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

Proceeding	91216180
Party	Plaintiff Sun Mark Ltd
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Nos. 85831237, 85859929, 85859938

and,

In the Matter of Application No. 85901343

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SUN MARK LTD.

Opposer,

v.

CEREALES Y PASTAS, S.A. De C.V.

Applicant

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OPPOSITION NO. 91216180  
(PARENT CASE)

and,

OPPOSITION NO. 91216453

**RESPONSE TO THE APPLICANT’S MOTION TO DISMISS FOR LACK OF SUBJECT MATTER  
JURISDICTION**

The Applicant through its attorneys requested the Board in their Letter dated 10<sup>th</sup> June 2014 to dismiss the Notices of Oppositions which were filed by the Opposer against their trade mark applications.

The Opposer hereby denies the Applicant’s accusations that “Opposer made repeated and incurable material misrepresentations to the Board in seeking extensions of time to file oppositions concerning the existence of purported settlement negotiations.”

According to ***Trademark Act § 13(a), 15 U.S.C. § 1063(a)*** any person who believes that would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would likely to cause dilution by blurring or dilution by tarnishment under section 1125 (c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. **Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director** (emphasis added).

It appears that the Applicant has misunderstood the intention of The Opposer in their requests for an extension of time, erroneously believing that the intention of the Opposer is to engage in delay tactics and to delay the registration of the applications, which cannot be further from the truth.

It is the Opposer's general policy with potentially conflicting trademarks to attempt to reach an amicable solution, e.g. co-existence or settlement agreement. This can be clearly seen from the Opposer's Letter of Concern for Spain and Australia with the genuine intention at the time of requesting the extension of time to seek to discuss any possible proposal should the Applicant wish to do so, but which they chose not to reach out to the Opposer.

The chronology of the matters speaks volume as to the intention of the Opposer and the knowledge that the Applicant had in relation to the US applications and indeed their applications worldwide and the potential to engage in contentious proceedings with the Opposer in other jurisdictions.

The chronology is as follows:

1. The Applicant filed the first US application in January 2013, presumably having done some due diligence and searching prior to filing the application. It should have or would have been aware of the Opposer's earlier mark in relation to breakfast cereals in particular.
2. In about October or November 2013 the Opposer became aware of the Applicant's applications in Australia and Spain and the Opposer subsequently sent a Letter of Concern to the proprietor of the marks informing them of our concern but offering an opportunity to perhaps resolve the matter amicably.
3. In December 2013, having not heard from the Applicant and in order to maintain their position, but by no means unwilling to reach a settlement on the matter the Opposer filed opposition notices in Australia and Spain.
4. In January 2014 the US application nos. 858831237, 85859929 and 8589938 were published with an opposition deadline of February. The Opposer requested a thirty day extension of time on the grounds that it would give the Applicant an opportunity to perhaps come forward and attempt to resolve the matter given that oppositions had now been filed in Australia and Spain. They did not.
5. 11 March 2014 the Opposer received notification from the Australian trade mark office that the Applicant had withdrawn their application without contesting the opposition and the opposition proceedings came to a close.
6. On 25 March 2014 the Applicant did not reply to the opposition in Spain and subsequently the Spanish trade mark office declared that the Applicant's application should be cancelled

The above sequence of events indicates the Applicant's own behaviour and indeed awareness of the Opposer and the earlier marks it is likely to contend with.

Therefore, when the first request for extension of time to file a notice of opposition was filed, the Applicant knew as early as February and in view of the trade mark opposition matters pending in Australia and Spain, who the Opposer is and that a Letter of Concern (albeit for Spain and Australia) included a statement informing the Applicant that the Opposer was willing to open dialogue for reaching a settlement and without the need to engage in litigation where possible.

The manner in which the Applicant has attempted to show the USPTO how the Opposer has attempted to mislead the Registry suggests that the Opposer was purposefully engaged in delaying the application. However, the sequence of filing the notices of extensions cannot be inferred as an attempt to engage in delay tactics. In fact, the Opposer has no value in delaying such proceedings given that they had confidence in being successful in these proceedings.

The Opposer filed three separate requests for extensions of time for 30 days, initially against Serial Nos. 85831237, 85859929 and 85859938 on 5 February 2014. A 60 days request was made on 7 February 2014 against 85831237, whilst against 85859929 and 85859938 a request was filed on 7 March 2014. As the marks were published on or around the first week of February and given that there were pending proceedings in Spain and Australia, the Opposer believed that the Applicant seeing the extension of time request would note that a third opposition is likely to be filed and therefore had an opportunity to seek to establish a line of communication in line with the Opposer's early communication. The Applicant did not.

Given that the 85831237, 85859929 and 85859938 were all published at the same time and all the same opposition deadlines, the Opposer states that there has effectively been only one attempt at extending the time period to respond for each of the individual trade mark applications. As the matters have now been deemed to be consolidated, therefore, the Opposer believes that only one extension of time request overall should be taken into consideration. The Opposer, in looking at a worldwide view of the trade mark applications by the Applicant filed the request for a further 60 days with consideration to the ongoing proceedings in other jurisdictions – especially in Spain - where depending on the decision, the Opposer would determine whether further dialogue would be required in order to reach a settlement agreement.

