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

Proceeding	91190169
Party	Plaintiff SUSINO UMBRELLA CO., LTD.
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Submission	Opposition/Response to Motion
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of App. Ser. No. 77/355,544)	
)	
SUSINO UMBRELLA CO., LTD.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91190169
)	
SUSINO USA LLC,)	
)	
Applicant.)	

**OPPOSER’S CORRECTED RESPONSE TO APPLICANT’S MOTION TO
DISMISS
NOTICE OF OPPOSITION AND MEMORANDUM OF LAW**

Opposer, Susino Umbrella Co., Ltd., ("Susino Umbrella"), by its undersigned attorney, hereby answers and opposes Applicant’s Motion to Dismiss Notice of Opposition and Memorandum of Law pursuant to Rule 12(b)(6) and requests that it be denied as follows:

1. Applicant asserts in the motion that Opposer’s Notice of Opposition to App. Ser. No. 77/355,544 fails to state a claim upon which relief can be granted pursuant to FR 12(b)(6).
2. 37 CFR Part 2 §2.101 (Filing an opposition) states:
 - (a) An opposition proceeding is commenced by filing a timely opposition, together with the required fee, in the Office.
3. Regarding the content of a Notice of Opposition. 37 CFR Part 2 § 2.104 states:

(a) The opposition must set forth a short and plain statement showing why the Opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.

4. Opposer's Notice of Opposition is sufficient and fulfills the requirements set out for Opposition Pleading.

Opposer's Belief of Damage by Registration

5. In the Notice of Opposition, Opposer sets forth short and plain statements showing why the Opposer believes he, she or it would be damaged by the registration of the opposed mark, as required by §1.104, as shown, but not limited to the following:

6. In paragraph 3 of the Notice of Opposition, it is stated that Susino Umbrella owns the mark SUSINO and associated nationwide common law rights in the trademark SUSINO.

7. It was also stated in paragraph 3 that Susino Umbrella had filed a Trademark Application (Serial No. 79/001855, filed March 26, 2004, since abandoned) under 66A in the US for SUSINO plus design and Characters for "Umbrellas, umbrella rings, frames for umbrellas or parasols, umbrella sticks, umbrella covers, umbrella handles, parasols" in International Class 18. It was further stated that the usage claimed by Applicant is by selling umbrellas made and marked SUSINO by Susino Umbrella in China which were sent to Applicant for distribution and sale in the United States.

8. In paragraph 4 of the Notice of Opposition that Susino Umbrella has rights in the trademark SUSINO which have priority over the Application at issue based on Susino Umbrella's prior use of the mark SUSINO.

9. In paragraph 5, it was stated that "Applicant's application for, and intended use of, the designation SUSINO for the goods identified in the Application so resembles Susino Umbrella's nationwide common law rights in the trademark and pending application to register SUSINO as to be likely to cause confusion, mistake, or deception".

10. It is further stated in paragraph 6 that "[t]he designation SUSINO in the Application is identical to Susino Umbrella's prior rights in the trademark SUSINO" and that, as stated in paragraph 8 in the Notice, "[i]f the Application is allowed to register, purchasers of umbrellas sold under the designation SUSINO are likely to be confused into believing that Applicant's goods originated or are connected with, or are sponsored, licensed, endorsed or approved by, Susino Umbrella or its SUSINO trademark or goods, all to Susino Umbrella's detriment." It is further stated in paragraph 8 that "[r]egistration of the designation SUSINO by Applicant would allow Applicant to wrongfully appropriate Susino Umbrella's valuable goodwill and reputation associated with its SUSINO trademark."

11. It is further stated in paragraph 9 of the Notice that "[i]f the Application is allowed to register, Susino Umbrella would likely be prevented from obtaining a registration to register the trademark SUSINO for "umbrellas", despite its priority of use of the trademark SUSINO."

12. As such, Opposer has, in its Notice of Opposition, made a showing of “why the Opposer believes he, she or it would be damaged by the registration of the opposed mark”, as required by 37 CFR Part 2 §101 and §104. As stated in paragraph 10 of the Notice, “As a result of the likelihood of confusion that would be caused by Applicant’s proposed registration and use of the designation SUSINO, Susino Umbrella believes that issuance of a registration based on the Application will result in damage and injury to Susino Umbrella. Applicant's registration of the designation SUSINO would allow Applicant an unqualified right (a) to wrongfully appropriate Susino Umbrella’s goodwill and reputation associated with the mark SUSINO; (b) to benefit from the likely confusion among purchasers as to the source or sponsorship of SUSINO goods; and (c) to harm Susino Umbrella's goodwill and reputation associated with the mark SUSINO by allowing any fault with or objection to Applicant’s goods to reflect adversely upon Susino Umbrella.”

