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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/
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Attachments	ReplyToApplicant'sResponseToMotionToDeclareAbandonment.pdf (10 pages) (160690 bytes) Exhibit1--ReplyToResponseToMotionToDeclareApplicationAsAbandoned.pdf (1 page) (46106 bytes)

Avraham Azrieli (AZ#020097)
Attorney at Law
Azrieli & Associates, LLC
7373 E. Doubletree Ranch Rd., Suite 200
Scottsdale, Arizona 85258
Tel. 480-483-2587
Fax 480-483-2653
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,
Mark: SKY SPA, Published in the
Official Gazette of January 13, 2004

ASPEN CLUB LODGE PROPERTIES, LLC,

Opposer,

v.

MARY E. INNIS,

Applicant.

Opposition No. 91160496

OPPOSER'S REPLY TO APPLICANT'S
RESPONSE TO OPPOSER'S MOTION
TO DECLARE APPLICATION AS
ABANDONED

Opposer in this matter filed its motion (the "Motion") to declared as abandoned the Application filed by Applicant Mary E. Innis ("Innis"), under Section 1(b), ("Application") with the United States Patent & Trademark Office ("USPTO"), for SKY SPA (the "Mark"). Innis is identified in the Application as both the Applicant and the Attorney for Applicant (see Exhibit 1 to Opposer's Motion.) Opposer's Motion is based

on the fact that Applicant's response to an Office Action was late, thereby rendering the Application as abandoned, without discretion.

While Applicant admits that Applicant's response to the Office Action in question was received by the USPTO after the expiration of the six-month period, Applicant argues, in its response to Opposer's Motion, that its delay was cured because it complied with the Certificate of Mailing procedure. However, as shown below, Applicant's argument fails because Applicant's mailing was defective in multiple aspects under the requirements of the rules governing a Certificate of Mailing for responses to the USPTO.

Relevant Facts.

The underlying facts are set forth in Opposer's Motion, filed on May 5, 2008. The thrust of the Motion concerns Applicant's failure to timely respond to an office action, as follows.

On April 24, 2003, Examining Attorney Matthew C. Kline issued an Office Action to Applicant (attached to Opposer's Motion as Exhibit 2), requiring two amendments to the Application. The Office Action clearly stated:

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

Applicant's response (“Response”) to the Office Action was received by the USPTO on October 27, 2003, which is undisputedly not within the 6 months period, and therefore late. The only question is whether the late Response could be ‘cured’ by the fact that Applicant allegedly mailed it on October 24th, 2003.

Argument.

Applicant does not dispute that Applicant's Response to the said April 24, 2003, Office Action, was received by the USPTO after the expiration of the six-month period, and that such failure causes automatic abandonment under the Rules.

In its response to Opposer's Motion, Applicant admits this failure, which causes automatic abandonment of the Application, but seeks to avoid abandonment by raising the following argument in two parts: That the last day of the six-month period was October 24, 2003 (not October 23, 2003), and that because the Response was allegedly mailed to the USPTO on October 24, 2003, Applicant's Response should be considered to be received by the USPTO on the 24th and not the actual date of receipt—the 27th of October, 2003.

Whether the last day of the six-months period was the 23rd or the 24th of October, 2003 is a question that seems unresolved in the Rules, but fortunately is not crucial to the resolution of this Motion, because Applicant failed in multiple ways to comply with the mailing requirements, as shown below, and its Response to the Office Action was undisputedly late,¹ causing an automatic abandonment of the Application. Therefore,

¹ The Trademark Manual of Examining Procedure (5th Edition), provides in:

- **“§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....” (Emphasis added)

Opposer's Motion should be granted and the Application should be ruled to have been abandoned.

Applicant's Mailing and its Mailing Certificate Were Defective

In its response to this Motion, Applicant relies on *TMEP* §§305.02 *et seq.* to argue that, as a result of Applicant's use of the Certificate of Mailing procedure, the Response was timely filed, regardless of when it was received by the USPTO. However, Applicant failed to meet the specific requirements of the Certificate of Mailing procedure, as set forth in the *TMEP* and the C.F.R.

- **“§718.02 Failure by Applicant to Take Required Action During Statutory Period**

Under 15 U.S.C. §1062(b) and 37 C.F.R. §2.65(a), an application becomes abandoned if the applicant fails to respond, or fails to respond completely, within the six-month statutory response period. See *TMEP* §§718.03 *et seq.* regarding incomplete responses....” (Emphasis added)

The Examining Attorney's Office Action was sent out April 24, 2003. The phrase “within six months,” as used in the Action, would take a party through October 23, 2003, October 24th being the start of the next six-month period.

