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

Proceeding	92053208
Party	Plaintiff Nordstrom, Inc. and NIHC, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	06/27/2011
Attachments	848.pdf (16 pages)(1643118 bytes)

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

NORDSTROM, INC. and NIHC, INC.,)	
)	
Petitioners,)	Cancellation No. 92053208
)	
v.)	Registration No. 3717204
)	
PERRIANN M. HOLDEN,)	
)	
Respondent.)	Attorney Docket No. 690097.848
_____)	

**PETITIONER’S MOTION TO FILE
AMENDED PETITION FOR CANCELLATION**

Petitioners Nordstrom, Inc. (“Nordstrom”) and NIHC, Inc. (“NIHC”) hereby move for leave to amend their Petition for Cancellation to add Registration No. 3944653 issued April 12, 2011 for “BP.” in Class 18. This Registration has a filing/priority date prior Respondent’s and therefore is relevant to this proceeding. Petitioners also move to amend their Petition to reflect that pled Registration Nos. 3520658, 3543681 and 3624666 were recently assigned to NIHC.

Application Sn. 77/386737, which matured into Registration No. 3944653, was pled in the original Petition and Respondent has taken discovery on the underlying application and Petitioners other pled registrations. Discovery is currently set to close on July 6, 2011. No prejudice will result from allowing Petitioners to amend their Petition for Cancellation.

FACTS

Petitioners filed a Petition for Cancellation of US Trademark Registration No. 3717204, issued to Respondent Perriann M. Holden on December 1, 2009 in class 25, on the ground that, *inter alia*, the mark is confusingly similar to Petitioners' BP. mark and variations of that mark ("the BP Marks").

The original Petition for Cancellation, filed October 28, 2010, alleges, *inter alia*, that Nordstrom has used its BP Marks in commerce since 1985, well before Respondent filed her application that led to US Registration No. 3717204, in connection with young women's clothing, footwear and accessories and for retail services featuring those products (Petition for Cancellation ¶3).

Petitioners listed among the bases for their Section 2(d) claim Application Sn. 77/386737 for BP. in class 18, with a priority filing date of February 1, 2008 (Petition for Cancellation ¶8). Registration No. 3944653 issued from Application Sn. 77/386737 on April 12, 2011.

Petitioners also listed among the bases for their Section 2(d) claim US Registration Nos. 3520658, 3543681 and 3624666 for the BP Marks (Petition for Cancellation ¶¶5-7). These registrations were assigned to NIHC on March 28, 2011 (Reel/Frame 4511/0320, Recorded March 30, 2011).

Respondent has served discovery requests on Petitioners regarding Petitioners' asserted BP Marks, including the underlying application for Registration No. 3944653 and the other pled registrations for the BP Marks.

ARGUMENT

Petitioners should be granted leave to amend their Petition for Cancellation to (1) add the Registration No. 3944653, especially since the underlying allowed application was pled in the original Petition as a basis for Petitioners' Section 2(d) claim, and

(2) reflect that pled Registrations Nos. 3520658, 3543681 and 3624666 were recently assigned to NIHC.

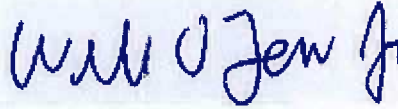
Fed. R. Civ. P. 15(a) provides that leave to amend pleadings shall be freely given when justice so requires. As stated by the Board in *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701, 1702 (TTAB 2000): “[c]onsistent therewith, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the parties.” *See also* TBMP §507.02(a).

The Board normally grants motions to amend petitions for cancellation to add registrations issued to or acquired by petitioners after the filing date of the original pleading and to reflect changes in ownership. *See Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991). *See also* TBMP §§507.02 and 512.01. Respondent will not be prejudiced by the requested amendment. Newly issued Registration No. 3944653 is for the same mark and goods and services pled in the original Petition for Cancellation and Respondent has been on notice of the underlying application since the filing of the original Petition. Indeed, Respondent has served discovery requests on Petitioners’ regarding the underlying application. Further, NIHC is already a party to this proceeding and amending the Petition to reflect its ownership of the pled registrations will have no adverse impact on Respondent. This proceeding is still in the pretrial stage and Petitioners have not delayed in bringing the instant motion to amend. *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (no prejudice to applicant because discovery still open when motion filed). *See also* TBMP §507.02.

