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

Proceeding	92052910
Party	Plaintiff Major League Softball, Inc.
Correspondence Address	MICHAEL E DOCKINS FRASER CLEMENS ET AL 28366 KENSINGTON LN PERRYSBURG, OH 43551-4163 UNITED STATES firm@fraser-ip.com
Submission	Other Motions/Papers
Filer's Name	Carrie A. Johnson
Filer's e-mail	firm@fraser-ip.com, johnson@fraser-ip.com, dockins@fraser-ip.com
Signature	/carrie a. johnson/
Date	02/04/2011
Attachments	39540 Brief in Opp to Mtn to Set Aside Judgment 2-4-11.pdf (14 pages)(574869 bytes)

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

Petitioner:	Major League Softball, Inc.	)	Cancellation No. 92052910 Registration No. 3,697,345
v.		)	Mark: WMLS WOMEN'S MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design
Registrant:	Thomas R. Adams, dba WMLS International	)	Attorney Docket: 1-39767

February 4, 2011

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

PETITIONER'S BRIEF IN OPPOSITION TO REGISTRANT'S MOTION TO SET ASIDE DEFAULT JUDGMENT

Major League Softball, Inc., ("Petitioner"), by and through its undersigned attorneys, moves the Trademark Trial and Appeal Board ("Board") to deny Registrant's Motion to Set Aside Notice of Default and Order Canceling Registration ("Registrant's Motion").

Motions to set aside or vacate a final judgment rendered by the Board are governed by FED. R. CIV. P. 60(b). *See* T.B.M.P. Rule 544. "Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances." *Id.* "When a motion for relief from judgment is made without the consent of the adverse party or parties, it must **persuasively show** (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in FED. R. CIV. P. 60(b)." *Id.,* emphasis added.

The Board should deny Registrant's Motion because the Registrant has failed to persuasively show that the relief requested is warranted.

As explained below, technically there is no basis for the Registrant's Motion because the Board properly mailed correspondence in this action directly to the Registrant. Second, the Registrant and his attorney had actual knowledge of this proceeding. Consequently, the Registrant has not been prejudiced in any way or deprived of the opportunity to defend U.S. Registration No. 3,697,345.

A. The Board Acted Properly.

The sole ground for the Registrant's Motion is that the correspondence in this proceeding has been addressed and sent directly to the Registrant, rather than the Registrant's attorney.

In accordance with Trademark Rule 2.113(c), the Board's conduct was proper. Namely, the Board properly sent correspondence directly to the owner of record for U.S. Registration No. 3,697,345. *See* 37 CFR § 2.113(c)("The Board shall forward a copy of the petition for cancellation and any exhibits with a copy of the notification to the respondent[]. The respondent shall be the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled...").

Contrary to the allegations in Registrant's Motion, the Board was not obliged to send correspondence to Mr. Morland C. Fischer, the Registrant's attorney, because Mr. Fischer did not make an appearance in this proceeding until the filing of Registrant's Motion.

Clearly, Petitioner has no grounds for the requested relief.

B. Registrant Had Actual Knowledge Of This Proceeding.

Even if the Board had committed an error – and it did not – Registrant had actual knowledge of this proceeding and was not deprived of the opportunity to participate.

The parties engaged in extensive settlement negotiations prior to the initiation of this proceeding. During the negotiations, the Registrant forwarded written correspondence to his attorney, Mr. Moreland C. Fischer. Specifically, on May 23, 2008, the Petitioner sent the Registrant a cease and desist letter warning that if a registration issued for the mark WMLS WOMEN'S MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design, Petitioner would initiate a cancellation proceeding. *See* Declaration of Michael E. Dockins ¶2. Registrant forwarded the demand letter to Mr. Fischer, who responded on behalf of his client within two weeks, on June 10, 2008. *See id.* ¶3.

As already established above, Mr. Fischer was not entitled to receive correspondence in this action. Nevertheless, it is difficult to believe that Mr. Adams failed to forward the Board's correspondence to Mr. Fischer.

The Registrant and the Petitioner did not communicate further in 2008 and 2009 because another party, Major League Baseball Properties, Inc., had filed a Notice of Opposition against U.S. Application Serial No. 78/878,045, the application that ultimately matured into the registration that is the subject of this proceeding. Major League Baseball Properties, Inc. ultimately withdrew its opposition without prejudice on September 9, 2009.

On October 20, 2009, the U.S. Patent and Trademark Office issued U.S. Registration No. 3,697,345.

