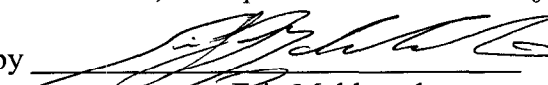


Exhibit

TTAB

Filed by Express Mail No. EL545192777US on March 27, 2002 pursuant to 37 C.F.R. §1.10

by   
Eric Maldonado

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

Yves Saint Laurent Fashion, B.V., Yves Saint  
Laurent Couture, and Yves Saint Laurent )  
Opposer, )  
v. )  
Y & S Handbags, Inc. )  
Applicant. )

Opposition No. 119,265

Serial No. 75/646,369

Mark: Y&S



BOX TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

03-27-2002

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**APPLICANT'S REPLY TO  
OPPOSERS RESPONSE TO MOTION FOR SUMMARY JUDGMENT**

Applicant, Y & S Handbags, Inc. ("Y&S"), hereby replies to Opposers Response to Motion for Summary Judgment pursuant to 37 C.F.R. §2.127(e)(1). For the reasons set forth below and for the reasons set forth previously, Applicant's Motion for Summary Judgment dated March 15, 2001, should be **granted**.

***Opposer Cannot Be "Damaged" Within the Meaning of  
Section 13 of the Lanham Act Because of Applicant's Prior Registration  
To the Same Exact Mark for the Same Exact Goods***

Opposer argues that Applicant has not successfully pleaded the *Morehouse* defense or that such defense inapplicable because (a) Applicant does not have an existing registration and

because (b) Applicant failed to provide evidence of material prejudice in connection with a “latches” defense. For the reasons noted below, Opposers arguments must fail.

Applicant’s prior registration lapsed through no fault of the Applicant because Applicant’s legal counsel failed to take the necessary steps to continue the registration under Section 8 of the Trademark Act. This was made abundantly clear to Opposers throughout this Opposition, and as evidenced by the Declarations of Samson Helfgott (attached Exhibit A), Larry Rand (attached Exhibit B) and Pinny Rand (attached Exhibit C), all of which were served on the Opposers on August 7, 2001. Unfortunately, the only action of the Applicant that caused this Opposition was Applicant’s reliance on its legal counsel. However, as noted in Exhibit A, an identical application was immediately re-filed after the lapse in registration was discovered, not more than six months after the cancellation.

The *Morehouse* defense is indeed equitable in nature, based on the simple concept that a third party that is not injured by a first registration cannot also be injured by second, substantially identical registration. While in *Morehouse* there was no lapse between the first and second registrations, in the present case there was a six month, inadvertent lapse in the original registration. Such lapse, however, does not change the equities of this case.

Whether or not the equitable principles behind *Morehouse* apply should not depend solely on the existence of a pre-existing registration at the time of the second application for registration. The true inquiry is harm to the Opposer. Opposer was not harmed by Applicant’s use of the Y&S mark since 1984, and Opposer was not harmed by Applicant’s U.S. Trademark Registration 1,713,676, even though Opposer had constructive notice of such registration for six years. It is only after a lapse resulting from an administrative oversight, over 15 years from the

initial use of the Y&S mark in commerce, that Opposer now proclaims that it is injured by Applicant's mark.

This type of situation was addressed in *Aquion Partners Limited Partnership*, wherein the first registration lapsed due to an inadvertent failure to renew and there was considerable overlapping use between the opposer and applicant without any evidence of confusion between the marks. However, the equitable principles behind the *Morehouse* defense are also rooted in cases decided before *Morehouse*, such as *College Inn Food Products Corp.*, 133 USPQ 346 (T.T.A.B. 1962), where the Applicant in an opposition sought to re-register a continuously-used mark that was the subject of a prior registration which had expired and the Opposer was estopped by laches from claiming that it would be harmed by the re-registration. It should be noted that Applicant's reliance on the *College Inn* case was conveniently un-addressed in Opposers Response to Motion for Summary Judgment.

Clearly the equities behind the *Morehouse* line of cases and other cases that have addressed a prior registration defense weigh heavily in favor of the Applicant's reliance on such a defense in this case. Simply put, Applicant's use of the mark Y&S continuously in commerce since 1984, without any objection from the Opposers based on use of the mark or in connection with Applicant's prior federal registration, and without any confusion in the marketplace, translates into the rightful conclusion that Opposer cannot now claim injury based on an identical registration for the same mark. The original Y&S trademark application was published on June 16, 1992, almost ten years after the Applicant commenced use of the mark in commerce and almost ten years prior to the date the Opposers supposedly first became actually aware of Applicant's rights in the mark.

After considerable use of the mark in commerce for almost 20 years, Applicant has undeniably been materially prejudiced by Opposers' delay in bringing this Opposition. Opposer indicates that Applicant made no factual showing that it had been materially prejudiced, and argues that Applicant's failure to maintain its registration or docket for renewal raises separate equitable issues that should rebut the equities behind the prior registration defense. In support of its position that it is being materially prejudiced by Opposers actions, Applicant presents a Declaration of Larry Rand (attached Exhibit D). It is undeniable that Applicant's use of the mark Y&S went uncontested by Opposers until over 15 years from the date the Applicant began such use, and that Applicant relied on the lack of contest from anyone in continuing to use and obtain good will in such mark Y&S to this date.

Opposers further argue that the equities weigh against the Applicant because of Applicant's negligence in maintaining its registration. While the Opposers arguments are completely immaterial to a prior registration defense and have no merit whatsoever, it should be clear from the record that Opposer relied on its counsel to handle all trademark registration matters. Furthermore, and as shocking as it may seem to the Opposers counsel, it is fairly common on the part of a corporate applicant to rely on its counsel for all registration matters including filing, docketing and renewal.

