

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

RK/am

Mailed: January 29, 2014

Opposition No. **91212948**

Albaugh, Inc.

v.

Tateho Kagaku Kogyo Kabushiki
Kaisha dba Tateho Chemical
Industries Co., Ltd.

Yong Oh (Richard) Kim, Interlocutory Attorney:

On December 23, 2013, applicant filed a proposed amendment to its application Serial No. 79119877, with opposer's written consent. On January 6, 2014, opposer filed, with applicant's written consent, a withdrawal of the opposition without prejudice.

By the proposed amendment, applicant seeks to change the identification of goods in International Class 1 as follows (deleted terms in bold type):

From: Chemicals and chemical materials used in industry, science and agriculture, namely, magnesium hydroxide, magnesium oxide, magnesium carbonate, calcium hydroxide, calcium oxide, calcium carbonate, zirconium oxide, calcium sulfite, calcium peroxide, silicon carbide, silicon nitride, all in powder form for use as additives for plastics, sintering additives for ceramics, raw materials for ceramics, additives for heavy oil, additives for paints, raw

materials for surface treatment agents for insulating film-forming on magnetic steel sheets and additives for pigments; chemicals used in deposition, namely, chemical source material for the deposition of thin films; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials for industrial use in powder, particle, and granular form for use as additives for plastics, sintering additives for ceramics, raw materials for ceramics, additives for heavy oil, additives for paints, raw materials for surface treatment agents for insulating film-forming on magnetic steel sheets and additives for pigments; adhesives, not for stationery or household purposes; **plant growth regulating preparations;** in International Class 1.

To: Chemicals and chemical materials used in industry, science and agriculture, namely, magnesium hydroxide, magnesium oxide, magnesium carbonate, calcium hydroxide, calcium oxide, calcium carbonate, zirconium oxide, calcium sulfite, calcium peroxide, silicon carbide, silicon nitride, all in powder form for use as additives for plastics, sintering additives for ceramics, raw materials for ceramics, additives for heavy oil, additives for paints, raw materials for surface treatment agents for insulating film-forming on magnetic steel sheets and additives for pigments; chemicals used in deposition, namely, chemical source material for the deposition of thin films; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials for industrial use in powder, particle, and granular form for use as additives for plastics, sintering

additives for ceramics, raw materials for ceramics, additives for heavy oil, additives for paints, raw materials for surface treatment agents for insulating film-forming on magnetic steel sheets and additives for pigments; adhesives, not for stationery or household purposes; in International Class 1.

While the proposed amendment is acceptable on its face, it cannot be approved inasmuch as the involved application is also the subject of Opposition No. 91212447, wherein the opposer is Mag Instrument, Inc., and the consent of that opposer has not been made of record. See *Vaughn Russell Candy Co. and Toymax Inc. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998). When a request to amend an application that is also the subject of other *inter partes* proceedings is filed, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved. Trademark Rule 2.133(a) and TBMP § 514.02 (2013).

In view thereof, proceedings herein are **SUSPENDED until March 3, 2014**, to allow applicant time to obtain and submit the consent of all opposers to the involved application. Otherwise, this opposition will go forward on the application as published in accordance with the following schedule as reset:¹

Proceedings Resume

3/4/2014

¹ As opposer's motion to withdraw is presumably contingent upon entry of applicant's prior-filed amendment, consideration thereof is presently deferred. Should proceedings resume, the motion will be given no further consideration.

Time to Answer	3/24/2014
Deadline for Discovery Conference	4/23/2014
Discovery Opens	4/23/2014
Initial Disclosures Due	5/23/2014
Expert Disclosures Due	9/20/2014
Discovery Closes	10/20/2014
Plaintiff's Pretrial Disclosures Due	12/4/2014
Plaintiff's 30-day Trial Period Ends	1/18/2015
Defendant's Pretrial Disclosures Due	2/2/2015
Defendant's 30-day Trial Period Ends	3/19/2015
Plaintiff's Rebuttal Disclosures Due	4/3/2015
Plaintiff's 15-day Rebuttal Period Ends	5/3/2015

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 taking of testimony. Trademark Rule 2.125.

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

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