction entered therein against Mine Design by the federal district court. In that case, VOTIVO has filed a pending Application for an Order to Show Cause Why Mine Design Should Not Be Held in Contempt. A true and correct copy is attached as Exhibit 1.

5. Counsel for Mine Design in these proceedings has recently taken the position before the above-referenced federal district court in California that a suspension of these proceedings is appropriate. A true and correct copy of Mr. Candeloro's statement is attached as Exhibit 2.

6. VOTIVO has used the limited period granted by the Board for the completion of discovery to timely prepare its motion for reconsideration, which again, if granted, eliminates the need for discovery by either party.

7. No prior extensions of the discovery period have been sought by either party to this action.

I declare under penalty of perjury under the laws of the state of Washington that the foregoing is true and correct to the best of my knowledge and belief.

EXECUTED at Seattle, Washington this 9th day of October 2008.

A handwritten signature in black ink, appearing to read 'S. Edmiston', with a long horizontal line extending to the right from the end of the signature.

Steven W. Edmiston

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Mr. Carlos Candeloro
1601 N. Sepulveda Blvd. 239
Manhattan Beach, CA 90266


Katy M. Albritton

Exhibit 1

1 Mark D. Baute, Esq. (SBN 127329)
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10 Attorney for Plaintiffs
11 VOTIVO, LTD. and VOTIVO, LLC

12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA

14 VOTIVO, Ltd., a Washington
15 corporation; and VOTIVO, LLC, a
16 South Carolina limited liability
17 company,

18 Plaintiffs,

19 vs.

20 MINE DESIGN, a sole proprietorship,
21 Defendant.

22 **NO. CV 03-6017-DT**
23 **[Hon. Dickran Tevrizian, Ret.]**

24 **APPLICATION FOR AN ORDER**
25 **TO SHOW CAUSE WHY**
26 **DEFENDANT SHOULD NOT BE**
27 **HELD IN CONTEMPT;**
28 **MEMORANDUM OF POINTS AND**
AUTHORITIES IN SUPPORT
THEREOF

APPLICATION

Pursuant to paragraph 3 of the Permanent Injunction entered by this Court on November 7, 2005, plaintiffs Votivo Ltd., and Votivo, LLC (hereafter "VOTIVO") hereby apply for an Order to Show Cause why defendant Mine Design, its sole proprietor Amal Flores, and its attorney Carlos Candeloro, should not be held in contempt for violating the terms of the Permanent Injunction. This Application is made following the Conference of Counsel pursuant to Local Rule 7-3 which took place on July 16, 2008. [Declaration of Robert M. Gilchrest Re: Local Rule 7-3 Conference of Counsel at ¶ 3.]

This Application is based upon the Permanent Injunction, the memorandum of points and authorities attached hereto, the Declarations of Steven Edmiston and Robert M. Gilchrest (re Local Rule 7-3 Conference of Counsel) filed concurrently herewith, and upon all documents, records and files in this action, and such oral and documentary evidence as may be presented at or before the time of the hearing on this Application. The proposed order granting this Application is lodged concurrently herewith and the original of such order shall be presented to the Court at the time of the hearing on this Application.

Dated: August 20, 2008

Respectfully Submitted,
BAUTE & TIDUS LLP

By



Mark D. Baute, Esq.
Robert M. Gilchrest, Esq.
Attorneys for Plaintiffs
VOTIVO, LTD. and VOTIVO, LLC

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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I.**

3 **INTRODUCTION**

4 VOTIVO has used the mark MANDARINE¹ in connection with a variety of
5 household and personal care products dating back to 1997. VOTIVO holds valid
6 federal trademark registrations for MANDARINE for use in connection with candles,
7 tapers, skin soap, scented body spray, scented room spray, and incense
8 (collectively, the "Existing Registrations"), dating back to 2003. The Existing
9 Registrations have been found distinctive when applied to VOTIVO home and
10 personal care products. [Declaration of Steven W. Edmiston ("Edmiston Decl."),
11 Exs. 18-19.]

12 VOTIVO filed its Complaint in this matter on August 22, 2003, alleging,
13 among other things, trademark infringement. On November 8, 2005, this Court
14 entered a Permanent Injunction against Defendant Mine Design:

15 1. [Mine Design], and its owners... and attorneys...are hereby
16 permanently enjoined and restrained from:

17 ***

18 d. Using MANDARINE,... which is a subject of a United States
19 trademark registration owned by VOTIVO, or any other term, symbol,
20 trademark, service mark, domain name, trade name, or corporate or other
21 entity name that is confusingly or substantially similar to MANDARINE..., in
22 connection with candles and tapers, burning sticks and incense, scented
23 room sprays, scented skin soaps, scented body sprays, and any other scented
24 products for household or personal care use.

25
26 ¹ Mandarin, a French word, may be translated as "mandarin" in English. Under
27 the doctrine of foreign equivalents, a foreign word and the English equivalent may
28 be held to be confusingly similar. Trademark Manual of Examining Procedures §
1207.01(b)(vi) (citations omitted).

1 [Edmiston Decl., Ex. 4 at (page:line) 1:23-2:27.]

