

ESTTA Tracking number: **ESTTA110555**

Filing date: **11/20/2006**

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

Proceeding	91163307
Party	Plaintiff Samar, L.L.C. Samar, L.L.C. 10 South Riverside Plaza Chicago, IL 60606
Correspondence Address	MARIA N. BERNIER REED SMITH LLP 435 SIXTH AVENUE PITTSBURGH, PA 15219-1886
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Joshua S. Bish
Filer's e-mail	ptoipinbox@reedsmith.com,jbish@reedsmith.com,bkubiak@reedsmith.com
Signature	/Joshua S. Bish/
Date	11/20/2006
Attachments	sl.opposersmotiontodismisscounterclaim.pdf ( 16 pages )(1667125 bytes )

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

SARAMAR, LLC and	)	
SARA LEE CORP.,	)	
	)	Opposition No.: 91163307
Opposers,	)	Mark: X SCENT [and design]
	)	
v.	)	Opposition No.: 91163331
	)	Mark: X SCENT
ARCTICSHIELD, INC.,	)	
	)	
Applicant.	)	

**OPPOSERS' MOTION TO DISMISS APPLICANT'S COUNTERCLAIM**

Pursuant to Fed. R. Civ. P. 12(b)(6), Opposers Saramar LLC and Sara Lee Corp. (collectively, "Opposers")<sup>1</sup> hereby move to dismiss Applicant ArcticShield Inc.'s ("Applicant") Counterclaim for Cancellation regarding Opposers' U.S. Trademark Registration No. 2,913,784. The facts alleged in Applicant's Counterclaim, even if taken as true, do not entitle Applicant to the relief it seeks. Accordingly, Applicant's Counterclaim must be dismissed. In support of this Motion, Opposers state as follows:

1. Opposers are the owner of U.S. Trademark Registration No. 2,913,784 for the mark "EX-SCENT" for "Thermal underwear, tops and bottoms, shirts, T-shirts, pants, turtlenecks, mock turtlenecks, underwear" in International Class 25 ("the '784 Registration"). The '784 Registration validly issued on December 21, 2004. *See* '784 Registration, Exhibit 1.

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<sup>1</sup> Opposers have moved separately to substitute HBI Branded Apparel Enterprises LLC ("HBI") as the new opposer in this consolidated proceeding, since HBI is now the owner by assignment of U.S. Trademark Registration No. 2,913,784. *See* Reel/Frame 3382/0001. However, for convenience, and until HBI is substituted or joined as a party, the term "Opposers" herein will refer to the currently-named parties Saramar LLC and Sara Lee Corp.

2. The application that resulted in the '784 Registration was filed as an intent-to-use application on February 21, 2002. *Id.* This date is the constructive first use date of Opposers' mark. *See* 15 U.S.C. § 1057(c).

3. The '784 Registration forms the basis for the current consolidated opposition proceeding against Applicant's pending U.S. Trademark Application Serial Nos. 76/509,381 and 76/509,382 for the marks "X SCENT" and "X SCENT [and design]", respectively, for "Clothing, namely, gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls" in International Class 25. Exhibits 2 and 3 hereto.

4. Applicant's applications were filed as intent-to-use applications on April 25, 2003, after the filing date of the '784 Registration. *Id.*

5. Applicant alleges a date of first use of its "X SCENT" and "X SCENT [and design]" marks in August 2003, which also is after the filing date of the '784 Registration. *See* Applicant's Counterclaim at ¶ 12.

6. Opposers' '784 Registration (filed February 21, 2002 and issued December 21, 2004) has priority over Applicant's marks (filed April 25, 2003, and allegedly first used in August 2003). *See* 15 U.S.C. § 1057(c).

7. Even if everything alleged in Applicant's Counterclaim is taken as true, the Counterclaim cannot stand because Applicant's filing date and alleged date of first use are both after Opposers' filing date. *See, e.g., Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[A]pplicant's motion to dismiss the opposition under Fed. R. Civ. P. 12(b)(6) is well taken. Opposer's allegations of common law rights in its mark as of April 15, 1990, a date subsequent to applicant's constructive use date, are inadequate to support the ground of priority of use and likelihood of confusion and accordingly opposer has failed to

set forth a claim upon which it can prevail.”) (emphasis added). Tellingly, Applicant does not and cannot allege priority of its marks in its Counterclaim.

8. Moreover, Applicant has not alleged a likelihood of confusion between its marks and Opposers’ mark to support its Counterclaim for Cancellation. In fact, Applicant expressly denied such a likelihood of confusion in its Answer. *See* Applicant’s Answer to Amended Notice of Opposition at ¶¶ 6-8. Thus, Applicant has not alleged any basis – either priority or likelihood of confusion – to support the cancellation of Opposers’ validly issued ‘784 Registration.

9. Accordingly, Opposers respectfully request that Applicant’s Counterclaim for Cancellation be dismissed for failure to state a claim upon which relief can be granted.

