

ESTTA Tracking number: **ESTTA403947**

Filing date: **04/15/2011**

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

Proceeding	92052063
Party	Defendant Andrew Kirpalani
Correspondence Address	JAY BEGLER NIESAR & VESTAL LLP 90 NEW MONTGOMERY STREET SAN FRANCISCO, CA 94105 UNITED STATES jbegler@nvlawllp.com
Submission	Other Motions/Papers
Filer's Name	Jay Begler
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Signature	/Jay Begler/
Date	04/15/2011
Attachments	Joint Request For Consideration .pdf (11 pages)(325103 bytes)

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

ACI INTERNATIONAL
Petitioner-Respondent

V

ANDREW KIRPALANI
Respondent-Petitioner

Cancellation Number: 92052063

Registration Number: 3,737,545

Trademark: DENALI

JOINT REQUEST FOR RECONSIDERATION

ACI INTERNATIONAL, Petitioner Respondent, and ANDREW KIRPALANI, Respondent-Petitioner, (collectively the "Parties") respectfully request reconsideration of the Interlocutory Attorney's decision of March 17th denying Kirpalani's Motion to Amend his description of goods.

Background

Pursuant to 37 CFR 2.133, and as part of a settlement agreement disposing of this proceeding, Respondent-Petitioner had moved to amend its registration, No.3, 737,545. The parties hereto had entered into and have executed a settlement agreement under the terms of which the Respondent-Petitioner is required to amend the description of goods in its registration as described below.

For ease of reference the Parties set forth the description of the goods as they appear in the present registration of Kirpalani, followed by the proposed amendment.

Present Description

"Footwear for men, women and children, namely, sneakers, boots, ski and snowboard shoes, hiking boots, heels, leather shoes, slippers, flip flops, sandals, pumps; clothing and apparel, namely, shirts, t-shirts, polo shirts, knit shirts, sweat shirts, sweat pants, pants, pullovers, sweaters, socks, scarves, hats, gloves and mittens."

Proposed Change

"Clothing and apparel, namely, shirts, t-shirts, polo shirts, knit shirts, sweat shirts, sweat pants, pants, pullovers, sweaters, socks, scarves, hats, gloves and mittens and expressly disclaiming all of the following goods: all goods and products normally worn on feet of any material whether for dress or casual or other use (but excluding hosiery and excluding clothing products affixed to feet such as pants with stirrups) but including but not limited to: shoes of any type (including without limitation, shoes used in connection with walking or sports or athletic or outdoor activities), boots of any type (including without limitation, boots used for hiking, fishing, hunting waders, cold weather activities), flip flops, sandals, slippers, overshoes, clogs and beach shoes as well as elements or components of the foregoing footwear."

The Prior Decision

The Interlocutory Attorney denied the motion on two grounds: first that the required fee for amending a registration was not paid and secondly that the proposed amendment was improper because "the goods that respondent expressly disclaims in the amended identification

are not logically within the scope of the remaining goods in that identification." As authority for this conclusion the Interlocutory Attorney cites IdeasOne Inc v Nationwide Betterhealth, Inc 89 USPQ1952 (TTAB 2009) (hereafter, the "IdeasOne decision"). The required fee has since been paid as evidenced by the attached receipt.

ARGUMENT

In the IdeasOne decision, Petitioner, IdeasOne, sought to register its mark WELLCORPS INTERNATIONAL for dietary supplements, but was barred by Respondent's registration of WELLCORP. Ultimately, Petitioner amended its description as follows: "consulting services in the field of health offered to employers, not including the provisions [sic] of dietary supplements." This amendment, the Board noted, "did not comport with trademark examination practice and procedure." The Board stated that: "Petitioner, by its proposed restriction, effectively seeks to exclude goods (dietary supplements) that are not encompassed within the scope of a registration that only includes services." The Board further noted that: "Petitioner's proposed restriction is deficient because the sale of a good, (i.e. the provision of dietary supplement) does not constitute a service."

