

TTAB

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

Colliers International Property
Consultants, an unincorporated
association,

Petitioner,

v.

Colliers International Property
Consultants USA, Inc., a Delaware
corporation,

Respondent.

Cancellation No. 92025322
Registration No. 1,652,602
Mark: DESIGN



06-01-2004
U.S. Patent & TMO/c/TIA Mail Rpt D: #??

CERTIFICATE OF MAILING

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Assistant Commissioner for Trademarks, 2900 Crystal
Drive, Arlington, VA 22202-3513, on May 27, 2004.

THELEN REID & PRIEST LLP

Date: May 27, 2004

By:

Becky L. Troutman

Name: Becky Troutman

**PETITIONER'S BRIEF IN RESPONSE TO RESPONDENT'S
MOTION TO DISMISS FOR PETITIONER'S FAILURE TO PROSECUTE**

1. Relief Requested.

On May 13, 2004 Respondent filed a Motion to Dismiss for Petitioner's Failure to Prosecute. For the reasons stated herein, Petitioner does not oppose dismissal of this action without prejudice for lack of prosecution. Alternatively, on April 29, 2004, Petitioner moved that the Board dismiss this cancellation with prejudice on grounds that the Board lacks jurisdiction to determine the breach of contract issues necessary to decide who is the current lawful owner of the mark and the registration.

2. Factual Background.

Petitioner is an unincorporated association of independently owned member companies offering real estate brokerage and consulting services throughout the world under the same brand. Respondent is a member of the association.

The application for the subject registration was filed August 10, 1990. At that time, the association and its members were parties to a 1983 Affiliation Agreement addressing ownership of and members' rights to use the subject DESIGN mark and other marks. Subsequently, the members entered into a 1994 Affiliation Agreement addressing the same issues.

The subject registration issued July 30, 1991 and this petition for cancellation was filed July 29, 1996.

Subsequently, a third 1996 Affiliation was entered into, and that agreement remains effective and binding at this time.

In the 1994 Affiliation Agreement and the 1996 Affiliation Agreement each member, including Respondent, promised to hold any trademark registrations they may own for the benefit of all the members and to transfer ownership of trademark registrations to Colliers International Property Consultants, Inc. ("CIPC"), a Delaware corporation that is owned by the members of Colliers. CIPC licenses back to the members the use of the trademarks in their respective territories.

At the time Petitioner filed its petition for cancellation, Respondent had not yet transferred any of its trademark registrations to CIPC because, Petitioner believes, certain other members also had not yet transferred trademark registrations to CIPC. Petitioner believed in good faith that the Board had jurisdiction over this matter with respect to Respondent's right to register the subject trademark.

Since that time, Petitioner and its members, including Respondent, have been engaged in lengthy and complex discussions and negotiations to try to restructure the Colliers affiliation, including issues pertaining to international trademark rights and obligations under the 1996 Affiliation Agreement.

Timely prosecution and resolution of this cancellation proceeding has been affected by these ongoing attempts at resolving these organizational and contractual differences and worldwide trademark ownership issues.

Until recently, the parties cooperated to accommodate these ongoing delays by extending deadlines in this proceeding in the hope that the internal differences and this proceeding could be amicably resolved. Unfortunately, resolution of the association's internal differences has not occurred.

At this time, based on further review of the parties' contractual obligations and the association's internal disputes, Petitioner believes that resolution of this proceeding would require determination of issues involving contract rights and duties by the Board.

3. The Board Does Not Have Jurisdiction to Enforce a Contract or Determine Breach of Contract Claims.

"The Board is empowered to determine only the right to register. The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition." Trademark Trial and Appeal Board Rules of Practice, 102.01. The Board does not have jurisdiction to enforce a contract or determine breach of contract claims. *See Vaughn Russell Candy Co. and Toymax Inc. v. Cookies in Bloom, Inc.*, 47 U.S.P.Q.2D 1635, 1638 n.6 (TTAB 1998) ("While it does not lie within the jurisdiction of the Board to enforce the contract between the parties, agreements to cease use of a mark or to not use a mark in a certain format are routinely upheld and enforced.").

4. Conclusion.

Given these recent developments, Petitioner does not oppose dismissal of this action without prejudice for lack of prosecution. Alternatively, Petitioner moved in its April 29, 2004

Motion to Dismiss for Lack of Jurisdiction that the Board dismiss this cancellation with prejudice on grounds that the Board lacks jurisdiction to determine the breach of contract issues necessary to decide who is the current lawful owner of the mark and the registration.

Respectfully Submitted,

THELEN REID & PRIEST, LLP

Dated: May 27, 2004

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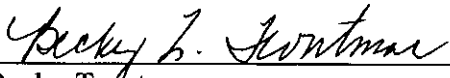
CERTIFICATE OF SERVICE

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail in an envelope, addressed to:

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Deposited on May 27, 2004 at San Francisco, CA.

Date: May 27, 2004



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