

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

Roger Orozco and Nora Orozco,)
)
Petitioner)
)
V.)
)
Michael Hwang,)
)
Respondent.)

TTAB

Cancellation No. 92043811

78213107

PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT
AND RESPONDENT'S CROSS-MOTION FOR SUMMARY JUDGMENT

This brief is in reply to Respondent's Brief in Opposition to Petitioner's Motion for Summary Judgment and Respondent's Cross-Motion for Summary Judgment ("Respondent's Opposition Motion") pursuant to 37 C.F.R. § 2.127(e) and further supports Petitioner's, Roger Orozco and Nora Orozco ("Petitioner") position.

As a preliminary matter, Respondent Michael Hwang ("Respondent" or "Hwang") is precluded from filing a "Cross-Motion for Summary Judgment." The consented extension request dated February 15, 2006 was specifically limited to allow Respondent to file a "Brief in Opposition to Petitioner's Motion for Summary Judgment." Respondent had initially requested that Petitioner consent to an extension to allow Respondent to file a "response." Petitioner only agreed to a limited extension for an "Opposition to the Summary Judgment Motion."¹ In any case, Respondent has presented no evidence to support its attempted cross-motion.

¹ Examples of papers which are or may be germane to a motion for summary judgment include a brief in opposition to a summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under Fed. R. Civ. P. 56(f) for discovery needed to enable the nonmoving party to respond to the summary judgment motion, a crossmotion for summary judgment, and a motion for leave to amend a party's pleading. TBMP §528.03

I. Introduction

Respondent has opposed Petitioner's Motion for Summary Judgment on the basis that 1) Petitioner has no standing, 2) there are genuine issues of fact for trial, and 3) Respondent desires to take the depositions of Petitioner. Petitioner does have standing to bring this action based on Petitioner's prior use of the mark OAK TREE and OAK TREE FARMS ("Petitioner's Mark") and through the use by Petitioner's predecessor- in-interest. Respondent hopes he may find some evidence which he has not yet been able to find, but Respondent has had adequate opportunity for discovery and the discovery period is long closed.

In countering a motion for Summary Judgment, more is required than mere assertions of counsel. Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1562-63 (Fed. Cir. 1987). The non-moving party may not rest on the pleadings, but must respond by affidavit which sets forth specific facts showing that there is a genuine issue for trial. See Fed. R. Civ. P. 56(e); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563 (Fed. Cir. 1991). The affidavits must be made on personal knowledge, must set forth facts which would otherwise be admissible as evidence, and must contain information to indicate a basis in the personal knowledge. Id. The affidavits must consist of more than mere conclusory statements and denials, and the adverse party must point to an evidentiary conflict created on the record as least by a counter statement of a fact or facts. Id. See also, Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd., 221 USPQ 561, 564 (Fed. Cir. 1984). Respondent has offered no evidence that can contradict the evidence presented by Petitioner. Respondent simply asks speculative questions and makes assertions about the evidence.

II. Standing

Respondent has alleged Petitioner has no standing because use by a related entity is not sufficient to confer standing and further because allegedly Petitioner is not the owner of Petitioner's Mark. (Respondent's Brief, p. 3, 14).

The rule is that any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. See Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064. Petitioner must plead a “real interest” in the proceeding and a “reasonable belief of damage.” TBMP § 309.03(b). Here, the basis for Petitioner’s claim is that Respondent’s OAKTREE mark so resembles Petitioner’s Mark as to be likely when used on or in connection with footwear to cause confusion, mistake, or to deceive. 15 U.S.C. § 1052(d). See e.g., Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1656 (TTAB 2002).

A review of the facts shows Petitioner has established ownership and prior use of Petitioner’s Mark. (Declaration of Nora Orozco in Motion for Summary Judgment (“Orozco Decl.”), ¶¶ 2, 12, 13, 17). In addition, the pending application for Petitioner’s Mark was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on likelihood of confusion with Respondent’s registered mark. Petitioner has submitted the declaration of its attorney, Kurt Koenig, which introduces a printout from the USPTO’s “Trademark Applications and Registrations Retrieval System” (TARR) of Petitioner’s pleaded application Serial No. 78304288 for Petitioner’s Mark and an office action refusing the application based on Respondent’s registration. (Second Declaration of Kurt Koenig (“Koenig Decl.”), ¶¶ 2, 3). The evidence of Petitioner’s use of Petitioner’s Mark and the fact that Respondent’s then pending OAKTREE mark was cited as a bar to registration of Petitioner’s Mark is sufficient to establish Petitioner’s standing in this case. Fram Track Indus., Inc. v. WireTracks, LLC, Cancellation No. 92043947 (January 23, 2006). No genuine issue of material fact exists on this issue.

