

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

In the Registration of

Registrant: COMPGEEKS.COM

Registration No.: 2,499,396

Mark: COMPGEEKS.COM

Computer Geeks, Inc.,

Petitioner,

v.

COMPGEEKS.COM,

Respondent.

Cancellation No.: 92046567

PETITIONER'S RESPONSE IN OPPOSITION TO RESPONDENT'S
MOTION TO ACCEPT LATE-FILED ANSWER

This is the Response of Petitioner to the Respondent's document entitled "Motion to Accept Late-Filed Answer" in this case. Petitioner's Declaration of Jane Shay Wald in Opposition to Respondent's Motion to Accept Late Filed Motion is attached hereto as Exhibit A.

Respondent did not timely Answer the Petition to Cancel. Respondent makes the point in its Motion and the Declaration of outside counsel John C. Wilson that on November 3, 2006, Petitioner's counsel, the undersigned, told Respondent she had filed a

Petition to Cancel the registration (being the subject hereof). That same day, Respondent looked on line and did not see it. Wilson Dec., Para. 2. (It was filed by mail).

“Accordingly, Respondent awaited receipt of the Board’s correspondence transmitting the Petition for Cancellation and related notice of relevant dates.” (Wilson Dec., Para. 2.)

Mr. Wilson checked again (after his initial investigation of November 3, 2006) on December 14, 2006 after the deadline to Answer. (Wilson Dec., Para. 4). Although Mr. Wilson knew from speaking with Petitioner’s counsel that the Petition had been filed, he apparently did not mention this to in-house counsel, Gregory Hansen, Esq., who has sworn he knew nothing of it until December 14, 2006 and that it was not routed to his attention at his company. (Hansen Dec., Paras. 2 and 4).

In an effort to show that Respondent’s outside counsel was too busy to remember about the Petition to Cancel that had come to its attention as described, Respondent’s Motion details the activities of these same parties in the co-pending Opposition over the months of November and December 2006 in Respondent’s (unsuccessful) Motion in the U.S. District Court in San Diego to quash the deposition of a witness.

Mr. Hansen is general counsel of the Respondent and has “overall responsibility for all legal matters for Respondent, including trademark matters.” (Hansen Dec., Para. 1). Moreover, this was not a case in which in-house counsel sat back and waited for reports from outside counsel. Mr. Hansen attended both depositions in the co-pending Opposition. (Wald Dec., Para. 3). It seems unlikely that he was not told of the conversation about the Petition on November 3, 2006, and that, in turn, he did not alert his staff to bring him the Petition when it was served upon his company by the PTO.

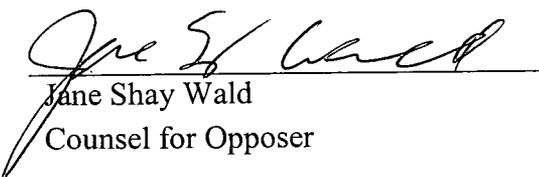
Respondent also implies that there was an offer and acceptance relating to a proposal by which the Petition could be withdrawn. On December 15, 2006, counsel for Petitioner asked counsel for respondent to "give some thought" to a proposal under which the Petitioner would be willing to withdraw the Petition. Counsel discussed this, but Petitioner withdrew the proposal prior to acceptance by Respondent. Nor has Respondent performed any acts consistent with a meeting of the minds regarding the proposal, such as withdrawing certain defenses in the co-pending Opposition. (Wald Dec., Para. 2)

Subject to the Board's discretion, Petitioner respectfully requests the entry of default.

Respectfully submitted,

IRELL & MANELLA LLP

Dated: January 23, 2007

By: 
Jane Shay Wald
Counsel for Opposer

1800 Avenue of the Stars, Suite 900
Los Angeles, California 90067
Ph.: (310) 277-1010
Fax: (310) 203-7199

EXHIBIT A

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Petitioner,

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COMPGEEKS.COM,

Respondent.

Cancellation No.: 92046567

DECLARATION OF JANE SHAY WALD IN OPPOSITION TO
RESPONDENT'S MOTION TO ACCEPT LATE-FILED ANSWER

I, Jane Shay Wald, do declare as follows:

1. I am an attorney with the law firm of Irell & Manella LLP. I represent Petitioner Computer Geeks, Inc. in the above-referenced cancellation proceedings. Except where stated on information and belief, I have personal knowledge of the facts stated herein and could and would competently testify thereto if called as a witness.

