

ESTTA Tracking number: **ESTTA4601**

Filing date: **01/12/2004**

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

Proceeding	91158590
Party	Defendant American Massage Therapy Association American Massage Therapy Association 820 Davis Street, Suite 100 Evanston, IL 602014444
Correspondence Address	THOMAS P. WHITE SCHIFF HARDIN & WAITE 6600 SEARS TOWER CHICAGO, IL 60606-0079
Submission	APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUSPENSION OF OPPOSITION PROCEEDINGS
Filer's Name	Thomas P. White
Filer's e-mail	trademarks@schiffhardin.com
Signature	/ThomasP.White/
Date	01/12/2004
Attachments	COMTA-Reply Brief.pdf (13 pages)

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

GALEN INSTITUTE LLC)	
)	
)	
Opposer,)	Opposition No. 91158590
)	Serial No. 76/466224
v.)	Mark: COMTA
)	
AMERICAN MASSAGE THERAPY)	
ASSOCIATION)	
)	
Applicant.)	

**APPLICANT’S REPLY BRIEF IN SUPPORT OF ITS
MOTION FOR SUSPENSION OF OPPOSITION PROCEEDINGS**

Applicant, the American Massage Therapy Association (“AMTA”) has moved for an order suspending this opposition proceeding filed by James Lattanzio as General Member of the Galen Institute LLC (“Opposer”). The Opposer filed a response brief dated December 22, 2003 (“Response”). This is AMTA’s reply brief in support of its motion.

I. It Is Irrelevant That Galen Institute Is Not A Party To The Pending Civil Litigation.

The Opposer argues that this proceeding should not be suspended because the Galen Institute LLC is not a party to the civil litigation pending in the United States District Court for the Northern District of Illinois. (Response ¶ 1). That is not relevant, because complete identity of the parties is not required for the Board to suspend an opposition under 37 C.F.R. § 2.117(a).

Section 2.117(a) provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that **a party or parties** to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a) (emphasis added).

In addition, it is clear from the Opposer's submissions in this matter that James Lattanzio, not the Galen Institute, is the real party in interest here. The Notice of Opposition begins by stating "I, James Lattanzio, as the General Member of the Galen Institute LLC hereby oppose" Throughout the Notice of Opposition, the Opposer refers to himself in the first person, as an individual not as an entity. (See, e.g., Notice of Opposition ¶1 – "I personally have never used the mark") Similarly, the Response refers to the Opposer individually. (See, e.g., Response ¶1: "suspending this proceeding would deny this opposer of **his** legal right to be heard." (emphasis added). The James Lattanzio who brought this proceeding is, of course, the same James Lattanzio who is a defendant in AMTA's civil infringement action.

II. The Pending Civil Action Clearly Will Have A Bearing On This Case.

The Opposer is simply incorrect when he asserts that "[t]he issues before this Board regarding the opposer is in no way similar to those pleaded in the applicant's lawsuit in IL." (Response ¶ 1). Of course, the civil action and this proceeding both involve the same mark – AMTA's certification mark COMTA - and both proceedings involve Mr. Lattanzio's challenges to AMTA's rights in the COMTA mark.

Specifically, the Opposer's primary (and clearly incorrect) argument in this proceeding appears to be that AMTA's mark is not a certification mark. (See Response ¶¶ 2-3; Notice of Opposition ¶¶ 6-8). As AMTA pointed out in its motion to suspend, the Opposer raises this same argument in the brief that he and Mr. Folkers (who is the opposer in Opposition No. 91158589) filed in response to AMTA's preliminary injunction motion in the civil action. (See pp. 4 and 12 of "Defendants Reply Per Courts Minute Order Of 10-24, 2003," a copy of which is attached as Exhibit 3 to AMTA's motion to suspend.)

Indeed, the Opposer admits that his claims will be resolved in the pending civil action. In his Response to AMTA's motion, the Opposer asserts that "[t]he entire issue of the applicants registration of a 'certification mark' will fail **in their civil action** as well as before this board" (Response ¶ 2, emphasis added). In the Notice of Opposition, the Opposer even asserts the pendency of AMTA's civil action as a basis for opposing AMTA's application. He alleges that if AMTA succeeds in the civil action, he will be harmed by being "forced to relinquish my accreditation status"; in other words, by having to stop using the infringing marks. (See Notice of Opposition ¶3).

