

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

SAMUEL ROSENBLATT &)
HELENE ROZENBLAT d/b/a)
ERES)
) Petitioners)
))
v.)
))
ERES)
) Registrant)

Cancellation No. 92044209

**PETITIONERS' OPPOSITION TO REGISTRANT'S
MOTION FOR SUMMARY JUDGMENT**



05-04-2005

U.S. Patent & TMO/TM Mail RcptDt. #74

I. INTRODUCTION

Petitioners, Samuel Rosenblatt and Helene Rozenblat, individual residents of the State of California, doing business as Eres (hereinafter "Petitioners"), pursuant to Federal Rules of Civil Procedure Rule 56, hereby submit their opposition to the motion for summary judgment filed by Registrant, Eres (hereinafter "Registrant") in relation to the above-captioned action. This Opposition is supported by the concurrently-filed Declarations of Helene Rozenblat, and Robert J. Kenney, Esq., along with the exhibits thereto.

Registrant's summary judgment motion is based upon the doctrine of res judicata, and Registrant claims that the decision of this Board in Cancellation No. 12,343 operates as a bar to this action pursuant to that doctrine and there are, therefore, no genuine issues of material fact to be tried. For the reasons set out herein, as supported by the accompanying Declarations and documents, Petitioners submit that res judicata does not apply, and that genuine issues of material fact exist which preclude the entry of summary judgment.

II. Statement of Facts

Petitioners, Samuel Rosenblatt and Helene Rozenblat, are husband and wife who have been doing business under the trademark and trade name ERES in California and elsewhere in commerce in the United States in connection with a retail store and clothing items sold therein continuously since their adoption of the mark in 1956. Petitioners operated their ERES store in Beverly Hills for over 25 years before moving to 10305 Santa Monica Boulevard, West Los Angeles, adjacent Beverly Hills. [Rozenblat, ¶¶ 2, 3]. Although Petitioners' store in West Los Angeles is temporarily closed due to a massive street construction project on Santa Monica Boulevard, Petitioners intend to re-open the store when that construction is completed. [Rozenblat, ¶ 16].

In about 1979, the Petitioners became aware that another party, Madame Irene Pinkus, had obtained a registration on October 5, 1976 for the mark ERES TOP SHOP under Registration No. 1,049,649 for "bathing suits, beachwear, and women's sportswear, namely, tunics, coats, dresses, skirts, and pants." Believing that the registration of the mark ERES TOP SHOP for such clothing items caused a likelihood of confusion with their ERES mark, which had then been in use by the Petitioners for twenty years, the Petitioners filed a Petition to cancel the ERES TOP SHOP mark under Cancellation No. 12,343, with the assistance of their son, an attorney who was not familiar with the rules of the Trademark Trial and Appeal board for such procedures. [Rozenblat, ¶ 3]. As a result of that unfamiliarity with those rules, the Petitioners failed to take any testimony in that proceeding. [Rozenblat, ¶ 3]. This, of course, significantly hampered the Petitioners' ability to successfully prosecute that action, and it was eventually dismissed by the Board for the failure of the Petitioner to carry his burden of proof. [Rozenblat, ¶, 3; Kenney, ¶ 2, Exhibit 1].

During that prior cancellation proceeding, Registrant, Madame Pinkus moved to amend her registration to claim the benefit of foreign registrations from France. [Rozenblat, ¶ 4; Kenney, ¶ 3, Exhibit 2]. The Board ruled on the motion, stating firstly that Madame Pinkus did not appear to be the exclusive owner of any of the three foreign registrations from which she sought the benefit of priority. [Rozenblat, ¶ 5; Kenney, ¶ 4, Exhibit 3]. In addition, the Board also stated that "The French registrations are for the mark ERES, while the United States Registration is for the mark "ERES TOP SHOP." The registrant has materially changed the nature of its mark in the United States registration and is thereby precluded from claiming the benefits of Section 44(e) of the Trademark Act." [Rozenblat, ¶ 6, Exhibit 2, Kenney, Exhibit 3].

It also appears that, at the time she obtained the registration for the mark ERES TOP SHOP, Madame Pinkus was not the owner of that mark. Documents obtained from the appropriate French government agencies show that ERES TOP SHOP was owned by a corporation called Collon. [Rozenblat, ¶ 12, Exhibit 5]. In addition, it appears that Madame Pinkus had granted to Collon the exclusive rights to the ERES mark for the United States and Canada. [Rozenblat, ¶ 13, Exhibit 6].

On December 7, 1998, the Registrant filed an application to register the mark ERES, claiming a first use date of 1969. That mark registered to the Registrant on February 22, 2000, for "swim wear, beachwear, pants, shirts, dresses, blouses, t-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits, and underwear." The Petitioners were unaware that such application had been filed, or that the mark had been registered. [Rozenblat, ¶ 7-9]. Nor were Petitioners aware that any party had used the ERES mark in connection with a clothing store until they discovered the Registrant's store in Beverly Hills on December 4, 2004. [Rozenblat, ¶ 8,9].

Upon learning of the existence of the Registrant's ERES store, Petitioners consulted an attorney, Mr. R. Joseph Trojan, who contacted the Registrant on behalf of the Petitioners. [Rozenblat, ¶ 10, Exhibit 3].

Petitioners then filed the present cancellation proceeding on February 16, 2005.

III. ARGUMENT

A. The Standard For Summary Judgment Is High

Summary judgment is a pre-trial device to dispose of cases in which there is no genuine issue as to any material fact, and the moving party is entitled to judgment as a matter of law. *Los Angeles Bonaventure Company v. Bonaventure Associates*, 4 USPQ2d, 1882, 1883 (T.T.A.B. 1987). The evidence must be sufficient for the Board to hold that no reasonable trier of fact could find other than for the moving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 89 L.Ed. 2d 538, 106 S. Ct. 1348, 1356 (1986). In deciding a motion for summary judgment, the trier of fact must view the evidence in the light most favorable to the non-moving party and must draw all inferences in favor of that party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 91 L.Ed. 2d 202, 106 S. Ct. 2505, 2511 (1986).

Thus, summary judgment is a drastic device, since its prophylactic function, when exercised, cuts off a party's right to present his case to the jury, and accordingly, the moving party bears a heavy burden of demonstrating the absence of any material issues of fact. *Nationwide Life Insurance Co. v. Bankers Leasing Association, Inc.*, 182 F.3d 157 (2d. Cir. 1999).

Finally, where a moving party seeks summary judgment based on the application of res judicata, summary judgment is not appropriate if res judicata is not found to apply. *Los Angeles Bonaventure Company*, supra, at 1883.

B. Res Judicata

This Board has quoted with approval the note to Section 13, Restatement (Second) of Judgments (1982), which states that:

"The principal concepts developed in this Chapter are: merger---the extinguishment of a claim in a judgment for plaintiff (§18); bar---the extinguishment of a claim in a judgment for defendant (§19); and issue preclusion---the effect of the determination of an issue in another action

between the parties on the same claim (direct estoppel) or a different claim (collateral estoppel) (§27). The term "res judicata" is here used in a broad sense as including all three of these concepts. When it is stated that "the rules of res judicata are applicable," it is meant that the rules as to the effect of a judgment as a merger or a bar or as a collateral or direct estoppel are applicable.

"Issue preclusion operates only as to issues actually litigated, whereas claim preclusion may operate between the parties simply by virtue of the final judgment. Thus, principles of merger and bar may apply even though a judgment results by default, although care must be taken to ensure the fairness of doing so. *The Young Engineers v. U.S. International Trade Commission*, 721 F.2d 1305, 1314, 219 U.S.P.Q. 1142, 1151 (Fed. Cir. 1983)." *La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a.*, 8 USPQ2d 1143, 1145-46 (TTAB 1988).

Claim preclusion appears to be the relevant doctrine herein, in view of the existence of a final judgment by the Board in the prior proceeding, Registrant is correct that three elements are necessary for claim preclusion to apply are (1) an identity of the parties or those in privity with them; (2) an earlier final judgment on the merits of the claim; and (3) the second claim is based on the same set of transactional facts as the first. *Jet, Inc. v. Sewage Aeration Systems*, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

For the reasons set out below, Petitioner asserts that Registrant has not carried its substantial burden of showing that there are no genuine issues of material fact on all of these necessary elements.

C. Res Judicata Does Not Apply Under the Facts In This Case

1. There Are Genuine Issues of Material Fact Regarding The Privity As Between Madam Pinkus And Eres

Registrant asserts in its motion for summary judgment that "By agreement dated February 17, 1984, Madame Pinkus assigned her rights in the ERES mark to Eres," and that there is, therefore, "privity as between Madame Pinkus and Eres."

As stated by the Registrant, parties may be in privity "when they hold successive interests in the same property." *Int'l. Nutrition Co. v. Horphag Research, Ltd.*, 55 U.S.P.Q.2d 1492, 1495 (Fed. Cir. 2000).

Thus, the "privity" upon which Registrant relies is presumably based on the assertion that Madame Pinkus and Eres hold successive interests in the same property by virtue of that 1984 assignment. However, it appears that Madame Pinkus was not the owner of rights in the ERES mark at the time she purportedly assigned the rights in the mark to Eres. [Rozenblat, ¶ 12, Exhibit 5]. Specifically, Madame Pinkus assigned ownership rights in the ERES mark in the United States and Canada to a corporation called COLLON on June 16, 1976. [Rozenblat, ¶ 13, Exhibit 6]. Thus, whatever rights Eres may claim in the ERES mark in the United States, it appears that those rights cannot derive from "successive ownership" of the mark from Madame Pinkus. As such, there cannot be "privity" between them, and the first element of the *res judicata* argument fails.

2. The Earlier Final Judgment

It is clear that the prior judgment of the Board in Cancellation No. 12,343 issued essentially as a default judgment, since the Petitioner had taken no testimony evidence in support of its case. Nevertheless, for the purposes of this Opposition, Petitioners do not contest that there was a final judgment in the prior action.

2. The Present Action Clearly Does Not Relate to the Same Set of Transactional Facts as the Prior Proceeding

For several reasons, the Registrant has not met its burden of showing that there is no genuine issue of material fact regarding the equivalence of the transactional facts between the present proceeding and the prior action.

(a). The Marks "ERES TOP SHOP" and "ERES" Are Materially Different

First, despite the Registrant's assertions to the contrary, the marks involved in the prior proceeding and the present proceeding are simply not the same. The mark which Petitioner sought to cancel in the prior proceeding was

ERES TOP SHOP, while the mark which is the subject of the present proceeding is ERES. Registrant asserts that the test applied in determining whether the marks at issue in separate proceedings are the same is to determine whether "tacking" is appropriate, namely whether the two marks are "legal equivalents" or give the "same commercial impression." *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 U.S.Q.P.2d 1875, 1893-94 (TTAB 1998).

This Board has already considered and ruled on this issue when, in deciding on the motion of Madame Pinkus to amend her registration in the prior proceeding to recite ownership of her French trademark registrations, it stated that:

"The French registrations are for the mark "ERES" while the United States registration is for the mark "ERES TOP SHOP." The registrant has materially changed the nature of its mark in the United States registration and is thereby precluded from claiming the benefits of Section 44(e) of the Trademark Act." [Rozenblat, ¶, 6, Exhibit 2; Kenney, ¶, 4, Exhibit 3].

Thus, the Board has found, and clearly considers the marks ERES TOP SHOP and ERES to be 'materially different' marks.

