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

|                        |   |
|------------------------|---|
| Proceeding             | 91178747  |
| Party                  | Defendant<br>Votivo, Ltd. and Votivo, LLC   |
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| Submission             | Other Motions/Papers  |
| Filer's Name           | Heather M. Morado   |
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| Signature              | /Heather M. Morado/   |
| Date                   | 02/08/2010  |
| Attachments            | Applicant-Defendant's Response to Opposer's Notice Requesting Corrective Action.pdf ( 6 pages )(123937 bytes )                                  |

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

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

Opposer,

v.

VOTIVO, LTD., a Washington corporation,

Applicant,

VOTIVO, LLC, a South Carolina Limited  
Liability Company,

Defendant.

APPLICANT / DEFENDANT'S  
RESPONSE TO OPPOSER'S  
NOTICE REQUESTING  
CORRECTIVE ACTION

Opposition No. 91178747

On December 10, 2009, the Board issued an order (the "December Order") requesting that Applicant / Defendant ("Votivo") file with the Board certain documents related to the pending federal litigation between the parties in the United States District Court for the Central District of California, Cause No. CV 03-6017-DT. The Board asked for the parties' briefing and court orders related to the following: (1) Votivo's August 20, 2008 Application for an Order to Show Cause Why [Opposer] Should Not Be Held in Contempt ("the August 20, 2008 Application"); and (2) Votivo's November 17, 2008 Motion for an Order to Show Cause Why [Opposer] Should Not Be Held in Contempt of the Permanent Injunction ("the November 17, 2008 Motion"). Specifically, the Board requested the following documents:

“(1) all briefing, from both parties, in support of, and in opposition to, the August 20, 2008 application and the November 17, 2008 motion that is not already in the Board file for this proceeding; and (2) any decisions rendered by the district court on the August 20, 2008 application and the November 17, 2008 motion that is not already in the Board file for this proceeding, including a copy of the December 22, 2008 decision.”

See December 10, 2009 Order, pp. 5-6.

Votivo filed the relevant documents requested by the Board on December 17, 2009.

In Opposer’s Notice Requesting Corrective Action, Opposer argues that Votivo “omitted or failed to submit a number of documents encompassed by the Dec. 10, 2009 Order.” Opposer then provides a list of docket numbers of several documents in a footnote to its Notice Requesting Corrective Action. With the exception of one inadvertently omitted declaration, the additional documents cited by Opposer are irrelevant to the matters at hand and outside of the scope of the Board’s requests in its December Order. Votivo addresses each document submitted by Opposer as follows:

1) The Court’s Order scheduling the case for mediation: This document is irrelevant because it is unrelated to the August 20, 2008 Application and the November 17, 2008 Motion. Thus, it is outside the scope of the documents requested by the Board in its December Order.

2) Docket No. 84, Notice of Decision of the Board Denying Plaintiff’s Motion for Summary Judgment: This decision of the Board denying Plaintiff’s Motion for Summary Judgment is already on file in this proceeding. Thus, it is unnecessary to supplement the record with this document.

3) Docket Nos. 85 and 86, Minutes of In Chambers Orders, dated October 31, 2008 and November 14, 2008: These minute orders are misleading when submitted by Opposer outside of their procedural context. The minute orders arose out of a simple procedural matter under which Votivo's 1) Motion to Substitute Plaintiff Votivo, LLC for Votivo Ltd.; and 2) Application for an Order to Show Cause re: Why Defendant Should Not Be Held in Contempt were both vacated and then refiled at the instruction of the court filing clerk. The California District Court action was originally filed before a District Court Judge who subsequently retired. After the case was assigned to the new judge, the new Judge's Clerk advised Votivo that the Motion and Application would have to be refiled because the caption page of the briefs did not include a proposed hearing date on the caption. As a result, the Motion and Application were vacated by the Clerk and subsequently refiled by Votivo. Thus, these minute orders cited by Opposer are misleading, irrelevant, and outside of the scope of the Board's requests in its December 10, 2009 Order.

4) Docket No. 92, Mine Design's Opposition to Votivo's Motion to Substitute a Party: This document was previously filed as Exhibit C to the Declaration of Heather M. Morado in Support of Motion for Leave to Supplement Record in Support of Motion for Reconsideration. Thus, it is already before the Board and it is unnecessary to supplement the record with this document.

5) Docket No. 93, Votivo's Reply in Support of Motion to Substitute a Party: This document is irrelevant because it is unrelated to the August 20, 2008 Application and the November 17, 2008 Motion, and is thus outside the scope of the documents

requested by the Board. Further, although Mine Design initially opposed Votivo's Motion for Substitution of Votivo, LLC in place of Votivo, Ltd., the Court granted Votivo's Motion for Substitution.

6) Docket No. 96, Minutes of Plaintiff's Motion for Substitution of a Party: This document is irrelevant for the same reasons as to Docket No. 93 above.

7) Docket No. 98, Attachment #2, the Declaration of Carlos Candeloro in Support of Supplemental Briefing re Motion for Order to Show Cause re: Why Defendant Mine Design Should Not Be Held in Contempt: This document was inadvertently omitted by Votivo in the Declaration of Heather M. Morado in Support of Motion for Leave to Supplement Record in Support of Motion for Reconsideration. Thus, Votivo submits this declaration as Exhibit A to the Declaration of Heather M. Morado filed in support of this Response.

#### **CONCLUSION.**

VOTIVO requests that with the exception of the Declaration of Carlos Candeloro in Support of Supplemental Briefing, that all other documents cited by Opposer in its Notice Requesting Corrective Action be disregarded as irrelevant and outside of the scope of the documents requested by the Board in its December 10, 2009 Order.

DATED: February 8, 2010.

Respectfully Submitted,

INVICTA LAW GROUP, PLLC

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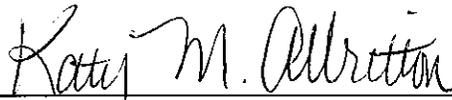
Attorneys for Applicant

**CERTIFICATE OF EXPRESS MAILING**  
**37 C.F.R. §1.10**

“Express Mail” mailing label number: EM484897444US  
Date of Deposit: February 8, 2010

I hereby certify that this paper is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 CFR §1.10 on the date indicated above and is addressed to:

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



Katy M. Albritton  
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