III. The Issues Raised By The Opposer Are Ripe For Decision In The Civil Action, But Not In This Proceeding.

The Opposer asserts that the Board should decide dispositive motions in this proceeding before it rules on AMTA's motion to suspend. (Response ¶ 6). The Opposer has not filed any dispositive motion here, and could not do so any time soon - a summary judgment motion would not be appropriate until the summer of 2004, after the close of the discovery period.

In contrast, AMTA's motion for preliminary injunction in the civil action has been fully briefed and is ready for decision. Indeed, in an order issued December 22, 2003, Judge Elaine Bucklo of the United States District Court for the Northern District of Illinois stated that she would be issuing a ruling on the preliminary injunction motion by mail. (A copy of Judge Bucklo's December 22, 2003 order is attached as Exhibit 1.) To AMTA's knowledge, Judge Bucklo has not issued that ruling yet. If Judge Bucklo grants the preliminary injunction, the civil

action and this proceeding may well be resolved. If, for some reason, Judge Bucklo does not grant the preliminary injunction, AMTA will continue to pursue the civil action vigorously.¹

The Opposer cites various cases in which he claims that district courts have stayed civil proceedings pending the outcome of oppositions. (Response ¶ 4). Those cases are not relevant here, for the simple reason that Judge Bucklo has *not* stayed the civil action pending before her. Moreover, three of the cases cited by the Opposer did not involve orders to stay civil proceedings, but rather were appeals to district courts from TTAB decisions on various issues. See Cardwell v. Investor's Analysis, Inc., 1987 U.S. Dist. LEXIS 4159 (E.D. Pa. May 15, 1987); Lantech, Inc. v. Mossinghoff, 228 U.S.P.Q. 775 (W.D. Ky. 1985); and Conrad-Pyle Co. v. Thuron Indus., Inc., 201 U.S.P.Q. 733 (N.D. Tex. 1978). The other cases cited by the Opposer appear to involve civil actions that were filed *after* TTAB proceedings had been instituted, although exact filing deadlines are not provided. See, e.g., Driving Force, Inc. v. Manpower, Inc., 498 F. Supp. 21 (E.D. Pa. 1980); and Kemin Indus., Inc. v. Watkins Prods., Inc., 183 U.S.P.Q. 799 (D. Minn. 1974). In any event, the Opposer ignores the well-settled law on this issue:

It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.

MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Section 32:47, 4th Ed., December 2003 Release (internal citations omitted). The overwhelming majority of courts have adopted and follow this proposition, consistent with the case law cited in AMTA's motion to suspend.

¹ Judge Bucklo's December 22, 2003 order also set a trial date of October 18, 2004 in the civil action. Thus, should the civil action not be resolved following Judge Bucklo's decision on AMTA's preliminary injunction motion, the civil action still is set for trial before this proceeding, in which the testimony periods run through December 24, 2004.

The Opposer represents that he and Mr. Folkers have filed a motion to stay the civil proceeding. (Response ¶ 6). AMTA's counsel has not received any such filing, and the District Court's current docket for the civil action does not reflect any such filing. (A January 12, 2004, printout of the Court's online docket in Case No. 03 C 6820 is attached as Exhibit 2.)

If Mr. Lattanzio and Mr. Folkers do file such a motion, it will represent a significant change of tactics – until now at least, they have elected to defend the civil action on the merits. The opposition period on AMTA's application opened on October 21, 2003, the same day, coincidentally, on which AMTA filed its preliminary injunction motion. Instead of immediately filing an opposition and asking Judge Bucklo to stay the civil action, Mr. Lattanzio and Mr. Folkers filed their substantive brief in opposition to AMTA's preliminary injunction motion on November 13, 2003, **before** this proceeding was even initiated. Clearly, the Opposer chose to fight AMTA's infringement claims on the merits, and the possibility of asking Judge Bucklo to stay the civil action was an afterthought that occurred to him following AMTA's filing of its motion to suspend this proceeding.

CONCLUSION

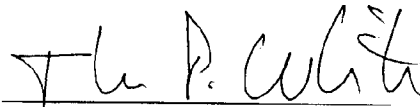
For the foregoing reasons and the reasons set forth in AMTA's motion to suspend, AMTA respectfully requests that the Board enter an order suspending this proceeding until

termination of the civil action captioned American Massage Therapy Association v. Folkers et al., Case No. 03 C 6820, pending in the United States District Court for the Northern District of Illinois.

