

ESTTA Tracking number: **ESTTA209155**

Filing date: **05/05/2008**

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

Proceeding	91160496
Party	Plaintiff Aspen Club Lodge Properties, LLC
Correspondence Address	Avraham Azrieli Azrieli & Associates, LLC 7373 E. Doubletree Ranch Rd., Suite 200 Scottsdale, AZ 85258 UNITED STATES Avi@AzrieliLaw.com
Submission	Other Motions/Papers
Filer's Name	Avraham Azrieli
Filer's e-mail	Avi@AzrieliLaw.com
Signature	/Avraham Azrieli/
Date	05/05/2008
Attachments	MotionToDeclareApplicationAbandoned.pdf (5 pages)(87646 bytes) Exhibit1 to Opposer's MotionToDeclareApplicationAbandoned .pdf (8 pages)(189775 bytes) Exhibit2 to Opposer'sMotionToDeclareApplicationAbandoned.pdf (3 pages)(7723 bytes) Exhibit3 to Opposer'sMotionToDeclareApplicationAbandoned.pdf (3 pages)(96191 bytes)

Avraham Azrieli (AZ#020097)
Attorney at Law
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Email: Avi@AzrieliLaw.com

Attorney for Opposer Aspen
Club Lodge Properties, LLC

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

In the matter of:
Application Serial No. 78/193,658
For the Mark: SKY SPA

ASPEN CLUB LODGE PROPERTIES, LLC,

Opposer,

v.

MARY E. INNIS,

Applicant.

Opposition No. 91160496

OPPOSER ASPEN CLUB LODGE
PROPERTIES, LLC'S MOTION TO
DECLARE APPLICATION AS
ABANDONED

MOTION TO DECLARE APPLICATION AS ABANDONED

Opposer Aspen Club Lodge Properties, LLC ("Opposer") hereby moves the Trademark Trial and Appeal Board ("TTAB" or "Board") for an Order declaring the Application for "SKY SPA," Serial No. 78/193,658 (the "Application") filed by Defendant-Applicant Mary E. Innis ("Innis"), to be abandoned due to Applicant's failure to respond timely to an Office Action. This Motion is made pursuant to applicable laws and regulations, including §528, TTAB MANUAL OF PROCEDURE (hereinafter "TBMP"); §718.02, TRADEMARK MANUAL OF EXAMINING PROCEDURE (5th Ed.) (hereinafter "TMEP"), and such other applicable sections, and Rule 56, FED. R.

Civ. P.C.F.R., §2.117, and TBMP §510.02(a), and is supported by the following Memorandum of Points and Authorities.

MEMORANDUM OF POINTS AND AUTHORITIES

I. FACTUAL BACKGROUND

On December 12, 2002, Applicant submitted an Application for SKY SPA trademark registration to the United States Patent and Trademark Office (“USPTO”). (Application of Mary E. Innis for SKY SPA Mark, attached hereto as Exhibit 1).

On April 24, 2003, USPTO examining attorney Matthew C. Kline issued an Office Action to Applicant regarding the Application. (April 24, 2003 USPTO Office Action, Serial Number 78/193658, attached hereto as Exhibit 2)

The Office Action advised Applicant of an error regarding the way Applicant classified the services in the application.

“Classification of Services

The applicant has classified the services incorrectly. The applicant must amend the application to classify the services in International Class 44.”

The Office Action also informed Applicant that a disclaimer needed to be added to the application:

“Disclaimer Required

The applicant must insert a disclaimer of SPA in the application because the term is descriptive of the applicant’s beauty salon services. ... A properly worded disclaimer should read as follows: No claim is made to the exclusive right to use SPA apart from the mark as shown. ...”

The Office Action contained the following directive regarding abandonment:

“TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.”

The Office Action was emailed to Applicant on the morning of April 24, 2003. To meet the requirement that, to avoid abandonment, Applicant’s response must be received by the USPTO within 6 months of the Office Action e-mailing date, such response would have had to be received by the USPTO on or before October 23, 2003, the last day of the 6-month period.

