

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: _____

Scott R. Maynard

Date Mailed: October 31, 2003

Express Mail No. EU638394431US



75870394
11-03-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

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

In the Matter of

Registration No.: 2,616,310

Date of Issuance: September 10, 2002

EPAGE, a California general partnership,

Petitioner,

v.

MICHAEL ARTER, an Australian
individual,

Registrant.

Cancellation No. 92/041,999

Petitioner's Motion for Default Judgment

File No.: 22849-2

**I.
INTRODUCTION**

EPAGE, a California general partnership ("EPAGE" or "Petitioner") whose business address is 1815 Via El Prado, Suite 203, Redondo Beach, California 90277, hereby moves, pursuant to Rule 55(b)(2) of the Federal Rules of Civil Procedure and section 317.01 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP")¹ for the entry of a default judgment.

¹All references to the TBMP are to the 1st edition effective September 1995. Though due to be released in September of 2003, the 2d edition of the TBMP was not available at the time of the drafting of this motion.

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The mark holder, Michael Arter, has failed to answer to the Petition to Cancel within the time set forth in the Boards notice of these proceedings mailed on July 22, 2003. Accordingly, Petitioner is entitled to an entry of default judgement.

II.

FACTUAL BACKGROUND

On March 17, 2003 Petitioner EPage initiated the instant action seeking the cancellation of the trademark EPAGES ANYWHERE!, Registration No. 2,616,310 registered to Michael Arter ("Registrant") of 5 Pendle Street Box Hill, Australia, Melbourne Victoria, 03128. (See Petition to Cancel, attached as Exhibit "A").

On May 21, 2003 the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office ("USPTO") sent notice of this action along with a copy of the EPage's Petition to Cancel to the Registrant. In accordance with TBMP §316.01 the TTAB set the due date for Registrant's Answer at forty (40) days from the date of the mailing of the notice or June 30, 2003. (See TTAB Notice, mailed on May 21, 2003, attached as Exhibit "B").

Petitioner served discovery on the Registrant on June 30, 2003. Petitioner served request for admissions, request for production and interrogatories on the Registrant. No response to this discovery was received by Petitioner.

On July 22, 2003 the TTAB resent the notice of the Petition to Cancel and the Petition to Cancel to the Registrant. The notice from the TTAB states that the first notice mailed on May 21, 2003 inadvertently was mailed with insufficient postage and thus was returned. Because of this the TTAB reset the forty (40) day period within which the Registrant was permitted to file an answer. The last date upon which the Registrant could file this answer was September 2, 2003.^{2/} (See Second TTAB Notice, mailed on July 22, 2003, attached as Exhibit "C").

On July 23, 2003 the Registrant mailed a letter to the TTAB and Petitioner stating that he

^{2/}The fortieth (40th) day actually falls on August 31, 2003. However, since the 31st was a Sunday and Monday, September 1, 2003 was Labor Day (a federal holiday) time for filing the answer would be the next business day which was September 2, 2003. See 37 C.F.R. §2.196 (Sensory Publishing 2003).

had recently become aware that the petition to cancel had been filed but that he had never received a copy of the petition.^{3/} (See Registrant's Letter, dated July 23, 2003, attached as Exhibit "D").

Petitioner, reserved its discovery request on August 1, 2003 following the receipt of the second notice from the TTAB and the Registrant's letter. The Registrant has neither responded to discovery propounded by Petitioner nor filed an answer within the time period set by the TTAB.

III.

ARGUMENT

A. Legal Standard

Proceedings before the TTAB are governed by the Trademark Act of 1946, 15 U.S.C. §1051 et seq. and the Trademark Rules of Practice contained in Part 2 of Title 37 of the Code of Federal Regulations. "*Inter partes* proceedings before the Board are also governed by the Federal Rules of Civil Procedure . . . , except as otherwise provided in the Trademark Rules of Practice, and wherever applicable and appropriate; and by the Federal Rules of Evidence. . . ." TBMP §101.02 (Matthew Bender 1995). The TBMP is a manual published by the TTAB to provide practioners with basic information generally useful for litigating cases before it. "It is not meant to modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law." TBMP Introduction (Matthew Bender 1995).