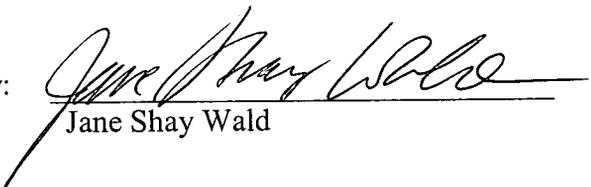
2. On December 15, 2006, I asked John C. Wilson, Esq., counsel for Respondent to "give some thought" to a proposal under which I would be willing to

withdraw the Petition to Cancel. It pertained to Respondent withdrawing certain defenses in a co-pending Consolidated Opposition No. 91167886. I am aware of no acceptance by Mr. Wilson or any other counsel for Respondent before I withdrew the proposal. Nor has Mr. Wilson or any other counsel performed any acts consistent with an understanding that the proposal had been agreed to, such as withdrawing certain defenses in the co-pending Consolidated Opposition, No. 91167886.

3. In-house counsel for Respondent, Gregory Hansen, whose Declaration is of record in these proceedings, attended both depositions in the co-pending Consolidated Opposition, No. 91167886.

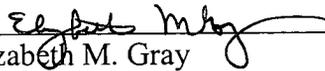
I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on January 23, 2007 in Los Angeles, California.

By:


Jane Shay Wald

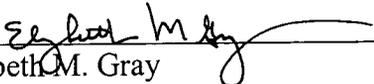
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PETITIONER'S RESPONSE IN OPPOSITION TO RESPONDENT'S MOTION TO ACCEPT LATE-FILED ANSWER** was served this 23rd day of January, 2007, by first-class mail, postage prepaid upon Counsel for Applicant, addressed as follows: John C. Wilson, Heller Ehrman L.L.P., 4350 La Jolla Village Drive, San Diego, CA 92122-1246

By: 
Elizabeth M. Gray

CERTIFICATE OF MAILING

I hereby certify that the foregoing document is being deposited this 23rd day of January, 2007 with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

By: 
Elizabeth M. Gray

Petition to Cancel the registration (being the subject hereof). That same day, Respondent looked on line and did not see it. Wilson Dec., Para. 2. (It was filed by mail).

“Accordingly, Respondent awaited receipt of the Board’s correspondence transmitting the Petition for Cancellation and related notice of relevant dates.” (Wilson Dec., Para. 2.)

Mr. Wilson checked again (after his initial investigation of November 3, 2006) on December 14, 2006 after the deadline to Answer. (Wilson Dec., Para. 4). Although Mr. Wilson knew from speaking with Petitioner’s counsel that the Petition had been filed, he apparently did not mention this to in-house counsel, Gregory Hansen, Esq., who has sworn he knew nothing of it until December 14, 2006 and that it was not routed to his attention at his company. (Hansen Dec., Paras. 2 and 4).

In an effort to show that Respondent’s outside counsel was too busy to remember about the Petition to Cancel that had come to its attention as described, Respondent’s Motion details the activities of these same parties in the co-pending Opposition over the months of November and December 2006 in Respondent’s (unsuccessful) Motion in the U.S. District Court in San Diego to quash the deposition of a witness.

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Respondent also implies that there was an offer and acceptance relating to a proposal by which the Petition could be withdrawn. On December 15, 2006, counsel for Petitioner asked counsel for respondent to "give some thought" to a proposal under which the Petitioner would be willing to withdraw the Petition. Counsel discussed this, but Petitioner withdrew the proposal prior to acceptance by Respondent. Nor has Respondent performed any acts consistent with a meeting of the minds regarding the proposal, such as withdrawing certain defenses in the co-pending Opposition. (Wald Dec., Para. 2)

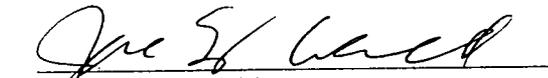
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IRELL & MANELLA LLP

Dated: January 23, 2007

By:


Jane Shay Wald
Counsel for Opposer

1800 Avenue of the Stars, Suite 900
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3. In-house counsel for Respondent, Gregory Hansen, whose Declaration is of record in these proceedings, attended both depositions in the co-pending Consolidated Opposition, No. 91167886.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on January 23, 2007 in Los Angeles, California.

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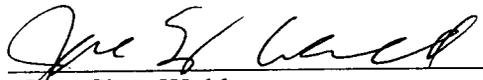
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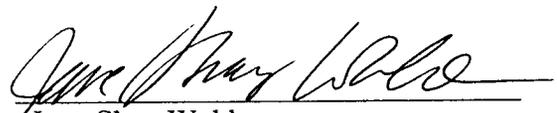
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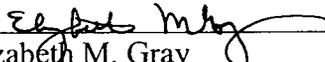
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Jane Shay Wald

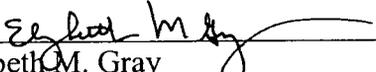
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