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

Proceeding	91213445
Party	Defendant Luminara Worldwide, LLC
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Luminara Worldwide LLC

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

In re the matter of:

Trademark Application Serial No.: 85/123625

For the Mark: LUMINARA

Malgor & Co, Inc.,

Opposer

v.

Luminara Worldwide LLC,

Applicant

Proceeding No.: 91213445

**MOTION TO DIVIDE APPLICATION
WITH CONSENT**

**TO THE TRADEMARK TRIAL AND APPEAL BOARD, INTERLOCUTORY ATTORNEY
RICHARD KIM, OPPOSER AND ITS ATTORNEY OF RECORD:**

Applicant, Luminara Worldwide, LLC (“Applicant”), hereby moves the Trademark Trial and Appeal Board to divide U.S. Application Serial No. 85/123,625 (“Application”). As described further in the Memorandum of Points and Authorities, below, Applicant’s Motion to Divide is based on Malgor & Co (“Opposer”)’s withdrawal of its opposition against all goods in Class 11 of the Application. Opposer consents to the division of the Application. Applicant therefore requests that Class 11 be divided out as the child application and for such child application to proceed to registration.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

On November 12, 2013, Malgor & Co. (“Opposer”) filed its Notice of Opposition (“Opposition”) against Luminara Worldwide, LLC (“Applicant”)’s application for the mark LUMINARA, U.S. Application Serial No. 85/123625 (“Application”). The Opposition was filed against all classes of goods in the Application.

On January 17, 2014, the parties held the discovery conference in this case. Included in that conference was a discussion regarding Opposer’s Opposition to the goods contained in Class 11 of the Application. After further discussions, Opposer agreed to withdraw its Opposition with respect to Class 11. On March 31, 2014, Opposer filed a Withdrawal of Opposition to the goods in Class 11. [Dkt. 5] and on April 3, 2014 Opposer provided its consent to the division of the Application.

Applicant requests that the goods in Class 11 be divided out into a child application (“Child Application”) and that such application proceed to registration. For the reasons stated herein, such division is appropriate and warranted in this case.

II. DIVIDING THE APPLICATION IS APPROPRIATE IN THIS CASE

A request to divide an application during an opposition proceeding may be requested upon motion to the Trademark Trial and Appeal Board (TTAB). 24 CFR §2.87(c). When an application is the subject of a TTAB proceeding, a request to divide must first be filed with the board and if division is appropriate, the TTAB will forward the request to the Divisional Unit for processing.

Further, if an application that is the subject of an opposition includes multiple classes, not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes.

TBMP 516.

In this case, Opposer has withdrawn its Opposition to all goods in Class 11. Therefore, dividing out Class 11 so that the Child Application proceeds to registration is appropriate.

III. OPPOSER HAS CONSENTED TO THIS MOTION

Under TBMP procedure, every other party to the proceeding shall be allowed an opportunity to file a brief in opposition thereto. TBMP 502.02(b). Further, When a request to amend an application or registration which is the subject of a Board *inter partes* proceeding is made with the consent of the other party or parties, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request ordinarily will be approved by the Board. TBMP 514.02.

Here, shortly after its withdrawal of its Opposition to Class 11, Opposer consented to the division of the Application so that the Child Application may proceed to registration. Opposer is the only other party to this proceeding; therefore, no reply brief is necessary. Applicant therefore requests that its Motion to Divide be granted without delay.

IV. FEES

This Motion to Divide is being filed electronically. Any required fees associated with the Motion to Divide as required by 37 CFR 2.6(a)(19) not submitted with this Motion are authorized to be deducted from USPTO Deposit Account No. 500341.

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V. CONCLUSION

Based on the foregoing, Applicant respectfully requests that its Motion to Divide be granted, and that the TTAB refer Applicant's request to the ITU/Divisional Unit for processing.

Respectfully submitted,

Date: April 10, 2014

/ryan dean

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