

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Ryan

MAILED: September 25, 2004

Opposition No. 91159972

Dunham's Athleisure Corporation

v.

New Balance Athletic Shoe, Inc.

Before Simms, Hairston, and Drost,
Administrative Trademark Judges:

This case now comes up for consideration of applicant's June 7, 2004 motion to dismiss this opposition proceeding and opposer's June 21, 2004 brief in opposition thereto, which includes an alternative motion that the Board "allow and deem the Notice of Opposition to be converted to a Petition to Cancel."

Looking at the written record for the involved application, Serial No. 75758998, we observe that on March 12, 2001 the Examining Operation of the Trademark Office approved applicant's amendment to the Supplemental Register and on October 15, 2001, the application was approved for registration. However, as we review the Office's electronic records, we see that the application was incorrectly entered in the TRAM system as approved for registration on the Principal Register. Consequently, the application was improperly published for opposition in the Official Trademark Gazette on March 26, 2002.

Opposition No. 91159972

Applicant argues that, because its application published for opposition in error, the opposition filed thereon is improper, and this proceeding should be dismissed.

In response, opposer argues that the opposition is appropriate. Opposer claims: that it justifiably relied on the publication notice in the Official Gazette because the TRAM system shows that the application was approved for registration on the Principal Register; that opposer's notice of opposition was timely; that the publication error should not be corrected because applicant failed to notify the Office of the publication error within one week of the publication date and in accordance with TMEP §1502.01 (3rd ed., 2002);¹ and that dismissal would cause prejudice to opposer.

Opposer's arguments are not well taken.

Under Section 24 of the Trademark Act, marks for the Supplemental Register shall not be published for or be subject to

¹ Opposer incorrectly cites TBMP §1502.01 even though the correct reference is TMEP §1502.01 which provides, in pertinent part that:

"To correct a clerical error in the publication of a mark in the *Trademark Official Gazette*, the applicant or applicant's attorney must file a written request. . . The request should be filed within one week after the date of publication in the *Official Gazette*.

The Photocomposition Coordinators can only correct errors that are purely clerical (e.g., a typographical error or omission, drawing printed upside down, or incorrectly stated data). The Photocomposition Coordinator will review the notification of error and verify the existence of the clerical error, determine whether the error can be corrected without jurisdiction being restored to the examining attorney or republication being required, and coordinate the appropriate correction procedure."

Opposition No. 91159972

opposition, but shall be published for registration in the Official Gazette of the Patent and Trademark Office. 15 U.S.C. §1092.

Accordingly, the Board must reject any opposition filed with respect to the mark in an application for registration on the Supplemental Register. See TBMP §301 (2d. ed., rev. March 2004). Under standard Board operating procedure, the opposition papers will be returned to the person who filed them, and any opposition fee submitted will be refunded. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. See Section 24 of the Act, 15 U.S.C. §1092. See also TBMP §301 (2d. ed., rev. March 2004).

The publication error in this instance directly violates Section 24 of the Trademark Act and must be corrected. Opposer misinterprets TMEP §1502.01 as overriding authority for imposing a rigid statute of limitations on corrective action by the Office.

Opposer's alternative motion that the Board somehow "convert" the notice of opposition to a petition to cancel is without legal basis. Section 24 of the Trademark Act clearly states that opposer's remedy lies with the filing of its petition to cancel once the registration has issued. See TBMP §301 (2d. ed., rev. March 2004). In any event, applicant's mark has not yet registered and accordingly, a cancellation proceeding would

Opposition No. 91159972

be premature at this time. See TBMP §309.04 (2d. ed., rev. March 2004).

In view thereof, applicant's motion to dismiss is **granted**. This opposition proceeding is dismissed as a nullity. The opposition papers will be returned to opposer and the opposition fee submitted will be refunded in due course. Application Serial No. 75758998 will go forward for appropriate corrective action and registration on the Supplemental Register.

* * * * *

Notice Regarding TTAB Electronic Resources and New Rules

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://esta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.