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

Proceeding	92053630
Party	Plaintiff OTTO International, Inc.
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Submission	Motion for Default Judgment
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3728502
Registered on December 22, 2009
For the mark OTTO GROUP

_____)	
OTTO INTERNATIONAL, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92053630
)	
OTTO GMBH & CO. KG,)	
)	
Registrant.)	
_____)	

PETITIONER’S MOTION FOR DEFAULT JUDGMENT UNDER 37 CFR §2.114(a)

Pursuant to 37 CFR § 2.114(a), Petitioner Otto International, Inc. (“Otto Int’l”) hereby moves for a judgment of default against Registrant Otto GmbH & Co. KG (“Otto GmbH”) for Otto GmbH’s failure to Answer Otto Int’l’s Petition to Cancel by the re-set deadline of April 27, 2011.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Petitioner Otto Int’l seeks by this Motion an Order that Registrant Otto GmbH is in default and that Registration No. 3728502 is thereby cancelled with respect to International Classes 35 and 41 only.

On March 28, 2011, this Trademark Trial and Appeal Board (“TTAB”) or “Board” issued an Order granting Otto GmbH’s Consent Motion for an Extension of Answer thereby re-setting


the dates as set forth in the Consent Motion. Registrant Otto GmbH failed to file an Answer by the April 27, 2011 re-set deadline, and is currently in default. For this reason, Petitioner Otto Int'l hereby requests entry of judgment in its favor.

II. STATEMENT OF FACTS

This cancellation proceeding, filed on February 16, 2011, involves Petitioner Otto Int'l's portfolio of OTTO marks—namely, (a) OTTO, Registration No. 2932768, for “[o]nline wholesale services for headwears”, in International Class 035; (b) OTTO, Registration No. 2947026, for “clothing, namely, hats, caps, and sunvisors”, in International Class 025; (c)



, Registration No. 2947026, for “clothing, namely, hats, caps, and sunvisors”, in

International Class 025; (d)  , Registration No. 3035238, for “handbags, sport bags, fanny packs, and luggages”, in International Class 018; and (e) OTTO, Registration No. 3046778, for “online wholesale store, outlet, and distributorship services for clothing, luggage, bags, sporting goods”, in International Class 035—and Registrant's confusingly similar mark OTTO GROUP (in which the color red is claimed as a feature of the mark), Registration No. 3728502, for the following services: “Wholesale and retail store services featuring: chemicals used in industry, science, photography, agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastic; fertilizers; fire extinguishing preparations; tempering and soldering preparations; chemical substances for preserving food-stuffs; tanning substances; adhesives used in industry; paints; varnishes; lacquers; preservatives against rust; wood preservatives; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; bleaching preparations and other substances for laundry

use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumes; essential oils; cosmetics; hair lotions; dentifrices; industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels, namely, motor spirit; and illuminants, candles and wicks for lighting; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; food for babies; plasters; materials for wound dressings; materials for stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides; common metals and their alloys; metal building materials, namely, fascia and soffits; transportable buildings of metal; materials of metal for railway tracks; metal cables and wires not for electrical purposes; ironmongery; safes; ores; motors and engines except for land vehicles; agricultural implements other than hand-operated; incubators for eggs; hand tools and hand-operated implements; cutlery; side arms; razors; photographic apparatus and instruments, namely, cameras; magnetic data carriers; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire-extinguishing apparatus; surgical, medical, dental and veterinary instruments and apparatus; artificial limbs, eyes and teeth; orthopaedic [sic] articles; suture materials; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; vehicles; apparatus for locomotion by land, air or water; firearms; ammunition and projectiles; explosive; fireworks; jewelry; precious stones; horological and chronometric instruments; musical instruments; paper; cardboard; printed matter, namely, printed periodicals in the field of fashion, furniture, household appliances, entertainment electronics, pieces of sports equipment, home textiles, and cosmetics; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites except furniture; plastic materials for packaging being

