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

Proceeding	91156321
Party	Defendant United States Hispanic Chamber of Commerce Foundation United States Hispanic Chamber of Commer ce Foundation 2175 K. Street, N.W., Suite 100 Washington, DC 20037
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Docket No. 27206-030

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, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO SUSPEND**

TO: Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Pursuant to 37 C.F.R. §§ 2.117(c) and 2.119(a), Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant"), hereby opposes Opposer The Chamber of Commerce of the United States of America's ("Opposer") Motion to Suspend or in the alternative, to extend the discovery and testimony dates ("motion to suspend"), filed on March 13, 2006, without discussion with, or service upon Applicant.

This opposition is supported by the accompanying Memorandum in Support of Opposition to Motion to Suspend Proceedings ("Memorandum") and such other papers and arguments as may be presented to the Board.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Date: April 21, 2006

By: /s/Jill M. Pietrini

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MEMORANDUM IN SUPPORT OF OPPOSITION TO MOTION TO SUSPEND

Applicant submits the following Memorandum in support of its opposition to Opposer's motion to suspend.

I. INTRODUCTION

On April 11, 2003, Opposer filed a Notice of Opposition of Applicant's Application Serial No. 78/081,731 to register the mark UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design for providing educational and professional development classes, seminars, workshops, conferences, and camps to promote leadership and foster development of entrepreneurship and business acumen among youth in International Class 41. The present proceeding, Opposition No. 91-156,321, was instituted against Application Serial No. 78/081,731.

On May 14, 2003, Opposer filed a duplicate Notice of Opposition of Application Serial No. 78/081,731. In response, Opposition No. 91-156,775 was instituted, and then terminated as null and void by order of the Board dated August 26, 2003. Application Serial No. 78/081,731 was inadvertently forwarded to registration following the dismissal of Opposition No. 91-156,775, and issued as U.S. Registration No. 2,777,830. However, pursuant to the Board's March 28, 2005 order, appropriate action will be taken by the Assistant Commissioner of Trademarks to restore the application to pendency, subject to the instant Opposition.

Since the inception of this Opposition more than **three years ago**, the proceedings have been either extended or suspended **seven times**, all but once initiated by Opposer. This request for an extension is the **eighth** request for such a delay.

Prior to Opposer's eighth request for a suspension of the proceedings, the discovery period was set to close on March 13, 2006. On March 13th, Opposer's counsel left voicemail messages for two attorneys at Applicant's counsel's firm. Neither attorney ever spoke to Opposer's counsel, and neither Applicant nor its counsel ever agreed to a suspension of the proceedings. Opposer filed its motion to suspend on the same day without serving a copy on Applicant. Before the day that Opposer filed its unilateral request for a suspension of the proceedings, Opposer had not contacted Applicant regarding settlement, or for any other reason, since the parties agreed to the previous 90-day extension requested by Applicant in December of 2005.

Although the parties exchanged letters regarding settlement in February, April and October 2005, no agreement has been reached between the parties. Furthermore, Opposer has repeatedly delayed the proceedings, and has done little to negotiate a settlement, or to otherwise move the proceedings forward, in the last six months, despite receiving numerous extensions and suspensions of the opposition for the purposes of settlement negotiations. Indeed, Opposer had maintained the same settlement posture since inception.

Applicant respectfully requests that Opposer's motion to suspend the proceedings based on settlement discussions be denied because this opposition has been delayed long enough and Opposer has not complied with the Trademark Rules of Practice or the Board's Manual in filing the motion to suspend. Applicant also opposes extending the discovery and testimony periods for another 60 days as requested by Opposer. Applicant seeks the resolution of the opposition and the registration of its

mark UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design at the earliest possible date.

II. THE MOTION TO SUSPEND SHOULD NOT BE CONSIDERED BY THE BOARD WITHOUT APPLICANT'S OPPOSITION BECAUSE OPPOSER DID NOT SERVE APPLICANT WITH THE MOTION

Pursuant to 37 C.F.R. 2.119(a) and TBMP §§ 114 and 502.02(a), every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service must be made before the motion will be considered by the Board. Here, Opposer filed a motion to suspend the opposition on March 13, 2006, but did not serve a copy of the motion on Applicant. Nor did Opposer provide the Board with a proof of service of the motion to suspend upon Applicant. The fact that Opposer filed the motion to suspend electronically does not relieve Opposer of its obligation to serve a copy of the motion on Applicant. It is not Applicant's duty to periodically check the Board's website to see what documents, if any, that Opposer filed.

