ESTTA Tracking number: **ESTTA10255**

Filing date: **06/16/2004**

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

Proceeding	91160023
Party	Plaintiff Remington Products Company, L.L.C. Remington Products Company, L.L.C. 60 Main Street Bridgeport, CT 06604 UNITED STATES
Correspondence Address	BARRY A. COOPER GOTTLIEB, RACKMAN & REISMAN, P.C. 270 MADISON AVENUE, 8TH FLOOR NEW YORK, NY 10016 UNITED STATES
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Date	06/16/2004
Attachments	Opp023.pdf (7 pages)

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

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REMINGTON CORPORATION, LLC, :

Opposer, Opposition No. 91160023

v.

FREDERIC REMINGTON TRUST 1861

Applicant. :
----------X

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Opposer Remington Products, LLC ("Opposer"), by its attorneys, respectfully submits this memorandum in opposition to the Motion to Dismiss filed by Applicant Frederic Remington Trust 1861 ("Applicant").[1]

Applicant's motion asserts several grounds. In a "shotgun" approach, it argues that the Notice of Opposition ("Notice") was not timely filed, that the Notice fails to state a claim, and that Opposer does not have standing to oppose.

None of the reasons submitted by Applicant are sufficient to warrant dismissal, and Applicant's motion should be denied.

The Notice Was Timely Filed

Applicant alleges that the Notice was not filed within the 120 days specified in 37 CFR §2.102 (c). Applicant is simply incorrect.

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[1] Applicant served its Motion on Joel Bedol, Esq., sending a copy directly to Opposer's address in Connecticut. The record will show that the present Opposition action was filed by the undersigned counsel of record. While said counsel has obtained a copy of the Motion, the Board is urged to advise Applicant that service should be made on counsel of record.

Trademark Rule §2.197(a) states, unambiguously, that a document shall be considered filed in the Office if it is mailed prior to the expiration period (§2.197(a)(1)(i)), if it is properly addressed and deposited with the U.S. Postal Service with sufficient postage as first class mail (§2.197(a)(1)(i)(B)), and if it includes a signed certificate of such mailing (§2.197(a)(1)(ii)).

Filing a notice of opposition by mailing the same pursuant to 37 CFR §2.197 is expressly recognized as an authorized method of filing. TBMP §306.01

In the present case, the Notice included proper postage, was sent by first class mail to the proper address, and included a signed certificate of mailing. All the requirements of §2.197 were met. It was also sent on the 120th day to oppose - as Applicant itself admits in its motion ("... although opposer mailed the opposition on the 120th day").

The Notice was timely filed and Applicant's motion to dismiss on the basis that it was filed late is without either legal or factual support.

Opposer's Notice Sets Forth Claims Upon Which Relief Can Be Granted and Opposer Has Standing in This Matter

Applicant contends that Opposer cannot prove the existence of its claims and that it has no standing to oppose.

The entire basis for the motion grounded on failure to state a claim is that Opposer has no registration in the class of Applicant's application and has not alleged use of its marks for such goods.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiently of the pleading. In order to withstand such

a motion, a pleading need only allege such facts as would, if proved, establish that the Opposer is entitled to the relief sought, that is, that (1) Opposer has standing to maintain the proceedings, and (2) a valid ground exists for cancelling the subject registration. T.B.M.P. §503.02; See, e.g., Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems Inc., 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer's pleaded allegations must be accepted as true, and the pleading must be construed in the light most favorable to Opposer. TBMP. §503.02. See, e.g., Kelly Services Inc. v. Greene's Temps., 25 USPQ2d 1460, 1462 (TTAB 1992); Baroid Drilling Fluids, Inc. v. Sun Drilling Products, 24 USPQ2d 1048, 1049 (TTAB 1992).

Opposer's Notice recites not just one, but several reasons why Applicant's application should not issue to registration. Those reasons include likelihood of confusion, abandonment based on non-use, abandonment based on uncontrolled licensing, and fraud.

Specifically, Opposer's Notice alleges, among other things, that it owns several registrations for REMINGTON and it has used these marks since at least 1900 (Notice, para. 3), that its marks have become well known to the public (Notice, para. 4), that its REMINGTON marks are the subject of numerous registrations (Notice, para. 5), that it has common law rights in the REMINGTON marks (Notice, para. 6), that its products have been extensively advertised and promoted (Notice, para. 7), that its marks have come to be associated with Opposer (Notice, para. 8), and that Applicant filed its present application, along with others, as a way of eventually seeking payment from Opposer (Notice, para. 10).

The Notice continues by alleging that the marks at issue are confusingly similar (Notice, para. 10), that consumers would be likely to believe that the goods and/or services of Applicant's application are connected with Opposer (Notice, para. 12), that confusion is likely (Notice, para. 13) and that Opposer would be damaged by issuance of a registration to Applicant (Notice, para. 13).

