

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

Applicant: THORSPRING-ICELAND, INC.

Mark: ICELAND SPRING and Design

Serial No.: 75/704354

Int'l Class No: 032

Filed: MAY 13, 1999

Hon. Commissioner of Patents and Trademarks
Office of the Solicitor
P.O. Box 15667
Arlington, VA 22215

SOLICITOR

DEC 27 2002

U.S. PATENT & TRADEMARK OFFICE

**PETITION TO COMMISSIONER TO ACCEPT
NOTICE OF OPPOSITION and MOTION TO SUSPEND RULES**

Sir:

In an Order dated December 12, 2002, the Trademark Trial and Appeal Board without prior notice or opportunity to be heard vacated its previous Order dated November 15, 2002. It appears that this action followed a discussion by counsel for Applicant with the Board wherein an *ex parte* complaint was raised by Applicant. Such action is unfair and detrimental to the potential opposer.

The Board's Order of November 15th granted an extension of time to potential opposer. The new deadline established in the Order was December 6, 2002. In reliance upon the date set forth in the Board's Order of November 15, potential opposer filed a Notice of Opposition on December 6, 2002.

As it now appears, the Board's Order of November 15 granted an extension of the period to oppose beyond the 120th day from the date of publication. Neither the potential opposer, the Board, nor the Applicant, whose counsel was provided with a courtesy copy of the request for extension and by rule would have received a copy of the Order of November 15, appeared to be aware of this fact. Such an event, however, is not a fatal flaw in the previously granted Order for two specific reasons.

First, §207.03 of the TTAB Manual of Procedure, First Edition, September 1995, provides that a request for an extension of time may seek an extension beyond the 120th day from the date of publication. The Board is vested with discretion to grant such requests. §101.02 of the Manual recognizes the applicability of the Federal Rules of Civil Procedure in inter parties proceedings, of which an opposition proceeding is one. FRCP 6(b) recognize the general discretionary authority of the Court to grant enlargements of time. This general discretionary authority is also vested with the Board. The Board, in its discretion, granted an extension to and including December 6, 2002, in this case. Such action was within the authority of the Board, and should not be summarily vacated at the *ex parte* behest of Applicant.

The second independent reason for vacating the Order of December 12 and reinstating the Order of November 15 is based upon the concepts of fundamental fairness and the existence of extraordinary circumstances. The potential opposer relied on the Board's decision and the new deadline as set forth in its November 15th Order. The Notice of Opposition was filed within the period of extension specifically granted by the Board's November 15th Order.

Further, Applicant was fully aware of the date of December 6 extension date, but chose to remain silent until after the 120 days from publication had run. If the matter would have been timely raised or otherwise brought to the attention of the Board or potential opposer, a deadline in November could have been established and met by the potential opposer. It is fundamentally unfair for Applicant to remain silent only to present the issue in an *ex parte* manner to the Board after the expiration of the 120th day, thereby obtaining a vacation of the previously approved and granted period of extension.

Finally, it appears without question that neither the Board, nor the potential opposer recognized any potential issue relating to the extension deadline of December 6. It is respectfully submitted that the good cause statement set forth in the potential opposer's request for extension resulting in the new deadline of December 6, when read by itself, constitutes extraordinary circumstances. While the Board in the Order of December 12 apparently did not agree with this position, when the facts underlying the application for extension are reviewed in combination with the present facts and the detrimental reliance of the potential opposer upon the new deadline established by the Board in its Order of November 15, it should be without question that such cause for extension to and including December 6 has matured into extraordinary circumstances. As such, the Board in its discretion is and should accept the application for extension of time and reaffirm the previously established deadline of December 6, 2002.

The TTAB Manual of Procedure, First Edition, September 1995, provides in §209.03 a general policy for grant or denial of extensions. Quoting from a portion of the final paragraph of §209.03, the following directive is found:

After 120 days from the date of publication of applicant's mark, the Board, as a general rule, will not grant extensions for more than sixty days at a time for requests made without the consent of the applicant, or more than ninety days at a time for requests made with the consent of the applicant. **Again, however, the general rule will be applied flexibly and reasonably, depending upon the circumstances in a particular case.** (emphasis added)

It is respectfully submitted that the potential opposer should not now be made to suffer by the Board's altered position. On December 16, 2002, potential opposer instituted trademark infringement and unfair competition litigation relating to the mark ICELAND SPRING, said suit filed in the United States District Court for the Southern District of Iowa, and captioned *Swiss Valley Farms, Co., Plaintiff, vs. Iceland Spring, Inc. and Iceland Spring North America, Inc., Defendants*, File No. 3:02-cv-80155. The presumption in the rules that the availability of a cancellation procedure to potential opposer provides an adequate alternative remedy is inapplicable to the instant case. If the application for registration is allowed to move forward and results in registration, Applicant would then be able to argue to the Court that it is entitled to receive the benefit of a presumption of validity of its mark. The availability of a cancellation proceeding is inadequate to overcome this potential prejudice. If the Order establishing the extended deadline to file an opposition is reinstated, and the Notice of Opposition is accepted by the Board, the potential opposer would then intend to file a Request to

Suspend the file. If granted, the relief requested herein would eradicate the unfairness to the potential opposer and would prevent a wasting of the resources of the USPTO that would occur by allowing this application to go to issue.

