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

Proceeding	91207895
Party	Plaintiff Hokie Objective Onomastics Society LLC
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Attachments	HOOS - Motion for Reconsideration of Sua Sponte Dismissal of Claim Under 15 U.S.C. sec 1068.pdf(209711 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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HOKIE OBJECTIVE ONOMASTICS	)	
SOCIETY LLC,	)	
	)	
Opposer,	)	
v.	)	Opposition No. 91207895
	)	
VIRGINIA POLYTECHNIC INSTITUTE	)	Serial No. 85-531,923
AND STATE UNIVERSITY,	)	
	)	
Applicant.	)	

**MOTION FOR RECONSIDERATION OF THE BOARD’S  
SUA SPONTE DISMISSAL OF OPPOSER’S CLAIM FOR  
RECTIFICATION OF THE REGISTER UNDER 15 U.S.C. § 1068**

Opposer Hokie Objective Onomastics Society LLC (“Opposer”) hereby respectfully moves the Board for reconsideration of the portion of the Board’s Order of January 8, 2014 (the “Order”), in which the Board dismissed *sua sponte* paragraphs 27 and 28 of the Amended Notice of Opposition in this matter.

In the Order, the Board referenced its earlier decision of May 31, 2013, in which the Board had held that allegations of false first use dates did not state a claim of fraud on the USPTO and failed to constitute a claim on which relief could be granted. (Order at 7.) The Board then proceeded to observe that paragraphs 27 and 28 of the Amended Opposition also did not properly set forth a claim of fraud. (*Id.*) The Board accordingly dismissed paragraphs 27 and 28 of the Amended Opposition *sua sponte* on this ground. (*Id.*)

Opposer respectfully begs the Board to reconsider its decision because paragraphs 27 and 28 of the Amended Opposition do not purport to set forth a claim of fraud on the USPTO. Rather, these paragraphs set forth a claim seeking rectification of the Register pursuant to Section 18 of the Lanham Act, 15 U.S.C. § 1068. Paragraphs 27 and 28 read as follows:

27. The 1901 date of first use in commerce asserted in the Application is false and lacks any foundation in historical fact.

28. Pursuant to 15 U.S.C. § 1068, which in opposition proceedings grants to the Director the power, as exercised through the Board, to “rectify with respect to the register the registration of a registered mark,” the Application, if granted, must be rectified so that its asserted date of first use in commerce has a foundation in historical fact.

(Am. Opp’n ¶¶ 27-28.) In addition, in its prayer for relief, Opposer requested of the Board that “if the Application is granted . . . its asserted date of first use in commerce be rectified and replaced with a date that has a foundation in historical fact as proven by evidence presented to the Board.” (*Id.* ¶ 29.)

Nowhere in these paragraphs did Opposer seek to bring a claim of fraud upon the USPTO. Rather, in these paragraphs Opposer sought to bring a claim pursuant to 15 U.S.C. § 1068 for rectification of the Register. Such relief is indeed within the power of the Board, as made clear by the text of the statute itself, which states that it applies in opposition proceedings. Such relief also is wholly consistent with the purpose of granting to the Board the power to rectify the Register, which is to “further the desire to have the registers reflect the true status of all marks in use.” *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 691 n.6 (C.C.P.A. 1961).

Opposer respectfully notes that the cases cited by the Board in the Order in connection with the dismissal of paragraphs 27 and 28 did not mention 15 U.S.C. § 1068, and accordingly it has occurred to Opposer that the Board might not have fully appreciated the basis for the claim set forth in these paragraphs.

The ludicrously false date in Applicant’s application will, if the application is granted, pollute the Register with falsehood while simultaneously chilling the free speech of innocent parties who may, upon viewing the resulting registration, conclude that Applicant’s purported rights are much stronger than they really are. It is for this reason that Congress granted to the

Board the power to rectify the Register, and it is on this basis that paragraphs 27 and 28 of the Amended Opposition seek relief.

For these reasons, Opposer respectfully requests that the Board reconsider its decision to dismiss *sua sponte* paragraphs 27 and 28 of the Amended Opposition, and instead withdraw the portion of its Order that effected such dismissal.

HOKIE OBJECTIVE ONOMASTICS SOCIETY LLC

By:



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CERTIFICATE OF SERVICE

I hereby certify that on February 5, 2014, I served the foregoing by first-class mail upon the following:

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