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

Proceeding	92059244
Party	Defendant Newman
Correspondence Address	JULIE B SEYLER ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017 UNITED STATES jseyler@lawabel.com
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Signature	/aimeemallen/
Date	04/29/2015
Attachments	NEWMAN - Cancellation No 92059244 - Respondent's Reply on Motion to Re-open.pdf(637749 bytes)

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

In re Registration No. 4284412

Garan Services Corp.

Petitioner,

v.

Newman,

Respondent.

Cancellation No. 92059244

**RESPONDENT'S REPLY ON MOTION TO REOPEN THE TERM
TO RESPOND TO SERVICE BY PUBLICATION**

Respondent hereby replies to Petitioner's Response to its Motion to Reopen the Term in the above-captioned matter.

Respondent reiterates that excusable neglect exists for reopening the term for the reasons set forth in the Motion and shall first address the mischaracterizations set forth in Petitioner's Response.

**I. Respondent Became Aware of
this Proceeding On March 17, 2015**

Petitioner assumes that Respondent had actual knowledge that a Petition to Cancel was filed on May 14, 2014 and voluntarily opted to ignore the proceeding until the day it filed its Motion to Reopen. Petitioner's conclusion is predicated on a number of mistaken assumptions such as the Board's order was physically delivered because "[t]here is nothing in the record which indicates that the notification of Exhibit A was returned as undeliverable".

However, because the records on the PTO database reflect a mailing address is not conclusive proof that the document was mailed or that it was received; and in this case, it was not. As indicated in its motion, Respondent never received any such notice. Attached hereto as Exhibit A is the Declaration of Catherine Clavereau, attesting to Respondent's failure to ever receive the petition, ¶¶ 3-5. Thus Petitioner's statement in its response that "Registrant does not deny that it received the Board's May 23, 2014 notification of the filing the petition [sic] and institution of the proceeding" is false. Registrant Respondent does deny that it received this notification.

Petitioner similarly asserts that "Registrant does not deny that it was aware of the service by publication within the thirty day period ending March 12, 2015." But Registrant Respondent does hereby deny receipt of and any knowledge the petition to cancel in this proceeding. See Clavereau Decl. ¶¶ 3-5.

Furthermore, in its Motion, Respondent's counsel asserted that she was made aware of this proceeding on Tuesday March 17, 2015 because she became aware of the issuance of Notices of Default with respect to other cancellation petitions filed by Petitioner. A Declaration detailing the facts of how and when Respondent's Counsel learned of this proceeding is attached as Exhibit B.

Under the circumstances, Respondent's failure to file an Answer is due to excusable neglect and not a willful nor deliberate attempt to delay or subvert the proceedings. The time to respond to the Petition to Cancel should be reopened.

II. The Pioneer Factors Favor a Finding of Excusable Neglect

The declaration now on record in this motion establishes that the *Pioneer* factors weigh in favor of finding excusable neglect in this matter such that Respondent's time to answer should be reopened.

A. Equity Dictates That the Term Be Reopened

Under *Pioneer*, the determination with regard to excusable neglect is "an equitable one, taking account of all relevant circumstances surrounding the party's omission". *Pioneer*, 507 U.S. at 395.

Furthermore, it is well-established that a trial on the merits is favored over a default judgment and in circumstances such as these, cases should be resolved in favor of the party seeking to set aside a default judgment. *Information Sys. and Networks Corp. v. United States*, 994 F.2d 792, 795 (Fed. Cir. 1993).

Here, only through inadvertence, mistake, and excusable neglect, Respondent has not responded to a petition to cancel that it never received. Equity clearly supports allowing Respondent an opportunity to defend its rights in a trial of the merits given these facts. Any other outcome would not be equitably decided, but rather would possibly deprive Respondent of its trademark rights without an examination of the law.

B. Petitioner Will Not Be Prejudiced

Petitioner makes the summary and suspect assertion that the delay in this proceeding "has prejudiced Petitioner by being prevented from moving forward with its commercial plans to use the mark of the registration at issue." However, we note that the Registration at issue predates any claims Petitioner has, so no matter what Petitioner's plans, it would have been blocked and delayed by Respondent's rights, even absent this

proceeding. Petitioner has thus not been prejudiced by any delay here. In any case, delay alone is insufficient basis to establish prejudice to Petitioner. *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (“delay alone is not a sufficient bases for establishing prejudice”).

