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

Proceeding	91181621
Party	Plaintiff StonCor Group, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.,	:	
	:	
Opposer,	:	
	:	Opposition No. 91181621
v.	:	
	:	Ser. No. 76/650,832
Les Pierres Stonedge Inc.,	:	
	:	
Applicant.	:	

**STONCOR’S OPPOSITION TO LES PIERRES’
23 JANUARY 2009 MOTION FOR JUDGMENT**

Introduction

StonCor opposes Les Pierres Motion for Judgment filed 23 January 2009.

This opposition paper should be considered in concert with StonCor’s 30 January 2009 Motion to Reopen StonCor’s Testimony Period.

Statement of Facts/History of the Case

On 20 December 2007 StonCor Group, Inc. filed a notice of opposition against the grant of registration of Les Pierres’ mark “STONEDGE” that was pending pursuant to application serial number 76/650,832. In its notice of opposition StonCor asserted that there would be a likelihood of confusion as between Les Pierres’ mark and at least one member and perhaps all of a family of “S T O N” marks owned by StonCor, all of which are registered, in force and incontestable.

Title and status copies of the fourteen registrations cited by StonCor in support of its notice of opposition were attached to the notice of opposition, in accordance with the requirements of 37 C.F.R. 2.122(d)(1), as amended effective 31 August 2007. Accordingly,

StonCor's fourteen cited, incontestable United States trademark registrations were a part of the record and were in evidence in this proceeding from the beginning.

Discovery closed 8 October 2008. StonCor's 30 day testimony period opened 7 December 2008 and closed on 6 January 2009. Illness of StonCor's counsel precluded the taking of any testimony during that period.

On 13 January 2009, Les Pierres served and filed a "Motion for Judgment for Opposer's Failure to Prove Case"; on 22 January 2009, Les Pierres served and filed an "Amended Motion for Judgment for Opposer's Failure to Prove Case"; and on 23 January 2009, Les Pierres served and filed a "Second Amended Motion for Judgment for Opposer's Failure to Prove Case".

In the 13 January motion Les Pierres contended that StonCor did not take any testimony or offer any other evidence during the StonCor Group testimony period. On such basis Les Pierres moved for dismissal of the opposition on the ground that StonCor had shown no right to relief.

Les Pierres' 22 January motion set forth averments in the first seven paragraphs essentially identical to those of Les Pierres' 13 January motion. In the eighth paragraph of the 22 January motion, Les Pierres stated "*[B]ecause copies of the registrations attached as exhibits to the notice of opposition were properly introduced into evidence in accordance with 37 CFR §2.122(d)*", the 13 January 2009 motion was, purportedly, more properly styled as a motion for judgment under 37 CFR 2.132(a). Les Pierres said that it was moving for dismissal on the ground that StonCor had allegedly failed to prosecute the opposition pursuant to 37 CFR 2.132(a). Les Pierres further moved, in the alternative, for dismissal of the opposition on the grounds that StonCor had allegedly shown no right to relief pursuant to 37 CFR 2.132(b).¹

Les Pierres' 23 January 2009 motion set forth averments in paragraphs 1, 3, 4, 5, 6, 7 and 8 using language essentially identical to corresponding allegations of Les Pierres' 13 and 22 January

motions. However, in the 23 January 2009 motion Les Pierres changed its position in paragraphs 2 and 9 and alleged that the copies of the registrations attached to the notice of opposition were purportedly “not properly made of record” (paragraph 2) and “not properly introduced as evidence in accordance with 37 CFR 2.122(d)” (paragraph 9). Les Pierres asserted no factual basis and presented no supporting evidence in declaration form or otherwise to support these allegations. Les Pierres gave no explanation of why or how the title and status copies of the registrations attached to the notice of opposition were purportedly “not properly made of record” or were “not properly introduced in evidence in accordance with 37 CFR 1.122(d).” Les Pierres then averred that its 29 January motion was more properly a motion for judgment under §2.132(a).²

To simplify the record, on 29 January StonCor filed a paper asserting that Les Pierres’ 22 January motion supplanted Les Pierres’ 13 January motion, that Les Pierres’ 23 January motion supplanted Les Pierres’ 22 January motion, and that, accordingly, no further response was required to Les Pierres’ motions of 13 and 22 January 2009. Les Pierres has not disputed that position.

