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

Proceeding	91160496
Party	Defendant Mary E Innis
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Date	06/18/2008
Attachments	Applicant's Reponse to Opposer's New Motion to Declare Application as Abandoned.pdf (5 pages)(24392 bytes) Exhibit A - Applicant's Resp to Opposer's New Motion to Declare Application as Abandoned.pdf (2 pages)(56814 bytes)

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: SKY SPA
Published in the *Official Gazette* of January 13, 2004 in International Class 44

Aspen Club Lodge Properties, Inc.,)	
)	
Opposer,)	
)	Opposition No. 91160496
v.)	
)	
Innis, Mary E.,)	
)	
Applicant.)	

APPLICANT’S RESPONSE TO OPPOSER’S NEW
MOTION TO DECLARE APPLICATION AS ABANDONED

Opposer moved to declare the application for SKY SPA, Ser. No. 78/193,658 (“Application”) abandoned for failure to file a Response to an Office Action within the required 6-month deadline, and Applicant responded. Now, the Opposer has filed a Reply to Applicant’s Response to Opposer’s Motion to Declare Application as Abandoned (“Reply”) requesting the Application be abandoned because Applicant’s Certificate of Mailing was not properly addressed and executed. However, since the Reply raises issues not addressed in Opposer’s Motion to Declare Application as Abandoned, it should be considered a new Motion To Declare Application as Abandoned. For the following reasons, Applicant requests that Opposer’s Reply not be considered, and if it is considered, that it be denied.

Opposer’s first Motion to declare the Application as abandoned relied on the deadline for filing a Response to an Office Action. According to Opposer, the Response to the Office Action which was issued against the Application on April 24, 2003, was due October 23, 2003. In its

Response, Applicant referred to TMEP §310, “Computing Period for Response to Office Action or Notice” which clearly states:

...a response to an examining attorney’s Office action dated August 31 is due on the following February 28 (or 29 if it is a leap year); a response to an Office action dated February 28 is due on August 28 and not on the last day of August. *Ex parte Messick*, 7 USPQ 57 (Comm’r Pats. 1930).

However, Opposer remains unable or unwilling to recognize the 6-month deadline is measured in months, regardless of whether they consist of 29, 30 or 31 days. Instead, Opposer claims in its Reply that this issue “...is a question that seems unresolved in the Rules, but fortunately is not crucial to the resolution of this motion...” Thus, while Opposer has now moved slightly away from its original argument, it has not completely rejected it despite the clear and plain meaning of the TMEP.

Now, Opposer claims that “[d]espite Applicant Innis’s declared expertise in trademark law...” the Certificate of Mailing was incorrectly addressed. Opposer accurately points out that Applicant used the following address in its certificate of mailing:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

However, according to Opposer, that is an incorrect street address, incorrect city and incorrect zip code.¹ To support its claim, Opposer cites to TMEP §305.01 and TMEP §305.02(d), requiring trademark-related correspondence, including Certificates of Mailing, be addressed to:

Commissioner for Trademarks

¹ Opposer fails to explain how the PTO received Applicant’s Response to Office Action despite the incorrect address.

P.O. Box 1451,
Alexandria, Virginia 22313-1451

As with the above rule regarding 6-month deadlines, the meaning of the TMEP is very clear, trademark-related correspondence must be sent to the Alexandria, Virginia address. However, as reflected in the attached notice from the PTO, this address did not come into effect until on or about October 4, 2004. See Exhibit A. Indeed, the PTO was not located at the Alexandria, Virginia address when Applicant filed its Response to Office Action in 2003. As any attorney with even a scintilla of experience in the intellectual property field knows, the PTO was formerly located in Arlington, Virginia, at the above address used by Applicant. Therefore, the Certificate of Mailing was correctly addressed, which explains why Applicant's Response to Office Action was both received and accepted by the Trademark Examining Attorney.

Opposer also claims the Certificate of Mailing was improperly executed because the Applicant did not execute it.² Applicant's Certificate was executed by Applicant's Assistant, a widely common practice routinely accepted by the PTO. Nevertheless, Opposer claims that Applicant was required to execute the Certificate because she was both the Applicant and the Attorney. However, Opposer provides no legal basis for that argument. Instead, Opposer simply refers to TMEP §305.02(c), which merely suggests the Certificate should be signed by "...the applicant or the party involved in the proceeding, or by the attorney for such person." Opposer has obviously overlooked the sentence in TMEP §305.02(c), which allows others to execute the Certificate so long as they are "...in a position to know that the mail will be deposited on the

² Again, Opposer suggests that Applicant as an "attorney specialist in intellectual property law" should have known better.

date specified.” Opposer should work at learning the basic rules of trademark practice before making frivolous claims and personal attacks that waste the Applicant’s and especially the Board’s time.

WHEREFORE, Applicant requests Opposer’s Reply to Applicant’s Response to Opposer’s Motion to Declare Application as Abandoned not be considered, but that if it is considered, it be denied.

Date: June 18, 2008

FRIEDMAN LAW GROUP, LTD.

By: /s/ Andrea E. Friedman
Andrea E. Friedman
101 West Grand Avenue
Suite 212
Chicago, Illinois 60610

Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S NEW MOTION TO DECLARE APPLICATION AS ABANDONED has been served upon Avraham Azrieli, Esq., Azrieli & Associates, LLC, 7373 E. Doubletree Ranch Rd., Suite 200, Scottsdale, Arizona, this 18th day of June, 2008, by first class mail, postage prepaid.

/s/ Darlene S. Hofstra

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[Trademarks](#) > Trademark Operation and Trademark Trial and Appeal Board Move to New Offices in Alexandria, Virginia

The Trademark Operation and the Trademark Trial and Appeal Board are moving to the new USPTO campus in Alexandria, Virginia. It is expected that this move will commence on or about October 4, 2004 and be completed on or about December 7, 2004.

The Office encourages trademark applicants and registrants to file documents with the Trademark Operation via the Trademark Electronic Application System ("TEAS"), available at <http://www.uspto.gov>, and to file documents with the Trademark Trial and Appeal Board via the Electronic System for Trademark Trials and Appeals ("ESTTA"), available at <http://esta.uspto.gov>. This is especially important during the transition to the new offices.

NEW ADDRESS FOR PAPER CORRESPONDENCE

Effective October 4, 2004, the new mailing addresses for all paper-filed trademark related correspondence, except for requests to record documents in the Assignment Services Division, requests for copies of trademark documents, and certain documents filed under the Madrid Protocol is:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ADDRESS FOR MADRID FILINGS (unchanged)

International applications, subsequent designations, responses to irregularity notices, requests to record changes in the International Register, requests for transformation, and petitions to the Director to review the actions of the Office's Madrid Processing Unit, when filed by mail, must be mailed to:

Commissioner for Trademarks
P.O. Box 16471
Arlington, VA. 22215-1471
Attention : MPU

NEW ADDRESS FOR HAND AND COURIER DELIVERED CORRESPONDENCE

Beginning Monday, October 4, 2004, all hand and courier delivered correspondence, including Madrid related filings, may be delivered to:

Trademark Assistance Center
James Madison Building - East Wing
Concourse Level
600 Dulany Street
Alexandria, Virginia

Such hand deliveries will only be accepted between 8:30 a.m. and 5:00 p.m. Eastern Standard Time, Monday through Friday, except on holidays.

NEW TELEPHONE NUMBERS

The new telephone numbers for employees and the separate processing units of the Trademark Operation will be made available once the move has occurred and the phone numbers are operational.

Look for these at <http://www.uspto.gov/main/contacts.htm>.

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