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

Proceeding	92063839
Party	Defendant Parasole IP, LLC
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Signature	/Larrin Bergman/
Date	09/06/2016
Attachments	2016-09-06 Registrant Reply Brief P509-028001.pdf(35900 bytes ) 2016-09-06 Exhibit 1 P509-028001.pdf(12392 bytes )

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

<p><b>MOZZA, LLC,</b></p> <p style="text-align:right">Petitioner,</p> <p style="text-align:center">v.</p> <p><b>PARASOLE IP, LLC</b></p> <p style="text-align:right">Registrant.</p>	<p>Registration No.: 3,975,466</p> <p style="text-align:center">Mark: MOZZA MIA</p> <p>Cancellation No.: 92063839</p>
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**REGISTRANT’S REPLY BRIEF TO OPPOSE THE MOTION FOR LEAVE TO FILE**

**AMENDED PETITION FOR CANCELLATION**

Registrant submits this reply brief to oppose Petitioner’s Motion for Leave to File Amended Petition for Cancellation.

**Background/Facts:**

Petitioner filed the Petition for Cancellation on June 6, 2016. On June 7, 2016, the Registrant filed a combined Section 8 and 15 affidavit with respect to registration no. 3975466. Although filed on June 6, 2016, the Cancellation proceeding did not appear in the TTAB filing as of the time of filing of the Section 15 affidavit. As a result, the registrant inadvertently included the incorrect statement associated with the Section 15 affidavit regarding related proceedings. The Registrant requested that the Section 8 and 15 affidavit be abandoned pursuant to 37 C.F.R.

§2.146(a)(3) and 37 C.F.R. §2.167(j) in a Petition to the Trademark Office filed on August 29, 2016.

**Argument/Law:**

Registrant notes that Petitioner is correct that the Petition to Cancel was filed on June 6, 2016, and that the Registrant did file Section 8 and 15 affidavits on June 7, 2016. Although filed on June 6, 2016, the cancellation proceeding did not appear in the TTAB filing as of the time of filing of the Section 15 affidavit. As a result, the registrant inadvertently included the incorrect statement associated with the Section 15 affidavit.

Registrant has filed a petition to abandon the defective declaration, and the Section 8 and 15 affidavit in its entirety. The Registrant notes that the correction of an incorrect statement made in a declaration demonstrates the absence of any intent to deceive the Patent and Trademark Office. See *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009) (noting that in trademark fraud cases, as in other fraud cases, the standard for finding intent to deceive is stricter than the standard for negligence or gross negligence; and that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the **intent** to deceive the USPTO, and a party challenging a registration must prove fraud by clear and convincing evidence.); *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899 (TTAB 2006) (stating that fraud occurs when a registrant knowingly makes false, material misrepresentations of fact; if there was a reasonable or legitimate basis for the representations, the registrant has not committed fraud).

In this matter, the timing of the petition allowed for an errant filing by Registrant. Upon checking TTAB and TSDR prior to the filing of the Section 8 and 15 affidavit on June 7, no

proceeding was noted, and thus the affidavit was filed. Registrant is addressing the errant filing, and has requested that the Section 8 and 15 affidavit be abandoned pursuant to 37 C.F.R. §2.146(a)(3) and 37 C.F.R. §2.167(j) in a Petition to the Trademark Office filed on August 29, 2016. See **Exhibit 1**. The filing of Exhibit 1 negates any intent to deceive the Trademark Office. As such, the Motion for Leave should be denied.

As further proof of the lack of intent to deceive, Registrant has requested that the Board find the Mark at issue to “be deemed to have incontestable status pursuant to 15 U.S.C. §§1065 and 1115.” Registrant, through the answer, was presuming that the Board would make the determination of incontestability, and not the errant filing. This again shows a lack of intent to deceive required for a finding of fraud.

Dated September 6, 2016

Respectfully submitted,

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**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that on September 6, 2016, a copy of the foregoing **REGISTRANT'S REPLY BRIEF TO OPPOSE THE MOTION FOR LEAVE TO FILE AMENDED PETITION FOR CANCELLATION**, with **EXHIBIT 1**, is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at <http://esta.uspto.gov/>.

