

**Exhibits**

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

In the Matter of Trademark Application Serial No. 75/863,261

Filed: December 3, 1999

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AVX Corporation

Opposer,

v.

SIEMENS AKTIENGESELLSCHAFT,

Applicant.

Opposition No: 91/150,971

**OPPOSER'S OPPOSITION TO THE MOTION OF EPCOS AG  
TO SUSPEND THE OPPOSITION**

EPCOS AG, claiming to be the owner of the subject application, has filed a Motion to suspend the opposition. As explained more fully below, because neither the movant nor the Applicant of record has shown good cause under Rule 117, the Motion should be denied.

**BACKGROUND**

The present Motion for suspension of the proceedings has been filed on behalf of EPCOS AG, the alleged current owner of the mark for which registration is sought in the subject application.

Prior to January 22, 2002, the Opposer's attorneys made several telephone calls to the attorney of record for the subject application in an attempt to negotiate an agreement that might avoid the need for the subject opposition. On January 22, 2002, Opposer's attorneys sent via facsimile to the attorney of record for the subject application, a letter that enclosed a draft Notice of Opposition. This letter and its enclosed draft Notice of Opposition are attached hereto as Exhibit A. The draft Notice of Opposition listed Siemens Aktiengesellschaft Corporation as the Applicant for the subject application. Applicant's attorneys therefore had a copy of a draft of the Notice of Opposition as early as January 22, 2002, yet never objected that the Applicant was misidentified in the draft Notice of Opposition.

The Opposition (No. 91/150,971) for the subject application was declared on March 5, 2002. The due date for service of Applicant's Answer was April 14, 2002, which is a Sunday.

Applicant's attorney contacted Opposer's attorney by telephone and requested a copy of page 3 from the Notice of Opposition. Applicant's attorney did not assert that the Applicant was misidentified in the Notice of Opposition. Moreover, Applicant's attorney did not mention that EPCOS AG allegedly acquired the mark for which registration was sought in the subject application. Opposer's attorney provided the requested page 3. Applicant's attorney did not request page 5 of the Opposition. Had Applicant's attorney requested a complete copy of the Notice of Opposition at that time, the remaining pages would have been provided, just as page 3 was provided.

On Friday, April 12, 2002, Applicant's attorneys contacted Opposer's attorneys to request consent for a two week extension of time to answer the Notice of Opposition. Opposer's attorneys consented to the extension. On Monday, April 15, 2002,

Applicant's attorneys filed the consented Motion for the extension of time, until April 28, 2002, which was a Sunday. In the caption on page 1 of the consented Motion, "Siemens Aktiengesellschaft" is listed as the Applicant. Applicant's attorneys never raised any issue of misidentification of the Applicant at this time or at any other time prior to the filing of the present Motion for suspension. Nor did Applicant's attorneys mention that EPCOS AG allegedly acquired the mark for which registration was sought in the subject application.

On April 3, 2002, Opposer served interrogatories and document requests on Applicant's attorneys. Applicant's service of its response to this discovery was due on May 8, 2002. But on Friday, April 26, 2002, Applicant's attorneys contacted Opposer's attorneys by telephone and requested thirty (30) additional days to respond to the pending discovery. Opposer's attorneys consented to the time extension. Again, Applicant's attorneys did not mention that the Applicant was misidentified in the Notice of Opposition. Moreover, Applicant's attorneys did not mention that EPCOS AG allegedly acquired the mark for which registration was sought in the subject application.

On Monday, April 29, 2002, the day when Applicant's answer was due, Applicant's attorneys filed the present Motion requesting a suspension of the proceedings. In section A on page 2 of the present Motion, it is stated that Siemens Aktiengesellschaft is "[t]he current record owner of the mark", and that the mark "has been acquired by EPCOS AG, \* \* \*." The motion fails to give the date of the alleged acquisition. Nor does the motion attach any documentary evidence that would in any way substantiate the alleged acquisition. The Motion does not allege that the Board failed to supply page 5 of the Notice of Opposition when the Board served the Notice. Nor does the Motion enclose any evidence that would support such an allegation.

Curiously, the caption in the present Motion for suspension lists the Applicant as "Siemens Aktiengesellschaft Corporation."

By facsimile letter dated May 13, 2002, (copy attached as Exhibit B), Opposer has provided a copy of page 5 of the Opposition and offered to provide any other pages that Applicant's attorneys desired. This same letter also requests Applicant's attorneys to provide a copy of the recordation of assignment documentation. Applicant's attorneys have not responded to this letter.

The attorneys that filed the consented Motion for Extension of Time to answer are the same attorneys that filed the present Motion for suspension of the proceedings. Accordingly, the same attorneys that represented the original Applicant, are also representing EPCOS AG, the alleged assignee of the original Applicant.

