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

Proceeding	91185325
Party	Plaintiff La Senza Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LA SENZA CORP., Opposer vs. OLYMPIC MOUNTAIN AND MARINE PRODUCTS, INC., Applicant.	Opposition No. 91185325

OPPOSER'S REQUEST FOR RECONSIDERATION

COMES NOW the Opposer, La Senza Corp., by and through counsel, and, pursuant to Trademark Rule 2.127(b), 37 CFR §2.127(b), respectfully requests reconsideration of the Order issued by the Trademark Trial and Appeal Board ("Board") in the above proceeding on June 14, 2010 (the "Board Order").

In essence, the parties *agree* that the Trademark Office inadvertently erred in not deleting goods from La Senza's Registration, consistent with La Senza's renewal papers, prior to the commencement of this proceeding. Accordingly, in view of this clearly disclosed material mistake in a registration, incurred through the fault of the Trademark Office, it is respectfully submitted that the Trademark Office (through the offices of the Board) should correct the mistake by deleting the noted goods as a "corrective measure" – without entering judgment on any claims.

In short, this issue is not a claim to be litigated, but rather an error to be corrected.

In view the present request, La Senza also requests that the deadlines set forth in the Board's July 9, 2010 Order (to answer Olympic's counterclaim and summary judgment motion on this issue) be stayed until this request for reconsideration is resolved.

Facts

As discussed more fully in earlier-filed papers[1], on October 22, 2003, La Senza submitted a "Combined Declaration of Use in Commerce/Application for Renewal" (the "Combined Declaration") on La Senza's registration, which declared that the LA SENZA mark was in use "on or in connection with the following goods listed in the existing registration, namely: **BODY LOTIONS**." *See* Exhibit C to La Senza's Opposition Brief and Motion to Amend Registration.

On January 10, 2004, the Trademark Office issued a Notice of Acceptance and Notice of Renewal on La Senza's registration. *See* Exhibit D to La Senza's Opposition Brief and Motion to Amend Registration. However, the Trademark Office did **not** narrow La Senza's registration consistent with the Combined Declaration. Rather, it included goods other than body lotions.

In short, both parties assert that it was error for the Trademark Office to not narrow the goods of La Senza's registration to those listed in the Combined Declaration, namely, "body lotions".

[1] *See* "Opposer's Brief in Opposition to Applicant's [Second] Motion for Leave to Amend Answer and Assert Counterclaim for Partial Cancellation and Opposer's Motion to Amend Registration" (hereafter "La Senza's Opposition Brief and Motion to Amend Registration"), pp. 3-4.

Argument

La Senza respectfully submits that the Board Order erred in its resolution of the outstanding motions. Thus, despite the multiple, fatal defects in Olympic's Motion to Amend its Answer – defects which Olympic did **not** contest and were not ruled upon in the Board Order (and so are maintained by La Senza) – this does not mean that the mistake in La Senza's registration should continue uncorrected. Rather, La Senza respectfully submits that the proper course is for the Board to delete the relevant goods from La Senza's registration, as a "corrective measure", and *without* entering judgment[2] – as the Board did in an analogous case. *See Immunotec Research Ltd. v. Rath, Matthias*, Opposition No. 91162850, 2006 TTAB LEXIS 193 (May 25, 2006) (not precedential).

In *Immunotec Research*, *supra*, the applicant sought, during prosecution, to change the basis of its multi-class application (consisting of three classes: 5, 16, and 32) from Section 1(b) (intent-to-use) to Section 44(e), relying on a German registration (which consisted of only two classes: 5 and 32). However, the Trademark Office improperly approved the application for publication in all three classes, including class 16 for which there was no basis under the German registration. During the opposition proceeding, the opposer sought to amend its opposition to seek judgment against the applicant as to the class 16 goods. Noting the Trademark Office's "apparent oversight", the Board deleted the Class 16 goods from the opposed application "as a corrective measure", and ordered the proceeding to go forward on the "corrected" application.

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[2] La Senza respectfully submits that it would be prejudicial and unfair to La Senza to allow Olympic's abandonment claim to go forward, with the risk of judgment being entered against La Senza, as the result of Trademark Office error. *Cf. Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (motion to amend denied because examiner's failure to enforce submission of foreign registration was examination error); *Saint-Gobain Abrasives, Inc. v. Unova Ind. Auto. Sys., Inc.*, 66 U.S.P.Q.2d 1355 (TTAB 2003) (fairness dictates that the *ex parte* questions not be a ground for cancellation).

