

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

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Mailed: December 15, 2011

Opposition No. 91201400

SIGNATURE FLIGHT SUPPORT UK
REGIONS LIMITED

v.

SIGNATURE TRAVEL NETWORK
COOPERATIVE, INC.

By the Board:

This proceeding is before the Board for consideration of applicant's motion (filed October 25, 2011) to withdraw its express abandonment of its opposed application, and to reinstitute this proceeding. The motion has been fully briefed.

As background, the order instituting this proceeding set applicant's answer to be due October 10, 2011. On September 20, 2011, applicant filed a "Voluntary Withdrawal of Application Without Prejudice," expressly abandoning its opposed application Serial No. 85175893 without prejudice, and without opposer's written consent. On September 28, 2011, the Board, pursuant to its ordinary practice, suspended proceedings, informed applicant of the applicability of Trademark Rule 2.135, and allowed applicant thirty days in

which to file opposer's written consent to its written abandonment.

In response, applicant filed a motion seeking leave to withdraw its abandonment, and seeking resumption of this proceeding, so as to avoid having judgment entered against it. In support thereof, applicant states, inter alia, that it sought opposer's consent, that opposer would not give consent to the withdrawal without prejudice, and that it attempted in good faith to obtain opposer's consent to its abandonment without prejudice. It further argues that opposer will not be prejudiced by granting applicant's request in view of the early stage of this proceeding, and asserts that it, applicant, should not be prejudiced by being subjected to a final judgment in this matter. Applicant submitted the declaration of its counsel of record, attesting to attempts he made to communicate with opposer's counsel of record after issuance of the Board's September 28, 2011 order.

In contesting the motion, opposer argues, inter alia, that applicant violated Trademark Rule 2.135 by filing an abandonment without opposer's consent, and that applicant presents no legal authority for its requested relief. On the issue of consent, opposer argues that applicant has not alleged that it sought opposer's consent prior to filing the abandonment, that opposer is not required to give its consent thereto, and that whether opposer consented after the

abandonment was filed is irrelevant to the issue of whether final judgment should be rendered. Opposer asserts that it will be prejudiced by being forced to continue with this proceeding and by being subjected to the continued risks posed by applicant's confusingly similar mark.

Turning now to the withdrawal (filed September 20, 2011) at issue, applicant's abandonment of its opposed application states that applicant "reserves the right to re-file the application at any time and to continue using the mark for all services identified in the application." Accordingly, applicant sought to abandon its application with an express reservation of the right to file the same application again at any time. As a practical matter, an abandonment of this nature without consent of opposer would merely serve to terminate this opposition proceeding and allow a presumably identical opposition proceeding to be filed at some point in the future against an identical application. In this manner, applicant's abandonment is contradictory on its face.

In its motion and supporting declaration, applicant has failed to be clear on its timeline of events. However, the record supports opposer's argument that applicant sought opposer's consent only after it filed the unconsented abandonment and thereafter received the Board's September 28, 2011 order apprising applicant of a procedural rule with which

it should have been familiar.¹ Moreover, opposer is correct that it is under no obligation to provide consent to the unconsented abandonment of the application being opposed, particularly here, where applicant seeks abandonment without prejudice.

Nevertheless, the record does not indicate that applicant filed its written abandonment with a callous disregard for the rules governing this proceeding, and inasmuch as applicant filed the abandonment twenty days prior to the time allowed to file an answer, said filing was not intended for dilatory purposes. Moreover, it is the policy of the law to decide cases on their merits, and the Board has a prevailing interest in adjudicating the right to register based upon the merits of the claims and defenses asserted, rather than pursuant to a mandate that applicant obtain opposer's consent, or pursuant to a default-like situation. *Cf.* TBMP § 312.02 (3d ed. 2011).

Regarding the issue of prejudice to opposer, in analogous situations, the Board has found that having to incur costs in preparing and filing a brief on a motion is not sufficient to support a finding of prejudice. See *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1903-04 (Comm'r 1990).

¹ For example, applicant's submission, Declaration of Tal Grinblat, states, in pertinent part, "On October 4, 2011 and again on October 6, 2011 I phoned counsel for Opposer Herbert L. Allen. On both occasions I left voice mail messages with Mr. Allen asking him to call me back to discuss the Opposition and the Board's September 28, 2011 Order" (Grinblat decl., para. 2).

Similarly, an opposer's need to move forward on meeting its burden of proof on its claims generally does not amount to prejudice. *Id.*

Upon consideration of all of the circumstances, applicant's motion to withdraw its abandonment is hereby granted. Accordingly, judgment will not be entered against applicant based on its filing of an abandonment of its application without opposer's written consent. This opposition will proceed.

In view thereof, applicant is allowed until thirty (30) days from the mailing date of this order in which to file its answer to the notice of opposition. Conferencing, discovery and trial dates, are hereby reset as follows:

Deadline for REQUIRED Discovery Conference	2/17/2012
Discovery Opens	2/17/2012
Initial Disclosures Due	3/18/2012
Expert Disclosures Due	7/16/2012
Discovery Closes	8/15/2012
Plaintiff's Pretrial Disclosures due	9/29/2012
Plaintiff's 30-day Trial Period Ends	11/13/2012
Defendant's Pretrial Disclosures due	11/28/2012
Defendant's 30-day Trial Period Ends	1/12/2013
Plaintiff's Rebuttal Disclosures due	1/27/2013
Plaintiff's 15-day Rebuttal Period Ends	2/26/2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits,

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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.