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

Proceeding	91199581
Party	Defendant Christina Goerner
Correspondence Address	CHRISTINA GOERNER HODAFEL BUILDING 196 ACTON RD ANNAPOLIS, MD 21403 UNITED STATES bartbags@verizon.net
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Robert J. Eichelburg
Filer's e-mail	lawofficesrje@aol.com
Signature	/Robert J. Eichelburg/
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Attorney Docket No. 99001.00001

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

HUDSON CLOTHING, LLC, Opposer, v. CHRISTINA GOERNER, APPLICANT.	Opposition No. 91199581 Mark: CATHERINE HUDSON Serial No. 85119450 Filed: August 31, 2010

APPLICANT CHRISTINA GOERNER'S MOTION TO DISMISS HUDSON CLOTHING, LLC'S OPPOSITION

Christina Goerner ("applicant") files this Motion to Dismiss Hudson Clothing LLC's Notice of Opposition with prejudice pursuant to Rule 37(b)(2) of the Federal Rules of Civil Procedure.

I. PROCEDURAL BACKGROUND

HUDSON CLOTHING, LLC, ("opposer") attempted to file an opposition against applicant's registration of the mark CATHERINE HUDSON on April 27, 2011. Applicant's only notice of this opposition was received electronically from the Trademark Trial and Appeal Board (TTAB) on April 27, 2011 and it appears that opposer either unintentionally or intentionally led the TTAB to believe that opposer had served the Opposition papers on applicant.[1] They did not, as pointed out in paragraph 13 of

[1] Cf. TTAB April 27, 2011 letter to applicant, p.1, par.1.

applicant's June 3, 2011 Answer. Paragraph 13 of applicant's Answer also requested opposer to provide applicant with a "sworn 'Certificate of Service' " (applicant's answer, par. 13) to establish opposer did in fact serve the Opposition on applicant as they represented to the TTAB. Again, they did not. It is clear that opposers never served applicant since they had time between applicant's June 3, 2011 Answer and the present to produce the Certificate but haven't.

Believing that the Certificate of Service was forthcoming, applicant attempted to enter into settlement talks with opposer, and on July 5, 2011 applicant's counsel conducted a telephone conference with opposer's counsel to address some of the issues, with the understanding that unresolved issues would be addressed the next day. Opposer's counsel was not available to take telephone calls on that day or on July 12, 2011. Opposer's counsel never returned the calls even though requests for call-backs were left on her voicemail on both occasions.

On July 17, 2011 an e-mail to counsel for the opposer requested a return call by no later than July 20, 2011 so that the parties could continue their settlement discussions, however, opposer's counsel did not respond to that request either.

In view of the lack of proper service and opposer's deliberate and calculated intransigence regarding settlement negotiations, applicant now makes this motion to dismiss with prejudice.

The Multiple "Hudson" Trademarks and Oppositions

Applicant hasn't run a complete search of the oppositions opposer has filed but notes three. Opposer filed opposition 91194442 against Reece Solomon for her use of

the name "Reece Hudson;" opposed Application Serial No. 78/819,889 filed by Sophie Hudson, Inc.; and based on the July 5, 2011 telephone conference with opposer's counsel, an opposition against the recording artist and film actress Jennifer Hudson for use of that name on items of apparel.

Opposer's HUDSON trademark ***standing alone*** is a weak mark for clothing and apparel evidenced by the numerous registered trademarks incorporating the term HUDSON for goods in International Class 025, including without limitation, the trademarks HUDSON'S BAY COMPANY, CAMILLE HUDSON, HARVIE & HUDSON, HUDSON, HUDSON VALLEY RENEGADES, HUDSON & COOK, and DOC HUDSON under Registration Numbers 1134716, 2842237,1095302, 2753910, 3060917, 3056233, and 3392827, respectively.

II APPLICABLE LAW

Failure of Service or Proof of Service – Oppositions

Proof of service by the plaintiff is required and must be included with the complaint as filed.[2] The failure to serve a complaint or to include proof of service as of

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[2] 37 C.F.R. §§ 2101 (a), 2,111(a).

the filing date of the complaint may result in dismissal of the opposition proceeding as a nullity.[3]

The Board granted applicant's motion to dismiss two oppositions in *Schott AG v. Scott,* on the ground that opposer failed to serve the notices required under amended Trademark Rules 2.101(a) and 2.101(d)(4).[4] Opposer filed two timely notices of opposition by mail but failed to include a proof of service certificate and failed to serve copies of the notices on applicant's counsel.[5] Opposer did not dispute the fact that it failed to comply with the amended Trademark Rules,[6] but argued that the Notice of Final Rulemaking indicated that the purpose of the service requirement is to "assist the parties in settlement discussions, not to prevent timely filed oppositions." [7] Opposer also argued that it should have the opportunity to cure its failure of service by amending its notices to include proof of service.[8]

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[3] *See generally* Lucasfilm Ltd. v. Biodroid Entm't, Lda., Opposition No. 91191104, 3-4 (T.T.A.B. Sept. 15, 2009), http://ttabvue.uspto.qov/ttabvue/v?pno=91191104&ptv=OPP&eno=5 (dismissing notice of opposition as a nullity because opposer did not comply with the service requirement); Schott AG v. Scott, 88 U.S.P.Q.2d (BNA) 1862, 1862 (T.T.A.B. 2008) (dismissing both opposition proceedings as a nullity for failure to comply with service requirements of 37 C.F.R. §2.101).

