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Filing date: **07/05/2013**

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

Proceeding	91201076
Party	Defendant OSR Enterprises, Inc.
Correspondence Address	THOMAS A DIRKSEN THOMAS A DIRKSEN ATTORNEY AT LAW 4607 LAKEVIEW CANYON RD , STE 117 WESTLAKE VILLAGE, CA 91361-4028 UNITED STATES trademarks@dirksenlaw.com
Submission	Response to Board Order/Inquiry
Filer's Name	Thomas A. Dirksen
Filer's e-mail	trademarks@dirksenlaw.com
Signature	/thomas a dirksen/
Date	07/05/2013
Attachments	2013_0705_reply_notice_of_default_applicants_answer__opp_91201076 (2).pdf(360557 bytes )

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

STARWAY RESTAURANTS, LLC	)	<b>Opposition No.:</b> 91201076
Opposer,	)	Application Ser. No.: 85-165680
	)	Filed: October 31, 2010
v.	)	Mark: SKIPPER & DESIGN
	)	
OSR ENTERPRISES, INC.	)	
Applicant.	)	

**REPLY TO NOTICE OF DEFAULT**

Applicant, OSR Enterprises, Inc., by its undersigned counsel, hereby responds to the Notice of Default and show cause order issued by the Board on June 5, 2013, as follows:

The standard for determining whether default judgment should be entered against the defendant for its failure to timely answer to the complaint is the FRCP 55(c) standard, namely, whether the defendant has shown good cause why default judgment should not be entered against it. TBMP 312.01. Judgment by default should not be entered against applicant for the following reasons: 1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, 2) the plaintiff will not be substantially prejudiced by the delay, and 3) the defendant has a meritorious defense to the action. TBMP 312.02.

**STATEMENT OF FACTS**

1. Counsel for Applicant has maintained communication with counsel for Opposer in a diligent manner at all times since the initiation of this Opposition proceeding. On May 13, 2013, Applicant filed its latest Motion to Extend Time to File the Answer with the consent of Opposer. Despite the Board's admonition on November 17, 2012 to provide a status report with any future extension requests, neither the Applicant nor the Opposer could anticipate when exactly the Board would decide to refuse to reset dates. On March 13, 2013, the Board accepted

Applicant's extension request without any status report and allowed all dates to be reset despite the prior admonition. On May 16, 2013, when the Board first notified the parties that dates would not be reset, the date for filing an answer had already passed on May 12, 2013. Therefore, even though Applicant filed its extension request with the consent of Opposer on May 13, 2013 (the next business day after Sunday, May 12, 2013) in the good faith belief that the Board would accept the extension request and reset dates, it would have been impossible for Applicant to file the answer in a timely manner.

2. Applicant asserts that the numerous extensions already on record are a result of settlement negotiations between the parties which remain pending which were consented to by counsel for Opposer. Applicant, has, in good faith, relied upon Opposer's statement that it would make direct business-to-business contact with Applicant, but Opposer has failed to make any such contact with Applicant over the last twelve months despite Applicant having made itself available to communicate with Opposer.

3. Counsel for Opposer only recently admitted by telephone call that he, too, has been unable to communicate with his client Opposer for many months for unknown reasons. As a result, counsel for Opposer admitted his intent to withdraw from representation of Opposer.

#### **APPLICATION OF RULE 55(c)**

4. Applicant has not delayed the filing of its Answer as the result of any willful conduct or gross neglect. In this matter Counsel for Applicant has consistently met all deadlines except the latest deadline which was impossible to meet because notice occurred only after the deadline for filing the answer has already passed. Applicant has made itself available for settlement discussion at all times throughout this proceeding and has received no substantive communication from Opposer apart from repeated consents to extensions offered by counsel for

Opposer. As regards the Board's November 17, 2012 warning that a status report could be required, the Applicant did not willfully disregard this requirement. The Applicant was unable to obtain any status report due to the lack of communication between Opposer and counsel for Opposer prior to the filing of Applicant's May 13, 2013 extension request.

5. Opposer cannot be prejudiced by Applicant's inadvertent delay in filing its answer because Opposer, through counsel, agreed to extend the time to file Applicant's answer.

6. Applicant has continuously maintained its intention to defend itself against the allegations contained in the Notice of Opposition and maintains that there is no likelihood of confusion between its trademark and the ones alleged by Opposer. Further, the attached Answer demonstrates that Applicant has a meritorious defense to the claims in the instant opposition and in favor of registration.

As established herein, together with the attached Answer, the failure to timely file the Answer was not the result of willful conduct or gross neglect, the Opposer would not be prejudiced by the grant of the instant motion, and the Applicant has a meritorious defense. Accordingly, Applicant prays that judgment by default should not be entered against Applicant in accordance with FRCP 55(b).

DATED this 5th day of July, 2013  
Westlake Village, California

OSR ENTERPRISES, INC.

