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

In the Matter of Application Serial No. 76/127,629
For the Mark EMAGINE

TELIGENT, INC.,

Opposer,

v.

EMAGINE, GMBH LLC,

Applicant.



Opposition No. 125,854

11-12-2002
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**MOTION FOR RECONSIDERATION OF THE
BOARD'S ORDER OF OCTOBER 10, 2002**

Opposer, Teligent, Inc., pursuant to 37 CFR 2.129(c) and TBMP § 544, submits this Motion for Reconsideration of the Trademark Trial and Appeal Board's Order of October 10, 2002, ruling that Opposer's Notice of Opposition against EMAGINE, Serial No. 76/127,629, is untimely, and dismissing the Notice as a nullity. As grounds for supporting this Motion, Opposer states as follows:

Applicant Emagine, GmbH LLC, filed an application for the mark EMAGINE, Serial No. 76/127,629, on September 13, 2000, on the basis of Section 44(e). The mark was originally published for opposition in the *Official Gazette* on August 28, 2001, even though the Applicant had not yet submitted a certified copy of its foreign registration. On September 10, 2001, during the second week of the opposition period, the Patent and Trademark Office ("PTO") mailed a letter of suspension to the Applicant, thereby removing the application from publication prior to the expiration of the statutory thirty-day opposition period. 15 U.S.C. 1063(a); 37 C.F.R. 2.101(c); TBMP § 307.01. The Examiner suspended the application pending receipt of the foreign registration. See Exhibit 1 (Suspension letter dated September 10, 2001).

On September 27, 2001, the Applicant filed a communication with the PTO, wherein it enclosed a certified copy of its foreign registration. In addition, the Applicant made the following statement: "Since the application was published on the basis of the Applicant's ownership of a home country registration, it is believed that the application may now be forwarded for issuance of the registration certificate without re-publication." See Exhibit 2, (Communication from Applicant dated September 27, 2001). Applicant did not explain the legal basis for cutting short the statutory thirty-day opposition period, and there is no provision in the statute or applicable rules to support such a request. Nevertheless, pursuant to a conversation between Applicant's counsel and Mr. Tom Lamone, managing attorney, regarding this issue, the Applicant apparently convinced the PTO that its application could be registered without undergoing the statutory thirty-day opposition period. See Exhibit 2. A registration issued for this mark on January 8, 2002.¹

During the period of time between when the application was placed on suspension in September 2001, until late December 2001, Opposer diligently monitored the status of the EMAGINE application, which remained on suspension for most of this time. The online PTO records reflected the following during this period: "CURRENT STATUS: An office action suspending further action on the application has been mailed. DATE OF STATUS: 2001-09-10." See Exhibit 3 (Online PTO records printed October 26, 2001). The first indication of a change in the above status occurred on November 27, 2001. The online PTO records at that time stated: "CURRENT STATUS: Application has been published for opposition. DATE OF STATUS: 2001-11-27." See Exhibit 4 (Online PTO records printed December 26, 2001).

¹

It is worthy of note that Applicant was well aware of Opposer's EMAGINE trademark during the application process for Applicant, because counsel for the parties had communicated with each other several times regarding a dispute over the parties' respective rights to the trademark in Germany and the United States. As a result, Applicant had good reason to be concerned that its application might be opposed if it were properly published for opposition.

Opposer reasonably understood this change in status to mean that Applicant's application had finally been republished on November 27, 2001. On December 27, 2001, within thirty days from that point, Opposer submitted its notice of opposition against Applicant's mark. Opposer subsequently learned, however, that Applicant's mark was granted registration on January 8, 2002.

Given the fact that Applicant's mark had been registered before Opposer was given the opportunity to oppose it, Opposer contacted Mr. Lamone, the managing attorney who Applicant had persuaded to waive the opposition period requirement. Mr. Lamone advised the Opposer that the matter would be forwarded to the Commissioner, so that the registration could be canceled as "inadvertently issued," and restored to its application status.

On April 25, 2002, the registration for EMAGINE, Serial No. 76/127,629 was cancelled, and the matter was returned to pending application status. Opposer again diligently monitored this mark, to ensure that it would not miss the new opposition period. On July 16, 2002, the application was published for a second time. Opposer contacted various representatives of the PTO to determine whether it would be necessary or appropriate to resubmit its opposition papers. Opposer was told that there was no need to do this, because the PTO would use Opposer's earlier submitted opposition for filing purposes. On August 14, 2002, a paralegal for Opposer spoke to Ms. Kay Ron Seldon Diggs, the lead legal assistant at the TTAB, who assured Opposer that its Notice of Opposition submitted on December 27, 2001, would be accepted and recognized as filed for purposes of the second opposition period. See Exhibit 5 (Contemporaneous notes taken by Chad Netherton, KMZR paralegal). Opposer had no reason to question the statement of Ms. Diggs, because its opposition papers had not been returned to Opposer in the seven months since they had been submitted, nor had the opposition fee ever been refunded, as is required whenever an opposition is treated as being prematurely filed or filed late in time. See TBMP §§ 307.03 and 307.04.

