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

Proceeding	91165912
Party	Defendant Walgreen Co.
Correspondence Address	MARK J. LISS LEYDIG, VOIT & MAYER TWO PRUDENTIAL PLAZA, 180 N. STETSON CHICAGO, IL 60601 UNITED STATES mnieds@leydig.com
Submission	Other Motions/Papers
Filer's Name	Caroline L. Stevens
Filer's e-mail	cstevens@leydig.com
Signature	/Caroline L. Stevens/
Date	02/01/2010
Attachments	2010.02.01 Joint Motion to Vacate TTAB Decision.pdf ( 10 pages )(236390 bytes )

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

Wyeth	)	
	)	
Opposer,	)	Opposition No. 91165912
	)	
v.	)	Mark: <b>WAL-VERT</b>
	)	
Walgreen Co.,	)	Serial No. 76/594,301
	)	
Applicant.	)	

**JOINT MOTION TO VACATE DECISION, WITHDRAW  
APPLICATION WITH PREJUDICE, AND DISMISS OPPOSITION**

Wyeth (“Wyeth”) and Walgreen Co. (“Walgreens”) (jointly, the “Parties”), by and through their respective attorneys, respectfully move the Trademark Trial and Appeal Board (“TTAB”) to grant the parties’ motion for *vacatur* of the TTAB’s decision dated August 5, 2008 and rendered in opposition proceeding No. 91165912 (the “Opposition”), pursuant to the instructions of the U.S. District Court for the Northern District of Illinois (the “Northern District”), and thereafter, to withdraw application Serial No. 76/594,301 (the “Application”) with prejudice and dismiss the Opposition as moot. As background and support for this Joint Motion, the Parties submit the following:

**I. FACTUAL HISTORY**

On May 24, 2004, Walgreens filed the Application for the WAL-VERT mark. On May 10, 2005, the Application was published for opposition. On July 18, 2005, Wyeth filed a Notice of Opposition against the Application. The TTAB sustained the Opposition in a decision dated August 5, 2008 (the “Decision”).

On October 6, 2008, Walgreens appealed the Decision by civil action to the U.S. District Court for the Northern District of Illinois (the “Federal Action”). The TTAB suspended the Opposition during the pendency of the Federal Action. The Federal Action was tried to the Court from October 14 through and including October 16, 2009.

After extensive negotiations, the Parties reached a conditional agreement and entered into a written settlement agreement (the "Agreement") that conditionally resolved their dispute, the Federal Action, and the Opposition. As an essential condition of the Agreement, the Parties agreed to *vacatur* of the TTAB Decision and also agreed to the withdrawal of the Application with prejudice and the dismissal of the Opposition as moot. Therefore, good cause exists for this Motion.

Pursuant to the terms of settlement, the Parties jointly moved the Northern District to remand the Federal Action to the TTAB with instructions to vacate the TTAB Decision and to grant the other requested relief to facilitate resolution of this dispute. The Northern District granted said motion. (See Order attached as Attachment 1). Accordingly, the Parties hereby move the TTAB to vacate the Decision as instructed by the Northern District. The Parties agree that *vacatur* is proper in this case. *See American Flange & Manufacturing v. Rieke Corp.*, 90 USPQ2d 1127, 1127 (TTAB 2009) (granting parties' joint motion for *vacatur* of TTAB decision where settlement was conditioned on amendment to application at issue and also on *vacatur* of TTAB decision if necessary for amendment to be accepted); *see also International Truck Intellectual Property Co., LLC v. Mitsubishi Motors North America, Inc.*, Cancellation No. 92041358 (TTAB 2009) (granting parties' motion to vacate TTAB decision rendered in cancellation action where settlement was conditioned on *vacatur* of the TTAB decision; a copy of the TTAB's decision is attached as Attachment 2 for the TTAB's reference).

Provided that the TTAB vacates the Decision, Walgreens requests that its Application be withdrawn with prejudice, Wyeth consents to such withdrawal, and the Parties jointly move for dismissal of the Opposition as moot.

## II. CONCLUSION

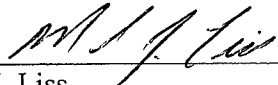
Pursuant to this Joint Motion, the Parties respectfully request and move the TTAB to vacate the Decision, dated August 5, 2008 and rendered in Opposition Proceeding No. 91165912, as instructed by the Northern District. Provided that the Decision is vacated,

Walgreens also moves the TTAB to grant its request to withdraw the Application Serial No. 76/594,301 with prejudice, Wyeth consents to such withdrawal, and the Parties jointly move for dismissal of opposition proceeding No 91165912 as moot.

Respectfully submitted,

Date: 1-29, 2010

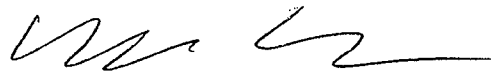
LEYDIG, VOIT & MAYER, LTD.

