ESTTA Tracking number: **ESTTA196932**

Filing date: **03/07/2008**

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

Proceeding	92048084
Party	Plaintiff ASICS Corporation
Correspondence Address	Michael R. Friscia McCarter & English, LLP 100 Mulberry Street, Four Gateway Center Newark, NJ 07102 UNITED STATES mboyce@mccarter.com
Submission	Other Motions/Papers
Filer's Name	Michael R. Friscia
Filer's e-mail	mboyce@mccarter.com
Signature	/Michael R. Friscia/
Date	03/07/2008
Attachments	ASICSvDynasty Resp Req Reconsideration.pdf (23 pages)(736241 bytes)

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

In the matter of Trademark Reg. No. 3,266,561 and Reg. No. 3,266,560 Date registered: July 17, 2007 ASICS Corporation, PETITIONER, V. Dynasty Footwear, Ltd., RESPONDENT	CANCELLATION NO. 92048084

RESPONSE TO REQUEST FOR RECONSIDERATION

The Respondent Dynasty Footwear, Ltd. ("Dynasty" or "Respondent") filed a Request for Reconsideration (the "Request") of the Board's February 5, 2008, decision granting petitioner ASICS Corporation's ("ASICS" or "Petitioner") Petition to Cancel Respondent's U.S. Registration Nos. 3,266,561 and 3,266,560. However, Respondent did not serve the Request on the Petitioner as required by the Trademark Trial and Appeal Board Manual of Procedure (the "TBMP"). See TBMP, Second ed. (June 11, 2003), First revision, §113.01 ("[e]very document filed in an inter partes proceeding before the Board . . . must be served by the filing party upon every other party to the proceeding"); Declaration of Michael R. Friscia ("Friscia Decl.") at ¶6. Indeed, the Respondent's Request does not include a Certificate of Service attesting to the fact that the Request was served on the Petitioner or its counsel, which is also required by the Board's

rules. TBMP §113 ("[p]roof of . . . service must be made before the paper will be considered by the Office"); Friscia Decl. at ¶6.

The Petitioner only recently became aware that the Request was filed when the Petitioner's counsel was performing a status check on the PTO website. Id. Thus, the Petitioner respectfully request that the Board strike the Request as improper. In the alternative, if the Board is inclined to consider the Request, we ask that the Board also consider the following response.

I. The Petitioner properly filed its Petition for Cancellation

The Respondent's Request should be denied because it is rife with factual and legal inaccuracies. Most significantly, the Respondent has not provided any explanation as to why it did not receive ASICS' Petition for Cancellation (the "Petition"). The Respondent states repeatedly that a Certificate of Mailing was not attached to the Petition, however, the Petitioner was not required to serve the Petition on the Respondent or include a Certificate of Mailing with its Petition, because that Petition was filed electronically on August 30, 2007. See TBMP §§113.01; 110.01. The Petition states that the Respondent's address is 800 North Sepulveda Boulevard, El Segundo, California 90245 (the "California Address"), which is the address listed in the U.S. Patent and Trademark Office's ("PTO") TARR database for the Respondent's Registration Nos. 3,266,561 and 3,266,560. See Petition at ¶1 and Friscia Decl., Exhibit B.

On September 11, 2007, the Board sent the Petition to the Respondent, along with a Scheduling Order (the "Order") setting forth the Respondent's deadline to answer the Petition, as well as deadlines for the discovery and trial dates in this action. Friscia Decl., Exhibit A. The Board's Order indicates that the Order and Petition were sent to the California Address - the same address as listed in the PTO's TARR records for the Respondent's marks and the same

address presumably used by the Board when sending the Notice of Default to the Respondent on November 9, 2007. Id. at Exhibits B and C.

II. The Respondent has not demonstrated that the Board committed an error in granting the Petition.

The "premise underlying a request for . . . reconsideration, is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued." TBMP §543. The Respondent's Request presents no such evidence or authority. In particular, the Request does not present any evidence that the California Address is incorrect or that the Board's Order was returned as undeliverable to the Board. In fact, the Request presents no explanation whatsoever as to why the Respondent did not receive the Petition or the Order, but received the Notice of Default sent to the same address.

If, for example, the Respondent's address changed, it was the Respondent's responsibility to maintain a current and accurate correspondence address in its registration. See Trademark Manual of Examination Procedure (4th ed. April 2005) ("TMEP") §603.03. An attorney representing a Respondent is responsible for insuring that a Respondent's correspondence address is updated. Id. at §117.03. However, the Respondent has not alleged that its address has changed, and the Board did not indicate that the mail it sent to the Respondent was returned as undeliverable. See Jack Lenor Larsen Inc. v. Chas. O. Larson Co., 44 U.S.P.Q.2d 1950 (TTAB 1997) (denying motion under Rule 60(b) in cancellation action where respondent denied receipt of any of Board's orders, and considering that Postal Service failed to return any of the orders as undeliverable). "The mailing of correspondence in accordance with standard Office mailing procedures creates a presumption of receipt of correspondence." TBMP §117.01; see Jack Larsen

Inc., 44 U.S.P.Q.2d at 1953. The Respondent has not cited any evidence or authority that refutes this presumption.