Importantly, the Board in IdeasOne gives an example of an acceptable proposed restriction, namely: "consulting services in the field of health offered to employers excluding consulting services in the field of dietary supplements." The Board then noted that this description would be acceptable because: "...the suggested exclusionary language would be logically encompassed within the scope of the original recitation of services...." Since the original description in Kirpalani's registration recited "footwear for men, women and children...." the exclusionary language of the proposed amendment is clearly within the scope of the original registration.

That the structure of the proposed amendment is proper is further evidenced by the acceptance by the Trademark Office of similarly structured descriptions of goods in class 25.

See for example the registration for the mark TATOO:

Word Mark	TATTOO
Goods and Services	IC 025. US 022 039. G & S: Sportswear for men, women, children and juniors, namely, shirts, tee shirts, knit tops; tank tops; fleece sweat shirts, fleece sweat pants, camp shirts, head wear and lounge wear; and specifically excluding footwear , namely, dress shoes, walking shoes, athletic shoes, slippers, sandals and boots for men, women and children; and dresses, skirts, pants and shorts for women. FIRST USE: 20050201. FIRST USE IN COMMERCE: 20050201
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	78447732
Filing Date	July 8, 2004
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	May 17, 2005
Registration Number	3133955
Registration Date	August 22, 2006
Owner	(REGISTRANT) Paisano Publications, LLC Joseph Teresi, Member, United States citizen. Ellen Teresi, Member, United States citizen. LIMITED LIABILITY COMPANY DELAWARE 28210 Dorothy Drive Agoura Hills CALIFORNIA 91301

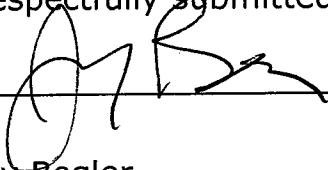
Other examples are attached hereto.

The structure of the above description with the exclusionary language is for all intents and purposes no different from the proposed amendment. The interpretation by the Interlocutory Attorney of IdeasOne would require a rejection of the Tattoo description and the description of the registrations attached hereto because "footwear" would not be logically within the scope of the remaining goods. Clearly this was not the intention of the Board in issuing the IdeasOne decision. The better interpretation, and one that is consistent with the issuance of the

cited registrations, is that so long as the registration has a recitation of "clothing" (the Denali registration recites "clothing and apparel,") specific exclusion of footwear is permissible and considered within the scope of the remaining goods of the registration.

For the foregoing reasons, the Parties request that the proposed amendment be permitted.

Respectfully submitted,

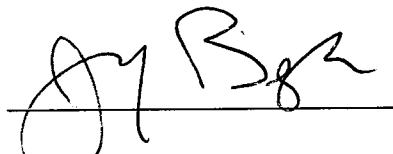
A handwritten signature in black ink, appearing to read "JB", is written over a horizontal line.

Jay Begler
Niesar & Vestal
90 New Montgomery Street
San Francisco, California 94105
(415) 882-5300
(415) 882-5400 (fax)

CERTIFICATE OF SERVICE PURSUANT TO 37 CFR 4 2.119

I hereby certify that a true and accurate copy of the foregoing
JOINT REQUEST FOR RECONSIDERATION has been served by first class
mail, and Email on April 15, 2011 upon:

LOUIS J. BOVASSO
GREENBERG TRAUIG
2450 COLORADO AVENUE, SUITE 400E
SANTA MONICA, CA 90404
BovassoL@GTLAW.com,



Jay Begler

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

Cancellation No. 92052063

Re: ACI International

v.

Andrew Kirpalani

TRADEMARK PROCESS
RECEIVED
2011 APR 14 P 1:00
US PATENT &
TRADEMARK OFFICE

Re: Payment of Fee

On March 17, 2011, the TTAB issued a Response to Respondent's Proposed Amendment to its Registration No. 3737545 allowing registrant thirty days to submit a revised amendment with appropriate fee. Attached is a copy of the TTAB Action.

The undersigned attorney acting on behalf of respondent's attorney Jay Begler of NIESAR & VESTAL LLP has been requested to pay the \$100.00 fee required to support registrant's revised amendment.

A check for \$100.00 is attached hereto.

The undersigned is acting only on behalf of respondent's attorney to pay the required fee and for no other purposes.

