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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, )  
 )  
 )  
Applicant. )

Opposition No. 91156321

Opposition No. 91156340



12-30-2003

U.S. Patent & TMOfc/TM Mail RcptDt. #78

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO REQUIRE SURRENDER  
OF REGISTRATION NO. 2,777,830, TO CONSOLIDATE THE PENDING  
PROCEEDINGS, AND TO RESET DISCOVERY AND TESTIMONY PERIODS IN THE  
CONSOLIDATED PROCEEDING**

U.S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202

Sir:

Pursuant to 37 C.F.R. §2.127(a), Applicant United States Hispanic Chamber of Commerce, by its attorneys, hereby responds to Opposer's Motion to Require Surrender of Registration No. 2,777,830 to Consolidate the Pending Proceedings, and to Reset Discovery and Testimony Periods in the Consolidated Proceeding.

As set forth in Applicant's Motion to Dismiss for Lack of Jurisdiction filed in Opposition No. 91156340 (copy attached), Opposer failed to timely file a notice of opposition against Serial No. 78/087,678 ("the '678 Application"). As a result, that opposition should be dismissed, rendering moot Opposer's Motion to Consolidate.

However, even if Opposition No. 91156340 is not dismissed, the Trademark Trial and Appeal Board (the "Board") should deny Opposer's Motion.

Opposer's Motion fails to comply with the applicable requirements for motions before this Board. Every motion filed before the Board must contain a full statement of the grounds, and must embody or be accompanied by a brief. 37 C.F.R. §2.127(a) and TBMP §502.02. Opposer's Motion sets forth facts relating to its filing of the present oppositions. Opposer, however, fails to set forth any support for the grounds in its Motion, particularly for the surrender of the '830 Registration. The Motion did not embody, nor was it accompanied by, a brief. Opposer completely fails to cite any support in its Motion for the surrender of the '830 Registration. Further, with respect to consolidation of the present opposition proceedings, Opposer simply states that judicial economy will be realized by consolidation. Thus, Applicant submits that Opposer failed to comply with the proper motion requirements before the Board and its Motion should be dismissed.

Moreover, the marks sought to be registered by the '731 Application and '678 Application are visually and phonetically different and are sought to be registered in connection with different services classified under different International Classes. Thus, the proceedings should remain separate as the evidence and testimony presented in each of the proceedings may be different.

Contrary to the assertion in Opposer's Motion that a single proceeding is the simple solution that puts the parties in exactly the position they would have been in had the errors not occurred, such a solution is not only improper as discussed herein and in Applicant's Motion to Dismiss, but would unfairly prejudice Applicant. Applicant submits that the dismissal of both

oppositions is the proper solution, thereby allowing the '678 Application to register and the '830 Registration to remain.

**CONCLUSIONS**

WHEREFORE, Applicant respectfully prays that the Board deny Opposer's Motion.

RESPECTFULLY SUBMITTED,

ARMSTRONG TEASDALE LLP



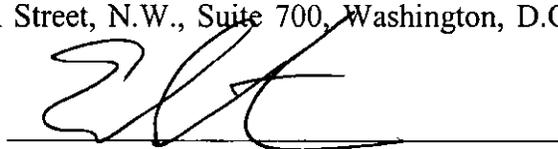
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Marfa I. Burgin  
Evan R. Sotiriou  
One Metropolitan Square  
Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070

Attorneys for Applicant

**CERTIFICATE OF SERVICE**

I certify that on December 24, 2003, a copy of the foregoing Applicant's Response to Opposer's Motion to Require Surrender of Registration No. 2,777,830 to Consolidate the Pending Proceedings, and to Reset Discovery and Testimony Periods in the Consolidated Proceeding was mailed, first class mail postage prepaid, to Mark C. Comtois and L. Lawton Rogers, III, of Duane Morris LLP, 1667 K Street, N.W., Suite 700, Washington, D.C. 20006, attorneys for Opposer.