A number of the decisions of the Board are consistent with, and support this conclusion. In *Chromalloy American Corporation v. Kenneth Gordon (New Orleans) Ltd.*, 736 F.2d. 694 (Fed. Cir. 1984), Appellant, Chromalloy, owner of the marks GORDON, GORDON-FORS and GORDON OF PHILADELPHIA & Design for men's and women's apparel and sportswear, sought to oppose the registration of the mark LADY GORDON by Appellee, Kenneth Gordon, for men's and women's apparel and sportswear. The parties had previously entered into a consent judgment whereby Appellee would cease using the mark GORDONS OF NEW ORLEANS, and would be free to adopt and register a new mark which included the term GORDON along with another non-geographically descriptive term of four or more letters in equal prominence and style as the GORDON portion of the mark. *Id.*, at 696. When Appellee adopted and sought to register the mark LADY GORDON, Chromalloy opposed. The Board, applying the doctrine of *res judicata*, granted Kenneth Gordon's motion for summary

judgment, finding that Chromalloy's opposition claim was barred as a result of the prior consent judgment. The Court of Appeals for the Federal Circuit reversed, finding that:

"The claim against LADY GORDON is simply not the same claim as one against GORDON OF NEW ORLEANS. The 'transactional facts' are different in that a different mark used over a different period of time is involved. Chromalloy's claim involving LADY GORDON was, accordingly, not extinguishable by the prior judgment under principles of *res judicata*." *Id.*, at 698.

As in the present case, the prior mark of the moving party included a descriptive term, i.e., "OF NEW ORLEANS," and the new mark, LADY GORDON, was used over a different period of time as the GORDON'S OF NEW ORLEANS mark.

On the same principles, the Board concluded in *Polaroid Corporation v. C&E Vision Services, Inc.*, 52 U.S.P.Q.2ed 1954, 1957 that:

"The mark of application Serial No. 73/595,897 comprises only the term POLAREX in typed form. We recognize that as such, it must be accorded "all reasonable manners in which [the mark] could be depicted." *INB National Bank v. Metrohost*, 22 U.S.P.Q.2d 1585, 1588 (TTAB 1992). However, the mark of application Serial No. 75/130,660, i.e., POLAREX (and design), with its unusual lettering, oversized "O" and "X", and overlapping lettering, is very highly stylized and contains design elements. Such stylization and design elements cause applicant's present POLAREX (and design) mark to have a commercial impression different from that of applicant's prior mark.

"In view of the foregoing, we conclude that the present claims asserted by the opposer are not the same as the claim previously asserted by opposer." *Id.*, at 1957.

Thus, even where the differences in the mark involved in one proceeding and that involved in a later proceeding are no more significant than the addition of stylized elements to the same word mark, the Board has found that the marks are not legal equivalents for the purposes of applying *res judicata*.

It is beyond questions that the differences in the marks ERES TOP SHOP and ERES are significantly greater than those in *Polaroid*.

Registrant contends that the decision of the Board in *Miller Brewing Company v. Coy International Corporation*, 230 U.S.Q.P. 675, (TTAB 1986) is applicable in the present case. However, in *Miller*, the Board found that the mark which the applicant, Coy, sought to register did not create a different commercial impression from the mark it had previously sought to register. However, it is clear that *Miller* does not apply herein. In that case, the Board stated that:

"...the changes in the design mark presented herein are so insignificant that even under applicant's theory of the applicability of claim preclusion, we would find this application barred by virtue of the prior judgment." *Id.*, at 678.

As the Board has already decided that the marks ERES TOP SHOP and ERES are materially different marks, the decision in *Miller* can be easily distinguished from the present case.

Thus, it is clear that the mark ERES TOP SHOP involved in the prior cancellation proceeding, and the mark ERES in the present proceeding are materially different marks which create materially different commercial impressions, and res judicata cannot bar the present cancellation proceeding.

(b). The Goods Involved In The Two Proceedings Are Different,
And Res Judicata Therefore Does Not Apply

Aside from the undisputed fact that the marks ERES TOP SHOP and ERES have been found by this Board to be materially different marks, it is also beyond dispute that the goods listed in the ERES TOP SHOP and the ERES registrations are significantly different. Specifically, the prior registration for ERES TOP SHOP listed "bathing suits, beachwear and women's sportswear, namely, tunics, coats, dresses, skirts and pants," while the registration for the mark ERES lists the goods as "swim wear, beachwear, pants, shirts, dresses, blouses, t-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits and

underwear." Thus, the goods in the ERES registration are different from, and much broader than those listed in the prior ERES TOP SHOP registration. The ERES registration includes the additional goods, "shirts, blouses, t-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits and underwear," while omitting the goods, tunics, coats, and skirts.

In a very similar case, the Board found in *La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a.*, 8 U.S.P.Q.2d 1143 (TTAB 1988) that:

"...applicant's present application includes an extended list of additional goods in Class 30, which were not involved in the prior proceeding and hence were not part of the opposer's earlier claim. Thus opposer is not precluded, either by the principle of claim preclusion or the incontestability of applicant's registration, from attempting to demonstrate its priority of the mark "LA FARA" for goods other than alimentary pastes [the goods of the prior registration], and from showing a likelihood of confusion between its use of the mark on such goods and applicant's use of the mark on the various Class 30 items. Because of the genuine issues of material fact which pertain to these questions, summary judgment in favor or applicant is not warranted." *Id.*, at 1146.

Thus, in addition to the fact that the marks involved in the prior proceeding and the present proceeding are materially different, it is clear that pursuant to the decision in *La Fara*, the material differences in the goods in the two registrations at issue would preclude the application of *res judicata*, at least as to those expanded goods in the present ERES registration.

D. Laches, Estoppel and Acquiescence Are Inapplicable To The Present Proceeding

Registrant, in its concluding paragraph, asserts that Petitioners have, over a period of 19 years, taken no action against the Petitioner's use of the ERES mark. That issue is simply not relevant to this action. As Registrant well knows, this proceeding relates only to the issue of the continued registration of the ERES mark by Registrant. *In National Cable Television Ass'n. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 U.S.P.Q. 2d 1424, 1432 (Fed. Cir. 1991), the

Court of Appeals for the Federal Circuit held that since the registration rights that a petitioner objects to come into being as a result of the registration process, not from use alone, laches can only start running from the first time when a petitioner could object to registration: the date when the registrant's application for registration was published for opposition.

Here, the Petitioners, immediately upon learning of the existence of the present registration, and within the time period set out under the trademark laws, took action to voice its objections to, and to cancel that registration. [Rozenblat, ¶ 10]. Thus, as to the issue of the continued registration of the ERES mark by Registrant, no laches, estoppel or acquiescence can be attributed to the Petitioner. That issue is, therefore, simply not relevant in this action.

IV. CONCLUSION

The Registrant seeks summary judgment in this action based upon the application of res judicata from the earlier decision of this Board in Cancellation No. 12,343. Registrant bears a heavy burden of proof, having to demonstrate that there are no genuine issues of material fact to be tried. Clearly, the Registrant has failed to carry that burden herein.

First, all of the Registrant's assertions to the contrary cannot overcome the fact that this Board found that the marks ERES TOP SHOP and ERES are materially different marks. Registrant did not appeal this decision, nor did it cite this decision in its brief in support of the motion for summary judgment.

Nor does Registrant raise the issue that the goods in the two registrations are significantly different, which likewise precludes an application of res judicata, and therefore a grant of summary judgment, at least as to the expanded goods.

Finally, Registrant asserts that summary judgment is warranted because Petitioners have failed to take timely action against the Registrant, when it is clear that Petitioners did precisely what is required under the trademark laws to pursue the rights available in a cancellation proceeding.

Clearly there are significant genuine issues of material fact that must be tried in this action, and the Registrant's motion for summary judgment should be denied.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

Robert J. Kenney
8110 Gatehouse Road
Suite 100 E.
Falls Church, VA 22042
(703) 205-8000

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT, along with the supporting Declarations and exhibits thereto, were served upon Michael Chiappetta, Esq., counsel for Registrant, at FROSS, ZELNICK, LEHRMAN & ZISSU, P.C., 866 United Nations Plaza, New York, NY 10017, via first class mail on this 4th day of May 2005.


Robert J. Kenney

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

3 In the Matter of Trademark Registration No. 2,320,998
4 For the Mark ERES

5 SAMUEL ROSENBLATT & HELENE)
6 ROZENBLAT) Cancellation No. 92044209
7 d/b/a "ERES")
8 Petitioners,)
9 -against-)
10 ERES)

11 Registrant

12
13 DECLARATION OF HELENE ROZENBLAT IN SUPPORT
14 OF REGISTRANT'S MOTION FOR SUMMARY JUDGEMENT

15 I, Helene Rozenblat, declare as follows:

16 1. I am the wife of Samuel Rosenblatt and one of the
17 Petitioners in this proceeding. This declaration is based on my
18 personal knowledge or on records which I have obtained from
19 government offices in France.

20 2. Petitioners are individuals, d/b/a ERES, having a
21 place of business at 10305 Santa Monica Boulevard, West Los
22 Angeles, California 90025. Petitioners are engaged in the
23 business of selling clothing, fabrics, trims and other items.

24 3. Petitioners adopted and used ERES as the trade name
25 and trademark for their retail store and clothing sold therein
26 continuously since at least as early as 1956 in California and
27 elsewhere in commerce in the United States. Petitioners
28 operated their store in Beverly Hills for over 25 years and

1 thereafter in West Los Angeles, adjacent Beverly Hills. In
2 about 1979, Petitioner, Samuel Rosenblatt, filed a Petition to
3 Cancel Registration No. 1,049,649 which was for the mark ERES
4 TOP SHOP. Eventually, that cancellation proceeding was
5 dismissed for failure of Petitioner, Samuel Rosenblatt, to file
6 any testimony or evidence during Petitioner's testimony period.
7 This occurred because Petitioners' son, who was an attorney not
8 familiar with trademark rules and procedures, failed to file any
9 testimony during the testimony period. Thus, the Petition for
10 Cancellation was dismissed on basically procedural grounds for
11 failure to file any evidence.

12 4. During the pendency of the Petition for Cancellation
13 of Registration No. 1,049,649. Madam Irene Pinkus brought
14 Motion before the TTAB for leave to amend her registration and
15 an amendment thereof. In her Motion, she sought to claim the
16 benefit of foreign trademark registrations from France. A copy
17 of her motion is attached hereto as Exhibit 1.

18 5. In ruling on Madam Pinkus' Motion, the TTAB noted that
19 Madam Irene Pinkus, owner of the U.S. Registration, did not
20 appear to be the exclusive owner of any of the three foreign
21 registrations which she then claimed.

22 6. In addition, the TTAB stated at the bottom of page 2
23 of their decision "The French Registrations are for the mark
24 ERES, while the United States Registration is for the mark "ERES
25 TOP SHOP." The registrant has materially changed the nature of
26 its mark in the United States registration and is thereby
27 precluded from claiming the benefits of Section 44(e) of the
28 Trademark Act" (underlining added). A copy of the TTAB decision
is attached hereto as Exhibit 2. Thus, the TTAB has already

1 ruled that the mark ERES and ERES TOP SHOP are materially
2 different.

3 7. After the TTAB dismissed the 1979 cancellation
4 proceeding, my husband and I took no further action since we
5 knew that we had lost that particular proceeding and could take
6 no further action against ERES TOP SHOP. We were totally
7 unaware that anyone had filed a new application for trademark
8 registration for ERES in 1998.

9 8. As far as we were concerned, and as far as we knew,
10 Madame Pinkus had never opened any shop under the name ERES in
11 the Beverly Hills area and thus we assumed that we were free to
12 continue our business under the name of ERES, that we started in
13 1956, without controversy.

14 9. It was not until December 4th of 2004, when we
15 discovered that a store by the name of ERES opened in Beverly
16 Hills, that we were awakened to the fact that someone was
17 attempting to use our name ERES in the Beverly Hills area.

18 10. We immediately investigated at that time and consulted
19 with attorney R. Joseph Trojan who wrote a letter dated January
20 3, 2005, to Ms. (Pinkus) Harrington with respect to the new
21 store in Beverly Hills. A copy of Mr. Trojan's letter is
22 attached hereto as Exhibit 3.

23 11. A response dated January 13, 2005 was sent by
24 attorneys for Ms. (Pinkus) Harrington to Mr. Trojan. A copy of
25 the letter from Barbara Solomon of FROSS ZELNICK LEHRMAN &
26 ZISSU, P.C. is attached hereto as Exhibit 4.

