

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

BUTLER

Mailed: May 26, 2011

Opposition No. 91198504

HONDA MOTOR CO., LTD.

v.

VANTIUM CAPITAL, INC. d/b/a ACQURA
LOAN SERVICES

Before Walters, Grendel and Bergsman, Administrative Trademark
Judges.

By the Board:

Applicant seeks to register the mark ACQURA for "financial services, namely, providing consultancy services in the areas of existing mortgage solutions and loan modifications." As grounds for opposition, opposer claims dilution and likelihood of confusion with its numerous previously used and registered marks composed in whole or in part of the term ACURA for automobiles, various items (e.g., umbrellas, computer game discs, sunglasses), various services (e.g., educational services and business consulting), and financing and leasing of ACURA-branded automobiles.

In its answer, applicant denies the essential allegations of the notice of opposition.

This case now comes up on applicant's motion, filed contemporaneously with its answer, to dismiss the notice of

opposition on the basis that the Board lacks jurisdiction. Opposer filed a response thereto.

In support of its motion, applicant argues that opposer made material misrepresentations to applicant in order to obtain applicant's consent, necessary for the third request to extend time to oppose (hereinafter also "third extension request"), which was filed on December 8, 2010. As background, applicant states that opposer's counsel called applicant's counsel on December 7, 2010 to offer a co-existence agreement and to request applicant's consent to the third request for an extension of time to oppose. On the same day, applicant's counsel, by email,¹ agreed to contact applicant to determine its interest in any such agreement and provided consent for the third extension request. On December 9, 2010, applicant's counsel informed opposer's counsel that applicant was interested in negotiating a co-existence agreement, asked for a proposed draft from opposer at its earliest convenience, and received an email from opposer's counsel on the same day that she would discuss the matter with her client and be in touch. On January 15, 2011, applicant's counsel contacted opposer's counsel inquiring about the status of the proposed settlement and received a response on January 19, 2011 that the matter was being discussed with opposer. On February 7, 2011, opposer filed the notice of opposition.

¹ Applicant has submitted copies of the email communications between the parties. Opposer notes that the copies are correct and expressly waives any objection to the authenticity of the submissions.

Applicant argues that its consent to the third extension request was obtained under false pretenses; that it would not have provided its consent if opposer had not offered a co-existence agreement; that there is little evidence to suggest opposer truly intended to pursue a co-existence agreement; and that opposer obtained additional time to prepare its notice of opposition by misleading applicant. Applicant contends that, because the Board would not have approved the third extension request absent applicant's consent, and the consent was obtained from applicant under false pretenses, the approval is improper, making the notice of opposition untimely. As a consequence, according to applicant, the Board does not have jurisdiction and the opposition must be dismissed.

In response, opposer argues that the copies of the email correspondence between the parties' attorneys do not show that applicant's consent was obtained under false pretenses. Instead, they show that the parties discussed the possibility of settlement, that such discussions were exploratory in nature, and that there was no misrepresentation. Opposer indicates that applicant omitted a letter dated February 15, 2011 from opposer which explains the reasons for the events of which applicant complains - basically, opposer changed its mind late in the process.² The relevant portion of the February 15, 2011 letter,

² A redacted copy of the letter has been submitted.

which specifically references the December 7, 2010 phone conversation, states:³

Since then, unfortunately, after further discussions among its business executives, our client is now taking a much harder stand with respect to ACURA ...

Opposer also argues that it did not seek the third extension in order to obtain time to prepare a notice of opposition, explaining that complaints grounded on likelihood of confusion and dilution are not difficult to prepare.

As a preliminary matter, because both parties have submitted matters outside the pleadings, and applicant's motion to dismiss is directed to the Board's jurisdiction, applicant's motion to dismiss is considered one for summary judgment. See Trademark Rule 2.127(e)(1); and TBMP § 503.04 (3d ed. 2011). Further, because opposer has responded to the substance of applicant's motion, because the subject of the motion is limited to the Board's jurisdiction, and in view of our determination, *infra*, no additional briefing time is being scheduled. See Fed. R. Civ. P. 12(d); Trademark Rule 2.127(e)(1); and TBMP § 503.04 (3d ed. 2011).

