

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

Butler

Mailed: November 13, 2007

Cancellation No. 92044624

J. Christopher Carnovale

v.

The Brand Experience LLC

**Before Walters, Kuhlke and Cataldo, Administrative Trademark
Judges.**

By the Board:

This case now comes up on respondent's motion, filed February 22, 2007, for relief from default judgment, entered May 10, 2006. Inasmuch as respondent's motion was not accompanied by proof of service on petitioner, the Board, in an order dated June 20, 2007, served a copy on opposer and allowed opposer time to respond. Opposer filed his response on July 19, 2007.

As background, this proceeding commenced on June 14, 2005 with the filing of the petition to cancel Registration Nos. 2384600, 2593603 and 2477694. The Board, on June 15, 2005, sent notice instituting proceedings. Such notice was returned as undeliverable on August 24, 2005. In the meantime, petitioner, on August 17, 2005, filed a motion for default judgment for respondent's failure to answer. The Board suspended proceedings on December 5, 2005 in order to effectuate service by publication. In the December 5th order, the Board informed

petitioner that his motion for default judgment would not be considered. Service by publication occurred on February 7, 2006. The Board entered default judgment on April 25, 2006 because no word had been heard from respondent.¹

In support of its motion, respondent argues that it was not aware of the Board proceeding; that it never received communications either from the Board or from petitioner; and that it was not aware of the service by publication. Respondent acknowledges that it relocated but did not update its address with the USPTO with respect to the registrations in question. Respondent argues, though, that it reasonably believed that the USPTO was aware of its present address because it was continuously in contact with the Office concerning its other registered and applied-for marks, pointing particularly to its SUNSAFE.COM mark for which the address is current and was current at the time the present opposition commenced. In addition, respondent contends that its present address was easily ascertainable at its website during the pertinent times and that petitioner, apparently, did not attempt to check respondent's address because respondent never received any correspondence or service copies from petitioner. According to respondent, it became aware of the cancellations of its registrations mid-November and is acting promptly to seek relief. Respondent notes that it has not abandoned use of its marks; that petitioner has not demonstrated

¹ The Commissioner's order canceling respondent's registrations is dated May 10, 2006.

he has prior use rights superior to those of respondent; and that there is no likelihood of confusion between the parties' involved marks.

In response, petitioner takes the position that the petition to cancel was granted "more than one year ago."² Petitioner contends that, because respondent admits it did not update its address with respect to the registrations, respondent is the responsible party for its non-receipt of the institution order and of petitioner's motion for default judgment and, thus, cannot show excusable neglect exists as a basis for vacating the entry of judgment.

Fed. R. Civ. P. 60(b) provides for relief from judgment in specified instances. Any motion for such relief must be made within a reasonable time not more than one year from the entry of judgment where the motion is brought pursuant to the first three grounds for relief (mistake, inadvertence, surprise, excusable neglect; newly discovered evidence; or fraud). Here, respondent's motion is timely insofar as it was brought within a reasonable time and less than one year after entry of the default judgment.

Relief from a default judgment has been granted under Fed. R. Civ. P. 60(b)(1) where the party seeking such relief had no

² While it is true that the default judgment was entered over a year prior to petitioner's response being filed, such judgment was entered less than a year before respondent filed its motion seeking relief therefrom. Petitioner's misconstruction of the pertinent timing under Rule 60(b)(1) is not appreciated.

actual knowledge of service upon him. See Wright & Miller, 11 Fed. Prac. & Proc. Civ. 2d §2858 (2007). A motion for relief from judgment is addressed to the discretion of the court (here, the Board). *Id.* §2857. In addition, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments. See TBMP §312.03 (2d ed. rev. 2004).

Among the factors to be considered in determining the propriety of vacating a default judgment for failure to answer the complaint are: (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action. See TBMP §§312.03 and 544 (2d ed. rev. 2004).

