

ESTTA Tracking number: **ESTTA156012**

Filing date: **08/09/2007**

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

Proceeding	78726526
Applicant	Outrigger Hotels Hawaii
Applied for Mark	OUTRIGGER HOTELS ? RESORTS
Correspondence Address	PATRICIA L. COTTON PILLSBURY WINTHROP SHAW PITTMAN LLP PO BOX 10500 MC LEAN, VA 22102-8500 UNITED STATES patricia.cotton@pillsburylaw.com
Submission	Applicants Request for Remand and Amendment
Attachments	remand.tif (1 page)(42820 bytes) consent_Page_1.tif (1 page)(65522 bytes) consent_Page_2.tif (1 page)(6506 bytes) consent_Page_3.tif (1 page)(4904 bytes)
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Signature	/Patricia L. Cotton/
Date	08/09/2007

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

In re Trademark Application of

Applicant: Outrigger Hotels Hawaii
Serial No.: 78/726,526
Mark: OUTRIGGER HOTELS RESORTS & Design
Class: 25
Examining Attorney: Steven W. Jackson
Law Office 107

REQUEST TO REMAND FOR ADDITIONAL EVIDENCE

Applicant hereby submits this request under 37 CFR § 2.142(d) to suspend the appeal in the above application and remand for consideration of additional evidence. Applicant has appealed the Examining Attorney's final refusal to register the above mark under Trademark Act § 2(d), 15 U.S.C. Section 1052(d) based on a likelihood of confusion with the mark OUTRIGGER CANOE CLUB and Design in Registration No. 2,538,362, owned by Outrigger Canoe Club. As additional evidence, Applicant submits the attached written consent of Outrigger Canoe Club, consenting to Applicant's registration of the above mark. Applicant respectfully submits that there is good cause for submitting such consent at this time. Applicant only recently obtained Outrigger Canoe Club's consent and, therefore, such consent was not available prior to the time that the appeal was filed. Applicant respectfully requests that this request be granted, and that the application be remanded to the Examining Attorney for consideration of the attached consent.

Dated: August 9, 2007

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP
PATRICIA L. COTTON
P.O. Box 10500
McLean VA, 22102
(650) 233-4758

By:


Patricia L. Cotton

CONSENT TO USE AND REGISTRATION AGREEMENT

This Consent to Use and Registration Agreement is between Outrigger Hotels Hawaii, a Hawaii limited partnership (“OHH”) and Outrigger Canoe Club, a Hawaii corporation (“**Outrigger Canoe Club**”), effective as of the date of the last signature hereto.

BACKGROUND

OHH is a hospitality services company that operates hotels, condominiums and vacation ownership properties throughout Hawaii and the Pacific and, in connection with such business, uses the OUTRIGGER HOTELS RESORTS and Design mark identified on Exhibit A hereto (the “**OHH Logo**”). Outrigger Canoe Club is a private club that provides sporting facilities, social activities and dining facilities to its members at its location in Honolulu, Hawaii and, in connection with such business, uses the OUTRIGGER CANOE CLUB and Design mark identified on Exhibit B hereto (the “**Outrigger Canoe Club Logo**”).

Outrigger Canoe Club owns U.S. Trademark Registration No. 2,538,362 for the Outrigger Canoe Club Logo for “clothing, namely, t-shirts, tank tops, polo shirts, jackets, sweatshirts, swim suits, shorts, baseball caps, and visors.” OHH owns U.S. Trademark Application Serial No. 78/726,526 for the OHH Logo for “clothing, namely t-shirts, polo shirts, sweatshirts, jackets, hats and caps.” The parties desire to provide for their continued use and registration of their respective marks for these goods upon the terms and conditions set forth in this Agreement.

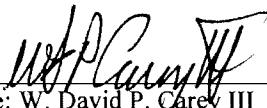
AGREEMENT

Therefore, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. Outrigger Canoe Club consents to OHH’s use and registration of the OHH Logo for clothing. Specifically, Outrigger Canoe Club consents to the registration of Application Serial No. 78/726,526 by OHH, agrees that Outrigger Canoe Club will not oppose or otherwise challenge such application, and affirms that Registration No. 2,538,362 should not bar registration of the mark in such application.
2. OHH consents to Outrigger Canoe Club’s use and registration of the Outrigger Canoe Club Logo for clothing. Specifically, OHH consents to Registration No. 2,538,362 of Outrigger Canoe Club, agrees that OHH will not petition to cancel or otherwise challenge such registration, and affirms that Application Serial No. 78/726,526 and any registration resulting therefrom should not bar Outrigger Canoe Club from maintaining such registration or obtaining any further registration for the Outrigger Canoe Club Logo for clothing.
3. The parties agree that, when the Outrigger Canoe Club Logo and the OHH Logo are used on clothing, there is no likelihood of confusion between the marks because of the differences in the commercial impressions of the two marks.

IN WITNESS WHEREOF, the parties have entered into this Agreement as of the last date written below.

OUTRIGGER HOTELS HAWAII
By Outrigger Enterprises, Inc.,
Its General Partner

By 
Name: W. David P. Carey III
Title: President and Chief Executive Officer
Date: July 16, 2007

OUTRIGGER CANOE CLUB

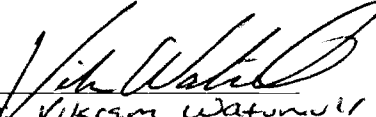
By 
Name: Vikram Watumull
Title: President
Date: 7/16/07

Exhibit A

Outrigger Hotels Hawaii (OHH) Logo



Exhibit B

Outrigger Canoe Club Logo



OUTRIGGER CANOE CLUB