#### ARGUMENT

The burden is on the Applicant to present facts that establish the "good cause" that is required by Rule 117(c) for the Board to grant a request to suspend the proceedings. The types of circumstances that constitute "good cause" under Rule 117(c) include: (1) when both parties stipulate to suspension for purposes of entering settlement negotiations; (2) when an attorney is withdrawing from the case; or (3) when the defendant files for bankruptcy. TBMP § 510.03(a). The present motion fails to present any fact or case law that supports the contention that the alleged misidentification constitutes the "good cause" required by Rule 117 for justifying the granting of a suspension of the proceedings. There is no allegation or evidence that the Board failed to serve the Applicant's attorney with page 5 of the Notice of Opposition.

Nor is there any authority that such an omission would constitute “good cause” for granting a suspension under Rule 117(c).

A. Over-identification of the Applicant Is Not Good Cause for Suspension under Rule 117(c)

In the Notice of Opposition, the Applicant’s name is completely stated, with the addition of the word “corporation,” which is the type of business entity that describes the Applicant. Thus, the Applicant is described in even more detail than is required. Instead of being misidentified as alleged in the present motion, the Applicant is actually over-identified. Over-identification of the Applicant does not render a pleading in need of correction. This is especially true where, as here, there has been no prejudice to the Applicant by virtue of the over-identification.

The silence of Applicant’s attorney concerning the Applicant’s identity emphasizes the lack of prejudice caused by any alleged inaccuracy. There is no denying that the Applicant’s attorney received the Notice of Opposition, notwithstanding that the identification of the Application provided more information than was necessary. Elimination of the word “corporation” would in no way substantively change the grounds for the opposition or the answer of the Applicant. The over-identification did not in any way prevent the Board from identifying the proper address of the attorneys representing Applicant. Nor did the over-identification in any way prevent the Applicant’s attorney from contacting the Applicant. This is clear from the Applicant’s consented motion to extend the time for answering. On page 2 of this consented motion, the Applicant’s attorneys stated: “The extension is necessary to allow Applicant’s counsel to confer with the Applicant to obtain all information necessary to file a complete and accurate answer to the Notice of Opposition.”

Moreover, since the Motion itself alleges that the prior Applicant is no longer the owner of the mark, the substitution of the new owner renders futile any possible correction of the original pleadings. Thus, the request for suspending the opposition until a corrected pleading is filed is tantamount to a request for the Board to order the Opposer to perform a futile act. The Board should not require performance of a futile act.

Upon reissue of the original pleadings with the word "Corporation" deleted from the Applicant's identifier, is the Applicant then going to claim that the new owner should be named as the Applicant? This is an especially relevant question and concern in view of the fact that the Motion fails to enclose a copy of the Assignment document. Accordingly, the Motion to Suspend should be denied for this additional reason.

The caption in the Applicant's April 15 consented Motion listed the applicant as just "Siemens Aktiengesellschaft." In the Applicant's April 29 Motion, the caption listed the Applicant as "Siemens Aktiengesellschaft Corporation." If the presence or absence of the word "Corporation" is critical, then either the consented motion for time extension to answer was improper (and Applicant is in default) or the motion for suspension is improper (and can be ignored as void ab initio).

In the caption of the consented motion for extension of time to answer, is the Board to consider that "SIEMENS AKTIENGESELLSCHAFT Applicant," which is the party listed in the position of the defendant, a misidentification as well? For there is no comma after AKTIENGESELLSCHAFT. This would be no less absurd a position than the Applicant's present contention that the over-identification of the Applicant requires filing a corrected pleading.

Moreover, if Applicant deemed the over-identification to be significant, it was incumbent upon Applicant's attorneys to bring the over-identification to the attention of Opposer's attorney when the draft Notice of Opposition was provided to Applicant's attorney in January of 2002 or in any of the subsequent dealings between the attorneys for the parties. In the meantime, Applicant's attorneys obtained consents from Opposer on at least two different occasions in the name of the Applicant. The obtaining of these consents, the inconsistent usage of "Corporation" in the Applicant's own motions, and the failure of Applicant's attorneys to bring the alleged misidentification to the attention of Opposer's attorneys, all combine to estop the Applicant (and/or its successors-in-interest) from the present complaint.

The facts set forth above demonstrate that the over-identification of the Applicant in the Notice of Opposition does not constitute good cause for granting a suspension under Rule 117(c).

**B. There Is No Evidence to Support the Alleged Failure of the Board to Serve Page 5 of the Notice of Opposition on Applicant's Attorneys**

The sequence of events noted above in the Background calls into question whether the Board failed to provide page 5 of the Notice in the service copy sent to Applicant's attorneys. The consented Motion claimed that more time was needed to confer with the Applicant to obtain all information necessary to file a complete and accurate answer to the Notice of Opposition. Since the Notice of Opposition is 6 pages long with the signature on page 6, one can only question how the absence of page 5 was only discovered after April 12 when Applicant's attorneys requested an extra two weeks to respond to the Notice of Opposition. Had Applicant's attorneys failed to read

the Notice of Opposition completely through to the signature on page 6 prior to making the request for the time extension on April 12? If so, then how could the Applicant's attorneys have known that more time was needed to confer with the Applicant to obtain all information necessary to file a complete and accurate answer to the Notice of Opposition? In order to file a complete answer, Opposer's attorneys would need to have been familiar with what was written on pages 5 and 6 of the Notice of Opposition. Thus, it appears that at least prior to April 12, Applicant's attorneys had a copy of page 5 that thereafter allegedly was lost.