Rule 2.113 provides, in part, that the TTAB's letter notifying the Registrant of the filing of a Petition to cancel "shall designate a time, not less than thirty days form the mailing date of the notification, within which an answer must be filed." 37 C.F.R. § 2.113 (Sensory Publishing 2003). Section 316.01 of the TBMP provides, in part, "[i]t is the general practice of the Board to allow the defendant in . . . [a] cancellation proceeding 40 days from the mailing date of the notification letter in which to file its answer. TBMP §316.01 (Matthew Bender 1995).

^{3/}Presumably, the Registrant became aware of the preceding through the receipt of Petitioners discovery request.

Rule 55(a) provides:

When a party against whom a judgment for affirmative relief is sought has failed to plead or otherwise defend as provided by these rules and that fact is made to appear by affidavit or otherwise, the clerk shall enter the party's default.

Fed. R. Civ. P. 55(a) (West 2003). When one party has failed to plead or otherwise defend as provided above, the other party "entitled to judgment by default shall apply to the court therefore. . . ." Fed. R. Civ. P. 55(b)(2) (West 2003). Likewise, section 2.114(a) of Title 37 C.F.R. provides "[i]f no answer is filed within the time set, the petition may be decided as in case of default." 37 C.F.R. §2.114(a) (Sensory Publishing 2003).

The procedure followed by the TTAB for entering a default judgment is set forth in section 317.01 of the TBMP which provides, in part:

If the defendant fails to file an answer to a complaint during the time allowed therefor, the Board may issue a notice of default. The notice states that no answer has been filed; enters notice of default under FRCP 55(a); and allows the defendant 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it.

....

The issue of whether default judgment should be entered against a defendant, for failure to file a timely answer to the complaint, may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (*in which case the motion may serve as a substitute for the Board's issuance of a notice of default*). . . .

TBMP §317.01 (Matthew Bender 1995)(emphasis added).

B. Registrant is in Default

The Registrant was required to file an answer within the period set forth in the second notice sent out by the TTAB. Thus the date that Registrant was required to file his answer, if it

intended to do so, was September 2, 2003. No answer has been received by the TTAB. It is now more than two months past the answer due date and the Registrant has had nearly three times the allotted time within which to answer the Petition to Cancel. Accordingly, the Registrant is clearly in default.

Accordingly, Petitioner requests that the TTAB accept this Motion for Default Judgment as a substitute as provided for in TBMP §317.01 *infra*.

IV.

CONCLUSION

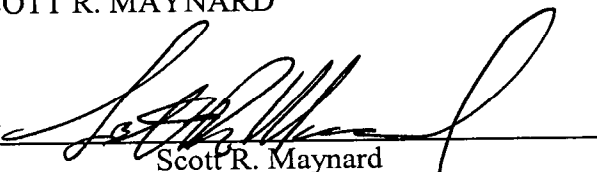
Based on the foregoing, Petitioner requests that the TTAB enter a judgement of default against the Registrant twenty (20) days from the mailing of this motion.

Respectfully submitted,

DATED: October 31, 2003

LEWIS BRISBOIS BISGAARD & SMITH, LLP
DAVID N. MAKOUS
LEO A. BAUTISTA
SCOTT R. MAYNARD

By



Scott R. Maynard

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Los Angeles, California 90012
(213) 250-1800 (Telephone)
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PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is 221 North Figueroa Street, Suite 1200, Los Angeles, California 90012.

On **October 31, 2003**, I served the following document described as **PETITIONER'S MOTION FOR DEFAULT JUDGMENT** on all interested parties in this action by placing ☒ a true copy ☐ the original thereof enclosed in sealed envelopes addressed as follows:

☒ (BY OVERNIGHT DELIVERY/COURIER)

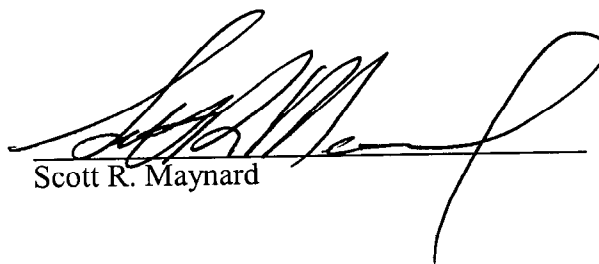
☐ I delivered such envelope to an authorized courier or driver authorized by the express service carrier to receive documents in an envelope or package designated by the express service carrier with delivery fees provided for.