Accordingly, Petitioners should be granted leave to file its proposed Amended Petition for Cancellation. Enclosed herewith are the proposed Amended Petition for Cancellation and a redline version of the Amended Petition showing the changes to the original Petition.

DATED this 27th day of June, 2011.

SEED IP Law Group PLLC

A handwritten signature in blue ink, appearing to read "William O. Ferron, Jr.", is written over a light blue rectangular background.

William O. Ferron, Jr. —
Nathaniel E. Durrance
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
Telephone (206) 622-4900
Facsimile (206) 682-6031

Attorneys for Petitioners
Nordstrom, Inc. and NIHC, Inc.

1922803_2.DOCX

Certificate of Service

I hereby certify that on this 27th day of June, 2011, the foregoing PETITIONERS' MOTION TO FILE AMENDED PETITION FOR CANCELLATION was served upon Respondent's counsel by United States first-class mail, postage-prepaid, addressed as follows:

Jerry R. Potts, Esq.
Law Office of Jerry R. Potts
3248 Via Ribera
Escondido, California 92029



Kelly Brennan

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

NORDSTROM, INC. and NIHC, INC.,)	
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Petitioners,)	Cancellation No. 92053208
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v.)	Registration No. 3717204
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PERRIANN M. HOLDEN,)	
)	
Respondent.)	Attorney Docket No. 690097.848
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AMENDED PETITION FOR CANCELLATION

Petitioners Nordstrom, Inc. (“Nordstrom”) and NIHC, Inc. (“NIHC”) hereby request that the Trademark Trial and Appeal Board cancel United States Trademark Registration No. 3717204, issued to Perriann M. Holden on December 1, 2009 for the mark BP BOD POCKETS THE POCKET YOU WEAR and Design for “clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility for holding personal items, driver licenses, currency, coins, cell phones, eye glasses, hand-held electronic devices, calculators, and the like” in International Class 25.

The grounds asserted by Petitioners for cancellation are as follows:

1. Nordstrom is a nationwide clothing retailer with department stores, Internet sales and catalog sales throughout the United States. Nordstrom is engaged in the marketing and sale of a wide variety of men’s, women’s and children’s clothing, footwear, handbags and accessories in interstate commerce.

2. NIHC is a wholly-owned subsidiary of Nordstrom.
3. Commencing at least as early as 1985, Nordstrom adopted and has used the mark “BP” and variations of that mark (“BP Marks”) in interstate commerce in the United States as a trademark in connection with young women’s clothing, footwear and fashion accessories and for retail services featuring those products.
4. Nordstrom applied for and received U.S. Trademark Registration No. 3027963 for the mark BP. SHOES for “footwear” in International Class 25. The registration is valid and subsisting and is now owned by NIHC and exclusively licensed to Nordstrom.
5. Nordstrom applied for and received U.S. Trademark Registration No. 3520658 for the mark BP. for “girl’s and young women’s fashion clothing, namely, jackets, turtlenecks, tank tops, dresses, shorts, overalls, blazers, sweaters, cardigans, coats, sweatshirts, vests, skirts, sweatpants, shirts, lingerie, mock turtlenecks, socks, pants and skorts; and women’s footwear” in International Class 25. The registration is valid and subsisting, was recently assigned to NIHC by Nordstrom, and is exclusively licensed to Nordstrom by NIHC.
6. Nordstrom applied for and received U.S. Trademark Registration No. 3543681 for the mark BP. for “retail store services and online retail store services featuring girl’s and young women’s fashion clothing, accessories and footwear” in International Class 35. The registration is valid and subsisting, was recently assigned to NIHC by Nordstrom, and is exclusively licensed to Nordstrom by NIHC.
7. Nordstrom applied for and received U.S. Trademark Registration No. 3624666 for the mark BP. PLATINUM for “footwear” in International Class 25. The registration is valid and subsisting, was recently assigned to NIHC by Nordstrom, and is exclusively licensed to Nordstrom by NIHC.
8. Nordstrom is also the owner of allowed U.S. Trademark Application Serial No. 77386737 for BP., with a priority filing date of February 1, 2008, for

“handbags, wallets, travel bags, key cases, luggage, briefcases; all-purpose bags; cosmetic cases sold empty, vanity cases sold empty” in International Class 18. This application has now issued as US Registration No. 3944653, which is valid and subsisting.

