

ESTTA Tracking number: **ESTTA126597**

Filing date: **02/23/2007**

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

Proceeding	91165506
Party	Plaintiff Sara Lee Global Finance, L.L.C. Sara Lee Global Finance, L.L.C. 1000 E. Hanes Mill Rd. Winston-Salem, NC 27105
Correspondence Address	Nicholas J. Valenziano, Jr. SARA LEE CORPORATION 1000 E. Hanes Mill Rd. WINSTON-SALEM, NC 27105 bbradford@saralee.com
Submission	Other Motions/Papers
Filer's Name	Randel S. Springer
Filer's e-mail	trademarkswinston@wcsr.com, rspringer@wcsr.com
Signature	/Randy Springer/
Date	02/23/2007
Attachments	SARATSA.pdf (21 pages)(581758 bytes)

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

In the Matter of Application Serial No. 78/386,608

Published on February 1, 2005

Mark: BODYFIT & Design

HBI BRANDED APPAREL ENTERPRISES, LLC)	
Successor in interest of)	
SARA LEE GLOBAL FINANCE, L.L.C.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91165506
)	
TSA CORPORATE SERVICES, INC.)	
)	
Applicant.)	

**Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

**DECLARATION OF RANDEL S. SPRINGER IN SUPPORT OF OPPOSER HBI
BRANDED APPAREL ENTERPRISES, LLC’S COMBINED MOTION FOR DEFAULT
JUDGMENT AND OPPOSITION TO APPLICANT’S MOTION FOR JUDGMENT**

I, RANDEL S. SPRINGER, state and declare as follows:

1. I am of legal age, competent to testify, and have personal knowledge of the facts set forth herein.
2. I am one of the attorneys representing HBI Branded Apparel Enterprises, LLC (“HBI”) in the above-captioned opposition.
3. On June 1, 2005, Sara Lee timely filed a Notice of Opposition contending that the mark **BODYFIT BY SPORTS AUTHORITY and Design** published in the Official Gazette dated February 1, 2005 (TM93), for “men’s children’s and ladies’ apparel, namely, shirts, shorts, pants, tights, warm up suits, jackets, vests, gloves, hats, visors, caps, athletic footwear and hosiery,” in

International Class 25 (the “Opposed Mark”), would cause HBI damage. *See* Exhibit A, attached.

4. On June 10, 2005, the opposition was instituted and the Trademark Trial and Appeal Board (“TTAB”) mailed notice of the due date for answering the above-captioned opposition, setting a due date for answering 40 days after the mailing of the notice, or July 20, 2005. *See* Exhibit B, attached.

5. On July 19, 2005, Applicant filed a Motion for an Extension of Time to Answer with Consent. *See* Exhibit C, attached.

6. On July 19, 2005, the TTAB granted Applicant’s motion to extend time, allowing Applicant to file an answer by September 18, 2005. *See* Exhibit D, attached.

7. On September 12, 2005, Applicant filed a Motion for Suspension for Settlement with Consent. *See* Exhibit E, attached.

8. On September 12, 2005, the TTAB suspended proceedings and reset the dates for discovery and testimony. Proceedings were suspended until March 11, 2006. Applicant was given thirty days from the date proceedings resumed, or until April 10, 2006, to file an answer. *See* Exhibit F, attached.

9. On December 28, 2005, Applicant’s counsel filed a change of correspondence address. *See* Exhibit G, attached.

10. To date, and well after the expiration of the thirty day period in which Applicant had to answer, Applicant has failed to answer HBI’s opposition.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

DATED this 23rd day of February, 2007.



Randel S. Springer

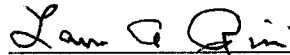
CERTIFICATE OF SERVICE

I do hereby certify that on February 23, 2007, I filed via electronic means (ESTTA) this DECLARATION OF RANDEL S. SPRINGER IN SUPPORT OF OPPOSER HBI BRANDED APPAREL ENTERPRISES, LLC'S COMBINED MOTION FOR DEFAULT JUDGMENT AND OPPOSITION TO APPLICANT'S MOTION FOR JUDGMENT with the:

U. S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

with a copy via First Class Mail, postage prepaid, to:

Michael A. Lisi
Honigman Miller Schwartz and Cohn LLP
38500 Woodward Avenue, Suite 100
Bloomfield Hills, MI 48304



Laurie A. Ricci, Senior Paralegal

TTAB

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451 Alexandria, VA 22313-1451, on: June 1, 2005

Nicholas J. Valenziano, Jr.
Nick Valy
Date: June 1, 2005

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

In the Matter of Application Serial No. 78/386,608
Published on February 1, 2005
Mark: BODYFIT and design

Sara Lee Global Finance, L.L.C.,)
)
) Opposer,)
)
) v.)
)
) TSA Corporate Services, Inc.,)
)
) Applicant.)

