IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
THORSPRING-ICELAND, INC.

01-09-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

TRADEMARK: ICELAND SPRING and Design

SERIAL NO.: 75/704354

FILING DATE: May 13, 1999

PUBLICATION DATE: July 9, 2002

OPPOSITION TO PETITION AND REQUEST FOR SUSPENSION FILED BY POTENTIAL OPPOSER SWISS VALLEY FARMS, CO.

To: Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Madam Commissioner:

Applicant hereby responds to the Petition to Commissioner to Accept Notice of Opposition and Motion to Suspend Rules, dated December 20, 2002, and the Request for Suspension of Action, dated December 20, 2002, filed by Swiss Valley Farms, Co. (herein "Petitioner" or "Swiss Valley"). Through these filings, Petitioner seeks to have the Commissioner (1) reverse the Board's Order, dated December 12, 2002, which properly denied Petitioner's Request for Extension of Time to oppose registration of the subject Application for failure to comply with the requirements of 37 C.F.R. §2.102(c); (2) allow its untimely filed Notice of Opposition; and, (3) suspend the subject Application indefinitely. These filings are without merit, and filed for purposes of delaying registration. They should be rejected out-of-hand.

As confirmed below, the Board did not in any respect err or abuse its discretion in denying Petitioner's Request for Extension of Time. In re Application of Software Dev. Sys., Inc., 17

U.S.P.Q.2d 1094 (Comm. 1989)(Commissioner will vacate action of the Trademark Trial and Appeal Board only where Board has committed "clear error" or an "abuse of discretion").

The subject Application was published in the Official Gazette on July 9, 2002. On August 6, 2002, Petitioner filed its first 30-day Request for Extension of Time for the period August 8, 2002 through September 7, 2002. This Request was granted by the Board (Shelley Jamison, Legal Assistant) by Order mailed August 17, 2002. On September 5, 2002, Petitioner filed a further 60-day Request for Extension of Time, for the period September 8, 2002 through November 6, 2002. Petitioner therein alleged that "good cause" existed for this further extension as required under 37 CFR §2.102. By Order mailed October 11, 2002, the Board (Millicent Canady, Legal Assistant) granted this further Request. Accordingly, Petitioner sought and obtained extensions of time aggregating 120 days from the July 9, 2002 date of publication.

On October 30, 2002, however, Petitioner filed yet a further Request for Extension of Time, for the period November 7, 2002 through December 6, 2002. Petitioner failed, however, to fulfill the express requirements of 37 CFR §2.102(c)[1] for the possible granting of this further Request for an extension beyond the 120 day period. Namely, it did not allege that there existed "extraordinary circumstances" or make any kind of showing in this regard. It also did not allege that it had obtained Applicant's consent (as it had not). Instead, it merely claimed that "good cause" existed for a further extension, because counsel had not had sufficient time to meet with Petitioner and needed more time

[1] 37 CFR §2.102(c) provides in relevant part: "extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application *will not be granted* except upon: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request [...], or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation." (emphasis added).

to complete its investigation, and to prepare and file an Opposition.[2] Upon receipt and review of this Request, since it was fatally deficient on its face, counsel for Applicant believed that this filing would be denied by the Board.

Regrettably, by Order mailed November 15, 2002, the Board (Veronica White, Legal Assistant) inadvertently granted Petitioner's October 30 Request. The Order also advised the parties: "[p]lease do not hesitate to contact the Trademark Trial and Appeal Board for any questions relating to this extension." Accordingly, in view of the Board's obvious error, counsel for Applicant called the Board on or about November 19, 2002. Counsel thereby brought to the Board's attention that Petitioner did not in its Request meet the pleading requirements of Rule 2.102 (c). Counsel also confirmed that Applicant did not consent to this filing. The Board acknowledged its error, and responsibly took steps to remedy same. It issued a further Order mailed December 12, 2002 which vacated the November 15 Order, and denied Petitioner's October 30 Request.[3]

Petitioner now requests that the Commissioner vacate the Board's December 12 Order, suspend the Rules, and accept its December 6, 2002 Notice of Opposition, which was filed *150 days after the date of publication*. The thrust of Petitioner's complaint is that it claims to have detrimentally relied upon the now vacated November 15 Order. Petitioner's requests, however, lack any possible merit and must be denied.

Petitioner cannot rely upon the Board's initial mistake in not recognizing that Petitioner's pleading on its face was deficient, or upon the time needed by the Board to prepare and issue its

---

[2] Such "boilerplate" claims including as to the "investigation" were included in all prior Requests.

