

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

Mailed: June 20, 2007

Cancellation No. 92044624

J. Christopher Carnovale

v.

The Brand Experience LLC

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

On February 22, 2007, respondent filed a motion for relief from final judgment, entered May 10, 2006.

Respondent's motion is not accompanied by proof of service on petitioner as required by Trademark Rule 2.119(a). *See also* TBMP §113 (2d ed. rev. 2004). In the interest of time, and as a courtesy, a copy is attached herewith. Petitioner is allowed until **thirty days** from the mailing date of this order in which to file a response. Notwithstanding the receipt of any response from petitioner, respondent's motion will be considered on its merits.

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

Proceeding	92044624
Party	Defendant Brand Experience LLC, The Sunsafe, Inc. 6465 S.W. 135 Drive Miami, FL 331567060
Correspondence Address	The Brand Experience LLC Rivo Alto Island US 1st Terrance Miami Beach, FL 33139
Submission	Other Motions/Papers
Filer's Name	Wayne V. Harper
Filer's e-mail	harperw@gtlaw.com
Signature	/s/Wayne V. Harper
Date	02/22/2007
Attachments	Motion to Vacate.pdf (6 pages)(29482 bytes) Exhibit A.pdf (1 page)(180190 bytes) Exhibit B.pdf (1 page)(213438 bytes)

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

J. CHRISTOPHER CARNOVALE

Petitioner

Cancellation Case No. 92044624

THE BRAND EXPERIENCE LLC

Registrant

MOTION TO VACATE DEFAULT JUDGMENT CANCELING REGISTRATION

For its Motion to set-aside the Default Decree Canceling Registration Nos. Registration Nos. 2,384,600; 2,477,694; and 2,593,603, Registrant states:

BACKGROUND

1. At all times relevant to this proceeding, up to issuance of the cancellation order of April 25, 2006, the Defendant has been the lawful owner of any and all rights for the word mark THE 50+ SUNSCREEN THAT WONT RUB OFF, Registration No. 2,384,600, issued on September 12, 2000; the word mark THE SUNSCREEN THAT WONT RUB OFF, Registration No. 2,477,694, issued on August 14, 2001; and the word mark THE SUNSCREEN KIDS WANT TO WEAR, Registration No. 2,593,603, issued on July 16, 2002.

2. Approximately two years ago, the Registrant relocated its offices from Miami, Florida and St. Petersburg, Florida, but due to a clerical error, failed to update its mailing address on Registration Nos. 2,384,600, 2,477,694, and 2,593,603.

3. On June 14, 2005, the Petitioner initiated a cancellation proceeding seeking to strike Registration Nos. 2,384,600, 2,477,694, and 2,593,603 from the Principle Register.

4. Notice of the cancellation proceeding was allegedly served to the Registrants' old mailing address in Miami, Florida on June 15, 2005, but was not received by the Registrant. The notice, if actually served, was presumably returned as undeliverable or was otherwise discarded.

5. Being unaware of the cancellation proceeding, the Registrant did not file a response to the Petitioner's Petition for Cancellation or request any manner of extension. On August 15, 2005, the Petitioner moved for default judgment on its Petition for Cancellation.

6. Notice of the motion for default judgment was allegedly served to the Registrant's old mailing address in Miami, Florida on August 15, 2005, but was not received by the Registrant. The notice, if actually served, was presumably returned as undeliverable or was otherwise discarded.

7. Notwithstanding the fact that the Petitioner was aware of the fact that the Registrant had not received proper service of the Cancellation proceeding and the motion for Default Judgment, the Petitioner apparently made no effort to determine the Registrant's correct mailing address. The Registrant's mailing address was, throughout 2005, readily available through the Registrant's web site and other advertisements. The Registrant's current mailing address was also readily available during that time through other marks registered to "The Brand Experience", such as "SUNSAFE.COM".

8. After failing to effect personal service on the Registrant, the USPTO gave notice of this proceeding through the Official Gazette of the USPTO on February 7, 2006.