☒ I deposited such envelope in a box or facility regularly maintained by the express service carrier in an envelope or package designated by the express service carrier with delivery fees provided for.

☐ (STATE) I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

☒ (FEDERAL) I declare that I am a member of the bar of this Court at whose direction the service was made.

Executed on October 31, 2003, at Los Angeles, California.


Scott R. Maynard

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513

By: _____

Leo A. Bautista

Date Mailed: March 14, 2003

Express Mail No.: EV197113283US

11-03-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #74

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

In the Matter of

Registration No.: 2,616,310

Date of Issuance: September 10, 2002

EPAGE, a California general partnership,

Petitioner,

v.

MICHAEL ARTER, an Australian
individual,

Registrant.

Cancellation No.

**PETITION FOR
CANCELLATION**

File No.: 22849-2

EPAGE, a California general partnership ("EPAGE") whose business address is 1815 Via El Prado, Suite 203, Redondo Beach, California 90277, believes that it is being or will be damaged by Registration No. 2,616,310 and hereby petitions to cancel same.

As grounds for cancellation, it is alleged that:

1. The mark registered under Registration No. 2,616,310, of Michael Arter ("Arter") consists of the words EPAGES ANYWHERE! and DESIGN.

3. The registrant, Michael Arter, filed the application for said mark on December

23, 1999 and the registration was issued by the United States Patent & Trademark Office on September 10, 2002.

2. The mark was registered pursuant Section 44 of the Trademark Act (15 U.S.C. §1126) based on a foreign registration in Arter's country of origin and claims no use in the United States.

3. The mark was thus registered for use with: "commercial information and directory agency for e-mail addresses, other addresses and contact details; on-line e-mail, telephone and other contact directory information in International Class 35" and "electronic transmission of data and documents, namely e-mail addresses, other addresses and contact details, and messages via telephonic, electromagnetic, electro-optic, and computer terminals in International Class 38."

4. Petitioner, EPage believes that it is being or will be damaged by Registration No. 2,616,310 because:

- A. EPage is an internet business founded in 1994 (prior to Arter's filing of its application in the United States and prior to Arter's filing in his country of origin) and is currently the premier full service on-line Auction and Classified advertising network on the Web. EPage was one of the first 1,500 ".com" companies on the entire web and its internet server (which can be accessed at the Web addresses, <www.epage.com> and <www.ep.com>) now receives over 800,000 internet visitors each month (over 9 million per year), transmits 5.6 million page views per month, and displays over 1 million classified ads per day. EPage currently has 363,967 registered users of one or more of its services and has been viewed by millions.
- B. EPage owns the United States Trademark Registration for the service mark EPAGE Reg. No. 2,087,038, registered August 12, 1997 for "dissemination of advertising for others via on-line electronic communication network," as well as common law rights in the mark EPAGE for these and other services. The mark and registration has become incontestable.

- C. EPAGE's trademark rights have been previously adjudicated in, and enforced by, the United States District Court for the Central District of California.
- D. In addition to the original service of the placement of the classified ads started in 1994, EPage also created and maintains online internet information and directory services (since 1994) , has engaged in electronic transmission of documents and data (since 1994) creates, designs, develops, implements, and maintains web sites and web pages for other businesses and individuals (since 1996), provides information that allows users to build and publish custom websites and web pages (since 1996), provides consultation services (since 1996), performs research, programming, and software design services (since 1996), supports photographic and computer imaging (since 1997), and has been actively offering and licensing technology (since 1999) for building and publishing custom web sites and Web pages.
- E. Since 1994, EPage has used the mark EPAGE on virtually every one of its internet pages, brochures, and other printed documents.
- F. Internet customers have been providing content for classified ads that are placed onto web pages at EPage's website at <www.ep.com > since October 1994. Since then, EPage has added many new products and services which it offers under the service mark EPAGE as the demand arose.
- G. In early 1995, EPage commenced the solicitation of newspapers for the hosting of newspaper classified ads on EPage's website. EPage began hosting and displaying newspaper classifieds on its website in June of 1995 and has hosted up to 100,000 ads per month that originated from newspapers.
- H. In 1995 EPage started offering and performing advisory services to customers on website design, online marketing, and search engine ranking. EPage also created a guide for website owners (known as an "FAQ") on how to announce the presence of their website.