On 30 January StonCor filed a Motion to Reopen the Period for StonCor’s Testimony in Chief. In the Motion to Reopen StonCor stated that its 30 January Motion was not StonCor’s only substantive response to Les Pierres’ 23 January Motion for Judgment.

This opposition is further in opposition to Les Pierres’ 23 January Motion for Judgment.

Argument

StonCor’s Incontestable Federal Registrations Have Been Evidence of Record Since 28 December 2007, When StonCor Filed its Notice of Opposition

¹ This was the same averment as in Les Pierres’ 13 January 2009 motion.

² Les Pierres asserted the same bases for dismissal as in the motions of 13 January and 22 January 2009.

In its motions of 13 and 23 January Les Pierres consistently asserts that the copies of the registrations attached to StonCor's notice opposition were purportedly "not properly made of record" and "not properly introduced as evidence in accordance with 37 CFR 2.122(d)".

A straightforward reading of 37 CFR 2.122(d), and the amendment to 37 CFR 2.122(d) that became effective in August 2007, makes it clear that when a registration is pleaded in an opposition, that registration is in evidence and is part of the record if the opposition was accompanied by an original or photocopy of the registration showing both the current status and/or current title of the registration:

A registration of the opposer or petitioner pleaded in an opposition or petition to cancel **will be received in evidence and made part of the record** if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration (emphasis added).³

The changes to 37 CFR 2.122(d) in August 2007 removed the requirement for the party in the position of the opposer to file two copies when making a pleaded registration of record with its pleading and allowed the party to file only a single copy or to rely on print-outs from the United States Patent and Trademark Office electronic database establishing status and title of a pleaded registration:

Section 2.122(d), in paragraph (1) currently sets forth provisions whereby a party in position of opposer or petitioner may make its registration(s) of record with its pleading. Section 2.122(d), in paragraph (1), is **amended to conform to existing practice by removing the requirement for a party in position of opposer or petitioner to file two copies** when making a pleaded registration of record with its pleading, and to allow the party to rely on printouts

³ 37 CFR §2.122, prior to amendment that was effectuated in August 2007.

from Office electronic database records establishing status and title of a registration.⁴

StonCor attached to the notice of opposition a single title and status photocopy of each of its registrations forming the basis for the opposition, in accordance with amended 37 CFR 1.122(d).

From these provisions it is clear that StonCor has had evidence in the record since commencement of this case. StonCor's registrations accompanied the notice of opposition, were copies of United States Patent and Trademark Office issued registration certificates, and indicated the title and status of the registration on the face of each registration. No action was required by StonCor to make these registrations of record as evidence in the case, other than to have attached the registrations to the notice of opposition when it was filed, which is exactly what StonCor did.

Les Pierres is wrong in contending, without any factual basis, that StonCor "submitted no evidence" as asserted in Les Pierres' motion of 13 January. (Interestingly, Les Pierres was correct in contending that the copies of StonCor's registrations were properly introduced into evidence in accordance with 37 CFR 2.122(d) in Les Pierres' 22 January motion.) Les Pierres was wrong again when it changed its tune the following day and alleged in its 23 January motion that the registrations were not properly made of record and not properly introduced as evidence under 37 CFR 2.122(d).

Les Pierres presented no argument, evidence, statement or assertion in either of Les Pierres' 13 or 23 January motions as to why or how the title and status copies of the registrations that StonCor had attached to the notice of opposition, were purportedly "not properly made of record" or were "not properly introduced into evidence in accordance with 37 CFR 2.122(d)". Les Pierres was wrong in contending, without any factual basis, that StonCor had submitted no

⁴ Final rule making notice, notes from Federal Register Volume 72, No. 147 commencing at page 42242.

evidence⁵ (but was correct in contending that copies of StonCor's registrations were properly introduced into evidence under 37 CFR 2.122(d)⁶), and was wrong again when Les Pierres reversed its field and contended that StonCor's registrations were not properly made of record and were not properly introduced as evidence under 37 CFR 2.122(d), as asserted in Les Pierres' 23 January motion, filed the very next day.

