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

Proceeding	92045274
Party	Defendant Sew Fast/Sew Easy, Inc. Sew Fast/Sew Easy, Inc. 147 West 57th Street New York, NY 10019
Correspondence Address	GEORGE NAHITCHEVANSKY KILPATRICK STOCKTON, LLP 31 WEST 52ND STREET NEW YORK, NY 10019 gnahitchevansky@kilpatrickstockton.com
Submission	Other Motions/Papers
Filer's Name	Georges Nahitchevansky
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Signature	/Georges Nahitchevansky/
Date	04/11/2006
Attachments	Respondents opposition to petitioners motion for leave to amend.pdf (16 pages)

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

DEBORAH STOLLER, Petitioner, v. SEW FAST/SEW EASY, INC., Respondent.	Cancellation No. 92045274 **Respondent's Opposition to Petitioner's Motion for Leave to Amend**

Petitioner's motion for leave to amend is nothing more than the latest in a string of continued efforts by Petitioner to harass Respondent. The proposed amended notice of opposition raises allegedly new grounds to cancel Respondent's registration on what can only be termed "flimsy" facts and in order to increase the burden on Respondent to protect its rights. Simply put, the proposed amendment is not being made in good faith but as a tactical maneuver to literally drown Respondent in litigation costs.

Statement of Facts

This case concerns a fight over rights in the marks STITCH AND BITCH CAFÉ and STITCH 'N BITCH. Respondent Sew Fast/Sew Easy, Inc. ("SFSE" or "Respondent"), a small New York company, adopted and first used the mark STITCH & BITCH CAFÉ in 1997. In the years that followed, SFSE has used the mark STITCH & BITCH CAFÉ and the marks STITCH AND BITCH and STITCH & BITCH in connection with a wide variety of goods and services, including sewing instruction, manuals and workbooks, various sewing and knitting products, an online forum and chat room, an online guestbook, instruction groups and classes, sewing patterns and various promotional items.

SFSE filed a trademark application for the mark STITCH & BITCH CAFÉ on April 14, 2000 and obtained a registration for the mark on April 30, 2002 for sewing instruction and manuals in Class 41 and for the providing of online chat rooms for the transmission of messages among computer users concerning sewing in Class 38.

On or about May 12, 2004, Petitioner Deborah Stoller ("Stoller" or "Petitioner"), a "successful" author and publisher of *Bust* magazine, filed four intent to use applications for the mark STITCH 'N BITCH for a wide variety of goods and services, including a television show related to knitting, bags and cases for knitting materials and supplies, knitting kits and related products, yarns, threads, needles, knitting patterns and instructions, and a series of books in the field of knitting (Application Serial Nos. 78417593, 78417575, 78417582, 78417589). In her applications, Stoller claimed that she was the "owner" of the STITCH 'N BITCH mark and that she was not aware of anyone else having a right to use the mark or a resemblance of such in commerce. *See* Exhibit A (representative example of declaration filed by Stoller's authorized representative in each of the four Stoller trademark applications for STITCH 'N BITCH).

On or about December 10, 2004, the Patent and Trademark Office issued office actions rejecting all four of Stoller's applications on the grounds that such applications were confusingly similar to SFSE's previously registered STITCH & BITCH CAFÉ mark. A few months thereafter, SFSE discovered that Stoller had filed the four trademark applications to register the mark STITCH 'N BITCH. On or about June 21, 2005, SFSE's attorney wrote to Stoller concerning Stoller's attempts to use and register the STITCH 'N BITCH mark and invited Stoller to discuss the matter. *See* Exhibit B. In the months that followed, SFSE also sent letters to various entities not related to Stoller that were offering unauthorized products for sale bearing the mark STITCH 'N BITCH and variations thereof.

No response was ever received from Stoller and it was soon discovered that Stoller had filed responses to the office actions in which it was claimed that Stoller's intent-to-use applications for the mark STITCH 'N BITCH would not cause any confusion with Respondent's STITCH 'N BITCH CAFÉ mark and that the mark STITCH 'N BITCH was uniquely associated with Stoller. *See* Response to Office Action dated June 9, 2005 in STITCH 'N BITCH application files. Subsequent attempts by SFSE's representatives to discuss the matter with Stoller likewise proved futile. On or about July 14, 2005, the Patent and Trademark Office issued final refusals rejecting all four of Stoller's applications for the mark STITCH 'N BITCH.

In or about November 2005, and without ever having responded to any of the attempts by SFSE's representatives to discuss the matter, Stoller filed the instant petition to cancel Respondent's registration for the mark STITCH & BITCH CAFÉ. In addition, in a letter subsequently sent to SFSE by Stoller's attorneys it was demanded that SFSE cease use of the mark STITCH & BITCH on sewing or knitting related products based on Stoller's claim to be the owner of superior rights in the mark STITCH 'N BITCH. *See* Exhibit C.