Additionally, Respondent notes that in the Petition as originally filed in this matter, Petitioner never asserted how it was being damaged, and absent specific allegation of damage or standing, Petitioner is a mere interloper and there can be no prejudice.¹

**C. The Length of the Delay Will Not
Have a Significant Impact on Judicial Proceedings**

Respondent responded in this matter on March 23, 2015, only eleven days after the March 12, 2015 deadline to respond to the notice by publication, by moving to reopen its time to answer. Respondent did this *as soon as it became aware* of the cancellation. This mere eleven days of delay, coupled with the absence of any claimed damage by Petitioner, clearly cannot have a significant impact on proceedings.

**D. The Reasons For the Delay
Were Not Within Respondent’s Control**

The delay in responding was not due to anything within Respondent’s control. Rather it was the negligence on the part of Petitioner for failure to make effective service on Petitioner², followed by mail that apparently was misplaced or lost between the Trademark Office and the undersigned’s address. It would not be in the interests of equity to prejudice Respondent with a loss of its trademark rights conferred by

¹ Petitioner’s original petition in this matter was filed on May 21, 2014. It contained no specific allegation that Petitioner had any real legitimate interest in the mark at issue. .

² The official records show that the undersigned was identified as Respondent’s attorney of record, and certainly had Petitioner sought in good faith to make proper service it would have served a courtesy copy on Respondent’s U.S. Counsel. It did not.

registration when it never had notice of the proceeding.

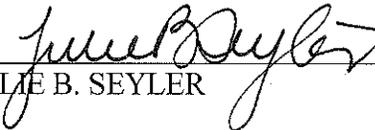
E. Respondent's Good Faith Cannot Be Questioned

Petitioner states, baselessly and erroneously that "Registrant ignored the Board's institutional order mailed to its correct address." But this is a baldly incorrect and unsupported falsehood. Registrant ignored nothing. Rather, as soon as Registrant had actual knowledge of these proceedings instructions were issued to make an appearance, as established by Exhibit A, the Clavereau Declaration.

For all the reasons set forth herein, Respondent respectfully requests that the Board grant this motion to reopen..

Dated: April 29, 2015

Respectfully submitted,



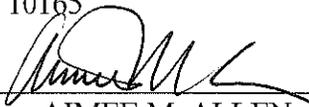
JULIE B. SEYLER

ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served by first class mail, postage prepaid this 29th day of April, 2015 upon the following:

Robert L. Epstein
Epstein Drangel LLP
60 East 42nd Street, Suite 2410
New York, NY 10165



AIMEE M. ALLEN

Exhibit A

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

Garan Services Corp.

Petitioner,

v.

NEWMAN,

Respondent.

Cancellation No. 92059244

**DECLARATION OF CATHERINE CLAVEREAU
IN SUPPORT OF RESPONDENT'S MOTION TO REOPEN
THE TERM TO RESPOND TO SERVICE BY PUBLICATION**

I, Catherine CLAVEREAU, hereby declare that I have personal knowledge of all the facts set forth herein relating to the matter captioned above:

1. I am currently employed as a Legal Assistant at NEWMAN with an office address at 25-27 rue du Mail, F-75002 Paris, France business.
2. I have been employed at NEWMAN June 19, 2000.
3. On behalf of NEWMAN, and to the best of my personal knowledge and good faith, I state that the company never received the attached communication from the United States Patent and Trademark Office dated May 23, 2014.
4. It is the regular business practice at NEWMAN to open and distribute all mail the day it is received. Legal notices received by postal delivery to our offices are forwarded to our legal counsel who represents us in matters related to intellectual property.
5. To my knowledge, no legal notice regarding the matter captioned above was ever received at NEWMAN. Neither myself, nor my colleagues to whom I showed the attached document, are familiar with or have ever seen it.

6. I became aware of the existence of the cancellation action filed by GARAN SERVICES CORP. against our US trademark registration No. 4 284 412 on March 19, 2015 when our attorney informed me of it by e-mail and simultaneously advised that it was urgent that we make an appearance in this matter as soon as possible.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge.



By: Catherine CLAVEREAU

Date: April 21, 2015

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

Mailed: May 23, 2014

Cancellation No. 92059244
Registration No. 4284412

NEWMAN
25-27 RUE DU MAIL
F-75002 PARIS FRANCE

Garan Services Corp.

v.

Newman

ROBERT L EPSTEIN
EPSTEIN DRANGEL LLP
60 EAST 42ND STREET
SUITE 2410
NEW YORK NY 10165 UNITED STATES

Lalita Greer, Paralegal Specialist:

A petition to cancel the above-identified registration, as to Class 25 only, has been filed. A service copy of the petition for cancellation was forwarded to registrant (defendant) by the petitioner (plaintiff). An electronic version of the petition for cancellation is viewable in the electronic file for this proceeding via the Board's TTABVUE system: <http://ttabvue.uspto.gov/ttabvue/>.