Furthermore, upon receiving the Notice of Default, the Respondent did not "show cause why judgment by default should not be entered against respondent in accordance with Fed.R.Civ.P. 55(b)" as required by the Notice of Default. Board's November 9, 2007 Notice of Default, attached as Exhibit C to the Friscia Decl. Instead, the Respondent's counsel alleges that it "had intended to file" a response to the order to show cause, but did not do so. However, as discussed in detail above, the Respondent's counsel offers no explanation or evidence as to why that response was not filed.

In addition, the Respondent's counsel alleges that it filed an Answer to the Petition with the Board on December 10, 2007 (nearly two months after its Answer was due). However, the Board has no record of an Answer having been filed, and the Respondent has not submitted evidence that the Answer was filed (such as an automatic response from the Board that is always sent to a filer after a pleading is filed with the Board, or proof of mailing if the Answer was filed by mail). See Friscia Decl., Exhibit A. Of course, even if the Answer had been filed with the Board on December 10, 2007, the Answer would not have been timely filed, given that the deadline for the Answer was nearly two months prior. Id.

In short, the Respondent has not demonstrated that the Board should reconsider its decision granting ASICS' Petition, and the Respondent has surely not demonstrated that the extraordinary remedy of vacating a final judgment of the Board is warranted. See Pfaltzgraf v. William Davies Co., Inc., 175 U.S.P.Q. 620 (TTAB 1972) (finding petitioner's failure to act in cancellation proceeding did not constitute excusable neglect, where petitioner alleged that he did

not receive office action setting discovery and testimony schedule and that he did not know he had to take action beyond filing petition in order to prove case); Marriott Corp. v. Pappy's Enterprises, Inc., 192 U.S.P.Q. 735 (TTAB 1976) (finding opposer's failure to take testimony resulting from interruptions, staff changes, and miscommunications in the office of opposer's attorney, "was occasioned by carelessness and inattention of such character as to constitute inexcusable neglect" and also could not be deemed to constitute "inadvertence").

In view of the foregoing, the Respondent respectfully requests that the Board deny Respondent's Request for Reconsideration.

Respectfully submitted,

Dated: March 7, 2008

Michael R. Friscia

Attorney for Petitioner ASICS Corp.
McCarter & English, LLP
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102
Tel: (973) 639-8493
Fax: (973) 624-7070

Certificate of Service

I hereby certify that a copy of the foregoing Response to Request for Reconsideration was served by overnight mail this 7th day of March, 2008 on:

Lucy B. Arant, Esq.
Mitchell, Silberberg & Knupp, LLP
11377 W. Olympic Boulevard
Los Angeles, CA 90064
Attorneys for Respondent Dynasty Footwear, Ltd.

Mary Ann Boyce

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

In the matter of Trademark Reg. No. 3,266,561 and Reg. No. 3,266,560 Date registered: July 17, 2007	
ASICS Corporation, PETITIONER, V. Dynasty Footwear, Ltd., RESPONDENT	CANCELLATION NO. 92048084 DECLARATION OF MICHAEL R. FRISCIA

I, MICHAEL R. FRISCIA, hereby declare, pursuant to 28 U.S.C. § 1746, as follows:

1. I am an attorney at law of the State of New Jersey and am a Partner in the firm of McCarter & English, LLP, counsel for Petitioner ASICS Corporation ("ASICS" or "Petitioner") in the above-captioned action. I make this Declaration in support of ASICS' Response to Request for Reconsideration.

2. On or about August 30, 2007, ASICS filed a Petition for Cancellation (the "Petition") against Dynasty Footwear, Ltd.'s ("Dynasty" or "Respondent") U.S. Trademark Registration Nos. 3,266,561 and 3,266,560.

3. The Board's docket sheet for this matter shows that on September 11, 2007, the Board sent the Petition to the Respondent, along with a Scheduling Order setting forth Respondent's deadline to answer the Petition (forty days from September 11, 2007), as well as deadlines for the discovery and trial dates in this action. I also received a copy of the Board's

Scheduling Order. A copy of the Scheduling Order and a printout of the docket sheet for this matter are attached as Exhibit A hereto.

4. Attached as Exhibit B are copies of the U.S. Patent and Trademark Office's TARR records for Dynasty's U.S. Registration Nos. 3,266,561 and 3,266,560.

