

ESTTA Tracking number: **ESTTA28463**

Filing date: **03/17/2005**

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

Proceeding	92044209
Party	Defendant Eres Eres S.A. 2 Rue Tronchet FRX 75008 Paris,
Correspondence Address	ARLENE B. SAVITSKY TRADEMARK SERVICES LIMITED 9 WEST 57TH STREET 44TH FL NEW YORK, NY 10019
Submission	Declaration of Michael Chiappetta and Exhibits Thereto In Support of Registrant's Motion for Summary Judgment
Filer's Name	Michael Chiappetta
Filer's e-mail	mchiappetta@fzlj.com
Signature	/Michael Chiappetta/
Date	03/17/2005
Attachments	Declaration of Michael Chiappetta and Exhibits.pdf (43 pages)

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

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

-----X		
SAMUEL ROSENBLATT & HELENE	:	
ROZENBLAT d/b/a "ERES"	:	Cancellation No. 92044209
	:	
Petitioners,	:	
	:	
-against-	:	
	:	
ERES	:	
	:	
Registrant.	:	
-----X		

DECLARATION OF MICHAEL CHIAPPETTA IN SUPPORT
OF REGISTRANT'S MOTION FOR SUMMARY JUDGMENT

I, Michael Chiappetta, declare as follows:

1. I am one of the attorneys of record for the Registrant, Eres, in the above-referenced action. I submit this declaration based on my review of the records of the Patent and Trademark Office and Trademark Trial and Appeal Board ("TTAB").

2. Attached hereto as Exhibit 1 is a true and correct printout from the U.S. Patent and Trademark Office TARR (Trademark Applications and Registrations Retrieval) database depicting Registration No. 1,049,649. Also included in Exhibit 1 is a true and correct copy of the December 12, 1983 Declaration Under Section 15 of Madame Irene Pinkus in connection with Registration No. 1,049,649.

3. In connection with this proceeding, we requested and obtained from the Trademark Trial and Appeal Board ("TTAB") a copy of its file for Cancellation No. 12,342 – Samuel Rosenblatt, dba Eres v. Madame Irene Pinkus. Attached hereto as Exhibit 2 is a true and correct copy of the docket sheet included with the TTAB file. The

docket sheet contains more than 120 entries, including, but not limited to, entries concerning the parties' pleadings, discovery served by both parties, responses to such discovery, motions to compel, default proceedings, testimony submitted by the parties, trial briefs, a request for oral hearing, the TTAB's January 14, 1986 decision in favor of Pinkus, Petitioner's request for an appeal and the Federal Circuit's November 19, 1986 affirmation of the TTAB's decision.

4. Attached hereto as Exhibit 3 is a true and correct copy of the Petition to Cancel filed by Petitioner Samuel Rosenblatt, dba Eres on May 29, 1979, which was assigned Cancellation No. 12,342 by the Trademark Trial and Appeal Board, against Registration No. 1,049,649.

5. Attached hereto as Exhibit 4 is a true and correct copy of the September 20, 1979 order of the Trademark Trial and Appeal Board noting that Rosenblatt identified the incorrect registrant in interest in his Petition to Cancel and instituting the proceeding against Madame Irene Pinkus, the actual registrant of Registration No. 1,049,649.

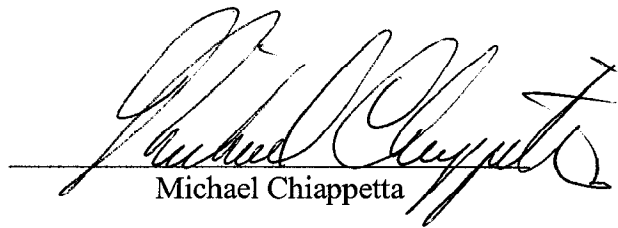
6. Attached hereto as Exhibit 5 is a true and correct copy of the TTAB's order of January 14, 1986 dismissing Cancellation No. 12,342. The TTAB's order refers to an oral hearing that took place in the proceeding on August 15, 1985, which also is referenced in the TTAB's docket for the proceeding (Exhibit 2).