Respectfully submitted,

Dated: November 20, 2006

/s/ Joshua S. Bish

Maria N. Bernier

Joshua S. Bish

REED SMITH LLP

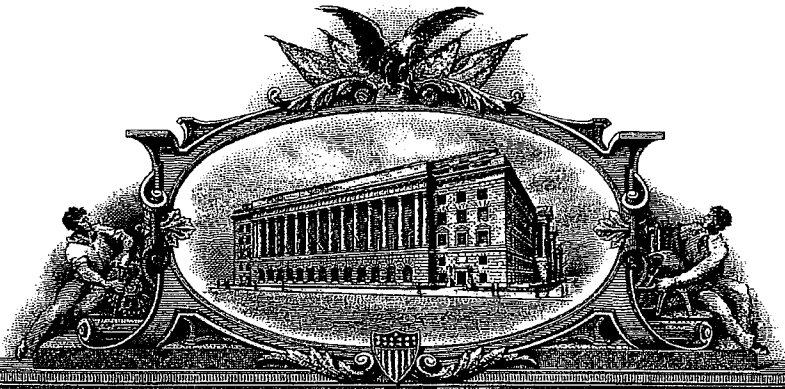
435 Sixth Avenue

Pittsburgh, PA 15219

(412) 288-4272/7288

Attorneys for Opposers Saramar LLC and  
Sara Lee Corp.

761297



**THE UNITED STATES OF AMERICA**

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

**March 25, 2005**

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,913,784 IS  
CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY  
THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH  
REGISTRATION IS IN FULL FORCE AND EFFECT.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *December 21, 2004*  
SAID RECORDS SHOW TITLE TO BE IN: *Registrant***



**By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS**

*L. Edelen*

**L. EDELEN  
Certifying Officer**

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 2,913,784**  
**Registered Dec. 21, 2004**

**TRADEMARK  
PRINCIPAL REGISTER**

**EX-SCENT**

**SARAMAR, L.L.C. (DELAWARE LIMITED LIABILITY COMPANY)  
10 SOUTH RIVERSIDE PLAZA  
CHICAGO, IL 60606**

**FIRST USE 12-31-2003; IN COMMERCE 12-31-2003.**

**FOR: THERMAL UNDERWEAR, TOPS AND BOTTOMS, SHIRTS, T-SHIRTS, PANTS, TURTLENECKS, MOCK TURTLENECKS, UNDERWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).**

**SN 78-110,238, FILED 2-21-2002.**

**AMY HELLA, EXAMINING ATTORNEY**

**Drawing Page**

**Date/Time Stamp:** Thursday, 04-24-2003 10:17:37 EDT



04-25-2003

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #67

**Applicant:**

ARCTICSHIELD, INC.  
905 S. 9th, Suite D  
Broken Arrow , OK 74012  
USA

**Date of First Use Anywhere: Intent-To-Use (Section 1(b))**

**Date of First Use In Commerce: Intent-To-Use (Section 1(b))**

**Goods and Services:**

Clothing, namely, gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls

**Mark:**

X SCENT

U.S. Patent & TM Ofc/TM



**76509381**

<http://www3.uspto.gov/cgi-bin/teas/V1.25/get?USPTO-6556174151-20030424101324...> 4/24/03

76509381

TRADEMARK APPLICATION SERIAL NO. \_\_\_\_\_

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

04/30/2003 KGIBBONS 00000032 76509381

01 FC:6001

335.00 0P



**FRANK J. CATALANO, P.C.**  
Patent, Trademark & Copyright Attorney  
The Avanti Building ■ 810 South Cincinnati ■ Suite 405  
Tulsa, Oklahoma 74119-1612  
Telephone (918) 584-8787  
Facsimile (918) 599-9889

April 24, 2003

**Box NEW APP FEE**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Re: Application for Registration of Mark: X SCENT  
Based on *Bona Fide* Intent-to-Use the Mark in Commerce  
Applicant: ARCTICSHIELD, INC.  
Reference No.: 2299.03C

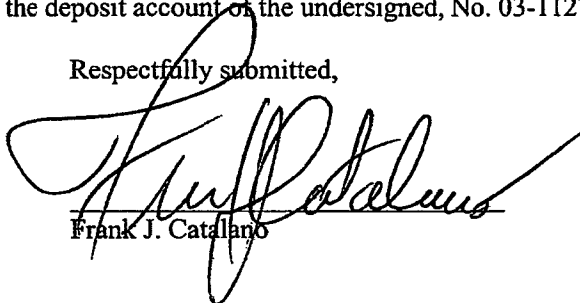
Dear Sir:

Enclosed please find the following for registering the above-referenced mark based on the Applicant's *bona fide* intent to use the mark in commerce:

- \* Application for registration based on Intent-to-Use pursuant to Section 1(b) of the Lanham Act;
- \* Power of Attorney;
- \* Signed Declaration in Support of Registration;
- \* Drawing Page;
- \* Check in the amount of \$335, the fee for filing this application; and
- \* A Return-Addressed Post Card.

Please send all communications to Frank J. Catalano. The Commissioner is authorized to charge any additional costs or credit any overpayments to the deposit account of the undersigned, No. 03-1127.

