

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

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Mailed: February 2, 2015

Opposition No. 91216180
(PARENT CASE)

Opposition No. 91216453

Sun Mark Ltd

v.

Cereales Y Pastas, S.A. De C.V.

(as consolidated)

Before Bucher, Lykos and Gorowitz.
Administrative Trademark Judges.

By the Board:

Signatory Authority on Opposer's Brief in Opposition to Motion to Dismiss

In Opposition No. 91216180, the Board issued an order on October 7, 2014 requiring Opposer to file either documentary evidence that the signatory to its June 30, 2014 brief, "Sanjay Raphael, Head of Legal Affairs," is entitled to practice before the USPTO in trademark cases and to represent Opposer in these proceedings, or a new copy of said brief signed by Opposer or by an authorized representative who is entitled to practice before the USPTO in trademark cases. In response, Opposer filed a second copy of its brief signed by "Harmeet Ahuja, Director."

Pursuant to Patent and Trademark Rule 11.14(e)(3), Harmeet Ahuja, as Director of Opposer, is recognized as an officer of Opposer, and as an individual authorized to represent it in these proceedings. In view thereof, the Board gives consideration to Opposer's brief filed October 23, 2014.¹

Applicant's Motions to Dismiss for Ineffective Service

Background

Opposer filed Opposition No. 91216180 on May 2, 2014 against three applications, discussed below. Opposer had filed requests for extensions of time to file an opposition ("request for extension") in all three applications as follows:

- 1) In Application Serial No. 85831237, Opposer filed a 30-day request for extension, and a 60-day request for extension in which it selected as good cause "The potential opposer is engaged in settlement discussions with applicant." Through the Board's ESTTA system, both requests were granted, and Opposer's time to oppose was extended to May 7, 2014.
- 2) In Application Serial No. 85859929, Opposer filed a 30-day request for extension, and filed a 60-day request for extension in which it selected as good cause "The potential opposer is engaged in settlement discussions with applicant." Through the Board's ESTTA system, both requests were granted, and Opposer's time to oppose was extended to May 7, 2014. (Opposer filed another 60-day request for extension, which the Board denied for failure to demonstrate extraordinary circumstances.)

¹ Although Patent and Trademark Rule 11.14 permits any entity to represent itself, it is strongly advisable for persons who are not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. Thus, the Board advises opposer to secure legal counsel. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. See *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006), *aff'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007).

- 3) In Application Serial No. 85859938, Opposer filed a 30-day request for extension, and a 60-day request for extension in which it selected as good cause “The potential opposer is engaged in settlement discussions with applicant.” Through the Board’s ESTTA system, both requests were granted, and Opposer’s time to oppose was extended to May 7, 2014.

Opposer filed Opposition No. 91216453 on May 20, 2014. In opposed application Serial No. 85901343, Opposer had filed a 30-day request for extension, and a 60-day request for extension in which it selected as good cause “The potential opposer is engaged in settlement discussions with applicant.” Through the Board’s ESTTA system, both requests were granted and Opposer’s time to oppose was extended to May 21, 2014.²

The records of the opposed applications reflect that when Opposer filed the notices of opposition, Applicant’s counsel of record was H. David Starr, of the firm of Nath, Goldberg & Meyer; Mr. Starr remains Applicant’s counsel of record. The record also reflects that, 1) in filing each notice of opposition, Opposer completed the “Certificate of Service” section of the ESTTA filing form indicating that the notice of opposition was “served upon all parties, at their address (of) record by

² To the extent that Applicant seeks dismissal of both oppositions for lack of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1), on the basis that the 60-day requests for extension of time to oppose were improperly granted, the motion is denied. Inasmuch as the record reflects that Opposer had communicated with Applicant regarding trademark filings in Spain and Australia prior to and near the time Opposer filed the requests for extension, we find that there was a sufficient basis for Opposer to assert that it had good cause for the requested extensions. The record does not support Applicant’s argument that Opposer “falsely represented” that it had been in settlement discussions with Applicant, or that Opposer “acted in bad faith and for improper purpose.” (Applicant’s brief, p. 5)

First Class Mail on this date,”³ and 2) on May 21, 2014, Opposer sent to Applicant, by courier, two letters, each including a copy of the respective notice of opposition, addressed to applicant as follows:

Cereales Y Pastas, S.A. DE C.V.
Col. Ciudad Industrial Celaya Avenida Mexico
Japon No. 400-A
Celaya Guanajuato
38010
Mexico.