The Merriam-Webster OnLine Dictionary defines “within” as follows:

“Main Entry: ²**within**
Function: *preposition*
Date: 12th century

1—used as a function word to indicate enclosure or containment 2—used as a function word to indicate situation or circumstance in the limits or compass of: as a: before the end of <gone within a week>....” (Emphasis added)

Under the above definitions and Rules, Opposer believes the due date for Applicant's response to the Office Action was October 23, 2003. However, as discussed above, even a due date of October 24, 2003, as Applicant argues, would not save the Application from abandonment, because Applicant failed to meet the requirements set forth in the Rules regarding Certificate of Mailing.

The USPTO sets very specific requirements for the Certificate of Mailing.

Under 37 C.F.R. §2.197, “correspondence is considered to be timely filed even if it is received after the expiration of the filing period, if the correspondence was deposited with the USPS as first class mail or transmitted to the USPTO by facsimile transmission before the expiration of the filing period and accompanied by a certificate attesting to the date of mailing or transmission.” (Emphasis added.)

Applicant’s Mailing Certificate Was Not Properly Addressed

The relevant Rules requiring specificity in mailing certificates set forth the address to where such mailing must be addressed, and the manner of execution, in order to benefit from the extra time accorded to those complying with the Certificate of Mailing procedures.

- **“TMEP § 305 Mailing Documents to the Office**

TMEP § 305.01 Mailing Addresses

For trademark-related documents filed on paper, except for documents sent to the Assignment Services Branch for recordation, requests for copies of trademark documents, and certain documents filed under the Madrid Protocol (listed below), all trademark-related correspondence that is mailed to the USPTO should be addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451”
(Emphasis added)

- **“TMEP § 305.02(b) Mailing Requirements**

The correspondence must be deposited in the United States mail, properly addressed (see TMEP §305.01 for mailing addresses), and the envelope must have sufficient postage as first-class mail.” (Emphasis added)

- **“TMEP § 305.02(d) Wording of Certificate of Mailing**

The following wording is suggested for the certificate of mailing.

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, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

(Typed or Printed Name of Person Signing Certificate)

(Signature)

(Date)”
(Emphasis added)

Despite Applicant Innis’s declared expertise in trademark law (See excerpt from online Martindale-Hubbell entry on Applicant attached hereto as Exhibit 1), the Certificate of Mailing for the Response clearly fails to meet the Rules, as follows:

a. Applicant’s Certificate of Mailing Attests to an Incorrect Street Address.

The Rules, as cited above, require that the Response be mailed, and the Certificate of Mailing attest to mailing the response, to “P.O. Box 1451.”

Applicant’s Certificate of Mailing attests to the fact that it was mailed to “2900 Crystal Drive.”

In other words, Applicant’s late Response was (i) mailed to the wrong street address, and (ii) the Certificate of Mailing was defective in its content, failing to meet the relevant Rules by failing to state “P.O. Box 1451” as required by the rules regarding mailing a Response.

b. Applicant’s Certificate of Mailing Attests to an Incorrect City.

The Rules, as cited above, require that the Response be mailed, and the Certificate of Mailing attest to mailing the response, to the city of “Alexandria, Virginia.”

Applicant’s Certificate of Mailing attests to the fact that it was mailed to “Arlington, Virginia.”

In other words, Applicant’s late Response was (i) mailed to the wrong city, and (ii) the Certificate of Mailing was defective in its content, failing to meet the relevant Rules by failing to state “Alexandria, Virginia” as required by the rules regarding mailing a Response.

c. Applicant’s Certificate of Mailing Attests to an Incorrect Zip Code.

The Rules, as cited above, require that the Response be mailed, and the Certificate of Mailing attest to mailing the response, to the following zip code: “22313-1451.”

Applicant's Certificate of Mailing attests to the fact that it was mailed to a different zip code: "22202-3514."

In other words, Applicant's tardy Response was (i) mailed to the wrong zip code, and (ii) the Certificate of Mailing was defective in its content, failing to meet the relevant Rules by failing to state the correct zip code as required by the rules regarding mailing a Response.

d. Applicant's Certificate of Mailing was not Properly Executed.

As shown above, in addition to a signature and date, the Certificate of Mailing must carry the "Typed or Printed Name of Person Signing Certificate."

Applicant's Certificate of Mailing only carries a scribbled signature, with neither a date of the execution nor the printed name of the person signing it.

In other words, Applicant's tardy Response was (i) improperly executed and omitted the printed name and date of execution, and (ii) the Certificate of Mailing was defective in its content, failing to meet the relevant Rules by failing to include those items, i.e., printed name and date of execution.