27 12. Madam Pinkus claims that on October 5, 1976, she
28 obtained U.S. Registration No. 1,049,649 for ERES TOP SHOP.
However, she did not own the right to ERES TOP SHOP at that

1 time. Attached hereto as Exhibit 5 are documents which I
2 obtained from the relevant government agencies in France showing
3 that ERES TOP SHOP was registered by a corporation called S.A.
4 COLLON.

5 13. In addition, attached hereto as Exhibit 6 are
6 documents which reflect that Madam Pinkus granted to COLLON the
7 exclusive rights to the ERES mark for the United States and
8 Canada (my hand-written notes added).

9 14. In 1982, Madam Pinkus filed a Section 8 Affidavit and
10 a Section 15 Affidavit certifying under oath that "the mark ERES
11 TOP SHOP was in continuous use in interstate commerce regulable
12 by congress for five consecutive years from October 5, 1976 to
13 the present date." Copies of the Section 8 and Section 15
14 Affidavits are hereto as Exhibit 7.

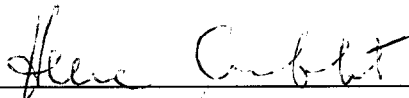
15 15. In Madam Pinkus' declaration for this Summary Judgment
16 Motion, she states in her declaration on page 2, paragraph 5
17 that the mark was in continuous use "with the exception of a two
18 year transition period (1977-1978) during which I was seeking a
19 new distributor for my ERES goods in the United States."
20 Therefore, the declarations under oath in the Section 8 and
21 Section 15 Affidavits were false.

22 16. Due to the massive street construction project, on the
23 street in front of our store, presently on Santa Monica
24 Boulevard, Petitioners have temporarily closed the store. But
25 when construction is completed, Petitioners intend to reopen the
26 store. A copy of an article from the Los Angeles Times dated
27 March 10, 2005, attached hereto as Exhibit 8, describes, and has
28 pictures depicting, the massive street construction project and
how it has affected the store owners on Santa Monica Boulevard

1 in the construction zone. Petitioners have had no choice but to
2 temporarily close their store until construction is completed.

3 I declare under penalty of perjury under the laws of the
4 United States of America that the foregoing is true and correct.

5
6 Executed this 29th day of April, 2005 in Los Angeles,
7 California.

8
9
10 
11 _____
12 Helene Rozenblat



TMT

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

IN THE MATTER OF)
Registration No. 1,049,649)
Date of Registration:)
October 5, 1976)
SAMUEL ROSENBLATT,)
Petitioner for Cancellation,)
vs.)
MADAME IRENE PINKUS,)
Registrant and Respondent.)

Cancellation No. 12,342

MOTION FOR LEAVE
TO AMEND REGISTRATION
AND AMENDMENT THEREOF

Pursuant to section 7(d) of the Act and TMEP sections 501.10 and 1607.03, Registrant hereby moves the Board for leave to amend registration No. 1,049,649 to recite ownership of her French trademark registrations.

AMENDMENT

Please amend the registration by adding the following language:

Registrant claims the benefit under Section 44(e) of French trademark registration 504,277, issued December 1, 1951 and now expired, French registration 122,893, issued March 17, 1959, and French registration 889,810, issued Nov. 27, 1973.

REMARKS

Certified copies and translations of these registrations are appended hereto. The original certificate is lost or destroyed, but an order for a certified copy showing title is attached hereto. Registrant is the sole heir of her parents Francine and the late Leopold Pinkus, original owner of registration 122,893. The only reason these registrations were not recited in the original application because Registrant's U.S. counsel was not informed of

their existence and because registrant was not sufficiently familiar with U.S. practice to call them to counsel's attention. Since Registrant would have been entitled to rely upon these registrations at the time of her original filing and since Petitioner, as a resident of Paris until 1953, had constructive if not actual notice of Registration 504,277, and therefore cannot be prejudiced by Registrant's defensive reliance on these registrations, this amendment should in fairness be approved.

Respectfully submitted,

MADAME IRENE PINKUS

Milton Oliver

Milton Oliver, Esq.

WOLF, GREENFIELD & SACKS, P.C

Attorneys for Registrant

201 Devonshire Street

Boston, MA 02110

(617) 426-6131

MAILED

Cancellation No. 12,342

AUG 18 1981

Samuel Rosenblatt, dba
Eres

PAT. & T. M. OFFICE

v.

Madame Irene Pinkus

On June 10, 1981, the respondent filed a motion for leave to amend U.S. Registration No. 1,049,649. The respondent has requested that the following language be added to the registration:

"Registrant claims the benefit under Section 44(e) of French trademark registration 504,277, issued December 1, 1951 and now expired, French registration 122,893, issued March 17, 1959, and French registration 889,810, issued November 27, 1973."

The registrant has submitted certified copies of the three French registrations and has ordered a certified copy of its U.S. registration in support of the amendment because the original certificate was lost or destroyed. However, it is noted that the respondent has failed to authorize a \$15 fee for a certificate of correction and has not submitted a verified statement or declaration in accordance with Rule 2.20 signed by the registrant. See Rule 2.173.. Therefore, the amendment is not formally correct and is not acceptable.

Moreover, Madame Irene Pinkus, owner of the U.S. registration, does not appear to be the exclusive owner of any of the three foreign registrations which she now claims:

1. French Registration No. 122,893 is in the name of Madame Francine Kahn, the wife of Leopold Pinkus, as co-owners.
2. French Registration No. 504,277 is owned by Madame Leopold Pinkus, formerly Francine Kahn.
3. French Registration No. 889,810 is owned by Madame Francine Kahn and Madame Irene Pinkus, as joint owners.

A party who is related to a registrant may not assert ownership of such registrant's registration nor claim the benefit of the registration. Cf In re Knight's Home Products Inc., 175 USPQ 447 (TTAB, 1972) and In re Air Products, Inc., 124 USPQ 81 (TTAB, 1960). The respondent should demonstrate that it is the owner of the French registrations and that it is therefore entitled to the benefits of Section 44(e) of the Trademark Act.

In addition to the foregoing, the respondent's proposed amendment is not acceptable because only French registration 889,810 appears to have been a valid registration at the time the U.S. registration was issued. The foreign registrations must be in force and effect at the time the United States registration issues. See Rule 2.39(a) and TMEP Section 1002.

In addition, the respondent is not entitled to claim the benefits under Section 44(e) because a party may not obtain a registration in this country broader in scope than the registration issued in the country of origin. Article 6 of the International Convention for the Protection of Industrial Property provides, so far as pertinent:

"A. Every trademark duly registered in the country of origin shall be admitted for registration and protected in the form originally registered in the other countries of the Union..."

The French registrations are for the mark "ERES" while the United States registration is for the mark "ERES TOP SHOP". The registrant has materially changed the nature

of its mark in the United States registration and is thereby precluded from claiming the benefits of Section 44(e) of the Trademark Act.

It is also noted that French registration 504,277, which appears to have expired before the U.S. application was filed, is for stockings and that the U.S. registration exceeds the scope if the goods set forth in the French registration. See Rule 2.39 and TMEP Section 1007.

Finally, at this point in the cancellation proceeding, there appears to be little, if any, purpose in amending the registration. The presumption of use created by a registration relates back to the filing date of the application. American Throwing Co., Inc. v. Famous Bathrobe Co., Inc., 116 USPQ 156 (CCPA, 1957) and The J. R. Clark Company v. Queen Manufacturing Co., Inc., 150 USPQ 73 (TTAB, 1966). A foreign registrant is not entitled to rely on the dates of use corresponding to the issue date of a foreign registration. Such registration is of no evidentiary value in this proceeding. The Barash Company, Inc. v. Vitafoam Ltd., 155 USPQ 267 (TTAB, 1967). Therefore, the respondent is required to submit evidence to show use of the mark earlier than the filing date of the application. In order to prove use prior to that alleged in the application, the respondent must establish such use by clear and convincing evidence. Elder Manufacturing Co., v. International Shoe Co., 92 USPQ 330 (CCPA, 1952). Any use of the mark outside the United States is wholly immaterial and irrelevant to the respondent's right to use and register the mark in the United States. Scotto v. Mediterranean Importing Co., Inc., 162 USPQ 415 (TTAB, 1969). Since the proposed amendment is of no evidentiary value in this cancellation proceeding, there is little point in amending the registration until the cancella-

tion proceeding reaches final disposition.

Accordingly, the respondent's motion to amend the registration is denied.

G. D. King for RLS
R. L. SIMMS
Acting Member, Trademark
Trial and Appeal Board

cc:

Willy Rosenblatt
2040 Avenue of the Stars
Fourth Floor
Los Angeles, California 90067

Arthur Z. Brookstein
c/o Wolf, Greenfield & Sacks, P.C.
201 Devonshire Street
Boston, Massachusetts 02110

R. JOSEPH TROJAN

YEWON MIN†
DYLAN C. DANG
LARISA R. LACIS*
DAVID KOGAN
SEAN O'BRIEN††

OF COUNSEL
J. NICHOLAS GROSS

† ALSO ADMITTED IN MASSACHUSETTS
* ADMITTED IN ILLINOIS, 11 PATENT AGENT

TROJAN LAW OFFICES

Rexford Plaza
9250 Wilshire Boulevard
Suite 325
Beverly Hills, California 90212
www.trojanlawoffices.com
REGISTERED PATENT ATTORNEYS

FILE COPY

PATENT, TRADEMARK,
COPYRIGHT, TRADE SECRET &
RELATED CAUSES

TELEPHONE (310) 777-8399
FACSIMILE (310) 777-8348

MIN@TROJANLAWOFFICES.COM

January 3, 2005

Ms. Irene Harrington
Eres Limited, Inc.
120 5th Avenue
New York, NY 10022

VIA FACSIMILE and MAIL (212-937-0050)

Re: Eres v. Eres Ltd.
ERES Trademark Infringement
TLO No. 04-12-2372

Dear Ms. Harrington:

This firm represents Samuel Rosenblatt d/b/a Eres ("Eres") in the protection of his intellectual property. Eres is the owner of the trademark ERES ("Mark") for clothing and retail services as used throughout the United States and based in Beverly Hills, California.

It has come to our attention that Eres Limited, Inc. ("Eres Limited") is using the ERES mark in violation of federal trademark law. Eres Limited's unauthorized use of the mark ERES in Beverly Hills constitutes infringement upon Eres' rights in the ERES servicemark as it is likely to cause confusion as to source or affiliation of the Mark. As such, your use of the Mark in Beverly Hills must cease immediately.

Eres has used the ERES mark for clothing and fashion related retail services continuously since 1956, over twelve years before Eres Ltd.'s inception of the use of the mark in 1968. Eres' use of the mark in Beverly Hills has especially prominent, as Eres has used the mark for fashion-related retail services continuously in the city since 1956. Eres has spent substantial time and resources to develop, promote, and protect its Mark, and has been publicly adopted and promoted by celebrities and famous clientele. As a result, Eres' Mark has developed significant goodwill and recognition in the public. Clients who encounter Eres Limited's unauthorized use of the ERES mark will be misled into believing that Eres Limited's goods and services share a common origin as those offered by Eres, especially given Eres' long-standing reputation in Beverly Hills and particularly because Eres has had its retail boutique on Rodeo Drive before Eres Limited. opened its store on the same street. Eres Limited's unauthorized use of the Mark in connection with retail services for clothing in

Eres Ltd.
January 3, 2005
TLO No. 04-12-2372
Page 2 of 2

Beverly Hills is likely to cause confusion as to the origin or affiliation with Eres under Federal trademark law. 15 U.S.C. § 1125, Lanham Act § 43. Further, Eres Limited's misleading usage of the ERES mark also constitutes unfair competition under California law. *See* Cal. Bus. & Prof. Code § 17200. Accordingly, Eres demands that Eres Limited immediately cease and desist from usage of the ERES mark in connection with retail services in Beverly Hills. Your written confirmation of such is requested by **Friday, January 14, 2005**.