5. The Board's docket sheet for this matter shows that on November 9, 2007, the Board sent Dynasty a Notice of Default. I also received a copy of that document. Attached as Exhibit C is a copy of the Notice of Default.

6. I never received a copy of Dynasty's Request for Reconsideration. On February 29, 2008, while performing a routine status check on the PTO's website, I discovered that Dynasty had filed a Request for Reconsideration on February 11, 2008 without having served that Request on my firm. Dynasty's Request for Reconsideration does not include a Certificate of Service indicating that the Request was served on my firm.

I declare that the foregoing statements made by me are true. I am aware that if any of the foregoing statements made by me are willfully false, I am subject to punishment.

Executed this 7th day of March, 2008.

Michael R. Friscia

EXHIBIT A

United States Patent and Trademark Office

TTABVUE. Trademark Trial and Appeal Board Inquiry System **v1.4**

Cancellation

Number: 92048084 **Filing Date:** 08/30/2007
Status: Pending **Status Date:** 02/13/2008
Interlocutory Attorney: MARY CATHERINE FAINT

Defendant

Name: Dynasty Footwear, Ltd.
Correspondence: Dynasty Footwear, Ltd.
800 North Sepulveda Boulevard
El Segundo, CA 90245
skb@msk.com
Serial #: 77023335 Application File **Registration #:** 3266561
Application Status: Cancelled - Section 18
Serial #: 77023331 Application File **Registration #:** 3266560
Application Status: Cancelled - Section 18

Plaintiff

Name: ASICS Corporation
Correspondence: Michael R. Friscia
McCarter & English, LLP
100 Mulberry Street, Four Gateway Center
Newark, NJ 07102
mboyce@mccarter.com
Serial #: 72337826 Application File **Registration #:** 937464
Application Status: Renewed
Serial #: 73406166 Application File **Registration #:** 1303804
Application Status: Renewed
Serial #: 73401552 Application File **Registration #:** 1273516
Application Status: Renewed
Serial #: 73388453 Application File **Registration #:** 1273615
Application Status: Renewed
Serial #: 74269804 Application File **Registration #:** 1781511
Application Status: Renewed

Prosecution History

#	Date	History Text	Due Date
8	02/11/2008	REGISTRANT REQUEST FOR RECONSIDERATION	
7	02/11/2008	TERMINATED	
6	02/11/2008	COMM'RS ORDER CANCELLING REGISTRATION	
5	02/05/2008	BOARD'S DECISION: GRANTED	
4	11/09/2007	RESPONSE DUE 30 DAYS (DUE DATE)	12/09/2007
3	09/11/2007	PENDING, INSTITUTED	
2	09/11/2007	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	10/21/2007

1 08/30/2007 FILED AND FEE

Results as of 03/04/2008 12:43 PM **Search:**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 11, 2007

Cancellation No. 92048084
Reg. No. 3266561
Reg. No. 3266560

Dynasty Footwear, Ltd.
800 North Sepulveda Boulevard,
El Segundo, CA 90245

ASICS Corporation

V.

Dynasty Footwear, Ltd.

Michael R. Friscia
McCarter & English LLP
100 Mulberry Street, Four Gateway Center
Newark, NJ 07102

Amy Matelski, Paralegal Specialist

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available on the TTAB's web page at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	10/1/07
Discovery period to close:	3/29/08
30-day testimony period for party in position of plaintiff to close:	6/27/08
30-day testimony period for party in position of defendant to close:	8/26/08
15-day rebuttal testimony period for plaintiff to close:	10/10/08

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. *See* TBMP § 502.06(a) (2d ed. rev. 2004).

If the parties to this proceeding are (or during the pendency of this proceeding, become) parties to another Board or civil proceeding involving related marks or other common issues of law or fact, they shall notify the Board immediately, so that the Board can consider consolidation or suspension of proceedings, if appropriate.

New Developments at the Trademark Trial and Appeal Board

For faster handling of all papers, the TTAB strongly encourages electronic filing whenever possible. TTAB forms for electronic filings are available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABvue at http://ttabvue.uspto.gov.

EXHIBIT B

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

This page was generated by the TARR system on 2008-03-06 22:59:31 ET

Serial Number: 77023335 Assignment Information Trademark Document Retrieval

Registration Number: 3266561

Mark

Standard Character claim: No

Current Status: Registration canceled under Section 18.

