

Janet F. Satterthwaite (202) 344-4974 jfsatterthwaite@venable.com

October 18, 2007

TTAB

Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

Attn: **BOX TTAB**

76644700

Re: Opposition No. 91-178432
Opposer: BBVA Bancomer S.A. Institucion de Banca
Multiple, Group Financiero BBVA Bancomer
Applicant: BANCOMERCIO DE EL SALVADOR, INC.
Marks: BANCOMERCIO and BANCOMERCIO & Design
Attorney Reference: 42968-251737

Dear Sir or Madam:

Enclosed for filing are the following documents:

1. Response to Order to Show Cause;
2. Answer to Notice of Opposition;
3. Declaration of Janet F. Satterthwaite;
4. Declaration of Linda Hill;
5. Certificate of Service; and
6. Two filing receipts to be date stamped and returned to the undersigned.

Authorization is granted to deduct any necessary filing fee or apply any deficiency or overpayment to the undersigned's Deposit Account No. 22-0261.

Please send all correspondence in connection with this matter to the undersigned's attention.

Respectfully submitted,

By:

Janet F. Satterthwaite
Attorney for Applicant

10-18-2007

Enclosures: As Stated
DC2/901730V1

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

BBVA Bancomer S.A. Institucion de Banca)
Multiple, Group Financiero BBVA)
Bancomer)
,)
)
Opposer,)
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v.)
)
)
)
BANCOMERCIO DE EL SALVADOR, Inc.)
Applicant.)
)

Opposition No. 91-178432
Marks: BANCOMERCIO and
BANCOMERCIO and Design

Attorney Docket No. 42968-251737

BOX: TTAB NO FEE

RESPONSE TO ORDER TO SHOW CAUSE

Applicant, through counsel responds to the order dated September 21 to show cause why a default should not be entered against Applicant.

The reason why default should not be entered is that Applicant's counsel did not receive the mailing notifying Applicant's counsel of the opposition.

All of mail directed to Attorneys in the trademark group of Venable LLP, including Ms Satterthwaite, attorney of record in this case, at Venable LLP is routed directly to the docketing department. As described in greater detail in the attached Declarations, Venable maintains specific mail-handling procedures to ensure that there is a complete record of all incoming "docketable" mail, that all such documents can be tracked within the firm, and that the responsible and working attorneys, their assistants, and the docketing department are all aware of the existence of the documents and any accompanying deadlines. *See* Hill Decl., ¶¶ 3-5. Under Venable's established procedures, mailings addressed to attorneys with prosecution-based practices must first be transmitted to the docketing department. *Id.* There, the receipt of the mail is logged; the contents are reviewed for docketable dates; those dates are recorded on the docketing system; the documents are scanned into .pdf form which is then sent to both the attorney and their assistant, the deadlines are entered into the master docket on the docketing system

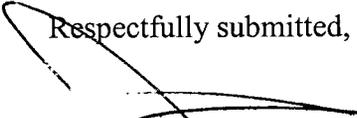
The docketing department maintains a log of incoming mail from the U.S. Patent and Trademark Office.

The log of the Venable docketing department for shows that the Notice of Opposition and scheduling order were not received. See Hill Decl. ¶¶6-8.

An Answer is being submitted herewith. Applicant intends to defend the opposition and should not be held in default because of issues caused by U.S. Mail.

October 18, 2007

Respectfully submitted,


Janet F. Satterthwaite
Venable LLP
575 7th St NW
Washington DC 20004
Attorney for Applicant

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

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BANCOMERCIO DE EL SALVADOR, Inc.)
Applicant.)

Opposition No. 91-178432
Marks: BANCOMERCIO and
BANCOMERCIO and Design

Attorney Docket No. 42968-251737

BOX: TTAB NO FEE

ANSWER TO NOTICE OF OPPOSITION

Applicant, Bancomercio de el Salvador, Inc. through Counsel, submits its Answer and Counterclaims.

1. Applicant admits the allegations in Paragraph 1 of the Notice of Opposition.
2. Applicant is without sufficient information to admit or deny the allegations in Paragraph 2 of the Notice of Opposition, and therefore denies same
3. Applicant is without sufficient information to admit or deny the allegations in Paragraph 3 of the Notice of Opposition, and therefore denies same
4. Applicant is without sufficient information to admit or deny the allegations in Paragraph 4 of the Notice of Opposition, and therefore denies same
5. Applicant denies the allegations in paragraph 5 of the Notice of Opposition.

6. Applicant is without sufficient information to admit or deny the allegations in Paragraph 6 of the Notice of Opposition, and therefore denies same.