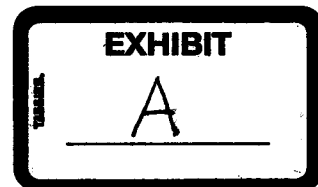
NOTICE OF OPPOSITION

Opposer Sara Lee Global Finance, L.L.C., a Delaware limited liability company having a principal place of business at 204F Weldin Building 3411 Silverside Road Wilmington, DE 19810, ("Opposer"), believes it will be damaged by the registration of the mark BODYFIT and design, published in the Official Gazette dated February 1, 2005 (TM 93), for "men's, children's and ladies' apparel, namely, shirts, shorts, pants, tights, warm up suits, jackets, vests, gloves, hats, visors, caps, athletic footwear and hosiery," in International Class 25 and hereby opposes same. As grounds for the opposition, it is alleged that:

06/09/2005 HP/HAM1 00000124 190142 78386608
01 FC6402 300.00 MA



06-06-2005
U.S. Patent & TMOc/TM Mail Rept DL #72



1. Opposer is now, and its predecessors in interest and licensees have been engaged in the manufacture, distribution, and sale of men's, women's, and children's athletic apparel and other related products specifically directed to the field of athletics and sports.

2. Opposer is the record owner of the following registration for the EVOLUTION BODYFIT mark used alone and in conjunction with other words and designs:

<u>Mark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
EVOLUTION BODYFIT	2,849,635	June 1, 2004	T-shirts, shirts, shorts, pants, leggings

The aforesaid registration is valid and subsisting, unrevoked, and uncanceled, and Opposer is the owner of it and the marks shown thereby and all of the business and goodwill represented thereby.

3. Opposer, and Opposer's licensees have, since registration, continuously used the EVOLUTION BODYFIT trademark in interstate commerce throughout the United States for the purpose of identifying Opposer's products and to distinguish those goods from the products of other manufactures.

4. Ever since the adoption and use of the EVOLUTION BODYFIT trademark as aforesaid, Opposer, and Opposer's licensees have widely and extensively advertised and sold goods bearing said EVOLUTION BODYFIT trademark as a consequence of same, the consuming public and trade have come to recognize and do recognize the EVOLUTION BODYFIT trademark as being used by Opposer or by a single source, and to associate and identify said mark and name with Opposer or with a single source, and Opposer derives substantial goodwill and value from the aforesaid identification by the consuming public and trade.

5. By the application herein opposed, Applicant seeks to register the mark BODYFIT and design for "men's, children's and ladies' apparel, namely, shirts, shorts, pants, tights, warm up

suits, jackets, vests, gloves, hats, visors, caps, athletic footwear and hosiery," in International Class 25. Such goods are identical or closely related to the goods for which Opposer has registrations and upon which it uses the EVOLUTION BODYFIT trademark.

6. Opposer's EVOLUTION BODYFIT trademark and Applicant's BODYFIT and Design mark is confusingly similar in sight, sound, and meaning.

7. Applicant's BODYFIT and design mark, when used on and in connection with the sale of the identified goods, is likely to cause confusion and mistake and to deceive, with consequent injury to Opposer, the consuming public, and the trade.

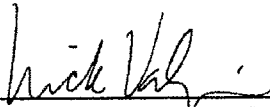
8. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's mark sought to be registered, and will give color and exclusive statutory right to Applicant in violation and derogation of prior and superior rights of Opposer.

WHEREFORE, Opposer believes it will be damaged by registration of Applicant's mark and prays that it not be allowed.

In addition to the undersigned, please recognize as attorney for opposer in this proceeding Bruce O. Bradford, a member of the Bar of the State of Illinois, whose office is located at 1000 East Hanes Mill Road, Winston-Salem, North Carolina, 27105, telephone (336) 519-7072.