2 VOTIVO returns to this Court because Mine Design is now intentionally
 3 violating the Permanent Injunction. Specifically, Mine Design is using the term
 4 Mandarin (a term confusing and substantially similar to MANDARINE) in
 5 connection with the direct marketing and sales of candles. In addition, Mine
 6 Design has filed an action against VOTIVO before the United States Patent and
 7 Trademark Office Trademark Trial and Appeal Board (“TTAB”), opposing
 8 VOTIVO’s pending federal trademark registration for the use of MANDARINE in
 9 connection with scented products for personal care use, bath salts and hand lotion.
 10 Mine Design was prohibited by this Court from using MANDARINE (or any
 11 confusingly or substantially similar term) in connection with any candles or
 12 household or personal care products. Mine Design is intentionally using the mark
 13 Mandarin in violation of the Permanent Injunction. In light of this misconduct,
 14 Mine Design, its owner and Attorney Candeloro should be held in contempt.

15 **II.**

16 **STATEMENT OF FACTS**

17 **A. Prior Litigation Between VOTIVO And Mine Design.**

18 1. **The California Federal District Court Lawsuits.**

19 Since 1996, VOTIVO² has specialized in the design, manufacture and
 20 wholesale of high-quality aromatic products such as scented candles, incense,
 21

22 ² VOTIVO, LLC, a limited liability company organized under the laws of the State
 23 of South Carolina, and VOTIVO, LTD., a corporation organized under the laws of the
 24 State of Washington, executed an Intellectual Property, Inventory, and other
 25 Physical Property Asset Purchase and Transfer Agreement, an Assignment of
 26 Trademark Interests, and Assignment of Intent-Based Trademark Interests, all on
 27 September 28, 2007, wherein VOTIVO, LLC acquired, among other things, all
 28 rights for the products at issue in this matter, including the trademark registrations
 and other intellectual property rights for U.S.P.T.O. Registration Nos. 2720908
 and 2728815, and Serial No. 76/613881, for MANDARINE [Edmiston Decl., Exs.
 14 and 15.]

1 soaps, room sprays, body and hand lotions, bath salts, and related products.

2 [Edmiston Decl., Ex. 16 (appending the Declaration of Robert E. Caldwell, Jr., ¶
3 3), Ex. 3 (Findings of Fact Nos. 2-4); and Ex. 17 (appending the Declaration of
4 Edgar Lee, ¶ 3).]

5 VOTIVO, Ltd. has twice litigated against Amal Flores, an individual doing
6 business under the name “Mine Design”, in federal district court.³ The primary
7 claims by VOTIVO in each lawsuit were for trademark infringement. The first
8 lawsuit was *VOTIVO, Ltd. v. Mine Design*, U.S. District Court for the Central
9 District of California, Case No. CV 03-6017 (“Mine Design I”), filed in April
10 2003. [Edmiston Decl., Ex. 1 (Complaint, Mine Design I), Ex. 2 (Mine Design’s
11 Answer and Affirmative Defenses of Defendant Mine Design to Plaintiff’s
12 Complaint in Mine Design I).]⁴ In March 2005, VOTIVO, Ltd. brought a second
13 action for trademark infringement, *VOTIVO, Ltd. v. Amal Flores D.B.A. Mine
14 Design*, U.S. District Court for the Central District of California, Case No. CV05
15 2942 (“Mine Design II”). [Edmiston Decl., Ex. 9 (Verified Complaint, Mine
16 Design II), Ex. 10 (Mine Design’s First Amended Answer, Affirmative Defenses,
17 and Counterclaims, Mine Design II).]⁵

18 During the pendency of Mine Design I and II, VOTIVO discovered that
19 Mine Design was also selling products that infringed additional federally
20

21
22 ³ In both cases Mine Design was represented by its present counsel, Attorney
23 Candeloro.

24 ⁴ The VOTIVO trademark registrations initially at issue in Mine Design I were
25 for RED CURRANT and SOKU LIME. Mine Design alleged that the subject marks
26 were generic and not capable of trademark protection. [Id.]

27 ⁵ The VOTIVO trademark registration initially at issue in Mine Design II was for
28 TALL GRASS. Mine Design alleged it “has an interest in the use of ‘tall grass’ as a
common descriptive term of the scent of tall grass.” [Id.]

1 registered trademarks owned by VOTIVO, including MANDARINE. [Edmiston
2 Decl., Ex. 3 (Permanent Injunction).] These additional instances of infringement
3 by Mine Design were incorporated into the litigation, and, as set forth below, are
4 included within the scope of the relief granted by the Court.

5 On November 8, 2005, the Federal Court in Mine Design I entered Findings
6 of Fact and Conclusions of Law, a Permanent Injunction, and a Final Judgment in
7 favor of VOTIVO, including the following:

8 FINDINGS OF FACT

9 2. VOTIVO is one of the country's leading manufacturers and
10 distributors of home décor products, gift products and personal care
11 products. Among the many products sold by VOTIVO are candles, burning
12 sticks and incense, scented room sprays, skin soaps, and scented body
13 sprays.

14 3. Since at least as early as 1999, VOTIVO has used a variety of
15 distinctive trademarks to advertise and promote its products.

16 4. VOTIVO's family of trademarks is distinctive when applied to
17 VOTIVO's products. Because of the excellent sales and extensive
18 promotion of VOTIVO's products, VOTIVO's family of trademarks have
19 become well known to consumers and others in the personal care, home
20 décor and gift industries as identifying unique and desirable products of the
21 highest quality that originate with VOTIVO.