Respectfully submitted,

AMERICAN MASSAGE THERAPY
ASSOCIATION

By:



Thomas P. White

Jeanette S. Zimmer

SCHIFF HARDIN LLP

6600 Sears Tower

Chicago, Illinois 60606

Telephone: (312) 258-5500

Facsimile: (312) 258-5700

Dated: January 12, 2003

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS

Michael W. Dobbins
CLERK

Office of the Clerk

Thomas P. White
Schiff, Hardin & Waite
233 South Wacker Drive
6600 Sears Tower
Chicago, IL 60606

Case Number: 1:03-cv-06820

Title: Amer Massage Therapy v. Folkers

Assigned Judge: Honorable Elaine E. Bucklo

MINUTE ORDER of 12/22/03 by Hon. Elaine E. Bucklo :
Plaintiff's motion for leave to supplement the record on
its motion for preliminary injunction with TTAB filings
[7-1] is granted. Ruling on the motion for preliminary
injunction [7-1] set for 12/18/03 was vacated. Ruling will
be made by mail. Defendants' motion for sanctions on
plaintiff for failure to make disclosure [28-1], their
motion to strike from plaintiffs complaint [29-1], for
protective order [30-1], and for security for costs [31-1]
are denied. Pursuant to parties' Report of Rule 26(f)
Planning Meeting, fact discovery shall be completed by
03/31/04 and expert discovery by 06/01/04. Any dispositive
motion shall be filed by 07/09/04. Pretrial order will be
due by 09/10/04; and response to any motions in limine by
09/24/04. Pretrial conference set for 10/08/04 at 3:00 p.m.
and trial set for 10/18/04 at 9:30 a.m. Mailed notice

This docket entry was made by the Clerk on December 23, 2003

ATTENTION: This notice is being sent pursuant to Rule 77(d) of the
Federal Rules of Civil Procedure or Rule 49(c) of the Federal
Rules of Criminal Procedure. It was generated by ICMS,
the automated docketing system used to maintain the civil and
criminal dockets of this District. If a minute order or
other document is enclosed, please refer to it for
additional information.

For scheduled events, motion practices, recent opinions and other information,

Exhibit 1

Docket as of December 29, 2003 9:17 pm

Web PACER (v2.4)

U.S. District Court
Northern District of Illinois (Chicago)
CIVIL DOCKET FOR CASE #: 03-CV-6820
Amer Massage Therapy v. Folkers, et al

Filed: 09/26/03
Assigned to: Hon. Elaine E. Bucklo
Demand: \$0,000
Nature of Suit: 840
Lead Docket: None
Jurisdiction: Federal Question
Dkt# in other court: None
Cause: 15:1051 Trademark Infringement

AMERICAN MASSAGE THERAPY
ASSOCIATION
plaintiff

Thomas P. White
[**COR LD NTC A**]
Schiff, Hardin & Waite
233 South Wacker Drive
6600 Sears Tower
Chicago, IL 60606
(312) 258-5500

Jeanette Sanniola Zimmer
[**COR**]
Dick and Harris
181 West Madison Street
3800
Chicago, IL 60602
(312) 726-4000

v.

CHRIS FOLKERS
dba
Council Overseeing Medical &
Massage Therapy Accrediation
defendant

Chris Folkers
[**NTC**] [**PRO SE**]
13505 South Mur-Len Suite 105-
336
Olathe, KS 66062-1600
913-782-2174

JAMES LATTANZIO
defendant

James Lattanzio
[**NTC**] [**PRO SE**]
1025 Silas Deane Hw
Wethersfield, CT 06109
860-721-1904