In connection with the execution of the Certificate of Mailing, it should also be noted that TMEP §305.02(c) states: "It is suggested that the certificate be signed by the applicant or the party involved in the proceeding, or by the attorney for such person. If someone else signs, it should be a responsible person in a position to know that the mail will be deposited on the date specified." (Emphasis added)

Applicant, at the time of mailing the late Response, was both the "party involved" and the "attorney for such person," but did not sign the Certificate of Mailing, even though Innis was available to, and did, sign the Response itself. (Note that Applicant Innis is identified as an attorney specialist in intellectual property law—See Exhibit 1 attached hereto). Rather, the Response was signed by a person whose name was not

printed, and who does not appear to be a party or counsel in the proceedings, or otherwise in the record.

The Defects in Applicant’s Certificate of Mailing Must be Strictly Enforced

- **“TMEP § 305.02(h) Certificate of Mailing Requirements Strictly Enforced**

The requirements of 37 C.F.R. §2.197 (see 37 C.F.R. §2.197 immediately below) are strictly enforced, and the USPTO denies petitions to consider a document timely filed as of the date on the certificate if a party fails to comply with these requirements.

A party’s inadvertent failure to comply with the requirements of a rule is not considered an extraordinary situation that would warrant waiver of a rule under 37 C.F.R. §2.146(a)(5) or §2.148. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995), aff’d mem., 95 F.3d 1166 (Fed. Cir. 1996) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 C.F.R. §1.10(c) and grant filing date to patent application, where applicant failed to produce “Express Mail” customer receipt or any other evidence that application was actually deposited with USPS as “Express Mail”); In re Sasson Licensing Corporation, 35 USPQ2d 1510 (Comm’r Pats. 1995) (failure to retain executed hard copy of certificate of mailing under 37 C.F.R. §1.8 not extraordinary situation that would justify waiver of rule); Gustafson v. Strange, 227 USPQ 174 (Comm’r Pats. 1985) (counsel’s unawareness of 37 C.F.R. §1.8 not extraordinary situation warranting waiver of a rule); In re Chicago Historical Antique Automobile Museum, Inc., 197 USPQ 289 (Comm’r Pats. 1978) (lateness due to mail delay not deemed to be extraordinary situation, because certificate of mailing procedure under 37 C.F.R. §1.8 was available to petitioner).” (Emphasis added)

- **“37 C.F.R. §2.197. Certificate of mailing or transmission.**

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in §2.190 (see 37 C.F.R. §2.190 immediately below) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or [...]” (Emphasis added)

- **“TMEP § 718 Abandonment**

An abandoned application is an application for registration that is removed from the USPTO docket of pending applications because of express abandonment or because the applicant failed to take appropriate action within a specified response period. The examining attorney has no authority to accept a late response.”

CONCLUSION

Based on the above, it is clear that Applicant may not rely on its defective Certificate of Mailing to cure its late Response to the Office Action. Applicant’s Certificate of Mailing in fact attests to the wrong street address, the wrong city and the wrong zip code, in addition to lacking proper attestation and execution. TMEP § 305.02(h), cited above, specifically requires strict enforcement of Mailing Certificate Requirements, stating “the USPTO denies petitions to consider a document timely filed as of the date on the certificate if a party fails to comply with these requirements.” And further, that “A party’s inadvertent failure to comply with the requirements of a rule is not considered an extraordinary situation that would warrant waiver of a rule under 37 C.F.R. §2.146(a)(5) or §2.148.”

The foregoing is even more applicable when Applicant, also formally named Attorney for the Applicant at the time, specializes in intellectual property law. Therefore, Applicant clearly failed to comply with the Rules governing Certificate of Mailing and may not rely on that procedure. And therefore, Applicant’s Response to the Office

Action was at least 3 days late, and Opposer respectfully requests that the TTAB grants its Motion to Declare the Application as Abandoned.

Dated: June 2, 2008

Respectfully submitted,

AZRIELI & ASSOCIATES

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

Certificate of Service

The undersigned hereby certifies that a true and correct copy of the foregoing Opposer's Reply to Applicant's Response To Opposer's Motion to Declare Application as Abandoned was served via email and deposited with the U.S. Postal Service as first class mail, postage prepaid, the 2nd day of June, 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
Date: June 2, 2008

EXHIBIT 1
TO
REPLY TO RESPONSE TO
MOTION TO DECLARE APPLICATION AS ABANDONED

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Name:	Mary E. Innis	Article(s) Published
Position:	Partner	
Organization:	Loeb & Loeb LLP	
Practice Areas:	Litigation; Intellectual Property; Advertising Law; Promotion Law	
Office:	Chicago, Illinois (Cook Co.)	