9. The Registrant, who does not monitor the Official Gazette of the USPTO, was unaware of being given notice by publication and did not file any response to the published notice. Furthermore, the registrant was, during the pendency of this case, continuously in contact with the USPTO regarding other marks, such as "SUNSAFE.COM" and "SUNSAFE FABRIC" and reasonably believed that the USPTO was aware of the Registrant's current business address.

10. On April 25, 2006, the Petitioner's Petition for Cancellation was granted as a Default Judgment and Registrant's marks, Registration Nos. 2,384,600, 2,477,694, and 2,593,603, were cancelled. The Petitioner did not receive personal service of the judgment of cancellation and was unaware of any publication regarding such cancellation in the Official Gazette of the USPTO.

11. On or about the second week or third week of November, 2006, the Registrant became aware of the cancellation of its marks, and now petitions this board to vacate the Default Judgment in this proceeding to allow the Registrant to fairly and properly defend its registrations in this proceeding.

12. Pursuant to Fed. R. Civ. P. 60(b), this Board has the authority to vacate Default Judgments where the Registrant's failure to respond is due to "(1) mistake, inadvertence, surprise, or excusable neglect;". Such mistakes or neglect, even if grossly negligent, are adequate grounds for relief so long as they are not willful, deliberate, or evidence of bad faith.

13. Default Judgments are not favored. The Board has the discretion to vacate a Default Judgment on motion to allow a case to be fully and fairly litigated on its merits. In reviewing such motions, the Board determines (1) whether the default was willful; (2) whether defendant has a meritorious defense; and (3) the level of prejudice that may occur to the non-defaulting party if relief is granted.

THE DEFAULT IN THIS CASE WAS A MISTAKE AND WAS NOT WILLFUL.

14. The Registrant did not respond to the Petitioner's Petition for Cancellation, and any other pleadings in this case, due to the fact that the Registrant never received personal service of any of such pleadings, nor was the Registrant aware of publication of notice of these proceedings in the Official Gazette of the USPTO.

15. Assuming that the pleadings in this case were properly served to the Registrant's address of record, the Registrant did not receive service of such pleadings because the address of record for the Registrations contested in this case is incorrect and reflects the Registrant's prior business address. The address of record is incorrect due to the Registrant's inadvertent mistake in failing to properly update its mailing address upon relocating its headquarters from Miami, Florida to St. Petersburg, Florida.

16. Furthermore, since the Registrant's current mailing address was correctly listed on other marks registered to "The Brand Experience" during the pendency of the cancellation proceeding, such as "SUNSAFE.COM", the registrant reasonably believed that the USPTO was aware of the Registrant's current mail address and would forward notice of any proceedings regarding the validity of the Registrant's marks.

17. The Registrant held Registration Nos. 2,384,600, 2,477,694, and 2,593,603 for nearly 5, 4, and 3 years respectively prior to this cancellation proceeding, and prior to this proceeding had never received notice of any disputes regarding the validity of its marks. Accordingly, the Registrant was unaware of any need to actively monitor the Official Gazette of the USPTO.

THE REGISTRANT HAS MERITORIOUS DEFENSES IN THIS CASE

The Registrant has not abandoned its marks.

18. The Registrant has continuously used the marks at issue in this case in interstate commerce in the United States from 1998 to the present. A simple Internet search would have revealed the fact that the Registrant is currently marketing its products using the marks at issue in this case (see exhibits A and B).

The Petitioner has not adequately demonstrated it has prior use rights superior to that of the registrant in all, or any part, of the United States for marks similar to, or identical to the marks at issue in this case.

19. The Petitioner has not brought forward sufficient evidence to prove that they have continuously sold their products within the United States under the mark THE SUNSCREEN THAT NEVER WEARS OFF! during a period beginning in, or prior to 1998, to the present.

20. Even if the Petitioner have continuously sold their products within the United States under the mark THE SUNSCREEN THAT NEVER WEARS OFF! during a period beginning in, or prior to 1998, to the present, the Petitioner has failed to bring forward sufficient evidence to indicate the extent of such sales, and it is impossible to determine the scope of their prior use rights, if any.

There is no likelihood of confusion with respect to at least one mark at issue in this case and the Petitioner's mark.

