

ESTTA Tracking number: **ESTTA590402**

Filing date: **03/03/2014**

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

Proceeding	91212948
Party	Defendant Tateho Kagaku Kogyo Kabushiki Kaisha dba Tateho Chemical Industries Co., Ltd.
Correspondence Address	MARK D ALLEMAN ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP 806 SW BROADWAY , SUITE 600 PORTLAND, OR 97205-3335 UNITED STATES alleman@ahmrt.com, harnett@ahmrt.com, gladwin@ahmrt.com
Submission	Motion to Amend Application
Filer's Name	Mark D. Alleman
Filer's e-mail	alleman@ahmrt.com, harnett@ahmrt.com, gladwin@ahmrt.com
Signature	/Mark D. Alleman/
Date	03/03/2014
Attachments	Consent of Mag Instrument, Inc. to Request to Amend Application (as filed), 3-03-2014.pdf(272635 bytes ) EXHIBIT A_Request to Amend Application with Consent (as filed), 12-23-13.pdf(509735 bytes ) EXHIBIT B_Withdrawal of Opposition with Consent (as filed), 1-06-2014.pdf(408086 bytes ) EXHIBIT C_TTAB Order Suspending Opposition, 1-29-2014.pdf(530865 bytes )

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

Mag Instrument, Inc. )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 Tateho Kagaku Kogyo Kabushiki Kaisha )  
 )  
 Applicant. )  
 \_\_\_\_\_ )

Opposition No. 91212447  
Mark: MAGSTAR  
Serial No. 79/119,877

Albaugh, Inc. )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 Tateho Kagaku Kogyo Kabushiki Kaisha )  
 )  
 Applicant. )  
 \_\_\_\_\_ )

Opposition No. 91212948  
Mark: MAGSTAR  
Serial No. 79/119,877

Commissioner for Trademarks  
TTAB  
P.O. Box 1451  
Alexandria, VA 22313-1451

**CONSENT OF MAG INSTRUMENT, INC. TO REQUEST TO AMEND APPLICATION**

Applicant Tateho Kagaku Kogyo Kabushiki Kaisha has obtained the consent of Opposer Mag Instrument, Inc. by its signature below to the amendment of the subject application, deleting "plant growth regulating preparations" from the goods identification in class 001. The circumstances for submitting this consent are explained as follows.

1. Two oppositions are currently pending against Trademark App. Serial No. 79/119,877 for the mark MAGSTAR, including Opposition No. 91212948, as well as Opposition No. 91212447.

2. On Dec. 23, 2013, Applicant Tateho Kagaku Kogyo Kabushiki Kaisha and Opposer in Opposition No. 91212948, Albaugh, Inc., submitted a Request to Amend Application With Consent, a copy of which is attached as Exhibit A. The amendment requested deletion of "plant growth regulating preparations" from the goods identification in class 001. Following submission of this requested amendment, Opposer Albaugh, Inc. submitted a withdrawal of Opposition No. 91212948 on January 6, 2014, which is attached as Exhibit B.

3. On January 29, 2014, since the consent of all Opposers in all co-pending oppositions is required to amend the subject application, the U.S. Trademark Trial and Appeal Board issued an order suspending Opposition No. 91212948 until March 3, 2014, to allow Applicant time to obtain and submit consent of Opposer Mag Instrument, Inc. in co-pending Opposition No. 91212447, a copy of which is attached as Exhibit C.

4. In view of the above, Applicant Mag Instruments, Inc. now consents to the Request to Amend Application With Consent filed December 23, 2013 (Exhibit A), which amends the goods identification as follows.

Amended description of the goods in International Class 001:

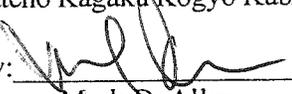
Chemicals and chemical materials used in industry, science and agriculture, namely, magnesium hydroxide, magnesium oxide, magnesium carbonate, calcium hydroxide, calcium oxide, calcium carbonate, zirconium oxide, calcium sulfite, calcium peroxide, silicon carbide, silicon nitride, all in powder form 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~~

9. Pursuant to TBMP § 514.02, Applicant respectfully requests that the above amendments be made to the Application.

Respectfully Submitted,

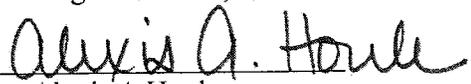
Tateho Kagaku Kogyo Kabushiki Kaisha

By: 

Mark D. Alleman  
Attorney for Applicant  
Alleman Hall McCoy Russell & Tuttle LLP  
806 S.W. Broadway, Suite 600  
Portland, Oregon 97205  
Tel.: (503) 459-4141  
Fax: (503) 459-4142

With consent by:

Mag Instrument, Inc.

By: 

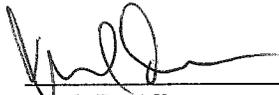
Alexis A Houle  
Attorney for Opposer  
555 South Flower Street, 50<sup>th</sup> Floor  
Los Angeles, CA 90071  
Tel.: (213) 243-2653

Date: March 3, 2014

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing CONSENT TO REQUEST TO AMEND APPLICATION was served by First Class Mail upon Opposer's Attorney, Alexis A Houle, 555 South Flower Street, 50th Floor, Los Angeles, CA 90071, United States and Albaugh's Attorney, Adam W. Jones, 1525 NE 36th Street, Ankeny, Iowa 50021, United States.

on March 3, 2014.