SARA LEE GLOBAL FINANCE, L.L.C.

Dated: June 1, 2005



Nicholas J. Valenzano, Jr.
1000 East Hanes Mill Road
Winston-Salem, NC 27105
Telephone: 336-519-7450
Attorney for Opposer

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

In the Matter of Application Serial No. 78/386,608
Published on February 1, 2005
Mark: BODYFIT and design

Sara Lee Global Finance, L.L.C.,)
)
Opposer,)
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v.)
)
TSA Corporate Services, Inc.,)
)

Applicant.)

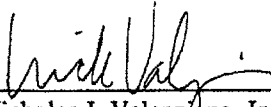
**PAYMENT OF FILING FEE FOR
NOTICE OF OPPOSITION**

Please charge the \$300.00 filing fee, as well as any additional charges associated with filing
the above-referenced opposition, to Deposit Account No. 190142.

Respectfully submitted,

SARA LEE GLOBAL FINANCE, LLC

Dated: June 1, 2005



Nicholas J. Valenziano, Jr.
Attorney for Opposer

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 10, 2005

Opposition No 91165506
Serial No. 78386608

MICHAEL A. LISI
Honigman Miller Schwartz and Cohn LLP
32270 Telegraph Road, Suite 225
Bingham Farms, MI 48025

Sara Lee Global Finance, L.L.C.

v.

TSA Corporate Services, Inc.

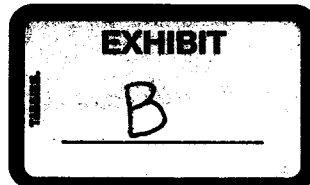
Nicholas J. Valenziano, Jr.
SARA LEE CORPORATION
1000 E. Hanes Mill Rd.
WINSTON-SALEM, NC 27105

Tamika Whitsey, Legal Assistant:

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12,



2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open: June 30, 2005

Discovery period to close: December 27, 2005

30-day testimony period for party in position of plaintiff to close: March 27, 2006

30-day testimony period for party in position of defendant to close: May 26, 2006

15-day rebuttal testimony period for plaintiff to close: July 10, 2006

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may

be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

ESTTA Tracking number: **ESTTA39116**

Filing date: **07/19/2005**

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

Proceeding	91165506
Applicant	Defendant TSA Corporate Services, Inc. TSA Corporate Services, Inc. 1050 West Hampden Avenue Englewood, CO 80110
Other Party	Plaintiff Sara Lee Global Finance, L.L.C. Sara Lee Global Finance, L.L.C. 1000 E. Hanes Mill Rd. Winston-Salem, NC 27105

Motion for an Extension of Time to Answer With Consent

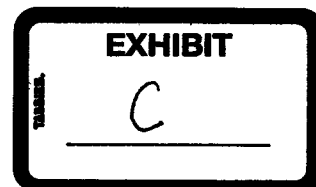
TSA Corporate Services, Inc.'s answer is currently due on 07/20/2005, and the close of discovery is currently set for 12/27/2005. TSA Corporate Services, Inc. requests that its time to answer be extended by 60 days from the current due date, or until 09/18/2005. The grounds for applicant's request are as follows:

- *Applicant needs additional time to investigate the claim*
- *The parties are discussing settlement*

TSA Corporate Services, Inc. has secured the express consent of all other parties to this proceeding for the extension requested herein.

TSA Corporate Services, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service



The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/Michael A. Lisi/

Michael A. Lisi

mlisi@honigman.com, tmdocketing@honigman.com

bbradford@saralee.com, nvalenziano@saralee.com

07/19/2005

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

Jul 19, 2005

PROCEEDING NO. 91165506

Sara Lee Global Finance, L.L.C.

v.

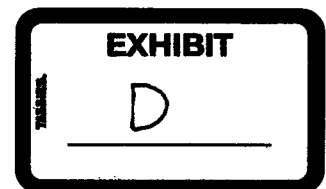
TSA Corporate Services, Inc.

MOTION TO EXTEND TIME TO ANSWER GRANTED

TSA Corporate Services, Inc.'s motion filed, Jul 19, 2005, to extend applicant's time to answer, with consent, is granted. Accordingly, applicant is allowed until **Sep 18, 2005** to file an answer.

