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

Proceeding	91266412
Party	Plaintiff Aerus Concepts, L.P.
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Date	02/16/2021
Attachments	Response To Motion To Set Aside Notice of Default - AERASAN 91266412.pdf(915516 bytes )

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

In the Matter of Serial Number 88710153.

Aerus Concepts, L.P.

Opposer,

v.

Stein & Co. GmbH,

Applicant.

Opposition No. 91266412  
Mark: AERASAN

**RESPONSE TO APPLICANT’S REPLY TO AND BRIEF  
IN SUPPORT OF SETTING ASIDE NOTICE OF DEFAULT**

Aerus Concepts, L.P. (“Opposer”) files this response with respect to the February 6, 2021 Reply To And Brief In Support of Setting Aside Notice of Default (“Default Response”) and Answer filed by Stein & Co. GmbH (“Applicant”). Applicant’s boilerplate response fails to show cause for why default judgment should not be entered against Applicant. Allowing Applicant to avoid default judgment despite offering next to no information to explain the cause for the delayed filing of the Answer would run afoul of the Board’s own rules regarding default, and would effectively reduce those rules to a mere formality. Applicant and its attorney were well aware of the Answer deadline prior to their failure to file the Answer on time.

**Relevant Facts**

On December 8, 2020, counsel for Opposer emailed counsel for Applicant at his email address of record, tm-docket@sturmanlaw.com. (**Exhibit A**) In the email, among other things, counsel for Opposer requested abandonment of Application Serial No. 88710153. (**Id.**) Counsel for Opposer also informed Applicant’s counsel of the opposition deadline and the availability of an additional extension with Applicant’s consent. (**Id.**) To date, neither Opposer nor its counsel has received a response to this email.

Having received no response from Applicant’s counsel, Opposer filed a Notice of Opposition against Application Serial No. 88710153 on December 9, 2020. (1 TTABVUE 1-26) The Board instituted Opposition No. 91266412 that same day and established January 18, 2021 as the Answer deadline. (2 TTABVUE 1-7; 3 TTABVUE 1) After Applicant failed to file or serve an Answer, the Board issued a Notice of Default on January 29, 2021. (4 TTABVUE 1)

More than one week later, on February 6, 2021, Applicant finally filed the Default Response and an Answer. (5 TTABVUE 1-7; 6 TTABVUE 1-7) The Default Response cites, without explanation, various court holdings as well as the Code of Federal Regulations and the Trademark Trial and Appeal Board Manual of Procedure. (5 TTABVUE 1-7) Otherwise, the Default Response contains only one explanation of Applicant’s failure to file the Answer, namely, that there was “a technology error on the part of Applicant’s counsel.” (5 TTABVUE 4) The Default Response provides no elaboration on the nature of the “technology error” or why it caused Applicant to miss the Answer deadline. (5 TTABVUE 1-7)

### Argument

Generally, the Board will not enter default judgment if the defendant shows all three of the following factors: “(1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action.” TBMP § 312.02.

**I. Applicant Has Not Provided Any Evidence or Explanation for Why Its Failure to File an Answer by the Deadline Was Not the Result of Willful Conduct or Gross Neglect.**

The principal reason for why the Board should reject the Default Response and enter judgment in Opposer’s favor is because Applicant has provided no information or evidence to establish that its conduct was not willful or grossly negligent. Instead, the Default Responses recites primarily three things: (1) citations to law, without explanation, (2) tautological allegations that Applicant did not act intentionally and that Applicant acted in good faith and (3) an unexplained reference to a “technology error” on the part of Applicant’s counsel that provides no information or context as to how that error caused Applicant to

miss the Answer deadline. In other words, the Default Response is little more than boilerplate language that sheds no light on the reason for Applicant's failure to file its Answer in a timely fashion.

It is noteworthy that the Default Response does not acknowledge Opposer's December 8, 2020 email, which specifically informed Applicant's counsel of the opposition deadline and the availability for extensions. (**Exhibit A**) This email is relevant for two reasons. First, assuming it was received, the email constitutes actual notice to Applicant's counsel of the opposition deadline and, by implication, notice that an Answer deadline would be set upon the filing of an opposition. Second, if the email was not received because of the alleged "technology error," then it begs the question of why the technology error was not fixed or addressed over a two month span.<sup>1</sup> What these possibilities show is evidence of gross negligence, either because Applicant's attorney had notice of the likely timeline for the opposition or because Applicant's attorney did not fix a technology issue that had lingered for months. Regardless, Applicant has not provided any explanation for these failures.