7. Attached hereto as Exhibit 6 is a true and correct copy of the December 12, 1986 decision of the United States Court of Appeals for the Federal Circuit affirming the TTAB's January 14, 1986 order dismissing Cancellation No. 12,342 and the judgment of the Trademark Trial Appeal Board.

8. Attached hereto as Exhibit 7 is a true and correct copy of a printout from the U.S. Patent and Trademark Office TARR database depicting Registration No. 2,320,998 that is in issue in this cancellation proceeding.

9. Attached hereto as Exhibit 8 is a true and correct copy of Petitioners' Petition to Cancel filed in this proceeding.

I declare under penalty of perjury that the foregoing is true and correct, and that this Declaration is being executed on March 16, 2005, at New York, New York.



Michael Chiappetta

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EXHIBIT 1

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-03-16 11:10:44 ET

Serial Number: 73056988 Assignment Information

Registration Number: 1049649 Assignment Information

Mark

ERES
TOP SHOP

(words only): ERES TOP SHOP

Standard Character claim: No

Current Status: This registration was not renewed and is considered to be expired.

Date of Status: 1997-07-14

Filing Date: 1975-07-07

Transformed into a National Application: No

Registration Date: 1976-10-05

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 41P -Office Of Public Records - Special Handling Section

Date In Location: 2005-02-02

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ERES

Address:

ERES

2, RUE TRONCHET

PARIS

France

Legal Entity Type: Company

State or Country Where Organized: France

GOODS AND/OR SERVICES

International Class: 025

BATHING SUITS, BEACHWEAR AND WOMEN'S SPORTSWEAR-NAMELY, TUNICS, COATS, DRESSES, SKIRTS AND PANTS

First Use Date: 1970-01-20

First Use in Commerce Date: 1970-01-20

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: APPLICANT DISCLAIMS THE WORDS "TOP SHOP" APART FROM THE MARK AS SHOWN.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1997-07-14 - Expired Section 9

1988-06-22 - Cancellation terminated for Proceeding

1988-06-22 - Cancellation terminated for Proceeding

1987-12-22 - Section 15 acknowledged

1987-03-16 - Section 15 affidavit received

1983-08-15 - Cancellation dismissed for Proceeding

1979-09-20 - Cancellation Instituted No. 999999

CORRESPONDENCE INFORMATION

Correspondent

JOHN L. WELCH

WOLF, GREENFIELD & SACKS. P.C.

201 DEVONSHIRE STREET

BOSTON, MA 02110

Latest Status info
Domestic Representative
WOLF, GREENFIELD & SACKS

9B15/259

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.

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	David Driscoll	No. 25,075
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

EXHIBIT 2

NO.

12342

Vol. II
CAFC



TRADEMARK

BC
Reinstated
12-20-84

APPLICATION FOR CANCELLATION

~~TERMINATED~~

~~AUG 24 1983~~

TERMINATED

JUN 22 1988

Samuel Rosenblatt dba Eres

VS

Madame Irene Pinkus

Reg. No. 1,049,649

12342
1979

ATTORNEYS

Samuel R. A. dba Eres
Willy Rosenblat
9107 Wilshire Boulevard
Suite 701
Beverly Hills, California 90210