Mark D. Alleman

Date: March 3, 2014

**EXHIBIT A**

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

Albaugh, Inc.	)	
	)	Opposition No. 91212948
Opposer,	)	
	)	Mark: MAGSTAR
v.	)	
	)	Serial No. 79/119,877
Tateho Kagaku Kogyo Kabushiki Kaisha	)	
	)	
Applicant.	)	

Commissioner for Trademarks  
TTAB  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REQUEST TO AMEND APPLICATION WITH CONSENT**

Now comes Applicant, Tateho Kagaku Kogyo Kabushiki Kaisha (“Applicant”), by and through its undersigned counsel, for its Request to Amend the Instant Application, and Opposer, Albaugh, Inc. (“Opposer”) by and through its counsel, being in agreement and consenting to the below, states:

1. Opposer timely filed the subject opposition against Applicant’s mark MAGSTAR for the following goods in International Class 01:

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

## EXHIBIT A

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

2. In the interim, the parties have agreed to settle Opposer's opposition to Applicant's application, pending Board approval to certain amendments to the description of goods in the Application.

3. Specifically, Applicant requests to delete the following goods from International Class 001: "plant growth regulating preparations." The proposed amended description of goods is as follows:

Amended description of the goods in International Class 001:

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,

**EXHIBIT A**

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—~~

4. Pursuant to TBMP § 514.02, Applicant respectfully requests that the above amendments be made to the Application.

Respectfully Submitted,

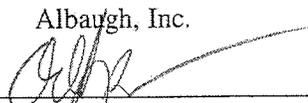
Tateho Kagaku Kogyo Kabushiki Kaisha

By: 

Mark D. Alleman  
Attorney for Applicant  
Alleman Hall McCoy Russell & Tuttle LLP  
806 S.W. Broadway, Suite 600  
Portland, Oregon 97205  
Tel.: (503) 459-4141  
Fax: (503) 459-4142

With consent by:

Albaugh, Inc.

By: 

Adam W. Jones  
Attorney for Opposer  
1525 NE 36<sup>th</sup> Street  
Ankeny, Iowa 50021  
Tel.: (515) 242-2400  
Fax: (515) 242-2448

Date: Dec. 23, 2013

**EXHIBIT A**

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REQUEST TO AMEND APPLICATION WITH CONSENT was served by First Class Mail upon Opposer's Attorney, Adam W. Jones, 1525 NE 36th Street, Ankeny, Iowa 50021, United States on Dec. 23, 2013.



\_\_\_\_\_  
Mark D. Alleman

Date: Dec. 23, 2013

ESTTA Tracking number: **ESTTA580176**

Filing date: **01/06/2014**

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

Proceeding	91212948
Party	Plaintiff Albaugh, Inc.
Correspondence Address	ADAM W JONES ALBAUGH INC 1525 NE 36TH STREET ANKENY, IA 50021 UNITED STATES adamj@albaughinc.com
Submission	Withdrawal of Opposition
Filer's Name	Adam W. Jones
Filer's e-mail	adamj@albaughinc.com
Signature	/adam jones/
Date	01/06/2014
Attachments	Withdrawal of Opposition with Consent - executed- 2013-12-30.pdf(867684 bytes )

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

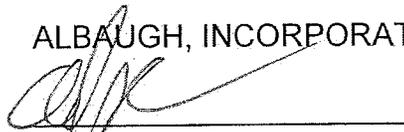
ALBAUGH, INC.  Opposer,  v.  TATEHO KAGAKU KOGYO KABUSHIKI KAISHA  Applicant,	Opposition No.: 91212948  Mark: MAGSTAR  Serial No. 79/119,877
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WITHDRAWAL OF OPPOSITION WITH CONSENT

Pursuant to Trademark Rule 2.106(c), and with the written consent of Applicant, TATEHO KAGAKU KOGYO KABUSHIKI KAISHA, through its attorney, Opposer, ALBAUGH, INC., withdraws, without prejudice, Opposition No. 91212948 regarding the mark MAGSTAR.

Respectfully submitted,

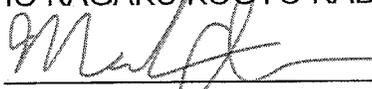
ALBAUGH, INCORPORATED



Adam W. Jones  
Attorney for Opposer  
1525 NE 36<sup>th</sup> Street  
Ankeny, Iowa 50021  
Tel.: (515) 965-5267  
Fax: (515) 964-9444

Date: December 30, 2013

TATEHO KAGAKU KOGYO KABUSHIKI KAISHA

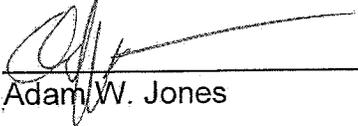


Mark D. Alleman  
Attorney for Applicant  
Alleman Hall McCoy Russell & Tuttle LLP  
806 S.W. Broadway, Suite 600  
Portland, Oregon 97205  
Tel.: (503) 459-4141  
Fax: (503) 459-4142

Date: December 30, 2013

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing WITHDRAWAL OF OPPOSITION WITH CONSENT was served by First Class Mail upon Opposer's Attorney, Mark D. Alleman, Alleman Hall McCoy Russell & Tuttle LLP, 806 S.W. Broadway, Suite 600, Portland, Oregon 97205, United States, on January 6, 2014.

  
\_\_\_\_\_  
Adam W. Jones

Date: January 6, 2014

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:<sup>1</sup>

Proceedings Resume

3/4/2014

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<sup>1</sup> 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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