

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: January 22, 2003

Opposition No. 91125854

TELIGENT, INC.

v.

EMAGINE, GMBH LLC

Before Hanak, Hohein and Holtzman Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's motion for reconsideration of the Board's order of October 10, 2002 dismissing the notice of opposition as untimely.

In support of its motion, opposer argues that the conclusion that its notice of opposition was "late" with regard to the first opposition period is "inconsistent with the fact that the first opposition period was cut short and never resumed"; that with regard to the second opposition period, "opposer's opposition was not "filed" prematurely" given: "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 not to reject opposer's first submission [of the notice of opposition filed on December 27, 2001] as a filing but instead hold it in the Board's file; 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 [orally] assured opposer that the December 2001 opposition would be accepted and recognized by the PTO during the second opposition period."

Motions for reconsideration, as set forth in Trademark Rule 2.127(b), provide an opportunity for a party to point out any error the Board may have made in considering the matter initially. It is not to be a reargument of the points presented in its original motion nor may it be used to introduce additional evidence.

Upon careful consideration of opposer's arguments on reconsideration, we are not persuaded that there was any error in its finding that opposer's notice of opposition was untimely.

The time for filing a notice of opposition to the registration of a mark is governed by Section 13(a) of the Trademark Act, 15 U.S.C. §1063(a), which provides, in relevant part, as follows: Any person who believes that he

would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, *within thirty days after the publication* under subsection (a) of section 12 of this Act of the mark sought to be registered...." (emphasis added). See also Trademark Rule 2.101(c). The requirements for filing an opposition are statutory and cannot be waived. *In re Cooper* 209 USPQ 6770 (Comm'r 1980).

In this case, application Serial No. 76/127,629 was published for opposition on August 28, 2001 but jurisdiction was subsequently restored to the Examining Attorney during the thirty-day opposition period because the mark had been improperly approved for publication prior to receipt of a certified copy of the foreign registration. See TMEP Section 1002.02. After some missteps by the Office¹, notice of publication was issued on June 26, 2002 and the mark was republished on July 16, 2002, as required under Office practice, in order to afford potential opposers a full opposition period. See TBMP Section 307.06.

¹ After receipt of the certified copy of the foreign registration, the Office, in error, allowed the mark to register without republication of the mark. This resulted in the inadvertent issuance of the registration on January 8, 2002. After recognizing the error, the Office restored the application to pendency on April 25, 2002.

If opposer had filed its notice of opposition during the first opposition period prior to restoration of jurisdiction to the examining attorney, its filing of the notice of opposition would have been timely. See TBMP Section 307.06. However, opposer did not file the notice of opposition until December 27, 2001, well after the first opposition period. Therefore, opposer's notice of opposition was late with respect to the first opposition period and should have been returned to opposer by the Office.²

While it was not unreasonable for opposer to assume the Office records it accessed regarding the status of applicant's application were accurate, it was opposer's responsibility to confirm the republication date of the mark by reviewing the Official Gazette if there was any discrepancy in the Office's records. Opposer has submitted a copy of an Office record it printed on December 26, 2001 from the Office's TARR WEB SERVER which indicated the current status of applicant's mark as "application has been published for opposition" as of "2001-11-27" but also submitted a copy of an Office record it printed on December 26, 2001 from the Office's Trademark Electronic Search

² After the filing of the untimely notice of opposition, the Board, in error, did not promptly advise opposer that the notice was untimely nor did it return the notice to opposer and refund its fee. See TBMP Section 307.03.

System ("TESS") which states something entirely different-- that applicant's mark was "published for opposition on August 28, 2001." At the very least, the discrepancy between the two Office records should have raised a question in opposer's attorney's mind so that he should have checked the Official Gazette to determine if applicant's mark had, in fact, been republished on November 27, 2001. Further inquiry (by reviewing the Official Gazette for that date) would have revealed that the mark was not republished in the November 27, 2001 Official Gazette. In any event, the only question at issue is whether opposer timely filed its notice of opposition after the mark was actually republished in the Official Gazette.

With regard to the second opposition period, opposer's December 27, 2001 notice of opposition was filed prematurely since the mark was republished on July 16, 2002.

After republication of the involved mark³, a notice of opposition would have been timely if opposer had filed such with the Office between July 16, 2002 and August 15, 2002. Thus, a timely notice of opposition would have to have been received by the Office no earlier than July 16, 2002 and no

³ With respect to the actual republication of the mark, opposer was clearly on notice as opposer indicates that "it contacted various representatives of the PTO to determine whether it would be necessary or appropriate to resubmit its opposition papers" after the July 16, 2002 republication of the mark in the Official Gazette.

later than August 15, 2002. Opposer was aware of the July 16, 2002 republication date of the mark but stated in its request for reconsideration that it failed to refile its notice of opposition during the second opposition period based upon reliance on a telephone conversation with a Board employee.⁴ Opposer's reliance on oral representations by a Board employee is misplaced.⁵ See Patent and Trademark Rule 1.2⁶ (made applicable by Trademark Rule 2.1); see e.g., *In re Investigacion Y Desarrollo de Cosméticos S.A.* 19 USPQ2d 1717 (Comm'r Pats. 1991). Moreover, opposer's failure to timely file a notice of opposition during the thirty-day opposition period cannot be remedied since the requirement that opposer file a notice of opposition within thirty days of the publication of the mark is statutory, and the Board has no authority to waive it. See *In Re Cooper*, supra.

The record before us clearly supports a finding that opposer's notice of opposition filed on December 27, 2001

⁴ Opposer states that it was "assured [by the Board employee] that its notice of opposition submitted on December 27, 2001, would be accepted and recognized as filed for purposes of the second opposition period."

⁵ Further, opposer's attorney's reliance upon a telephone inquiry was misplaced since, as a registered attorney, he is presumed either to know the provisions of the rules or at the least to be able to obtain and interpret those rules. *In re Sivertz, et al.*, 227 USPQ 255 (Comm'r Pats. 1985).

⁶ Patent and Trademark Rule 1.2 clearly states that "no attention will be paid to any alleged oral promise, stipulation or understanding in relation to which there is disagreement or doubt."

was premature as to the second opposition period and that opposer missed the time to file an opposition. As stated in the prior Board order, opposer's only remedy is to file a petition for cancellation after issuance of the registration.⁷

In view thereof, opposer's request for reconsideration is denied.

⁷ The mark has since registered on December 31, 2002 as Registration No. 2,667,831.