Curiously, there is no affidavit stating that the Notice of Opposition was served by the Board without page 5. The facts strongly suggest that the absence of page 5 of the Notice of Opposition likely occurred when someone in the office of Applicant's attorneys lost it. Else, it would have been discovered long prior to the present Motion, presuming that Applicant's attorneys read through the Notice of Opposition around the time of April 12, 2002, when Applicant's attorneys made the consented motion for extension of time to answer or when Applicant's attorneys requested page 3 of the Notice from Opposer's attorneys. Thus, the present Motion fails to establish any fault of the Office in supplying page 5 of the Notice.

The present Motion is little more than a stalling tactic. Applicant could have obtained any missing pages by just asking for them a long time ago. The true motivation behind the present Motion is not the avoidance of prejudice to the Applicant, but rather the desire of Applicant to avoid responding on the merits to the Opposition and to the pending discovery. This Motion is interposed purely for purposes of delay and accordingly should be denied as improper.

## CONCLUSION

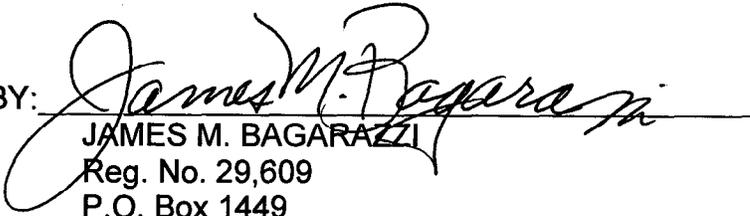
The present Motion should be denied. There is no need for a corrected pleading. Applicant suffers no prejudice from the over-identification of Applicant in the Notice. Moreover, the over-identification of the Applicant is rendered moot by the alleged transfer of ownership of the application to EPCOS AG. A corrected pleading would be an exercise in futility. Additionally, Applicant is estopped to complain of the over-identification, since Applicant's attorneys have had a copy of the draft of the Notice of Opposition containing the over-identification since at least January of 2002, and never raised it while obtaining consents from Opposer on at least two different occasions in the name of the Applicant. Accordingly, there is no justification for requiring a corrected pleading and thus no basis for suspension on that account.

Finally, the facts strongly suggest that the absence of page 5 of the Notice of Opposition likely occurred when someone in the office of Applicant's attorney misplaced it. Else, the absence of this page 5 would have been discovered long before the present Motion, presuming that Applicant's attorneys read through the Notice of Opposition around the time of April 12, 2002, when Applicant's attorneys made the consented motion for time extension to answer or earlier when Applicant's attorneys requested page 3 of the Notice from Opposer's attorneys. Thus, the Motion fails to establish any fault of the Office in supplying page 5 of the Notice. Moreover, there is no need to grant additional time to answer the Notice of Opposition unless the Board finds that the Board's copy of the Notice is missing page 5 for example. Failing such finding, the Board should deny the Motion and require Applicant Siemens Aktiengesellschaft to answer.

Respectfully submitted,

DORITY & MANNING, P.A.

DATED: 5-17-02

BY: 

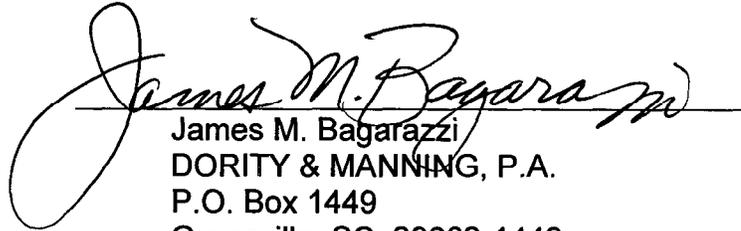
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing OPPOSER'S OPPOSITION TO THE MOTION OF EPCOS AG TO SUSPEND THE OPPOSITION was deposited in U.S. First-Class Mail, postage prepaid, Certified Mail/Return Receipt No. 7001 0360 0001 6730 5748, on the date written below and addressed to counsel of record as follows:

Marie Ann Mastrovito, Esquire  
Abelman, Frayne & Schwab  
150 East 42nd Street  
New York, NY 10017

Date: May 17, 2002

A handwritten signature in black ink, reading "James M. Bagarazzi", written over a horizontal line.

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TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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EXPRESS MAIL CERTIFICATE

"Express Mail" Mailing Label Number: EV 110 346 018 US

Date of Deposit: May 17, 2002

I hereby certify that the attached paper and/or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Box TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Denise R. Ginn

(Typed or printed name of person mailing paper or fee)

Denise R. Ginn

(Signature of person mailing paper or fee)

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