21. The mark THE SUNSCREEN KIDS WANT TO WEAR, Registration No. 2,593,603, is so dissimilar to the Petitioner's mark, THE SUNSCREEN THAT NEVER WEARS OFF!, that

there is no likelihood a reasonable consumer would believe that products originated from the same source or are sponsored by the same organization.

The Petitioner's claims are barred by laches.

22. The Registrant has been using the marks at issue in this case for approximately 8 years. Notwithstanding the Petitioner's claims that it has been marketing its products in the U.S. for approximately 20 years, the Petitioner has allowed the Registrant to expend significant funds to establish a recognizable brand in the U.S. for over 4 years before contesting the Registrant's use of the mark.

THE PETITIONER WILL NOT BE UNFAIRLY PREJUDICED IF THIS MOTION IS
GRANTED

23. The Registrant has persistently and continuously used the marks at issue in this case since 1998. The Petitioner has not alleged or established that such use have impaired the sales of its products in the U.S., nor has the Registrant attempted to restrict or otherwise hamper the Petitioner in the operation of its business.

24. The sole basis the Petitioner has apparently pleaded for relief in this case is that the Registrant's marks are a bar to the registration of the Petitioner's mark. Furthermore, the Petitioner has not attempted to communicate with the Registrant or demand that the Registrant cease to use any of the marks at issue in this case. Thus, the Petitioner's actions appear to indicate that neither registration of its mark or its exclusive use is a priority for the Petitioner.

25. The sole result of granting this motion will be to require the Petitioner to fully and fairly litigate its Petition for Cancellation in this case. At most, the Petitioner's registration will suffer a short delay, which, based on the Petitioner's actions, is apparently of little consequence.

WHEREFORE, The Registrant THE BRAND EXPERIENCE, LLC respectfully prays that this Board grant the following relief:

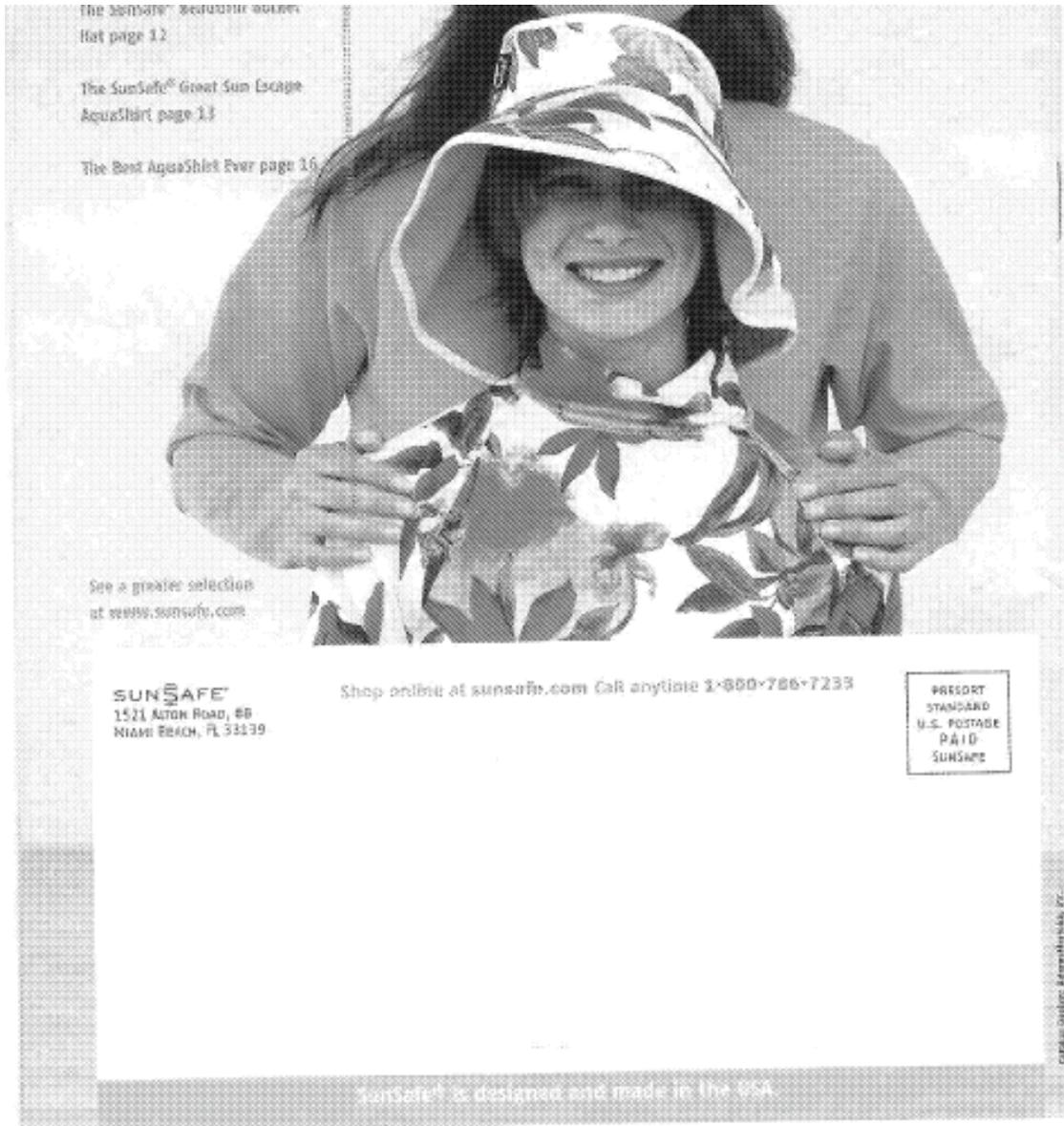
- i. The Default Judgment canceling the Registrant's Registration in the marks THE 50+ SUNSCREEN THAT WONT RUB OFF, Registration No. 2,384,600, THE SUNSCREEN THAT WONT RUB OFF, Registration No. 2,477,694, and the and the word mark THE SUNSCREEN KIDS WANT TO WEAR, Registration No. 2,593,603 be vacated and set aside.
- ii. The Registrant be given 30 days to file a substantive answer to the Petitioner's Petition for Cancellation.
- iii. Any other relief this Board deems fair and equitable.