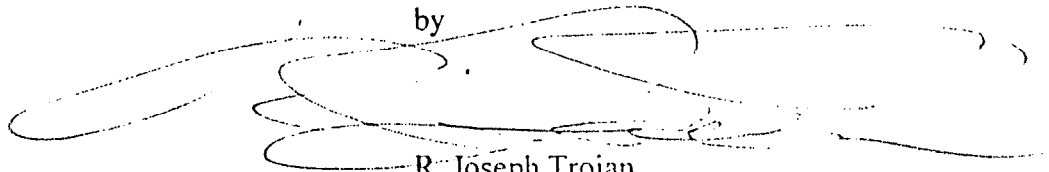
Please be advised that Eres will aggressively enforce its investment in its intellectual property rights. Under Federal law Eres Limited may be liable for treble of Eres' lost profits and costs of litigation in addition to Eres Limited's own profits as damages for its unauthorized, misleading use of the ERES mark. 15 U.S.C. § 1117(a), Lanham Act § 35. In addition, California law allows for recovery of lost profits as well as actual damages for successful trademark infringement and unfair competition claimants. As you have now been put on actual notice of Eres' trademark rights, should you continue to infringe, a jury may also award punitive damages if it determines that you acted maliciously, wantonly or oppressively. Cal.Civ.Code § 3294.

Your anticipated cooperation in resolving this dispute out of court is most appreciated, and we look forward to hearing from you shortly.

Very truly yours,

TROJAN LAW OFFICES

by

A large, stylized handwritten signature in black ink, appearing to read 'R. Joseph Trojan', is written over the printed name below.

R. Joseph Trojan

ym

cc: S. Rosenblatt

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

866 UNITED NATIONS PLAZA
AT FIRST AVENUE & 48TH STREET
NEW YORK, N. Y. 10017

TELEPHONE: (212) 813-5900
FACSIMILE: (212) 813-5901
E-MAIL: 1212@frosszelnick.com

JAMES D. SILVERSTEIN
RUTH V. SAGAN
JOYCE M. FERRARO
PHILIP T. SHAMMOH
MICHELLE D. KOZMAN
GRUNSEL

ROBERT A. RECKER
TAMAR MIV ROSSINGER
ANGELA RIM
LYDIA F. RUBINA
MICHAEL CHIAPPETTA
EVAN SOURVITZ
CARLOS CUCURELLA
HARRY S. BIERNER
ZOE MILBERG
LAUREN J. VANDELL
JAMES D. WEINBERGER
JASON M. VOGEL
VICTOR G. LALLA
DAVID I. GREENBAUM
DAVID DONAHUE
CHARLOTTE BERGER
MELISSA A. ANTONACCIO
NANCY ZABARNA
LAURA ROSE-ROSENBERG
IRENE SEBAL AYERS
KARA BOYLE
JOHN M. CALLACHER
*ADMITTED IN OH ONLY

January 13, 2005

BY FACSIMILE AND MAIL

R. Joseph Trojan, Esq.
Trojan Law Offices
Wexford Plaza
9250 Wilshire Boulevard, Suite 325
Beverly Hills, CA 90212

Re: Objection by Samuel Rosenblatt d/b/a Eres
(Our Ref: ERES USA TC-05/00286; Your Ref.: TLO #04-12-2372)

Dear Mr. Trojan:

We are outside counsel to Eres LLC, formerly known as Eres Limited. Your letter of January 3, 2005 to Irene Harrington has been referred to our firm for response. Your letter requests quite drastic and extraordinary relief. Given what you are seeking we were surprised by the lack of any evidence to support your client's claims. This lack of evidence combined with the facts that we are aware of provides no legal or equitable basis for your client's demands.

As a preliminary matter, I think it would be helpful for you to have a bit of background about our client. Our client or its predecessors have used the ERES mark since 1920 and for decades have operated ERES boutiques in Paris. Through word of mouth, our client's brand became widely known among fashion conscious consumers. In 1969, ERES brand products became available in the U.S. Currently, there are more than 600 doors that sell ERES products around the world, including several stand-alone boutiques. As early as 2000, press reports indicated that our client was contemplating opening a boutique in Beverly Hills. Our client creates and sells luxurious yet simple, feminine and refined clothing focusing primarily on swim wear, cover-ups, loungewear, beachwear and lingerie. The styling, detailing, fabrics, cut, materials and colors are hallmarks of our client's products.

RONALD J. LEHMAN
DAVID WEILD III
STEPHEN BIDDER
MICHAEL I. DAVIS
ROBERT L. ZIFFU
MARIE V. ORIGIELL
RICHARD J. LEHY
DAVID M. ENGLISH
VIVIAN OPTON DOUGLASS
JANET J. HOFFMAN
PETER J. SILVERMAN
LAWRENCE ELI SPOLZON
BARBARA A. BLOOMER
LISA PERAZON
MARK S. IMPELLMANN
MADINE M. JACOBSON
ANDREW M. FARBBERG
ESSROCK NANTICHEVANSKY
ERIE S. MEMBE
PATRICK J. PERKINS
J. ALLISON BYRNEKAMP
JOHN P. BARGIOTTA
MARIA A. SCUNGIO

R. Joseph Trojan, Esq.
January 13, 2005
Page 2

According to the information in your letter and other materials that we have seen, your client claims to have used the ERES mark in the United States since 1956. While this may be prior to our client's use of the mark in the United States, it is not prior to our client's use of the ERES mark in Paris. This is an important fact and one that you neglected to mention in your letter. According to articles we have seen, your client Sam Rosenblatt lived in Paris and in fact worked as a ladies' tailor in Paris from 1947 to 1953. Given these facts, we cannot believe that your client's adoption of the ERES mark upon his return to the United States was mere coincidence uninfluenced or uninspired by our client's growing reputation under the ERES mark in Paris. Not only does your client's adoption of the ERES name coincide with his knowledge of our client's rights in Paris, but his change of logo appears to have occurred soon after our client adopted the stylized version of the ERES mark. According to records, your client left its single location in Beverly Hills approximately 22 years ago when it moved to 10305 Santa Monica Boulevard, a considerable distance from Beverly Hills, if not in mileage then in spirit. The store ultimately became Eres Silk and Woolens. At some point prior to 2001 your client ceased selling clothing. Signage on your client's stores from May 2004 refers only to fabrics and identifies the store as Eres Fabrics. At that time, a large "store closing" banner, together with numerous signs referring to "final sales" were posted. Your client's store signage continues to refer to the store as Eres Fabrics. Notwithstanding your client's claim of trademark rights, your client does not own any trademark registrations for ERES. This is in contrast to our client who owns two federal trademark registrations for the mark.

In order to prevail against our client on either the Lanham Act claim or the California state law claims referenced in your letter, your client has to establish first, prior and continuous rights in the ERES mark for women's clothing; second, that our client's use is likely to cause confusion; and third, that there was no undue delay. From the scant facts set forth in your letter, your client cannot meet this burden.

With respect to establishing rights, your letter fails to address either the effect of our client's federal trademark registrations or the legal consequences that attach to the fact that our client is the senior trademark registrant. Our client owns U.S. federal trademark registration number 2,497,205 for ERES for "retail store services in the field of clothing and clothing accessories" registered October 9, 2001 and U.S. Reg. No. 2,320,998 for ERES (Stylized) for "swim wear, beachwear, pants, shirts, dresses, blouses, T-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, bodysuits and underwear" which registration issued in 2000. We note that your client never opposed the applications or otherwise objected to them. The only time your client did object to a registration of our client was in 1979 when it sought to cancel a registration for ERES TOP SHOP. That action was dismissed. As a matter of law, any rights that your client may claim in the ERES mark were frozen as of the date our client's trademark registrations issued. While your letter is silent as to what use, if any, your client was making of the ERES mark in October 2001, our understanding is that as of that date your client had abandoned its location in Beverly Hills, had a single store located in a commercial area on Santa Monica Boulevard next to a dry cleaners, had limited its retail services to the sale of fabrics and had abandoned whatever rights it had to use the ERES mark in connection with the retail sale of

R. Joseph Trojan, Esq.

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clothing. Indeed your client's operation became known as Eres Fabrics or Eres Silk and Woolens. There is no evidence that as of October 2001 your client was known outside this one geographic location or that your client had any reputation or market penetration in Beverly Hills. Rather, all evidence points to the fact that your client was winding down its use of ERES. The most notable evidence of this is its "store closing" sign posted on or before May 2004.

Looking at the evidence in the best light to your client, the only rights it can conceivably claim to have is the right to use the ERES mark in a geographically limited area for purposes of selling fabric. By your own letter you recognize that our client is not selling these types of products and is not offering its products for sale in your client's territory. Because your client does not have prior or continuous rights in the ERES mark for the goods and services offered by our client, your client's claims must fail. The fact that recently your client has begun putting clothing in its store does not bolster your client's claims. Rather, it could subject your client to liability. Once our client's registration for retail store services for the sale of clothing issued in October 2001, your client was prohibited from expanding into this area of use.

On top of the lack of rights that can be asserted against our client, your client's claims also are barred by laches. Clearly your client had actual as well as constructive notice of our client's rights to ERES for clothing. Our client's registration for clothing issued in 2000. As a matter of law, your client was deemed on constructive notice of these registrations. 15 U.S.C. § 1072. Moreover, your client was on actual notice of our client's use of the ERES mark on clothing. Your client instituted a cancellation action - which was dismissed - seeking to cancel our client's mark ERES TOP SHOP in 1979. Since at least 1977, our client has been selling product under the ERES mark in Los Angeles. Since at least 2000, our client has been sending catalogues to customers in California. Since at least 2000, our client has had a toll-free 800 number that allows customers, including customers from California, to purchase ERES brand products. Since 1975, there have been editorial references and articles about our client in such national publications as *Glamour*, *Harper's Bazaar*, *Allure*, *Mademoiselle*, *Travel & Leisure*, *Elle*, and *Vogue*. As to retail store services, the issuance of our client's registration for such services in October 2001 constitutes constructive notice to your client. On top of this, an article in the December 20, 2000 issue of *WWD* stated that Eres was considering opening a store in Beverly Hills and the July 2, 2004 issue of *WWD* announced that our client was opening a boutique. Through all of this, your client sat back and did nothing. Your client cannot now turn around and claim that it will be injured by our client opening a retail store under the ERES mark when it knew of our client's rights, knew of its plans and has never been injured by, and by its conduct has acquiesced to, the use of the ERES mark on the very items to be sold at the store.

Although we believe based on the information we have that your client has unduly delayed in taking action and that whatever rights your client has are so limited and circumscribed that they cannot defeat our client's rights to exploit its federally registered mark in connection with the very goods and services identified in those registrations, even if your client could overcome these significant hurdles, it still would not be able to obtain the relief requested. Indeed, if anybody is entitled to relief it is our client who would be entitled to an order

R. Joseph Trojan, Esq.
January 13, 2005
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prohibiting your client from selling clothing at any retail stores as such use, occurring as it did after our client's registrations issued and after your client announced it was going out of business, violates our client's exclusive rights in its federal trademark registration. 15 U.S.C. § 1115(a).

To obtain relief, your client must show that there is a likelihood that an appreciable number of reasonably prudent consumers in the marketplace are likely to be confused as a result of our client's opening of a retail store called ERES selling the products that our client has been selling in the U.S. for over 30 years under the ERES mark. There simply is no likelihood of confusion and the evidence shows this to be the case. As you admit, our respective clients have been co-existing for 37 years. Our client has had a strong presence in the Los Angeles area under the ERES mark for decades as a result of its advertising and sales. Yet despite these facts, there is not one scintilla of evidence of actual confusion. This lack of evidence speaks volumes to the issue of likelihood of confusion. As to the other likelihood of confusion factors that are used by the courts, it is clear that your client simply cannot establish a claim against our client.

The first factor is the strength of your client's mark. There is no evidence that your client's mark has any strength in the marketplace generally or among our client's consumers or purchasers of our client's goods. In this regard we note that you have provided not a single piece of evidence as to your client's sales, the number of people who visit the store in any period of time, the demographics of your client's customers, where your client advertised, how your client advertised, the amount spent on advertising, or any other fact to suggest that your client's mark is even known.

