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

Proceeding	91194697
Party	Plaintiff Pac-Dent International, Inc.
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Date	06/14/2010
Attachments	Request for Reconsideration - 697 Opposition.pdf (3 pages)(299559 bytes)

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

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PAC-DENT INTERNATIONAL, INC.,	:	
	:	
Opposer,	:	Opposition No. 91194697
	:	
v.	:	
	:	
SULZER MIXPAC AG,	:	
	:	
Applicant.	:	

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REQUEST FOR RECONSIDERATION

Opposer Pac-Dent International, Inc. (“Opposer”) submits this Memorandum of Law pursuant to 37 C.F.R. §2.127 to Request Reconsideration of the Board’s Order dated June 10, 2010 granting the Motion filed by Applicant Sulzer Mixpac AG (“Applicant”) to suspend the instant Opposition based on a civil action currently pending between the parties (“the Civil Action”). For the reasons discussed below, it is respectfully submitted that Opposer’s Request for Reconsideration should be granted and Applicant’s Motion should be denied.

It is respectfully submitted that the Board should not have granted Applicant’s Motion since Opposer was not given an opportunity to oppose the Motion. In particular, Applicant’s Motion was filed on June 7, 2010, and the Board’s Order granting the Motion issued three days later, on June 10, 2010. Under the Trademark Rules, Opposer should have been given twenty days from the filing of the Motion to submit a brief in opposition. 37 C.F.R. § 2.127 (“a brief in response to a motion shall be filed within fifteen days from the date of service of the motion”); 37 C.F.R. § 2.119(c) (adding five days to the deadline to file a response to a motion if the motion is not delivered by hand). Accordingly, Applicant was not given the statutorily required twenty days to respond to the Motion, and therefore, its Request for Reconsideration should be granted.

Opposer's Request for Reconsideration should also be granted on substantive grounds, since The Civil Action and the instant Opposition address different issues, and therefore, it is not necessary to suspend the instant Opposition.

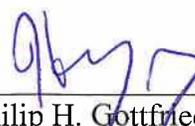
In particular, as Applicant correctly points out, the Civil Action will determine whether Opposer's product "is confusingly similar to, and infringes" the marks covered by the Applications which are the subject of the instant Opposition ("Applicant's Marks"). The instant Opposition does **not** address whether Opposer's product is confusing similar to or infringes Applicant's Marks. Rather, the instant Opposition addresses whether Applicant's Marks are entitled to registration in the first instance - *i.e.*, whether they should have been denied registration on a number of grounds, including without limitation, use of a defective specimen of use, lack of secondary meaning, functionality, *etc.* Indeed, the Board is not authorized to determine issues of infringement and can **only** determine issues of registrability. *See, e.g.*, Gary D. Krugman, *Trademark Trial and Appeal Board Practice and Procedure*, § 3:4 (2009-2010) ("The only issue before the TTAB [in a Opposition] is the entitlement of the defendant to the registration sought").

Based on the foregoing, it is respectfully submitted that Applicant's Request for Reconsideration should be granted.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
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Dated: New York, New York
June 14, 2010

By: 
Philip H. Gottfried
Holly Pekowsky

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Opposer in the above-captioned Opposition proceeding and that on the date which appears below, she caused a copy of the foregoing Request for Reconsideration to be served on Applicant by Federal Express, postage pre-paid, as follows:

Michael T. Murphy, Esq.
Christopher S. Adkins, Esq.
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Holly Pekowsky

Dated: New York, New York
June 14, 2010