Dr. Beacher
200 Wilshire Boulevard, Suite 500
Beverly Hills, California 90403

Oliver

ATTORNEY: *Mess, P.C.*

*Walt, Greenfield +
att. Milton Oliver*

201 Devonshire Street
Boston, Massachusetts 02110

Address

12342

Samuel Rosenblatt, dba ERES
v.
Madame Irene Pinkus

1. 5-29-79 Pet. + Fee
2. 20 SEP 1979 Propn declaration due 10-22-79
3. 10-1-79 response to #2
4. 29 OCT 1979 Notice sent; answer due
5. 11-30-79 Respondents motion to extend answer ^{disappearance}
6. 1-23-80 #5 granted; ans. due 1-8-80
7. 1-8-80 answer
8. 2-7-80 Appearance noted.
9. FEB 20 1980 Trial dates set.
10. 6-16-80 Petitioner's answer to 1st interog
11. 7-14-80 Stip to extend dates
12. 7-14-80 Petitioner supplemented answer to #12
13. 7-14-80 Petitioner 1st interog
14. 7-30-80 stip filed July 14, 1980 approved; trial dates reset
15. 7-21-80 Petitioner's notice of taking testimony
16. 9-8-80 Stip to extend dates approved 9-22-80
17. 10/6/80 Stip to extend trial dates approved 10-23-80
18. 10-10-80 Petitioner request to produce
19. 10-10-80 Petitioner request for admissions ^{returned 8-22-83}
20. 10-10-80 Petitioner further response to 1st interog due
21. 10-14-80 Petitioner notice of taking testimony
22. 10-20-80 Petitioner motion to compel
23. 10-24-80 Respondents request to produce
24. 10-24-80 Respondents 2nd interog.
25. 10-28-80 Petitioner 2nd interog
26. 11-12-80 Respondents reply for admissions
27. 11-17-80 Respondents reply to produce
28. 12-1-80 Respondents reply to 2nd interog
29. 1-9-81 ^{Response to interog due 2-3-81} answers from app due 2-3-81
30. 1-9-81 trial dates reset

- 3. 2-3-81 Registrant's motion to extend dates to be interrogated
- 3. 2-6-81 Registrant's ^{partial} answers to interrogatories
- 3. 2-10-81 Petitioner's opp. to #31
- 3. 2-19-81 Petitioner's motion to strike
- 3. 2-23-81 Petitioner's notice of taking testimony
- 3. 3-3-81 Respondent's answer due 3/30/81; #34 mail
- 3. 3-9-81 Registrant's partial answers to interrogatories
- 3. 3-9-81 Registrant's opposition to #34
- 3. 3-9-81 Registrant's response to #27
- 3. 3-9-81 Registrant's motion to quash notice of deposition
- 4. 3-11-81 Change of address of respondent's atty
- 4. 3-27-81 Respondent's 3rd interrogatory
- 4. 3-30-81 Respondent's answers 1st interrogatory
- 4. 3-30-81 Petitioner's interrogatories
- 4. 5-14-81 #40 granted, trial dates remain as set
- 4. 5-13-81 Registrant's answers to interrogatories
- 4. 5-29-81 Registrant's notice of taking testimony
- 4. 6-10-81 Respondent's motion for leave; amount \$1,049,649
- 4. 7-20-81 Petitioner's answers 2nd set of interrogatories
- 5. 7-20-81 Petitioner's answers 3rd set of interrogatories
- 5. 8-18-81 Motion to Amend denied
- 5. 8-27-81 Slip to extend Dates approved 9-3-81
- 5. 9-25-81 Registrant's answers to Interrogatories
- 5. 10-5-81 Petitioner's Notice of Reliance
- 5. 11-12-81 Respondent's statement re 2.132; objections to #54
- 5. 11-17-81 Respondent's notice of taking testimony
- 5. 11-27-81 Petitioner's Opposition to #55
- 5. 11-27-81 Petitioner's Amended Notice of Reliance
- 5. 11-27-81 Petitioner's Opposition to Written Questions
- 6. 11-27-81 Petitioner's Questions to Registrant