The next factor is the proximity or relatedness of the parties' goods. This is not measured as of today but as of the date of our client's federal trademark registration at which point in time your client's rights were frozen. When our client's registration issued in 2001 for retail store services in the field of clothing and clothing accessories in Class 35, your client had a single store that offered fabric and fabric only. These services are not sufficiently related to our client's retail store services featuring swim wear, lingerie, beachwear and related products, all made in Paris and known for their cut, materials and colors.

Turning next to the marks themselves and the degree to which the marketing channels converge, the mere fact that both of our clients use ERES as a mark is not dispositive of your client's claims. Your client uses Eres Fabrics and Eres Silk and Woolens. Our client uses ERES. The messages conveyed are clear and distinct. Also distinct are the contexts in which the marks are presented. Here, the context could not be more different, considering the merchandise sold, the store locations, and each store's appearance. From photographs that we have seen of your client's store, it bears no resemblance to our client's store and no consumer would believe that there is any relationship. Your client has a brick-front building in a commercial neighborhood. Signage on the store refers to fabrics. Most of the signs are missing letters. A large "for lease" sign sits on the storefront. The words "imported fabrics" appear on the side of the building. The words "Eres Fabrics" appears on the top of the building and "Eres Fabrics" appears on the back of the building. Our client is operating a chic luxury boutique on Rodeo

R. Joseph Trojan, Esq.

January 13, 2005

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Drive selling high-quality, high-end merchandise that consumers have been purchasing for years. Indeed, the store will clearly display and sell the very type of product that has been sold and advertised in California under the ERES mark for years. Our client does not go by the name Eres Fabrics or Eres Silk and Woolens and its store bears no conceivable resemblance to your client's store. The neighborhoods in which the stores are located also are fundamentally distinct. As such, consumers would clearly know that the stores are unrelated and that the products offered come from different sources. Your client's recent inclusion over the last six months of retail clothing at its fabric store not only is irrelevant but also is in bad faith given our client's prior trademark registrations for retail store services featuring clothing and for clothing itself.

Also defeating your client's claim is the degree of care exercised by consumers in purchasing the products offered by our client. Consumers who are spending between \$270 and \$400 for a bathing suit and on average over \$100 for underwear -- the very type of merchandise to be sold at our client's boutique -- exercise a high degree of care and brand consciousness. The sophistication of our client's purchasers is further enhanced by the location of our client's store, and the fact that consumers are already familiar with the products and the brand by virtue of our client's presence in Los Angeles and throughout the country for years. The sophistication of our client's consumers, who devote a high degree of care and attention to their selection of merchandise, militates against any finding of likelihood of confusion.

The final factor considered by the courts is our client's intent in adopting the mark. Our client or its predecessors have been using the ERES mark since 1920 outside the United States and since 1969 in the United States. At the time our client adopted the mark, it did not know of your client and at the time it commenced use in the United States it did not know of your client. No evidence points to the contrary.

Finally, your letter ignores in its entirety the balance of equities. Your letter ignores our client's use of ERES for 37 years in the United States without confusion. It ignores our client's use of ERES on products sold and advertised in Los Angeles for decades without confusion. It ignores our client's pre-existing federal trademark registrations for the ERES mark to which your client never objected. It ignores your client's failure to object to our client's use of the ERES mark on any product. It ignores the fact that your client has not had a store in Beverly Hills for 22 years. It ignores the fact that the very signage used on your client's store refers to Eres Fabrics, to imported fabrics, or identifies fabrics, therefore clearly creating a distinction in the minds of consumers between your client's goods and services and our client's goods and services. It ignores some very hard to explain coincidences including the fact that your client worked in Paris from 1947 to 1953 when our client's ERES mark was being used and then adopted the name in the United States in 1956, that it adopted a stylized version of the ERES mark only after our client first introduced its own stylized version, and that it suddenly decided not to go out of business, after advising in May 2004 that it would be closing, after it was announced in *WWD* that our client was opening a store in Beverly Hills. And it ignores the fact that despite the press reports dating back to 2000 about our client coming to Beverly Hills, it was

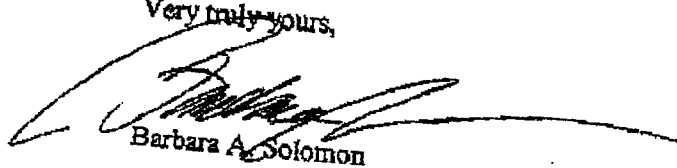
R. Joseph Trojan, Esq.
January 13, 2005
Page 6

not until last week that your client decided to object. Our client has conducted itself in good faith and in an equitable manner. Can the same be said of your client?

Given all of the above, we see little substance to your conclusory statement that our client's use of its ERES mark in connection with retail store services in Beverly Hills would violate any rights your client claims to have or would violate either the Lanham Act or California state law. Accordingly, based on the lack of evidence in your letter and the information that we have obtained from our own investigation, we simply cannot agree to the unwarranted demand in your letter that our client "cease and desist from usage of the ERES mark in connection with retail store services in Beverly Hills." Should you have in your possession any facts or evidence to contradict our information, we of course stand ready to review. Further, if there is anything in this letter that you wish to discuss, please feel free to contact me at the above address or if I am not available contact our client's lawyer in California, Joseph Gabriel at the Liner Yankelevitz Sunshine and Regenstreif law firm. We trust, however, that after you review the attached, you will agree that this matter can and should be closed.

This letter is written without waiver of any of our client's rights, remedies and defenses all of which are expressly reserved.

Very truly yours,



Barbara A. Solomon

BAS/skm,gc,dod,gc

cc: Joseph M. Gabriel, Esq. (by fax & email)
Ms. Irene Harrington (by fax)



Cadre réservé au greffe et à l' I.N.P.I.

ENREGISTREMENT

DEPOT DE MARQUE

INSTITUT NATIONAL
de la PROPRIÉTÉ INDUSTRIELLE

le 23 JUIL. 1970 à 16 heures

N° de dépôt : 101167

effectué à l'Institut National de
la propriété industrielle

N° d'enregistrement : 817408

1 - MANDATAIRE - Nom et adresse :

Sorin WERBA
Conseil Juridique
30^a rue de Léningrad
PARIS 8^e ou bien Melle KOCHIN Michèle

2 - DEPOSANT - Nom ⁽¹⁾, prénoms, domicile, nationalité :
(Dénomination, forme juridique, siège)

S.A. COLLON
Représentée par Madame FINKUS
2, rue Tronchet
PARIS 8^e

3 - Couleurs (combinaison, disposition) revendiquées :

Modèle de la Marque



4 - Produits ou services désignés :

Tissus ; couvertures de lit et de table, articles textiles non
compris dans d'autres classes.

Vêtements, y compris les bottes, les souliers et les pantoufles.
En particulier, maillots de bains.

5 - Classes de produits ou services : 24 et 25

6 - Renouvellement du dépôt opéré le _____ à _____

INSTITUT NATIONAL
de la
PROPRIETE INDUSTRIELLE

BUREAU DES REGISTRES NATIONAUX
DES BREVETS ET DES MARQUES
ET DES DECHEANCES

INSCRIPTION **86237**
DATE : **-1 OCT. 1973**

DEMANDE d'INSCRIPTION au REGISTRE NATIONAL des MARQUES d'un ACTE PORTANT :
des Brevets et des Marques
et des déchéances

~~concession (1)~~
~~concession~~
concession de licence
~~concession de licence~~
~~concession de licence~~
~~concession de licence~~

MINISTÈRE DU DEVELOPPEMENT
INDUSTRIEL ET SCIENTIFIQUE

(a) Dénomination des marques : Lieu de dépôt : Date de dépôt : N° du dépôt : N° d'enregistrement à l'I.N.P.I.

" ERES "	T.C. de la Seine	16 Mars 1959	479.097	122.892
" " "			479.098	122.893

1 - Nom, prénom, profession, domicile du titulaire actuel Individuelle Léopold FINKUS représentée par Mesdames Francine et Irène FINKUS, 98, Boulevard des Batignolles, PARIS 17^{ème}

2 - Nom, prénom, profession, domicile du bénéficiaire du droit / au 17 Mars 1973

ou s'il s'agit d'une société :
Dénomination, nature juridique et siège social "COLLON" société anonyme, dont le siège social est à PARIS 8^{ème}, 2, rue Tronchet,

3 - Nature et étendue du droit ~~concessé~~ ~~concessé~~ ainsi que sa durée : licence exclusive d'usage et d'exploitation de la marque pour une durée limitée à compter du 20 Octobre 1968, limitée aux départements de la Seine, S-et-O. et S-et-M.

4 - Nature et date des documents justificatifs fournis :
Acte S.S.P. du 13 Décembre 1968
" " " 5 Avril 1972

Date : Signature

(1) Biffer la mention inutile
(2) Si la demande d'inscription concerne plusieurs marques et si le cadre est insuffisant joindre liste en annexe.

CONTRAT DE CONCESSION DE MARQUE

ENTRE LES SOUSSIGNES :

L'Indivision Léopold PINKUS, représentée par Madame Irène Charlotte PINKUS, divorcée de Monsieur Daniel ROUKHOMOVSKY, demeurant à PARIS (17ème), 98, Boulevard des Batignolles, agissant tant en son nom personnel qu'en celui de Madame Francine PINKUS née KAHN, seules héritières de Monsieur Léopold PINKUS et ce, en vertu d'un pouvoir qui lui a été donné à cet effet,

L'UNE PART,

Et la S.A. COLLON, au capital de 200.000 francs dont le siège social est à PARIS (8ème), 2, Rue Tronchet, immatriculée au registre du commerce de la Seine sous le numéro 58 B 11417 et à l'INSEE sous le numéro 754 75 108 0 930, représentée par Madame Francine KAHN, veuve de Monsieur Léopold PINKUS, Président Directeur Général,

D'AUTRE PART,

IL A TOUT D'ABORD ETE EXPOSE CE QUI SUIIT :

EXPOSE

Aux termes d'un acte S.S.P. en date à Paris du 15 Décembre 1968, enregistré à Paris 8ème Baux, le 23 Décembre 1968, bordereau 8, n° 230, C 27, aux droits de 96.000 francs, Madame Irène, Charlotte PINKUS divorcée de Monsieur ROUKHOMOVSKY, demeurant 98, Boulevard des Batignolles, agissant tant en son nom personnel qu'en celui de Madame Francine PINKUS née KAHN, seules héritières de Monsieur Léopold PINKUS, ont cédé à compter du 20 Octobre 1968, à la S.A. COLLON, un fonds de commerce de bonneterie au détail situé à PARIS (8ème), 4, rue Tronchet avec possibilité pour la S.A. COLLON d'exploiter la marque "ERES", propriété de l'Indivision PINKUS.

CECI EXPOSE, IL A ETE CONVENU CE QUI SUIIT :

Article 1

Madame Irène PINKUS, au nom de l'Indivision Léopold PINKUS, concède par les présentes à la S.A. COLLON représentée par Madame Francine PINKUS, Président Directeur Général, qui accepte :

ire National

Marques

86237

le - 1 OCT. 1973

chef de Bureau

J. Chouet

IP.

J.P.

A

Une licence exclusive d'usage et d'exploitation pour les départements de la Seine, Seine et Oise, Seine et Marne, de la marque de fabrique consistant dans la dénomination "ERES" déposée par Madame Francine PINKUS née KAHN et Monsieur Léopold PINKUS au Greffe du Tribunal de Commerce de la Seine le 17 Mars 1959 sous les numéros 479 097 et 479 098 désignant :

- fils et tissus en tous genres, vêtements confectionnés en tous genres sous-vêtements, pull-over, cardigans, survêtements tricotés en tous genres, collants, combinaisons, jupons, tous articles de lingerie de corps, tous articles de bonneterie en tous genres, bas, mi-bas, corsets, gaines, porte-jarretelles, soutien-gorge, slips, culottes, maillots de bain en tous genres et de toutes formes, chemisiers, corsages, déshabillés, vêtements de nuit, vêtements d'intérieur, ganterie, foulards.

