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Filing date: **09/19/2007**

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

Proceeding	91172575
Party	Plaintiff GMA Accessories, Inc.
Correspondence Address	Medea B. Chillemi The Bostany Law Firm 40 Wall Street- 61st Floor New York, NY 10005 UNITED STATES andrew.sweeney@bozlaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Adrienne S. Kosta
Filer's e-mail	akosta@bozlaw.com
Signature	/ASK/
Date	09/19/2007
Attachments	MotiontoAmend.9.19.07.pdf ( 2 pages )(75448 bytes ) NoticeofOpposition.Amended.9.19.07.pdf ( 5 pages )(187546 bytes ) ProofofService.9.19.07.pdf ( 1 page )(23836 bytes )

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

-----x  
GMA ACCESSORIES, INC.,

Plaintiff-Opposer,

- against -

**MOTION TO AMEND**

Opposition No. 91172575

WRIGHT MEDICAL TECHNOLOGY, INC.,

Defendant-Applicant.  
-----x

Applicant's Mark: CHARLOTTE  
Serial No.: 76621053  
Filing Date: Nov. 18, 2004  
Filing Type: ITU  
Class: 10

ADRIENNE S. KOSTA hereby declares, under penalty of perjury pursuant to 28 U.S.C. § 1746, as follows:

1. I am an associate in The Bostany Law Firm, attorney for Petitioner.
2. I respectfully submit this declaration in support of Plaintiff's Motion to Amend its Pleadings.
3. Pleadings in an opposition proceeding may be amended "in the same manner and to the same extent as in a civil action in a United States district court." 37 CFR § 2.107. "A party may amend the party's pleading by leave of court ...and leave shall be freely given when justice so requires." Fed. R. Civ. P. 15(a).
4. We seek to merely notify the Defendant-Applicant of an additional claim to the Opposition proceeding. We respectfully request that the additional claim of dilution be permitted as an additional basis for the Opposition. A mark likely to cause dilution by blurring or tarnishment under section 1125(c) of the Lanham Act may be refused registration. 15 U.S.C. § 1052(f).

5. Here, the Defendant seeks to use the exact same trademark as the Plaintiff to identify a different category of products. It is respectfully alleged that if the Defendant was permitted to accomplish this, the capacity of the CHARLOTTE mark to identify Plaintiff's goods would become diluted and diminished as the public will begin to associate the mark with Defendant's products, i.e. prosthetic devices.

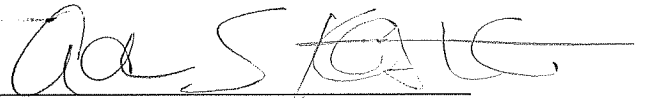
6. The standard for a motion of this nature is liberal and allows amendments where as here the claim is reasonable and logical. *GMA Accessories, Inc. v. DML Marketing Group, Ltd.*, 229 F.R.D. 71 (S.D.N.Y. 2005).

7. Pursuant to Rule 15(a), leave to amend is to be freely given when justice so requires. *Forman v. Davis*, 371 U.S. 178, 182 (1962); *Rachman Bag Co. v. Liberty Mutual Ins. Co.*, 46 F.3d 230, 234 (2d Cir. 1995).

WHEREFORE, we respectfully ask that Plaintiff be permitted to file the attached Amended Notice of Opposition.

Dated: New York, New York  
September 19, 2007

Respectfully submitted,  
THE BOSTANY LAW FIRM



By: Adrienne S. Kosta  
Attorneys for Petitioner  
40 Wall Street - 61st Floor  
New York, New York 10005  
(212) 530-4400

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

-----X  
GMA ACCESSORIES, INC.,

Plaintiff-Opposer,

- against -

**AMENDED NOTICE OF  
OPPOSITION**

Opposition No. 91172575

WRIGHT MEDICAL TECHNOLOGY, INC.,

Defendant-Applicant.

-----X

Applicant's Mark: CHARLOTTE  
Serial No.: 76621053  
Filing Date: Nov. 18, 2004  
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Opposer GMA Accessories, Inc. ("GMA"), through its undersigned counsel of record, hereby opposes the above noted application of WRIGHT MEDICAL TECHNOLOGY, INC. (the "Applicant") and in support thereof respectfully submits as follows:

**FACTS**

1. GMA is the current title owner of the registered mark CHARLOTTE in International Classes 9 (Reg. #2,561,025), 18 (Reg. #2,217,341), 25 (Reg. #2,535,454), and 26 (Reg. #2,216,405), all of which have been deemed incontestable.

2. GMA does business as CAPELLI NEW YORK.

3. Each of these registrations pre-date the defendant-applicant's subject intent to use application which was filed on Nov. 18, 2004.