On August 9 and 10, 2010, Michael E. Dockins, counsel for Petitioner, engaged in telephone discussions with Mr. Fischer. *See id.* ¶4. During these discussions, it became clear that the parties would not reach a settlement. Consequently, Mr. Dockins advised Mr. Fischer that if a settlement could not be reached, Petitioner would file a Petition for Cancellation of U.S. Registration No. 3,697,345 on August 18, 2010. *See id.* ¶4.

On August 17, 2010, Mr. Dockins called Mr. Fischer again in reference to the impending August 18, 2010 deadline. Mr. Fischer made it clear that settlement could not be achieved. *See id.* ¶5.

On August 18, 2010, the Petition for Cancellation was filed.

Both Mr. Fisher and the Registrant had actual knowledge of this proceeding. Further, as noted above, the Board properly mailed correspondence in this proceeding to the Registrant. In sum, the Registrant was afforded its opportunity to appear in this proceeding to defend its registration.

For reasons unknown to the Petitioner, the Registrant failed to file an Answer to the Petition for Cancellation. Consequently, the Board issued a Notice of Default on November 4, 2010. The Registrant was afforded 30 days to show cause as to why default judgment should not have been entered. On December 21, 2010, the Board acknowledged that the Registrant did not respond to the Notice of Default and granted the Petition to Cancel U.S. Registration No. 3,697,345.

The Registrant has failed to establish valid grounds for its request that the Board set aside the default judgment in this proceeding. Further, the Registrant has failed to show that the requested relief is warranted.

In contrast, the Petitioner respectfully submits that it will be prejudiced if the Board allows this proceeding to be reopened after the Registrant's multiple, unjustified failures to respond to legal process.

Therefore, the Petitioner requests that the Board deny Registrant's Motion.

-Signature Page to Follow-

Dated: February 4, 2011

Carrie A. Johnson
johnson@fraser-ip.com
FRASER CLEMENS MARTIN & MILLER LLP
28366 Kensington Lane
Perrysburg, Ohio 43551
(419) 874-1100

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

Petitioner:	Major League Softball, Inc.	)	Cancellation No. 92052910
		)	Registration No. 3,697,345
v.		)	Mark: WMLS WOMEN'S MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design
Registrant:	Thomas R. Adams, dba WMLS International	)	Attorney Docket: 1-39767

Declaration of Michael E. Dockins

I, Michael E. Dockins state and declare as follows:

1. I am counsel for the Petitioner, Major League Softball, Inc., in the above referenced proceeding.

2. On or about May 23, 2008, I sent correspondence to Mr. Thomas R. Adams, the owner of U.S. Application Serial No. 76/678,045 ("the '045 Application") seeking registration of the mark WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design. The letter informed Mr. Adams of the trademark rights of Major League Softball, Inc. and requested that Mr. Adams cease all use of the confusingly similar mark WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design. The letter also indicated that if the '045 Application matured to registration, Major League Softball, Inc. would file a Petition for Cancellation of the registration. A copy of the May 23, 2008 letter to Mr. Adams is attached to this declaration as Exhibit A.

3. Mr. Adams apparently forwarded our correspondence to attorney Morland C. Fischer. Mr. Fischer responded on behalf of Mr. Adams in a letter dated June 10, 2008. A copy of the June 10, 2008 letter is attached to this declaration as Exhibit B.

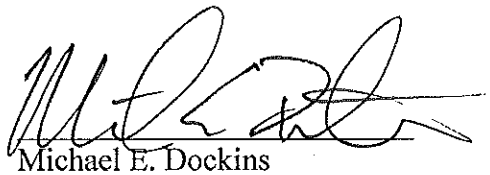
4. On or about August 9, 2010, I spoke with Mr. Fischer on the telephone regarding a potential resolution of the dispute between Major League Softball, Inc. and Mr. Adams. On August 10, 2010, I spoke with Mr. Fischer again on the phone. When it became clear that a settlement would not be reached, I advised Mr. Fischer that Major League Softball, Inc. would file a Petition for Cancellation of U.S. Registration No. 3,697,345 on August 18, 2010.

5. On or about August 17, 2010, I called Mr. Fischer to again remind him of the impending August 18, 2010 deadline. Mr. Fischer again made it clear that settlement was not possible.

6. I declare under penalty of perjury that the foregoing is true and correct.

7. Further declarant sayeth naught.

Dated this 3rd day of February, 2011.