Opposer’s Grounds for Opposition

13. Opposer also states grounds for opposition, which is the remaining requirement for the Contents of Opposition under 37 CFR Part 2 §104, illustrated as follows.

14. Opposer has asserted that it has “prior use” in the mark (see paragraphs 4 and 9 of the Notice of Opposition as non-limited examples) and that, as stated in paragraph 5 (among other places in general), “the designation SUSINO for the goods identified in the Application so resembles Susino Umbrella’s nationwide common law rights in the trademark and pending application to register SUSINO as to be *likely to*

cause confusion, mistake, or deception under § 2(d) of the Trademark Act, 15 U.S. C. § 1052(d). (emphasis added)

15. As such, Opposer's Notice of Opposition stated at least one Ground for Opposition, as required by 37 CFR Part 2 §§ 101, 104.

16. As shown above, Opposer's Notice of Opposition is sufficient and fulfills the requirements set out for Opposition Pleading. It gives enough detail to give the Applicant fair notice of the basis for the claimed ground for opposition. Nothing further was required.

Applicant's Motion to Dismiss

17. The follow is to further address certain specifics in Applicant's Motion document. It is not to be considered exhaustive of Opposer's objections to the Motion.

18. Applicant certified that it served this Motion on Opposer on August 28, 2009 by mail. Applicant submitted its Exhibits to the TTAB on September 10, 2009. None of Applicant's filed Exhibits comport with Rule 2.123(g) (2). Rather, they are simply a collection of documents without the Applicant's name, Opposition Number, or number. Opposer's Motion and Brief appears to be missing a page since the last sentence on page 1 is incomplete, and the next page (none are numbered) does not appear to be the intended page 2. Applicant filed its Initial Disclosure late, on September 4, 2009, and its Answer was never received by Opposer, who instead found it on TTABVUE.

19. In the Motion, at the third page, Applicant states:

In the instant case, Susino China's Notice Of Opposition alleges the following facts with respect to Jinjiang Hengshun Gingham

Company's SUSINO Application and its use of the mark
SUSINO:

- On March 26, 2004 Jinjiang Hengshun Gingham Company filed application with Serial Number 79001855, not the Opposer, Susino China. (Susino China's Notice Of Opposition ¶ 4) Based on these alleged facts, Susino China claims priority of rights in the mark SUSINO not only to Susino USA but also to Jinjiang Hengshun Gingham Company's rights, if any still exist.

20. In response, Applicant is not quoting the statements alleged in the Opposition. The Opposition clearly states that Opposer Susino Umbrella owns rights to the mark SUSINO and makes reference to an earlier filed trademark application it made under its prior name, and the fact that the translator erroneously included "Gingham" as a part of its old name.

21. A 12(b)(6) Motion requires the Board to accept well-pleaded allegations as true, in a light most favorable to the Oppose. Opposer is not required to prove each of its allegations in the Opposition to survive a Motion to Dismiss under Rule 12(b)(6). However, Opposer submits as Exhibit 1, Susino Umbrella's Business License of Enterprise and a Certificate of Name Change from Jianjiang Hengshun Umbrella Company, Ltd. to Susino Umbrella Company, Ltd. dated February 17, 2006. The Business License of Enterprise notes that its foundation date is September 22, 1995, the date of formation of Jianjiang Hengshun Umbrella Company, Ltd.

22. In the Motion, at its third page, Applicant further states:

- On April 26, 2005 Jinjiang Hengshun Gingham Company was issued a final disposal notice as to IB Disposal (ID# 337612601) with a transaction type Final Decision "refusing all goods and services".

On June 7 2005, a notice of abandonment was issued to Jinjiang Hengshun Gingham Company who applied for the application on the referenced application.