The record shows, and there is no dispute, that Petitioner’s initially operated their business through a limited liability company named Evolutions, LLC. The LLC was dissolved and the Petitioner’s kept ownership of Petitioner’s Mark as individuals and licensed Petitioner’s Mark to a corporation wholly owned by Petitioner. Respondent’s believes there are issues of genuine fact because it believes Petitioner must provide written evidence of the assignment of the prior common law rights to Petitioner’s Mark from the dissolved LLC. However, this is not required and Ms. Orozco’s Declaration adequately shows Petitioner has acquired rights to Petitioner’s Mark. (Orozco Dec. ¶ 2) An assignment in writing is not necessary to pass common law rights in a

trademark. Speed Products Co. v. Tinnerman Products, Inc., 179 F.2d 778 (2d Cir. 1949). If there is no documentary evidence of an assignment, it may be proven by the clear and uncontradicted testimony of a person in a position to have actual knowledge. Sun Valley Co. v. Sun Valley Mfg. Co., 167 USPQ 304 (TTAB 1970). Ms. Orozco is certainly considered to be the person with actual knowledge since she and her husband wholly owned the entity which assigned the mark to them.

A separate issue suggested by Respondent is the license of Petitioner's Mark to a wholly owned corporation owned by Petitioner. The general rule is that the entity which controls the nature and quality of the goods or services provided under a mark is the owner. In re Wella A.G., 787 F.2d 1549 (Fed. Cir. 1986)(Nies, J., concurring). Since Petitioner owns all the stock of the licensee, it can be presumed that Petitioner's control the licensee and the nature and quality of the services rendered by the licensee. When an individual adopts and uses a mark and later orally licenses its use to a corporation of which he or she is the president, the individual, not the corporation, is the owner of the mark. In re Briggs, 229 USPQ 756 (TTAB 1986) Thus, Petitioner as licensor is presumed to be the owner of the mark. See In re Hand, 231 USPQ 487 (TTAB 1986) and J.T. McCarthy, McCarthy on Trademarks and Unfair Competition §16:36 (4th ed. 2003). At a minimum, the evidence is sufficient to presume at least an implied license to the corporation. See McCarthy, supra, § 18:43, page 18-69 and, e.g., University Book Store v. University of Wis. Bd. of Regents, 33 U.S.P.Q.2d 1385, 1396 (TTAB 1994).

III. Petitioner has Prior use

To establish priority on a likelihood of confusion ground brought under Trademark Act Section 2(d), a party must prove that, vis-a-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act

Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; T.A.B. Systems v. PacTel Teletrac, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996).

Respondent has presented no evidence which can establish priority. Petitioner first sold footwear under Petitioner's Mark in 1995. (Orozco Dec. ¶¶ 11, 12). Respondent did not sell any footwear under the OAKTREE brand until December 20, 2003 (Declaration of Michael Hwang attached to Respondent's Opposition Motion. ¶ 4) Petitioner has established, through the declaration of Ms. Orozco and Mr. Russell Chaney, that Petitioner made its first actual use of Petitioner's Mark on or about 1995 by selling footwear bearing Petitioner's Mark and have continuously used the mark since that first use date. The 1997 Sales Summary for goods sold bearing Petitioner's Mark that Petitioner submitted in support of its Motion for Summary Judgment shows Petitioner made significant sales of footwear bearing Petitioner's Mark prior to Respondent's Application filing date of February 10, 2003². The documentation and Ms. Orozco's declaration are internally consistent and not characterized by uncertainty. See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc., 60 USPQ2d 1733, 1736 (TTAB 2001). Respondent has not challenged the veracity or the basis for the testimony of Ms. Orozco. As such, her declaration is both credible and persuasive.