4. In November of 2001, GMA was assigned all rights to Registration # 1135037.

5. GMA is also the current title owner of CHARLOTTE in Class 22 (Reg. #3,242,358).

6. The GMA Marks consist of words only, with the dominant word CHARLOTTE prominently appearing in block letters.

7. The use of the word CHARLOTTE in the GMA Marks in connection with GMA's products is arbitrary.

8. GMA Marks has used CHARLOTTE, on a nationwide basis, in connection with GMA's products since 1996, and through its assignee since 1979. GMA has incurred substantial expense in promoting and advertising its products under the GMA Marks.

9. The Applicant has not yet begun use in commerce of the mark it seeks to register as an "intent to use" application.

10. The Applicant's Mark consists of words only and prominently incorporates the word CHARLOTTE in block lettering.

#### **COUNT I - LIKELIHOOD OF CONFUSION**

11. In determining whether there is a likelihood of confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E. I. Dupont de Nemurs & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

12. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

13. The Applicant's Mark is similar to the GMA Marks in appearance, sound, connotation and commercial impression.

14. Any doubt regarding the likelihood of confusion must be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ 2d 1025 (Fed. Cir. 1988).

15. The registration and use by the applicant of the CHARLOTTE mark to identify medical products and promotion of the mark CHARLOTTE with respect to medical devices will undoubtedly create confusion with the opposer's long standing CHARLOTTE brand name which has been registered in 9 separate classes for many years.

16. A mark shall be refused registration if it is likely to cause confusion. 15 U.S.C. § 1052(d).

## **COUNT II - DILUTION**

17. GMA repeats and realleges the allegations of paragraphs 1 through 16 as if fully set forth herein.

18. GMA will be damaged by the registration of the Applicant's mark because the mark will likely cause dilution by blurring and tarnishment pursuant to section 1125(c) of the Lanham Act. 15 U.S.C. § 1063(a).

19. A mark likely to cause dilution by blurring or tarnishment under section 1125(c) of the Lanham Act may be refused registration. 15 U.S.C. § 1052(f).

20. A trademark owner may seek an injunction "against another person who, at any time after the owner's mark has become famous, commences use of a trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition or of actual economic injury." *Dan-Foam A/S and Tempur-Pedic, Inc., v. Brand Named Beds, LLC*, 2007 WL 1346609 at \* 9 (S.D.N.Y. 2007) *citing* 15 U.S.C. § 1125(c)(1).

21. The fame requirement is evaluated pursuant to the following factors: (1) duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (2) amount, volume, and geographic extent of sales of goods or services offered under the mark; (3) extent of actual recognition of the mark; and (4) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. *Id. citing* 15 U.S.C. § 1125(c)(2)(A).

22. Here the Charlotte mark is inherently distinctive, incontestable, arbitrary and strong. *GMA Accessories, Inc. v. Bop LLC*, 2007 WL 2483507 at \*2

(S.D.N.Y. 2007). There has also been extensive advertisement and promotion of Plaintiff's CHARLOTTE mark.

23. Plaintiff's CHARLOTTE mark is famous.

24. Defendant's use of its stylized form of the CHARLOTTE mark is likely to cause dilution. *See, e.g., Savin Corp. v. Savin Group*, 391 F.3d 439, 452 (2d Cir. 2004) (Use of by defendant of the same mark is "per se evidence of actual dilution.") "Like being stung by a hundred bees, significant injury is caused by the cumulative effect, not by just one." *Id.* at 449. *See also Dan Foam A/S and Tempur-Pedic, Inc.*, 2007 WL 1346609 at \* 9 citing 15 U.S.C. § 1125(c)(2)(A).

WHEREFORE, GMA respectfully requests that the Defendant-Applicant be refused registration of the above mentioned mark.

Dated: New York, New York  
September 19, 2007

Respectfully submitted,  
THE BOSTANY LAW FIRM



By: Adrienne S. Kosta

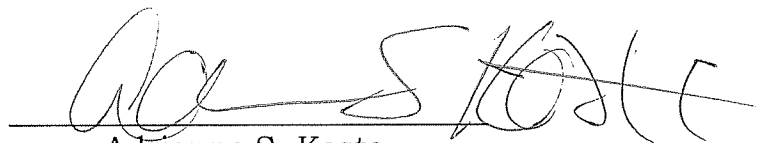
40 Wall Street – 61<sup>st</sup> Floor  
New York, New York 10005  
(212) 530-4400  
Attorneys for Plaintiff-Opposer



**Certificate of Service**

I, Adrienne S. Kosta, hereby certify that the within Motion to Amend and Amended Notice of Opposition is being deposited with the United States Postal Service on September 19, 2007, postage pre-paid, to counsel for Defendant-Applicant as follows:

Maxim Voltchenko, Esq.  
Duane Morris LLP  
30 South 17<sup>th</sup> Street  
Philadelphia, PA 19103-4196  
Attorneys for Defendant-Applicant

A handwritten signature in black ink, appearing to read 'Adrienne S. Kosta', written over a horizontal line.

Adrienne S. Kosta  
The Bostany Law Firm  
40 Wall Street  
New York, New York 10005  
Attorneys for Plaintiff-Opposer  
GMA Accessories, Inc.