23. Abandonment of a US trademark application does not result in the abandonment of use of the mark. In the context of subject matter preventing the registration of a mark, the term abandonment is almost always restricted to situations of nonuse of a mark, not its relation to its registration or lack thereof *See Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581 (2d Cir. 1990). The term "use" is defined by the Lanham Act as the bona fide use of a mark in the ordinary course of trade and not merely to reserve a right in a mark. *Lanham Act* §45, 15 U.S.C.A. § 1127 ("Use in Commerce"). Thus, so long as a person is the first to use a particular mark to identify his goods or services in a given market, and so long as that owner continues to make use of the mark, he is "entitled to prevent others from using the mark to describe their own goods" in that market. *ITC Limited v. Punchgini Inc.*, 482 F.3d 135 (2d Cir. 2007) (citing *Defiance Button Mach. Co. v. C & C Metal Prods Corp.*, 759 F.2d 1053, 1059 (2d Cir. 1985).

The doctrine of abandonment also requires that the owner of a mark not have an intent to resume use in the reasonably foreseeable future. *Lanham Act* § 45, 15 U.S.C.A. § 1127. *See Silverman v. CBS, Inc.*, 870 F.2d 40, 45 (2d Cir. 1989); 2 *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 17:5, at 17-8 (4th ed. 2002). Therefore for the mark to be considered "abandoned," not only must the owner of the mark discontinue his use of the mark, he must also not intend to resume use of the mark in the future. This permits short periods of nonuse without the owner being subject to losing his rights in the mark while the mark is not being used.

Thus the absence or cancellation of a registration does not invalidate the trademark. *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 207 U.S.P.Q. 465, 470 (1st Cir. 1980).

24. The motion asserts further that:

"Other than in the Notice of Opposition is there is no application, assignment, notice, or reference to Susino China's claim as to having any rights or goodxvill in the application of Jianjiang Hengshun Gingham Company, if any still exist. To make such a claim more than 5 years after the initial application is disingenuous. Furthermore Susino China has no standing to oppose Susino USA's mark SUSINO."

25. Opposer in its Notice of Opposition stated that it had prior common law rights to the mark SUSINO and made reference to its earlier trademark application 79/001855 and noted that that application was made under its prior name, and that a mis-translation was made adding "Gingham." In fact, the Chinese "Yusan" meaning "Umbrella" was mis-translated to "Gingham.". No abandonment of the mark was made. Susino Umbrella just did not respond to the Office Action.

26. Opposer pled that the use by Applicant Susino USA is by selling Opposer's umbrellas made and marked SUSINO by Opposer which were sent to the US for distribution and sale by Applicant. The catalog specimen Applicant submitted is in fact the Opposer's catalog. Opposer Susino Umbrella not only has prior use of the mark, the very use alleged by Applicant is Opposer's use, and not use by Applicant, who was only a distributor and sales source in the United States.

Conclusion

Applicant has not its burden of proof since Opposer has well-pleaded allegations which must be accepted as true for this Motion in a light most favorable to Opposer. That alone is enough for the Motion to fail. The Exhibit attached also shows that their claim that Opposer has no standing as being unrelated to the prior user of SUSINO is wrong, since the prior use is by Opposer under its previous name, as indicated in the Notice of Opposition.

This "Corrected Response" is submitted since paragraph numbered 25 had incorrectly stated "Susino USA" rather than "Susino Umbrella" in the last sentence of that paragraph. Applicant was kind enough to point out the error.

WHEREFORE, Susino Umbrella prays that the Board dismiss Applicant's Motion to Dismiss.

Respectfully submitted,
SUSINO UMBRELLA CO., LTD.

By: /s/ /Scott Q. Vidas/
One of its Attorneys

Dated: September 15, 2009

Scott Q. Vidas
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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing
**OPPOSER'S CORRECTED RESPONSE TO APPLICANT'S MOTION TO
DISMISS NOTICE OF OPPOSITION AND MEMORANDUM OF LAW**
to be served upon:

SUSINO USA, LLC
P.O. Box 1013
Loxahatchee, Florida 33470-1013

by placing same in an envelope, properly sealed and addressed, with postage prepaid and
depositing same with the United States Postal Service on this 15th day of September,
2009.

/s/ /Scott Q. Vidas/ _____
Scott Q. Vidas

Filed with the TTAB via
ESSTA on September 15, 2009

BUSINESS LICENCE OF ENTERPRISE

(COPY)

REGISTERED NO.: 35000040000215

NAME: Susino Umbrella Co.,Ltd.

