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

Proceeding	91123805
Party	Plaintiff RKO PICTURES, INC. ,
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Submission	Opposition/Response to Motion
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Date	08/25/2005
Attachments	Opp to Motion re Concurrent Use - 91123805.pdf (3 pages)

OPPOSITION TO MOTION TO INSTITUTE

CONCURRENT USE PROCEEDING

I. Introduction.

RKO Century Warner Theaters, Inc.'s ("Defendant") has thrice attempted (under motions disguised by other names) by to convert this opposition proceeding into a concurrent use proceeding. First, in Defendant's Motion to Strike filed August 31, 2001, again in its "communication" of February 17, 2004, then again in its Request for Clarification of March 2, 2004, Response for Trademark Trial and Appeal Board filed March 10, 2004. Because Defendant's Motion to Institute Concurrent Use Proceeding is untimely and without merit, it should be DENIED (again).

II. Relevant Factual History.

On August 31, 2001, Defendant filed its Motion to Strike the instant proceedings.

On January 23, 2003, the Board acted on Defendant's Motion to Strike by suspending action on the motion pending the disposition of Opposition Nos. 91120565 and 91125220.

On February 17, 2004, Defendant filed its "communication" with the Board requesting that it decide the Motion to Strike.

On March 2, 2004, the Board affirmed its Order of January 23, 2003, stating "that the proceedings herein would remain suspended pending the disposition of Opposition Nos. 91120565 and 91125220."

On March 10, 2004, Defendant filed its Request for Clarification of March 2, 2004, Response for Trademark Trial and Appeal Board filed March 10, 2004. This "request", actually

a motion to institute concurrent use proceedings in disguise, once again invited the Board to dismiss the instant proceedings in favor of a concurrent use proceeding.

On June 8, 2004, the Board mailed its Order Denying Applicant's Motion for Reconsideration ("Order"), stating, in pertinent part:

...the Board has the discretion to terminate an opposition in favor of a concurrent use proceeding. The action is permissive, not mandatory. We see no error in the Board's decision to suspend proceeding herein pending resolution two relevant opposition proceedings....

III. Argument.

The two relevant opposition proceedings referred to the Board's Order are Opposition Nos. 91120565 and 91125220. The first (Opp. No. 91120565) was dismissed with prejudice on September 24, 2004. The second (Opp. No. 91125220) is pending before the Board.

With respect to Opp. No. 91125220, Loews Cineplex Entertainment Corp. ("Loews")¹ filed a Motion to Suspend for Settlement Discussions ("Motion to Suspend") based on a key misrepresentation of fact, specifically, Loews alleged that "...the parties believe that they can ultimately obtain a settlement of the dispute and are actively engaged in settlement negotiations for this purpose."²

Because that statement is false,³ and Loews had failed to engage in any settlement discussions with Defendant that would provide cause for the requested suspension, Plaintiff filed its Motion to Reopen Discovery on August 16, 2005. Plaintiff is currently awaiting the disposition of that motion.

¹ Defendant, RKO Century Warner Theaters, Inc. is the wholly owned subsidiary of Loews. See Defendant's Response to Board's Order filed January 27, 2003 (Dkt. No. 10).

² See Motion to Suspend (Dkt. No. 17 in Opp. No. 91125220).

³ Loews had failed to discuss, or even to contact, Defendant since March 2005.

As stated in the Board's Order denying Defendant's motion to convert the instant proceeding into a concurrent use proceeding, the Board appropriately denied Defendant's motion as untimely because of the relevant opposition proceeding (Opp. No. 91125220), which is still pending before the Board. Therefore, Defendant's request is still untimely and should be DENIED for the reasons previously asserted in the Board's Order.

IV. Conclusion.

Defendant's request has been denied three times by the Board. First in its Order of January 23, 2003, again in its order of March 2, 2004, then again in its Order of June 8, 2004. The reason for the Board's denial has not changed. Accordingly, Plaintiff respectfully requests that Defendant's motion be DENIED (again).