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SAYEGH & PHAM, PLC

BY U.S. MAIL
December 8, 2006



UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER OF PATENTS & TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

12-14-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

Re: **PETITION REQUESTING RECONSIDERATION OF DECISION
THAT OPPOSITION WAS UNTIMELY FILED
(re MARK ROCK REVOLUTION, 78/703298)**

Dear Director:

We are in receipt of correspondence dated November 28, 2006 from paralegal specialist Millicent Canady which notified our client, Rock Revolution (App. Ser. No 78/709908) that their opposition to publication of the mark referenced above was untimely filed. We also make note of the fact that Ms. Canady's notice was mailed directly to our client and no such correspondence was sent to this office as attorney of record.

This petition contains legal and factual arguments which dispute Ms. Canady's decision and identification of the facts, and which demonstrates that her application of the rules of procedure was in error. In order to prevent an unjust and improper extinguishment of our client's rights, we submit this petition for reconsideration.

BACKGROUND FACTS.

The details of the situation are as follows: The relevant 30-day opposition period was from the mark's publication date of October 17 to November 16, 2006. During that period we attempted to negotiate with the mark's owner who was aware of our client's prior use of the same mark. On the 29th day of the opposition period, November 15, 2006, we attempted to file the opposition but our attempted e-filing was blocked. It appears that the PTO's option for electronic filing does not honor west coast time zone. While relevant guidelines and details are provided to users of the site, such as a form petition and fee requirements, notice that electronic filings of oppositions must be done according to east coast time is not readily available. Adequate and reasonable notice is essential for proper guidance with filings.

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PETITION REQUESTING RECONSIDERATION OF DECISION THAT
FILING OF OPPOSITION IS UNTIMELY
Mark: Rock Revolution/ Scr. No 78/703298
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As access to ESSTA was blocked, the unexpected circumstances caused us to utilize an alternative method of filing. We immediately placed the opposition papers and fee in the mail to stay timely. Under these conditions, a certificate of mailing was inadvertently left out of the package. However, on the following day, still within the 30-day opposition period, we submitted an email to the USPTO attesting to the mailing by electronic signature and attaching the opposition papers which had been mailed. Our email is in all legal respects equivalent to the requirements of the Certificate of Mailing under 37 C.F.R. §2.197.

After our papers were received at the PTO, our opposition was posted. Subsequently, the filing was adjudged to be untimely. We submit that our filing was in compliance with 37 C.F.R. §§2.101 and 2.197 in all essential and required aspects. Assuming *arguendo* that the filing was untimely, good cause exists for the Commissioner to exercise its discretion and to accept our opposition as timely filed.

DISCRETION IS AVAILABLE TO THE COMMISSIONER TO REVERSE ITS DECISION UNDER 37 C.F.R. §2.146(A)(5) OR §2.148 WHEN 1) AN EXTRAORDINARY SITUATION EXISTS, 2) JUSTICE REQUIRES, AND 3) NO OTHER PARTY IS INJURED (TMEP CHAPTER 1708).

1) The facts demonstrate that an extraordinary situation exists: Our timely submission of the opposition through ESSTA was rejected and the site denied recognition of west coast normal business hours. Opposition guidelines do not provide adequate notice that electronic filings of oppositions must be done according to east coast time. This vital information is not easily accessible, resulting in unreasonable expectations on the part of west coast users of the site. It is foreseeable that attorneys commonly utilize the maximum opposition period, particularly, as in our case, when negotiations are being conducted between the parties.

The blocking of our e-filing was an unforeseeable circumstance which caused unintentional delay, requiring that we speedily prepare the opposition for mailing. The package was postmarked within the opposition period and the certificate of mailing was submitted via email on the 30th day of the opposition period.

The refusal to accept our opposition amounts to an unreasonable and ultimately unjust reading of the rule and contradicts the intent of the TMEP. Proof of the mailing date and a signed attestation by the sender are the critical elements required by 37 C.F.R. §2.197. The omission of the certificate of mailing until the following day could not have been reasonably avoided despite our exercise of reasonable care. Reconsideration has been granted for a belated filing reasoning that a petitioner should not be deprived, on a purely technical ground, of the right to proper consideration. *Com. of Australia v. Radio Corp. of America*, 399 F.2d 807, 810, (C.A.N.Y. 1968), 159 U.S.P.Q. 1.

2) Justice requires recognition of the reality that attorneys in large part submit filings close to the due date as a means of protecting a client's interests. This practice is highly probable and foreseeable, and a reasonable accommodation should be available. In the interests of justice parties on the west coast who file during their business hours should not be unjustly subjected to an unanticipated penalty.

The pertinent details presented above were not included in Ms. Canady's assessment of our situation. One court determined that "evidence produced before the Patent and Trademark Office "should have been considered by the board in the interest of justice ..." and that it was "... necessary to remand the case for consideration of that evidence." *Application of Mead*, 569 F.2d 1128, 1129 (Cust. & Pat.App.,1978).