22 5. Consequently, VOTIVO's trademarks are very important and
23 valuable business assets of VOTIVO, and represent significant business
24 goodwill.

25 * * *

26 14. Since filing this lawsuit, VOTIVO also has discovered that –
27 notwithstanding that VOTIVO already has sued Defendant for trademark
28

1 infringement – Defendant has been marketing and selling products that
2 infringe other registered trademarks owned by VOTIVO....

3 * * *

4 CONCLUSIONS OF LAW

5 6. Based upon the foregoing, the Court finds and concludes that
6 the well-pled facts alleged in VOTIVO's complaint and set forth herein
7 establish that Defendant is liable to VOTIVO for: (a) federal trademark
8 infringement; (b) violation of the Lanham Act Section 43(a); (c) violation of
9 California Business & Professions Code section 17200 et seq.; (d) common
10 law trademark infringement; and (e) common law unfair competition.

11 * * *

12 8. Pursuant to Section 34(a) of the Lanham Act, 15 U.S.C. §
13 1116(a), the Court finds and concludes that a permanent injunction in the
14 form requested by VOTIVO should be entered to prohibit Defendant, and
15 all persons acting in concert and participation with Defendant, from
16 infringing... (d) any and all other registered trademarks owned by
17 VOTIVO.

18 9. For the reasons set forth in the July 15 Order, the Court finds
19 and concludes that VOTIVO is entitled to an award of attorneys' fees in the
20 amount of \$19,800 as well as an award of litigation costs pursuant to 28
21 U.S.C. § 1920.

22
23 [Edmiston Decl., Ex. 3 (emphasis supplied).]

24 The Permanent Injunction states:

25 **IT IS HEREBY ORDERED, ADJUDGED AND DECREED AS**
26 **FOLLOWS:**

27 1. Defendant, and its owners, controlling persons... and
28 attorneys...are hereby permanently enjoined and restrained from:

1
2 d. Using any of the terms set forth on Exhibit "A" hereto, each
3 of which is a subject of a United States trademark registration owned by
4 VOTIVO, or any other term, symbol, trademark, service mark, domain
5 name, trade name, or corporate or other entity name that is confusingly or
6 substantially similar to the terms listed on Exhibit "A", in connection with
7 candles and tapers, burning sticks and incense, scented room sprays, scented
8 skin soaps, scented body sprays, and any other scented products for
9 household or personal care use.

10 2. Defendant shall take all reasonable steps to ensure that its
11 owners, controlling persons... and attorneys, do not violate the terms of this
12 Permanent Injunction....

13 3. This Court shall retain jurisdiction over the parties hereto for
14 the purposes of any proceeding to enforce this Permanent Injunction. In the
15 event Defendant, or any of this owners, controlling persons . . . and
16 attorneys... violate any of the terms of this Permanent Injunction, VOTIVO
17 shall be entitled to immediately seek an order to show cause as to why
18 Defendant should not be held in contempt because of such violation. In the
19 event the Court finds that any violation by Defendant of the terms of this
20 Permanent Injunction has taken place, VOTIVO shall be entitled to its
21 reasonable attorneys' fees and costs incurred in addressing such violation.

22 [Edmiston Decl., Exs. 4-5.]

23 Exhibit A to the Permanent Injunction identified and included the over 40
24 separate VOTIVO registered trademarks, including MANDARINE, U.S. Registration
25 Nos. 2,720,908, and 2,728,815. [Edmiston Decl., Exs. 4, 18-19.] Other VOTIVO
26 marks included: BLACK GINGER, RED CURRANT, TALL GRASS and ROSEMARY
27 GARDEN. Id.

1 The Court expressly retained jurisdiction for any subsequent proceeding to enforce
2 the Permanent Injunction.⁶

3 2. Settlement of Mine Design I and II; Dismissal of Appeal.

4 Mine Design appealed the Final Judgment in Mine Design I to the Ninth
5 Circuit, Case No. 06-55147. [Edmiston Decl., Ex. 8.] While the appeal and the
6 Mine Design II case were pending, on May 5, 2006, VOTIVO entered into a
7 Settlement Agreement with Mine Design. [Edmiston Decl., Ex. 11.] The parties
8 agreed that the Mine Design I appeal would be dismissed. [Id.] The Settlement
9 Agreement provides for ongoing enforcement of the Permanent Injunction by
10 providing for the retention of jurisdiction by the federal court in Mine Design I.
11 [Id.] The Settlement Agreement confirms the broad prohibition against Mine
12 Design's use of all of VOTIVO's federally registered trademarks, including
13 MANDARINE:

14 3. Use of VOTIVO Registrations. MINE agrees that it will not,
15 directly or indirectly... use... (ii) any of the trademarks set forth in the
16 Permanent Injunction provided such trademarks remain registered with the
17 United States Patent and Trademark Office.

18 [Edmiston Decl., Ex. 11.]

19 The parties also agreed to a release of all claims and/or liabilities "the
20 Parties may have against each other... including any and all demands, claims,
21 rights, obligations, liabilities, causes of actions... of whatever kind, nature or
22 description... up until the EFFECTIVE DATE. [Edmiston Decl., Ex. 11 at ¶ 7.7,
23
24

25 ⁶ On December 27, 2005, the Mine Design I Court denied Mine Design's
26 F.R.C.P. 59(e) Motion to Alter or Amend Final Judgment. [Edmiston Decl., Exs.
27 6-7.]