7. Applicant is without sufficient information to admit or deny the allegations in Paragraph 7 of the Notice of Opposition, and therefore denies same

8. Applicant is without sufficient information to admit or deny the allegations in Paragraph 8 of the Notice of Opposition, and therefore denies same

9. Applicant is without sufficient information to admit or deny the allegations in Paragraph 9 of the Notice of Opposition, and therefore denies same

10. Applicant is without sufficient information to admit or deny the allegations in Paragraph 10 of the Notice of Opposition, and therefore denies same

11. Applicant is without sufficient information to admit or deny the allegations in Paragraph 11 of the Notice of Opposition, and therefore denies same

12. Applicant is without sufficient information to admit or deny the allegations in Paragraph 12 of the Notice of Opposition, and therefore denies same

13. Applicant denies the allegations in paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations in paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations in paragraph 15 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

1. Opposer fails to state a claim upon which relief can be granted.

2. Opposer's claim is barred by unclean hands.

3. Opposer's claim is barred by Acquiescence.

5. The marks BANCOMERCIO and BANCOMERCIO and Design and BANCOMER are not confusingly similar.

6. If the facts as alleged in the Notice of Opposition are true, the marks BANCOMERCIO and BANCOMER have coexisted for at least 7 years with no actual confusion know to applicant.

7. On information and belief, Opposer does not use its mark in the same channels of trade or with respect to the same types of customers.

WHEREFORE, Applicant prays that the Opposition be dismissed

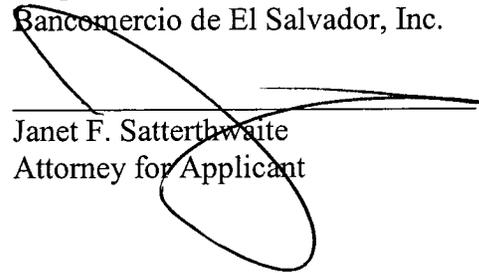
October 18, 2007

Venable LLP
575 7th St NW
Washington, D.C. 20004
(202) 344-4974

Dated: October 18, 2007

Respectfully submitted,
Bancomercio de El Salvador, Inc.

By:



Janet F. Satterthwaite
Attorney for Applicant

DECLARATION OF JANET F. SATTERTHWAITE

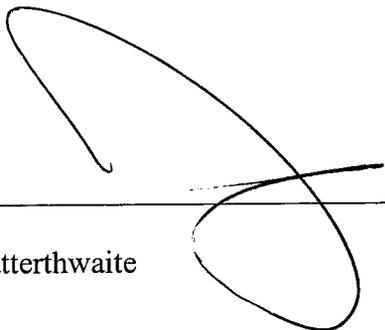
I, Janet F. Satterthwaite, declare as follows:

1. I am over the age of 18, have personal knowledge as to the facts stated below, and if called upon to testify, I could and would do so competently.
2. I am a partner at Venable LLP, and am the attorney for Applicant Bancomercio de el Salvador in the above-captioned proceeding before the Trademark Trial and Appeal Board (“TTAB”).
3. Venable’s Trademark Group, of which I am a member, prosecutes several hundred trademark applications every year.
4. As described in greater detail in the accompanying declaration of Linda Hill, a docketing supervisor, Venable has established procedures to monitor the flow of mail and docket and track deadlines. In brief, all incoming mail for attorneys identified as having “docketable” mail (including me) is sent from the mail room directly to Venable’s Docketing Department, which is then responsible for recording the receipt of such mail; reviewing the mail for “docketable” dates; recording such due dates on IP Master, our internal docketing system; having the documents scanned into .pdf files, sending them to the attorney and their assistant (LAA), and entering the deadlines into IP Master; and having the mail matched with the file and delivered to the Attorneys.
5. On or about September 28 2007, members of the docketing department came to my office to show me the Board's Order to Show cause mailed September 21, 2007, and to advise me that they had never received the Notice of Opposition; that there was no record of the Notice of Opposition have in been received or recorded by Venable’s docketing department, and no such documents or deadlines appear in IP Master.

6. I never received the Notice of Opposition in this case, and my Legal Administrative Assistant ("LAA") advised me that she had never seen it either.

7. Applicant intends to defend its registration, and at no point intended to abandon these proceedings. I could not respond to a notice of opposition I never knew existed. Had I known of the opposition, I assuredly would have timely responded.

I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge and belief.



Janet F. Satterthwaite

Executed on October 18, 2007.