IV. Likelihood of Confusion

The evidence provided by Petitioner in its initial brief fully outlines Petitioner's Motion on

² Respondent has alleged the 1997 sales summary is of no probative value because it is only an excerpt, it is nine years old, and there is no evidence the goods bore Petitioner's Mark. In fact, the evidence is quite probative as it shows that sales were significant in 1997 and as noted by Ms. Orozco have increased annually since that date. Further, Ms. Orozco has noted that her labels and packages bore the OAK TREE Mark. (Orozco Decl. ¶ 13.) Paragraph 35, which was apparently cut off, stated in its entirety:

"The page attached as Exhibit J represents the first page of a printout of sales of OAK TREE FARMS footwear during calendar year 1997. This printout shows that in 1997 Petitioner's Mark was used on the sale of footwear to various retail stores in all 50 states. The printout references the mark OAK TREE by the use of the acronym "OT." Additionally, the "Item Description corresponds with the "style names" listed in the catalogs."

Clearly, the 1997 printout which is entitled "Customer Open Order Detail Report" shows the product sold listed by customer name. This Detail Report includes the order date, ship date, item number, color, item description, unit price, shipped quantity, and invoice date. In the columns listed as "Items Description" and "Item Number" it clearly shows which product was sold. The catalog clearly shows the specific product which was sold because the product names match. This makes it clear that all the sales in the 1997 sales summary correlate with the OAK TREE brand and no other mark used by Petitioner.

the issue of likelihood of confusion. Respondent has raised a few separate points that Petitioner will briefly address.

A. The Design Elements do not Distinguish the Marks.

Respondent suggests the parties' marks can be distinguished because both parties use different designs in conjunction with the word OAK TREE. (Respondent's Opposition Motion, p. 18). In fact, the design elements are insufficient to create a genuine issue of material fact as to the similarities of the marks. See Herbko International, Inc. v. Kappa Books, Inc., 308 F.3d 1156, (Fed. Cir. 2002) (words are dominant portion of mark); Ceccato v. Manifattura Lane Gaetano Marzetto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994) (literal portion of mark makes greater and long lasting impression).

C. The Goods are Identical and Travel in the Same Channels of Trade

Respondent tries to pick apart the issue of related goods by arguing the parties goods are not similar and that Western style boots are not similar to hiking boots. (Respondent's Opposition Motion, p. 19).

With regard to the similarity of the goods at issue, namely footwear, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in Respondent's registration compared with the goods recited in Petitioner's petition to cancel, rather than what Respondent's goods are asserted or shown to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490 (Fed. Cir. 1987). As such, the goods identified in registrant's registration, i.e., "footwear," are presumed to overlap Petitioner's pleaded goods, which as shown by the evidence, are "footwear." As such, Respondent's footwear goods would be considered to travel in all the normal channels of trade for goods of these types, such as through retail stores and distributors, and that they would be purchased by the same class of customers. See Id. Indeed, the record shows that both parties' goods are sold through retail stores and Petitioner's goods are also sold on the Internet.

Respondent's registration is registered for "footwear." Respondent tries to draw a very fine line for his channels of trade to a very limited type of hiking boots. His registration however covers every conceivable type of boot or shoe. The channels of trade are both targeted at people who buy footwear. Based on the fact that there could be contemporaneous positioning and complementary use of both parties goods displaying OAKTREE, consumers would be likely to assume an association between the two products. Moreover, even though Petitioner's goods are not limited to boots, hiking boots and western boots are in fact sold by the same retailer. For example, at Bootbarn.com Petitioner's goods are sold side by side with Ariat® hiking shoes. (Koenig Decl. ¶ 5).

D. Strength of Petitioner's Mark

Respondent's counsel conducted a Google search for the term "Oak Tree" to show Petitioner's Mark is not in fact strong. Of course, a search for merely the words "oak" and "tree" without limitation will generate a lot of hits. A proper search would be for ("OAK TREE" and boots). This search is more indicative of a search that would prove the strength of Petitioner's Mark by showing that Petitioner's Mark is exclusively associated with such goods. In fact, the results of such search do show that every single hit on the first Google page related to Petitioner's footwear. (Koenig Decl., ¶ 4, Ex. C).

E. Petitioner has Attended Trade Shows and Marketed it OAK TREE

Goods

The only attempt to present evidence in Mr. Hwang's Affidavit is that he has attended trade shows and never seen Petitioner at any show. Petitioner has provided evidence that they have regularly attended trade shows and offered for sale OAK TREE brand footwear. The World Show Association trade show in Las Vegas is one of the largest shoe trade shows in the United States. Literally thousands of people attend this show every year. Just because Mr. Hwang has not seen Petitioner at any show does not refute the clear evidence that Petitioner has presented that Petitioner attends numerous trade shows yearly.

F. Good Faith of Respondent is not Relevant.

Respondent's alleged good faith does not preclude summary judgment. Even assuming for the purposes of this motion that Respondent selected its mark in good faith, such subjective issues are generally inappropriate to the issues of summary judgment. See American Int'l Group, Inc. v. London Am. Int'l Corp., 212 USPQ 803, 808 (2d Cir. 1981). Furthermore, good faith is no defense if a likelihood of confusion is established. See I.P. Lund Trading ApS v. Kohler Co., 49 USPQ2d 1225, 1237 (1st Cir. 1998).

V. Respondent has had Adequate Opportunity to take Discovery and Further Discovery is Not Warranted.

Respondent argues that he has been denied discovery because he failed to take depositions during the discovery period. Respondent has had more than adequate opportunity to take discovery. Moreover, Respondent's speculative assertions lack any evidentiary basis and therefore are insufficient to preclude entry of summary judgment in favor of Petitioner. Respondent assumed, as acknowledged by Respondent's counsel, that Petitioner had abandoned the case. Quite the contrary, Petitioner reviewed all the facts and determined that they needed nothing further from Respondent to prove priority. Respondent suggests he was considering filing a Motion for failure to prosecute, but such a motion could not have been filed until after the close of Petitioner's testimony period and only if Petitioner proffered no testimony.

Respondent is not entitled to further discovery for several reasons. First, if Respondent felt he could not properly oppose a motion for summary judgment without first taking discovery he should have filed a motion under Rule 56(f) for additional time to take the needed discovery. Respondent did not such a Motion and may not now file such a motion. TBMP § 528.06. Additional discovery is not available to Respondent.

Second, Respondent's counsel keeps asking to take depositions of Petitioner. The deposition notices served by Respondent of Mr. and Ms. Orozco, who live in California, were noticed at Respondent's counsel's offices in New York. The rules on depositions are quite clear.

A deposition may be taken only in the judicial district where the witness resides. Trademark Rule §2.120(b). Therefore, a Notice of Deposition indicating the deposition is to be taken in New York City of someone who resides in California is clearly improper. There was no need to move to quash the Notice and the proper practice was to advise respondent as the deposing party that the notice was improper and the witness will not appear. Petitioner's counsel sent correspondence to John T. Johnson on May 7, 2005 indicating the same. (As this correspondence also referenced settlement discussions it has not been attached.) A deposition must be properly noticed and taken prior to the close of the discovery period. In light of the close of discovery and the failure to file a Motion under Rule 56(f), depositions and further discovery are not available to Respondent. Trademark Rule §2.120(a) and (b).

Third, Respondent argues he did not get the evidence he was hoping to find. Speculative assertions concerning the possible existence of evidence are insufficient to prevent entry of summary judgment. See, Sweats Fashions, supra at 1566-67 (Summary judgment need not be denied merely to satisfy a litigant's speculative hope of finding some evidence [through discovery] that might tend to support a complaint"). To the contrary, a party must demonstrate that there is some issue for which discovery is necessary. See Dr. Pepper Bottling Co. of Texas v. Del Monte Corp., 18 USPQ2d 1065, 1067 (N.D. Tex 1990)(The non movant must identify genuine issue of material fact which requires a postponement for discovery"). If a party that served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. TBMP § 523.04.

Finally, an attorney affidavit, such as the Johnson affidavit and Hudson affidavit submitted in the Opposition brief, cannot alone establish the existence of a genuine issue sufficient to preclude summary judgment. Nieves v. Univ. of Puerto Rico, 7 F.3d 270, 276, n.9 (1st Cir. 1993)("Factual assertions by counsel in motion papers, memoranda, briefs, or other such self serving documents, are generally insufficient to establish the existence of a genuine issue of materials fact at summary judgment."); Shapiro, Bernstein & Co. Inc. v. Club Lorelei, 35 USPQ2d 1852, 1854 (W.D.N.Y. 1995)("[W]hat the attorney learned from others - - even from the officers

of her client - - is not admissible evidence.”). The only evidence provided in Mr. Hwang’s Affidavit is that he has never seen Petitioner at any trade show.