Respondent did not act willfully insofar as it was unaware of the entry of default judgment and because it acted promptly after finding out about the entry of default judgment to seek relief therefrom. While there is some delay occasioned in this proceeding, it is adjudged that petitioner, as the party who brought the proceeding and has the duty to prosecute, is not substantially prejudiced by the reopening of this case. In addition, respondent has made a showing that it has a meritorious defense to petitioner's claims.

Accordingly, respondent's motion for relief from final judgment is granted and the default judgment entered on April 25, 2006 is hereby vacated.³

Proceedings are resumed. Respondent is allowed until **thirty days** from the mailing date of this order in which to file its answer to the petition to cancel, a copy of which is attached.

Discovery and trial dates are reset as follows:

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| THE PERIOD FOR DISCOVERY TO CLOSE: | May 26, 2008 |
| 30-day testimony period for party in position of plaintiff to close | August 24, 2008 |
| 30-day testimony period for party in position of defendant to close: | October 23, 2008 |
| 15-day rebuttal testimony period to close: | December 7, 2008 |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

³ The Board is electronically notifying the Office of the Commissioner for Trademarks in order that appropriate action may be undertaken with respect to

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

In re Registration No. 2,384,600 for the mark THE 50+ SUNSCREEN THAT WON'T RUB OFF issued on September 12, 2000; Registration No. 2,477,694 for the mark THE SUNSCREEN THAT WON'T RUB OFF issued on August 14, 2001; and Registration No. 2,593,603 for the mark SUNSCREEN KIDS WANT TO WEAR issued on July 16, 2002

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|---------------------------|---|-----------|
| J. CHRISTOPHER CARNOVALE | : | |
| | : | |
| Petitioner | : | |
| | : | |
| v. | : | Canc. No. |
| | : | |
| THE BRAND EXPERIENCE LLC. | : | |
| | : | |
| Registrant | : | |

PETITION FOR CANCELLATION

Petitioner J. Christopher Carnovale ("Petitioner") believes that he will be damaged by the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603 and hereby petitions to cancel these registrations pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064. As grounds for cancellation, Petitioner alleges that:

1. Petitioner is the owner of all right, title and interest in and to the mark THE SUNSCREEN THAT NEVER WEARS OFF! for a variety of clothing products in Class 25.
2. Since long prior to the acts complained of in this petition, Petitioner has continuously used the mark THE SUNSCREEN THAT NEVER WEARS OFF! in connection with its clothing products in several countries, including the United States.

3. Since the initial use of the mark, Petitioner has made a substantial investment in advertising and promoting its goods under the mark THE SUNSCREEN THAT NEVER WEARS OFF!

4. As a result of the significant advertising and publicity, and several years of continuous use in the marketplace, Petitioner's mark has become well known as a distinctive indicator of the origin of Petitioner's goods, and as a symbol of Petitioner's valuable goodwill.

5. Petitioner has filed with the United States Patent and Trademark Office (the "Office") Appl. S/N 76/599,475 THE SUNSCREEN THAT NEVER WEARS OFF! for men's, ladies' and children's clothing, namely, shirts, tops, blouses, jackets, cover-ups, skirts, pants, jumpsuits, robes, and hats, in Int. Class 25.

6. Notwithstanding Petitioner's prior rights in its mark, Registrant has obtained the following registrations:

- Registration No. 2,384,600, for the mark THE 50+ SUNSCREEN THAT WON'T RUB OFF for "sun protective clothing, namely, swim wear, hats, shirts, shorts, and shoes", in Int. Class 25, issued on September 12, 2000;
- Registration No. 2,477,694 for the mark THE SUNSCREEN THAT WON'T RUB OFF for "sun protective clothing, namely, swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear", in Int. Class 25, issued on August 14, 2001; and
- Registration No. 2,593,603, for the mark SUNSCREEN KIDS WANT TO WEAR for "sun protective clothing, namely, swimwear, long and short sleeved shirts, T-

shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear", in Int. Class 25, issued on July 16, 2002.