DECLARATION OF LINDA HILL

I, LINDA HILL, declare as follows:

1. I am over the age of 18, have personal knowledge as to the facts stated below, and if called upon to testify, I could and would do so competently.
2. I am the Docketing Supervisor for Venable LLP and supervisor of the Docketing Specialists and other Docketing support staff. My permanent employment at Venable began September 26, 2006. Previous to that date, I was employed on a contract basis in the Docketing Department from early January 2001 to 9/25/2006.
3. In my capacity as Docketing Supervisor, I am responsible for ensuring the timely and expeditious entry of all incoming data by the Docketing Department staff from all and any mails and communications received for patents and trademarks. This includes Federal Express, UPS, DHL, U.S. Postal Service, wire transfers, e-mails, facsimiles, and all hand delivered documents. All incoming data relative to PTO due dates or foreign patent offices due dates are entered into the computerized docketing system as soon as possible after receipt to ensure that any and all information is disseminated and routed to the appropriate personnel for immediate handling. Upon receipt, the mail is opened, date stamped, and processed for incoming invoices. The mail received from the U.S. Patent and Trademark Office is recorded into the firm's PTO log for that day. The mail is then hand-carried to TDS (the firm's document management contractor) for scanning and disbursement via electronic means. Once scanned, the mail is hand delivered to the Docketing Department for further processing.

4. Venable has established mail delivery procedures to manage the flow of correspondence and to ensure that the mail reaches its intended recipients as quickly as possible, including the original correspondence and the associated electronic copy. These procedures have been established over the years of my tenure and are considered industry standard for mail processing. Thus far, these procedures have proven very effective in managing the patent and trademark mail flow.

Following is an outline of our mail processing procedures.

- a. All mail is delivered to the central receiving mail room. The patent and trademark mail is separated from the general mail and is redirected and hand-delivered to the Docketing Department.
- b. The mail is opened, dated stamped and reviewed. PTO mail is immediately entered into the PTO Log.
- c. All patent and trademark mail is then hand-carried to TDS for imaging. The Responsible attorney and the corresponding assistant are identified by the TDS staff by use of the IP Master Docketing Software. Once identified, an electronic copy of each piece of correspondence is routed via e-mail to the appropriately identified staff members.
- d. The mail is then hand-carried back to the Docketing Department for analysis.
- e. The Docketing Specialist reviews the correspondence for docketable due dates and enters this information into the electronic docketing database (IPMaster), which is a specialized software package created specifically for the practice of Intellectual Property Law.

f. After the analysis takes place and dates are docketed into the docketing database each piece of correspondence is reviewed by a second Docketing Specialist to ensure accuracy of the information in the database. The mail is then returned to TDS for delivery to the appropriate attorney or assistant. Ms. Satterthwaite is one of the attorney's identified to receive processed in this fashion.

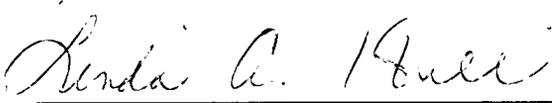
5. Because of the numerous files each attorney handles and the multiple daily deadlines that could be missed, the firm has established the Docketing Department whose primary responsibility is to maintain the "master" docket. Daily dockets are generated each day by the Docketing Department reflecting the due dates and reminder dates for every attorney identified in the database. These daily dockets define a two-day time frame and are hand-delivered to each work station. In addition to her daily docket, each week Ms. Satterthwaite receives a hand-delivered monthly docket advising her of all due dates and reminder dates for the next month.

6. There is no record anywhere in the office regarding receipt of a Notice of Opposition # 91178432 for Trademark Serial Numbers 76/644700 or 76/644702 dated July 17, 2007, as reflected in the Notice to Show Cause issued by the Patent and Trademark Office on September 21, 2007.

7. Regarding the incoming PTO Mail Log which was referenced above in No. 3, I have reviewed the log from July 17, 2007 through July 31, 2007. There is no record of any mail coming in from the USPTO with respect to Opposition Number No. 91178432.

8. The Docketing Department has no record of ever receiving this mailing. No documents were noted in IP Master as being received. No documents were scanned by TDS to Ms. Satterthwaite or her assistant. No due dates relative to the aforementioned documents appeared on Ms. Satterthwaite's daily or monthly docket.

I declare under penalty of perjury that the foregoing is true and correct to the best of my information, knowledge and belief.

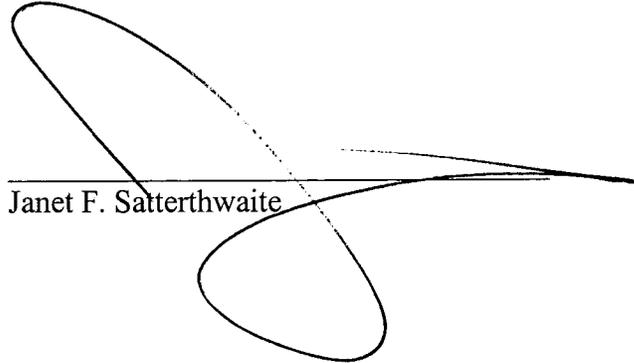

Linda Hill

Executed on October 16, 2007.

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing ANSWER and RESPONSE TO SHOW CAUSE ORDER to be served by mail on October 18 , 2007 on Opposer's attorney, as follows:

Henry H. Skillman
Dann Dorfman Herrell and Skillman PC
1601 Market Street
Suite 2400
Philadelphia PA 19103



Janet F. Satterthwaite

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