However, the USPTO did not receive Applicant’s response to the Office Action until October 27, 2003, four days after the expiration of the mandated “within six months” deadline. (Mary E. Innis’ Amendment and Response to Office Action, together with USPTO Incoming Correspondence Routing Sheet, attached as Exhibit 3)

II. LEGAL ARGUMENT

A. APPLICANT HAS ABANDONED THE APPLICATION FOR TRADEMARK REGISTRATION

Under the Trademark Manual of Examining Procedure (5th Edition), the Rule regarding time limitations on response to Office Action is clear:

“711 Deadline for Response to Office Action

The statutory period for response to an examining attorney’s Office action is six months. 15 U.S.C. §1062(b); 37 C.F.R. §2.62. The examining attorney has no discretion to shorten or extend this period. The applicant must file a response within six months of the mailing date of the Office action, unless the examining attorney has issued a supplemental action resetting the period for response. *See* TMEP §711.02 regarding supplemental Office actions.”

As stated in the Office Action in this case, the automatic effect of an Applicant’s failure to respond within 6 months is that the Application is to be declared as Abandoned.

“An abandoned application is an application for registration that is removed from the United States Patent and Trademark Office [(“USPTO”)] docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within a specified response period.” An application becomes abandoned if the applicant fails to respond, or fails to respond completely within six months, to an Office Action issued by an examining attorney of the USPTO. *See* 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a); TMEP §718.06. “The examining attorney has no authority to accept a late response.” TMEP §718.02

In this matter, Examining attorney Kline issued the Office Action (Ex. 2) to Applicant regarding the pending application on April 24, 2003, and the Office Action was emailed to Applicant on April 24, 2003. The Office Action specifically, **IN BOLD, UPPER-CASE FONT LETTERS**, notified Applicant that:

“TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.”

In this case, as the Office Action was emailed and mailed to Applicant on April 24, 2003, Applicant’s response had to be received by the USPTO no later than October 23, 2003. Because Applicant’s response was not received by the USPTO within the prescribed 6 months period, it was abandoned.

It should be noted that Applicant in this case has shown repeated disregard to time limits and response dates. In fact, in the Opposition proceedings pending before the TTAB in this matter, Applicant has sought many extensions (including a Motion to Reopen Time to File Answer (after default)), the last of which was denied by the TTAB,

and has failed to meet discovery deadlines, as set more fully in a Opposer's Motion to Compel (filed subsequently to this Motion).

Any excuses by Applicant for its failure to respond timely are immaterial, because, as cited above, the TMEP clearly denies the examining attorney any authority to accept a late response. Thus, a response received after expiration of the "within six months" response deadline must be ignored, and an automatic abandonment of the application must be declared without exception.

Therefore, due to Applicant's failure to submit a response to the Office Action within the prescribed 6 months period, Applicant's application must be deemed abandoned.

III. CONCLUSION

Based upon the foregoing, Opposer respectfully requests that the TTAB grant this Motion to Declare the Application as Abandoned.

Dated: May 5, 2008.

Respectfully submitted,

AZRIELI & ASSOCIATES

By /s/ Avraham Azrieli
Avraham Azrieli
Attorney for Opposer
Aspen Club Lodge Properties, LLC

A true and correct copy of the foregoing Motion to Declare Application as Abandoned was served via first class mail, mailed postage prepaid, the 5th day of May, 2008, to:
Andrea E. Friedman, Esq.
Friedman Law Group, Ltd.
Attorneys for Applicant
101 West Grand Avenue, Ste. 212
Chicago, Illinois 60610

By: /s/ Sandra L. Ravel

Drawing Page

Serial Number:

78193658

Applicant:

Innis, Mary, E
501 N Kingsbury #G
Chicago IL USA 60610



Goods and Services:

beauty salon services

Mark:

SKY SPA



NO OCR



12-12-2002

Internet Transmission Date:

2002/12/12

Serial Number:

78193658

Filing Date:

2002/12/12



TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: \$325

RAM SALE NUMBER: 471
RAM ACCOUNTING DATE: 12/12/2002



NO OCR



12-12-2002

DOCUMENT INFORMATION**TRADEMARK/SERVICEMARK APPLICATION****VERSION 1.24****APPLICANT INFORMATION**

NAME	Innis,Mary,E
STREET	501 N Kingsbury #G
CITY	Chicago
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60610
TELEPHONE NUMBER	312-832-1988
FAX NUMBER	312-554-8015
E-MAIL ADDRESS	minnis@pattishall.com
AUTHORIZE E-MAIL COMMUNICATION	Yes

APPLICANT ENTITY INFORMATION

INDIVIDUAL: COUNTRY OF CITIZENSHIP	USA
------------------------------------------	-----

TRADEMARK/SERVICEMARK INFORMATION

MARK	SKY SPA
TYPED FORM	Yes

BASIS FOR FILING AND GOODS/SERVICES INFORMATION

INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL	042

CLASS NUMBER	
LISTING OF GOODS AND/OR SERVICES	beauty salon services
ATTORNEY INFORMATION	
NAME	Mary Innis
STREET	311 S. Wacker
CITY	Chicago
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60606
FIRM NAME	Pattishall, McAuliffe
E-MAIL ADDRESS	minnis@pattishall.com
AUTHORIZE E-MAIL COMMUNICATION	Yes
TELEPHONE NUMBER	312-554-7968
FAX NUMBER	312-554-8015
FEE INFORMATION	
TOTAL FEES PAID	325
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1
LAW OFFICE INFORMATION	
E-MAIL ADDRESS FOR CORRESPONDENCE	minnis@pattishall.com
SIGNATURE AND OTHER INFORMATION	

SIGNATURE	/mary innis/
DATE	12/12/2002
NAME	Mary Innis
TITLE	Attorney
MAILING ADDRESS	
LINE	Mary Innis
LINE	Pattishall, McAuliffe
LINE	311 S. Wacker
LINE	Chicago IL USA 60606
SERIAL NUMBER INFORMATION	
SERIAL NUMBER	78193658
RAM INFORMATION	
RAM SALE NUMBER	471
RAM ACCOUNTING DATE	12/12/2002
INTERNET TRANSMISSION DATE	Thu Dec 12 02:02:20 EST 2002
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E-MAIL ADDRESS FOR ACKNOWLEDGMENT	minnis@pattishall.com

<SERIAL NUMBER> 78193658

<FILING DATE> 12/12/2002

<DOCUMENT INFORMATION>

<TRADEMARK/SERVICEMARK APPLICATION>

<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME> Innis,Mary,E
<STREET> 501 N Kingsbury #G
<CITY> Chicago
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60610
<TELEPHONE NUMBER> 312-832-1988
<FAX NUMBER> 312-554-8015
<E-MAIL ADDRESS> minnis@pattishall.com
<AUTHORIZE E-MAIL COMMUNICATION> Yes

<APPLICANT ENTITY INFORMATION>

<INDIVIDUAL: COUNTRY OF CITIZENSHIP> USA

<TRADEMARK/SERVICEMARK INFORMATION>

<MARK> SKY SPA
<TYPED FORM> Yes

~Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended).~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>

<INTENT TO USE: SECTION 1(b)> Yes

~ The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).~

<INTERNATIONAL CLASS NUMBER> 042

<LISTING OF GOODS AND/OR SERVICES> beauty salon services

<ATTORNEY INFORMATION>

<NAME> Mary Innis
<STREET> 311 S. Wacker
, Suite 5000

<CITY> Chicago
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60606
<FIRM NAME> Pattishall, McAuliffe
<E-MAIL ADDRESS> minnis@pattishall.com
<AUTHORIZE E-MAIL COMMUNICATION> Yes
<TELEPHONE NUMBER> 312-554-7968
<FAX NUMBER> 312-554-8015

<FEE INFORMATION>

<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>

~The USPTO is authorized to communicate with the applicant's attorney at the below e-mail address~

<E-MAIL ADDRESS FOR CORRESPONDENCE> minnis@pattishall.com

<SIGNATURE AND OTHER INFORMATION>

~The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.~

<SIGNATURE> /mary innis/
<DATE> 12/12/2002
<NAME> Mary Innis
<TITLE> Attorney

<MAILING ADDRESS>

<LINE> Mary Innis
<LINE> Pattishall, McAuliffe

<LINE> 311 S. Wacker
Suite 5000
<LINE> Chicago IL USA 60606

<SERIAL NUMBER INFORMATION>

<SERIAL NUMBER> 78193658

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USPTO/BAS-6724888107-20021212020220712433-78193658-

