TTAB

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

02 DEC 17 AM 9:30

In the matter of Application Serial No. 76/024,587

NEW BALANCE ATHLETIC SHOE, INC.,
Opposer,

v.

H. John Campaign,
Applicant.

Opposition No. 91122,837

[redacted]

BOX TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

12-09-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #78

Certificate of First Class Mailing (37 CFR 1.8(a))

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date set forth below.

December 4, 2002
Date of Signature and of Mail Deposit

By: Thomas V. Smurzynski
Thomas V. Smurzynski
Reg. No. 24,798
Attorney for Opposer

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

This is Opposer's opposition to Applicant's "Motion to Dismiss," filed and served on November 27, 2002. The "Motion to Dismiss" is procedurally and substantively defective.

Applicant's Motion is Defective Under Rule 2.132(a) or Rule 2.132(b)

Applicant's Motion to Dismiss states that it is filed in accordance with Rule 2.132(a) of the Trademark Rules of Practice. That rule allows a motion to dismiss in the event that "the time

4116.

for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony or offered any other evidence" (emphasis added). Applicant acknowledges that Opposer, during its testimony period filed (a) copies of Opposer's registrations (in support of allegations of likelihood of confusion in the Notice of Opposition) and (b) responses by Applicant to Opposer's First Set of Interrogatories (in support of allegations of lack of a bona fide intention to use the mark by Applicant, also in the Notice of Opposition). Thus, while Opposer has not taken testimony, it has offered evidence. Rule 2.132(a) is therefore not applicable as a basis for a motion to dismiss.

Applicant's last paragraph in its motion asks for dismissal on the ground that "upon the law and the facts Opposer has shown no right to relief." That appears to be a reference to Rule 2.132(b). However, according to that rule such a motion may only be made in the event that "no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff" (emphasis added). In this proceeding, Opposer has offered other evidence besides copies of Patent and Trademark Office records. It has offered Applicant's Responses to Opposer's Interrogatories. Rule 2.132(b) is therefore not applicable as a basis for a motion to dismiss.

Applicant's Motion to Dismiss Appears
To be a Motion for Summary Judgment
That is Incomplete and Untimely

Applicant's Brief in support of its Motion to Dismiss goes on to argue that the facts revealed by Applicant's Responses to Opposer's Interrogatories do not support a finding in favor of Opposer. As such, the motion to dismiss could be considered as a motion for summary judgment. As a motion for summary judgment it fails on two grounds.

One ground is that it is directed to only one of the two bases for the Notice of Opposition, which included an allegation of likelihood of confusion as well as lack of a bona fide intent to use by Applicant. Applicant simply does not address the issue of likelihood of confusion in his brief.

The second ground is that it is too late. A motion for summary judgment should be filed prior to the commencement of the first testimony period, according to Rule 2.127(e)(1).

According to the rule, the Trademark Trial and Appeal Board may deny as untimely any motion for summary judgment filed thereafter. There is ample justification for denying this apparent motion for summary judgment as untimely. Applicant appears to be doing nothing more than trying to hurry the proceedings by demanding judgment before the regularly scheduled briefing schedule is concluded following the testimony periods.

Applicant's Motion to Dismiss
Should be Denied on the Law and Facts

If the Board should not deny the motion to dismiss on procedural grounds (acknowledging that it only goes to one of the two bases in the Notice of Opposition), it should deny it on substantive grounds.

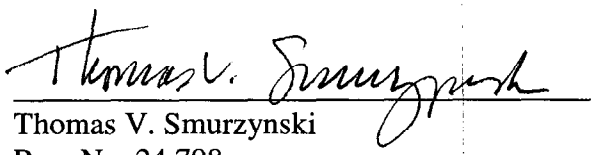
The Trademark Law (15 U.S.C. §1051(b)) requires that a person applying to register a trademark based on intent to use it have "a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce."

In contrast to this requirement, Applicant, a trademark attorney, has no past or present experience in the manufacture or sale of footwear, the subject of the application (Response to Interrogatory No. 3). There are no parties that are, or were, a "related company" of Applicant (Response to Interrogatory No. 4). The Applicant's only basis for asserting a bona fide intent to use the mark is his "long lasting love affair with the name 'FLEXIBLE FLYERS' and a belief that it will be a most appropriate trademark for footwear, particularly basketball shoes" (Response to Interrogatory No. 1). The Applicant's only basis for asserting an intention to license the mark is to say that "Provided that registration of 'FLEXIBLE FLYERS' could be obtained for such goods, applicant had every intention in the world of contacting a manufacturer of footwear for the purpose of manufacturing the goods and/or using the trademark "FLEXIBLE FLYERS' thereon" (Response to Interrogatory No. 2).

What these facts and stated intentions show is that Applicant filed a speculative application to register a mark that he hoped would survive examination and the opposition period, whereupon he would shop the mark around (using the euphemism, "offering to license it"). This activity is precisely the kind of activity that the framers of the intent-to-use provisions

of the trademark law wanted to prohibit by requiring a "bona fide" intent to use the mark, rather than an intent to stockpile the mark and traffic in it, as Applicant proposes to do. There is a sound basis in law and fact for rejecting Applicant's Motion to Dismiss.

Respectfully submitted,

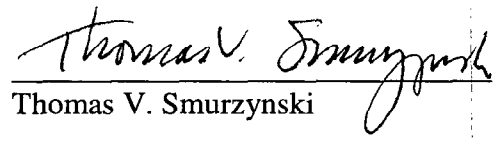


Thomas V. Smurzynski
Reg. No. 24,798
Attorney for Opposer
LAHIVE & COCKFIELD, LLP
28 State Street
Boston, MA 02109
(617) 227-7400

Dated: December 4, 2002

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS was served by first-class mail, postage prepaid, on Applicant, H. John Campaign, Esq., The Bar Building, 36 West 44th Street, New York, NY, 10036, on this 4th day of December, 2002.



Thomas V. Smurzynski