

ESTTA Tracking number: **ESTTA296183**

Filing date: **07/20/2009**

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

Proceeding	91187188
Party	Plaintiff North Atlantic Operating Company, Inc.
Correspondence Address	Lawrence W. Greene Cowan, Liebowitz and Latman 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com, asc@cll.com, lwg@cll.com
Submission	Reply in Support of Motion
Filer's Name	Lawrence W. Greene
Filer's e-mail	LWG@CLL.COM, TRADEMARK@CLL.COM
Signature	/Lawrence W. Greene/
Date	07/20/2009
Attachments	THE PAPER - Response to Applicant's Opposition to Motion.pdf ( 5 pages ) (18276 bytes )

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

In The Matter of Application Serial No. 77/316,130  
Filed: October 29, 2007  
For Trademark: THE PAPER  
Published in the Official Gazette of May 27, 2008

----- x

NORTH ATLANTIC OPERATING COMPANY, :  
INC., :

Opposer, :

v. : Opposition No. 91187188

NEW IMAGE GLOBAL, INC., :

Applicant. :

----- x

**OPPOSER’S RESPONSE TO APPLICANT’S OPPOSITION TO OPPOSER’S MOTION  
FOR EXTENSION OF TIME**

Opposer, North Atlantic Operating Company, Inc. (“Opposer”), hereby responds to Applicant’s Opposition to Opposer’s Motion for Extension of Time filed by New Image Global, Inc. (“Applicant”).

**The Board Should Consider this Reply Brief**

Pursuant to Trademark Rule 2.127(a), the Board, in its discretion, may consider reply briefs. This reply brief should be considered by the Board since it helps clarify the issues under consideration. *See Zirco Corp. v. American Telephone and Telegraph Co.*, 21 U.S.P.Q. 2d 1542

(T.T.A.B. 1991) (Board accepted reply brief because it was filed within the prescribed period, and helped to clarify the issues, thereby assisting the Board in its disposition of the motion).

**The Board Should Not Grant Applicant's Opposition to Opposer's Motion For Extension of Time**

In Applicant's Opposition to Opposer's Motion for Extension of Time, Applicant asks the Board to not only deny Opposer's motion but to also dismiss the opposition proceeding because Opposer allegedly missed the January 5, 2009 discovery conference deadline. Opposer respectfully submits that the Board should deny Applicant's request to dismiss the opposition because it is premature. Sanctions such as dismissal of a proceeding cannot be imposed unless the Board has issued an order affirming or reiterating a party's obligations to make disclosures. Trademark Rule 2.120(g)(1). In this case, the Board has not issued any such order. The only order issued by the Board in this proceeding is the institution order dated October 27, 2008. However, an institution order is not a type of order contemplated under Trademark Rule 2.120(g)(1). See *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 U.S.P.Q.2d 1541 (T.T.A.B. 2008) (maintaining a notice of institution which sets a deadline for parties to provide initial disclosures does not constitute an "order of the Trademark Trial and Appeal Board relating to disclosure or discovery" under Trademark Rule 2.120(g)(1)).

Moreover, the circumstances set forth in Trademark Rule 2.120(g)(2) in which the Board may order sanctions such as dismissal of an opposition (such as one party's affirmative refusal to make initial disclosures) are not present here. *Id.* at 1544. Instead, a party's proper remedy concerning another party's alleged failure to participate in a discovery conference is to bring a motion for sanctions "prior to the deadline for any party to make initial disclosures." See Trademark Rule 2.120(g)(1). The deadline for initial disclosures in this opposition was February 4, 2009. Accordingly, Applicant's request for dismissal is improper and should be denied.

Opposer respectfully requests the Board to grant Opposer's motion because there will be no prejudice to Applicant. Opposer alleges extreme prejudice because the "six month extension of time" and thus the delay in the "final adjudication herein and determination of Applicant's rights for half a year" with respect to Applicant's intent-to-use application is unfair to Applicant, and prejudices Applicant's prospective rights in respect of obtaining a trademark registration. However, mere passage of time is generally not considered prejudicial, absent the presence of other facts, such as the loss of potential witnesses or evidence. *See S. Industries Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293 (T.T.A.B. 1997). Here, Applicant has not shown that any of its witnesses and evidence have become unavailable as a result of the delay in proceedings. *See Pumpkin Ltd. v. The Seed Corps.*, 43 U.S.P.Q.2d 1582 (T.T.A.B. 1997).

Furthermore, there is no basis to conclude that Opposer has acted in bad faith. As set out in Opposer's motion, Opposer made good faith attempts to contact Applicant's attorney in an effort to schedule the discovery conference and reschedule the discovery and testimony schedule. If concerned with the timeliness of this proceeding, Applicant could have attempted to mitigate any alleged prejudice by either responding to Opposer's communications or, on its own initiative, contacting the Board to facilitate communication between the parties. *See Guthy-Renker Corp. v. Boyd*, 88 U.S.P.Q.2d 1701 (T.T.A.B. 2008) (Board denied opposer's motion for sanctions holding that "opposer is not entirely blameless and could have conceivably facilitated a resolution of the parties' problems in scheduling a discovery conference, including by requesting the Board's participation in the discovery conference"). However, Applicant made no such effort.

Given that the parties have been unable to effectively communicate in this case, Opposer requests the Board to order the parties to hold a discovery conference and to reset discovery and testimony periods as requested by Opposer.

For all of the above reasons, Opposer's Motion for Extension of Time should be granted and Applicant's opposition to the motion should be denied.

Dated: New York, New York  
July 20, 2009

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: /Lawrence W. Greene/ \_\_\_\_\_  
Arlana S. Cohen  
Lawrence W. Greene  
Sujata Chaudhri

1133 Avenue of the Americas  
New York, New York 10036  
(212) 790-9200