Consistent with Ms. Diggs' assurances that the opposition already submitted by Opposer would be accepted by the Board for the new opposition period, the Board mailed its scheduling order on August 29, 2002, stating: "A notice of opposition to the registration against the above-identified application has been filed." (emphasis added). Thus, the Board once again confirmed that Opposer's Notice of Opposition had been accepted for filing purposes during the new opposition proceeding. No prejudice was suffered by Applicant as the result of the Board exercising its discretion to treat a document that was already in its files as now being "filed" for purpose of instituting an opposition proceeding. And this was certainly appropriate given the improper waiver of the original opposition period at the urging of Applicant.

Following issuance of the scheduling order, the present proceeding was instituted, on September 3, 2002. In lieu of filing an answer to the Notice of Opposition, Applicant filed a Motion for Suspension of Time to Answer the Opposition, on October 8, 2002. In this Motion, the Applicant argued that, as related to the original opposition period, the Opposer "was required to have either filed an opposition or filed a request to extend time to oppose by September 27, 2001." However, based on the procedural history of the application for this mark, any attempts by Opposer to file an opposition or extension request by September 27, 2001 would have been futile given that all action on the application was suspended. Opposer had no recourse but to wait until the mark was again published for opposition.²

In the Board's Order of October 10, 2002, on which Opposer here seeks reconsideration, the Board concludes that with regard to the first opposition period Opposer's Notice of Opposition was filed "well after the thirty-day opposition period and is late...." This conclusion is inconsistent with the fact that the first opposition period was cut short, and never resumed

² In Applicant's Motion, it acknowledges that the original publication date was in error. This admission does not square with Applicant's request to the PTO in late September 2001 that the application be allowed to proceed directly to registration. This admission also flies in the face of Applicant's argument that Opposer should have filed an opposition or extension of time request by September 27, 2001, because Applicant is aware that no opposition period existed at that time.

prior to the inadvertent registration of the mark in January 2002. Thus, there was no thirty-day opposition period.

With regard to the second opposition period, the Board finds that Opposer's "notice of opposition is prematurely filed in that it was filed prior to the July 16, 2002 republication of the mark." The Board relies on TBMP § 307.03 to support its position that any opposition "filed" prior to the beginning of the opposition period will be deemed premature and rejected by the Board.

Opposer's opposition was not "filed" prematurely given the very unusual procedural history of this case, and the facts as highlighted above, including: (1) the erroneous cut-off of the first opposition period; (2) the granting of Applicant's request that republication of this application be waived; (3) the November 27, 2001 PTO status report which indicated that the mark had been republished for opposition beginning on that date; (4) the cancellation of the inadvertent registration for this mark due to an incomplete opposition period; (5) the Board's decision to not reject Opposer's first submission as a filing, but instead hold it in the Board's files; (6) the republication of this mark in July 2002; and (7) Opposer's good faith reliance on the Board's lead legal assistant responsible for instituting proceedings, who assured Opposer that the December 2001 opposition would be accepted and recognized by the PTO during the second opposition period.

For all of the above reasons, Opposer respectfully asserts that it did "file" its Notice of Opposition in a timely manner. In short, the December 2001 submission was never formally "filed" with the Board given the procedural posture of this case. It was, instead, held by the Board until the republication period opened, at which time, it was deemed by the Board to be "filed."

Amid all the mishaps and unusual procedural history for this EMAGINE mark, Opposer has kept but one goal in mind--to oppose it. Opposer is the owner of several EMAGINE marks

and its rights will be jeopardized by the registration of Applicant's EMAGINE mark for very similar services. Under the Lanham Act, Opposer is entitled to the opportunity to oppose the registration of that mark, and it should not be required to revert to a cancellation proceeding simply because that might be easier for all who have been involved with the mishandling of Applicant's application.

FOR THE FOREGOING REASONS, Opposer respectfully requests that its opposition be REINSTATED.

TELIGENT, INC.

Dated: November 12, 2002

By: 

One of its Attorneys
Roger P. Furey, Esq.
Sylvia D. Davis, Esq.

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CERTIFICATE OF HAND DELIVERY

I hereby certify that the foregoing Motion for Reconsideration of the Board's Order of October 10, 2002 (original and two copies) regarding Opposition No. 125,854 for the mark EMAGINE was hand-delivered to the following address, this 12th day of November, 2002.

Box TTAB – NO FEE
Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513



SYLVIA DENISE DAVIS

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Motion For Reconsideration Of The Board's Order Of October 10, 2002** regarding Opposition No. 125,854 was served on:

J. Allison Strickland, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
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Attorney for Applicant, via first-class mail, postage prepaid, this 12th day of November, 2002.



SYLVIA DENISE DAVIS