ESTTA Tracking number: **ESTTA432491**
Filing date: **09/27/2011**

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

Proceeding	91201139
Party	Defendant O2 DÃ©veloppement
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Attachments	Applicant's reply brief to suspend.pdf (5 pages)(236880 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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O2 Holdings, Ltd.	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91201139
	)	Appln. No. 79087506
O2 Développement	)	
Société par Actions Simplifée	)	
	)	
Applicant	)	

APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS AND TO EXTEND ITS TIME TO ANSWER THE PLEADING

Applicant, O2 Développement Société par Actions Simplifée ("Applicant"), hereby submits its reply brief in further support of its motion to suspend this opposition proceeding and to extend its time to answer the pleading.

Opposer ignores the facts of this case, particularly its own pleading, in arguing against suspension of this case. Opposer's Notice of Opposition (*see* paragraph 2) merely pleads use of its alleged marks rather than pleading, as required under Section 2(d), use of such marks in the United States. *See Bayer Consumer Care Ag v. Belmora LLC,* 90 USPQ2d 1587 (TTAB 2009). Thus, subtracting any claim of prior use in the Untied States, Opposer's pleading is left to rely on three pleaded registrations as grounds for its opposition. Of those three, Reg. No. 2231093 is the subject of cancellation, as noted in Applicant's initial brief.

Reg. No. 2231093 asserts use of the mark for computer hardware and computer operating system software and corresponding instruction manuals. Opposer's only other registration of the three to assert use of the mark is Reg. No. 3848986 which covers prepaid telephone calling cards and telephone services provided via such calling cards and prepaid

wireless telephone services. The respective goods and services of the '093 and '986 registrations are obviously vastly different.[1]

Opposer should not have to engage in discovery with respect to the disparate goods and services reflected in the '093 and '986 registrations when an ongoing proceeding is seeking to cancel the '093 registration. Judicial economy weighs against that inefficient effort and, instead, weighs in favor of suspension. The whole point of a suspension is to allow another fist-filed proceeding to determine if the issues can be narrowed in a second-filed proceeding.

Otherwise, Opposer, a U.K. based company, pleads five pending applications all based on foreign rights and none of which assert use of the mark in the United States. These applications thus establish no grounds for an opposition unless, and until, the application actually matures to registration. The applications are thus mere place holders for a possible amended pleading at a later time. As to these applications, two are actively opposed as noted in Applicant's initial brief. Again, judicial economy weighs in favor of suspension to determine if the issues can be narrowed in this proceeding by the outcome of the first-filed proceeding.

Opposer makes two sweeping generalizations without any supporting authority. First, Opposer asserts that absent consent the "Board seldom grants a motion to suspend" based on another pending Board proceeding. Rule 2.117(a), however, acknowledges that suspension is appropriate in view of "another Board proceeding which may have a bearing on the case…." Likewise, the Board's Manual specifically acknowledges, without any mention of a consent,

[1] Of Opposer's three registrations, the remaining one, Reg. No. 3625167, asserts, on its face, only Section 44(e) as a basis for registration, and Opposer describes the mark therein as consisting of "THE 2" with a "stylized stadium dome design". That registration thus lacks the component O2 which is at the heart of this proceeding.

the suspension of a proceeding in view of another Board proceeding "in which only one of the parties is involved." TBMP § 510.02(a) ¶ 3. *Cf. Coca-Cola Co. v. Corporación Industrial Alimenticia, S.A. de C.V.,* Opposition No. 91187368 at p. 3 (June 25, 2010 TTAB) (Board *sua sponte* suspended proceeding in view of other Board proceedings). Second, Opposer further asserts without support (legally or factually) that, absent consent, Applicant's motion is "unfair" and "highly prejudicial" since Applicant did not file an answer. The Board's Manual, however, holds to the contrary: "The Board does not usually require that an issue be joined (that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding." TBMP § 510.02(a) ¶ 7.[2]

Opposer also relies on inapposite propositions with respect to this case. Opposer cites *Melwani v. Allegiance Corp.,* 97 USPQ2d 1537, 1541 (TTAB 2010) and *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.,* 59 USPQ2d 1369, 1372 (TTAB 2000) which concern whether the plaintiff engaged in excusable neglect to the defendant's prejudice. Those cases, and those concerns, were recently discussed by the Board in *New Orleans Louisiana Saints LLC v. Who Dat? Inc.,* 99 USPQ2d 1550, 1551 n.4 (TTAB 2011). Therein, the Board was concerned with multiple oppositions against the same application—clearly not relevant here—and the need to keep the proceedings ongoing, rather than suspending, because multiple plaintiffs were asserting multiple grounds against the same application. Any harm from suspension in that situation is simply not applicable here. Opposer's argument is essentially that its evidence and witnesses may be lost due to any delay

[2] The issues are joined in each of two ongoing proceedings on which Applicant relies so that the Board may determine that those proceedings have a bearing on the validity of the marks asserted herein by Opposer.

from suspension—a situation that is essentially within Opposer's control, but that argument proves too much in that no proceeding would be suspended if that criterion was dispositive. Opposer also argues that the extent of the delay herein from suspension would be unknown, but that too is a factor in any case and would effectively eliminate any suspension if elevated to a determinative factor.

Overall, Opposer also takes the incorrect position that the issues in the subject proceeding must duplicate the claims at issue in another proceeding in order for suspension to be appropriate. As noted above, however, Rule 2.117(a) permits suspension if some issues in the first-filed proceeding may have a bearing on some issues in the second-filed proceeding. *See Arcadia Group Brands, Ltd. v. Studio Moderna SA,* 99 USPQ2d 1134, 1136 (TTAB 2011) (non-precedential) ("the standard for suspension is not whether the civil action will be dispositive but whether it may have a bearing on the case").

Accordingly, in view of the foregoing, Applicant requests that its time to file an Answer to the Notice of Opposition be extended pursuant to Fed. R. Civ. P. 6(b)(1)(A), and that this entire proceeding be suspended until the final disposition of the other relevant Board proceedings. Applicant respectfully requests that its motion be granted.

Date: September 27, 2011

By: _____

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Certificate of Service

This is to certify that a copy of the foregoing was served this 27th day of September 2011 by first class mail, postage prepaid, on the following:

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