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*Attorneys for Registrant Parasole IP, LLC*

**CERTIFICATE OF SERVICE**

I hereby certify that on September 6, 2016 copies of the foregoing **REGISTRANT'S REPLY BRIEF TO OPPOSE THE MOTION FOR LEAVE TO FILE AMENDED PETITION FOR CANCELLATION**, with **EXHIBIT 1**, has been served upon Petitioner, addressed as follows:

Via electronic delivery (pursuant to agreement)

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## 2.146 Petition to the Director

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	77935634
<b>REGISTRATION NUMBER</b>	3975466
<b>MARK SECTION</b>	
<b>MARK</b>	http://tmng-al.uspto.gov/resting2/api/img/77935634/large
<b>LITERAL ELEMENT</b>	MOZZA MIA
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>FORM TEXT</b>	
<p>On June 7, 2016, the Registrant filed a combined Section 8 and 15 affidavit with respect to registration no. 3975466. The Registrant hereby requests that the Section 8 and 15 affidavit be <u>abandoned</u> pursuant to <a href="#">37 C.F.R. §2.146(a)(3)</a>, <a href="#">37 C.F.R. §2.167(j)</a>; see <a href="#">TMEP §§1605.03, 1704, 1707</a>..</p> <p>It has come to the attention of the Registrant that the declaration submitted as required by the Section 15 Affidavit was incorrect, because a cancellation action with respect to the registration is currently pending before the Trademark Trial and Appeals Board filed one day prior to the date of the Section 15 filing, Although filed on June 6, 2016, the cancellation proceeding did not appear in the TABB filing as of the time of filing of the Section 15 affidavit. As a result, the registrant inadvertently included the incorrect statement associated with the Section 15 affidavit.</p> <p>The Registrant notes that the Section 8 and 15 affidavit has been examined by the Patent and Trademark Office post-registration section. Accordingly, Registrant is filing this petition to abandon the defective declaration and the Section 8 and 15 affidavit in its entirety. The Registrant notes that the correction of an incorrect statement made in a declaration has been held to demonstrate the absence of any intent to deceive the Patent and Trademark Office.</p>	
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>FEE PER CLASS</b>	100
<b>TOTAL FEES DUE</b>	100
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
<b>SUBMISSION SIGNATURE</b>	/Jennifer Forbes/
<b>SIGNATORY'S NAME</b>	Jennifer A. Forbes
<b>SIGNATORY'S POSITION</b>	Attorney of Record Minnesota Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	612-373-8558

<b>DATE SIGNED</b>	08/29/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Aug 29 10:28:59 EDT 2016
<b>TEAS STAMP</b>	USPTO/PDR-XX.XXX.XX.XX-20 160829102859824873-397546 6-20160829095347218312-DA -8809-2016082909534721831 2

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PTO Form No Form Number (Rev 01/2012)

OMB No. 0651-0054 (Exp 10/31/2017)

## 2.146 Petition to the Director

### To the Commissioner for Trademarks:

The following is submitted for registration number. **3975466**

#### FORM INFORMATION

On June 7, 2016, the Registrant filed a combined Section 8 and 15 affidavit with respect to registration no. 3975466. The Registrant hereby requests that the Section 8 and 15 affidavit be abandoned pursuant to [37 C.F.R. §2.146\(a\)\(3\)](#). [37 C.F.R. §2.167\(j\)](#); see [TMEP §§1605.03, 1704, 1707](#).

It has come to the attention of the Registrant that the declaration submitted as required by the Section 15 Affidavit was incorrect, because a cancellation action with respect to the registration is currently pending before the Trademark Trial and Appeals Board filed one day prior to the date of the Section 15 filing. Although filed on June 6, 2016, the cancellation proceeding did not appear in the TABB filing as of the time of filing of the Section 15 affidavit. As a result, the registrant inadvertently included the incorrect statement associated with the Section 15 affidavit.

The Registrant notes that the Section 8 and 15 affidavit has been examined by the Patent and Trademark Office post-registration section. Accordingly, Registrant is filing this petition to abandon the defective declaration and the Section 8 and 15 affidavit in its entirety. The Registrant notes that the correction of an incorrect statement made in a declaration has been held to demonstrate the absence of any intent to deceive the Patent and Trademark Office.

#### FEE(S)

Fee(s) in the amount of \$100 is being submitted.

#### SIGNATURE(S)

##### Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that Trademark Rule 2.146 requires a declaration if any facts are being set forth in the petition and that a signed declaration could be required prior to consideration of the merits of the petition.

##### Submission Signature

Signature: /Jennifer Forbes/ Date: 08/29/2016

Signatory's Name: Jennifer A. Forbes

Signatory's Position: Attorney of Record Minnesota Bar Member

Signatory's Phone Number: 612-373-8558

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the petitioner's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the petitioner in this matter: (1) the petitioner has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the petitioner has filed a power of attorney appointing him/her in this matter; or (4) the petitioner's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 8809

RAM Accounting Date: 08/29/2016

Serial Number: 77935634

Internet Transmission Date: Mon Aug 29 10:28:59 EDT 2016

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