In short, Opposer's motion to suspend should be denied outright for failure to comply with 37 C.F.R. § 2.119(a) and TBMP §§ 114 and 502.02(a).

Even if the Board does consider this motion, it should not be decided until the Board receives and reviews this opposition, and it should not be considered filed as of March 13, 2006. Had Applicant been served with a copy of Opposer's motion by first class mail (as it has served Applicant with other documents in this proceeding), Applicant would have had until April 3, 2006 to oppose the motion. However, because Opposer failed to serve Applicant with a copy of the motion to suspend, Applicant just recently obtained a copy of the motion on April 14, 2006 while doing a routine status

check for this proceeding. Thus, the motion to suspend should not be deemed filed until April 14, 2006. As such, Opposer's alternative motion to extend time is really a motion to reopen and is therefore governed by the excusable neglect standard in TBMP § 509.01(b)(1).

III. THE MOTION TO SUSPEND SHOULD BE DENIED

Although proceedings *may* be suspended for purposes of settlement negotiations, good cause for further delay does not exist in this instance. Furthermore, either party to the opposition may request resumption of the proceedings at any time. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952 (TTAB 1979) (an order suspending the proceedings for settlement was vacated once it came to the Board's attention that the adverse party objected to suspension on that basis). Applicant objects to the suspension of the opposition due to settlement negotiations because Opposer has made very little effort to advance the settlement of this matter in the last six months, and absolutely no effort to resolve the opposition since December 2, 2005, the day that the parties agreed to the *last* 90-day extension of the proceedings.

Early in the opposition, Opposer suggested that the dispute should be resolved with a license of the trademark at issue from Opposer to Applicant. Nonetheless, Applicant has consistently taken the position that it is not interested in taking a license from Opposer for a mark that Opposer does not own. In a letter dated February 1, 2005, Opposer acknowledged Applicant's position, but tried to convince Applicant to settle the matter with a license anyway. In response, Applicant sent Opposer a letter dated April 20, 2005, indicating that it would not enter a license, but instead enclosed a

proposed coexistence agreement. Six months later on October 12, 2005, Opposer sent another letter stating that it would not enter a coexistence agreement, but remained of the opinion that a license is in the best interests of the parties. Opposer suggested that the parties meet to further discuss a settlement, even though Opposer stated that the principals of the parties had met previously. Although another meeting of the parties was considered, the parties never met to discuss the settlement of the opposition. Applicant contacted Opposer on December 1, 2005 to request that the discovery and testimony periods be extended for three months to continue settlement discussions. Opposer consented to the extension via e-mail on December 2, 2005. The next contact the parties had was on March 13, 2006, when Opposer's counsel called two of Applicant's counsel to request another suspension of the opposition.

Throughout the settlement negotiations, Opposer has not moved from its original position that the opposition should be resolved with a license, despite the fact that Applicant has informed Opposer on numerous occasions that it is not willing to enter a license. Another suspension of the opposition for settlement discussions will only serve to delay the registration of Applicant's mark at issue longer, and will not likely bring a resolution to this proceeding. This case has been pending for three years and is not much further along from the day that it was filed. Opposer needs to move this case forward or dismiss it, or retreat from its long standing position that after 25+ years of using Applicant's trade name that forms part of the opposed mark, Applicant must now assign those rights to Opposer and take a license back to use its opposed trademark and trade name.

For the same reasons as above, Applicant also objects to Opposer's alternative request to extend the trial schedule for 60 days. Applicant therefore requests that this opposition continue on its previous schedule, with the discovery period closed and Opposer's testimony period to run from May 12, 2006 to June 11, 2006, so that this dispute can be resolved, and Applicant's registration may be determined, at the earliest possible date.

IV. CONCLUSION

For the reasons stated herein, the Board should deny Opposer's motion to suspend the proceedings, deny Opposer's request to extend the discovery, testimony and trial periods, and order that the schedule set in the Board's March 13, 2006 order remain effective.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Dated: April 21, 2006

/s/Jill M. Pietrini

Jill M. Pietrini
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Attorneys for Petitioner Applicant, Inc.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 21st day of April, 2006.

/s/Ruth Quintanilla
Ruth Quintanilla

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO SUSPEND** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

William Merone
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005

on this 21st day of April, 2006.

/s/ Ruth Quintanilla
Ruth Quintanilla

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