

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

IN THE MATTER OF APPLICATION:

Serial No.: 78/095,659  
Mark: SQRAT  
Applicant: Ivy Silberstein  
Published in the  
Official Gazette: December 17, 2002

FOX ENTERTAINMENT GROUP, INC. and  
TWENTIETH CENTURY FOX FILM CORP.,

Opposers,

v.

IVY SILBERSTEIN,


Applicant.

Opposition No. 91156138

**APPLICANT'S RESPONSE TO REPORT OF OPPOSERS**

Applicant in the above-captioned proceeding, Ivy Silberstein, Inc., by her attorneys, hereby responds to the Report of Opposers dated September 7, 2007 ("Report") as follows:

1. On or about September 7, 2007, Opposers filed the Report, requesting grant of judgment in their favor in view of the decision of the United States District Court for

  
**10-11-2007**

the Southern District of New York dated July 19, 2004<sup>1</sup> and of the Court of Appeals for the Second Circuit dated June 14, 2007.<sup>2</sup>

2. Opposers argue that the Trademark trial and Appeal Board ("Board") should enter judgment in favor of Opposers because the District Court had dismissed Applicant's claims against Opposers on the ground that Applicant had made no use of the mark in commerce so as to bring the matter within the purview of the Lanham Act. Report at ¶ 2.

3. This argument is misplaced because the District Court's decision is not dispositive of the instant matter. The instant matter is based upon a mark that is intended to be used in commerce. Therefore, the District Court's finding that the Applicant had not used the mark in commerce provides no basis for sustaining the instant Opposition and entering judgment in Opposers' favor.

4. In another pending Opposition proceeding between the same parties for a related mark, the Opposers raised the exact same argument and sought entry of judgment in their favor on the basis of the District Court's opinion cited above. *Fox Entertainment Group, Inc. et al. v. Ivy Silberstein*, Opposition No. 91157532. In an Order dated September 25, 2007, the Board denied the requested relief, holding,

Upon review, the Board finds that the court's order is not determinative of this proceeding. In granting opposer's motion for summary judgment on the ground of trademark infringement, the district court found that applicant did not have a protectible interest in its mark because the mark is not yet in use, and the United States Court of Appeals for the Second Circuit affirmed the district court's decision on the same basis. Inasmuch as the

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<sup>1</sup> This decision was rendered in the matter of *Ivy Silberstein, d/b/a Ivy Supersonic v. Fox Entertainment Group, Inc. et al.*, No. 02 Civ. 1131 (RJH), 2004 WL 1620895 (S.D.N.Y. July 19, 2004).

<sup>2</sup> This decision was rendered in the matter of *Ivy Silberstein, d/b/a Ivy Supersonic v. John Does 1-10, et al.*, No. 04-4401-CV, 2007 WL 1725506 (2d Cir. June 14, 2007).

opposed application is based on applicant's allegation of a bona fide intent to use the mark in commerce, the findings of the court do not provide a basis for dismissal or entry of judgment in this proceeding. The parties to this proceeding therefore request that the Honorable Board reset the discovery and testimony deadlines for good cause shown herein.

A copy of the Order of the Board dated September 25, 2007 is appended hereto at Exhibit A. In that case, the Board ordered that the Opposition proceedings move forward and set a schedule therefore. Applicant respectfully adopts the reasoning of the Board in that case for the instant matter.

5. In view of the foregoing, Applicant respectfully requests that the Board deny entry of judgment and permit the parties to proceed with the instant Opposition.

Respectfully submitted,



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David A. Einhorn  
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New York, New York 10020-1182  
Telephone: (212) 278-1000

Dated: October 1<sup>st</sup>, 2007

Attorneys for Applicant  
Ivy Silberstein

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing APPLICANT'S RESPONSE TO REPORT OF THE OPPOSERS was served upon counsel for Opposers by depositing the same in the U.S. Mail, first class postage prepaid, on October 11, 2007, in an envelope addressed to:

Shelly Elimelekh, Esq.  
Loeb & Loeb LLP  
345 Park Avenue  
New York, New York 10154

  
Audrey de Souza

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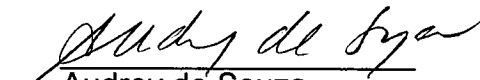
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CERTIFICATE OF MAILING

Express Mail No.: EV 570884324 US

Date of Deposit: October 11, 2007

It is hereby certified that the foregoing APPLICANT'S RESPONSE TO REPORT OF THE OPPOSERS in the above-identified proceeding is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, Trademark Trial and Appeal Board, Box TTAB No Fee, 2900 Crystal Drive, Arlington, VA 22202.

  
Audrey de Souza



UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

DUNN  
Mailed: September 25, 2007

Opposition No. 91157532

FOX ENTERTAINMENT GROUP INC  
AND TWENTIETH CENTURY FOX  
FILM CORPORATION

v.

IVY SILBERSTEIN

**Elizabeth A. Dunn, Attorney:**

Proceedings herein were suspended pending the disposition of the civil action between the parties. On September 7, 2007, opposer notified the Board that the civil action and the appeal were concluded, and attached copies of the district and appellate court orders.

Upon review, the Board finds that the court's order is not determinative of this proceeding. In granting opposer's motion for summary judgment on the ground of trademark infringement, the district court found that applicant did not have a protectible interest in its mark because the mark is not yet in use, and the United States Court of Appeals for the Second Circuit affirmed the district court's decision on the same basis. Inasmuch as the opposed application is based on

applicant's allegation of a bona fide intent to use the mark in commerce, the findings of the court do not provide a basis for dismissal or entry of judgment in this proceeding.

Accordingly, proceedings herein are resumed and applicant is allowed until thirty days from the mailing date of this order to file her answer to the notice of opposition.

Discovery and trial dates are reset below:

DISCOVERY PERIOD TO CLOSE:	<b>March 27, 2008</b>
Thirty-day testimony period for party in position of plaintiff to close:	<b>June 25, 2008</b>
Thirty-day testimony period for party in position of defendant to close:	<b>August 24, 2008</b>
Fifteen-day rebuttal testimony period to close:	<b>October 8, 2008</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and



Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdagmt.htm>