28 ⁷ Notably, as of the "Effective Date" (May 5, 2006) of the Settlement Agreement,
VOTIVO's Trademark Application for MANDARINE in connection with bath salts

1 Exs. 12 and 13, (dismissals of the Mine Design I Appeal and the Mine Design II
2 lawsuit).]

3 **B. The MANDARINE Marks.**

4 1. The Existing Registrations for MANDARINE.

5 On April 11, 2002, VOTIVO filed applications to register MANDARINE for
6 skin soap, scented body spray, scented room spray, incense, candles and tapers as
7 a trademark with the U.S. Patent and Trademark Office (the "PTO"). In the course
8 of seeking registration for the trademark, the Trademark Office found that
9 MANDARINE had acquired distinctiveness or secondary meaning under Section
10 2(f). The trademark was registered on the Principal Register in mid-2003.

11 [Edmiston Decl., Exs. 18 and 19.8.]

12 2. Pending Application for MANDARINE.

13 On September 22, 2004, VOTIVO filed an intent-to-use application to
14 register MANDARINE in connection with bath salts and hand lotion. Edmiston
15 Decl., Ex. 20. On May 19, 2005, following an Examiner's Amendment/Priority
16 Action stating that VOTIVO may seek registration under Section 2(f) by claiming
17 acquired distinctiveness through ownership of U.S. Registration No. 2,728,815
18 (for MANDARINE), VOTIVO provided the Examiner the following statement:

19 The mark has become distinctive of the goods as evidenced by the
20 ownership of U.S. Registration No. 2,728,815 on the Principal Register for
21 the same mark for related goods or services.

22 [Edmiston Decl., Exs. 21-22.]

23
24
25 and hand lotion had been pending for *over one and one-half years*, and therefore is
26 clearly included within the scope of the release. [Edmiston Decl., Exs. 11 and 20.]

27 ⁸ These Existing Registrations, among numerous others, were expressly included
28 within the scope of the Permanent Injunction entered against Mine Design,
discussed above. [Edmiston Decl., Ex. 4.]

1 VOTIVO provided an Amendment to Allege Use of MANDARINE on June
2 16, 2005, alleging actual use for bath salts and hand lotion beginning January 7,
3 2005. [Edmiston Decl., Ex. 23.] Notice of Publication issued from the PTO on
4 June 5, 2007. [Edmiston Decl., Ex. 23.]

5 3. Mine Design's TTAB Opposition Proceeding.

6 On August 3, 2007, Mine Design filed a Notice of Opposition before the
7 federal Trademark Trial and Appeal Board. [Edmiston Decl., Ex. 24.] Mine
8 Design alleged it was engaged in the manufacture and wholesale of aromatic
9 products, including aromatic candles, aromatic room sprays, reed diffusers,
10 aromatic bath salts, soaps, and other similar items, and opposed VOTIVO's
11 registration of the term MANDARINE based upon the argument that the term was
12 "generic and functional." VOTIVO Answered and denied Mine Design's
13 allegations. [Edmiston Decl., Ex. 25.] Despite the fact that Mine Design was
14 enjoined from using the term MANDARINE in connection with scented household or
15 personal care products, Mine Design did not address or mention the prior federal
16 court litigation, appeal, nor the Permanent Injunction in its Complaint to the
17 TTAB. Mine Design conducted no discovery. Mine Design moved for summary
18 judgment on or about February 6, 2008.

19 VOTIVO opposed the motion, and filed a cross-motion for summary
20 judgment. [Edmiston Decl., Ex. 26.] In the cross-motion, VOTIVO provided the
21 TTAB with the entire history of the litigation between the parties and argued,
22 among other things, that based upon the Permanent Injunction, Mine Design lacks
23 standing before the TTAB and that its claims are precluded by the doctrines of res
24 judicata. A ruling by the TTAB is pending. [Id.]

25 4. Mine Design's Use of the Term "Mandarin" (And Other Prohibited
26 Terms) is in Violation of the Permanent Injunction.

27 As part of VOTIVO's investigation and defense of the TTAB matter,
28 VOTIVO has discovered that Mine Design is marketing products, including

1 candles, in violation of the Permanent Injunction. To elaborate, VOTIVO
2 discovered that Mine Design filed a pending trademark application for the term
3 “Chalkboard”, Serial No. 77302044, on October 11, 2007. [Edmiston Decl., Ex.
4 28.] Under penalty of perjury, the Mine Design application alleges: that the
5 owner of the mark is Amal Flores DBA Mine Design; that the attorney for Mr.
6 Flores is Carlos Candeloro; that the mark is used in connection with candles; and
7 that the mark was used by August 1, 2007.

8 It is also alleged that the specimen provided in the application is a depiction
9 of actual “product and packaging as shown in catalog.” [Id.] The specimen
10 provided with the application is a picture of product packaging and contents,
11 including the candle, sitting atop five different illustrations (referenced as “five of
12 our most popular fragrances”). The illustrations include “ginger mandarin
13 chalkboard candle.” [Id.]

