





Intellectual Property Law

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April 26, 2005

**BOX TTAB – NO FEE**  
Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451

*Anne Grosheitsch* *April 26, 2005*  
Anne Grosheitsch Date

Re: RESPONSE TO ORDER TO SHOW CAUSE,  
CONSENTED MOTION TO SUSPEND PROCEEDINGS, AND  
MOTION TO RESET TRIAL DATES

Opposer : THE CHAMBER OF COMMERCE OF THE  
UNITED STATES OF AMERICA

Applicant : UNITED STATES HISPANIC CHAMBER OF  
COMMERCE FOUNDATION

Opposition No. : 91/156,321

Our File No. : 11904-8

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Dear Madam:

Enclosed herewith, in triplicate, is Opposer's Response to Order to Show Cause; Related Motion on Consent to Suspend Proceedings; and Related Motion to Reset Trial Dates, for the above-referenced matter. Should any fees be required, please charge them to Deposit Account No. 11-0600 (Ref: 11904-8). A duplicate copy of this letter is enclosed for that purpose.

Respectfully submitted,

KENYON & KENYON

By: Anne Grosheitsch  
Trademark Legal Assistant

cc: Jill Pietrini  
MANATT, PHELPS & PHILLIPS L.P.

Edward Colbert  
William Merone  
KENYON & KENYON

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

THE CHAMBER OF COMMERCE OF  
THE UNITED STATES OF AMERICA

*Opposer,*

v.

UNITED STATES HISPANIC CHAMBER  
OF COMMERCE FOUNDATION,

*Applicant.*

Opposition No.: 91/156,321

Serial No.: 78/081,731

**OPPOSER'S RESPONSE TO ORDER TO SHOW CAUSE;  
RELATED MOTION ON CONSENT TO SUSPEND PROCEEDINGS;  
AND RELATED MOTION TO RESET TRIAL DATES**

Opposer, The Chamber of Commerce of the United States of America, hereby responds to the *Order to Show Cause* issued by the Board on March 28, 2005. In the March 28<sup>th</sup> Order, the Board noted that the trial dates for this proceeding had not been reset following the resumption of the proceedings, and that, as a consequence, Opposer's deadline for filing its answer to the counterclaim had passed without any action. Further, it is noted that during the period immediately following the expiration of the suspension period, other trial dates (such as the close of discovery) also passed without any action by either Opposer or Applicant (United States Hispanic Chamber of Commerce Foundation).

Opposer submits that its failure to file an answer to the counterclaim was due to a misunderstanding as to the appropriate trial dates following the automatic resumption of the proceedings and was not the result of willful conduct or gross neglect on the part of

Opposer, nor does it represent any lost of interest in the present case. Further, Opposer maintains that Applicant will not be prejudiced by any delay that may result, and that Opposer has appropriate and meritorious defenses to Applicant's counterclaim to cancel Opposer's registered marks. As such, Opposer requests that the notice of default be set aside on the basis of Opposer's showing of good cause. *See TBMP*, §312.02.

Pursuant to TBMP Section 510 and Trademark Rule 2.117, Opposer also respectfully requests that the above-referenced opposition proceeding be suspended for a further three months, subject again to the right of either party to request resumption at any time. The parties continue to engage in potential settlement negotiations that, if successful, would obviate the need for a formal proceeding at the Trademark Trial and Appeal Board. Counsel for Applicant, the United States Hispanic Chamber of Commerce Foundation, has consented to the requested suspension. Further, Opposer submits that it has shown good cause for why the consolidated proceeding should be suspended. *Accord MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).<sup>1</sup>

Finally, pursuant to TBMP Section 509 and Trademark Rules 2.120 and 2.121, Opposer also requests that the discovery and trial dates for the pending proceeding be reset (and that any dates that have closed, such as for the taking of discovery, be reopened) such that the discovery period closes no less than ninety (90) days following the expiration of the suspension period. Opposer submits that reopening the closed

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<sup>1</sup> Should the Board disagree, or should the pending *Motion on Consent to Suspend* be otherwise denied, Opposer requests in the alternative that the discovery and trial dates for the pending proceeding be reset such that the discovery period closes no less than sixty (60) days following the Board's decision on the instant motion, and that the deadline for Opposer to file its reply to Applicant's counterclaims be reset to a date that is no less than thirty (30) days following any such decision. Opposer believes that in the event the present *Motion* is denied, the additional time requested would be needed to facilitate the orderly presentation of the evidence in this case and submits that this alternative request is not being made for the purposes of mere delay but, rather, for the good cause stated above.

periods will not cause prejudice to Applicant, nor will it have any adverse impact on the current proceedings. See *Pioneer Investment Services Co. v. Brunswick Assoc. Ltd. Part.*, 507 U.S. 380 (1993); *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997); *TMBP*, §509.01(b)(1). Opposer further submits that the reasons for any delay and Opposer's good faith relating thereto (both of which are set forth above in discussions concerning Opposer's misunderstanding as to the appropriate trial dates following the automatic resumption of the proceedings) are sufficient to support the relief requested.

Respectfully submitted,

Date: April 26, 2005



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*Counsel for Opposer, The Chamber of  
Commerce of the United States of America*

**(PROPOSED) TRIAL SCHEDULE**

The period of suspension to expire:	7/28/05
Defendant in the counterclaim to file an answer:	9/1/05
The period for discovery to close:	11/1/05
30-day testimony period for plaintiff in the opposition to close:	2/1/06
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	3/31/06
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	5/30/06
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	7/13/06
Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	1/12/07
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	2/12/07
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	3/11/07
Reply brief (if any) for plaintiff in the counterclaim shall be due:	3/26/07

**CERTIFICATE OF SERVICE**

I hereby certify that the required number of copies of the foregoing *Opposer's Response To Order To Show Cause; Related Motion on Consent to Suspend Proceedings; and Related Motion to Reset Trial Dates* was served on the parties or counsel on the date and as indicated below:

***By First Class Mail (Postage Prepaid)***

Jill M. Pietrini  
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11355 West Olympic Blvd.  
Los Angeles, California 90064-1614

Date: April 26, 2005



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