Discovery and trial dates remain as previously set.

*By the Trademark Trial
and Appeal Board*



ESTTA Tracking number: **ESTTA44741**

Filing date: **09/12/2005**

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

Proceeding	91165506
Applicant	Defendant TSA Corporate Services, Inc. TSA Corporate Services, Inc. 1050 West Hampden Avenue Englewood, CO 80110
Other Party	Plaintiff Sara Lee Global Finance, L.L.C. Sara Lee Global Finance, L.L.C. 1000 E. Hanes Mill Rd. Winston-Salem, NC 27105

Motion for Suspension for Settlement With Consent

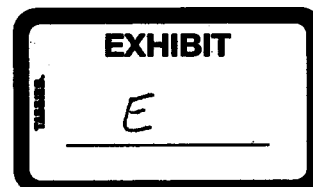
The parties are actively engaged in negotiations for the settlement of this matter. TSA Corporate Services, Inc. requests that this proceeding be suspended for 180 days to allow the parties to continue their settlement efforts.

TSA Corporate Services, Inc. has secured the express consent of all other parties to this proceeding for the suspension requested herein.

TSA Corporate Services, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.



Respectfully submitted,
/Michael A. Lisi/
Michael A. Lisi
tmdocketing@honigman.com
bbradford@saralee.com
09/12/2005

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

Sep 12, 2005

PROCEEDING NO. 91165506
Sara Lee Global Finance, L.L.C.

v.

TSA Corporate Services, Inc.

MOTION TO SUSPEND GRANTED

TSA Corporate Services, Inc.'s motion filed, Sep 12, 2005, to suspend this proceeding to allow the parties time to continue their settlement efforts is granted. Accordingly, proceedings herein are suspended until Mar 11, 2006, subject to the right of either party to request resumption at any time. During the suspension period, the parties shall notify the Board of any change of address for either the parties or their counsel.

Unless the parties sooner request resumption, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below. If an answer has not been filed, the defendant is allowed until thirty days from the date of resumption to file an answer. The parties are allowed THIRTY DAYS from resumption in which to serve responses to any outstanding discovery requests.



Proceedings Resume:

Mar 12, 2006

DISCOVERY PERIOD TO CLOSE:

Jun 25, 2006

Thirty-day testimony period for party in
position of plaintiff to close:

Sep 23, 2006

Thirty-day testimony period for party in
position of defendant to close:

Nov 22, 2006

Fifteen-day rebuttal testimony period
to close:

Jan 06, 2007

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

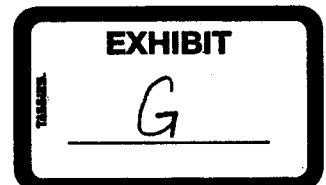
*By the Trademark Trial
and Appeal Board*

ESTTA Tracking number: **ESTTA59500**

Filing date: **12/28/2005**

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

Proceeding	91165506
Party	Defendant TSA Corporate Services, Inc. TSA Corporate Services, Inc. 1050 West Hampden Avenue Englewood, CO 80110
Correspondence Address	MICHAEL A. LISI Honigman Miller Schwartz and Cohn LLP 32270 Telegraph Road, Suite 225 Bingham Farms, MI 48025 tmdocketing@honigman.com
Submission	Change of Correspondence Address
Filer's Name	Michael A. Lisi
Filer's e-mail	tmdocketing@honigman.com
Signature	/Michael A. Lisi/
Date	12/28/2005
Attachments	Change of Address 91165506.pdf (1 page)



CHANGE OF CORRESPONDENCE ADDRESS

Opposition Number: 91165506

Filing Date: 06/06/2005

Status: Pending

Status Date: 06/10/2005

Interlocutory Attorney: CHERYL A BUTLER

Defendant

Name: TSA Corporate Services, Inc.
Correspondence: Michael A. Lisi

Former Address: Honigman Miller Schwartz and Cohn LLP
32270 Telegraph Road, Suite 225
Bingham Farms, MI 48025
tmdocketing@honigman.com

NEW/CURRENT ADDRESS: Honigman Miller Schwartz and Cohn LLP
38500 Woodward Avenue, Suite 100
Bloomfield Hills, MI 48304
tmdocketing@honigman.com