From the foregoing quotation of 37 CFR 2.122, anyone can see that 37 CFR 2.122 is a self-executing regulation. Once the copies of the federal registrations, or papers printed from the website of the United States Patent and Trademark Office showing the title and status of the registrations, are attached to the notice of opposition and the notice of opposition is filed, the registrations are in evidence. Nothing further is required. No authentication or verification is needed; no identification and marking is required; there is nothing else for the party filing the notice of opposition to do. When an opposer submits such status and title copies of its pleaded registrations as an exhibit to its notice of opposition, the registrations are received in evidence and made part of the record without any further action by the opposer. Les Pierres' contentions to the contrary fly in the face of the literal language of 37 CFR 2.122 and should be summarily dismissed.

StonCor's Lack of Testimony Taken During its Testimony Period Was Caused by StonCor Counsel's Unavoidable Illness, as Addressed in StonCor's 30 January Motion to Reopen.

The record lacks testimony in support of StonCor's testimony-in-chief because StonCor's principal counsel was ill during StonCor's testimony period and was unable to schedule or to take deposition testimony by StonCor's witnesses, as explained in more detail in StonCor's 30 January motion to reopen StonCor's testimony period. That motion is incorporated herein by reference.

⁵ Les Pierres motion of 13 January.

The TTAB Rules Allow Situations in Which an Opposer Submitted its Registrations or Other Evidence, But Did Not Take Testimony or Was Otherwise Deficient, and Yet The Opposition Goes Forward.

The rules of the Trademark Trial and Appeal Board contemplate situations in which an opposer has submitted the opposer's title and status registrations or has submitted other evidence or both, while not taking testimony, and yet the opposition may go forward to a decision on the merits.

For example, 37 CFR 2.128 applies where an opposer fails to file a main brief. 37 CFR 2.128(a)(3) reads as follows:

When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.⁷

From a reading of 37 CFR 2.128(a)(3), clearly if the opposer fails to file a main brief an order may be issued allowing the opposer a set time, not less than 15 days, in which to show cause as to why the Board should not treat such failure as a concession of the case. If the opposer fails to file a response to the order or files a response indicating loss of interest in the case, the Board may enter judgment against the opposer. However, if the opposer responds to the order, showing cause as to why the Board should not treat the failure to file the brief as a concession, and indicating that the opposer maintains interest in the case, the Board may permit the opposer time to file its main brief or may preclude the opposer from submitting a main brief but allow the opposer to file a reply to the applicant's brief.

It is clear that 37 CFR 2.128 addresses situations where an opposer fails to file its principal brief for whatever reason and yet wishes to proceed forward with the trademark

⁶ Les Pierres motion of 22 January.

opposition proceeding. In such cases under appropriate circumstances the opposition may proceed to a decision on the merits.

StonCor submits that 37 CFR 2.128 is an example of one of the Trademark Trial and Appeal Board rules allowing an opposition to go forward where an opposer had failed to file a brief. StonCor respectfully submits that the instant situation is **not** analogous to the situation addressed in 37 CFR 2.128(a)(3) in that the parties are not yet to the time for submission of briefs. The applicant has yet to take testimony and StonCor has pending a motion to reopen StonCor's testimony period. Even if StonCor's motion to reopen is denied, StonCor still has evidence already of record, namely StonCor's trademark registrations submitted with the notice of opposition, from which StonCor can argue in its principal brief and in its rebuttal brief as respecting the merits of StonCor's case. Additionally, StonCor can participate in the cross-examination of Les Pierres' witnesses and can present StonCor's own rebuttal witnesses after hearing the testimony from Les Pierres' witnesses.

Accordingly, StonCor submits that while 37 CFR 2.128(a)(3) addresses a situation in which a party has failed to file a brief and yet the trademark opposition proceeding may go forward, that section reflects a policy that may be implemented by the Board permitting decisions on the merits where a party has, either for reasons beyond the party's control or inadvertently, missed one of its testimonial or briefing periods. StonCor again emphasizes that StonCor seeks to have its testimony period reopened and that even if StonCor's motion for reopening is denied, StonCor intends to submit a brief in support of StonCor's position addressing the evidence of record that StonCor submitted with its notice of opposition.

⁷ 37 CFR 2.128(a)(3).

As another section of the rules of the Trademark Trial and Appeal Board that envision continuation of a trademark opposition proceeding on the merits despite an opposer's failure to take testimony, StonCor points to 37 CFR 2.132(a):

If the time for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony **or offered any other evidence**, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.⁸

Under this rule if an opposer's time for taking testimony has expired without the opposer taking testimony or offering any other evidence, the applicant may move for dismissal on the ground of failure to prosecute the opposition. In such case the opposer has 15 days from the date of service of the motion to show cause why judgment should not be entered against him.