  
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Mark J. Liss  
Tamara A. Miller  
Caroline L. Stevens  
Leydig, Voit & Mayer, Ltd.  
Two Prudential Plaza, Suite 4900  
Chicago, Illinois 60601  
mliss@leydig.com  
(312) 616-5600

Attorneys for Applicant, Walgreen Co.

Date: Jan 22, 2010

DORSEY & WHITNEY LLP

  
\_\_\_\_\_  
Bruce R. Ewing  
250 Park Avenue  
New York, New York 10177  
(212) 415-9200  
ewing.bruce@dorsey.com

Attorney for Opposer, Wyeth

**Joint Motion to Vacate  
Decision**

**Attachment 1**

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

WALGREEN CO.	)	
(an Illinois corporation),	)	
Plaintiff,	)	
	)	Civil Action No. 08-cv-5694
v.	)	
	)	Judge W.R. Andersen
WYETH	)	Magistrate Judge A. Keys
(a Delaware corporation),	)	
Defendant.	)	

**ORDER**

Upon consideration of the Parties' Joint Motion to Remand to the Trademark Trial and Appeal Board ("TTAB"), and the Court being fully informed and good cause having been shown, it is hereby:

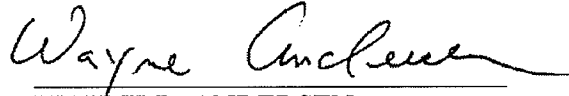
**ORDERED**, that the Motion is GRANTED, such that this case is hereby remanded to the TTAB, and it is further

**ORDERED**, that this Court hereby instructs the TTAB to vacate the TTAB decision dated August 5, 2008 and rendered in opposition proceeding No. 91165912 (the "Decision"), and it is further

**ORDERED**, that upon *vacatur* of the Decision, U.S. App. Serial No. 76/594,301 for WAL-VERT shall be deemed withdrawn with prejudice and Opp. No. 91165912 shall be dismissed as moot, and it is further

**ORDERED**, that the case shall be reinstated in the unlikely event that the TTAB does not vacate its Decision. Each party to bear its own costs and fees.

Signed on this 1<sup>st</sup> day of February 2010, Chicago, Illinois.

  
\_\_\_\_\_  
WAYNE R. ANDERSEN  
UNITED STATES DISTRICT JUDGE

**Joint Motion to Vacate  
Decision**

**Attachment 2**



**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
August 24, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

International Truck Intellectual Property Company, LLC,  
successor-in-interest to Monaco Coach Corporation<sup>1</sup>

v.

Mitsubishi Motors North America, Inc.

Cancellation No. 92041358

On Motion to Vacate

Mark J. Liss of Leydig, Voit & Mayer, Ltd. for International  
Truck Intellectual Property Company, LLC.

David M. Kelly and Linda K. McLeod of Finnegan, Henderson,  
Farabow, Garrett & Dunner, L.L.P for Mitsubishi Motors North  
America, Inc.

Before Sams, Chief Administrative Trademark Judge; Seeherman  
and Kuhlke, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

<sup>1</sup> The parties have stipulated to the substitution of International Truck Intellectual Property Company LLC for petitioner Monaco Coach Corporation. According to the parties' submission, after the Board rendered its decision in this matter on August 11, 2008, petitioner filed for Chapter 11 bankruptcy. Navistar International Corporation purchased all of petitioner's assets, including its intellectual property, and then transferred them to its related company, International Truck. The parties' request for substitution is hereby granted.


On August 11, 2008, the Board issued a final decision granting then-petitioner Monaco Coach Corporation's petition to cancel Registration No. 2336392, owned by Mitsubishi Motors North America, Inc., (hereafter "respondent") for the mark ENDEAVOR for "automobiles and structural parts therefor." That decision was appealed to the Court of Appeals for the Federal Circuit. The Court has remanded the case to us so that the Board can consider the parties' Joint Motion to Vacate Decision and Stipulation for Voluntary Surrender of Registration." On August 20, 2009 the parties filed a "Joint Motion to Vacate Decision," in which they request that the Board vacate its August 11, 2008 decision, and the parties also filed a stipulation to the voluntary surrender of respondent's Registration No. 2336392, contingent on the Board's order vacating the August 11, 2008 decision.

In view of the parties' agreement that the decision be vacated, we hereby grant the motion, and the Board's August 11, 2008 motion granting the petition for cancellation is vacated. Accordingly, respondent's voluntary surrender of its registration is accepted, and Office records have been updated to show that Registration No. 2336392 has been cancelled.

# **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the above foregoing Joint Motion to Vacate Decision, Withdraw Application with Prejudice, and Dismiss Opposition was sent via First Class Mail on this First day of February, 2010 to:

Bruce R. Ewing  
Dorsey & Whitney LLP  
250 Park Avenue  
New York, NY 10177-1500

A handwritten signature in black ink, appearing to read "B. Ewing", is written over a horizontal line.