14 VOTIVO also discovered that Mine Design’s website is marketing candles
15 using the term “Mandarin”. Mine Design has launched a website to sell, among
16 other things, candles. [Edmiston Decl., Ex. 29 (copies of the website pages
17 located at <http://minedesignonline.com>)] Although Mine Design is prohibited by
18 permanent injunction from using the terms BLACK GINGER and MANDARINE, Mine
19 Design is marketing several types of candles with packaging that bears the name
20 on the packaging/label “Ginger Mandarin.” [Id.] In addition, it appears Mine
21 Design is marketing candles that bear prohibited names on the packaging/label
22 including Grass, Rosemary and Currant (Black). A complete list of Mine Design
23 candles offered on the website using terms prohibited by the Permanent Injunction
24 are included as Exhibit 29 to Edmiston Declaration.

III.

ARGUMENT

A. The Court Expressly Retained Jurisdiction To Grant The Relief Sought By This Application.

On November 7, 2005, the Honorable Judge Dickran Tevrizian (Ret.) entered the Permanent Injunction. Because of the history of infringement by Mine Design, Judge Tevrizian included a provision in the Permanent Judgment whereby:

3. This Court shall retain jurisdiction over the parties hereto for the purposes of any proceeding to enforce this Permanent Injunction. In the event Defendant or any of its owners, controlling persons, officers... and attorneys...violate any of the terms of this Permanent Injunction, Votivo shall be entitled to immediately seek an order to show cause as to why Defendant should not be held in contempt because of such violation. In the event the Court finds that any violation by Defendant of the terms of this Permanent Injunction has taken place, VOTIVO shall be entitled to its reasonable attorneys' fees and costs incurred in addressing such violation.

[Edmiston Decl., Ex 4.]⁹

The retention of jurisdiction to enforce the Permanent Injunction is appropriate in light of the discretionary power granted a court of the United States: "A court of the United States shall have power to punish by fine or imprisonment, or both, at its discretion, such contempt of its authority, and none other, as (1) Misbehavior of any person in its presence or so near thereto as to obstruct the administration of justice; (2) Misbehavior of any of its officers in their official

⁹ Thereafter, Judge Tevrizian entered judgment and made the Permanent Injunction a part of that judgment. On December 27, 2005, the Mine Design I Court denied Mine Design's F.R.C.P. 59(e) Motion to Alter or Amend Final Judgment. [Edmiston Decl., Exs. 6-7.]

1 transactions; (3) Disobedience or resistance to its lawful writ, process, order, rule,
2 decree, or command.” Civil contempt is encompassed within this section. *E.g.*,
3 *Britton v. Co-op Banking Group*, 916 F.2d 1405, 1409 n. 4 (9th Cir.1990).

4 Sanctions for civil contempt may be imposed to coerce obedience to a court
5 order, or to compensate the party pursuing the contempt action for injuries
6 resulting from the contemptuous behavior, or both. *United States v. United Mine*
7 *Workers*, 330 U.S. 258, 303-04 (1947), See generally, II C. Wright & A. Miller
8 *Federal Practice and Procedure* § 2960 at 584 (1973).

9 **B. VOTIVO Has Made A Prima Facie Showing That The Permanent**
10 **Injunction Has Been Violated.**

11 “[C]ivil contempt sanctions, or those penalties designed to compel future
12 compliance with a court order, are considered to be coercive and avoidable
13 through obedience, and thus may be imposed in an ordinary civil proceeding upon
14 notice and an opportunity to be heard.” *Int’l Union v. Bagwell*, 512 U.S. 821, 827
15 (1994). A prima facie showing of civil contempt is established by clear and
16 convincing evidence showing that a party had notice of the terms of a court's order
17 and violated that order. *E.g.*, *United States v. Powers*, 629 F.2d 619, 626 n. 6 (9th
18 Cir.1980). Intent to violate the order is not germane; rather, violation of a court
19 order by a party constitutes civil contempt whether or not the violation of the court
20 order was intentional. *Perry v. O'Donnell*, 759 F.2d 702, 705 (9th Cir.1985).
21 Moreover, where “the affidavits offered in support of a finding of contempt are
22 uncontroverted, we have held that a district court's decision not to hold a full-
23 blown evidentiary hearing does not violate due process.” *Peterson v. Highland*
24 *Music*, 140 F.3d 1313, 1324 (9th Cir.1998).

25 Mine Design, Amal Flores and Mr. Candeloro should be ordered to show
26 cause why they should not be held in contempt. Paragraph 3 of the Permanent
27 Injunction shifts the burden of assuring compliance with its terms to Mine Design.
28 Paragraph 3 states in relevant part:

1 3. Defendant shall take all reasonable steps to ensure that its owners,
2 controlling persons, officers... and attorneys, do not violate the terms of this
3 Permanent Injunction.

4 [Edmiston Decl., Ex. 4.]