[4] 88 U.S.P.Q.2d (BNA) at 1862.

[5] *See id.* at 1863.

[6] *id*

[7] *Id.* (quoting opposer's Response at 1).

[8] *id.*

Although the Board recognized the importance of early settlement discussions, it rejected opposer's arguments.[9] According to the Board, the service requirement fosters the efficient commencement of proceedings and shifts the responsibility of service from the Board (as under the old rules) to the plaintiff.[10] Further, the Board held that opposer could not cure its service oversight by simply filing amended notices.[11]

The Board also denied opposer's motion to amend its notices to include proof of service,[12] holding that "the amended notices of opposition cannot be used as a substitute for the original notices of opposition because, while they bear proof of service, the amended notices of opposition were not filed within the opposition period, as extended." [13] Because the original notices did not include proof of service and were not served in a timely manner, the oppositions were dismissed as a nullity.[14]

Opposer filed its complaint on the last day of the opposition period, as extended, in *Springfield Inc. v. XD,* via the Board's Electronic System for Trademark Trials and Appeals (ESTTA).[15] Opposer checked the box on the ESTTA form indicating that it had

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[9] *See id.*

[10] *id,*

[11] *id* at 1864

[12] *id.*

[13] *id.*

[14] *id.*

[15] 86 U.S.P.Q.2d (BNA) 1063, 1064 (T.T.A.B. 2008).

served applicant.[16] Opposer did not, however, serve a copy of the complaint on applicant.[17]

In an effort to remedy the service oversight, opposer filed a motion to amend the complaint to indicate that it had served a copy on applicant, albeit three weeks after filing the opposition.[18] In dismissing the opposition as a nullity and denying opposer's motion to amend, the Board held that "[t]he proof of service requirement assumes actual service on applicant, or its attorney or domestic representative of record . . . The requirement of the rules is for proof of service, not a promise to make service at some time in the future."[19] The Board also noted that Trademark Rule 2.101 (a) requires the notice of opposition to include proof of service, and the filing date of the opposition is the date on which it is received in the PTO with proof of service on the applicant.[20]

Sanctions

Title 37 of the Code of Federal Regulations, § 2.120 (g) (1) empowers the Board to impose sanctions on any of the parties for failure to participate in settlement conferences. They may make any appropriate order for sanctions

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[16] *id.*

[17] *id.*.

[18] *id.*

[19] *id.*

[20] *id.*

including those enumerated in Fed. R. Civ. P. 37 (b) (2). This includes dismissing the action. [21]

III. ARGUMENT

Opposer has had ample time to document service of this opposition on applicants, but even at this late date they have not done so, nor offered any explanation for this lack of documentation. Simply put, the facts and opposer's silence on the issue confirm they never served applicant with the Notice of Opposition.

Coupled with the lack of *bona fides* in engaging in settlement negotiations, the opposer's other oppositions regarding use of the name HUDSON and the number of registered marks incorporating HUDSON in International Class 025 showing the mark is a weak mark, they attempt to monopolistically advance their position, more by bluster than substance. The opposition should be dismissed; *AG v. Scott,* (*supra*), Trademark Rules 2.101(a) and 2.101(d)(4) and *Springfield Inc. v. XD*. (*supra*). Title 37 of the Code of Federal Regulations, § 2.120 (g) (1) and Fed. R. Civ. P. 37 (b) (2) empower the Board to dismiss the action.

In view of opposer's failure to serve applicant, failure to conduct *bona fides* settlement negotiations, the overall weakness of the mark HUDSON standing alone, and HUDSON CLOTHING, LLC's monopolistic filing of multiple oppositions, applicant asks for dismissal of this action with prejudice.

[21] Fed. R.Civ. P. 37 (b) (2) (v).

IV. CONCLUSION

WHEREFORE, applicant respectfully requests that this Opposition be dismissed with prejudice and that applicant's mark be granted registration.

Respectfully Submitted,

/ Robert J. Eichelburg /

Dated: July 22, 2011

Robert J. Eichelburg, Reg. 23,057
Attorney for APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of July, 2011, that a true copy of the foregoing Motion to Dismiss was served by the United States first class mail, certified mail and return receipt requested, and postage prepaid, on counsel for opposer at the following address of record:

Rita Weeks, Esq.
McDermott Will & Emery LLP
600 13th Street NW
Washington, D.C. 20005

/Robert J. Eichelburg/

Robert J. Eichelburg
Attorney for applicant
Hodafel Building
196 Acton Road
Annapolis, MD
(410) 295-1508

Date: July 22, 2011