As a result, the Default Response does not and cannot establish that Applicant's conduct was not willful or grossly negligent. Allowing Applicant to escape its obligations to provide a full and clear explanation would effectively render the Board's rules regarding default a mere formality. The Board should reject Applicant's arguments and enter default judgment in favor of Opposer.

## **II. Applicant Has Not Established that It Has a Meritorious Defense.**

The Board should also reject Applicant's arguments because Applicant has failed to address whether it has a meritorious defense, which is the third prong of the Board's rule for setting aside a notice of default. To establish a meritorious defense, a defendant must provide "a plausible response to the allegations in the complaint." TBMP § 312.02.

Here, Applicant has provided no information regarding its defense, let alone whether it has a meritorious defense. Instead, the Default Response merely recites law and repeats assertions that Applicant

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<sup>1</sup> It is also unclear whether Applicant or its attorney received the Board's Notice of Institution as the Default Response conspicuously does not address this. If Applicant or its attorney did receive the notice, Applicant must explain how it nonetheless missed the Answer deadline.

did not intentionally delay its filing and that Applicant acted in good faith. These shallow allegations do not meet the third requirement for avoiding entry of default judgment.<sup>2</sup>

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For the foregoing reasons, Opposer respectfully requests that the Board reject the Default Response, deny the late-filed “Answer,” and enter default judgment in Opposer’s favor.

Respectfully submitted,



Dated: February 16, 2021

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<sup>2</sup> To the extent that Applicant would argue that its “Answer” constitutes its meritorious defense, the Board should reject such an argument. To accept it would be to validate the “Answer” before consideration of the Default Response. At this time, the late-filed “Answer” is not valid and should be given no consideration.



# EXHIBIT A

## Lombardozi, Vincent C.

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**From:** Lombardozi, Vincent C.  
**Sent:** Tuesday, December 08, 2020 11:35 AM  
**To:** 'tm-docket@sturmanlaw.com'  
**Cc:** Sherman, Adam C.; Horan, Miranda J; IPLaw  
**Subject:** AERAPURE (88710142), AERAPURA (88710149) and AERASAN (88710153)

**Follow Up Flag:** Follow up  
**Flag Status:** Flagged

**Categories:** To Do, Awaiting Follow Up

Dear Mr. Sturman,

Our firm represents Aerus Concepts, L.P. and its related companies (“Aerus”). Aerus is a manufacturer and seller of purification and filtration devices, and other sorts of air movement devices and related parts, such as vacuums. As you might guess, Aerus is also the owner of the trademark AERUS and of many U.S. and international registrations and pending applications for marks containing the mark AERUS. These include several U.S. registration including, *inter alia*, AERUS (Reg. No. 5936669), AERUS (Reg. No. 3142464), AERUS (Reg. No. 3142468), and BEYOND BY AERUS (Reg. No. 4582963), all of which claim vacuums and vacuum-related parts and services.

Aerus recently learned of your client’s applications for the marks AERAPURE, AERAPURA and AERASAN, for which we filed extensions of the opposition deadline for each in order to study the marks further. The reason I write today is to inform you that upon consideration, Aerus has decided not to oppose the AERAPURE and AERAPURA applications at this time. However, Aerus is concerned about the likelihood of confusion that may arise from use and registration of the AERASAN mark (Ser. No. 88710153). That mark begins with and contains a prefix that is very similar to the AERUS mark and claims products that are identical or highly related to those claimed in the AERUS registrations and/or sold by Aerus. Given that the AERUS mark is our client’s house brand, it is especially important that our client ensure that third parties do not encroach upon that brand or use marks that could cause consumer confusion. For this reason, we intend to file an opposition against the application for AERASAN.

That being said, I am writing today to see if, instead of undergoing the expense of an opposition, your client would agree to withdraw the application today. Given that our client is not opposing your client’s other two applications, it is clear that your client has alternative marks that it can pursue instead. Please let me know if your client will affirmatively abandon the AERASAN mark (Ser. No. 88710153). If you would like additional time to discuss, be aware that our current opposition deadline is tomorrow, December 9, 2020; we require your consent for any further extensions. However, we do not envision an agreement that would allow registration of the AERASAN mark.

Kind regards,

Vince