Exhibit 2

DOCKET PROCEEDINGS

DATE	#	DOCKET ENTRY
9/26/03	1	COMPLAINT(Attachments); - Civil cover sheet - Appearance(s) of Jeanette Sanniola Zimmer, Thomas P. White as attorney(s) for plaintiff (Twor original and two copies summons(es) issued.) (Documents: (1-1 through 1-3)) (nf) [Entry date 09/29/03]
9/26/03	--	RECEIPT regarding payment of filing fee paid; on 9/26/03 in the amount of \$ 150.00, receipt # 1075990. (nf) [Entry date 09/29/03]
9/26/03	2	NOTIFICATION by plaintiff of affiliates. (nf) [Entry date 09/29/03]
9/29/03	--	MAILED trademark letter to plaintiff's counsel requesting trademark numbers. (nf) [Entry date 09/29/03]
10/7/03	--	MAILED to plaintiff's counsel Lanham Mediation Program materials. (yp) [Entry date 10/07/03]
10/14/03	3	CERTIFICATE by plaintiff under Local Rule 16.3. (nf) [Entry date 10/15/03]
10/16/03	4	RESPONSE by plaintiff to letter requesting additional trademark information (Attachment). (nf) [Entry date 10/17/03]
10/16/03	--	MAILED trademark report to Commissioner Patent and Trademark in Washington D.C. (nf) [Entry date 10/17/03]
10/20/03	5	PRO SE APPEARANCE by defendant Chris Folkers. (nf) [Entry date 10/21/03]
10/20/03	6	PRO SE APPEARANCE by defendant James Lattanzio. (nf) [Entry date 10/21/03]
10/21/03	7	MOTION by plaintiff for preliminary injunction; Memorandum in support; (Attachments); Notice (nf) [Entry date 10/27/03]
10/24/03	8	MINUTE ORDER of 10/24/03 by Hon. Elaine E. Bucklo : Response to plaintiff's motion for preliminary injunction [7-1] is due by 11/14/03; and any reply by 11/28/03. Ruling set for 12/18/03 at 10:00 a.m. Mailed notice (nf)

[Entry date 10/27/03]

10/27/03 9 MOTION by defendant James Lattanzio for enlargement of time to file responsive pleading (Attachment); Notice (nf) [Entry date 10/28/03]

10/28/03 10 MOTION by defendant Chris Folkers for enlargement of time to file responsive pleading to complaint. (nf) [Entry date 10/29/03] [Edit date 10/29/03]

10/29/03 11 RESPONSE by plaintiff to the defendants' motions for enlargement of time to file responsive pleading to complaint [9-1], [10-1] (nf) [Entry date 10/30/03]

11/5/03 -- ALIAS SUMMONS issued original and one copy as to defendant James Lattanzio (nf) [Entry date 11/06/03]

11/5/03 12 RETURN OF SERVICE executed as to defendant Chris Folkers on 10/06/03. (nf) [Entry date 11/06/03]

11/5/03 20 MOTION by defendant Chris Folkers to dismiss this defendant; Notice (nf) [Entry date 11/18/03]

11/6/03 -- SUMMONS issued original and one copy as to defendant Chris Folkers (nf) [Entry date 11/07/03]

11/6/03 21 MOTION by defendant James Lattanzio to dismiss this defendant (Attachments); Notice (nf) [Entry date 11/18/03]

11/7/03 13 MINUTE ORDER of 11/7/03 by Hon. Elaine E. Bucklo : Motions for extension of time to file responsive pleading by defendants [9-1] and [10-1] are granted. Accordingly, defendants until 11/24/03 to answer or otherwise plead to the complaint. Mailed notice (nf) [Entry date 11/10/03]

11/12/03 14 OBJECTIONS by defendant Chris Folkers to court minute order of 10/24/03 [8-1] (nf) [Entry date 11/13/03]

11/12/03 15 RESPONSE by plaintiff to defendant Lattanzio's motion to dismiss (Attachments). (nf) [Entry date 11/13/03]

11/12/03 16 RESPONSE by plaintiff to defendant Folkers' motion to dismiss (Attachments). (nf) [Entry date 11/13/03]

11/12/03 17 RETURN OF SERVICE executed as to defendant James Lattanzio on 10/03/03. (nf) [Entry date 11/14/03]

11/12/03 22 OBJECTIONS by defendant James Lattanzio to court minute order of 10/24/03 [8-1] (Attachment). (nf) [Entry date 11/18/03]

11/13/03 18 RESPONSE by plaintiff to the defendants' objection to court minute order of 10/24/03 [14-1] (nf) [Entry date 11/14/03]

11/13/03 19 RETURN OF SERVICE executed as to defendant James Lattanzio on 11/06/03. (nf) [Entry date 11/14/03]

11/14/03 23 MINUTE ORDER of 11/14/03 by Hon. Elaine E. Bucklo : Defendants have until 12/05/03 to file any replies on motions to dismiss. Ruling set for 12/10/03 at 9:30 a.m.