61. 11-27-81 Discovery for Respondent Exhibits Attached
Returned 8-22-83
62. 11-27-81 Discovery for Respondent Exhibits Attached
63. 12-2-81 Registrant's Notice of Reliance
64. 12-4-81 Registrant's Reply to #57
65. 12-17-81 Respondent's opposition to #58
66. 12-14-81 Respondent's objection to & related cross questions.
67. JAN 6 1982 Petit. amended notice of reliance re respond. discovery depositions of petit. and petit's answers to interrog. are stricken; other portion of amended notice is proper. Trial dates reset.
68. 1-28-82 Petitioner's objections to written questions
69. 1-28-82 Petitioner's cross-questions to respondents
70. 1-29-82 Registrant's Notice of taking testimony
71. 2-8-82 Registrant's req. to extend testimony dates
72. 2-18-82 Petitioner's opposition to #71
73. 2-18-82 Change of address of petitioner's atty
74. 3-2-82 Respondent's motion to extend dates
75. 3-12-82 # 74 granted
76. 4-28-82 Registrant's motion to resume proceedings
77. 4-28-82 Testimony under 2/124 Respondent's
Resigned 8-22-83
Exh. att.
78. 5-19-82 M.C. ^{resigned} ~~suspended~~; trial dates reset & letter of corp. ⁶⁻²⁴⁻⁸² Approved
79. 6-14-82 Respondent's motion to extend date
80. 7-19-82 Petitioner's Notice of taking testimony
81. 7-19-82 Petitioner's Notice of taking testimony
82. 7-22-82 Petitioner's Notice of taking testimony
83. 7-22-82 Petitioner's Notice of taking testimony
84. 9-9-82 Petitioner's motion to extend testimony
85. 10-4-82 Petitioner's Brief 3-T-C
86. 11-1-82 Registrant's Request to Extend Briefs & to Compel
87. 1-27-83 # 84 granted; # 86 granted to extend respondent's brief due 2/25/83
88. 3-2-83 Respondent's motion to extend briefs to compel
89. 5-3-83 No. 88 granted; petitioner's response due 6/2/83; briefs reset
90. 6-8-83 Registrant's Motion for Default Judgment

- 91 8-15-83 #90 granted; Conc. dismissed set aside
- 92 3-5-84 Rev. & PA for petitioner
- 93 3-13-84 Plaintiff's petition to set aside #91 (60B FRCP)
- 93 4-26-84 Defendant's opposition to #93
- 94 4-26-84 Pa for plaintiff accepted
- 95 5-8-84 Confirmation of telephone conversation
- 96 5-25-84 No. 95 letter forwarded as indicated; ^{due 5-14-84} respondent's response
- 97 6-14-84 Defendant's Opposition to #93
- 98 14 AUG 1984 Mot. to set aside default judgment denied.
- 99 9-7-84 Reconsideration of #98
- 100 9-24-84 Defendant's Opposition to #99
- 101 12-20-84 Petitioner's resp. due 1-9-85; Brief dates reset
- 102 1-4-85 Testimony for Plaintiff IT (Yves Donnet) ²⁰³
- 103 1-4-85 Testimony for Plaintiff IT (Charles Byrne) ²⁰³
- 104 1-17-85 Defendant's motion to reinstate default judgment
- 105 1-17-85 Defendant's motion to extend brief dates
- 106 1-28-85 Plaintiff's opposition to motion to reinstate default judgment
- 107 1-28-85 Testimony for Plaintiff ^{ack 2-5-85}
- 108 1-28-85 Testimony for Plaintiff ^{Sec 402/85}
- 109 4-9-85 Brief dates reset; Response due 5-8-85 ⁵⁻¹¹
- 110 4-29-85 Change of address of pet'n atty
- 111 5-13-85 Defendant's request for oral hearing
- 112 4-29-85 Exhibits for Plaintiff ^{rel 4/27/85}
- 113 4-30-85 Letter + Registrant's notice of reliance
- 114 5-14-85 Defendant's Brief 3-T-C
- 115 5-21-85 Pl's reply brief 3-T-C
- 116 6-14-85 Oral hearing set 7-18-85
- 117 6-28-85 Plaintiff's letter re Evidence
- 118 6-28-85 Plaintiff's request for Oral hearing (to reset)
- 119 7-1-85 Defendant's Response re Evidence
- 120 7-10-85 Oral hearing reset 8-15-85

12. 1-14-86 Bd's decision: Can. dismissed

12. 1-29-86 Plaintiffs notice of appeal to CAFC

12. 2-27-86 Appeal to CAFC acknowledged ¹¹⁻¹⁹⁻⁸⁶

12. 12-12-86 CAFC affirmed ¹¹⁻¹⁹⁻⁸⁶ Mandate 12-10-86

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EXHIBIT 3

25.00 202-T.M.R



WILLY ROSENBLATT, Esq
2040 Ave of the Stars, 400
Los Angeles, California 90067
(213) 552-9554
Attorney for Petitioner

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

IN THE MATTER OF)	CANCELLATION NO.
Registration No. 1,049,649.)	12,342
)	
Date of Registration: October 5, 1976)	
SAMUEL ROSENBLATT, dba ERES)	
Petitioner,)	
vs.)	
VIVELOTTE S.A.,)	
Respondent.)	