plastic bags; printers' type; printing blocks; rubber; skins and hides; umbrellas; parasols; and walking sticks; whips; harness and saddlery; household or kitchen utensils and containers not of precious metal or coated therewith; combs and sponges; brushes except paintbrushes; brush-making materials; articles for cleaning purposes, namely, steel wool; unworked and semi-worked glass except glass used in building; glassware; porcelain and earthenware, namely, dishes, bowls, pitchers, figurines, and sculptures; ropes; string; nets; tents; awnings; tarpaulins; sails; padding and stuffing material except of rubber or plastics; raw fibrous textile materials; yarns and threads for textile use; textiles and textile goods, namely, bed and table covers; lace and embroidery; ribbons and braid; buttons; hooks and eyes; pins and needles; artificial flowers; carpets; rugs; mats and matting; linoleum and other materials for covering existing floors; games and playthings; decorations for Christmas trees; preserved, dried and cooked fruit and vegetables; jellies; jams; fruit sauces; edible oils and fats; coffee; tea; cocoa; sugar; rice; tapioca; sago. artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery; ices; honey; treacle; yeast; baking-powder; salt; mustard; vinegar; sauces, namely, condiments; spices; ice; agricultural products, namely, unprocessed grains; fresh fruits and vegetables, seeds, natural plants and flowers, and foodstuffs for animals; malt liquor; beers; mineral and aerated waters and other non-alcoholic drinks, namely, lemonade, fruit teas, energy drinks; fruit drinks and fruit juices; alcoholic beverages except beers; tobacco; smokers' articles; and matches; Advertising and marketing; providing commercial information on the Internet relating to the following: chemicals used in industry, science, photography, agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastic; fertilizers; fire extinguishing preparations; tempering and soldering preparations; chemical substances for preserving food-stuffs; tanning substances; adhesives used in industry; paints; varnishes; lacquers; preservatives against rust;

wood preservatives; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumes; essential oils; cosmetics; hair lotions; dentifrices; industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels, namely, motor spirit; and illuminants, candles and wicks for lighting; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; food for babies; plasters; materials for wound dressings; materials for stopping teeth; dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides; common metals and their alloys; metal building materials, namely, fascia and soffits; transportable buildings of metal; materials of metal for railway tracks. metal cables and wires not for electrical purposes; ironmongery; safes; ores; motors and engines except for land vehicles; agricultural implements other than hand-operated; incubators for eggs; hand tools and hand-operated implements; cutlery; side arms; razors; photographic apparatus and instruments, namely, cameras; magnetic data carriers; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire-extinguishing apparatus; surgical, medical, dental and veterinary instruments and apparatus; artificial limbs, eyes and teeth; orthopaedic [sic] articles; suture materials; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; vehicles; apparatus for locomotion by land, air or water; firearms; ammunition and projectiles; explosive; fireworks; jewelry; precious stones; horological and chronometric instruments; musical instruments; paper; cardboard; printed matter, namely, printed periodicals in the field of fashion, furniture, household appliances, entertainment electronics, pieces of sports equipment, home textiles, and cosmetics; bookbinding material;

photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites except furniture; plastic materials for packaging being plastic bags; printers' type; printing blocks; rubber; skins and hides; umbrellas; parasols; and walking sticks; whips; harness and saddlery; household or kitchen utensils and containers not of precious metal or coated therewith; combs and sponges; brushes except paintbrushes; brush-making materials; articles for cleaning purposes, namely, steel wool; unworked and semi-worked glass except glass used in building; glassware; porcelain and earthenware, namely, dishes, bowls, pitchers, figurines, and sculptures; ropes; string; nets; tents; awnings; tarpaulins; sails. padding and stuffing material except of rubber or plastics; raw fibrous textile materials; yarns and threads for textile use; textiles and textile goods, namely, bed and table covers; lace and embroidery; ribbons and braid; buttons; hooks and eyes; pins and needles; artificial flowers; carpets; rugs; mats and matting; linoleum and other materials for covering existing floors; games and playthings; decorations for Christmas trees; preserved, dried and cooked fruit and vegetables; jellies; jams; fruit sauces; edible oils and fats; coffee; tea; cocoa; sugar; rice; tapioca; sago; artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery; ices; honey; treacle; yeast; baking-powder; salt; mustard; vinegar; sauces, namely, condiments; spices; ice; agricultural products, namely, unprocessed grains; fresh fruits and vegetables, seeds, natural plants and flowers, and foodstuffs for animals; malt liquor; beers; mineral and aerated waters and other non-alcoholic drinks, namely, lemonade, fruit teas, energy drinks; fruit drinks and fruit juices; alcoholic beverages except beers; tobacco; smokers' articles; and matches; administrative receipt and processing of purchase orders”, in International Class 035; and for “[p]roviding entertainment in the nature of fashion shows and sporting events in the nature of judo, marathon running, triathlons; organizing community sporting and cultural activities; conducting of games