Defendants will have 14 days after ruling on the motion to dismiss, if the motion is denied, to file a response to the motion for preliminary injunction. Mailed notice (nf) [Entry date 11/18/03]

11/17/03 24 SUPPLEMENTAL response by plaintiff to defendants' objections to court minute order of 10/24/03 [14-1], [22-1] (nf) [Entry date 11/18/03] [Edit date 11/18/03]

11/17/03 25 REPLY by defendant James Lattanzio per courts minute order on 10/24/03 [8-1] (Attachments). (nf) [Entry date 11/18/03] [Edit date 11/18/03]

11/18/03 24 RESPONSE by plaintiff to defendants' motion for nonsuit on plaintiff for failure to make disclosure. (nf) [Entry date 11/19/03]

11/19/03 25 REPORT OF THE PARTIES' RULE 26(f) PLANNING MEETING. (nf) [Entry date 11/20/03]

11/26/03 26 REPLY memorandum by plaintiff in support of its motion for preliminary injunction [7-1] (Attachments). (nf) [Entry date 12/01/03]

11/26/03 27 COMPENDIUM by plaintiff of unreported cases and authorities cited in its memoranda in support of its motion for preliminary injunction (Attachments). (nf) [Entry date 12/02/03]

11/26/03 28 MOTION by defendant for sanctions on plaintiff for failure to make disclosure (Attachments); Notice (nf) [Entry date 12/23/03]

11/26/03 29 MOTION by defendant James Lattanzio to strike from plaintiffs complaint. (nf) [Entry date 12/23/03]

11/26/03 30 MOTION by defendant Chris Folkers for protective order ; (nf) [Entry date 12/23/03]

11/26/03 31 MOTION by defendants for security for costs; Notice (nf) [Entry date 12/23/03]

12/9/03 32 MOTION by plaintiff for leave to supplement the record on its motion for preliminary injunction [7-1] (Attachments); Notice (nf) [Entry date 12/23/03]

12/22/03 33 MINUTE ORDER of 12/22/03 by Hon. Elaine E. Bucklo : Plaintiff's motion for leave to supplement the record on its motion for preliminary injunction with TTAB filings [7-1] is granted. Ruling on the motion for preliminary injunction [7-1] set for 12/18/03 was vacated. Ruling will be made by mail. Defendants' motion for sanctions on plaintiff for failure to make disclosure [28-1], their motion to strike from plaintiffs complaint [29-1], for protective order [30-1], and for security for costs [31-1] are denied. Pursuant to parties' Report of Rule 26(f) Planning Meeting, fact discovery shall be completed by 03/31/04 and expert discovery by 06/01/04. Any dispositive motion shall be filed by 07/09/04. Pretrial order will be due by 09/10/04; and response to any motions in limine by

09/24/04. Pretrial conference set for 10/08/04 at 3:00 p.m.
and trial set for 10/18/04 at 9:30 a.m. Mailed notice (nf)
[Entry date 12/23/03]

12/22/03 34

NOTICE by plaintiff of filing attached excerpts from the
deposition of Jim Lattanzio (Attachments). (nf)
[Entry date 12/29/03]

Case Flags:
LEVIN
A0279

END OF DOCKET: 1:03cv6820

PACER Service Center			
Transaction Receipt			
01/12/2004 16:30:03			
PACER Login:	sh0047	Client Code:	23001-1700
Description:	docket report	Search Criteria:	1:03cv06820
Billable Pages:	5	Cost:	0.35

CERTIFICATE OF SERVICE

Thomas P. White, an attorney, certifies that on January 12, 2004, he caused to be served the foregoing APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUSPENSION OF OPPOSITION PROCEEDINGS via prepaid first class U.S. Mail to:

James Lattanzio
Galen Institute LLC
1025 Silas Deane Hwy., 2nd Floor
Wethersfield, CT 06109

A handwritten signature in black ink, appearing to read "Thomas P. White", is written over a horizontal line.

Thomas P. White

Date: January 12, 2004