9. Petitioners Nordstrom and NIHC are hereafter jointly referred to as “Nordstrom.”

10. Since commencing use of the BP Marks as described above, Nordstrom has generated substantial revenue from the sale of “BP” goods and the provision of BP services in the United States, including sales through Nordstrom’s online retail store. Additionally, Nordstrom has expended substantial sums of money, time and effort in advertising, promoting and popularizing the BP Marks in the United States.

11. As a result of such use of the BP Marks, and the advertising and promotion of the BP retail services and BP-branded apparel and footwear, the BP Marks have become well known in the United States and are recognized as identifying the high-quality services and goods of Nordstrom, especially among purchasers of women’s fashion apparel and accessories. Thus, the BP Marks and associated goodwill are valuable assets of Nordstrom.

12. Respondent’s mark consists of the term “BP” in a rectangular logo form (hereafter “BP Logo”) followed by “bod pockets” and “THE POCKET YOU WEAR” in separate text. “THE POCKET YOU WEAR” and “bod pockets” are descriptive terms that have been disclaimed by Respondent. The BP Logo is prominently placed at the beginning of the mark and displayed in a different font than “bod pockets” or “THE POCKET YOU WEAR.”

13. To the extent it is not a separate mark, the BP Logo is the dominant portion of Respondent’s mark, as reflected in Respondent’s disclaimers of “the pocket you wear” and “bod pockets,” the size and placement of “BP” within the mark, and the fact that Respondent has used the BP Logo alone to promote her goods, as shown in the printout retrieved from Respondent’s website at www.bodpocketstore.com and attached

hereto as Exhibit A. In her use, Respondent places separate “TM” markings after the “bod pockets” and “THE POCKET YOU WEAR” portions of her mark, as seen on Exhibit A and on the specimen of use filed in support of her registration, a copy of which is included as Exhibit B to this Petition.

14. The goods described in Respondent’s registration—*i.e.*, “clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility for holding personal items, driver licenses, currency, coins, cell phones, eye glasses, hand-held electronic devices, calculators, and the like”—are women’s fashion accessories. On information and belief, Respondent’s goods are marketed and sold or intended to be sold to the same consumers as those to whom Petitioner markets services and goods under the BP Marks—*i.e.*, fashion-conscious women—and Respondent’s goods are marketed and offered through the same channels of trade as Petitioner’s goods and services, *e.g.*, online retail stores.

15. The goods described in Respondent’s registration are so closely related to Petitioner’s BP clothing, footwear, fashion accessories, and handbags that confusion is likely to result if the parties’ respective goods and services are marketed and sold under the same or confusingly similar marks.

16. The mark shown in Respondent’s registration for the described goods is confusingly and deceptively similar to Petitioner’s BP Marks for Petitioner’s above-described goods and services, such that the trade and purchasing public will be confused by and deceived into believing that Respondent’s goods originate with Petitioner, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Petitioner.

17. Respondent’s mark was improperly registered because it comprises at least two separate marks that do not make a single commercial impression—*i.e.*, the BP Logo, the stylized words “bod pockets” and the stylized words “THE POCKET YOU WEAR.”

15 USC § 1051(a)(2), *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361

(Fed. Cir. 1999). See Exhibit B, specimen of use filed in support of Registration No. 3717204 and Bod Pockets product packages shown on Respondent's website, Exhibit A.

18. Nordstrom will be damaged by the continuance of Registration No. 3717204.

WHEREFORE, Petitioners pray that this Petition for Cancellation be sustained and Registration No. 3717204 be cancelled.

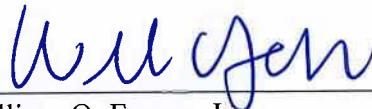
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SEED IP Law Group PLLC
701 Fifth Avenue, Suite 5400
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DATED this 27th day of June, 2011.

Respectfully submitted,
SEED IP Law Group PLLC



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Attorneys for Petitioners
Nordstrom, Inc. and NIHC, Inc.

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I hereby certify that on this 27th day of June, 2011, the foregoing AMENDED PETITION FOR CANCELLATION was served upon Respondent's counsel by United States first-class mail, postage-prepaid, addressed as follows:

Jerry R. Potts, Esq.
Law Office of Jerry R. Potts
3248 Via Ribera
Escondido, California 92029



Kelly Brennan

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DATED this 27th day of June, 2011.

Respectfully submitted,
SEED IP Law Group PLLC

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