

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

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Mailed: February 3, 2012

Cancellation No. 92054111

OTTO International, Inc.

v.

Otto Carius

Before Quinn, Holtzman and Ritchie,
Administrative Trademark Judges.

By the Board:

Otto Carius ("respondent") owns a registration for the mark OTTO CARIUS (stylized font) for various goods in International Classes 9, 16, 25, 26 and 28.

Otto International, Inc. ("petitioner") filed a petition to cancel said registration only as to International Class 25 for goods identified as follows:

articles of clothing, namely, pants, shirts, T-shirts, jackets, coats, uniforms, jumpsuits, skirts, blouses, pullovers, sweaters, socks, sweatshirts, and undergarments; footwear; and headgear, namely, hats and caps.

Petitioner asserts as grounds 1) priority and likelihood of confusion pursuant to Trademark Act § 2(d), and 2) that respondent did not have a bona fide intent to use the mark in

commerce as of the filing date of its Request for Extension of Protection, and pleads ownership of:

- 1) three registrations for the mark OTTO (standard characters) for "online wholesale services for headwears (sic)," "clothing, namely, caps, hats and sunvisors," and "online wholesale store, outlet and distributorship services for clothing, luggage, bags, sporting goods;" and
- 2) two registrations for the mark OTTO and design (shown below) for "clothing, namely, caps, hats and sunvisors," and "handbags, sport bags, fanny packs, and luggages (sic)."



In its answer, respondent set forth the following voluntary amendment as an affirmative defense:

Pursuant to 15 U.S.C. § 1068, 37 C.F.R. § 2.133, and TBMP 311.02(b) and by motion filed concurrently herewith, Registrant moves to restrict Registration 3,696,048 to remove all International Class 25 goods presently specified therein. With the proposed modification, there is no likelihood that Registrant's mark is confusingly similar to any of Petitioner's marks asserted herein. In addition, Registrant is not presently using Registration 3696048 on any goods to be excluded by the proposed restriction. Thus, Petitioner's allegation that it will be damaged by the existence of Registration 3696048 is without any basis in fact and the present cancellation petition is rendered moot.

In a concurrently-filed motion to restrict its registration and to dismiss the petition to cancel "with prejudice as moot" (motion, unnumbered p. 2),¹ respondent proposes to restrict its registration to delete all of the International Class 25 goods identified therein. It asserts that the proposed restriction "will avoid any likelihood of confusion between Registrant's mark and the marks asserted by Petitioner," and that "[R]egistrant is not presently using the mark on the goods or services being excluded from the registration" (respondent's motion, unnumbered p. 2).

In response, petitioner states that it does not contest the motion to restrict, but asserts that it does not consent to dismissal with prejudice as moot. Petitioner requests dismissal *without prejudice* as moot, asserting that it should not be prejudiced from filing any future inter partes proceedings in the event that respondent, at a later date, seeks to register the mark OTTO CARIUS "for related goods in International Class 025 should Petitioner decide to expand its goods in this area with respect to such related goods" (petitioner's brief, p. 1-2).

Inasmuch as respondent's proposed restriction constitutes an amendment to a registration subject to cancellation, and inasmuch as petitioner, in its brief, provides its consent to

¹ All motions and briefs submitted to the Board must be numbered, as required by Trademark Rule 2.126(a)(5).

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the amendment, respondent has complied with Trademark Rule 2.133(a).

Accordingly, respondent's motion to amend its registration is granted.

With respect to the issue of the manner of disposition of this proceeding, TBMP §602.02(a) (3d ed. 2011) provides that, in a cancellation proceeding against any registration having multiple classes, if respondent files a request to amend its registration to delete an entire class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by Trademark Rule 2.134(a); if the voluntary cancellation of the registration as to that class is filed with the written consent of petitioner, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled as to that class.

In view thereof, this proceeding is dismissed without prejudice, and a Commissioner's Order cancelling Registration No. 3696048 as to International Class 25 will issue in due course. See TBMP § 514.01 (3d ed. 2011). Furthermore, this Office will notify the International Bureau of the cancellation of said registration as to International Class 25 in due course. See TMEP § 1904.13(a).