

TTAB



04-11-2003

U.S. Patent & TMO/c/TM Mail Ropt Dt. #73

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

In the Matter of:	)	
	)	
KULKONI, INC.	)	Opposition No. 121,228
(Texas Corporation)	)	
	)	Application Serial No.:
Opposer,	)	75/670,023
	)	Mark: Miscellaneous Design
v.	)	
	)	Filed: March 29, 1999
USHA MARTIN AMERICAS, INC.	)	Published: August 29, 2000
(Texas Corporation)	)	
	)	
Applicant.	)	

APPLICANT'S RESPONSE TO OPPOSER'S REQUEST TO WITHDRAW OPPOSITION  
WITHOUT PREJUDICE

This memorandum is a response to opposer Kulkoni, Inc.'s ("opposer") letter to the Trademark Trial and Appeal Board ("TTAB") dated April 2, 2003. In its letter, Opposer states that it has decided that further prosecution of the above identified opposition is not sensible. Applicant USHA Martin Americas, Inc. ("USHA Martin") construes opposer's letter to be a motion to withdraw the opposition without prejudice. USHA Martin prays for the following relief:

1. Dismiss the instant opposition with prejudice.

2. Suspend the proceedings pending disposition of opposer's request.

MEMORANDUM OF LAW

I. ARGUMENT

A. The Opposition Must Be Withdrawn With Prejudice.

Pursuant to the provisions of 37 C.F.R. § 2.106(c), an opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative once an answer has been filed. USHA Martin filed an answer on January 12, 2001. Opposer did not request nor obtain USHA Martin's consent to withdraw the opposition without prejudice. Accordingly, the instant opposition must be withdrawn with prejudice.

B. Opposer's Cited Reasons for Withdrawal Must Be Addressed.

USHA Martin will consent only to a withdrawal of the opposition with prejudice, precluding opposer from filing another opposition against the present application. Opposer's stated reasons for seeking a withdrawal without prejudice include several erroneous assertions. This memorandum addresses opposer's most substantial errors. Accordingly, USHA Martin's response should not be construed as a waiver with respect to any of opposer's remaining assertions.

First, the issue of acquired distinctiveness is moot. The issue of acquired distinctiveness has already been decided by

the TTAB. In an order dated July 26, 2001, the Board denied opposer's motion for summary judgment on the ground that the involved mark had not acquired distinctiveness. TTAB Order dated April 19, 2002, p.3 n. 4.

Second, neither the TTAB nor applicant is bound by opposer's unsupported assertion of assurances from the Office of the Assistant Commissioner. Opposer did not attach a record or summary of those assurances to its letter. Opposer did not produce a written record of those assurances in discovery. In fact, opposer does not even cite the specific time, place, or manner of the purported assurances in its April 2 letter. Accordingly, *assuming arguendo* that opposer received those assurances, opposer did not give notice thereof to USHA Martin, as required under 37 C.F.R. § 10.93(b)(1)-(4).

Opposer's erroneous assertions are not ripe. They are not related to the underlying issue of dismissal. These errors can be addressed during the subsequent prosecution of the instant application. Accordingly, opposer's erroneous assertions should be ignored, and the opposition should be dismissed with prejudice.

C. The Instant Opposition Should Be Suspended.

Finally, since Opposer's Request to Withdraw is potentially dispositive of the instant opposition, USHA Martin submits that proceedings should be suspended pursuant to 37 C.F.R. 2.127(d)

pending disposition of Opposer's request. Accordingly, applicant requests suspension of the present proceedings.

## II. CONCLUSION

For the reasons set forth above, opposer's request for dismissal of the present opposition without prejudice should be denied and the opposition should be dismissed with prejudice.

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, 2900 Crystal Drive, Arlington, VA 22202-3513 on April 8, 2003

PRICE & ADAMS  
John M. Adams

April 8, 2003

Respectfully submitted,

USHA MARTIN AMERICAS, INC.

By:

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John M. Adams  
Attorney for Applicant

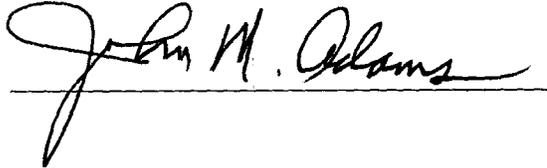
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CERTIFICATE OF SERVICE

I hereby certify that on April 8, 2003, a true and correct copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S REQUEST TO WITHDRAW OPPOSITION WITHOUT PREJUDICE was deposited in the U.S. Mail, first class postage prepaid, addressed to:

Judith Sapp, Esquire  
Pierce Atwood  
One Monument Square  
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