Stoller's cancellation proceeding was instituted on the eve of Christmas. In her Petition to Cancel, Stoller claimed, *inter alia*, that SFSE had abandoned its rights in its STITCH & BITCH CAFÉ mark by not having sufficiently policed and enforced its rights in the mark. *See* Petition to Cancel at ¶¶ 15-17. Notably, when SFSE stepped up and continued its efforts to police its rights in the STITCH AND BITCH CAFÉ mark, Stoller objected to such. On information and belief, Stoller and/or other individuals closely associated with Stoller then launched a campaign to portray SFSE in a negative light. A handful of individuals started to regularly post a series of negative and inappropriate comments on SFSE's web site, began to post negative reviews regarding books written by the principal of SFSE on Amazon.com, sent

derogatory letters to SFSE, organized a boycott campaign against SFSE, and generally pursued a strategy of making it appear that SFSE was attempting to usurp rights in the name and mark STITCH & BITCH – all the while ignoring or concealing the fact that Stoller claimed to own the mark STITCH N' BITCH, had filed four trademark applications to secure the mark STITCH N' BITCH for herself and for her own benefit, had demanded that SFSE cease use of the mark STITCH & BITCH and, in short, has been seeking to destroy SFSE's senior rights in the STITCH AND BITCH CAFÉ mark so that Stoller could secure her junior rights in the STITCH N' BITCH mark for her own benefit.[1]

Stoller's proposed amendment at this late date raises claims on facts that have been within Stoller's knowledge since prior to the time the Petition to Cancel was filed. The so called "new" information (which Stoler's motion does not disclose) concerning SFSE's manner of use and dates of first use of the STITCH & BITCH CAFÉ mark is in fact information that Stoller has been aware of and/or which was clearly available to Stoller well before she filed her Petition to Cancel. Stoller was well aware of SFSE's use, and manner of use, of the mark STITCH & BITCH CAFÉ, and nothing in discovery thus far has revealed "newly discovered information" that was not already known to Stoller.

Argument

For purposes of obtaining leave to amend a Petition to Cancel after a responsive pleading has been filed, the Petitioner must show that granting leave to amend will not be unduly

[1] It should also be noted that some of the negative postings have suggested that SFSE's enforcement actions regarding groups using the name STICH AND BITCH (such as STICH AND BITCH NYC) was for the purpose of preventing user groups from expressing their views on knitting on sewing. Such has never been the case. SFSE took actions to protect its rights and to have online groups change their names from STITCH AND BITCH to another name, not to prevent groups from having online venues. SFSE continues to support and welcomes the free exchange of ideas in the fields of sewing and knitting, and has even invited groups that want to use the STITCH AND BITCH mark for their online user groups to do so on forums that could be created on or through SFSE's web site for free.

prejudicial to the non-moving party. *Trek Bicycle Corp v. Style Trek Ltd.*, 64 U.S.P.Q.2d 1540 (TTAB 2001).

Here, there is no real basis for Petitioner's motion. The alleged new (but undisclosed) facts upon which Petitioner has based its motion concern the manner in which Respondent has used its STITCH & BITCH CAFÉ mark. Petitioner has claimed without any explanation that discovery has revealed new facts on how and when Respondent's mark was used that allegedly support claims for fraud upon the Patent and Trademark Office . However, all of these so-called new facts were in documents that were publicly available to and known to Petitioner for many years. Pages from Respondent's web site showing use and manner of use of the mark STITCH AND BITCH CAFÉ, and on which Petitioner now apparently seems to rely upon, have been available on the Internet archival service The Wayback Machine (see web site at Archive.org) well before Petitioner commenced this proceeding. Indeed, in postings and communications from individuals supporting Petitioner, it is clear that such archival web pages have been reviewed, commented on and communicated to Petitioner well before the instant Petition to Cancel was filed. Moreover, Petitioner has had at least two different sets of attorneys advising her in this matter. It thus seems incredulous that Petitioner has suddenly discovered new grounds for claims based on facts that were already well within her knowledge or that of her attorneys.

In short, the real purpose behind Petitioner's proposed new pleading is purely tactical and for the purpose of harassing Respondent. Petitioner is fully aware that as between the two parties she has more resources. Granting leave to amend would essentially reward Petitioner for delaying in raising its new claims until after an initial round of discovery had occurred and without any real justification. To be sure, the true reason for wanting to interpose new claims is

simple: to increase the costs on Respondent in defending its rights in its STITCH & BITCH CAFÉ mark.