Toutefois, il est ici précisé que Madame Francine PINKUS en accord avec Madame Irène PINKUS, se réserve le droit d'utiliser personnellement la dénomination "ERES" pour le commerce de bonneterie et nouveautés dont elle est propriétaire et qu'elle exploite à PARIS (9ème), 108, Boulevard Haussmann, tout en s'interdisant de céder ou de concéder ladite marque à des successeurs dans l'exploitation de son fonds de commerce et qu'en cas de cessation d'activité pour quelque cause que ce soit de Madame Francine PINKUS, l'exploitation exclusive de la marque, limitée à la région sus-désignée, reviendrait de plein droit à la S.A. COLLON.

Article 2

La présente concession est consentie en conséquence de l'acte sus-énoncé du 15 Décembre 1968.

Article 3

La S.A. COLLON restera libre de faire et de choisir toute publicité qu'elle jugera utile, et sous quelque forme que ce soit, dans les limites imposées par la réglementation en vigueur.

Article 4

Les présentes conventions prendront fin le 17 Mars 1974.

Article 5

La présente concession est strictement personnelle et ne pourra être transférée, directement ou indirectement, totalement ou partiellement, à qui que ce soit, sans le consentement exprès et par écrit des propriétaires de la marque.

I.P.

G.P.

La présente concession ne pourra être considérée comme faisant partie de l'actif de la S.A. COLLON. Elle ne pourra être exploitée par un administrateur judiciaire ou syndic, ni être mise en vente ou en adjudication, sous quelque forme que ce soit.

En conséquence, toute modification de la situation de la S.A. COLLON qui serait de nature à l'empêcher d'exploiter elle-même et librement la présente concession, telle que faillite, liquidation judiciaire, interdiction ou dissolution, entraînera de plein droit la résiliation de la présente concession.

Article 6

Les contractants auront la faculté de dénoncer à tout moment les présentes conventions, à la condition d'avertir par lettre recommandée le cocontractant au moins un an avant la date à laquelle ils entendent fixer la résiliation du contrat.

Tous les différends ou divergences d'interprétation au sujet d'une clause du présent contrat, ou tout cas imprévu pouvant surgir pendant l'exécution, sur lesquels les contractants n'arriveraient pas à se mettre d'accord, devront être soumis au Tribunal de la Seine.

Article 7

Aux fins de présentes, les parties font élection de domicile au lieu de leur domicile et siège respectifs énoncés en tête des présentes.

Article 8

Les frais de préparation et d'établissement des présentes conventions, ainsi que les frais d'enregistrement, sont supportés par la S.A. COLLON.

Fait à PARIS, en quatre exemplaires,
Le quinze décembre mil neuf cent soixante huit

lu et approuvé

Rih

lu et approuvé

J. P. Jinks

INSTITUT NATIONAL
de la
PROPRIETE INDUSTRIELLE

BUREAU DES REGISTRES NATIONAUX
DES BREVETS ET DES MARQUES
ET DES DECHEANCES

INSCRIPTION N°	
DESCRIPTION du REGISTRE NATIONAL des MARQUES	
DATE	N°
10 MAR. 77	102073
Le Chef de Bureau <i>H. Thauver</i>	

DEMANDE d'INSCRIPTION au REGISTRE NATIONAL des MARQUES d'un ACTE PORTANT :

КЭСКСХСХ (1)

ХХРХХХ

avenant à

concession de licence *portant le n° d'inscription 86.237 de*

XXXXXXXXXXXXXXXXXXXXXXXXXXXX

XXXXXXXXXXXX

XXXXXXXXXXXX

1/10/1993

*observation faite que les depots de la
marque en cause ne sont pas cités
dans l'acte fourni*

(2) Dénomination des marques : Lieu de dépôt : Date de dépôt : N° du dépôt : N° d'enregistrement à l'I.N.P.I.

ERES	I. N. P. I.	27 novembre 73	163 247	889 810
			163 248	889 811

1 - Nom, prénom, profession, domicile du titulaire *division Leopold PINKUS, représentée*
Mme Francine KAHN, veuve de Mr Léopold PINKUS,
Mme Irène PINKUS, 98 boulevard des Batignolles - 75017 PARIS
ou s'il s'agit d'une société : *Mme Irène PINKUS, agissant en son nom personnel qu'en*
Dénomination, nature juridique et siège social *nom et comme mandataire de Mme*
FRANCINE PINKUS née KAHN

2 - Nom, prénom, profession, domicile du bénéficiaire du droit

ou s'il s'agit d'une société :

Dénomination, nature juridique et siège social VIVELLOTTE, Société anonyme (anciennement
COLLON) 2 rue Tronchet - PARIS 8ème *exclusive*

3 - Nature et étendue du droit transféré, concédé ou nanti, ainsi que sa durée : *Licence d'usage et d'ex*
exploitation de la marque pour une durée limitée au 1er septembre 1980 à compter du 20 octobre
1968 limitée aux départements de la Seine, Yvelines, Essonne, Hauts de Seine, Seine Saint
Denis, Val de Marne, Val d'Oise et pour les Etats Unis et le Canada, avec droit de sous
4 - Nature et date des documents justificatifs fournis *concéder uniquement pour les USA et le Canada*

Date : Signature :

Acte sous seings privés du 16 juin 1976

(1) Biffer la mention inutile

(2) Si la demande d'inscription concerne plusieurs marques et si le cadre est insuffisant joindre liste en annexe.

INSCRIPTION au REGISTRE NATIONAL des MARQUES

DATE: 10 MAR. 77

102073

Le Chef de BUREAU: *B. Thuret*

page #1

application of registration of mark

DEMANDE d'INSCRIPTION au REGISTRE NATIONAL des MARQUES d'un ACTE PORTANT :

КАВАНОВ (2)

КАВАНОВ

concession de licence portant le n° d'inscription 86237 de

КАВАНОВ/СЕРВЕТИС/КАВАНОВ

КАВАНОВ/СЕРВЕТИС

1/10/1973

*emission of Invention
observation made that the deposit of the
request for cause was not furnished
- facte fourni -*

2) Dénomination des marques	Lieu de dépôt	Date de dépôt	N° du dépôt	N° d'enregistrement à l'I.N.P.I.
ERES	I.N.P.I.	27 novembre 73	163 247 163 248	889 810 889 811

Mme KAHN

1 - Nom, prénom, profession, domicile du titulaire *division Leopold PINKUS, représentée*
 Mme Francine KAHN, veuve de Mr Léopold PINKUS,
 Mme Irène PINKUS, 98 boulevard des Batignolles - 75017 PARIS
 ou s'il s'agit d'une société : *Mme Irène PINKUS, agissant en son nom personnel qui est
 Dénomination, nature juridique et siège social nom et comme mandataire de Mme KAHN*
joint ownership.
 FRANCINE PINKUS née KAHN

2 - Nom, prénom, profession, domicile du bénéficiaire du droit
beneficiary
 ou s'il s'agit d'une société :
 Dénomination, nature juridique et siège social VIVELLOTTE, Société anonyme (anciennement
 COLLON) 2 rue Tronchet - PARIS 8ème *(registered Eres top exclusive)*

3 - Nature et étendue du droit transféré, concédé ou nanti, ainsi que sa durée : Licence d'usage et d'exploitation de la marque pour une durée limitée au 1er septembre 1980 à compter du 20 octobre 1968 limitée aux départements de la Seine, Yvelines, Essonne, Hauts de Seine, Seine Saint Denis, Val de Marne, Val d'Oise et pour les Etats Unis et le Canada, avec droit de sous
 4 - Nature et date des documents justificatifs fournis concéder uniquement pour les USA et le Canada

Acte sous seings privés du 16 juin 1976

1) Biffer la mention inutile
 2) Si la demande d'inscription concerne plusieurs marques et si le cadre est insuffisant joindre liste en annexe
*observation registration of mark not cited in application
 assignment) act furnished -
 additional assignment for USA and Canada, with
 right to sous concède only for USA and Canada*

10⁰⁰-213-TM



DECLARATION UNDER SECTION 8

Registrant: Madame Irene Pinkus
Reg. No.: 1,049,649
Registered: October 5, 1976
Mark: ERES TOP SHOP
Class No.: 25

Madame Irene Pinkus declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document or of said registration; and that she is the owner of said Registration No. 1.049,649, dated October 5, 1976, as shown by the records in the Patent and Trademark Office; that the mark shown therein has been in continuous use in interstate commerce regulable by Congress for five (5) consecutive years from October 5, 1976 to the present date, on or in connection with the the following items recited in the registration:
Bathing suits, beachwear and women's sportswear
--namely, tunics, coats, dresses, skirts and pants;
that the mark is still in use in interstate commerce regulable by Congress in connection with said items, as evidenced by the attached specimen and/or facsimile showing the mark as actually used.

Registrant hereby appoints, with full powers of substitution and revocation, the following as its attorneys to file this declaration and to transact all business in the Patent and Trademark Office in connection therewith:

- | | | | |
|-------------------|------------|-------------------|------------|
| David Wolf | No. 17,528 | Edward Perlman | No. 28,105 |
| George Greenfield | No. 17,756 | John L. Welch | No. 28,129 |
| Stanley Sacks | No. 19,900 | Milton Oliver | No. 28,333 |
| Alfred Rosen | No. 16,031 | Paul Kudirka | No. 26,931 |
| Louis Orenbuch | No. 17,318 | Susan Haddad Hage | No. 29,646 |
| David Driscoll | No. 25,075 | John W. Kepler | No. 30,397 |
| Arthur Bookstein | No. 22,958 | Lawrence Green | No. 29,384 |

Address all correspondence to Wolf, Greenfield & Sacks, P.C., 201 Devonshire St., 6th Floor, Boston, MA 02110. Direct all telephone calls to Milton Oliver at (Area Code 617) 426-6131.

Date: July 15th, 1982

Madame Irene Pinkus

08/23/82 1049649

3 213 10.00CK



16 309-7001

DECLARATION UNDER SECTION 15

Registrant: Madame Irene Pinkus
Reg. No.: 1,049,649
Registered: October 5, 1976
Mark: ERES TOP SHOP
Class No.: 25

Madame Irene Pinkus declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document or of said registration; and that she is the owner of said Registration No. 1,049,649, dated October 5, 1976, as shown by the records in the Patent and Trademark Office; that the mark shown therein has been in continuous use in commerce regulable by Congress for five (5) consecutive years from October 5, 1976 to the present date, on or in connection with the the following items recited in the registration: bathing suits, beachwear and women's sportswear - namely, tunics, coats, dresses, skirts and pants; that the mark is still in use in interstate commerce regulable by Congress in connection with said items; that there has been no final decision adverse to Registrant's claim of ownership of such mark for such items or its right to register the same or keep the same on the register; that there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not fully disposed of.

01/03/84 1049649

2 309

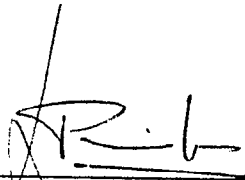
100.00 CK

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George Greenfield	No. 17,756	Edward F. Perlman	No. 28,105
Stanley Sacks	No. 19,900	John L. Welch	No. 28,129
Alfred Rosen	No. 16,031	Paul Kudirka	No. 26,931
Louis Orenbuch	No. 17,318	Lawrence Green	No. 29,384
Arthur Bookstein	No. 22,958	Susan Haddad Hage	No. 29,646

Address all correspondence to Wolf, Greenfield & Sacks, P.C., 201 Devonshire St., 6th Floor, Boston, MA 02110. Direct all telephone calls to (Area Code 617) 426-6131.

Date: December 12, 1983

By 
Madame Irene Pinkus
Title: Owner

CALIFORNIA

LOS ANGELES EDITION

Thursday, March 15, 2005

latimes.com/calif

I don't know how much longer I can last... My business is down 75%.
All Golbad, owner of City Copy and Printing shop on Santa Monica Boulevard



MASSIVE UNDETECTING. Officials say unexpected engineering problems and the season's unusually wet weather have knocked the Santa Monica Boulevard Transit Parkway project seven months behind schedule. The projected completion date for the work, which began in March 2003, is now March 2006.

Barak VASBERG, BRUNO LA AZARIE/THIRD STREET

A Big Bump in the Road for Businesses

Santa Monica Boulevard widening project is a headache for local shop owners, who say their sales have plummeted.

