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

Proceeding	92056169
Party	Plaintiff HarperCollins Publishers, LLC
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Submission	Opposition/Response to Motion
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Date	12/05/2012
Attachments	CANCELLATION NO 92056169 - OPPOSITION TO MOTION TO SUSPEND.pdf (3 pages)(81751 bytes)

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

11 HARPERCOLLINS PUBLISHERS LLC,

12 Petitioner,

13 v.

14 JASON P. BARNES,

15 Respondent.

Petition for Cancellation No. 92056169

Claimed Mark: CARNIVAL OF SOULS

Registration No. 3,921,658

**OPPOSITION TO RESPONDENT'S
MOTION TO SUSPEND FOR CIVIL
ACTION**

16 Petitioner HarperCollins Publishers LLC hereby opposes Respondent Jason P. Barnes'
17 Motion to Suspend for Civil Action (the "Motion").

18 Petitioner initially observes that it was never served with the Motion (or with Respondent's
19 Answer in this proceeding). The "Certificate of Service" attached to both the Motion and the
20 Answer states that the documents were "served by the TTAB ESTTA system." This assertion is
21 clearly incorrect. First, service "by the TTAB ESTTA system" is not an authorized method of
22 service under 37 CFR § 2.119(b). *See* TTAB Manual of Procedure § 113.04. Perhaps more to the
23 point, the TTAB ESTTA system does *not* transmit a copy of a party's filing to the other parties or
24 their counsel of record (a fact confirmed by the TTAB help line). As a result, neither Petitioner nor
25 its counsel were aware of the filing of the Motion (or the Answer) until Petitioner's counsel
26 unilaterally checked the status of this matter through TTABVUE on November 29, 2012. The
27 Motion and the Answer should be stricken due to Respondent's failure to properly serve those
28 documents.

1 To the extent the Board considers the Motion, it should be denied. The determination
2 whether to suspend a cancellation proceeding in light of pending litigation is “solely within the
3 discretion of the Board.” TTAB Manual of Procedure § 510.02(a). In the litigation, Respondent is
4 relying upon the above-referenced registration as prima facie evidence of the validity of his claimed
5 trademark. In light of the specialized knowledge and expertise of the Board respecting issues of
6 registrability, it is likely that the district court will defer to the determination of the Board regarding
7 the validity of Respondent’s claimed mark. Moreover, cancellation of the registration would clearly
8 and directly impact both Respondent’s standing to bring certain of his claims and the evidentiary
9 weight to be accorded his claimed mark in connection with other of his claims, such that
10 determination of the validity of Respondent’s registration should be considered by the Board in the
11 first instance.

12 Petitioner therefore respectfully requests that the Board deny the Motion.

13 Dated: December 5, 2012

Respectfully submitted,

14 SIDLEY AUSTIN LLP

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16 By: /s/ Rollin A. Ransom

17 Rollin A. Ransom

18 Attorneys for HARPER COLLINS
19 PUBLISHERS LLC
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