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**APPLICANT'S MOTION TO DISMISS FOR LACK OF JURISDICTION  
AND SUGGESTIONS IN SUPPORT THEREOF**

U.S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202

Sir:

Pursuant to 37 C.F.R. §2.127(a) and Rule 7(b) of the Federal Rules of Civil Procedure, Applicant United States Hispanic Chamber of Commerce, by its attorneys, hereby moves the Trademark Trial and Appeal Board to dismiss the present opposition on the grounds that Opposer failed to timely oppose the application that is the subject of this opposition. In support of this Motion Applicant states the following.

**INTRODUCTION**

Applicant filed two applications to register the marks UNITED STATES HISPANIC CHAMBER OF COMMERCE and UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Serial Nos. 78/087,678 (the "'678 Application") and 78/081,731

(the “’731 Application”), respectively. This opposition involves the ‘678 Application.

The ‘678 Application was published for opposition on October 15, 2002. Opposer extended the time to oppose the ‘678 Application several times, with a final consented motion extending the time to oppose to April 14, 2003. The ‘731 Application was published for opposition on July 16, 2002, and the Opposer extended the time to oppose the ‘731 Application several times, with a final consented motion extending the time to oppose to May 14, 2003.

On April 11, 2003, Opposer timely filed a notice of opposition against the ‘731 Application. Opposer then filed a notice of opposition against the ‘678 Application on May 7, 2003, nearly a month after the April 14 deadline. Opposer also filed a second notice of opposition against the ‘731 Application on May 14, 2003.

### ARGUMENT

The period for opposing the ‘678 Application expired on April 14, 2003. Opposer sought no further extension of time in which to oppose during the extension period. Therefore, Opposer’s notice of opposition to the registration sought in the ‘678 Application, which was filed on May 7, 2003, was clearly filed after the expiration of the consented extension period. Because Opposer did not file a timely notice of opposition, the Trademark Trial and Appeal Board (the “Board”) should dismiss this opposition.

An opposition may be filed only as a timely response to the publication of the mark in the Official Gazette of the United States Patent and Trademark Office, 15 U.S.C. §1062(a) and TBMP §102.02, and must include, among other information, the number of the Application being opposed. TBMP §106.01. A notice of opposition must be filed within 30 days of

publication or within the extension period for filing the opposition. 37 C.F.R. §2.101(c).

The notice of opposition Opposer filed on April 11, 2003 properly identified the '731 Application, the corresponding International Class (41) and date of publication for opposition (July 16, 2003) for the '731 Application. Thus, Opposer's notice of opposition filed on April 11, 2003, sought to oppose only the '731 Application. Moreover, the fact that the notice of opposition did not mention the '678 Application was not merely a mistake in form (i.e., merely a mistake in identifying the proper serial number).

Moreover, Opposer's May 7, 2003 request to extend the time to file its notice of opposition to the '678 Application was improper. A request for an extension of time in which to file a notice of opposition must be filed prior to the expiration of any extension to file that was previously granted to a party. TBMP §202.04. The extension of time requirements are statutory and cannot be waived by stipulation of the parties, nor can the Director upon petition waive the requirements. TBMP §202.04.

There is no statutory authority for accepting the late-filed notice of opposition or for granting the extension request filed on May 7. Opposer simply failed to file a timely notice of opposition and such failure to comply with the statutory filing requirements could not be cured following the expiration of the time period for filing the notice of opposition. Opposer should not be allowed for its own benefit to circumvent the statutory time period for filing a notice of opposition by substituting or converting a notice opposition filed against the registration sought in the '731 Application to a notice of opposition against the registration sought in the '678 Application.

For the foregoing reason, the Board lacks jurisdiction to adjudicate and should dismiss

this opposition.

**CONCLUSIONS**

WHEREFORE, Applicant respectfully prays that the Board dismiss this opposition and issue a registration based on the '678 Application.

RESPECTFULLY SUBMITTED,

ARMSTRONG TEASDALE LLP



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Suite 2600

St. Louis, Missouri 63102-2740

(314) 621-5070

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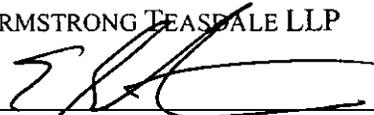
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