7. The Office refused Petitioner's Application S/N 76/599,475 THE SUNSCREEN THAT NEVER WEARS OFF! on the ground that Petitioner's mark is allegedly confusingly similar to the marks identified in Registrant's Reg. Nos. 2,384,600; 2,477,694; and 2,593,603.

8. Upon information and belief, Registrant made no use of its alleged marks in commerce prior to May 28, 1998, the alleged date of first use in commerce.

9. Upon information and belief, when Registrant applied to register the marks at issue, Registrant had full knowledge of Petitioner's prior rights in the mark THE SUNSCREEN THAT NEVER WEARS OFF!.

10. Petitioner continuously has used its mark THE SUNSCREEN THAT NEVER WEARS OFF! in connection with its goods, in interstate commerce, since long prior to the alleged date of first use of the marks identified in Reg. No. 2,384,600; Reg. No. 2,477,694; and Reg. No. 2,593,603, and long prior to the application filing dates listed in each registration.

A. Likelihood Of Confusion

11. Registrant's alleged marks so resemble Petitioner's mark that the use thereof by Registrant, and the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603 is likely to cause confusion, mistake and/or deception within the meaning of Section 2(d) of the Trademark Act as to the source or origin of Registrant's goods, and will injure and damage Petitioner and the goodwill and reputation symbolized by Petitioner's mark.

12. Petitioner has been and will be damaged by the continued existence of Registration No. 2,384,600, Registration No. 2,477,694; and Registration No. 2,593,603 because the marks shown in these registrations are likely to cause confusion, mistake or deception among consumers who may believe that the goods of Registrant emanate from or are in some way sponsored or endorsed by or associated with Petitioner.

13. Registrant is not affiliated or connected with or endorsed or sponsored by Petitioner, nor has Petitioner approved any goods or services offered or sold by Registrant under the mark THE 50+SUNSCREEN THAT WON'T RUB OFF, THE SUNSCREEN THAT WON'T RUB OFF, and SUNSCREEN KIDS WANT TO WEAR, nor has Petitioner granted Registrant permission to use said marks.

14. Petitioner's goods and those of Registrant are identical or so closely related that the public is likely to be confused and to assume erroneously that Registrant's goods are Petitioner's goods or that Registrant is connected with, sponsored by or affiliated with Petitioner.

15. Upon information and belief, Registrant adopted the registered marks and has subsequently used the registered marks with a deliberate intent to cause confusion among purchasers as to the source of its products.

16. Petitioner has been and will be damaged by the continued existence of Registration No. 2,384,600, Registration No. 2,477,694; and Registration No. 2,593,603 because said registrations have been cited by the Office as a bar to the registration of Petitioner's mark THE SUNSCREEN THAT NEVER WEARS OFF! on the ground that Petitioner's mark is likely to cause confusion, mistake or deception among consumers who may believe that the goods of Registrant emanate from or are in some way

sponsored or endorsed by or associated with Petitioner. Because Petitioner has prior rights, Petitioner is entitled to obtain an order directing that Registrant's registrations be cancelled.

B. Abandonment

17. Upon information and belief, Registrant has discontinued all use of the marks THE 50+ SUNSCREEN THAT WON'T RUB OFF, THE SUNSCREEN THAT WON'T RUB OFF, and SUNSCREEN KIDS WANT TO WEAR with intent not to resume such use.

18. Upon information and belief, Registrant has forfeited all rights it may ever have had in its alleged marks and the marks have been abandoned.

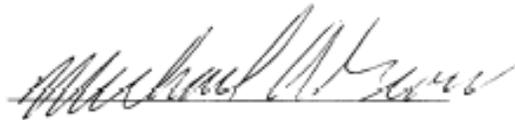
19. Notwithstanding the fact that the Registrant's marks have been abandoned, the registrations for said marks have been cited as a bar to registration of Petitioner's mark.

20. By reason of the foregoing, Petitioner will be damaged by the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603, and said registrations should be cancelled.

WHEREFORE, Petitioner requests that the Board grant this petition for cancellation.

J. CHRISTOPHER CARNOVALE

By



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June 14, 2005