SAMUEL ROSENBLATT, whose post office address is 456 North Rodeo Drive, Beverly Hills, California 90210 (hereinafter called "Petitioner"), believes that he is or will be damaged by Registration No. 1,049,649. owned by VIVELOTTE S.A., 2 Rue Tronchet, 75008, Paris, France (hereinafter called "Respondent"), hereby petitions to cancel the same under the provisions of §14(a) of the Trademark Act of 1946 (15 U.S.C. 1064(a)).

1. The Petitioner is a retailer and manufacturer and designer of women's apparel, and has been using the trademark "ERES", to identify his merchandise as early as August 15, 1956.

2. On October 5, 1976, the Respondent VIVELOTTE filed for a trademark application for the name "ERES" and received

1 Registration No. 1,049,649.

2 3. Petitioner has used the name "ERES" in interstate
3 commerce, in foreign commerce and in intrastate commerce since
4 August 15, 1956 so that the mark "ERES" has acquired a high repu-
5 tation for quality and now has a great value.

6 4. Respondent's trademark is identical to Petitioner's
7 trademark.

8 5. Petitioner believes that Respondent's mark "ERES" may
9 take advantage of the nationwide reputation of Petitioner's mark
10 "ERES", and may take advantage of the good will of Petitioner's
11 gain by his twenty-three years of continuous manufacturing and
12 designing of women's apparel which have acquired a reputation
13 for high fashion and quality. If Respondent is permitted to
14 use its mark "ERES" the public is likely to be confused, mis-
15 lead or deceived in believing that the trademark "ERES" identi-
16 fies merchandise sold, designed and created by Petitioner.

17 6. If Respondent's merchandise is of inferior quality, there
18 will be irreparable injury to Petitioner's valuable good
19 will and his mark "ERES", because this mark will have an un-
20 favorable connotation.

21 7. Petitioner is the first user, has continued to use, and
22 by reason of his first and continuous use of "ERES" for his
23 merchandise, he is the owner of the trademark "ERES".

24 WHEREFORE Petitioner, SMAUEL ROSENBLATT, believes and
25 submits that he is damaged by Registration No. 1,049,649, and
26 prays that such registration be cancelled.

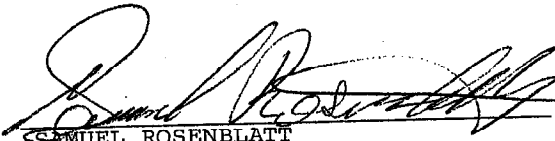
27 This Petition is filed in duplicate, accompanied by the
28 filing of \$25.00.

29 The undersigned says that he has read the foregoing Petition
30 for Cancellation, and the facts set forth therein are true and
31 correct to the best of his information and belief.

32 Please conduct all correspondence with Willy Rosenblatt,

1 a member of the Bar of California, whose post office address
2 is 2040 Avenue of the Stars, 4th floor, Los Angeles, California
3 90067, his attorney with full power of substitution, addition,
4 and revocation, to prosecute this Petition for Cancellation,
5 and to transact all business in the Patent and Trademark Office
6 in connection therewith.

7
8 DATED:



~~SAMUEL ROSENBLATT~~
Petitioner

10
11
12 Willy Rosenblatt
13 2040 Avenue of the Stars
14 Fourth Floor
15 Los Angeles, California 90067
16 Telephone: (213) 552-9554
17 Attorney for Petitioner
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EXHIBIT 4

All communications respecting
this case should identify it by
number and names of parties.



**U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Cancellation No. 12,342

Samuel Rosenblatt, dba
Eres

v.

Madame Irene Pinkus

SEP 20 1979

& T.M. OFF

#2

The petition filed May 29, 1979 to cancel the
above-identified registration is noted.

The petition is defective in that the declaration does
not comport with the requirements of Rule 2.112. Petitioner is
allowed until October 22, 1979 in which to submit a properly
executed declaration attesting to the allegation contained in
the petition. See: Rule 2.20 and Forms 4.17 and 4.18.