StonCor respectfully submits that this rule does not apply to StonCor since while StonCor did not take any main testimony in the position of opposer, due to the illness of opposer's counsel as addressed above and set forth in greater detail in StonCor's 30 January motion to reopen, the rule requires more than the mere failure to take testimony. The rule requires that the opposer has "**not offered any other evidence**". StonCor, as set forth in detail above, submitted into evidence the trademark registrations on which StonCor's opposition is primarily based; those trademark registrations went into evidence the day StonCor filed its notice of opposition under 37 CFR 2.122 as set forth above. Consequently, by its clear language, 37 CFR 2.132(a) regarding

⁸ 37 CFR 2.132 (a) (emphasis supplied).

involuntary dismissal for failure to take testimony does not apply to StonCor, because StonCor has evidence of record in this case.

Moreover, StonCor is filing the instant motion to show cause why judgment should not be entered against StonCor. This is another example of a rule of the Trademark Trial and Appeal Board where the trademark opposition may go forward with the testimony periods being reset for the applicant and the rebuttal testimony period being reset for the opposer, to be followed by briefing.

While StonCor again submits that 37 CFR 2.132 does not, by its literal language, apply to this case because StonCor has offered “other evidence” as recited in the rule, 37 CFR 2.132 is a second example of a rule of the Trademark Trial and Appeal Board permitting a trademark opposition to go forward where an opposer, through no fault of the opposer, has failed to take testimony during the scheduled period.

StonCor further notes that the registrations submitted with the notice of opposition are strong evidence in favor of StonCor in this opposition proceeding:

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this Act and **owned by a party to an action shall be admissible in evidence and shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrants’ exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration** subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.⁹

To the extent that the right to use the registered mark has become incontestable under section 15 [§1065], the registration shall be conclusive evidence of the validity of the registered

⁹ 15 USC 1115(a).

mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce.¹⁰

From the foregoing statutory language respecting the evidentiary strength to be accorded to a trademark registration certificate, it is apparent that StonCor's trademark registration certificates, which are in evidence and of record in this proceeding, are strong evidence from which StonCor can argue its position against the registration of applicant's mark. StonCor will be able to argue StonCor's exclusive right to use the registered marks in commerce on or in connection with the goods or services specified in the registrations. From this the burden will shift to Les Pierres to distinguish Les Pierres mark from the various StonCor registrations on the basis of the duPont factors and other evidence that Les Pierres may choose to submit.

All of the preceding section is based on the premise that StonCor's motion of 30 January to reopen might conceivably be wrongly denied. StonCor does not concede the same but rather strongly asserts that in the interest of justice the 30 January motion should be granted, the testimony period should be reopened and this trademark opposition proceeding should go forward from that point. StonCor further submits that Les Pierres motion of 23 January, being completely without factual basis or evidentiary support, should be denied.

StonCor Has Acted in Good Faith

StonCor has engaged in settlement negotiations with the Les Pierres, to no avail. StonCor has served discovery requests on Les Pierres and those discovery requests were answered. Responses to Les Pierres' interrogatories and document product requests served on StonCor have been answered. StonCor's good faith is further evidenced by StonCor's offer to cut its principal briefing period in half, to recover some of the time lost due to StonCor's counsel's illness, as offered in StonCor's 30 January motion.

¹⁰ 15 USC 1115(b).

Conclusion and Prayer for Relief

StonCor respectfully submits that Les Pierres' 23 January motion for judgment is deficient and should be denied. Les Pierres' motion is based on an erroneous understanding and operation of the current version of 37 CFR 1.122(d) and on a misreading of 37 CFR 1.132(a). Additionally StonCor again respectfully prays that its testimony-in-chief period be reopened at an early date.

Respectfully submitted,

Date: 12 February 2009

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CERTIFICATE OF SERVICE

I, Charles N. Quinn, of full age, by way of certification, state that a copy of StonCor's Further Opposition to Les Pierres' 23 January Motion for Judgment, was sent to applicant's counsel on the date set forth below via electronic mail and by first class mail, postage prepaid, addressed as follows:

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Date: 12 February 2009

/CHARLES N. QUINN/
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