Accordingly, whereas Opposers were not harmed by Applicant's 15 years of use of the mark Y&S in commerce, and whereas Opposers were not harmed by Applicant's U.S. Trademark Registration 1,713,676, which existed for 6 of such 15 years of use, Opposers cannot now claim harm from an identical, subsequent registration covering the identical goods as the prior registration 1,713,676.

***Opposer Has Failed to Offer Any Evidence  
in Support of its Claim of Likelihood of Confusion***

Opposers brought this Opposition because of a supposed likelihood of confusion between Opposers' marks and Applicant's Y&S mark. After months of discovery, Opposers have failed to offer any evidence whatsoever supporting such assertion of likely or actual marketplace confusion. Accordingly, Applicant is entitled to move for Summary Judgment based on the failure of Opposers to offer any evidence. It is not Applicants responsibility to disprove a likelihood of confusion in a Motion for Summary Judgment.

Opposers first argue that a "serious likelihood of (actual) confusion is present" based on depositions taken of Larry and Pincus Rand. Opposers argue that "when employees of the Applicant company were deposed, both deponents related an instance of actual confusion that took place in its Florida location." A simple review of the deponents testimony will reveal that Opposers statement is materially false and therefore misleading to the Board. First, the "Florida location" was entitled New York Wholesale, a company unrelated to the Applicant (see Deposition of Pinny Rand, P. 83, Opposers Exhibit B; see Deposition of Larry Rand, P. 94, Opposers Exhibit C). Thus, the term "its Florida location" is false.

Second, both deponents failed to relate any instance of actual confusion. In fact, the deponents asserted that there was never any confusion present (see Deposition of Larry Rand, P. 95, Opposers Exhibit C ). The deponents only related one hearsay occurrence of an unnamed, unidentified individual that entered the store New York Wholesale and asked if such store carried YSL product. This is the equivalent of a customer entering a store named "Miami Wholesale" and asking if such store carried YSL product. In both cases, there is no indication from the storefront that such store sells any particular brand of product. In this case, there was

no indication from the outside that New York Wholesale sold Y&S product (see Deposition of Pincus Rand, P. 76, Opposers' Exhibit B). This type of customer inquiry does not, by any stretch of the imagination, constitute an instance of actual confusion. Furthermore, the testimony of both deponents is strictly hearsay. Opposers have failed to offer any direct evidence from any individual at New York Wholesale regarding any alleged instance of actual confusion.

Opposers also offer a Declaration of Valerie Dellinger (Opposers Exhibit D) in support of its claim of a likelihood of confusion. Such Declaration dated July 5, 2001, and presented into evidence and to the Applicant for the first time in this Opposition proceeding, should have no probative value on the Board's consideration whatsoever. The Declaration is supposedly by an outside counsel of the Opposers, and includes an assertion that "Handbags are confusingly similar goods to those that Yves Saint Laurent has sold in conjunction with its YSL mark," and makes no mention whatsoever of the Applicant or the Applicant's mark Y&S. Furthermore, such Declaration constitutes mere opinion testimony of a supposedly interested individual connected with the Opposers, and is immaterial to likelihood of consumer confusion in the marketplace.

The simple truth is that Opposers have failed to put forth any evidence supporting a likelihood of confusion in the marketplace. After a prolonged discovery period, and with the resources of a multinational, globally recognized and branded company, Opposers have failed to take any surveys or put forth any consumer testimony regarding potential confusion in the marketplace. Opposers assertion of confusion is predicated on the global recognition of its brand. However, this alone does not translate into a likelihood of confusion with respect to any other mark having similar mark components, goods or channels of trade.

**CONCLUSION**

A dismissal of Opposition No. 119,265 on Summary Judgment is proper. Opposers were not harmed by Applicants first registration for the mark Y&S, and Opposers will not therefore be harmed by a subsequent registration for the identical mark and the identical goods. In addition, Opposers have failed to offer any credible evidence of consumer confusion in the marketplace. Thus, in view of the Applicant's continuous use of the mark Y&S in the United States in 1984, and in view of the Applicant's prior registration of the mark Y&S, which registration claimed the identical mark and the identical goods of the present application, and in light of the complete lack of evidence of confusion concerning the mark Y&S, summary judgment is warranted.

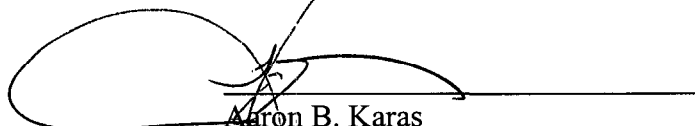
Applicant respectfully requests the Board to **grant** Applicant's Motion for Summary Judgment in all respects.

Any fee due with this paper, not fully covered by an enclosed check, may be charged on Deposit Account 50-1290.

Dated: March 27, 2002

Respectfully submitted,

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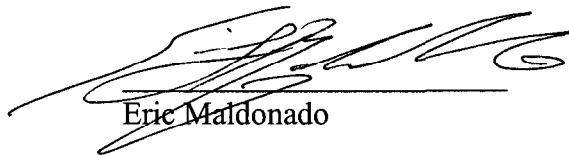
Attachments: Exhibits A-D

**CERTIFICATE OF SERVICE**

I, the undersigned, Eric Maldonado, hereby certify, that on the 27<sup>th</sup> day of March, 2002, I caused to be served a true and correct copy of **APPLICANT'S REPLY TO OPPOSERS RESPONSE TO MOTION FOR SUMMARY JUDGMENT** by U.S. Mail, first class, by depositing the same in a depository of the United States Postal Service on:

Julian Burke, Esq.  
Collen IP  
80 South Highland Avenue  
Ossining, New York 10562

Attorneys for Opposer



Eric Maldonado