on the internet, namely, sweepstakes; publishing of electronic publications on the internet”, in International Class 041. Registrant Otto GmbH’s registered mark was obtained pursuant to Section 66(a) of the Trademark Act on the basis of an International Registration (Reg. No. 0969232) registered on December 11, 2007.

On March 28, 2011, the Board issued an Order granting Otto GmbH’s Consent Motion for an Extension of Answer filed on same date thereby re-setting the dates as set forth in the Consent Motion.

On April 26, 2011, one day before the deadline for Registrant Otto GmbH to file its answer to Petitioner Otto Int’l’s Petitioner to Cancel, Registrant’s counsel requested a further 30-day extension for additional time for Otto GmbH to consider settlement of the pending proceeding. Petitioner Otto Int’l was not inclined to grant such last minute request because settlement negotiations had not progressed between the parties since the filing of Registrant Otto GmbH’s Consent Motion for an Extension of Answer on March 28, 2011.

Otto GmbH failed to file an Answer by the April 27, 2011 re-set deadline, and is currently in default. In this regard, Petitioner Otto Int’l hereby requests entry of a judgment in its favor.

III. LEGAL STANDARD

Under the Trademark Rules of Practice, 37 CFR § 2.114(a) states that “[i]f no answer is filed within the time set, the petition may be decided as in case of default.” In addition, Section 312.01 of the TTAB Manual of Procedure (TBMP) states:

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board may issue a notice of default. The notice states that neither an answer nor any extension of time to answer has been filed; that notice of default under Fed. R. Civ. P. 55(a) is entered; and that defendant is allowed

20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response that does not show good cause, default judgment may be entered against it.

If the defendant fails to file a response to the notice, or files a response which does not show good cause in a case where the plaintiff is seeking to partially cancel a registration [. . .], default judgment will be entered only to the extent that the restriction requested by plaintiff will be entered.

The issue of whether default judgment should be entered against a defendant for failure to file a timely answer to the complaint may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default) [. . .].

In this regard, Petitioner Otto Int'l hereby requests that a default judgment be entered against Registrant Otto GmbH.

IV. ARGUMENT

A. Registrant Otto GmbH Is In Default For Its Failure To File A Timely Answer Or Otherwise Respond to Petitioner Otto Int'l's Petition to Cancel

On March 28, 2011, this Board issued an Order granting Registrant Otto GmbH's Consent Motion for an Extension of Answer thereby re-setting the dates as set forth in the Consent Motion. Registrant Otto GmbH failed to timely file an Answer by the April 27, 2011 re-set deadline, and is currently in default.

B. Registrant Otto GmbH Cannot Show Cause For Its Failure To File A Timely Answer Or Otherwise Respond to Petitioner Otto Int'l's Petition to Cancel

Registrant Otto GmbH can provide no reason for its complete failure to answer Petitioner Otto Int'l's Petition to Cancel. While Registrant Otto GmbH did make an "eleventh hour" request for a further extension to answer the Petition to Cancel on April 26, 2011, Petitioner Otto Int'l was not inclined to grant such last minute request because settlement negotiations had not progressed between the parties since the filing of Registrant Otto GmbH's Consent Motion for an Extension of Answer on March 28, 2011 by failing to make any settlement offer to Petitioner. Thus, Registrant Otto GmbH cannot show cause for its blatant failure to timely file an Answer to Petitioner Otto Int'l's Petition to Cancel.

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V. CONCLUSION

For the foregoing reasons, the Board should grant the instant Motion for an Order for Entry of Default of Registrant Otto GmbH and judgment in favor of Petitioner Otto Int'l.

Respectfully submitted,

CHAN LAW GROUP LLP

Dated: May 3, 2011

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