Date of Status: 2008-02-11

Filing Date: 2006-10-17

Transformed into a National Application: No

Registration Date: 2007-07-17

Register: Supplemental

Law Office Assigned: LAW OFFICE 111

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: 845 -TTAB

Date In Location: 2008-02-11

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

---

1. Dynasty Footwear, Ltd.

Address:
Dynasty Footwear, Ltd.
800 North Sepulveda Boulevard
El Segundo, CA 90245
United States

Legal Entity Type: Ltd Liab Co
State or Country Where Organized: California
Phone Number: (310) 312-2000
Fax Number: (310) 231-8311

GOODS AND/OR SERVICES

International Class: 025
Class Status: Section 18 - Cancelled
FOOTWEAR
Basis: 1(a)
First Use Date: 2006-02-00
First Use in Commerce Date: 2006-02-00

ADDITIONAL INFORMATION

Description of Mark: The mark consists of a fanciful geometric design.

Design Search Code(s):
26.13.14 - Quadrilateral (three or more quadrilaterals); Three or more quadrilaterals
26.13.16 - Quadrilaterals touching or intersecting
26.13.21 - Quadrilaterals that are completely or partially shaded

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-11 - Canceled Section 18 -Total

2008-02-11 - Cancellation terminated for Proceeding

2008-02-05 - Cancellation granted for Proceeding

2007-11-09 - TEAS Change Of Correspondence Received

2007-09-11 - Cancellation Instituted No. 999999

2007-07-17 - Registered - Supplemental Register

2007-05-15 - Law Office Publication Review Completed

2007-05-15 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2007-05-14 - Amendment From Applicant Entered

2007-05-14 - Communication received from applicant

2007-05-14 - Assigned To LIE

2007-04-20 - PAPER RECEIVED

2007-02-12 - Non-final action mailed

2007-02-12 - Non-Final Action Written

2007-02-09 - Assigned To Examiner

2006-10-24 - Notice Of Design Search Code Mailed

2006-10-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Lucy B. Arant

Correspondent
Lucy B. Arant
Mitchell Silberberg & Knupp LLP
11377 West Olympic Boulevard
Los Angeles CA 90064-1683
Phone Number: (310) 312-2000
Fax Number: (310) 231-8311

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

This page was generated by the TARR system on 2008-03-06 22:59:52 ET

Serial Number: 77023331 Assignment Information Trademark Document Retrieval

Registration Number: 3266560

Mark

Standard Character claim: No

Current Status: Registration canceled under Section 18.

Date of Status: 2008-02-11

Filing Date: 2006-10-17

Transformed into a National Application: No

Registration Date: 2007-07-17

Register: Supplemental

Law Office Assigned: LAW OFFICE 111

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: 845 -TTAB

Date In Location: 2008-02-11

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

---

1. Dynasty Footwear, Ltd.

Address:
Dynasty Footwear, Ltd.
800 North Sepulveda Boulevard
El Segundo, CA 90245
United States

Legal Entity Type: Ltd Liab Co
State or Country Where Organized: California
Phone Number: (310) 312-2000
Fax Number: (310) 231-8311

GOODS AND/OR SERVICES

International Class: 025
Class Status: Section 18 - Cancelled
FOOTWEAR
Basis: 1(a)
First Use Date: 2004-08-00
First Use in Commerce Date: 2004-08-00

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of a fanciful geometric design.

Design Search Code(s):
26.13.13 - Quadrilateral (two quadrilaterals); Two quadrilaterals
26.13.21 - Quadrilaterals that are completely or partially shaded
26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-11 - Canceled Section 18 -Total

2008-02-11 - Cancellation terminated for Proceeding

2008-02-05 - Cancellation granted for Proceeding

2007-11-09 - TEAS Change Of Correspondence Received

2007-09-11 - Cancellation Instituted No. 999999

2007-07-17 - Registered - Supplemental Register

2007-05-15 - Law Office Publication Review Completed

2007-05-15 - APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER

2007-05-14 - Teas/Email Correspondence Entered

2007-05-14 - Communication received from applicant

2007-05-14 - Assigned To LIE

2007-04-20 - PAPER RECEIVED

2007-02-12 - Non-final action mailed

2007-02-12 - Non-Final Action Written

2007-02-09 - Assigned To Examiner

2006-10-24 - Notice Of Design Search Code Mailed

2006-10-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Lucy B. Arant

Correspondent
Lucy B. Arant
Mitchell Silberberg & Knupp LLP
11377 West Olympic Boulevard
Los Angeles CA 90064-1683
Phone Number: (310) 312-2000
Fax Number: (310) 231-8311

EXHIBIT C

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

vb

Mailed: November 9, 2007

Cancellation No. 92048084

ASICS Corporation

v.

Dynasty Footwear, Ltd.

Vionette Baez, Paralegal:

Answer was due in this case on October 21, 2007. Inasmuch as it appears that no answer has been filed, nor has respondent filed a motion to extend its time to answer, notice of default is hereby entered against respondent under Fed. R. Civ. P. 55(a).

Respondent is allowed until thirty days from the mailing date of this order to show cause why judgment by default should not be entered against respondent in accordance with Fed. R. Civ. P. 55(b).