5 It cannot be disputed that the Permanent Injunction prohibits Mine Design
6 from using the mark MANDARINE (the "Mark") (or any confusingly or substantially
7 similar term such as mandarin) in connection with candles and other home and
8 personal care products. It equally cannot be disputed that Mine Design, its sole
9 proprietor Mr. Amal Flores, and Mr. Caneloro, were directly involved in the
10 litigation leading to the findings of infringement and the entry of the Permanent
11 Injunction. Despite the clarity of the language of the Permanent Injunction, Mine
12 Design, through Mr. Caneloro, has interfered with VOTIVO's ongoing efforts to
13 register the mark MANDARINE by filing the opposition before the TTAB. The sole
14 purpose of filing such an action is the intent to use the Mark; indeed, Mine Design
15 cannot have standing before the TTAB if it does not have (1) a "real interest" in
16 the proceedings and (2) a reasonable basis for the belief of damage. *See Ritchie v.*
17 *Simpson*, 170 F.3d 1092, 1095-96 (Fed. Cir. 1999).

18 Plainly, Mine Design's intent to use the Mark is evidenced by its own
19 federal trademark application for "Chalkboard", in which it states under oath that
20 it has used the mark with packaging utilizing the term "mandarin" since August of
21 2007. Notably, Mine Design's federal trademark application alleges use as of
22 August 1, 2007, only five days prior to the date that Mine Design filed the TTAB
23 Opposition.

24 Mine Design's actual use of the Mark is also evidenced by Mine Design's
25 own website, which repeatedly shows candle products and product logos utilizing
26 the word mandarin in connection with marketing its candles.

27 While its reasons for ignoring the prohibitions of the Permanent Injunction
28 may be unknown, the fact that Mine Design has determined to intentionally violate

1 the Permanent Injunction cannot be disputed. Mine Design should be held in
2 contempt, and the Court should fashion relief preventing Mine Design from
3 further harassment of VOTIVO, and infringement of its trademark rights including
4 enjoining Mine Design from maintaining the TTAB opposition.

5 In a case with nearly identical facts, the TTAB granted summary judgment
6 based upon application of the terms of a permanent injunction previously entered
7 by a federal district court:

8 [T]o the extent that a civil action in a Federal district court involves issues
9 in common with those in a proceeding before the Board, the decision... is
10 typically binding upon the Board, while the decision of the Board is not
11 binding upon the court. See TBMP §510.02(a) (2d ed. rev. 2004).

12 Moreover, any final determination made by the Board is appealable to
13 Federal district court, including to the district in which the civil action
14 between the parties took place. See Trademark Act §21(b); Trademark Rule
15 2.145(c); and TBMP §901 (2d ed. rev. 2004). Thus, in this case, it is
16 incumbent upon the Board to give deference to the determinations of the
17 court, including the remedy entered therein, and consider the terms of the
18 permanent injunction.

19 [Edmiston Decl., Ex. 30, (*Daimler Chrysler Corp. v. Maydak*, Opp. No. 91153172,
20 at p. 12-13 (April 4, 2008)).] The Board concluded that the Federal court
21 permanent injunction was, as a matter of law, dispositive: “because the injunction
22 permanently prohibits applicant from using...the mark, it is a legal impossibility
23 for applicant to obtain registration.” [Id.]

24 This Court has the authority to require Mine Design, and its legal counsel,
25 to cease efforts to “backdoor” its way around the Permanent Injunction. Based
26 upon the facts, Mine Design should be ordered to dismiss its TTAB Opposition.

1 **C. This Court Should Require Mine Design To Reimburse VOTIVO For**
2 **All Reasonable Attorney's Fees Arising From The Violation Of The**
3 **Permanent Injunction.**

4 Paragraph 3 of the Permanent Injunction provides in relevant part:

5 3. ... In the event the Court finds that any violation by Defendant of
6 the terms of this Permanent Injunction has taken place, VOTIVO shall be
7 entitled to its reasonable attorney's fees and costs incurred in addressing
8 such violation.

9 [Edmiston Decl., Ex. 4.] Even without this mandate in this case, an award of
10 attorneys' fees is proper in a case of willful trademark infringement as well as in
11 contempt proceedings for such infringement. 15 U.S.C. § 1117; *General Signal*
12 *Corp. v. Donallco, Inc.*, 787 F.2d 1376, 1380 (9th Cir. 1986).

13 In evaluating a request for such fees, the Court must consider certain factors
14 which are called into question by the case, and which support the reasonableness
15 of the award of such fees. *Kerr v. Screen Extras Guild, Inc.*, 526 F.2d 67, 70 (9th
16 Cir. 1975); *Ford Motor Co. v. Kuan Tong Indus. Co., Ltd.*, 697 F.Supp. 1108,
17 1109 (N.D. Cal. 1987). These factors include: (1) the time and labor required; (2)
18 the novelty and difficulty of the questions involved; (3) the skill required to
19 perform the legal service properly; (4) the preclusion of other employment by the
20 attorney due to the acceptance of the case; (5) the customary fee; (6) whether the
21 fee is fixed or contingent; (7) time limitations imposed by the client or the
22 circumstances; (8) the amount involved and the results obtained; (9) the
23 experience, reputation and ability of the attorneys; (10) the "undesirability" of the
24 case; (11) the nature and length of the professional relationship with the client;
25 and (12) awards in similar cases. *Id.*

26 Here, Mine Design has been permanently enjoined from using the Mark, but
27 has intentionally proceeded to use the Mark. It is difficult to imagine a worse set
28 of facts for Mine Design. VOTIVO should be awarded its reasonable attorneys

1 fees and costs in this proceeding, and those incurred in connection with the TTAB
2 opposition, which VOTIVO has been required to vigorously defend. If the Court
3 agrees, VOTIVO will submit supplemental declarations setting forth the fees and
4 costs it has incurred for the Court's consideration.