Respectfully submitted,



Michael J. Hynak
Attorney at Law

Other Registrations With Exclusionary Language

Logout

Please logout when you are done to release system resources allocated for you.

Start

List At: OR Jump to record: **Record 23 out of 97**

TARR Status

ASSIGN Status

TDR

TTAB Status

(Use the "Back" button of the Internet Browser to return to TESS)

BACKSTAGE

Word Mark BACKSTAGE

Goods and Services IC 025. US 022 039. G & S: Headwear; men, ladies and children clothing **excluding** footwear, namely, dresses, tops, pants, shirts, shorts, skirts

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Trademark Search

Facility SHAPES-MISC Miscellaneous shaped designs

Classification Code

Serial Number 79064929

Filing Date October 27, 2008

Current Filing Basis 66A

Original Filing Basis 66A

Published for Opposition April 28, 2009

Registration 3655061

Number
International
Registration Number 0992172
Registration Date July 14, 2009
Owner (REGISTRANT) Dara Pty Ltd COMPANY AUSTRALIA 58 Hoskins Avenue BANKSTOWN AUSTRALIA NSW 2200

Please logout when you are done to release system resources allocated for you.

List At: OR to record: **Record 12 out of 97**

(Use the "Back" button of the Internet Browser to return to TESS)

MÖDID.

Word Mark MÖDID.
Goods and Services IC 025. US 022 039. G & S: CLOTHING, NAMELY, T-SHIRTS, BLOUSES, COATS, SWEATSHIRTS, BATHING SUITS, SLEEPWEAR, HATS, SCARVES, BELTS, EXCLUDING FOOTWEAR. FIRST USE: 20060200. FIRST USE IN COMMERCE: 20060200

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 78527061
Filing Date December 3, 2004
Current Filing Basis 1A
Original Filing Basis 1B
Published for Opposition September 12, 2006
Registration Number 3399446
Registration Date March 18, 2008
Owner (REGISTRANT) Guerra, Raul INDIVIDUAL UNITED STATES P.O Box 922612 Sylmar

CALIFORNIA 91392

(REGISTRANT) Guerra, Josefina R. INDIVIDUAL UNITED STATES P.O Box 922612
Sylmar CALIFORNIA 91392

TARR Status	ASSIGN Status	TDR	TTAB Status
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 (Use the "Back" button of the
Internet Browser to return to TESS)

Typed Drawing

Word Mark BURLY GIRLS

Goods and Services IC 025. US 022 039. G & S: Clothing and accessories, namely T-shirts, tank tops, long-sleeve shirts, sweatshirts, belts, visors, and caps for snowboarders, skateboarders, and surfers, excluding rain jackets and pants for cyclists and **excluding footwear**. FIRST USE: 20010801. FIRST USE IN COMMERCE: 20010801

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76358035

Filing Date January 14, 2002

Current Filing Basis 1A

Original Filing Basis 1A

Published for Opposition August 26, 2003

Registration Number 2783686

Registration Date November 18, 2003

Owner (REGISTRANT) Burly Girls Marissa Noppe and Adrienne Noppe, both U.S. citizens PARTNERSHIP WASHINGTON PO Box 5906 Bellingham WASHINGTON 98227

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GIRLS" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 8 (6-YR).

Live/Dead Indicator LIVE

Word Mark JADE BY JASMINE
Goods and Services IC 025. US 022 039. G & S: Bridal dresses, ladies' evening dresses, ladies' daytime dresses, children's dresses and suits, bridal headgear, namely bridal headbands, bridal garlands and bridal veils, veils, gloves, hosiery, men's tuxedos and suits and **specifically excluding footwear**. FIRST USE: 20020801. FIRST USE IN COMMERCE: 20020801
Mark Drawing Code (1) TYPED DRAWING
Serial Number 76403207
Filing Date May 2, 2002
Current Filing Basis 1A
Original Filing Basis 1B
Published for Opposition June 29, 2004
Registration Number 2944361
Registration Date April 26, 2005
Owner (REGISTRANT) Jasmine Enterprises, Inc. CORPORATION ILLINOIS 820 Turnberry Court Hanover Park ILLINOIS 60103
Attorney of Record Laurel V. Dineff
Prior Registrations 1390916
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE