

ESTTA Tracking number: **ESTTA199715**

Filing date: **03/20/2008**

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

| | |
|------------------------|--|
| Proceeding | 92044571 |
| Party | Defendant Delan Enterprises Incorporated and One Step Up, Ltd. |
| Correspondence Address | Harlan M. Lazarus, Esq. LAZARUS AND LAZARUS, P.C. 240 MADISON AVENUE NEW YORK, NY 10016 UNITED STATES hmlaw@att.net |
| Submission | Opposition/Response to Motion |
| Filer's Name | Harlan M. Lazarus, Esq. |
| Filer's e-mail | hmlaw@att.com, carissalaz@aol.com |
| Signature | /hml/ |
| Date | 03/20/2008 |
| Attachments | hml.decl.3.20.pdf (6 pages)(246504 bytes) |

letter (See Registrant's 6).

4. Simultaneous with Declarant's receipt of Registrant's 6, Registrant served Registrant's 1, the Notice of Testimonial Deposition of Haigeny.

5. Registrant's 6 was supplied to Petitioner prior to the Haigney Deposition (see Petitioner's Declaration at paragraph 6).

6. As further acknowledged by Petitioner, and in particular Registrant's 7 and Registrant's 8, were produced for the first time to each of Petitioner and Registrant on the morning of Haigney's Deposition (See footnote 3, page 5, of Petitioner's Declaration).

7. Petitioner's argument that any Registrant's trial exhibit produced through BCF by Haigney should be excluded is without merit.

8. Tab 2 of Petitioner's Declaration is "One Step Up. Ltd's Verified Responses to Petitioner's First Set of Requests for Production" ("Registrant's Responses").

9. Registrant's "General Objection" 7 in Registrant's Responses sets forth:

"Registrant objects to the Document Requests on the ground, and to the extent that they seek information which is not within Registrant's possession, custody, or control, or might otherwise be obtained by Registrant from governmental or other public entities or sources."

10. Registrant's "General Objection" 8 in Registrant's Responses sets forth:

"Registrant's search for information and documents is ongoing and Registrant expressly reserves the right to rely on any facts, documents, or other evidence that may develop or come to its attention at a later time during this

litigation, and to supplement or amend the responses at any time prior to the trial of this action. Registrant further reserves the right to raise any additional objections deemed necessary or appropriate in light of the result of any further review.”

11. As set forth in the accompanying Trial Brief and Opposition to Petitioner’s Motion to Strike Registrant’s Trial Exhibits (“Registrant’s Trial Brief”), at no time was BCF (or any other pertinent non-party) in the “control” of Registrant, and therefore Petitioner’s arguments for exclusion based on “lateness” are without merit.

12. Moreover, and as argued in Registrant’s Trial Brief, Petitioner’s claim of “unfair surprise” with respect to BCF is also without merit.

13. BCF is the retail vendor with respect to which Petitioner predicates Petitioner’s “abandonment” argument.

14. As became evident at the Reich Deposition, Petitioner’s abandonment claim has, as its only conceivable factual basis, Reich’s BCF post-Pet. Application investigation of Trademark sales at BCF.

15. Petitioner and Reich, in fact, never made any investigation of Trademark activity at BCF in the Relevant Period; assuming arguendo, that Reich made any BCF investigation, it was, at best, less than nominal.

16. Upon such testimony, *as was its unquestionable right*, and in accordance with proper procedure, served testimonial deposition notices upon the non-party, BCF (see Registrant’s 1).

17. BCF, as was its right, voluntarily appeared as a trial witness, and voluntarily produced documents, all of which were timely produced to Petitioner.

18. The burden to substantively investigate the authenticity of Reich's "assumptions" and "impressions" with respect to BCF is that of the Petitioner. The lack of such an investigation by Petitioner is Petitioner's weight to bear, not Registrant's.

19. Following the Reich Deposition, Registrant conducted an investigation with respect to BCF, and the trial testimony of Haigney was conducted in accordance with proper procedure. Because there is no basis for exclusion and Haigney's testimony disproves Petitioner's claim of abandonment, said testimony should be heard by the Board.

20. For these reasons and as argues at length in Registrant's Trial Brief, Registrant respectfully requests that (i) Petitioner's Motion to Strike Registrant's Exhibits and (ii) the Petition for Cancellation be denied.

Dated: March 20, 2008
New York, New York

LAZARUS & LAZARUS, P.C.
Attorneys for Registrant

By: _____

HARLAN M. LAZARUS, ESQ.
240 Madison Avenue, 8th Floor
New York, New York 10016
(212) 889-7400

CERTIFICATE OF SERVICE AND FILING

This certifies that a copy of the foregoing Declaration of Harlan M. Lazarus, Esq. was served on Petitioner on the date indicated below by placing an envelope and depositing same with the United States Postal Service as First Class Mail, postage prepaid, addressed to Petitioner's counsel of record:

GRIMES & BATTERSBY, LLP
488 Main Avenue, 3rd Floor
Norwalk, Connecticut 06851
Attention: EDMUND J. FERDINAND, III., ESQ.

and further certifies that the Declaration of Harlan M. Lazarus, Esq. was filed with the Trademark Trial and Appeal Board via the Board's electronic filing system on the date indicated below.

By: _____

HARLAN M. LAZARUS, ESQ.

Dated: March 20, 2008
New York, New York