In the exercise of the spirit and discretion afforded the Board under §209.03 to approach extensions with flexibility and reasonableness, and based upon fundamental fairness to the potential opposer, it is respectfully requested that the Commissioner direct that the Notice of Opposition filed with the Board on December 6 be accepted.

In the alternative to the Petition set forth above, Swiss Valley Farms, Co., pursuant to the provisions of §2.148, hereby requests to Commissioner to suspend or waive the rules relating to the time deadlines for filing a Notice of Opposition. In so doing, Swiss Valley Farms, Co. further requests the Commissioner to overturn the Board's Order of December 6, compelling the Board to accept as timely filed the Notice of Opposition filed herein.

The supporting Affidavit of Robert W. Hoke is attached hereto.

The fee pursuant to Rule 2.6(a)(15) is submitted herewith.

Respectfully submitted,
SWISS VALLEY FARMS, CO.

By Glenn Johnson
Glenn Johnson
Attorney for Opposer

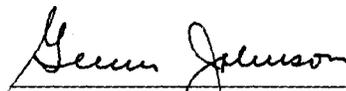
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Reg. No.: 37,362
December 20, 2002

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Box Hon. Commissioner of Patents and Trademarks, Office of Solicitor, P.O. Box 15667, Arlington, VA 22215 on December 20, 2002
Glenn Johnson
Glenn Johnson, Registered Representative

CERTIFICATE OF SERVICE

The undersigned does hereby certify that on December 20, 2002, a true and correct copy of the foregoing Petition to Commissioner to Accept Notice of Opposition and Motion to Suspend Rules was served by First Class Mail on counsel for Applicant at the following address:

Howard G. Slavit, Esq.
Slavit & Gill, P.C.
1025 Thomas Jefferson, St. N.W.
Suite 425 West
Washington, DC 20007-5201



Glenn Johnson

4. I received an Order dated November 15, 2002 from Veronica White, Legal Assistant, TTAB, granting the request to extend time to oppose until December 6, 2002.
5. I communicated the Order of November 15th to Glenn L. Johnson, another attorney at law representing the potential opposer.
6. I provided Mr. Johnson with no other information regarding the extension of time.
7. On December 6, 2002 Mr. Johnson filed the Notice of Opposition with the TTAB by depositing the Notice with the United States Postal Service as First Class Mail. A proper certificate of mailing was included therewith.
8. Without prior warning or notice, I received an Order dated December 12, 2002 entered by Veronica White, vacating the Order of November 15th and denying the previously-granted extension of time.
9. I called Veronica White on December 17, 2002, seeking an explanation for the vacation of the order of November 15. I learned that Ms. White had been in verbal contact with David Starr whom Ms. White identified as an attorney at law for Applicant.
10. Ms. White further indicated that Mr. Starr had checked with other members of his firm and confirmed that no member of his firm had consented to the previously-granted extension of time through December 6, 2002. Ms. White told me that since there was no consent, she could not extend the deadline for filing the opposition to December 6.

11. No where in the application for extension of the deadline that I filed on October 30 does it indicate that the request was in any way predicated upon consent of the applicant. The subject of consent was not a part of my application.
12. An examination of the Order granting an extension of time and specifying the new deadline for purposes of filing an opposition to December 6 is also devoid of any mention of consent. Said Order of extension was not predicated upon the consent of the applicant.
13. As a result of the Order of vacation, the TTAB will now not accept the Notice of Opposition filed on December 6, 2002, unless some relief is granted to the potential opposer.
14. On Monday, December 16, 2002, based upon the facts and circumstances underlying the Notice of Opposition, the potential opposer has filed trademark and unfair competition litigation in the United States District Court for the Southern District of Iowa. The mark at issue is ICELAND SPRING. The litigation is captioned: *Swiss Valley Farms, Co., Plaintiff, vs. Iceland Spring, Inc. and Iceland Spring North America, Inc., Defendants*, File No. 3:02-cv-80155.
15. If the application for registration is allowed to move forward and results in registration, applicant would then be able to argue to the Court that it is entitled to receive the benefit of a presumption of validity of its mark. The availability of a cancellation proceeding is inadequate to overcome this potential of prejudice to the potential opposer.

16. If the Order establishing the extended deadline to file an opposition is reinstated, and the Notice of Opposition is accepted by the TTAB, the potential opposer would then intend to file a Request to Suspend Pending Inter Parties Proceeding, thereby allowing the United States District Court to determine the issues at hand.


Robert W. Hoke

Subscribed and sworn to before me this 19th day of December, 2002.


Notary Public