In terms of abandonment based on non-use, the Notice alleges that Applicant has not used its mark as of the dates of use asserted therein (Notice, para. 16), that such non-use exceeds three (3) years (Notice, para. 17), that such non-use continues (Notice, para. 18), that during said non-use, Applicant had no intent to resume use (Notice, para. 19), and that as a result thereof, the mark of Applicant's subject application has been abandoned (Notice, para. 20).

Abandonment has also been asserted based on non-controlled licensing, and these allegations are contained in paragraphs 21 - 24 of the Notice.

Opposer's Notice also includes allegations of fraud on the Trademark Office. These allegations relate to Applicant's assertion, as contained in the application as filed, that its mark was in use as of the dates set forth in its application (Notice, para. 25) and that the mark was not in use as so alleged (Notice, paras. 26, 27 and 28). Fraud is also alleged regarding use of the mark in a declaration submitted by Applicant, and Applicant's ownership of one of its registrations (Notice, paras. 29, 30 and 31). All of the statements are alleged to be false, and made with knowledge of said falsity (Notice, para. 32).

Fraud on the Trademark Office is also alleged in connection with a Petition to Make Special filed by Applicant. Opposer identifies the statements made in the

Petition to Make Special (Notice, para. 33), alleges that the statements were untrue and false (Notice, paras. 35 and 36), and further asserts that said statements were made intentionally (Notice, para. 36), and were relied on by the PTO (Notice, para. 37).

The Notice alleges that, as a result of the false and fraudulent statements so identified, the application is invalid (Notice, para. 38).

These allegations – all of which must be taken as true – set forth sufficient facts to withstand a Motion to Dismiss. See, e.g., TBMP §309.03(c).

Applicant argues that the Opposition should be dismissed because Opposer does not have standing. To have standing in an opposition, "the opposer must plead facts sufficient only to show a personal interest in the outcome of the case beyond that of the general public." Jewelers Viligance Committee Inc. v. Ullenberg Corp., 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

As set forth above, Opposer alleges in its Notice that it is the owner of several REMINGTON marks and registrations therefor, that the Applicant's mark is confusingly similar to and will cause confusion, that Applicant has abandoned its mark and has committed fraud on the PTO, and that Opposer will be damaged if Applicant obtains a registration for its mark. Accordingly, Opposer has pled facts sufficient to show that its interest in the outcome of this opposition goes well beyond the interest of the general public and that Opposer has standing in this opposition.

Applicant's Motion to Dismiss based on failure to state a claim and standing should be dismissed.

CONCLUSION

For the above reasons, Applicant's Motion to Dismiss should be denied.

Respectfully submitted,

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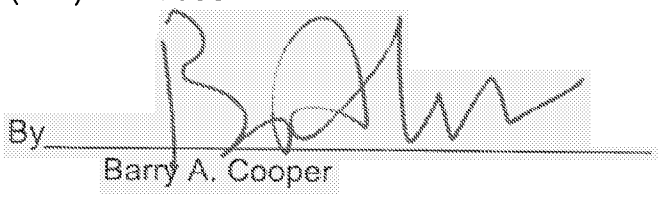


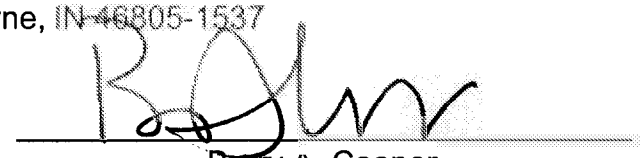
By_____
Barry A. Cooper

Dated: New York, New York
June 16, 2004

CERTIFICATE OF SERVICE

I, Barry A. Cooper, hereby certify that a true and correct copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SET ASIDE DEFAULT AND, IF NECESSARY, OPPOSER'S OPPOSITION TO APPLICANT'S MOTIONS TO DISMISS** was mailed by First Class Mail, postage prepaid, this 16th day of June, 2004 to:

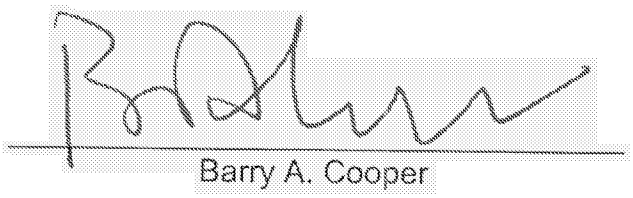
S.H. Yoo, Trustee, in Pro Se
Frederic Remington Trust 1861
c/o Dean Shideler, Consultant
3539 Rolston Street
Fort Wayne, IN 46805-1537



Barry A. Cooper

CERTIFICATE OF FILING

I hereby certify that a copy of **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SET ASIDE DEFAULT AND, IF NECESSARY, OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS** was filed by ESTTA on June 16, 2004.



Barry A. Cooper

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