5 **IV.**

6 **CONCLUSION**

7 For the reasons detailed above, VOTIVO requests that the Court should
8 issue an order to show cause why Mine Design, Amal Flores, and Attorney
9 Candeloro should not be held in contempt. If the Court finds these parties in
10 contempt, the Court also should award VOTIVO reasonable attorney's fees and
11 costs arising from the violation of the Permanent Injunction.

12
13 Dated: August 20, 2008

Respectfully Submitted,
BAUTE & TIDUS LLP

14
15
16
17 By _____


Mark Q. Baute, Esq.
Robert M. Gilcrest, Esq.
Attorneys for Plaintiffs
VOTIVO, LTD. and VOTIVO, LLC

Exhibit 2

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5 carlos@candeloro.net

6 Attorney for Defendant

7 UNITED STATES DISTRICT COURT
8 CENTRAL DISTRICT OF CALIFORNIA

9 Votivo, Ltd., a Washington corporation; and
10 Votivo LLC, a South Carolina limited
11 liability company,

12 Plaintiff,

13 vs.

14 Mine Design, a sole proprietorship,

15 Defendant

Case No.: CV 03-6017 DDP (Ex)

Notice Of Decision by Other Court

16 **Notice**

17 Notice is hereby given that the United States Patent and Trademark Office (PTO)
18 Trademark Trial and Appeal Board (TTAB)¹ issued an Opinion (enclosed) in Opposition
19 No. 91178747.²

20 Relevant to the present action before the Court, the Board, *inter alia*, denied
21 summary judgment to either party on the issue of standing – apparently on the ground
22 that issues of material fact remain regarding the Permanent Injunction and the Settlement
23 Agreement between the parties.

24 _____
25 ¹ The Board is not necessarily a “Court.” The Opinion is nevertheless being brought to the
26 attention of the Court to keep the Court informed of the proceedings in the Opposition, as they
27 may be relevant to the present action before the Court.

28 ² The Opposition file in its entirety should be available from the PTO’s website
(www.uspto.gov), specifically at ttabvue.uspto.gov/ttabvue/v?pno=91178747&pty=OPP

1 Counsel for the parties to the Opposition are presently conferring regarding
2 notifying the Board of the present action by Votivo in the United States District Court
3 and possibly filing a motion to stay the Opposition pending a decision herein. It is
4 undersigned's present understanding that a decision herein would likely be binding on the
5 Board and a final decision by the Board may be appealed to this Court or the United
6 States Court of Appeals for the Federal Circuit.

7
8 Dated this 29th day of September, 2008

9 Respectfully submitted,

10 /Carlos Candeloro/

11

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THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: September 19, 2008

Opposition No. 91178747

Mine Design a d.b.a. of Amal
Flores

v.

Votivo, Ltd. and Votivo, LLC

Before Holtzman, Cataldo, and Ritchie de Larena,
Administrative Trademark Judges

By the Board:

Votivo, LLC, successor in interest to Votivo, Ltd.,
(collectively "applicant") seeks to register the mark
MANDARINE in standard character form for "bath salts and
hand lotion" in International Class 3.¹

¹ Application Serial No. 76613881, filed September 30, 2004 by Votivo, Ltd. ("Ltd."), based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The application includes a statement that the English translation of the French word "MANDARINE" is "MANDARIN" and a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), based on its ownership of Registration No. 2728815 on the Principal Register for the same mark for related goods, namely, "skin soap, scented body spray, scented room spray, and incense," which was issued on June 24, 2003. During *ex parte* examination, Ltd. filed an amendment to allege use wherein it alleged January 7, 2005 as the date of first use anywhere and the date of first use in commerce. The application was published for opposition on June 5, 2007, and opposer filed his notice of opposition on August 3, 2007.

Mine Design a d.b.a. of Amal Flores ("opposer"), an individual, opposes registration of applicant's mark on grounds that the mark is "de jure functional" under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5), and that it is generic for applicant's goods. In the answer thereto, applicant denied the salient allegations of the notice of opposition.² In addition, applicant asserted the following affirmative defenses: (1) that the notice of opposition "fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition;"³ and (2) the opposition is subject to the doctrines of "res judicata and claim preclusion" because the involved mark was previously registered in Registration No. 2728815.

As an initial matter, with regard to the proposed functionality claim, we note that the mark at issue in this case consists entirely of wording in standard characters and that only utilitarian product features can be refused

² Ltd., the record owner of the involved application when this proceeding commenced, filed the answer in this proceeding on September 12, 2007. The involved application was assigned, along with Registration No. 2728815, to applicant in a document that was executed on September 28, 2007 and was recorded with the USPTO's Assignment Branch on October 31, 2007 at Reel 3650, Frame 0419. Applicant was joined as a party defendant in this case in a February 7, 2008 Board order.

³ We note, however, that the only context in which the Board will consider the sufficiency of opposer's pleading is a motion to dismiss under Fed. R. Civ. P. 12(b)(6). Otherwise, such "affirmative defense" will be given on consideration.

registration on the ground that they are, as a whole, functional, under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5). See TMEP Section 1202.02(a) (5th ed. 2007). Accordingly, the proposed claim that the mark is *de jure* functional is unavailable in this case, and paragraphs 29-32 of the notice of opposition are hereby stricken.