It is noted that petitioner has indicated that
respondent is VIVLOTTE S.A.. In this regard, the records of
this Office show that Reg. No. 1,049,649 issued to Madame Irene
Pinkus and that Madame Irene Pinkus is still the owner of said
registration. Accordingly, since Madame Irene Pinkus is the
real party in interest herein, this proceeding will be
instituted against Madame Pinkus, notwithstanding petitioner's
naming of a different respondent.

Gary Krugman
Gary Krugman
Attorney Examiner
Trademark Trial and
Appeal Board

CC:

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

EXHIBIT 5

81
JLW

9815/6003

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"/>	mm
Docket Cross Off	<input checked="" type="checkbox"/>	na
Afil. & Renl. Bk.	<input type="checkbox"/>	
Order Copies	<input type="checkbox"/>	
Annuities	<input type="checkbox"/>	
Other	<input type="checkbox"/>	

2/13/86
3/15/86

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.

Cancellation No. 12,342

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

Cancellation No. 12,342

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); *Pekor 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. 80-556 (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.

Cancellation No. 12,342

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.

Cancellation No. 12,342

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

Cancellation No. 12,342

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

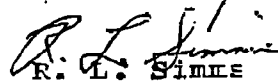
In view of the foregoing, the petition to cancel is dismissed.



D. B. Allen



L. E. Rooney



R. L. Simms

Members, Trademark Trial and Appeal Board

JAN 14 1986

EXHIBIT 6

Note: This opinion will not be published in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

SAMUEL ROSENBLATT, d/b/a ERES,

Appellant,

v.

MADAME IRENE PINKUS,

Appellee.

) Appeal No.

86-982.

SOLICITOR

DEC 12 1986

U.S. PATENT AND TRADEMARK OFFICE

DECIDED: November 19, 1986

Before FRIEDMAN, Circuit Judge, NICHOLS, Senior Circuit Judge,
and BALDWIN, Circuit Judge.

PER CURIAM.

DECISION

The decision of the United States Patent and Trademark Office, Trademark Trial and Appeal Board (board), dismissing the petition for cancellation of United States Trademark Registration No. 1,049,649, is affirmed.

OPINION

In a cancellation proceeding before the board, a determination of priority of use of the registered mark ERES was made in favor of Madame Irene Pinkus, thus dismissing Samuel Rosenblatt's (Rosenblatt) petition to cancel registration of the mark.

In the proceeding, the board ruled that during his testimony period-in-chief, Rosenblatt had failed to carry his burden of proof. In order to prevail, Rosenblatt had the burden of showing that he has rights superior to those of Madame Irene Pinkus by proving his prior use of the mark by clear and convincing evidence. Stock Pot Restaurant v. Stock Pot, Inc., 737 F.2d 1576, 1579, 222 USPQ 665, 669 (Fed. Cir. 1984); Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 1225, 188 USPQ 485, 488 (CCPA 1976).

On appeal, Rosenblatt does not disagree with the board's finding that he did not carry his burden during his case-in-chief. He asks that the cancellation proceedings be reopened to admit testimony taken during the designated rebuttal period for the purpose of re-establishing his case-in-chief. Rosenblatt's only argument is that his attorney was unfamiliar with board practice in cancellation proceedings. Being "out of his depth," Rosenblatt argues, the attorney's failure to submit evidence during the case-in-chief should be excused.

It is well settled that the purpose of the rebuttal testimony period before the board is limited to permitting the cancellation petitioner to explain or discredit the evidence presented by the respondent. It is clearly not the purpose of rebuttal testimony to permit a petitioner to introduce evidence to establish its case. This is no different from any civil case before the courts where the plaintiff makes its case, the defendant defends its position, and the plaintiff has an opportunity to rebut the defendant's case. As the board stated in its opinion, unfamiliarity with these procedures cannot be seriously argued.

Having considered all of appellant's arguments, we find that the board's dismissal of the petition for cancellation is in accord with correct procedures.

Appellee's request that she be awarded attorney's fees is denied.