In lieu of filing an answer, Applicant filed a motion to dismiss in both oppositions on the basis of ineffective service pursuant to Fed. R. Civ. P. 12(b)(5).

Authorities

The requirements for the filing of a notice of opposition are set forth in Trademark Rules 2.101(a) and (b), which read, in pertinent part (emphasis added):

- (a) An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. *The notice must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.101(b) and 2.119.*
- (b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board and must serve a copy of the opposition, including any exhibits, *on*

³ If a plaintiff files its complaint through the Board’s ESTTA online filing system, it cannot complete the process unless it confirms that it has forwarded a service copy of its complaint to all parties at their addresses of record. Such confirmation then appears on the ESTTA generated filing form for the attached complaint, and the filing form is considered part of the plaintiff’s initial pleading. Therefore, any plaintiff who files through ESTTA is viewed by the Board as having included proof of service with its pleading. Actual forwarding of the service copy, however, is the responsibility of the filer, as the ESTTA system does not effect service for the filer. *See Schott AG v Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008).

the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office.

(emphasis added). *See also* TBMP § 211.02 (2014).

The Board has recognized that there is a distinction between a complete lack of actual service and defective but curable actual service, and has allowed an opposition to move forward where an opposer, upon learning of its error in service, moved promptly to cure by sending a copy of the notice of opposition to applicant's attorney. *See Chocoladefabriken Lindt & Sprungli AG v. Flores*, 91 USPQ2d 1698, 1700 (TTAB 2009).

Responses Required from Opposer

In its motion and supporting declaration⁴ of Jorge Israel de Leon Martinez, its Chief Marketing Officer, Applicant states that it received the two May 21, 2014 letters with copies of the respective notices of opposition (Martinez decl., para. 13, Exh. B and C). Applicant also submitted the declaration of its counsel (Donahue decl.), who does not state whether, and if so when, Applicant's attorney of record received from Opposer a service copy of the notice of opposition.

In its brief, Opposer responds with respect to the service issue as follows:

With regard to the service of the Notice of Opposition to the agent on record, the Opposers sent a copy of the Notice of Opposition directly to the Applicant as the Opposer had already contacted them in relation to issues in Spain and Australia. It was hoped that on seeing the Notice of

⁴ For the purpose of ascertaining and clarifying the record to determine the instant motion, the Board considers the materials submitted outside the pleadings.

Opposition, the Applicant might be interested in engaging in discussions relating to reaching a settlement on the possible opposition. However, although the opposition proceedings have been suspended, the Opposer is sending to the agent on record a copy of the Notice of Opposition. (Opposer's brief, p. 5)

On the present record, Opposer does not affirmatively state whether, and if so, upon whom and on what date, it served the notice of opposition on Applicant's attorney of record, Mr. Starr, at the attorney's correspondence address of record. Accordingly, the record is not clear with respect to what action, if any, Opposer took, during the time allowed to oppose, as extended, to cure the deficiency in service.

To clarify the record, Opposer is allowed until twenty (20) days from the mailing date of this order in which to file herein documentary evidence, if any, with respect to both oppositions, indicating whether and when Opposer served each of the notices of opposition on Applicant's attorney of record as required by Trademark Rules 2.101(a) and (b) within the time allowed, in each respective opposition, to file a notice of opposition, as extended (*see Musical Directions v. McHugh*, 104 USPQ2d 1157, 1160 (TTAB 2012)), failing which the opposition will be dismissed.

In its motion, Applicant also questions whether "Ms. Aneta Lenicka" - the individual who signed the requests for extension of time to oppose on behalf of Opposer - was properly authorized to sign the requests on behalf of Opposer. Opposer responds that Ms. Lenicka "is a member of the in-house legal team for (Opposer) and she is duly authorized to file oppositions and motions on behalf of

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the company” (Opposer’s brief, p. 5). Because the record does not clearly indicate whether Ms. Lenicka is a person entitled to represent Opposer under Patent and Trademark Rules 11.1 or 11.14, Opposer is allowed the same twenty (20) days from the mailing date of this order in which to submit *either* documentary evidence that Ms. Lenicka is entitled to represent Opposer in these Board proceedings, *or* properly-signed copies of each of the requests for extension of time which were previously signed by Ms. Lenicka, failing which the opposition or oppositions may be dismissed. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905 (TTAB 2014).

Proceedings otherwise remain suspended.