Michael E. Dockins

Exhibit A

Law Offices Of
FRASER CLEMENS MARTIN & MILLER LLC
Intellectual Property and Technology Law

Donald R. Fraser
William J. Clemens [1]
Richard G. Martin
J. Douglas Miller

28366 Kensington Lane
Perrysburg, Ohio 43551-4163

e-mail: dockins@fraser-ip.com
Telephone: (419) 874-1100
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Michael E. Dockins [1]
Jacob M. Ward [2]
William C. Dusseau
Brenda J. Kruse

[1] Admitted in Ohio and Michigan
[2] Admitted in Michigan only
[3] Admitted in Ohio and Indiana

May 23, 2008

Womens Major League Softball International
Attn: Mr. Thomas R. Adams
5858 Engineer Drive
Huntington Beach, CA 92649

Via Certified Mail
Return Receipt Requested

Re: Infringement – U.S. Trademarks of Major League Softball, Inc.
MAJOR LEAGUE SOFTBALL
MLS MAJOR LEAGUE SOFTBALL and Design
(1-39540)

Dear Mr. Adams:

Our office represents Major League Softball, Inc., located in Burbank, California, in connection with certain legal matters including trademarks.

Major League Softball, Inc. recently learned that Womens Major League Softball International ("WMLS") has filed U.S. Trademark Application Ser. No. 76/678,045 seeking registration of the mark WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design. The application states that WMLS has been using the mark in connection with organizing and scheduling services in the field of women's fast pitch softball since January, 2006.

The mark WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL is confusingly similar to trademarks owned and used by Major League Softball, Inc., namely MAJOR LEAGUE SOFTBALL and MLS MAJOR LEAGUE SOFTBALL and Design. These trademarks have been in continuous use in commerce in California and elsewhere since at least as early as 1986. The marks are the subject of pending U.S. Trademark Application Serial Numbers 77/372,368 and 77/372,446, respectively. Accordingly, the marks have been used for twenty-two years by Major League Softball, Inc. in connection with services that are identical, or closely related, to the more recent services of WMLS.

Considerable time, effort, and financial resources have been invested by Major League Softball, Inc. in developing and promoting its MAJOR LEAGUE SOFTBALL and MLS MAJOR LEAGUE SOFTBALL and Design trademarks. The marks have developed substantial good will and secondary meaning as a result of their long use and promotion.

It is the purpose of this letter to inform you of the trademark rights of Major League Softball, Inc. and to request that you immediately cease all use of the confusingly similar mark WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL. The use of the complained-of mark is a violation of United States trademark law.

Federal trademark law protects the owners of trademarks from trademark infringement, trademark dilution, and unfair trade practices. Trademark infringement occurs when a person uses any reproduction, counterfeit, copy, or colorable imitation of a mark in connection with the sale or advertising of goods or services where such use is likely to cause confusion, or to cause mistake, or to deceive. Upon the determination of trademark infringement, the Court may grant injunctive relief and award damages based on defendant's profits, plaintiff's losses, or both. Trademark rights in a particular mark are based on use of the trademark in commerce. The individual or entity that is first to use a mark in commerce gains superior rights over all junior users of the mark. Major League Softball, Inc. has been using its marks since 1986, which is nearly twenty years prior to the first use of the WMLS mark.

Furthermore, under U.S. trademark law, trademark owners are required to police the use of their marks and other marks that are identical to, or confusingly similar with, the owner's mark. As a result, if the WMLS trademark is approved for registration by the U.S. Patent and Trademark Office, Major League Softball, Inc. will have no choice but to file a Petition for Cancellation of the WMLS registration.

A review of the prosecution history of the WMLS application disclosed that Major League Baseball Properties ("MLBP") has filed two extensions of time to oppose the registration of the WMLS mark. WMLS may be faced with substantial costs associated with defending its application against an opposition by MLB. Even if WMLS is successful against Major League Baseball Properties, WMLS will then be faced with defending the registration against Major League Softball, Inc.'s substantial prior use and rights. Given the potential costs of defending the application, only to be followed by defending the registration if it should issue, we hope that WMLS will decide to abandon its current application and adopt a new mark.

It is not in the best interests of either group to use similar marks for identical services. We have not requested an accounting for profits at this point but reserve the right to do so should that become necessary. We would appreciate receiving your written assurances within two (2) weeks of the date of this letter that you will respect the legal rights of Major League Softball, Inc. by expressly abandoning U.S. Trademark Application Ser. No. 76/678,045 for WMLS WOMENS MAJOR LEAGUE SOFTBALL INTERNATIONAL and Design and ceasing further use of the mark.

