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

Proceeding	91152940
Party	Plaintiff SINCLAIR OIL CORPORATION SINCLAIR OIL CORPORATION ,
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Date	10/24/2006
Attachments	023 Opp motion to amend itu.pdf (5 pages)(207441 bytes)

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

In the matter of Trademark Application Serial No. 76/212,011
Published in the Official Gazette of May 28, 2002, on page TM 497, Int'l Class 35
Filed: February 20, 2001
Mark: STAACHI'S CO. 1996 & DESIGN

SINCLAIR OIL CORPORATION	}	Opposition No. 91152940
Opposer,		
v.		OPPOSITION TO APPLICANT'S
SUMATRA KENDRICK		"MOTION TO AMEND"
Applicant.		

In an Order mailed August 28, 2006, the Board granted Applicant's "Motion to Extend" and allowed Applicant an additional thirty (30) days from the date of the Order to file an Answer to the Amended Notice of Opposition and an Opposition to the Motion for Summary Judgment filed by Opposer Sinclair Oil Corporation ("Sinclair"). [See Paper No. 38.] In response to the Order, on September 27, 2006, Applicant filed a document entitled "Amendment to Notice of Opposition." It is unclear exactly what this document is and to which motion or document Applicant's "Amendment to Notice of Opposition" is responsive.

Accordingly, Sinclair, erring on the side of caution, hereby submits this Opposition to Applicant's possible attempt to amend its application from a use application filed under Section 1(a) to an intent-to-use application under Section 1(b).¹ Because Applicant's "motion" is

¹ Sinclair notes that in Applicant's "Amendment to Notice of Opposition" Applicant states "I am amending my answer to Trademark Act Section 1 (b), 15 U.S.C. Section 1051 as its filing basis and maintain its original filing date. And rules 2.34." [See Paper No. 39, at 2 (emphasis added).]

untimely, unsupported, and made in bad faith only to overcome Sinclair's Motion for Summary Judgment, Applicant's motion should be denied.

I. APPLICANT'S "MOTION" TO AMEND SHOULD BE DENIED.

A. Applicant's Motion to Extend is Untimely.

In an Order mailed January 31, 2006, the Board informed Applicant that she could amend her Application to substitute a Section 1(b) basis for the current use basis (Section 1(a)). [Paper No. 30, Order mailed January 31, 2006, at 1 n.1.] The Order expressly stated "[i]f applicant wishes to file a motion to amend its application to substitute Section 1(b) as its filing basis, **it should do so promptly.**" [Id.] Applicant did nothing. Instead, when Applicant finally responded she filed a document that the Board construed to be a Request for Extension of Time to Answer the Amended Notice of Opposition and the Motion for Summary Judgment filed by Sinclair Oil. [See Paper Nos. 35 and 36.] After Applicant's "Motion for an Extension" was briefed, the Board granted Applicants' motion and allowed her thirty (30) days from the mailing date of the August 28, 2006 Order to file an Answer to the Amended Notice of Opposition and an Opposition to the Motion for Summary Judgment. [See Paper No. 38, Order mailed August 28, 2006.] Again, Applicant has not done what was ordered.

This time rather than follow the Order, on September 27, 2006, Applicant filed a document entitled "Amendment to Notice of Opposition."² [See Paper No. 39, Applicant's Amendment to Notice of Opposition.] In this document, Applicant is apparently attempting to change her answers to certain interrogatories as well as attempting to "amend [her] **answer** to Trademark Act Section 1(b), 15 U.S.C. Section 1051(b) as its filing

² Applicant's Amendment does not comply with the requirement of TMEP § 514.01. Further, Applicant ignored the Order issued by this Board dated August 28, 2006. While Applicant is *pro se* and some instances of compliance can be overlooked Opposer respectfully submits that at some point, Applicant should have to follow the rules and the Orders of this Board. See, e.g., *Briones v. Riviera Hotel & Casino*, 116 F.3d 379, 382 (9th Cir. 1997) (acknowledging the rule that "pro se litigants are not excused from following court rules"). Sinclair Oil is being prejudiced by allowing Applicant to pick and choose which rules she will follow or even not requiring that the rules be followed while Sinclair follows the rules and Orders of the Board.

basis and maintain its original filing date.” [*Id.* (emphasis added).] It is not clear that Applicant is attempting to amend her trademark application or that she is making a motion to do so.