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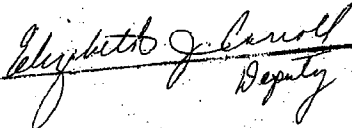

Deputy Clerk

EXHIBIT 7

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-03-16 11:21:34 ET

Serial Number: 75600586 Assignment Information

Registration Number: 2320998 Assignment Information

Mark

ERES

(words only): ERES

Standard Character claim: No

Current Status: A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

Date of Status: 2005-02-17

Filing Date: 1998-12-07

Transformed into a National Application: No

Registration Date: 2000-02-22

Register: Principal

Law Office Assigned: LAW OFFICE 108

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 41P -Office Of Public Records - Special Handling Section

Date In Location: 2005-02-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Eres S.A.

Address:
Eres S.A.

Latest Status Info
2 Rue Tronchet
75008 Paris
France

Legal Entity Type: Corporation
State or Country of Incorporation: France

GOODS AND/OR SERVICES

International Class: 025

swim wear, beachwear, pants, shirts, dresses, blouses, T-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits and underwear

First Use Date: 1920-00-00

First Use in Commerce Date: 1969-00-00

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The English translation of "ERES" is "you are".

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-02-17 - Cancellation Instituted No. 999999

2000-02-22 - Registered - Principal Register

1999-11-30 - Published for opposition

1999-10-29 - Notice of publication

1999-07-28 - Approved for Pub - Principal Register (Initial exam)

1999-07-22 - Examiner's amendment mailed

1999-07-09 - Non-final action mailed

1999-06-30 - Examiner's amendment mailed

1999-06-29 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent

Arlene B. Savitsky (Attorney of record)

ARLENE B. SAVITSKY
TRADEMARK SERVICES LIMITED
9 WEST 57TH STREET 44TH FL
NEW YORK, NY 10019

Domestic Representative
Trademark Services Limited

EXHIBIT 8

California, 90025. Petitioners are engaged in the business of selling clothing, fabrics, trims and other items.

2. Petitioners adopted and used "ERES" as the trade name and trademark for their retail store and clothing sold therein, continuously since at least as early as 1956, in California and elsewhere in commerce in the United States. Petitioners operated their store in Beverly Hills for over 25 years and thereafter in West Los Angeles, adjacent Beverly Hills. Due to a massive street construction project on the street in front of their store, Petitioners have temporarily closed the store, but when construction is completed, Petitioners intend to reopen the store.

3. Petitioners are informed and believe, and on that basis allege, that Registrant is a corporation of France, and has just recently opened a retail store in Beverly Hills, California, selling swimwear, beachwear and lingerie, under the trade name and service mark, ERES.

4. Petitioners are filing, in the United States Patent and Trademark Office, an application for registration of the mark ERES.

5. Registrant is the owner of Principal Register Trademark Registration No. 2,320,998 for, Swim wear, beachwear, pants, shirts, dresses, blouses, T-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body

suits and underwear, in Class 25, (hereinafter referred to as "Registrant's Mark").

6. In its application which issued as U.S. Registration 2,320,998, Registrant claimed a date of first use between the United States and France of 1969.

7. Petitioners have developed extensive goodwill in California and elsewhere with respect to their mark ERES.

8. Petitioners have earned substantial revenue from the sale of clothing, fabrics and other items, offered or sold under their mark ERES. As a result of such substantial revenue Petitioners have garnered a valuable reputation for their mark ERES.

9. Petitioners have been and will be damaged by Registrant's registration because there is likelihood of confusion between Petitioners' mark and Registrant's mark. Petitioners, as the senior users of the mark ERES, have superior rights to the mark ERES over Registrant.

WHEREFORE, Petitioners request that this Petition be granted and that Registrant's Registration No. 2,230,998 be cancelled.

Please charge any fees or credit any overpayment pursuant to 37 C.F.R. § 2.6 to Deposit Account No. 02-2448.

Please address all correspondence to Sanford Astor,
Birch, Stewart, Kolasch & Birch, LLP, P.O. Box 747, Falls
Church, Virginia, 22040-0747.

Telephone Contact: Sanford Astor, (714) 708-8555.