Sincerely,

FRASER CLEMENS MARTIN & MILLER LLC

Michael E. Dockins

MED/jlh

c. Major League Softball, Inc.
Richard G. Martin, Esq.

Exhibit B

JUN 13 2008
BY:

Law Offices of Morland C. Fischer

Patent, Trademark and
Copyright Matters

2030 Main Street, Suite 1300
Irvine, California 92614
Telephone: (949) 476-0600
Facsimile: (949) 476-0606
morlandf@earthlink.net

June 10, 2008

Michael E. Dockins, Esq.
Frasier, Clemmons, Martin & Miller
28366 Kensington Lane
Perrysburg, OH 43551-4163

Re: Federal Service Mark Application No. 76/678,045
for the mark "WMLS WOMEN'S MAJOR LEAGUE
SOFTBALL INTERNATIONAL," by Thomas R. Adams,
Your file: 1-39540; My file: TIO-53

Dear Mr. Dockins:

My office is intellectual property counsel to Thomas R. Adams who is the applicant in the above-identified pending federal service mark application. In fact, my office filed this application on behalf of Mr. Adams. Your letter dated May 23, 2008 requested that my client cease using his pending service mark because it "is a violation of United States Trademark Law." Mr. Adams has asked that I reply to your aforementioned letter.

In this regard, be advised that we disagree with your opinion that Mr. Adams' current and continued use of his service mark constitutes a violation of United States Trademark Law. To this end, my client will not abandon his pending application or discontinue using his service mark which is the subject thereof. In particular, we are hopeful that ongoing negotiations with Major League Baseball will be successful and that Mr. Adams will ultimately be granted a federal service mark registration to promote his women's fast-pitch softball events.

As you should know, the designations MAJOR LEAGUE and SOFTBALL are highly descriptive terms. A search of the records of the Patent and Trademark Office would immediately reveal to you that applications for registration (including those filed by Major League Baseball and Thomas R. Adams) were met with requirements to disclaim the exclusive right to use "Major League" apart from the respective marks as a whole. In the present case, the distinctive portion of Mr. Adams' service mark is his fanciful design (i.e., logo) and the acronym WMLS.

Despite any long use by Major League Softball, Inc. of the marks identified in its Application Nos. 77/372,368 and 77/372,446, the reality exists that the designation "Major League Softball" taken as a whole is highly descriptive when applied to organizing a softball league. It may be that because of this descriptive characteristic, Major League Softball, Inc. will be unable to obtain the exclusive right to use the designation "Major League Softball" and, correspondingly, will be unable to prevent Thomas R. Adams from continuing to use an identical descriptive designation. In fact, the expression "Major League Softball" may be incapable of becoming distinctive of your client's services in commerce regardless of its prior use and goodwill, because your client may not be able to prove its substantial exclusive use of the mark for the past five years. Not every descriptive mark is entitled to be registered on the Principal Register on the basis of acquired distinctiveness simply because of long use.

I agree with your observation that it is not in the best interests of our respective clients to be using similar marks for similar services. Nevertheless, and barring some settlement between the parties, my client, Thomas R. Adams, has no intention of abandoning his pending service mark application (which has already been indicated by the PTO to be in condition for registration) or discontinuing his lawful use of the mark WMLS WOMEN'S MAJOR LEAGE SOFTBALL INTERNATIONAL (plus design) to promote his women's fast-pitch softball competition. Please direct any further communications concerning this matter to my office.

Very truly yours,

Morland C. Fischer

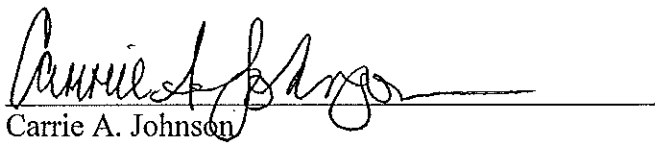
MCF:paf

cc: Thomas R. Adams

CERTIFICATE OF SERVICE

I hereby certify that on February 4, 2011, I served a true and correct copy of the foregoing Petitioner's Brief in Opposition to Registrant's Motion to Set Aside Default Judgment by depositing the same in the United States Mail, with proper First Class postage, addressed to the following:

Morland C. Fischer
2030 Main Street, Suite 1300
Irvine, CA 92614



Carrie A. Johnson
Attorney for Petitioner
FRASER CLEMENS MARTIN & MILLER LLP