By Thomas A. Dirksen

Thomas A. Dirksen, Attorney for Applicant  
4607 Lakeview Canyon Road, Suite 117  
Westlake Village, CA 91361  
(805) 370-9100  
[trademarks@dirksenlaw.com](mailto:trademarks@dirksenlaw.com)

Certificate of Service

The undersigned hereby certifies that a true and accurate copy of the REPLY TO NOTICE OF DEFAULT has been served on the following by delivering said copy on July 5, 2013, via email with consent of Opposer, and via First Class Mail, postage prepaid, to counsel for Opposer at the following address:

ALLEN J. BADEN  
EDGE LAW GROUP  
236 North Santa Cruz, Suite 228  
Los Gatos, CA 95030  
(408) 827-4461  
[abaden@edgelawgroup.com](mailto:abaden@edgelawgroup.com)

By: *Susan R. Levitt*  
Susan R. Levitt

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

STARWAY RESTAURANTS, LLC	)	<b>Opposition No.:</b> 91201076
Opposer,	)	Application Ser. No.: 85-165680
	)	Filed: October 31, 2010
v.	)	Mark: SKIPPER & DESIGN
	)	
OSR ENTERPRISES, INC.	)	
Applicant.	)	

**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION**

Applicant, OSR Enterprises, Inc., by its undersigned counsel, hereby submits its Answer to the Notice of Opposition (the "Notice") filed by Opposer Starway Restaurants, LLC, as follows:

Applicant denies that Opposer is entitled to relief because Opposer has not been, nor will it be, damaged by the registration of Applicant's SKIPPER & DESIGN mark. Applicant's SKIPPER & DESIGN mark is distinctive and creates a completely different overall commercial impression from the Opposer's marks, which is highly unlikely to cause consumer confusion.

Any allegation not specifically admitted hereinafter is denied by Applicant.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

2. Admitted.

3. Answering to Paragraph 3, this paragraph contains conclusions of law, to which no response is required, except that Applicant admits that it is seeking registration of SKIPPER & DESIGN for fresh vegetables in International Class 031.

4. Answering to Paragraph 4, Applicant admits that Opposer has attached to its Notice, as Exhibit A, a document purporting to be "a copy of TM Page 1159 from the Official Gazette." As to the remaining allegations, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4, and, based upon said lack of knowledge and information, denies each and every remaining allegation contained therein.

5. Admitted.

6. Answering to Paragraphs 6 through 11, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, based upon said lack of knowledge and information, denies each and every allegation contained in Paragraphs 6 through 11.

7. Answering to Paragraph 12, this paragraph contains conclusions of law to which no response is required. Applicant denies each and every remaining allegation in Paragraph 12.

8. Answering to Paragraph 13, Applicant admits that Opposer has attached to its Notice, as Exhibit B, certain documents purporting to be copies of trademark registrations. As to the remaining allegations, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 13, and, based upon said lack of knowledge and information, denies each and every remaining allegation contained therein.

9. Answering to Paragraphs 14 through 17, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and,

based upon said lack of knowledge and information, denies each and every allegation contained in Paragraphs 14 through 17.

10. Applicant denies each and every allegation of Paragraph 18.
11. Applicant denies each and every allegation of Paragraph 19.
12. Applicant denies each and every allegation of Paragraph 20.
13. Applicant denies each and every allegation of Paragraph 21.
14. Applicant denies each and every allegation of Paragraph 22.
15. Applicant denies each and every allegation of Paragraph 23.
16. Applicant denies each and every allegation of Paragraph 24.
17. Applicant denies each and every allegation of Paragraph 25.

#### AFFIRMATIVE DEFENSES

18. The Notice fails, in whole or part, to state a claim upon which relief can be granted.
19. There is no likelihood of confusion, mistake and deception because Applicant's mark and the pleaded marks of Opposer are not confusingly similar in sight, sound and meaning.
20. The respective goods of the parties are sold through different channels of trade to different and discriminating purchasers. The services provided and the goods manufactured by Opposer under the pleaded marks are different from, unrelated to, and not competitive with the goods identified in the opposed SKIPPER & DESIGN application.
21. Opposer's claims fail, in whole or in part, because Applicant is the senior user of the marks containing the term, "skipper."
22. Applicant owns U.S. Trademark Reg. No. 1271971, for SKIPPER (stylized) for fresh vegetables in Class 031, a copy of which is attached hereto as Exhibit 1.

23. Subsequent to the filing of the Notice, Opposer's Registration Nos. 2904780 and 2939224 have been cancelled by the Patent & Trademark Office.

24. Opposer's claims fail, in whole or in part, because Opposer does not have broad common law rights in its marks.

25. Opposer's claims are barred, in whole or in part, under the doctrines of laches, estoppel, acquiescence and/or waiver.

26. Applicant reserves the right to amend this Answer and to assert additional defenses as may be warranted by discovery in this case.

WHEREFORE, Applicant prays that the Board enter a judgment that 1) the Notice of Opposition, in its entirety and on the merits, be dismissed with prejudice; 2) all relief requested by Opposer be denied; and 3) the registration of Applicant's mark, SKIPPER & DESIGN (Ser. No. 85-165680) for use in connection with goods in Class 031 be granted.