Respectfully Submitted,

/s/ Wayne V. Harper, FL Bar #763,101

Greenberg Traurig, P.A.
450 South Orange Avenue
Suite 650
Orlando, FL 32801
Telephone: 407-420-1000
Facsimile: 407-420-5909
Email: harperw@gtlaw.com

Attorney for the Defendant





SunSafe® Kids' Ultimate AquaPants

You can't find better leg protection from the sun's harmful rays – especially the back. Team them up with our Ultimate AquaShirt® for maximum protection. Lightweight and fast drying. FABRIC: SUNSAFE® 50+UPF AQUA®, FOUR-WAY STRETCH FOR ULTIMATE COMFORT. MADE IN USA. COLOR: ROYAL, BLACK. SIZE: 2, 4, 6, 8, 10, 12, 14. #P01-L, \$28.00

The SunSafe® Kids' Legionnaire Hat

Our over-sized, protective bill and neck drape help keep the sun away from little faces, ears, and necks. Lightweight and dries quickly. Great both in and out of the water. *Please remember that for maximum protection from reflected light, sunscreen should be applied to exposed skin.* FABRIC: SUNSAFE® 50+ UPF AQUA®. COLOR: FLORAL, ROYAL (SEE PAGE 27), CAPRI (SEE PAGE 28) SIZE: SMALL (FITS 9 MONTHS TO 3 YEARS, INCLUDES TIE), LARGE (FITS AGES 3 AND UP) #H01, \$20.00



SunSafe® It's A Wrap Sarong

Did you know your children's thighs are particularly vulnerable to sun damage? Keep them protected in this adorable piece, and while you are at it – get one for yourself. Comfortable, lightweight and quick drying. FABRIC: SUNSAFE® 50+UPF AQUALITE®, WITH FOUR-WAY STRETCH. MADE IN USA. MACHINE WASHABLE. COLORS: FLORAL, BLACK. KIDS' SIZE: SMALL. ADULT SIZES: MCD, LG. #KLS, \$38.00