Respectfully submitted,



Frank J. Catalano

FJC:ms  
Enclosures  
EXPRESS MAIL #ET229398981US

PTO Form 1478 (Rev 9/98)  
 OMB Control #0651-0009 (Exp. 08/31/2004)

**\*Trademark/Service Mark Application\***

**\* To the Commissioner for Trademarks \***

<DOCUMENT INFORMATION>  
 <TRADEMARK/SERVICEMARK APPLICATION>  
 <VERSION 1.22>

<APPLICANT INFORMATION>  
 <NAME> ARCTICSHIELD, INC.  
 <STREET> 905 S. 9th, Suite D  
 <CITY> Broken Arrow  
 <STATE> OK  
 <COUNTRY> USA  
 <ZIP/POSTAL CODE> 74012

<APPLICANT ENTITY INFORMATION>  
 <CORPORATION: STATE/COUNTRY OF INCORPORATION> Oklahoma

<TRADEMARK/SERVICEMARK INFORMATION>

<MARK> X SCENT

<TYPED FORM> Yes  
 ~ Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq., as amended). ~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>  
 <INTENT TO USE: SECTION 1(b)> Yes  
 ~ Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. §1051(b), as amended.) ~  
 <INTERNATIONAL CLASS NUMBER> 025  
 <LISTING OF GOODS AND/OR SERVICES> Clothing, namely, gloves, mittens, footwear, socks, neckwear, muffs, bib overalls, jackets and coveralls

<ATTORNEY INFORMATION>  
 <NAME> Frank J. Catalano  
 <STREET> 810 S. Cincinnati, Suite 405  
 <CITY> Tulsa  
 <STATE> OK  
 <COUNTRY> USA

<ZIP/POSTAL CODE> 74119  
<FIRM NAME> Frank J. Catalano, P.C.  
<TELEPHONE NUMBER> (918) 584-8787  
<FAX NUMBER> (918) 599-9889  
<ATTORNEY DOCKET NUMBER> 2299.03C

<FEE INFORMATION>  
<TOTAL FEES PAID> 335.00  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>  
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>

~ **PTO-Application Declaration:** The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. ~

<SIGNATURE> Dave W. Gordon \* please sign here\*

<DATE> 4-24-03  
<NAME> Dave W. Gordon  
<TITLE> CEO

The information collected on this form allows the PTO to determine whether a mark may be registered on the Principal or Supplemental register, and provides notice of an applicant's claim of ownership of the mark. Responses to the request for information are required to obtain the benefit of a registration on the Principal or Supplemental register. 15 U.S.C. §§1051 et seq. and 37 C.F.R. Part 2. All information collected will be made public. Gathering and providing the information will require an estimated 12 or 18 minutes (depending if the application is based on an intent to use the mark in commerce, use of the mark in commerce, or a foreign application or registration). Please direct comments on the time needed to complete this form, and/or suggestions for reducing this burden to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington D.C. 20231. Please note that the PTO may not conduct or sponsor a collection of information using a form that does not display a valid OMB control number.

**Drawing Page**

**Date/Time Stamp:** Thursday, 04-24-2003 10:34:20 EDT



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**Mark:**



U.S. Patent & TM Otc/TM



**76509382**

<http://www3.uspto.gov/cgi-bin/teas/V1.25/get?USPTO-6556174151-20030424103125...> 4/24/03

76509382

TRADEMARK APPLICATION SERIAL NO. \_\_\_\_\_

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Applicant: ARCTICSHIELD, INC.  
Reference No.: 2299D.03C

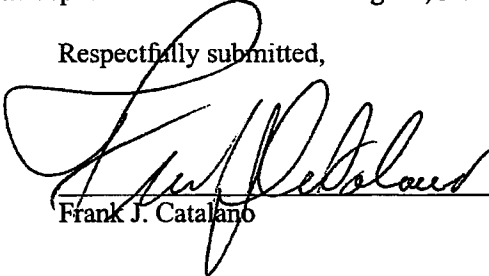
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FJC:ms  
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PTO Form 1478 (Rev 9/98)  
OMB Control #0651-0009 (Exp. 08/31/2004)

## **\*Trademark/Service Mark Application\***

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<TRADEMARK/SERVICEMARK INFORMATION>

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<FIRM NAME> Frank J. Catalano, P.C.  
<TELEPHONE NUMBER> (918) 584-8787  
<FAX NUMBER> (918) 599-9889  
<ATTORNEY DOCKET NUMBER> 2299D.03C

<FEE INFORMATION>  
<TOTAL FEES PAID> 335  
<NUMBER OF CLASSES PAID> 1  
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>  
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>

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<SIGNATURE>  \* please sign here\*

<DATE> 4-24-03  
<NAME> Dave W. Gordon  
<TITLE> CEO

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that he or she has caused a true and correct copy of the foregoing OPPOSERS' MOTION TO DISMISS APPLICANT'S COUNTERCLAIM to be served on the following counsel for Applicant via First Class U.S. Mail this 20th day of November, 2006:

Frank J. Catalano, Esq.  
GABLE & GOTWALS  
100 West Fifth Street, 10<sup>th</sup> Floor  
Tulsa, OK 74103-4217

/s/ Joshua S. Bish \_\_\_\_\_