

ESTTA Tracking number: **ESTTA409047**

Filing date: **05/13/2011**

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

Proceeding	92053630
Party	Defendant Otto GmbH & Co. KG
Correspondence Address	OTTO GMBH & CO KG WANDSBEKER , STR 3-7 HAMBURG, 22172 GERMANY efingerhut@dykema.com, jstiven@dykema.com, smckeon@dykema.com, ipmail@dykema.com
Submission	Other Motions/Papers
Filer's Name	Eric T. Fingerhut
Filer's e-mail	smckeon@dykema.com
Signature	/Eric T. Fingerhut/
Date	05/13/2011
Attachments	Registrant's Response to Petitioner's Motion for Default Judgment.pdf (5 pages) (81084 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OTTO INTERNATIONAL, INC.)	
)	
)	
Petitioner)	
)	Cancellation No. 92053630
)	Registration No.: 3728502
v.)	OTTO GROUP
)	
OTTO GMBH & CO. KG)	
)	
Registrant)	

REGISTRANT’S RESPONSE TO PETITIONER’S MOTION FOR DEFAULT JUDGMENT

Registrant, Otto GmbH & Co. KG, does not contest Petitioner’s Motion for Default Judgment. However, Petitioner’s Motion contains glaring factual errors and mischaracterizations and Registrant is simply providing this response to correct the record.

On April 26, 2011 Registrant’s counsel contacted Petitioner’s counsel to provide an update on settlement negotiations and to request Petitioner’s consent for a further thirty (30) day extension of time for Registrant to file its Answer which was due on April 27, 2011.¹ Petitioner’s counsel did not provide Registrant’s counsel with the professional courtesy of a “yes” or “no” response and Registrant decided to forego answering the Petition for Cancellation.

In Petitioner’s Motion for Default Judgment, Petitioner’s counsel states that his client was not inclined to grant Registrant’s "eleventh hour" request for a further extension of time to

¹ A true copy of the relevant portions of the April 26, 2011 email sent by Registrant’s counsel is attached hereto as Exhibit A.

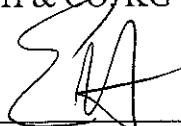
answer because settlement negotiations had not progressed. Petitioner's counsel further states that Registrant "failed to make any settlement offer to Petitioner" after its first request for extension of time to answer was granted on March 28, 2011. Both are false statements. Petitioner's counsel did not send any settlement-related correspondence to Registrant's counsel until April 13, 2011 and Registrant's counsel promptly conveyed the proposal to Registrant. As evidenced by the April 26, 2011 email attached hereto as Exhibit A, Registrant's counsel informed Petitioner's counsel of the current status of settlement negotiations and indicated Registrant was still considering Petitioner's settlement proposal. The April 26, 2011 email was not an "eleventh hour" request; rather, it was a good faith effort to preserve the status quo while the parties continued settlement discussions.

Registrant prays that this Response be made of record.

OTTO GMBH & CO, KG

Dated: May 13, 2011

By: _____



Eric T. Fingerhut
Janet A. Stiven
Shannon M. McKeon
Attorneys for Defendant
Dykema Gossett PLLC
1300 I Street, N.W., Suite 300
Washington, D.C. 20005
Tel: 202.906.8618
Fax: 202.906.8669

CERTIFICATE OF SERVICE

I hereby certify that a copy of Registrant's Response to Petitioner's Motion for Default Judgment was served via first-class mail, postage prepaid, on this 13th day of May, 2011 upon
Petitioner's counsel:

THOMAS T. CHAN
CHAN LAW GROUP LLP
PO BOX 79159
LOS ANGELES, CA 90079-0159
UNITED STATES



Eric T. Fingerhut
Attorney for Registrant

EXHIBIT A

McKeon, Shannon

From: Fingerhut, Eric
Sent: Tuesday, April 26, 2011 9:49 AM
To: 'Thomas T. Chan'
Cc: 'CLG Litigation'; IPMail; McKeon, Shannon
Subject: RE: Our Ref. No.: 0809.431-Cancellation No. 92053630 (U.S. Registration No. 3728502)
(OTTO GROUP)

Importance: High

Tom,

Here is a brief status report on where we stand. I communicated your suggestion regarding settlement framework to my client; however, due to the Easter holidays, Otto GmbH's offices were closed last Friday- Monday and I have not yet received further direction. Otto GmbH is still considering your email and will respond. In the meantime, we would like your client's consent to a further 30 day extension of time to file its answer to the cancellation proceeding. As the deadline to answer is tomorrow (April 27) I apologize for the late request. That said, I also would appreciate your quick reply.

Sincerely,

Eric

Eric T. Fingerhut
Trademark Practice Group Leader
Dykema
1300 I Street, N.W.
Washington, D.C. 20005-3353
202-906-8618 (Tel)
202-415-2535 (Mobile)
202-906-8669 (Fax)
efingerhut@dykema.com
www.dykema.com