Even assuming that Applicant is making such a motion, to which Sinclair objects and opposes, Applicant should have filed the present Amendment when suggested to do so by the Board nine (9) months earlier. [*See* Paper No. 30, Order mailed January 31, 2006.] Instead, Applicant did nothing. Even when Applicant moved for an extension of time because she allegedly did not get the January 31, 2006, Order from the Board, she still did not file the suggested amendment. Instead, as a result of Applicant’s failure to comply with the Orders of this Board, Sinclair has been forced to continue with this proceeding and incurred the expense relating to serving additional discovery which has not been responded to and filing a Motion for Summary Judgment which Applicant is now attempting to avoid.

In the present situation, Applicant filed this vague document and has not filed a motion to amend application and or even attempted to identify the basis for the amendment. Even if the document filed by Applicant is considered to be a motion to amend application, Applicant has not shown good cause or that Opposer will not be prejudiced. Applicant chose to ignore the Board when it made its suggestion for her to amend the application. As a result, Applicant’s ‘motion’ is, at a minimum, untimely. While this Board has the discretion to grant Applicant’s motion which is contested, (*see* 37 C.F.R. § 2.133(a), TBMP § 514.03), Applicant’s conduct should not be rewarded. Rather than reward this type of game playing, judgment should be entered against Applicant for failure to comply with the suggestion of the Board. *See* 37 C.F.R. § 2.133(b).

B. Even if Applicant is Allowed to Amend its Application, Applicant Still Committed Fraud on the PTO.

Even assuming that Applicant’s is making a motion to amend her application, Applicant has still committed fraud on the United States Patent and Trademark Office (“PTO”). Only now, when faced with a Summary Judgment motion, does Applicant arguably seek to amend her Application into and intent-to-use application. This effort is nothing more than a thinly veiled

effort to undo the fraud she attempted to commit on the PTO. [See Sinclair's Motion for Summary Judgment.]³ Applicant should not be allowed to manipulate these proceedings in an effort to hide her inequitable conduct. Further, even if the Board allows Applicant to change the Application to an intent-to-use application, such an amendment does not remedy the underlying fraud on the PTO. See *Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205, 1208 (TTAB 2003) (holding deleting the goods upon which the mark had not yet been used does not remedy the fraud on the USPTO due to the filing of a false statement of use.) As a result, Applicant's application is *void ab initio* and the Opposition should be affirmed.

II. CONCLUSION.

For the reasons stated above, Sinclair Oil submits that Applicant's attempt to amend its application from a use application filed under Section 1(a) to an intent-to-use application under Section 1(b) should be denied.

DATED this 24th day of October, 2006.

By: 

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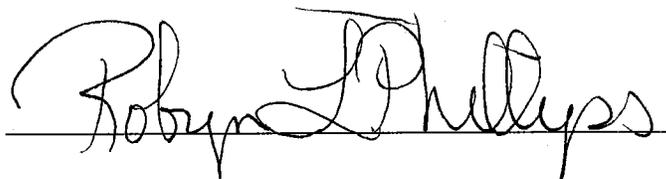
Attorneys for Opposer
SINCLAIR OIL CORPORATION

³ It is not clear if Applicant's "Motion to Amend" was also intended as an Opposition to Sinclair's Motion for Summary Judgment. Even assuming it was, which Sinclair believes it was not, Applicant has failed to raise a genuine question of material fact. See Sinclair's Reply, filed concurrently herewith.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **OPPOSITION TO APPLICANT'S "MOTION TO AMEND"** was served on Applicant by mailing a true copy thereof to its attorney of record, by First Class Mail, postage prepaid, this 24th day of October, 2006, in an envelope addressed as follows:

Sumatra Kendrick
P.O. Box 21055
El Sobrante, California 94820

A handwritten signature in cursive script that reads "Robyn Phillips". The signature is written in black ink and is positioned above a horizontal line.

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