The Board acknowledges that petitioner included proof that it forwarded a service copy of its petition to registrant. Specifically, the proof of service indicates that petitioner sent that service copy to an address that apparently petitioner has reason to believe is the current address for the registrant, however it is not of record with this Office. As provided in amended Trademark Rule 2.111(a), a petitioner must include "proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record of the Office." The reference in the rule to correspondence address is a reference to the address for the owner of the registration or the domestic representative, if one has been appointed. A courtesy copy may be sent to an address that the petitioner has reason to believe is current, but does not substitute for service on the registrant at the address on record with the USPTO.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations ("Trademark Rules"). These rules may be viewed at the

Cancellation No. 92059244

USPTO's trademarks page: <http://www.uspto.gov/trademarks/index.jsp>. The Board's main webpage (<http://www.uspto.gov/trademarks/process/appcal/index.jsp>) includes proceedings, on Amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

Plaintiff must notify the Board when service has been ineffective, within 10 days of the date of receipt of a returned service copy or the date on which plaintiff learns that service has been ineffective. Plaintiff has no subsequent duty to investigate the defendant's whereabouts, but if plaintiff by its own voluntary investigation or through any other means discovers a newer correspondence address for the defendant, then such address must be provided to the Board. Likewise, if by voluntary investigation or other means the plaintiff discovers information indicating that a different party may have an interest in defending the case; such information must be provided to the Board. The Board will then effect service, by publication in the Official Gazette if necessary. See Trademark Rule 2.118. In circumstances involving ineffective service or return of defendant's copy of the Board's institution order, the Board may issue an order noting the proper defendant and address to be used for serving that party.

Defendant's ANSWER IS DUE FORTY DAYS after the mailing date of this order. (See Patent and Trademark Rule 1.7 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) Other deadlines the parties must docket or calendar are either set forth below (if you are reading a mailed paper copy of this order) or are included in the electronic copy of this institution order viewable in the Board's TTABVUE system at the following web address: <http://ttabvue.uspto.gov/ttabvue/>.

Defendant's answer and any other filing made by any party must include proof of service. See Trademark Rule 2.119. If they agree to, the parties may utilize electronic means, e.g., e-mail or fax, during the proceeding for forwarding of service copies. See Trademark Rule 2.119(b)(6).

The parties also are referred in particular to Trademark Rule 2.126, which pertains to the form of submissions. Paper submissions, including but not limited to exhibits and transcripts of depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Time to Answer	7/2/2014
Deadline for Discovery Conference	8/1/2014
Discovery Opens	8/1/2014
Initial Disclosures Due	8/31/2014
Expert Disclosures Due	12/29/2014
Discovery Closes	1/28/2015
Plaintiff's Pretrial Disclosures	3/14/2015
Plaintiff's 30-day Trial Period Ends	4/28/2015
Defendant's Pretrial Disclosures	5/13/2015
Defendant's 30-day Trial Period Ends	6/27/2015
Plaintiff's Rebuttal Disclosures	7/12/2015
Plaintiff's 15-day Rebuttal Period Ends	8/11/2015

As noted in the schedule of dates for this case, the parties are required to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case. See Trademark Rule 2.120(a)(2). Discussion of the first two of these three subjects should include a discussion of whether the parties wish to seek mediation, arbitration or some other means for resolving their dispute. Discussion of the third subject should include a discussion of whether the Board's Accelerated Case Resolution (ACR) process may be a more efficient and economical means of trying the involved claims and defenses. Information on the ACR process is available at the Board's main webpage. Finally, if the parties choose to proceed with the disclosure, discovery and trial procedures that govern this case and which are set out in the Trademark Rules and Federal Rules of Civil Procedure, then they must discuss whether to alter or amend any such procedures, and whether to alter or amend the Standard Protective Order (further discussed below). Discussion of alterations or amendments of otherwise prescribed procedures can include discussion of limitations on disclosures or discovery, willingness to enter into stipulations of fact, and willingness to enter into stipulations regarding more efficient options for introducing at trial information or material obtained through disclosures or discovery.

The parties are required to conference in person, by telephone, or by any other means on which they may agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference, upon request of any party, provided that such participation is requested no later than ten (10) days prior to the deadline for the conference. See Trademark Rule 2.120(a)(2). The request for Board participation must be made through the Electronic System for Trademark Trials and Appeals (ESTTA) or by telephone call to the interlocutory attorney assigned to the case, whose name can be found by referencing the TTABVue record for this case at <http://ttabvue.uspto.gov/ttabvue/>. The parties should contact the assigned interlocutory attorney or file a request for Board participation through ESTTA only after the parties have agreed on possible dates and times for their conference. Subsequent participation of a Board attorney or judge in the conference will be by telephone and the parties shall place the call at the agreed date and time, in the

Cancellation No. 92059244

absence of other arrangements made with the assigned interlocutory attorney.

