

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 21, 2005

Opposition No. 91166663

Kellogg North America Co.

v.

Provea

David Mermelstein, Interlocutory Attorney:

This opposition is a proceeding against a request for extension of protection under the Madrid Protocol, pursuant to Trademark Act § 66(a), 15 U.S.C. § 1141f. It has come to the Board's attention that the Office failed to provide one of the notices required by statute. Therefore, the Board cannot proceed with the opposition.

Pursuant to the Trademark Act, the USPTO must timely send to the International Bureau of the World Intellectual Property Organization ("IB") certain notices with respect to a request for extension of protection. The Trademark Act requires the following notices as relevant hereto:

(c) Notice to International Bureau.—

(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Director shall transmit to the International Bureau any of the following that applies to such request:

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* * *

(B) A notification of refusal based on the filing of an opposition to the request.

(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

(2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

* * *

(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.

Trademark Act § 68(c)(emphasis added).

Therefore, with respect to an opposition, the Director must - within 18 months from the date the request for extension of protection was transmitted to the USPTO - either notify the IB that an opposition has been filed, Trademark Act § 68(c)(1)(B), or notify the IB of the possibility that an opposition may be filed after the expiration of 18 months, Trademark Act § 68(c)(1)(C). If neither notice is sent by the Director within 18 months, the Board may not entertain an opposition and the Director must register the mark. Trademark Act § 68(c)(4).

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In this case, the opposition was filed on September 21, 2005, and the Board promptly transmitted to the IB the notification required by Trademark Act § 68(c)(1)(B) (notice of refusal based on an opposition) on October 13, 2005. Nonetheless, because the USPTO had not timely transmitted to the IB the notice required by Trademark Act § 68(c)(1)(C) (notification of the possibility of an opposition after 18 months), no opposition may be entertained, and the mark must proceed to issuance of a certificate of protection. Trademark Act § 68(c)(4).¹

In view thereof, the Board is constrained to dismiss this opposition, without prejudice.²

***By the Trademark Trial
and Appeal Board***

¹ On October 3, 2005, the IB transmitted to the USPTO a "notice of irregularity" in response to the Board's § 68(c)(1)(B) notice. The notice of irregularity points out that the opposition may not be maintained under Article 5(2) of the Madrid Protocol and Rules 16 and 17 of the Common Regulations under the Madrid Agreement and Protocol. The irregularity was further noted to be "no[t] correctable." The notice of irregularity has been placed in the file of the subject application. The cited sections of the Madrid Protocol and Common Regulations correspond to the sections of the Trademark Act upon which this order is based.

² If otherwise appropriate, the opposer is not barred by this disposition from filing a petition for cancellation following issuance of the certificate of protection.