VI. Conclusion

Respondent has raised a number of theoretical questions he would like answered. These questions do not equate to evidence or raise any issue of fact. Based on the foregoing, Petitioner has met its burden by supporting its motion with declarations and other evidence which establish their right to judgment. Accordingly, the burden shifted to Respondent to provide countering evidence that there is a genuine factual dispute for trial. Respondent’s evidence in support of its opposition motion and attempted cross-motion is insufficient to show that there is a genuine issue of material fact for trial.

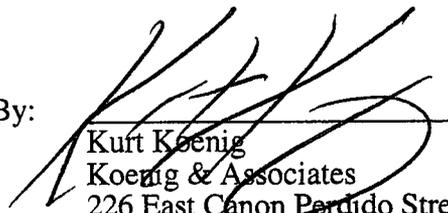
Considering the substantial similarity in sound, appearance, and commercial impression of the marks and the overlapping nature of the goods, trade channels and purchasers, there is no genuine issue of material fact and confusion is likely to result if Respondent is allowed to keep his registration. Petitioner’s motion for summary judgment should be granted, and respondent’s attempted cross-motion for summary judgment should be denied.

Respectfully submitted,

KOENIG & ASSOCIATES

Dated: March 14, 2006

By:


Kurt Koenig
Koenig & Associates
226 East Canon Perdido Street
Santa Barbara, CA 93101
Tel: 805-965-4400
Fax: 805-564-8262
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I, KURT KOENIG, hereby certify that I caused a copy of the foregoing "Petitioner's Reply to Respondent's Brief in Opposition to Petitioner's Motion for Summary Judgment and Respondent's Cross-Motion for Summary Judgment" to be served on March 14, 2006, by first class mail, postage prepaid, addressed to:

Mr. John Johnson
Ms. Irene Hudson
Fish & Richardson P.C.
Citigroup Center
153 E, 53rd St., 52nd Floor
New York, NY 10022-4611

Dated: March 14, 2006



Kurt Koenig

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on March 14, 2006 with the United States Postal Service as first class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



KURT KOENIG

Dated: March 14, 2006

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

Roger Orozco and Nora Orozco,)	
)	
Petitioner,)	
)	
V.)	Cancellation No. 92043811
)	
)	
Michael Hwang,)	
)	
)	
Respondent.)	
)	

SECOND DECLARATION UNDER 37 C.F.R. SECTION 2.20
OF KURT KOENIG IN SUPPORT OF
PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT
AND RESPONDENT'S CROSS-MOTION FOR SUMMARY JUDGMENT

I, Kurt Koenig, declare as follows:

1. I am an attorney duly licensed to practice law in the States of California and Illinois. I am a principal of the firm of Koenig & Associates. Koenig & Associates is trademark counsel to Petitioner, Roger Orozco and Nora Orozco in the above captioned matter. I submit this declaration in support of Petitioner's Reply to Respondent's Brief in Opposition to Petitioner's Motion for Summary Judgment and Respondent's Cross-Motion for Summary Judgment. This declaration is made based on my personal knowledge of the following facts, and I could and would testify competently thereto if called as a witness.

2. On September 23, 2003, Petitioner filed Trademark Application Serial No. 78304288 in the United States Trademark Office. A printout from the USPTO's "Trademark Applications and Registrations Retrieval" system (TARR) of Petitioner's pleaded application Serial No. 78/304,288 for Petitioner's Mark is attached as Exhibit A.

3. On April 3, 2004, the United States Trademark Office issued an office action against Petitioner's Trademark Application Serial No. 78/308,288 for the mark OAK TREE FARMS & Design on footwear ("Petitioner's Mark"). The examining attorney refused the application for Petitioner's Mark based on a likelihood of confusion between Petitioner's Mark and pending Application Ser. No. 78/213,107 filed by Respondent Michael Hwang. A copy of the Office Action issued by the USPTO is attached as Exhibit B.

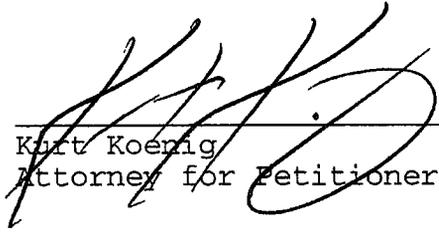
3. The trademark examining attorney has suspended the application for Petitioner's Mark pending the resolution of the instant cancellation proceeding.