2001654de70b73c10fdb44a2924a0ccfb9-RAM-471-20021212015552652478

E-MAIL ADDRESS FOR ACKNOWLEDGMENT> minnis@pattishall.com

To: Innis,Mary,E (minnis@pattishall.com)
Subject: TRADEMARK APPLICATION NO. 78193658 - SKY SPA - N/A
Sent: 4/24/03 11:42:40 AM
Sent As: ECom114
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/193658

APPLICANT: Innis,Mary,E

CORRESPONDENT ADDRESS:

Mary Innis
Pattishall, McAuliffe
311 S. Wacker Suite 5000
Chicago IL USA 60606

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom114@uspto.gov

MARK: SKY SPA

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

minnis@pattishall.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/193658

The assigned examining attorney has reviewed the referenced application and determined the following.

Classification of Services

The applicant has classified the services incorrectly. The applicant must amend the application to classify the services in International Class 44. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§1401.02(a) and 1401.03(b).

Disclaimer Required

The applicant must insert a disclaimer of SPA in the application because the term is descriptive of the applicant's beauty salon services. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.08(a)(i).

A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use SPA apart from the mark as shown.

General Information

Search Clause

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

/Matthew C. Kline/
Trademark Examining Attorney
Law Office 114
(703) 308-9114
e-mail: ecom114@uspto.gov

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 114 - AWAITING RESPONSE DOCKET

Word Mark: SKY SPA

Serial No: 78193658



Mail Date: 10272003



Doc. Type: Amendments to Response



RECEIVED
TMO
LAW OFFICE 114
NOV 14 A 11:03

No Fee

RAM Mail Date: 102703



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

MARK: SKY SPA
SERIAL NO.: 78/193,658
FILING DATE: December 12, 2002
INTERNATIONAL CLASS: 42
APPLICANT: Mary E. Innis

To: Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

ATTN: Matthew C. Kline
Law Office 114
ecom114@uspto.gov

**AMENDMENT AND RESPONSE TO
OFFICE ACTION DATED APRIL 24, 2003**

In response to Office Action dated April 24, 2003, Applicant hereby amends its application to classify the services from Class 42 to International Class 44. Applicant further amends its application as follows:

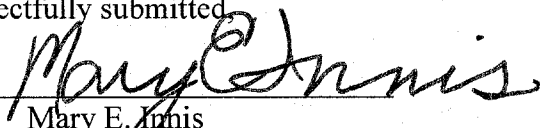
No claim is made to the exclusive right to use SPA apart from the mark as shown.

Applicant submits the above application is now entitled to registration.

Dated: October 24, 2003

Respectfully submitted,

By:


Mary E. Innis
Loeb & Loeb LLP
200 South Wacker Drive
Suite 3100
Chicago, IL 60606
312/674-4782
minnis@Loeb.com



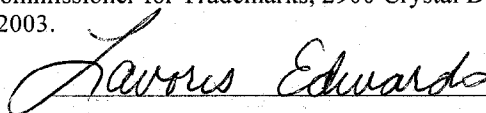
10-27-2003

U.S. Patent & TMOfr/TM Mail RcptDt. #64

CH329.1
66666655555
10/24/2003 le

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on October 24, 2003.



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

MARK: SKY SPA
SERIAL NO.: 78/193,658
FILING DATE: December 12, 2002
INTERNATIONAL CLASS: 42
APPLICANT: Mary E. Innis

To: Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

ATTN: Matthew C. Kline
Law Office 114
ecom114@uspto.gov

SUBSTITUTION OF CONTACT INFORMATION

Please address all future correspondence relating to this opposition to
Mary E. Innis, 200 South Wacker Drive, Suite 3100, Chicago, Illinois 60606,
minnis@loeb.com

MARY E. INNIS

Dated: October 24, 2003

By: 

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on October 24, 2003.