DATED this 5th day of July, 2013  
Westlake Village, California

OSR ENTERPRISES, INC.

By Thomas A. Dirksen

Thomas A. Dirksen, Attorney for Applicant  
4607 Lakeview Canyon Road, Suite 117  
Westlake Village, CA 91361  
(805) 370-9100  
[trademarks@dirksenlaw.com](mailto:trademarks@dirksenlaw.com)

Certificate of Service

The undersigned hereby certifies that a true and accurate copy of the APPLICANT'S ANSWER TO NOTICE OF OPPOSITION has been served on the following by delivering said copy on July 5, 2013, via email with consent of Opposer, and via First Class Mail, postage prepaid, to counsel for Opposer at the following address:

ALLEN J. BADEN  
EDGE LAW GROUP  
236 North Santa Cruz, Suite 228  
Los Gatos, CA 95030  
(408) 827-4461  
abaden@edgelawgroup.com

By:   
Susan R. Levitt

TSDR will be down for maintenance for ½ hour between 12:01 AM and 4:00 AM on Sunday 7/7/13. TSDR will not be available during this period. Thank you for your patience!

**STATUS**      **DOCUMENTS**

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**Generated on:** This page was generated by TSDR on 2013-07-05 15:40:35 EDT

**Mark:** SKIPPER



**US Serial Number:** 73357060

**Application Filing Date:** Mar. 29, 1982

**US Registration Number:** 1271971

**Registration Date:** Mar. 27, 1984

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** May 11, 2004

**Publication Date:** Jan. 03, 1984

**Mark Information**

**Mark Literal Elements:** SKIPPER

**Standard Character Claim:** No

**Mark Drawing Type:** 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

**Goods and Services**

**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** [ Dehydrated Chilis ]

**International Class(es):** 029 - Primary Class

**U.S Class(es):** 046

**Class Status:** SECTION 8 - CANCELLED

**Basis:** 1(a)

**First Use:** 1972

**Use in Commerce:** 1972

**For:** Fresh Vegetables

**International Class(es):** 031 - Primary Class

**U.S Class(es):** 046

**Class Status:** ACTIVE

Basis: 1(a)

First Use: 1972

Use in Commerce: 1972

**Basis Information (Case Level)**

Filed Use: Yes	Currently Use: Yes	AI
Filed ITU: No	Currently ITU: No	A
Filed 44D: No	Currently 44D: No	A
Filed 44E: No	Currently 44E: No	A
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

**Current Owner(s) Information**

Owner Name: OSR ENTERPRISES, INC.  
 Owner Address: 1910 E. Stowell Rd.  
 Santa Maria, CALIFORNIA 93454  
 UNITED STATES

Legal Entity Type: CORPORATION  
 State or Country Where Organized: CALIFORNIA

**Attorney/Correspondence Information**

**Attorney of Record**

Attorney Name: THOMAS A. DIRKSEN

**Correspondent**

Correspondent THOMAS A. DIRKSEN  
 Name/Address: Thomas A. Dirksen, Attorney at Law  
 4607 Lakeview Canyon Road, Suite 117  
 Westlake Village, CALIFORNIA 91361  
 UNITED STATES

Phone: (805) 370-9100

Fax: (805) 435-1795

Correspondent e-mail: [trademarks@dirksenlaw.com](mailto:trademarks@dirksenlaw.com)

Correspondent e-mail Yes Authorized:

Domestic Representative - Not Found

**Prosecution History**

Date	Description	Proceeding Number
Jul. 27, 2010	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 07, 2008	CASE FILE IN TICRS	

May 11, 2004	REGISTERED - PARTIAL SEC. 8 (10-YR) ACCEPTED
May 11, 2004	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)
May 11, 2004	REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8
Apr. 30, 2004	POST REGISTRATION ACTION MAILED - SEC. 8 & 9
Mar. 16, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED
Mar. 16, 2004	TEAS SECTION 8 & 9 RECEIVED
Jan. 20, 2004	TEAS CHANGE OF CORRESPONDENCE RECEIVED
Sep. 19, 1989	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.
Jul. 21, 1989	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED
Mar. 27, 1984	REGISTERED-PRINCIPAL REGISTER
Jan. 03, 1984	PUBLISHED FOR OPPOSITION
Nov. 14, 1983	NOTICE OF PUBLICATION
Nov. 14, 1983	NOTICE OF PUBLICATION
Nov. 09, 1983	NOTICE OF PUBLICATION
Sep. 14, 1983	APPROVED FOR PUB - PRINCIPAL REGISTER
Aug. 29, 1983	CORRESPONDENCE RECEIVED IN LAW OFFICE
Jan. 03, 1983	ASSIGNED TO EXAMINER

**Maintenance Filings or Post Registration Information**

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Filed:** Yes

**Renewal Date:** Mar. 27, 2004

**Change in Registration:** Yes

**TM Staff and Location Information**

**TM Staff Information - None**

**File Location**

**Current Location:** SCANNING ON DEMAND

**Date in Location:** May 07, 2008

**Assignment Abstract Of Title Information - Click to Load**