[3] It is anticipated that, consistent with the December 12 Order, the Board will issue a further Order rejecting Petitioner's Notice of Opposition filed December 6, 2002.

December 12 Order vacating its improvident November 15 Order. In this regard, the Commissioner has dismissed Opposition proceedings where the Board, by mistakenly granting the petitioner's miscalculated requests of extension of time, accepted a Notice of Opposition 121 days after publication. Lotus Dev. Corp. v. Narada Prods., Inc., 23 U.S.P.Q.2d 1310 (Comm'r. 1990)("[T]he Office has no obligation to inform parties of errors in papers to allow for their timely correction or refiling.") The Commissioner thus ruled that the Board has no discretion to accept a Notice of Opposition beyond the 120 day period without the requisite showing under 37 C.F.R. §2.102(c). The same is true here.[4]

Similarly, the Commissioner has affirmed the Board's rejection of a Notice of Opposition where the Board did not timely notify the petitioner that its extension request was only partially granted, and the full requested extension would have required a showing of consent or extraordinary circumstances which the petitioner did not show. In re Trademark Application of Societe Des Produits Nestle S.A., 17 U.S.P.Q. 1093 (Comm'r. 1989). ("Although it is regrettable that petitioner was not timely notified that the requested extension was only partially granted, Rule 2.012 (c) clearly requires consent of applicant or extraordinary circumstances. Omission of such requirements on the part of petitioner, or its attorney, is not considered an extraordinary situation to justify waiver of the rules.") See also In re Trademark Application of Su Wung Chong, 20 U.S.P.Q.2d 1399 (Comm'r. 1989)("Inadvertent omissions [as to a showing of extraordinary circumstances] on the part of attorneys do not constitute extraordinary situations within the purview of these rules".) In sum, Petitioner cannot blame the Board or rely upon the Board's actions for its own failings.

---

[4] Moreover, the Board in all respects acted properly through its corrective actions. In any event, Petitioner also has made no showing of any "detrimental reliance" here. Even if it had, this could not serve as a basis for the kind of relief now being requested.

Petitioner's concurrently filed Request for Suspension of Action is also improper. It is unclear whether this Request is directed to the Examining Attorney (see Request for Suspension at caption), the Board (see Petition at 4-5) or to the Office of the Solicitor (see Request for Suspension at Certificate of Mailing). However, given the current posture of the application, it is possible that it will be construed as a letter of protest. Letters of protest filed more than 30 days after publication are generally denied as untimely, because a letter of protest filed after publication may delay the registration process significantly. Such is the case here. TMEP 1715.03(a).

Accordingly, the Commissioner should deny Swiss Valley's Petition to Commissioner to Accept Notice of Opposition and Motion to Suspend Rules and the Request for Suspension of Action, and should direct this Application to proceed to registration.

Dated: January 7, 2003

Respectfully submitted,

H. David Starr
Howard G. Slavit
SLAVIT & GILL, P.C.
1025 Thomas Jefferson St., N.W.
Suite 425 West
Washington, D.C. 20007
(202) 342-1402

Attorneys for Thorspring-Iceland, Inc.

CERTIFICATE OF MAILING

I hereby certify that this Opposition to Petition and Request for Suspension Filed by Potential Opposer Swiss Valley Farms, Co. concerning Application Serial No. 75/704354 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date shown below.

Dated: January 7, 2003

H. David Starr

CERTIFICATE OF SERVICE

I hereby certify that on this 7th of January, a true and correct copy of the foregoing was served by first class mail on the counsel for Petitioner at the following address:

Glenn Johnson
Shuttleworth & Ingersoll, PLC
5000 Firstar Bank Bldg., P.O. Box 2107
Cedar Rapids, IA 52460

H. David Starr

TTAB

SLAVIT & GILL
A PROFESSIONAL CORPORATION
ATTORNEYS AT LAW
1025 THOMAS JEFFERSON STREET, N.W.
SUITE 425 WEST
WASHINGTON, D.C. 20007

01-09-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

TELEPHONE: (202) 342-1402
FAX: (202) 342-8387
E-MAIL: office@slavitgill.com

MEMBER,
INTERNATIONAL LAW
FIRMS

January 7, 2003

BY FIRST CLASS MAIL

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: U.S. Trademark Application for ICELAND SPRING and Design
Serial No. 75/704,354

Dear Madam Commissioner:

Enclosed please find Applicant's Opposition to Petition and Request for Suspension filed by Potential Opposer Swiss Valley Farms, Co. Please do not hesitate to contact me if you have any questions.

Thank you for your consideration.

Very truly yours,
SLAVIT & GILL, P.C.

By: _____
H. David Starr

Enclosure