

ESTTA Tracking number: **ESTTA583432**

Filing date: **01/23/2014**

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

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
Correspondence Address	JOHN S EGBERT EGBERT LAW OFFICES PLLC 1314 TEXAS, 21ST FLOOR HOUSTON, TX 77002 UNITED STATES mail@egbertlawoffices.com
Submission	Opposition/Response to Motion
Filer's Name	John S. Egbert
Filer's e-mail	mail@egbertlawoffices.com
Signature	/1433-55/
Date	01/23/2014
Attachments	1433-55 Response to Motion to Strike Registrations.pdf(15045 bytes )

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

In the Matter of Application Serial No. 85/836,544  
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

**OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE PLED  
REGISTRATIONS**

Applicant, Disidual Clothing, LLC, moved to strike Trademark Registration Nos. 4,113,640 and 4,269,396 from Opposer's October 2, 2013 Notice of Opposition. Opposer, INTS It Is Not The Same, GmbH, by and through his counsel of record, hereby responds to the Motion to Strike.

**DISCUSSION**

1. On October 23, 2013 Opposer filed its Notice of Opposition, asserting priority and likelihood of confusion. To support its claims, Opposer cited five federal trademark registrations and a common law mark, as Opposer's "DESIGUAL" Marks.

2. On December 20, 2013 Applicant filed its Motion to Strike Trademark Registration Nos. 4,113,640 and 4,269,396 from Opposer's October 2, 2013 Notice of Opposition. As a general rule, "[m]otions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case." TBMP § 506.01 (citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999)). Clearly, Opposer's two "DESIGUAL (Stylized)"

trademark registrations have bearing upon the issues of priority and likelihood of confusion asserted in this Opposition against Applicant's "DESIDUAL" trademark application.

3. Applicant has moved to strike Trademark Registration Nos. 4,113,640 and 4,269,396 from Opposer's October 2, 2013 Notice of Opposition on the basis that those marks lack priority over Applicant's trademark application. This conclusion is wholly incorrect. It is well established, hornbook law that "priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark." TBMP § 309.03(c) (citing *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (had opposer properly introduced its pleaded registrations, priority would have been removed as an issue to be proved)).

4. On May 26, 2011 Opposer filed its request for extension of protection for Trademark Registration No. 4,113,640 for the mark "DESIGUAL (Stylized)". See [Notice of Opposition ¶ 5]. As such, the constructive first use date for the trademark registration is May 26, 2011. On October 17, 2011 Opposer filed the trademark application that resulted in Trademark Registration No. 4,269,396 for the mark "DESIGUAL (Stylized)". See [Notice of Opposition ¶ 5]. As such, the constructive first use date for the trademark registration is October 17, 2011. *A fortiori*, nothing bars Opposer from submitting proper evidence for the two registrations at issue showing an earlier actual first use date. Simply stating that Opposer's marks have a constructive first use date due to the filing date does not mean that evidence of an earlier date cannot be proven. On January 30, 2013 Applicant filed Trademark Application No. 85/836,544 for the mark "DISIDUAL". As such, the earliest date established by Applicant that can be relied upon for purposes of priority, without introducing proper evidence of earlier use, is the filing date of Applicant's application for the

"DISDIUAL" mark. The fact that Opposer's Notice of Opposition acknowledges that Applicant claimed a first use in commerce date of June 1, 2010 in its application is certainly not an admission that Applicant's unverified claim of its first use date is true. *See* [Notice of Opposition ¶ 6].

5. In summary, Applicant contends that because Applicant's application claims a first use date of June 1, 2010, Applicant has priority over Opposer's trademark registrations. However, the unverified date that Applicant has entered as its first use date is not *prima facie* evidence that Applicant's trademark application has priority over Opposer's cited trademark registrations. In reality, Opposer's cited registrations, including the status and title copies submitted by Opposer for those registrations, are *prima facie* evidence of Opposer's ownership and that each registration is subsisting; priority is therefore not an issue. *See L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008).

WHEREFORE, Applicant respectfully requests that the Board deny Applicant's Motion to Strike Opposer's Pled Registrations.

Respectfully submitted,

January 23, 2014  
Date

/1433-55/  
John S. Egbert  
Reg. No. 30,627  
Kevin S. Wilson  
Michael F. Swartz

Egbert Law Offices, PLLC  
1314 Texas, 21st Floor  
Houston, Texas 77002  
(713)224-8080  
(713)223-4873 (Fax)

ATTORNEYS FOR OPPOSER  
BLUEBONNET NUTRITION CORP.