Such attempt to harass Respondent should not be endorsed by the Board, particularly where, as here, the underlying facts for new claims were well within the knowledge of Petitioner when she filed her original Petition to Cancel. *See Id.*

CONCLUSION AND REQUEST FOR EXTENSION

For the foregoing reasons, Petitioner's motion for leave to amend should be denied. In the event, however, that Board grants Petitioner's motion, it is respectfully requested that the Board reset the current discovery and trial schedule so as to allow Respondent an additional three (3) months of discovery in the matter. It is likely that expert discovery will be required in this matter as well as significant third party discovery concerning both the existing claims in the Petition to Cancel as well as for the proposed new claims. Not granting such extension would be unduly prejudicial to Respondent and would deprive Respondent of the ability to conduct full discovery on the issues raised in this matter.

Dated: New York, New York
April 11, 2006

Respectfully submitted,

KILPATRICK STOCKTON LLP

Georges Nahitchevansky
31 W. 52nd Street
New York, New York 10019
(212) 775-8700
Attorneys for Respondent

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing RESPONDNET'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND is being filed electronically with the TTAB via ESTTA on this day, April 11, 2006.

Georges Nahitchevansky

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing ANSWER TO PETITION TO CANCEL was served by first class mail upon Marie-Anne Mastrovito, Esq., Abelman, Frayne & Schwab, 666 Third Avenue, New York, New York 10017, as attorneys for Petitioner Deborah Stoller on this 11th day of April, 2006.

Georges Nahitchevansky

EXHIBIT A

PTO Form 1478 (Rev 4/98)
OMB Control #0651-0009 (Exp. 09/30/2008)

Trademark/Service Mark Application, Principal Register

Serial Number: 78417589
Filing Date: 05/12/2004

To the Commissioner for Trademarks:

MARK: (Standard Characters, see mark)

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The literal element of the mark consists of STITCH 'N BITCH.

The applicant, Deborah Stoller, a citizen of United States, residing at 373 Union Street, Apt. #1, Brooklyn, NY, USA, 11231, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 026: Knitting kits comprising knitting needles, yarns, threads, knitting patterns and instructions; knitting kits and knitting bags sold as a unit; knitting kits and knitting needle cases sold as a unit

The applicant hereby appoints Edward H. Rosenthal and Melissa Georges, Jean Voutsinas of Frankfurt Kurnit Klein & Selz, PC, 9th Floor, 488 Madison Avenue, New York , NY, USA, 10022 to submit this application on behalf of the applicant. The attorney docket/reference number is 14158-0201.

The USPTO is authorized to communicate with the applicant or its representative at the following email address: erosenthal@fkkslaw.com.

A fee payment in the amount of $335 will be submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /ehr8022/ Date: 05/12/2004
Signatory's Name: Edward H. Rosenthal
Signatory's Position: Attorney

Mailing Address:
Edward H. Rosenthal
9th Floor
488 Madison Avenue
New York , NY 10022

RAM Sale Number: 350
RAM Accounting Date: 05/13/2004

Serial Number: 78417589
Internet Transmission Date: Wed May 12 17:03:49 EDT 2004
TEAS Stamp: USPTO/BAS-1607917991-2004051217034927348
6-78417589-200ebd5be149fc74b736faed221ad
b856c-DA-350-20040512170117870608

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- *Call the Trademark Assistance Center at 571.272.9250 for help on trademark matters.*
- *Send questions about USPTO programs to the USPTO Contact Center (UCC).*
- *If you have technical difficulties or problems with this application, please e-mail them to Electronic Business Support Electronic Applications or call 1 800-786-9199.*

EXHIBIT B

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

866 UNITED NATIONS PLAZA
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CORRENE S. KRISTIANSEN
JUSTIN DEABLER
CHARLES WEIGELL

June 21, 2005

VIA FEDERAL EXPRESS

Melissa Georges, Esq.
Frankfurt Kurnit Klein & Selz, PC
488 Madison Avenue
New York, NY 10022

Re: Deborah Stoller – Infringement of STITCH & BITCH CAFÉ trademark
(Our Ref: SFSE 05/07446)

Dear Ms. Georges:

We represent Sew Fast/Sew Easy, Inc. ("SFSE"). SFSE is the owner of the trademark STITCH & BITCH CAFÉ, which it has used since as early as 1999 in connection with manuals and chat rooms concerning sewing, and more recently in connection with a variety of products related to sewing. Our client has obtained a federal trademark registration for the mark STITCH & BITCH CAFÉ, U.S. Registration No. 2,596,818, for the provision of on-line chat rooms concerning sewing, as well as sewing instruction and manuals distributed in connection therewith. Our client has expended much time and effort in developing good will associated with its STITCH & BITCH CAFÉ trademark, which it will act to protect.

