

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

Mailed: June 14, 2010

Opposition No. 91185325

La Senza Corporation

v.

Olympic Mountain and Marine
Products, Inc.

Linda Skoro, Interlocutory Attorney

This case now comes up on applicant's motion to amend its answer to add a counterclaim for partial cancellation of opposer's claimed registration on the ground that opposer has abandoned its mark as to certain goods. Opposer has responded¹ contending applicant's motion to amend its answer to add a counterclaim is untimely, legally insufficient, procedurally defective and serves no useful purpose. However, in further response, opposer has moved to amend its claimed registration to delete the goods which applicant claims have been abandoned.

¹ It is also noted that opposer has filed a motion to extend time within which to respond to applicant's motion to amend its answer on March 15, 2010. Applicant has objected stated that this proceeding has been the subject of numerous consented extensions; that there have been no genuine settlement discussions going on as asserted by opposer and that its privilege of any further extensions has been abused. In that opposer filed its motion on the last day of the previous extension period, and filed its response on March 22, 2010, the extension is hereby granted.

In that opposer's proposed amendment to its claimed registration can be deemed as an admission that those goods have indeed been abandoned, the motion to amend the answer to add the counterclaim will be granted. It is noted, however, the counterclaim to partially cancel opposer's pleaded Registration No. 1800379 cannot be entered at this time because the proper fee for filing a counterclaim has not been paid. See Trademark Rules 2.106(b)(2) and 2.111. Accordingly, applicant is allowed THIRTY DAYS within which to file the appropriate fee, should it wish to go forward with its counterclaim.

As for opposer's motion to amend its registration to delete certain goods, that too must be denied in that (1) opposer has not obtained the consent of applicant for a claimed registration involved in an inter partes proceeding and (2) it too has not paid the appropriate fee. Trademark Rule 2.173 provides, in part, that the application for such action is to be signed by the registrant and verified or include a declaration in accordance with 37 C.F.R. § 2.20, and must be accompanied by the required fee.² See also Section 7(e) of the Trademark Act.

Accordingly, opposer is allowed until **thirty** days from the mailing date of this order to submit the appropriate

² Also see the requirement in Trademark Rule 2.173(c) requiring a printed copy of the amendment to be attached to each printed copy of the registration.

documents for the amendment to the identification of goods, including the appropriate fee. Upon receipt of the same, should applicant have paid the appropriate fee and wish to proceed with its amendment to its answer, time will be allowed for opposer to respond to the motion for summary judgment. If, on the other hand, opposer files the appropriate fee and documentation for the amendment to its registration **and** obtains applicant's consent to the amendment, the amendment will be entered. Further, if these amendments resolves this matter before the Board, opposer should inform the Board of its withdrawal of the opposition. Absent any of the above, opposer will be allowed time to file its response, if any, to applicant's motion for summary judgment. No further extensions of time will be allowed.

Proceedings herein are suspended for THIRTY DAYS pending the parties' response to each of these matters.