In accordance with Section 211.01 the Applicant is required to respond to a request for an extension of time "promptly". Although, this is not defined, the Opposer does not believe that the Applicant's complaint is indeed sufficiently prompt considering that the first 60 day request for an extension of time was made for 85831237 on 7 February 2014, yet the Applicant's complaint of this request of the extension of time and motion to dismiss was not lodged until 10<sup>th</sup> June 2014. The Opposer does not believe that this is a prompt response as meant by Section 211.01.

Furthermore, the 60 day extension of time request for 85859929 and 85859938 was requested on 7 March 2014 and again the Applicant has waited until 10 June 2014 to file a motion to dismiss, a period of almost three months. The Opposer suggests that the Applicant had an opportunity to attack the request for extension of time as early as 7 February 2014. The Applicant had the opportunity to ask the Board to reconsider the decision but failed to take this step in the first place.

The Applicant attempts to rely on TBMP §211.02 and in particular the case *Central Mfg. Inc v Third Millenium Tech Inc.*, 61 USPQ 2d 1210, 1215 (TTAB 2001). However, the Opposer is able to

distinguish this current matter from the cited case as in that case, the Opposer firstly did not respond to or submit any defence and so the decision could only be made upon the Applicant's submissions. In addition, the Court found that the Opposer was intentionally harassing the Applicant to withdraw or make a payment and was deemed to have filed the requests for extensions by way of abusing the system. The Opposer in that case had also previously been found to have acted in a similar manner and had established a pattern of behaviour thus adding to the concern that the judge had regarding the good cause to request those extensions.

The Opposer in the current case has previously brought proceedings at the USPTO and has never acted in bad faith in those previous proceedings. The Opposer has not forced the Applicant to capitulate but rather given the Applicant ample opportunity to attempt a resolution which may have been suitable for all parties concerned. By the Applicant's own admission, they summarily ignored the attempts of the Opposer to open dialogue, yet how is the Opposer expected to know the intention of the Applicant through its silence. Had the Applicant acknowledged the letter and or stated its intention not to engage in discussions with the Opposer, the Opposer would have maintained their position. The "false representation" as labelled by Applicant appears to have an element of deceit which must be shown by the Opposer. In fact, the Opposer has done nothing more than attempt to reach out to the Applicant and has had the honest belief and intention to resolve these matters in the USA without going to trial if it can be avoided. The Opposer was also very mindful of the other proceedings worldwide and including in particular Spain and Australia.

The Opposer is also rather interested as to why the applicant did not raise an issue to the requests for extension of time at the time that were granted. Surely, this should have been appropriate response and step to take.

The Opposer does not believe that the requests for the extension of time had any adverse effect on the Applicant, and the Opposer had genuine reasons or beliefs that dialogue could be engaged in.

This was particularly the case from a wider international perspective, given that the Opposer had pending oppositions in Spain and Australia. Despite the Applicant stating otherwise, proceedings in Spain had officially commenced. The fact that the Applicant did not respond to those allegations does not negate that an official decision was handed down in favour of the Opposer.

The Opposer was also waiting to determine whether the Applicant would attempt to appeal the decision in Spain hence the request for an extension of time to oppose upon extraordinary circumstances.

The fact that no evidence of dialogue or attempted communication in relation to the intention to file the Notice of Opposition in relation to the US application is available does not automatically infer bad faith on the part of the Opposer or that the Opposer was intentionally trying to mislead the Board. Had there been such a bad faith intention, the Opposer could have chosen any other option for good cause to request the extension of time. Given that the Opposer is self-represented, it could have chosen the option for additional time to seek counsel to represent the Opposer. This could have been the bad faith misrepresentation. However, the Opposer has always had an intention to resolve contentious matters amicably where possible.

However, the Opposer does not believe that it has acted in bad faith or has caused the Applicant further distress by requesting the extensions of time. The Applicant states that four requests were made, however, the Opposer rejects that argument as the extensions of time were made against each of the applications of which three have the same opposition deadlines. Given that these oppositions have now been consolidated, the Board is respectfully asked to view the requests as one request or alternatively one request for each individual opposition and not collectively as the Applicant wishes to falsely demonstrate to the Board.

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 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.

On a separate matter, kindly note Ms Aneta Lenicka is a member of the in-house legal team for Sun Mark Ltd and she is duly authorised to file oppositions and motions on behalf of the company.

Therefore, the Opposer requests that the Board dismiss the Applicant's motion and allow the opposition to proceed as initiated.

Respectfully submitted

Sun Mark Ltd



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Sanjay Raphael

Head of Legal Affairs

On behalf of Opposer

30 June 2014

## CERTIFICATE OF SERVICE

This is to certify that I am on this date serving a copy of the within and foregoing upon the Applicant by depositing a true and correct copy of same in an envelope to be delivered by courier, addressed as follows:

H DAVID STARR  
NATH, GOLDBERG & MEYER  
112 S WEST ST  
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USA



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Date: June 30, 2014

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