This case now comes up for consideration of: (1) opposer's motion (filed February 6, 2008) for summary judgment on his pleaded claim of genericness; and (2) applicant's cross-motion (filed March 12, 2008) for summary judgment on the grounds that opposer lacks standing to oppose registration of applicant's mark because opposer has been "permanently enjoined" from using the involved mark and because the opposition is barred by the doctrine of *res judicata* or claim preclusion and/or the doctrine of collateral estoppel or issue preclusion. The motions have been fully briefed.

Inasmuch as applicant's cross-motion for summary judgment is based on opposer's alleged lack of standing to pursue this opposition, we will consider the cross-motion first. We note initially that Ltd. did not set forth in its answer the affirmative defenses upon which it relies as bases for that cross-motion. We further note that opposer has objected to applicant's cross-motion on that basis and that applicant did not subsequently seek leave of the Board

to amend its answer to add such affirmative defenses.⁴ Accordingly, notwithstanding that opposer responded on the merits to the cross-motion for summary judgment, these unpleaded affirmative defenses may not serve as bases for summary judgment. See *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 n.5 (TTAB 1995).

In any event, the record indicates that the parties were involved in two earlier civil actions: (1) Case No. CV 03-6017-DT, styled *Votivo, Ltd. v. Mine Design*, filed in 2003 in the United States District Court for the Central District of California; and (2) Case No. CV 05-2942-DT, *Votivo, Ltd. v. Amal Flores d/b/a Mine Design*, filed in 2005 in the United States District Court for the Central District of California. Because neither civil action was actually litigated, the doctrine of collateral estoppel or issue preclusion does not apply. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

We will next consider whether opposer's standing is barred under the doctrine of *res judicata* or claim preclusion. While the second civil action was in the

⁴ Opposer's contention that *Votivo, LLC* is in default because it did not file its own answer following its joinder as a party defendant herein is incorrect. As the assignee of the involved application, applicant stands in the shoes of assignor *Ltd.*, which timely files an answer. See *CBS Inc. v. Man's Day Publishing Company, Inc.*, 205 USPQ 470 (TTAB 1980). Accordingly, *Ltd.*'s answer serves as applicant's responsive pleading. The Board notes in addition that, in the February 7, 2008 order in which *Votivo, LLC* was joined as a party defendant, the Board did

discovery period and opposer's appeal of the district court's entry of default judgment and permanent injunction against him to the United States Court of Appeals for the Ninth Circuit was pending in the first civil action,⁵ the parties entered into a settlement agreement. Under the terms of that agreement, the parties agreed to "dismiss their claims against [each] other" and that opposer would not use the MANDARINE mark so long as that mark remains registered. Settlement agreement at paragraphs 1 and 3. The parties filed a stipulation with the district court to dismiss "all claims and counterclaims" in the second civil action "with prejudice." However, the stipulation that the parties filed with the court of appeals in the first civil action sought dismissal of the appeal only and does not expressly asks that all claims in that case be dismissed.

In view of the discrepancy between the actions that the parties appear to have agreed to take in the settlement agreement with regard to their district court litigation and the action that the parties took by way of the stipulation to dismiss the first civil action that they filed with the court of appeals, we find that there are genuine issues of

not set time for Votivo, LLC to file an answer because a new answer was unnecessary.

⁵ The permanent injunction, in relevant part, "permanently enjoined and restrained [opposer] from" using the involved MANDARINE mark "or any term ... that is confusingly or substantially similar" thereto on "any ... scented products for

material fact regarding whether, under the doctrine of *res judicata* or claim preclusion, opposer lacks standing to pursue this opposition. In particular, there are genuine issues of material fact as to whether the settlement agreement is effective to dismiss the claims in the first civil action; and, if it is not, as to the effect of that agreement on the earlier permanent injunction. In view thereof, applicant's cross-motion for summary judgment is denied.

We will next consider opposer's motion for summary judgment on the ground of genericness. With regard to opposer's standing to maintain this proceeding, we find that opposer has failed to meet his burden of showing that there is no genuine issue of material fact that he has a present or prospective right to use the term MANDARINE or its asserted equivalent "mandarin" descriptively or generically in his business. See *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984). Moreover, as to the merits, we find that opposer has failed to meet his burden of showing that there is no genuine issue of material fact that the involved MANDARINE mark or its asserted equivalent "mandarin" is understood by the relevant public

household or personal care use." Permanent injunction at paragraph 1(d).

primarily to refer to "bath salts and hand lotion."⁶ See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In view thereof, opposer's motion for summary judgment is denied.⁷

Proceedings herein are resumed. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE:	October 10, 2008
Plaintiff's 30-day testimony period to close:	January 8, 2009
Defendant's 30-day testimony period to close:	March 9, 2009
Plaintiff's 15-day rebuttal testimony period to close:	April 23, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

⁶ Applicant asserts in its brief in opposition to the motion for summary judgment and in support of its cross-motion for summary judgment that its involved mark is "suggestive" and "inherently distinctive." However, by seeking registration of the involved mark under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), applicant has conceded the mark's lack of inherent distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

⁷ The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss &*

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993);
Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB 1983).