4. On March 13, 2006, I performed a search of Google.com by typing "oak tree" (in quotes) and the additional word "boots" and found the web page which has been printed and attached as Exhibit C. The first page displayed on Google.com shows Petitioner's footwear goods offered for sale on all ten of the non-advertised links. This search was designed to show that Petitioner has a strong mark that is recognized as being associated with footwear, namely "boots."

5. On March 13, 2006, I performed a search of a website located at BootBarn.com and found the web page which has been printed and attached as Exhibit D. The web page shows Petitioner's footwear offered for sale on this web page. The web page also shows that various hiking boots, such as those sold by Ariat® are available for purchase on this website and are displayed in close proximity and on the same web page as Petitioner's goods.

6. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in

this application are true; all statements made herein of her own knowledge are true; and all statements made on information and belief are believed to be true.


Kurt Koenig
Attorney for Petitioner

Dated: March 13, 2006

EXHIBIT A

to

SECOND DECLARATION UNDER 37 C.F.R. SECTION 2.20
OF KURT KOENIG IN SUPPORT OF
PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT
AND RESPONDENT'S CROSS-MOTION FOR SUMMARY JUDGMENT

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-03-14 22:03:03 ET

Serial Number: 78304288

Registration Number: (NOT AVAILABLE)

Mark



(words only): OAK TREE FARMS

Standard Character claim: No

Current Status: Further action on the application has been suspended.

Date of Status: 2005-11-22

Filing Date: 2003-09-23

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 111

Attorney Assigned:
TIERNEY MARGERY ANN Employee Location

Current Location: M20 -TMO Law Office 111

Date In Location: 2005-11-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Orozco, Nora

Address:

Orozco, Nora
4690 A Carpinteria Ave
Carpinteria, CA 93013
United States

Legal Entity Type: Individual

Country of Citizenship: United States

2. Orozco, Roger

Address:

Orozco, Roger
4690 A Carpinteria Ave
Carpinteria, CA 93013
United States

Legal Entity Type: Individual

Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 025

Footwear

First Use Date: 1995-04-01

First Use in Commerce Date: 1995-10-01

Basis: 1(a)

ADDITIONAL INFORMATION

Description of Mark: The mark consists of The mark consists of the words OAK TREE FARMS and a design element.

Design Search Code(s):

05.03.02 - Oak leaf

05.03.08 - More than one leaf, including scattered leaves, bunches of leaves not attached to branches

05.03.10 - Other branches with leaves, with or without fruit

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-11-22 - Report Completed Suspension Check Case Still Suspended

2005-05-16 - Report Completed Suspension Check Case Still Suspended

2004-11-15 - LETTER OF SUSPENSION E-MAILED

2004-11-15 - Suspension Letter Written

2004-11-08 - Amendment From Applicant Entered

2004-10-28 - Communication received from applicant

2004-10-28 - TEAS Response to Office Action Received

2004-10-28 - Attorney Revoked And/Or Appointed

2004-10-28 - TEAS Revoke/Appoint Attorney Received

2004-04-30 - Non-final action e-mailed

2004-04-19 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

Kurt Koenig (Attorney of record)

Kurt Koenig
Koenig & Associates
220 East Figueora St.
Santa Barbara CA 93101

Phone Number: 805-965-4400

Fax Number: 805-564-8262

EXHIBIT B

to

SECOND DECLARATION UNDER 37 C.F.R. SECTION 2.20
OF KURT KOENIG IN SUPPORT OF
PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT
AND RESPONDENT'S CROSS-MOTION FOR SUMMARY JUDGMENT

To: Orozco, Nora (ntan@impulse.net)
Subject: TRADEMARK APPLICATION NO. 78304288 - OAK TREE FARMS - N/A
Sent: 4/30/04 12:15:05 PM
Sent As: ECom111
Attachments: Attachment - 1
Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/304288

APPLICANT: Orozco, Nora

CORRESPONDENT ADDRESS:
Orozco, Nora
4690 A Carpinteria Ave
Carpinteria, CA 93013

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: OAK TREE FARMS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
ntan@impulse.net

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/304288

SEARCH RESULTS - PRIOR PENDING APPLICATION

Although the examining attorney has searched the Office records and has found no similar *registered* mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), the examining attorney encloses information regarding pending Application Serial No. 78/213107 for the mark OAKTREE as applied to "footwear." 37 C.F.R. §2.83.