ADDRESS: Jin Ou Industrial District Dongshi Town Jinjiang City

LEGAL REPRESENTATIVE:Wang Anbang

REGISTERED CAPITAL: 61,939, 921 RMB

Actually Paid Capital: 61,939,921 RMB

ENTERPRISE TYPE: Limited Company

BUSINESS SCOPE: Umbrella, umbrella accessories, clothing, plastics,
packing, tent.

Stockholder (Funder): HUIYUAN INT'L COMMERCE & EXHIBITION CO., LTD.

FUJIAN SEPTWOLVES INDUSTRY CO.,LTD.

XIAMEN BAO DE LI TRADING CO.,LTD

HENSHUN UMBRELLA (HongKong) Co. Ltd

Operational Term: From September 22, 1995 to unspecified expiration date

Foundation: September 22, 1995

Issued by: Fujian Bureau for the Industry and Commerce Administration (seal)

REGISTERED DATE: December 28, 2005

Note

1. Business License for Enterprise's Legal Person is the certificate for enterprise to obtain legal person qualification and legal operation.
2. Business License for Enterprise's Legal Person has an original copy and a duplicate copy. Both of the two copies have the same legal forces.
- 3 The original copy of business license shall place in an eye-catching position in the address of enterprise's legal person.
4. The business license shall not be fabricated, altered, leased, lent or transferred.
- 5.The enterprise's legal person shall apply an alternation registration to the original registration office for a change of the registered items.
- 6 The registration office shall conduct yearly check on the enterprise's legal person between January 1 and April 30 every year.
- 7.Return the original and duplicate copies of business license when canceling the registration.
- 8,The business license shall become invalid automatically if withdrew by the registration office.
9. A statement should be provided on the authorized publication once the license was lost or destroyed

企业法人营业执照

编号: N9 0030964

须知

1. 《企业法人营业执照》是企业法人资格和合法经营的凭证。
2. 《企业法人营业执照》分为正本和副本, 正本和副本具有同等法律效力。
3. 《企业法人营业执照》正本应当置于住所的醒目位置。
4. 《企业法人营业执照》不得伪造、涂改、出租、出借、转让。
5. 登记事项发生变化, 应当向公司登记机关申请变更登记, 领取《企业法人营业执照》。
6. 每年三月一日至六月三十日, 应当参加年度检验。
7. 《企业法人营业执照》被吊销后, 不得开展与清算无关的经营活动。
8. 办理注销登记, 应当交回《企业法人营业执照》正本和副本。
9. 《企业法人营业执照》遗失或者毁坏的, 应当在公司登记机关指定的报刊上声明作废, 申请补领。

(副本)

注册号 3500004000002152

名称 梅花伞业股份有限公司
 住所 晋江市东石镇金瓯工业区
 法定代表人 王安邦
 注册资本 6193.9921万人民币
 实收资本 6193.9921万人民币
 公司类型 股份有限公司(中外合资、未上市)
 经营范围 生产雨伞、伞骨配件、服装、塑料制品、布袋、帐篷(出口不含配额许可证管理品种。涉及审批许可项目的, 只允许在审批许可的范围和有效期限内从事生产经营)。

年度检验情况

			
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股东(发起人)

福建汇源国际商务会展有限公司、福建七匹狼集团有限公司、福建凤竹集团有限公司、厦门宝德利贸易有限公司、厦门宝德利贸易有限责任公司

营业期限 自 1995年09月22日 至 不约定
 成立日期 一九九五年九月二十二日

登记机关 福建



二〇〇五年十二月二十一日

Fujian Administration for Industry and Commerce

The certificate of Name Change

According to investigation, Jianjiang Hengshun Umbrella Company, Ltd (Registration No. :003471) registered in our office on December 28, 2005, and changed its name as following: Susino Umbrella Company, Ltd (Registration No.:004010).

Hereby certificate

Fujian Administration for Industry and Commerce
17/02,2006

福建省工商行政管理局

名称变更证明

NO:219

经查晋江恒顺洋伞有限公司(注册号:企合闽泉总字第003471号)于2005年12月28日迁至我局,名称变更为梅花伞业股份有限公司(注册号:企股闽总字第004010号)。

特此证明

