

TTAB

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

Nandadi Textile Company Ltd.,)
)
Opposer,)
)
v.)
)
Bulur Giyim Sanayi ve Ticaret Limited)
Sirketi,)
)
Applicant.)

Opposition No.: 91160654
Appln. Serial No. 78/203,296

TRADEMARK FEE PROCESS
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 STATEMENT &
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OPPOSER'S MEMORANDUM IN RESPONSE
TO APPLICANT'S REQUEST FOR RECONSIDERATION OF REMAND

Opposer, Nandadi Textile Company, Ltd. ("Opposer"), by its attorneys, submits its Memorandum in Response to Applicant's Requests for Reconsideration of Remand (hereinafter "Request for Reconsideration") served via First Class mail by Bulur Giyim Sanayi ve Ticaret Limited Sirketi ("Applicant") on December 29, 2004.

I. Introduction

The Examining Attorney for the subject application requested that the Trademark Trial and Appeal Board ("Board") remand the case because Opposer's application, which presents a potential bar to registration of the subject application under Section 2(d) of the Trademark act, had been revived. The Board granted the request of the Examining Attorney and issued an order remanding the subject application pursuant to Trademark Rule 2.130 and suspending this opposition proceeding pending the *ex parte* determination



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of the question of registrability. Applicant filed its Request for Reconsideration on December 29, 2004.

II. Argument

Opposer believes the Applicant's Request for Reconsideration is without merit on three principal grounds: First, the reason for the Board's order is clear and its actions comport with the Trademark Trial & Appeal Board Manual of Procedure. Second, under the given circumstances, it is within the Board's authority to suspend this proceeding on its own initiative, thereby rendering Opposer's outstanding motion and Applicant's response thereto moot. Third, Applicant is in no way prejudiced by the Board's decision to suspend the proceeding. Opposer will discuss these three grounds in turn below.

A. The Reason for the Board's Order are Clear and its Actions Comport with the Trademark Trial & Appeal Board Manual of Procedure

Contrary to Applicant's assertions, the Board's reason for remanding the subject application and suspending this proceeding is clearly stated. The Board's order refers specifically to Trademark Rule 2.130. This rule contemplates the situation where, during an *inter partes* proceeding, a trademark examining attorney learns of facts which "in the opinion of the trademark examining attorney, render the mark in the application unregistrable." Under these circumstances, 37 C.F.R. § 2.130 clearly states that "the Board may suspend the proceeding and refer the application to the trademark examining attorney for an *ex parte* determination of the question of registrability." Such are the facts in this case.

Pursuant to Trademark Rule 2.66 and 37 C.F.R. § 2.66, Opposer's application was revived by the Commissioner For Trademarks on August 20, 2004 after being unintentionally abandoned. As required by Trademark rules, the Examining Attorney for Opposer's application conducted a search of the Office records to identify any later-filed applications for conflicting marks. TMEP § 1208.01(d). Upon information and belief, Applicant's later-filed application was identified during this search. Upon further information and belief, the Examining Attorney for Applicant's application was then notified by the Examining Attorney for Opposer's application that Opposer's earlier-filed application had been revived. This action was also dictated by TMEP § 1208.01(d). As further dictated by Trademark rules, the Examining Attorney for Applicant's application then filed an Examining Attorney's Request for Remand.¹ See TMEP §§ 1208.01(d), 1504.05(a) and TBMP § 515. This request was properly granted by the Board as clearly provided for by 37 C.F.R. § 2.130. The rules addressing the present circumstances are clear. Thus, Opposer is at a loss as to why Applicant finds it necessary to call into question the Board's order or suggest the need for consideration of this matter by the Chief Justice or a three judge panel.

¹ Opposer recognizes that Applicant's Examining Attorney cited the wrong section of the TMEP; however, the Examining Attorney's Request correctly cites to 37 C.F.R. § 2.130 and provides a succinct explanation of the reasons for why the remand was requested as required by TMEP § 1504.05(a).

B. It is within the Board's authority to suspend this proceeding thereby rendering Opposer's outstanding motion and Applicant's response thereto moot.

The Applicant has asserted that "the Interlocutory Attorney's order provides no reasons for the . . . suspension that is the subject of a pending contested motion." However, the Board's order specifically refers to 37 C.F.R. § 2.130 which provides, *inter alia*, that "the Board may suspend the proceeding and refer the application to the trademark examining attorney" after being informed about a question of registrability regarding the mark at issue. Further, TBMP § 510.01 provides that the Board has "the power to stay proceedings, which may be exercised by the Board upon its own initiative." Thus, under the circumstances, Opposer's Motion to Suspend and Applicant's response thereto would seem to be rendered moot.

C. The Applicant is not prejudiced by the suspension of these proceedings.

Opposer and Applicant each applied to register the VIGOSS mark in connection with identical or similar goods. Opposer's application was filed first. However, contrary to USPTO rules of procedure, Applicant's application for the conflicting mark was approved for publication while Opposer's earlier-filed application was still pending. If any party has been prejudiced, it is the Opposer, having been forced into the position of plaintiff in the instant proceeding as a result of the USPTO error. Under the circumstances, it was appropriate to suspend this proceeding to enable the Examining Attorney for Opposer's application to correct the USPTO error and make *ex parte*

determinations which could be potentially dispositive of this case. In the unlikely event Applicant's mark is not refused final registration by the Examining Attorney, the Board will reset all pertinent dates and establish a time for Opposer to respond to discovery requests. See, TBMP § 510.03(b) (stating that "if proceedings have been suspended for consideration of a matter by the examining attorney, including disposition of a party's application before the examining attorney, and the matter does not resolve the case, the Board will issue an order resuming proceedings, and taking further appropriate action.") Accordingly, Applicant has not been prejudiced by the Board's order to suspend the proceedings.

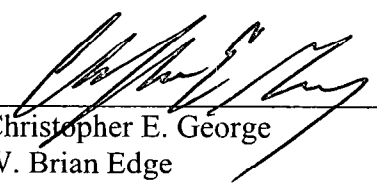
Opposer therefore respectfully requests that Applicant's Request for Reconsideration for Remand be DENIED.

Respectfully submitted,

NANDADI TEXTILE COMPANY LTD.,

Dated: January 18, 2005

By: _____

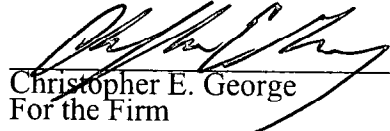

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S RESPONSE TO APPLICANT'S REQUEST FOR RECONSIDERATION OF REMAND was served on counsel for Applicant, this 18th day of January, 2005 via First Class mail, postage prepaid, to:

P. Jay Hines
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke street
Alexandria, Virginia 22314



Christopher E. George
For the Firm

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