There may be a likelihood of confusion between the applicant's mark and the mark in the above noted application under Section 2(d) of the Act. The filing date of the referenced application precedes the applicant's filing date. If the earlier#filed application matures into a registration, the examining attorney may refuse registration under Section 2(d).

DRAWING

The drawing is not acceptable because it will not reproduce satisfactorily because it appears to be a faint photocopy. The applicant must submit a new drawing showing the mark clearly and conforming to 37 C.F.R. §2.52. TMEP §807.07(a).

SPECIAL FORM DRAWING RULES

NOTE: The Trademark Rules pertaining to drawings were amended on November 2, 2003. For applications filed prior to November 2, 2003, applicants may follow either the new special form drawing rules or the special form drawing rules in force prior to their amendment on November 2, 2003. Exam Guide 01-03, section I.B.6.

Paper Submission

The requirements for a special-form drawing are as follows:

- # The drawing must appear in black and white if color is not claimed as a feature of the mark, or in color if color is claimed as a feature of the mark.

- # Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

- # The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8cm) wide.

- # If reduction of the mark to the required size renders any details illegible, then applicant may insert a statement in the application to describe the mark and these details.

37 C.F.R. §§2.52(b); See TMEP §§807.01(b) and 807.07(a).

If submitted on paper, the Office prefers that the drawing be depicted on a separate sheet of non-shiny, white paper that is 8 to 8.5 inches wide and 11 to 11.69 inches long (20.3 to 21.6 cm. wide and 27.9 to 29.7 cm. long). One of the shorter sides of the sheet should be regarded as its top edge. In addition, the drawing should include the caption "DRAWING PAGE" at the top of the drawing beginning one-inch (2.5 cm) from the top edge. 37 C.F.R. §2.54.

The Office strictly enforces these drawing requirements.

Electronic Submission

To submit a special form drawing electronically, applicant must attach a digitized image of the mark to the submission. The image must be formatted at no less than 300 dots per inch and no more than 350 dots per inch; and with a length and width of no less than 250 pixels and no more than 944 pixels. All lines in the image must be clean, sharp and solid, and not fine or crowded, and produce a high quality image when copied. 37 C.F.R. §2.53.

ENTITY REQUIRES CLARIFICATION

Applicant must clarify its entity type because there is an inconsistency in the application. Specifically, the application indicates that Roger Orozco and Nora Orozco own the mark.

A mark is usually owned by a single business entity or one individual. If both named applicants own the mark jointly, they must state that they are *joint* applicants. TMEP §803.03(d). Applicant cannot amend the application to designate another entity as the applicant. If the application was filed in the name of the wrong party, then this application is considered void. In such a case, the true owner may refile a new application for the mark, with a new filing fee. TMEP §803.06.

RESPONSE

Applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the trademark examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) applicant's telephone number. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

/Margery A. Tierney/
Examining Attorney, Law Office 111
703-536-5277
fax: (703)746-8111
email: margery.tierney@uspto.gov

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at

<http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Print: Apr 30, 2004

78213107

Issue: May 25, 2004

DESIGN MARK

Serial Number

78213107

Status

SU - REGISTRATION REVIEW COMPLETE

Word Mark

OAKTREE

Standard Character Mark

No

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Hwang, Michael INDIVIDUAL UNITED STATES 12-25 Robin Lane Bayside NEW YORK 11360

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Footwear.
First Use: 2003/12/20. First Use In Commerce: 2003/12/20.

Filing Date

2003/02/10

Examining Attorney

AMOS, TANYA

oaktree

EXHIBIT C

to

SECOND DECLARATION UNDER 37 C.F.R. SECTION 2.20
OF KURT KOENIG IN SUPPORT OF
PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT
AND RESPONDENT'S CROSS-MOTION FOR SUMMARY JUDGMENT



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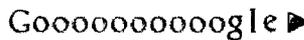
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EXHIBIT D

to

SECOND DECLARATION UNDER 37 C.F.R. SECTION 2.20
OF KURT KOENIG IN SUPPORT OF
PETITIONER'S REPLY TO
RESPONDENT'S BRIEF IN OPPOSITION
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