By Bob Pool, Times Staff Writer

First they blocked off the street in front of his shop. Then they dug up the sidewalk outside his door.

But the really bad news for shopkeeper All Golbad is that workers are less than halfway finished with what city officials are calling the largest street widening project in Los Angeles.

The \$66-million West Los Angeles widening and realignment effort involves a 2½-mile section of Santa Monica Boulevard.

Local work crews are excavating hillsides, relocating underground utilities, removing a one-mile Pacific Electric Red Car right-of-way median strip and combing what generations of commuters have called "Big Santa Monica" with a frontage road known as "Little Santa Monica."

But merchants in the construction zone say the upheaval is killing their businesses. Desperate shopkeepers are struggling to stay afloat by taking out loans, stiching advertising signs on street barriers and pleading with nearby homeowners to let customers park in restricted residential zones along the construction zone.

Days at a time seem to go by between visitors at Golbad's tiny City Copy and Printing shop at 10927 Santa Monica Blvd. And he faces another year of the dust and disruption — provided he can hang on that long.

(See Boulevard, Page B8)

Gang Sweep Results in 103 Arrest

In a nationwide action authorities rounded up members of MS-13, formed in L.A. and involved in smuggling trafficking and murder

By RICH CONNELL AND ROBERT J. LOPEZ Times Staff Writers

As part of a nationwide crackdown, federal authorities Monday announced 103 arrests in major cities of members of MS-13, an international gang born in Los Angeles and now involved in murder, narcotics trafficking and human smuggling.

The sweeps, conducted in recent weeks in an operation stretching from Hollywood to New York City and Miami agents with the Department of Homeland Security, represent the first thrust of a campaign in Miami, San Antonio, and other cities in 33 states and Latin America, the gang has become a law enforcement priority in Washington, as well as in Salvador, Honduras and Mexico.

Undergoing the gang's 10th year, more than half the arrests occurred Monday in the New York, Washington and Baltimore areas. In 1993, the gang was founded by a former soldier in the Salvadoran military described as founding member of the gang in Hollywood Branch.

The gang has spread to other parts of the United States, including New York, Washington and Baltimore.



FRANK C. RIZZO/LOS ANGELES TIMES
ISOLATED: There is no parking and very little room to park in front of All Golbad's City Copy and Printing shop on Santa Monica Boulevard. About 500 shops and storefronts line the boulevard between Century City and the San Diego Freeway.

Street Widening Project Creating a Roadblock for Area Businesses

(Boulevard, from Page B1) long.

Officials say unexpected engineering problems and this winter's unusually wet weather have knocked the Santa Monica Boulevard Transit Parkway project seven months behind schedule. They say more rain will only make things worse.

"I don't know how much longer I can last. I have a huge problem paying my rent," said Golbad, who has operated his 800-square-foot shop for 30 years. "My business is down 75%. Often there are days when nobody comes in. And I'm not the only one. All the businesses here are hurting."

About 500 shops and storefronts line the boulevard between Century City and the San Diego Freeway where construction began in March 2003.

The new parkway will feature five lanes in each direction. Billboards and the unsightly dirt median have been removed and new landscaping is planned.

The project is a partnership of the city, Los Angeles County and the Metropolitan Transportation Authority. State and federal transportation funds are helping finance the construction, which is being coordinated by the city.

Tonya Durrell, a city Department of Public Works staff member who is the project's community relations manager, said recent rains caused \$1.2 million in damage to temporary boulevard pavement and construction trenches. Federal Emergency Management Agency funds are being sought to cover the repair costs.

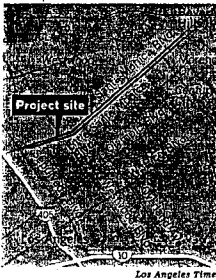
But problems with the design of a large retaining wall at the Century City end of the project and the discovery of "unknown and unanticipated underground utilities" in the construction zone project are primarily to blame for pushing the project behind schedule.

"We're about 45% completed. We're looking at March 2006 completion. There are people who are frustrated and we can understand that," Durrell said. "This is the largest street-improvement project ever undertaken by the city of L.A. It will be a very rewarding parkway when it's done."

The city has waived some municipal sign restrictions to allow the use of "we're open" signs along the construction zone and uses mailings, a telephone hotline and automated message signs to keep merchants and



FRUSTRATED: Ali Golbad makes a call outside his City Copy and Printing store on Santa Monica Boulevard. He says his business is barely holding on: "Often there are days when nobody comes in."



Los Angeles Times

shoppers alike informed of project workers' schedules, Durrell said. About 70 construction workers are involved in the project.

Some merchants wonder if that's enough.

"They seem to work one or two days and then take two weeks off. If they wanted to work at it they could finish it off very fast," said John Amirteb, who has placed his small beauty supply shop, J&S Beauty Palace, up for sale because of the drop-off in business.

"My feeling is they don't have the manpower to finish in a timely manner."

Neighboring businessman Hamid Shekarchian agreed. Business at his 10-year-old Mailboxes, Box & Shop store in a small boulevard strip mall is off by half.

"It doesn't look like they're working that hard. They're taking their time," complained Shekarchian. "Some of us won't survive. I'm hanging in by putting money in out of my own pocket. It's a disaster."

Near the middle of the small shopping center, shopkeeper Eddie Hakimi said he is close to losing his 21-year-old Master Copy & Printing shop, where he said business is off about 65%.

"I've gotten five or six 'three-day notices to quit' from my landlord when I was late paying rent. I had to let my full-time pressman go. I'm living from minute to minute."

At the nearby Ristorante Positano, only two of owner/chef Angela Battara's 15 tables were occupied during lunchtime. "I'd have closed six months ago if my parents hadn't loaned me \$40,000. I can only hold out another couple of months," she said.

City officials said some merchants have been able to successfully work with officials to minimize the disruption.

Durrell cited Clementine, a bakery-cafe at the eastern end of the construction zone, as one of them.

Annie Miller, owner of Clementine, said City Councilman Jack Weiss' staff helped expedite temporary suspension of the neighborhood permit-parking zone along Ensley Street after residents signed petitions that

she and operators of the Sugar Plum stationery store prepared.

"For the most part people were sympathetic. We brought cookies to give them and that helped," Miller said. "Business has dipped a little. But we're continuing to be quite busy."

Back at his copy and banner shop, where he also offers fingerprinting, notary services, passport photos and shirt and cap printing, Golbad and next-door merchant Carlos Verduzco shook their heads at their empty shops. Verduzco, a tailor, said his 10-year-old shop has lost half of its clientele.

Golbad said project administrators took pity on him earlier this year, hiring him to make small reproductions of poster-size pictures depicting before-and-after views of the boulevard. Even that gesture went poorly.

"I did the job Jan. 2 and I still haven't been paid. They owe me about \$300," he said last week.

On Monday, however, things seemed to be improving for Golbad. The city issued his check. And a work crew showed up to finally pour a concrete sidewalk outside his shop's doorway.

Golbad said those are but tiny steps in the right direction.

"They say they're doing us a favor, that we'd be very happy and see a big improvement with the street when they finish," he said.

"But will we be around to see it?"

... and a federal judge ordered the board to release him or hold a hearing on his case. Commissioners then determined that Bowers was an appropriate candidate for release and set a parole date for Feb. 21.

Bowers is expected to face the Parole Commission again this month. His lawyers have declined to comment.

Bowers has continued to proclaim his innocence and describe himself as a political prisoner. He denounced his conviction as an example of "American fascism," according to news reports at the time, saying his conviction was part of a government campaign to destroy the Panthers.

Patrick-Lee objects to Bowers calling himself a political prisoner, saying, "He went to prison for committing a cold-blooded murder."

Until now, Patrick-Lee has never talked publicly about her husband's killing. But her recollections, along with accounts by police and news reports from the time, provide a chronology of what happened.

A fellow park service worker was supposed to join Patrick on patrol that morning but called in sick, so Patrick set out alone at 5 a.m., much earlier than usual. He was looking for deer poachers at the national seashore, about 20 miles north of San Francisco, and was expected to return home by 8 for breakfast.

Shortly into his patrol, Patrick spotted a Pontiac on a remote road between Point Reyes and Mt. Vision.

Bowers was in the car with Jonathan Shoher and Alan Veale, who in a signed confession later identified Bowers as the triggerman.

When Patrick approached the car with a flashlight, Bowers shot the ranger in the chest with a 9-millimeter handgun, according to Veale's statement.

A strapping man — 6 feet 1 and about 230 pounds — Patrick staggered from the car. A second bullet then whizzed through his thumb and into his wrist. He came crashing down. According to Veale, Bowers pumped a third round into the ranger's chest.

By 8 a.m., Patrick-Lee was surprised that her husband had not returned for a breakfast of pancakes — his favorite — and she tried to reach him on the park service radio. There was no reply.

She fed their three sons — ages 20 months, 5 and 12 — and then tried again. Still no reply. There was a flurry of radio traffic before the voices went silent. "I knew then that something very, very bad had happened," she said.

Her husband's body was found just before noon. It lay face-up in wet brush, enveloped in thick morning mist, about 150 feet from his patrol car. The engine was still running. Patrick's gun was still in its holster.

Count, P.S., said she and Bowers have often prayed together. "Whatever changes I need to make, I'm ready," she quoted him as saying, adding, "I think he's rehabilitated."

Parole Commission officials would not comment on Bowers' case.

But Tom Hutchison, a spokesman for the Maryland-based agency, said a prisoner could be kept locked up after his parole date if the commission determined that the person had seriously and frequently violated prison rules or might commit another offense after being released.

The commission also must consider relevant information about a prospective parolee by interested people.

The ranger's widow and law enforcement officials are not convinced of Bowers' rehabilitation.

"Rehabilitation would require some remorse for shooting and killing a human being, don't you think?" said Chuck Canterbury, national president of the Fraternal Order of Police.

"If this man truly had admitted so much as his guilt, if he wasn't the same person as when he went into prison, I wouldn't feel so bad about him being released," Patrick-Lee said. "I still believe the hatred and the rage is there."

Her husband of seven years was buried in Grand Canyon National Park, where he once served.

The visitors' center and a park trail are named for him.

"He was a living, breathing human being who had his faults," Patrick-Lee said. "He was far from perfect. But he was very charismatic. People liked him. He had an unbelievable zest for life."

She struggled to hold her life together after his death.

She was obliged to move out of her home, which belonged to the park service. When she decided to return to college in Arizona, Point Reyes residents took up a collection for the trailer to haul her possessions.

Patrick-Lee remarried in 1981 and now works in Alaska as superintendent of Glacier Bay National Park and Preserve in Gustavus.

"Even though the pain itself is still very fresh, I think most of us in the family have been able to move beyond the ideas of revenge," Patrick-Lee said, her voice breaking.

"It's normal in the beginning that you just want the person apprehended and punished, and no punishment is too great."

"But time changes things. It doesn't change the pain or the loss. It makes it possible to put it aside. You never forget. Time doesn't heal. Time just makes it possible to live through things."

EXHIBIT 1

Hearing:
August 15, 1985

DOCKETED
JAN 22 1986

Hussain
Paper No. 121

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

File Folder	<input checked="" type="checkbox"/>	INITIAL
Code Book	<input type="checkbox"/>	
D. Of Cases Filed	<input type="checkbox"/>	
Docket Entry	<input checked="" type="checkbox"/>	
Docket Cross Off	<input checked="" type="checkbox"/>	na
Affl. & Renl. Bk.	<input type="checkbox"/>	
Order Copies	<input type="checkbox"/>	
Annuities	<input type="checkbox"/>	
Other	<input type="checkbox"/>	

2/13/84
3/15/84

Trademark Trial and Appeal Board

Samuel Rosenblatt
v.

Madame Irene Pinkus

Cancellation No. 12,342

Keith D. Beecher, for Samuel Rosenblatt,.

Wolf, Greenfield & Sacks, P.C., for Madame Irene Pinkus.

Before Allen, Rooney, and Simms, Members.