Justice requires that our client not be deprived of his rights and be forced to relinquish a mark in which he has prior use and substantial goodwill. He has been using the mark continuously for at least a full year prior to the applicant we oppose. In spite of the junior user's knowledge of our client's superior rights, the junior user rushed to register one week prior to our client's application filing.

3) No party will be injured or harmed and no rights will be prejudiced if the refusal of our opposition is reversed. The mark holder may still avail himself of the PTO procedures to dispute our client's registration efforts even while he is fully aware that our client possesses a superior right to use the mark in dispute. Under these circumstances, the mark holder cannot be damaged. *Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 199 F.Supp.124, (D.C.Wis. 1961), 131 U.S.P.Q. 328. Damage resulting from registration of the mark of another must be concerned with an invasion of the petitioning party's right to protection of its good will. *Land O'Lakes* at 127; *Price Vacuum Stores, Inc. v. Admiral Corp.*, 223 F.2d 269, 271 (CCPA 1955); *Robert Hall Clothes, Inc. v. Stern-Slegman-Prins Company*, 285 F.2d 816 (CCPA 1961).

REVERSAL OF THE AGENCY'S ACTION IS WARRANTED IN A CASE SUCH AS THIS WHERE THERE HAS BEEN A CLEAR ERROR OR ABUSE OF DISCRETION.

The paralegal specialist's determination that our certificate of mailing was not sent in compliance with 37 C.F.R. §2.1971 misinterprets the rule. Our submission substantially complied with the rule in all essential respects. For a certificate of mailing, proof of the mailing date and attestation by the sender are the vital elements required to comply with 37 C.F.R. §2.1971. The refusal to accept our opposition is in error as an unreasonably narrow reading of the rule was applied.

The assessment by Ms. Canady contradicts the intent of the TMEP. Reversal of the agency's action is warranted in a case such as this where there has been a clear error or abuse of discretion. *In re Richards-Wilcox Manufacturing Co.*, 181 USPQ 735 (Comm'r Pats. 1974); *Ex parte Peerless Confection Co.*, 142 USPQ 278 (Comm'r Pats. 1964); *Re: Trademark Application of Choay S.A.*, 16 U.S.P.Q.2D (BNA) 1461 (Comm'r Pats. 1990).

REVERSAL OF THE AGENCY'S ACTION IS WARRANTED IN A CASE SUCH AS THIS WHERE THE RULING IS UNREASONABLE AND PLAINLY ERRONEOUS OR INCONSISTENT WITH THE PERTINENT REGULATION.

The decision that our filing was untimely, particularly in not recognizing our timely certificate of mailing, is unreasonable and a construction of the rule that is overly narrow so as to be inaccurate. The Director has discretion to reverse a decision that is "plainly erroneous and inconsistent with the regulation." *Bowles v. Seminole Rock & Sand Co.*, 325 U.S. 410, 414, 65 S.Ct. 1215, 89 L.Ed. 1700 (1945); *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 1336, 67 U.S.P.Q.2d 1638, 1639 (2003)l; *Thomas Jefferson Univ.*, 512 U.S. at 512, 114 S.Ct. 2381.

Certain relevant facts should have been included in Ms. Canady's review in order to produce an accurate decision. As one court states, if "certain evidence produced before the Patent and Trademark Office should have been considered by the board in the interest of justice, it would be necessary to remand the case for consideration of that evidence. We will not attribute to the board a desire to control the final result by an arbitrary election to consider some materials and disregard others." *Application of Mead*, 569 F.2d 1128, 1129, 1130 (Cust. & Pat. App.,1978).

CONCLUSION.

As our statements of the facts and the law reflect, we maintain that our opposition to publication of the mark at issue was timely filed. The PTO website does not provide adequate notice that electronic filings of oppositions must be done according to east coast time and does not take into consideration the reality of the normal practice of filing just before a deadline. Unforeseeable circumstances in being blocked from submitting an e-filing resulted in an unintentional delay in forwarding our certificate of mailing. We submit with this petition that good cause exists for the Commissioner to exercise its discretion and accept our opposition as timely filed.

An affidavit attesting to the validity of the relevant facts relating to this petition and the appropriate fee are included with this petition as required by 37 C.F.R. §2.6 and 37 C.F.R.

§2.146(c). We appreciate the time and attention you will give our petition and look forward to hearing a response to our legal arguments.

Thank you for your courtesies and consideration.

Yours truly,



SAYEGH & PHAM, PLC
Susan Rabin, Esq.
Christopher Q. Pham, Esq

Enclosures.

DECLARATION
(In accordance with 28 U.S.C. 1746)

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

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SUSAN RABIN, Esq.
Attorney of Record for Rock Revolution,
App. Ser. No. 78/709908

Petition dated December 8, 2006

CERTIFICATE OF MAILING 37 C.F.R. §2.197

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

Susan Rabin, Esq.

Susan Rabin, Esq.

December 8, 2006