ESTTA Tracking number: **ESTTA555090**
Filing date: **08/20/2013**

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

Proceeding	91210772
Party	Plaintiff Intercast Europe S.r.l.
Correspondence Address	Ralph H. Cathcart Ladas & Parry LLP 1040 Avenue of the Americas New York, NY 10018-3738 UNITED STATES rcathcart@ladas.com,rroa@ladas.com,mmercado@ladas.com
Submission	Request for Discovery Conference
Filer's Name	Ralph H. Cathcart
Filer's e-mail	rcathcart@ladas.com,rroa@ladas.com,mmercado@ladas.com
Signature	/Ralph H. Cathcart/
Date	08/20/2013
Attachments	8-20-2013 Letter to Interlocutory Attorney Christen English - T H K Photo Products.pdf(616991 bytes)

LADAS & PARRY LLP
INTELLECTUAL PROPERTY LAW

Ralph H. Cathcart rcathcart@ladas.com
212.708.1920

1040 Avenue of the Americas ▪ New York, New York 10018-3738
P 212.708.1800 ▪ F 212.246.8959 ▪ F 212.246.8925 ▪ nymail@ladas.com ▪ www.ladas.com

August 20, 2013

VIA E-MAIL and ESTTA

Christen M. English, Esq.
Interlocutory Attorney
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

E-mail: christen.english@uspto.gov

Re: Intercast Europe S.r.l. v. T H K Photo Products, Inc. – Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Ms. English:

We represent Opposer in the above-referenced opposition proceeding.

Counsel for Opposer and Applicant conducted a Discovery/Settlement Conference on July 31, 2013.

During the conference, Opposer noted that many of Applicant's Affirmative Defenses were seemingly groundless and should be withdrawn. Applicant disagreed, so both parties expressed their willingness to conference with the assigned Interlocutory Attorney on the issue so the conference could be concluded.

Attached hereto as Exhibit A is a copy of our letter to Applicant's counsel reiterating the basis and subject matter for the proposed conference with you.

Kindly let us know your availability to set up the conference. I am available September 3, 5 - 6 or September 10 - 13 between 10:00 a.m. and Noon (EDT) or 2:00 p.m. – 5:00 p.m. (EDT)

I am copying Applicant's attorney on this communication so she can indicate her availability.

We look forward to hearing from you.

Respectfully submitted,

Ralph H. Cathcart
Attorney for Opposer

RHC/rmr
Enclosures

cc: **VIA E-MAIL and FEDEX**
Katherine M. Hoffman, Esq. E-mail: KHoffman@MckennaLong.com

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **LETTER TO INTERLOCUTORY ATTORNEY CHRISTEN M. ENGLISH, ESQ.** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated below:

Dated: August 20, 2013

Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **LETTER TO INTERLOCUTORY ATTORNEY CHRISTEN M. ENGLISH, ESQ.** was served by FEDEX overnight courier, postage prepaid, to the following person:

Katherine M. Hoffman, Esq.
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com

Dated: August 20, 2013

Reinaldo M. Roa

EXHIBIT A

LADAS & PARRY LLP
INTELLECTUAL PROPERTY LAW

Ralph H. Cathcart

rcathcart@ladas.com
212.708.1920

1040 Avenue of the Americas • New York, New York 10018-3738
P 212.708.1800 • F 212.246.8959 • F 212.246.8925 • nymail@ladas.com • www.ladas.com

August 14, 2013

VIA E-MAIL
Katherine M. Hoffman, Esq. E-mail: KHoffman@MckennaLong.com
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Re: Intercast Europe S.r.l. v. T H K Photo Products, Inc.- 91/210,772 (Our Ref: C13650025)

Dear Ms. Hoffman:

As per our discussion on July 31, 2013 during the Discovery/Settlement Conference mandated by the Board's Institution Order, we are following up on the open issue relating to our joint stated willingness to confer with the assigned Interlocutory Attorney regarding the propriety of your client's Affirmative Defenses in order to narrow the issues.

Kindly let us know whether your client will voluntarily withdraw its Affirmative Defenses for the reasons discussed or if we should conclude the Discovery/Settlement Conference by scheduling a telephonic conference with the assigned Interlocutory Attorney.

To avoid any doubt, following are our comments regarding Applicant's unnumbered "Affirmative Defenses":

Applicant's Affirmative Defenses

Paragraph 7: Applicant claims that Opposer has failed to sufficiently state a claim upon which relief can be granted and to establish its standing in the present opposition. Failure to sate a claim and lack of standing is not an affirmative defense. *See, e.g., Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738, n. 7 (TTAB 2001). Further, Opposer is the owner of prior common law rights and incontestable registrations for NXT and your client seeks registration for the identical NXT mark for closely related products. Thus, Opposer has 1) "a real interest in the proceeding and 2) a reasonable basis for believing that it will suffer damage if the mark is registered. *Ritchie v. Simpson*, 170 F.2d 1092, 1094 (Fed. Cir. 1999). Kindly confirm that your client will withdraw this alleged affirmative defense.

Paragraph 8: Applicant asserts as an affirmative defense that "Opposer as [*sic*] failed to state sufficient grounds for maintaining an opposition and prevent registration of Applicant's mark". *See* response to affirmative defense at paragraph 7. This again implicates Opposer's standing.

Paragraph 10: Applicant alleges as an affirmative defense that Opposer has never owned any enforceable rights in NXT marks, because such rights have been abandoned. Plainly, this Affirmative Defense is improper and Opposer's registrations cannot be attacked by way of Affirmative Defense. Please confirm that your client will withdraw this affirmative defense. *See* also TBMP § 313.

Paragraph 11: Applicant's alleges as an affirmative defense that "Opposer's requested relief should be denied because Opposer has failed to use the NXT mark in interstate commerce". This Affirmative Defense must be stricken as Opposer is the owner of several NXT trademarks, including incontestable NXT trademarks, and has filed affidavits of use in support thereof.

Paragraph 12: Applicant asserts a "laches and/or acquiescence" affirmative defense. The Affirmative Defense of laches and acquiescence are not available in opposition proceedings. *See, e.g.*, *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 U.S.P.Q.2d 1424, 1432 (Fed. Cir. 1991); *Bausch & Lomb, Inc. v. Karl Starz GmbH & Co. KG*, 87 U.S.P.Q.2d 1526, 1531 (TTAB 2008); and *Barbara's Bakery Inc. v. Lindeman*, 82 U.S.P.Q.2d 1283, 1292, n.14 (TTAB 2007) (Defenses of laches, acquiescence or estoppel generally not available in opposition proceeding).

Your prompt response is required failing which we will contact the Interlocutory Attorney to schedule a conference.

Very truly yours,

Ralph H. Cathcart

RHC/rmr