It has come to our client's attention that your client, Ms. Deborah Stoller, is currently using the mark STITCH 'N BITCH in connection with a website, www.bust.com, and chat rooms on that site concerning sewing, knitting, and other craft projects. As we understand it, your client began publishing knitting books using the phrase "Stitch 'n Bitch" in the title in or about September 2004. More recently, your client is now attempting to make use of the title "Stitch 'n Bitch" as a trademark for a variety of goods in services. In particular, your client is making use of the phrase on its website, in connection with services virtually identical to those for which our client has used its federally registered mark for many years.

The public is likely to be confused by your client's use of the mark STITCH 'N BITCH, which is nearly identical to our client's mark, and mistakenly conclude that your client's business is somehow connected with SFSE. Such consumer confusion is accentuated by the fact that your client uses the mark on-line in chat rooms concerning the same subject matter as our client's chat rooms, and which cater to the same national audience. Indeed, our client has strong evidence of actual confusion between SFSE and your client. This confusion should come as no surprise to you, in light of the United States Patent and Trademark Office's recent rejection of your client's four intent to use applications for the mark STITCH 'N BITCH on the grounds that a likelihood of confusion exists between your client's applied for mark and our client's prior STITCH & BITCH CAFÉ registration. Needless to say, your client's use of the STITCH 'N BITCH mark constitutes trademark infringement and unfair competition under the federal and state trademark and unfair competition laws.

Given that a protracted fight in this matter may not be to anyone's ultimate interest, our client may be willing to discuss an amicable resolution of this matter. However, that being said, we request that your client cease its proposed and/or current use of the STITCH 'N BITCH mark in connection with various products and services so as to avoid exacerbating this situation any further.

We look forward to receiving your client's response by July 1, 2005. This letter is written without prejudice to client's rights and remedies, all of which are expressly reserved.

Sincerely yours,

Georges Nahitchevansky

EXHIBIT C

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Jeffrey A. Schwab
Victor M. Tannenbaum
Peter J. Lynfield
Alan J. Hartnick
Caridad Piñeiro Scordato
Michael Aschen
Julianne Abelman
Jonathan W. Gumport
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John H. Choi

November 4, 2005

Georges Nahitchevansky, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017

WITHOUT PREJUDICE SOLELY
FOR THE PURPOSES OF
SETTLEMENT DISCUSSIONS

Re: Sew Fast/Sew Easy, Inc. v. Deborah Stoller
Our Ref. 215083

Dear Mr. Nahitchevansky:

We currently represent Deborah Stoller with respect to her use and registration of the mark STITCH 'N BITCH. This responds to your letter of June 21, 2005 to Melissa Georges alleging that Ms. Stoller's use of STITCH 'N BITCH infringes your client, Sew Fast/Sew Easy's mark STITCH & BITCH CAFE .

We enclose a copy of our Petition to Cancel your client's registration for STITCH & BITCH CAFE, based on, among other grounds, that the mark is merely descriptive of the services covered by your client's registration, and that any rights which your client may ever have held to the exclusive right to use the wording STITCH & BITCH have been abandoned through widespread third party use of this same wording on identical, or closely related services. For the same reasons, we believe your client has no right to preclude Ms. Stoller from using STITCH 'N BITCH in connection with a chat room on her www.knithappens.com website.

As we believe that the wording STITCH & BITCH will be found to be descriptive of your client's chat rooms and sewing instruction services, we further believe that your client has no basis for precluding Ms. Stoller from using or registering STITCH 'N BITCH for the products listed in Ms. Stoller's applications for this mark which were filed on May 12, 2004.

Moreover, we believe that our client's May, 2004, applications for STITCH 'N BITCH in connection with a series of books, bags and cases for knitting materials, television shows, and knitting kits preceded your client's alleged "use" of STITCH & BITCH on sewing related products such as scissors, needles, and seam guides. Thus, we ask that your client cease and desist from further use of STITCH & BITCH for all sewing or knitting related products, as we believe our client has superior rights to the mark in this context.

We share your interest in reaching an amicable settlement in this matter, however, we find that your client is misguided in the notion that she holds exclusive rights to STITCH 'N BITCH for chat rooms even though this wording has been used for decades to describe knitting and sewing circles and is widely used by third parties on the Internet. Moreover, we believe that your client's recent rush to place the mark on products by superimposing the mark on photographs of goods shown on its website is in bad faith. Our client clearly holds superior rights in this regard.

That being said, we welcome any reasonable settlement proposal which you have to offer. Absent which, we shall continue with our action to remove your client's mark from the register.

Sincerely,

Marie Anne Mastrovito

MARIE ANNE MASTROVITO

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