In doing so, it denied the parties' various motions as moot, expressly finding that "there is no abandonment of the application with respect to Class 16 during the pendency of this opposition proceeding". La Senza respectfully submits that a similar "corrective" course in this case is proper and required; and would avoid unnecessary delay, expense, and consumption of Board resources – as well as avoiding undue prejudice to La Senza.

Indeed, the Trademark Rules would seem to provide for this very situation:

> Whenever Office records clearly disclose a material mistake in a registration, incurred through the fault of the Office, the Office will issue a certificate of correction stating the fact and nature of the mistake, signed by the Director or by an employee designated by the Director, without charge. Thereafter, the corrected certificate shall have the same effect as if it had been originally issued in the corrected form. In the discretion of the Director, the Office may issue a new certificate of registration without charge.

See 37 CFR §2.174 (Correction of Office mistake). As discussed above and in La Senza's Opposition Brief and Motion to Amend Registration, in this case the "records clearly disclose a material mistake in a registration, incurred through the fault of the Office." Accordingly, the "Office [should] issue a certificate of correction stating the fact and nature of the mistake . . . .".

Additionally, La Senza respectfully submits that the Board Order erred in requiring La Senza to obtain Olympic's consent to the proposed amendment,[3] since the Trademark Rules do not require it.[4] Rather, the request may be granted upon Motion, as La Senza sought. *Id., see*

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[3] Moreover, the Board Order found that La Senza had not paid the appropriate fee. However, La Senza respectfully submits that no fee is required since the amendment is necessitated by Trademark Office error. *See* 37 CFR § 2.174 (Correction of Office mistake).

[4] *See* 37 CFR § 2.133(a) ("An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, <u>or upon motion granted by the Board</u>.") (emphasis supplied).

also La Senza's Opposition Brief and Motion to Amend Registration. Indeed, it is undisputed that Olympic did not contest, or otherwise object to, La Senza's motion to amend its registration. Accordingly, the uncontested Motion could have been granted, as conceded.[5] Moreover, it is difficult to imagine a more appropriate case for amending a registration than to correct a material mistake incurred through the fault of the Trademark Office. Furthermore, there would appear to be no compelling reason to allow a non-moving party the opportunity to derail the Trademark Office's corrective action, in such a case, by withholding consent.

In any event, as discussed above, La Senza contends that the proper approach is for the Board to administratively correct the material mistake in La Senza's registration, as a "corrective measure".

Stay

La Senza respectfully requests that the Board stay the deadlines set forth in the Board's July 9, 2010 Order, pending a determination of the present request. Were La Senza required to comply with the latter Order before the present request is ruled upon, it would render such request meaningless and moot. However, in an effort to minimize any delay, Opposer requests that the present motion be resolved (or at least addressed) by telephone conference as soon as practical. 37 CFR § 2.120(i)(1), TBMP § 502.06(a).

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[5] *See* Trademark Rule 2.127(a) ("When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded."), *see also*, *Chesebrough-Pond's Inc. v. Faberge, Inc*., 618 F.2d 776, 205 USPQ 888, 891 (CCPA 1980) (treating motion for summary judgment as conceded was proper); *Central Manufacturing Inc. v. Third Millennium Technology, Inc*., 61 USPQ2d 1210, 1211 (TTAB 2001) (motion to dismiss treated as conceded); and *Boston Chicken Inc. v. Boston Pizza International Inc*., 53 USPQ2d 1053, 1054 (TTAB 1999).

Conclusion

It is respectfully submitted that legal and factual considerations – buttressed by the broader policies of judicial efficiency, simplicity, and fairness – require reconsideration of the Board Order. Accordingly, for all of the foregoing reasons, La Senza respectfully requests that the Board GRANT Opposer's Request for Reconsideration.

Respectfully submitted,

LA SENZA CORP.

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Dated: July 14, 2010
Attorney Docket No. I-5837

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing OPPOSER'S REQUEST FOR RECONSIDERATION, to be served by first-class mail, postage prepaid, upon counsel for Applicant:

Philip A. Kantor, Esquire
Law Offices of Philip A. Kantor, P.C.
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on this 14th day of July, 2010

/Matthew J. Cuccias/