An applicant may question the propriety of extensions of time in a motion to dismiss,⁴ including one which is being considered as a motion for summary judgment.

³ The portion quoted is not redacted from opposer's submission.

⁴ See *Cass Logistics, Inc. v. McKesson Corp.*, 27 USPQ2d 1075 n. 2 (TTAB 1993).

Trademark Rule 2.102(c)(3) provides, in relevant part, as follows:

After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances.

Here, it is clear that opposer obtained applicant's consent to the third extension request. Applicant's attorney stated this was so and the email communications dated December 7 and 9, 2010 further confirm the consent.

Contrary to applicant's position, and notwithstanding any intent otherwise, applicant's consent was not conditioned upon execution of a co-existence agreement. Nor could it have been, given the imminent deadline for filing the third extension request. There appears to be a simple misunderstanding as to whether a co-agreement existed in fact, awaiting only execution. However, the email correspondence indicates that the parties' attorneys had just begun contacting their clients to ascertain the clients' interest in a co-existence agreement at the time of the deadline for filing the third extension request. Thus, an agreement did not exist at the time the third extension request was filed. There is no evidence that opposer needed the time made available by the third extension request to prepare its

notice of opposition and, indeed, opposer's attorney stated she did not need such time to do so.

The facts of *Central Mfg., Inc. v. Third Millennium Tech., Inc.*, 61 USPQ2d 1210 (TTAB 2001), relied upon by applicant, are distinguishable. In that case, applicant had not agreed to the requests to extend time to oppose that were at issue. Yet, opposer misrepresented to the Board that applicant had agreed. In addition, the Board found opposer had engaged in a pattern of submitting filings with false statements and imposed sanctions because there was no indication opposer could be discouraged from improper conduct in the future.⁵

Although applicant is understandably disappointed that settlement did not conclude prior to the commencement of this opposition, its consent to the third extension request was not obtained under false pretenses.⁶ Nor did opposer misrepresent to the Board that it had obtained applicant's consent.

⁵ The Board notes, too, that in the *Central Mfg., Inc.* opposition, opposer's representative, Leo Stoller, was a "bad actor." He had been sanctioned by the Board in the past for the same type of conduct. *Central Mfg.*, 61 USPQ2d at 1214. Mr. Stoller's improper behavior has been consistently recognized by the courts and the Board. See for example *Stoller v. Pure Fishing, Inc.*, 528 F.3d 478, 87 USPQ2d 1053 (7th Cir. 2008); and *Central Mfg. Co. v. Brett*, 78 USPQ2d 1662 (N.D. Ill. 2005).

⁶ Parties often use the periods available through requests for extension of time to oppose to explore and begin settlement talks. Doing so can reduce costs associated with the commencement of the opposition. However, because the timeliness requirements for extension requests and filing a notice of opposition are statutory, the settlement conversation begun often cannot be finalized before the notice of opposition must be filed. See Trademark Act § 13 for the statutory deadlines.

In view thereof, the third extension request stands; the notice of opposition was timely filed; and the Board has jurisdiction in this case. Accordingly, applicant's motion for summary judgment is denied.

Proceedings are resumed. Applicant's answer is noted and entered. Dates are reset as follows.

Deadline for Discovery Conference	6/24/2011
Discovery Opens	6/24/2011
Initial Disclosures Due	7/24/2011
Expert Disclosures Due	11/21/2011
Discovery Closes	12/21/2011
Plaintiff's Pretrial Disclosures	2/4/2012
Plaintiff's 30-day Trial Period Ends	3/20/2012
Defendant's Pretrial Disclosures	4/4/2012
Defendant's 30-day Trial Period Ends	5/19/2012
Plaintiff's Rebuttal Disclosures	6/3/2012
Plaintiff's 15-day Rebuttal Period Ends	7/3/2012

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