Opinion by Rooney, Member:

This is a petition to cancel the registration of the mark ERES TOP SHOP (TOP SHOP disclaimed) issued to Madame Irene Pinkus for bathing suits, beachwear and women's sportswear, namely, tunics, coats, dresses, skirts and pants. (1)

(1) Reg. No. 1049649 issued October 5, 1976 Section 8 affidavit accepted; Section 15 affidavit filed. A motion for default judgment was granted in this case on August 15, 1983. A motion to set aside the default judgment was denied but upon reconsideration said motion to set aside was granted on December 20, 1984. The Section 15 affidavit was filed on December 22, 1983.

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Petitioner, Samuel Rosenblatt, d.b.a. Eres alleges as the grounds for cancellation that respondent's mark so resembles the mark ERES previously and continuously used by petitioner for women's apparel as to be likely to cause confusion, mistake or deception. Respondent denied petitioner's allegations.

The evidence submitted by petitioner includes petitioner's third set of interrogatories and petitioner's request for admissions with respondent's answers thereto. Petitioner also submitted as rebuttal testimony the depositions of Samuel and Helene Rosenblatt and of Terence Byrne.

Respondent's submission includes interrogatories Nos. 40 and 49 of respondent's third set of interrogatories and petitioner's answers thereto, and the deposition on written questions of Madame Irene Pinkus, which includes petitioner's objections and cross-questions.

In a proceeding based on the issue of likelihood of confusion, the plaintiff has the burden of presenting facts from which it can be established that the respondent's mark is the same as or similar to one previously used by the petitioner and that the goods on which said marks are used are similar or related to each other. The issue is simplified herein because there is agreement as to the similarities of the marks and the goods. Thus, the only issue we are called upon to determine is that of priority of use.

Petitioner's case-in-chief consists of nothing more than certain interrogatories and requests for admissions

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propounded to respondent with respondent's answers thereto. These prove nothing relative to petitioner's allegations. In its brief on the case, petitioner argues the issue of priority relying for proof on the depositions of Samuel and Helene Rosenblatt. However, those depositions were taken during the rebuttal period, not during the period set for petitioner's testimony in chief. (2)

It is well settled, as petitioner has acknowledged in its reply brief, that evidence offered to prove the allegations set forth in a notice of opposition or a petition to cancel may only be introduced during the period assigned to the petitioner or opposer for proving its case, that is, its testimony period in chief. The rebuttal period, on the other hand, is intended to allow the plaintiff to deny, explain or discredit the facts and witnesses adduced by the defendant. See *Western Leather Goods Company v. Blue Bell, Inc.*, 178 USPQ 382 (TTAB 1973); *Pakor Iron Works, Inc. v. Pennsylvania Engineering Corporation*, 181 USPQ 660 (TTAB 1970); *Autac Incorporated v. Walco Systems, Inc.*, 195 USPQ 11 (TTAB 1977); and *The Finance Company of America v. BankAmerica Corporation*, 205 USPQ 1016 (TTAB 1979), affirmed in unpub. opinion, App. No. 80-555 (CCPA 2/12/81).

In order to convince the Board that the Rosenblatt depositions constitute proper rebuttal, petitioner has argued

(2) Petitioner also offered the rebuttal testimony of Terence Byrne on the question of respondent's reputation in the United States. While this was proper rebuttal, in the absence of evidence to establish the basic allegations of the petition, respondent's reputation is not in question.

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that the statement made by Madame Irene Pinkus during the course of her cross-examination to the effect that it was her contention that Samuel Rosenblatt was not the first user of the mark ERES in the United States, opened the door for petitioner's rebuttal demonstrating that it was indeed the first user.

With regard to the foregoing, we note that respondent denied all of petitioner's allegations in her answer to the petition to cancel. Thus, Madame Pinkus' statement was merely an affirmation of the contentions which she has espoused from the onset of this proceeding and which should have been, but were not, challenged as part of petitioner's case-in-chief. Madame Pinkus offered proof of her use of the mark in the United States from 1969. Petitioner's rebuttal did not challenge any of the facts established by respondent to prove that date. It is therefore clear that petitioner has not sustained its burden of proof herein.

In a further effort to urge the Board to accept the evidence presented during the rebuttal period, petitioner argues in its reply brief that petitioner's prior attorney⁽³⁾ was unfamiliar with practice before the Patent and Trademark Office and additionally that respondent had an opportunity following the close of petitioner's testimony period to file a motion under Rule 2.132(a) for judgment in view of petitioner's failure to file evidence but did not do so.

⁽³⁾ Petitioner appointed a new attorney after the testimony and petitioner's briefing period had closed.

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Apart from the fact that we have not detected any unfamiliarity with practice before the Trademark Trial and Appeal Board on the part of the previous attorney, the order of testimony before the Board is no different from that in any civil case before the courts, i.e., the plaintiff makes its case; the defendant defends its position; and the plaintiff has an opportunity to rebut the defendant's case. Thus, unfamiliarity with these procedures cannot be seriously argued.

Contrary to petitioner's argument on the question of a Rule 2.132(a) motion, respondent did indeed file such a motion on November 12, 1981. However, said motion was denied on January 6, 1982 because petitioner had filed certain discovery evidence under a notice of reliance and was therefore not without testimony or evidence as is required to grant such a motion.

Finally, petitioner suggests that it would be in the interest of judicial economy to decide this case on a substantive rather than a technical basis. While we agree that a decision on substantive grounds would be preferable, it is also important to judicial economy that there be an orderly progression in every case. Here there has been a total

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disregard for that order. To condone such procedures would result in chaos.

In view of the foregoing, the petition to ~~cancel~~ is dismissed.



D. B. Allen



L. E. Rooney



R. L. Simms

Members, Trademark Trial
and Appeal Board

JAN 14 1986

EXHIBIT 2



TMT

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

IN THE MATTER OF)
Registration No. 1,049,649)
Date of Registration:)
October 5, 1976)
SAMUEL ROSENBLATT,)
Petitioner for Cancellation,)
vs.)
MADAME IRENE PINKUS,)
Registrant and Respondent.)

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MOTION FOR LEAVE
TO AMEND REGISTRATION
AND AMENDMENT THEREOF

Pursuant to section 7(d) of the Act and TMEP sections 501.10 and 1607.03, Registrant hereby moves the Board for leave to amend registration No. 1,049,649 to recite ownership of her French trademark registrations.

AMENDMENT

Please amend the registration by adding the following language:

Registrant claims the benefit under Section 44(e) of French trademark registration 504,277, issued December 1, 1951 and now expired, French registration 122,893, issued March 17, 1959, and French registration 889,810, issued Nov. 27, 1973.

REMARKS

Certified copies and translations of these registrations are appended hereto. The original certificate is lost or destroyed, but an order for a certified copy showing title is attached hereto. Registrant is the sole heir of her parents Francine and the late Leopold Pinkus, original owner of registration 122,893. The only reason these registrations were not recited in the original application because Registrant's U.S. counsel was not informed of

their existence and because registrant was not sufficiently familiar with U.S. practice to call them to counsel's attention. Since Registrant would have been entitled to rely upon these registrations at the time of her original filing and since Petitioner, as a resident of Paris until 1953, had constructive if not actual notice of Registration 504,277, and therefore cannot be prejudiced by Registrant's defensive reliance on these registrations, this amendment should in fairness be approved.

Respectfully submitted,

MADAME IRENE PINKUS

Milton Oliver

Milton Oliver, Esq.
WOLF, GREENFIELD & SACKS, P.C
Attorneys for Registrant
201 Devonshire Street
Boston, MA 02110
(617) 426-6131

EXHIBIT 3

MAILED

AUG 18 1981

PAT. & T. M. OFFICE

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Samuel Rosenblatt, dba
Eres

v.

Madame Irene Pinkus

On June 10, 1981, the respondent filed a motion for leave to amend U.S. Registration No. 1,049,649. The respondent has requested that the following language be added to the registration:

"Registrant claims the benefit under Section 44(e) of French trademark registration 504,277, issued December 1, 1951 and now expired, French registration 122,893, issued March 17, 1959, and French registration 889,810, issued November 27, 1973."

The registrant has submitted certified copies of the three French registrations and has ordered a certified copy of its U.S. registration in support of the amendment because the original certificate was lost or destroyed. However, it is noted that the respondent has failed to authorize a \$15 fee for a certificate of correction and has not submitted a verified statement or declaration in accordance with Rule 2.20 signed by the registrant. See Rule 2.173.. Therefore, the amendment is not formally correct and is not acceptable.

Moreover, Madame Irene Pinkus, owner of the U.S. registration, does not appear to be the exclusive owner of any of the three foreign registrations which she now claims:

1. French Registration No. 122,893 is in the name of Madame Francine Kahn, the wife of Leopold Pinkus, as co-owners.
2. French Registration No. 504,277 is owned by Madame Leopold Pinkus, formerly Francine Kahn.
3. French Registration No. 889,810 is owned by Madame Francine Kahn and Madame Irene Pinkus, as joint owners.

A party who is related to a registrant may not assert ownership of such registrant's registration nor claim the benefit of the registration. Cf In re Knight's Home Products Inc., 175 USPQ 447 (TTAB, 1972) and In re Air Products, Inc., 124 USPQ 81 (TTAB, 1960). The respondent should demonstrate that it is the owner of the French registrations and that it is therefore entitled to the benefits of Section 44(e) of the Trademark Act.

In addition to the foregoing, the respondent's proposed amendment is not acceptable because only French registration 889,810 appears to have been a valid registration at the time the U.S. registration was issued. The foreign registrations must be in force and effect at the time the United States registration issues. See Rule 2.39(a) and TMEP Section 1002.

In addition, the respondent is not entitled to claim the benefits under Section 44(e) because a party may not obtain a registration in this country broader in scope than the registration issued in the country of origin. Article 6 of the International Convention for the Protection of Industrial Property provides, so far as pertinent:

"A. Every trademark duly registered in the country of origin shall be admitted for registration and protected in the form originally registered in the other countries of the Union..."

The French registrations are for the mark "ERES" while the United States registration is for the mark "ERES TOP SHOP". The registrant has materially changed the nature

of its mark in the United States registration and is thereby precluded from claiming the benefits of Section 44(e) of the Trademark Act.

It is also noted that French registration 504,277, which appears to have expired before the U.S. application was filed, is for stockings and that the U.S. registration exceeds the scope if the goods set forth in the French registration. See Rule 2.39 and TMEP Section 1007.

Finally, at this point in the cancellation proceeding, there appears to be little, if any, purpose in amending the registration. The presumption of use created by a registration relates back to the filing date of the application. American Throwing Co., Inc. v. Famous Bathrobe Co., Inc., 116 USPQ 156 (CCPA, 1957) and The J. R. Clark Company v. Queen Manufacturing Co., Inc., 150 USPQ 73 (TTAB, 1966). A foreign registrant is not entitled to rely on the dates of use corresponding to the issue date of a foreign registration. Such registration is of no evidentiary value in this proceeding. The Barash Company, Inc. v. Vitafoam Ltd., 155 USPQ 267 (TTAB, 1967). Therefore, the respondent is required to submit evidence to show use of the mark earlier than the filing date of the application. In order to prove use prior to that alleged in the application, the respondent must establish such use by clear and convincing evidence. Elder Manufacturing Co., v. International Shoe Co., 92 USPQ 330 (CCPA, 1952). Any use of the mark outside the United States is wholly immaterial and irrelevant to the respondent's right to use and register the mark in the United States. Scotto v. Mediterranean Importing Co., Inc., 162 USPQ 415 (TTAB, 1969). Since the proposed amendment is of no evidentiary value in this cancellation proceeding, there is little point in amending the registration until the cancella-

tion proceeding reaches final disposition.

Accordingly, the respondent's motion to amend the registration is denied.

G.D. King for RLS
R. L. SIMMS
Acting Member, Trademark
Trial and Appeal Board

cc:

Willy Rosenblatt
2040 Avenue of the Stars
Fourth Floor
Los Angeles, California 90067

Arthur Z. Brookstein
c/o Wolf, Greenfield & Sacks, P.C.
201 Devonshire Street
Boston, Massachusetts 02110