

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

Mailed: February 19, 2008

Opposition No. 91156138

Fox Entertainment Group, Inc.
and Twentieth Century Fox Film
Corp.

v.

Ivy Silberstein

Frances S. Wolfson, Interlocutory Attorney:

Proceedings were suspended on September 13, 2007, pending disposition of opposers' motion (filed September 7, 2007) for judgment. Applicant filed a response to opposers' motion. For the reasons stated below, the motion is denied.

Opposers seek judgment against applicant on the grounds of preclusion based on the decision of the federal district court, 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)' affirmed by the Court of Appeals for the Second Circuit in *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).

In the civil action, the court determined that applicant did not have a protectible interest in her mark

because she had not yet used the mark in commerce, a required element under Section 43(a) of the Trademark Act.

In this case, applicant does not have to show that she has used her mark in commerce prior to disposition of this proceeding, to have a protectible interest in its registration. Accordingly, the findings of the court do not provide a basis for entry of judgment in this proceeding.

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. Trial dates, including the close of discovery, are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	May 31, 2008
30-day testimony period for party in the position of plaintiff to close:	August 29, 2008
30-day testimony period for party in the position of the defendant to close:	October 28, 2008
15-day rebuttal period for party in the position of the plaintiff to close:	December 12, 2008

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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

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/stndagmnt.htm>