The Board's Standard Protective Order is applicable to this case, but the parties may agree to supplement that standard order or substitute a protective agreement of their choosing, subject to approval by the Board. The standard order is available for viewing at:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. Any party without access to the web may request a hard copy of the standard order from the Board. The standard order does not automatically protect a party's confidential information and its provisions must be utilized as needed by the parties. See Trademark Rule 2.116(g).

Information about the discovery phase of the Board proceeding is available in chapter 400 of the TBMP. By virtue of amendments to the Trademark Rules effective November 1, 2007, the initial disclosures and expert disclosures scheduled during the discovery phase are required only in cases commenced on or after that date. The TBMP has not yet been amended to include information on these disclosures and the parties are referred to the August 1, 2007 Notice of Final Rulemaking (72 Fed. Reg. 42242) posted on the Board's webpage. The deadlines for pretrial disclosures included in the trial phase of the schedule for this case also resulted from the referenced amendments to the Trademark Rules, and also are discussed in the Notice of Final Rulemaking.

The parties must note that the Board allows them to utilize telephone conferences to discuss or resolve a wide range of interlocutory matters that may arise during this case. In addition, the assigned interlocutory attorney has discretion to require the parties to participate in a telephone conference to resolve matters of concern to the Board. See TBMP § 502.06(a) (2d ed. rev. 2004).

The TBMP includes information on the introduction of evidence during the trial phase of the case, including by notice of reliance and by taking of testimony from witnesses. See TBMP §§ 703 and 704. Any notice of reliance must be filed during the filing party's assigned testimony period, with a copy served on all other parties. Any testimony of a witness must be both noticed and taken during the party's testimony period. A party that has taken testimony must serve on any adverse party a copy of the transcript of such testimony, together with copies of any exhibits introduced during the testimony, within thirty (30) days after the completion of the testimony deposition. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.

If the parties to this proceeding are (or during the pendency of this proceeding become) parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately, so that the Board can consider whether consolidation or suspension of proceedings is appropriate.

ESTTA NOTE: For faster handling of all papers the parties need to file with the Board, the Board strongly encourages use of electronic filing

Cancellation No. 92059244

through the Electronic System for Trademark Trials and Appeals (ESTTA). Various electronic filing forms, some of which may be used as is, and others which may require attachments, are available at <http://estta.uspto.gov>.

Exhibit B

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

In Re Registration No. 4,284,412

Garan Services Corp. <p style="text-align: center;"><i>Petitioner,</i></p> <p style="text-align: center;">v.</p> <p>Newman,</p> <p style="text-align: center;"><i>Respondent.</i></p>

Cancellation No. 92059244

Declaration of Julie B. Seyler in Support of Respondent’s Motion to Reopen the Term

I, Julie B. Seyler, hereby declare as follows:

1. I am a partner at the law firm of Abelman Frayne & Schwab and have personal knowledge of the facts stated herein.
2. On March 20, 2015, Respondent appointed the law firm of Abelman Frayne & Schwab as its Domestic Representative in proceedings before the Trademark Office.
3. The chart below reflects the online records at the Trademark Trial and Appeal Board in connection with the above identified cancellation and the date.

Prosecution History	Date
Service by Publication	2/10/2015
Suspension	12/08/2014
Plaintiff’s Notice of Ineffective Service	08/11/2014
Notice of Default	07/19/2014
Institution Order	05/23/2014
Pending, Instituted	05/21/2014

4. The undersigned never received any of the documents and only became aware of the existence of said documents on March 17, 2015 because of research related to the status of two other cancellations involving the same parties wherein the Trademark Office had issued Notices of Default.
5. As soon as I became aware of the above-identified proceeding, Respondent was notified and instructions were received to file a Motion to Reopen.
6. To the best of my knowledge Respondent's delay in responding to the Petition to Cancel was not due to negligence or willful misconduct but a result of improper service by Petitioner and mail that apparently was misplaced or lost between the Trademark Office and the Respondent.
7. Because Petitioner failed to serve a courtesy copy of the Petition on me, despite the fact that I was identified in the Trademark Office database as Registrant's attorney, I never had knowledge of the cancellation until March 17, 2015.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge.

By: Julie Seyler
Julie B. Seyler

Date: 29 April 2015

Abelman Frayne & Schwab
666 Third Avenue
New York, New York 10017
212-949-9022