

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

dmd/gcp

Mailed: September 17, 2016

Opposition No. 91213932

Tessera, Inc.

v.

Forbo Flooring UK Limited

By the Trademark Trial and Appeal Board:

Application Serial No. 79124226, the subject application of this opposition proceeding, is a request for extension of protection to the United States, filed pursuant to Trademark Act § 66(a), 15 U.S.C. §1141f(a).¹

On August 27, 2015, the International Bureau (“IB”) transmitted to the United States Patent and Trademark Office notification of the cancellation of International Registration No. 1039605, upon which the involved extension of protection is based. The IB noted in the notification that the international registration expired on April 18, 2015.

Trademark Rule 7.30 provides as follows:

When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of

¹ Opposer’s change of correspondence address filed on January 15, 2016 is noted. Board records have been updated accordingly.

protection or relevant part shall be the expiration of the corresponding international registration or relevant part.

In light of the cancellation of the international registration, Applicant's involved application Serial No. 79124226 was abandoned in full on August 11, 2015 by the Office.

The extension of protection having been cancelled and the involved application having been abandoned, the burden was then put upon Applicant to show cause why its failure to maintain the international registration should not be deemed to be the equivalent of an abandonment of its involved application without the written consent of the adverse party, and should not result in the entry of judgment against as provided by Trademark Rule 2.135.

On December 28, 2015, Applicant, in response to the Board's November 27, 2015, default notice, informed the Board that the international registration that formed the basis for the opposed application was inadvertently cancelled by the IB, and that Applicant filed the necessary papers for transformation of the opposed application to a U.S. application.²

In view of Applicant's response, the Board will not enter judgment against Applicant under Trademark Rule 2.135. Instead, Opposer is allowed until **October 7, 2016** in which to inform the Board whether it wishes to go forward with this

² Application Serial No. 79124226 was transformed into a US application, Serial No. 76718712, on December 4, 2015, and was published for opposition on January 19, 2016. Inasmuch as the opposition period for the transformed application has now expired, Opposer's remedy with regard to the transformed application lies in a petition to cancel if and when the transformed application Serial No. 76718712 matures into a registration.

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opposition proceeding on the merits, or to have the opposition dismissed without prejudice as moot, failing which this opposition proceeding will be dismissed without prejudice as moot. *See* TBMP § 602.01 (2016).³

Proceedings are otherwise suspended pending Opposer's response to this order.

³ In light of this order, the Board's November 27, 2015, default notice is hereby discharged.