- I. In 1995, EPage began its SearchAlert service that allows customers to create a search phrase used to search ads received each day. Each night an e-mail summary of ads matching the search phrase is sent to the customer. Around 5,000 customers currently use this service.
- J. In October of 1995 EPage created a discount service called the Agent Program for clients placing a significant number of classified ads for other people. This program grew to over 190 registered agents when the program was terminated in mid 1997.
- K. In 1996 EPage created a Usenet newsgroup posting service offering customers the option of placing a summary of their classified ad on a Usenet newsgroup of the appropriate charter and a link to the Web page displaying the customer's full ad content.
- L. In April 1996, EPage created one of the first internet "affiliate programs" (known as EPage's "Classified Service Provider" program, or "CSP"), whereby EPage provides EPage co-branded classified and auction services for inclusion in other affiliate websites.
- M. The CSP program currently has over 25,000 affiliated sites or "affiliates" in its network, including a number of regional portals, hundreds of specialty websites, and a number of Internet Service Providers.
- N. In 1997, EPage began to offer website hosting services, hosting websites.
- O. Around 1998, EPage began offering new services that embedded classified ads and category lists directly into a client's website.
- P. In 1999 EPage began its efforts to license EPage technology to other large institutional users who would use such technology to publish fully customized and branded classified ad sites, which are hosted on EPage's servers.
- Q. Since 1996, EPage has also provided consulting and design services.
- R. EPage thus owns trademark rights in the mark EPAGE in connection with all of

these services.

S. Since 1994, EPage has made prominent use of its mark in connection with its services in the following manners:

- (1) The trademark EPAGE and logo are on virtually every page viewed by its customers since 1994. This combination is shown, at the bottom of every page over five million times each month;
- (2) Since 1994 all outgoing email (since 1998 averaging approximately 600,000 each month) is branded with "EPAGE" as a signature.
- (3) EPage sends out approximately 7,300,000 e-mails each year, all branded with the EPAGE mark;
- (4) EPage displays approximately 68,000,000 pages each year, all branded with the EPAGE mark;
- (5) Since 1994, the recipients of all e-mails sent by EPage see "from EPage" on his/her e-mail mailbox screen;
- (6) EPage has run many banner advertisement campaigns, mostly on Safe Audit and Link Exchange. Safe Audit has displayed approximately 20 million EPage banner ads throughout its affiliate network and Link Exchange has displayed about 12 million EPage banner ads;
- (7) EPage has promoted its mark and services by the attendance of numerous conferences where EPage has made demonstrations and distributed brochures and other written material;
- (8) EPage receives approximately 4,500,000 unique visitors each year;
- (9) EPage has been recognized and published as "EPage" many times over the last 9 years.
- (10) EPage has sponsored and appeared at numerous internet related conferences throughout the United States since 1999;

T. Petitioner EPage believes that it will be and is being damaged by the continued

registration of the mark EPAGES ANYWHERE! & DESIGN in Registration No. 2,616,310.

U. Arter is not entitled to registration of the EPAGES ANYWHERE! & DESIGN mark because:

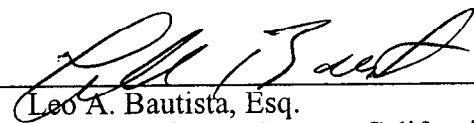
- A. EPage has rights prior to Arter;
- B. The mark consists of or comprises a mark which so resembles the mark EPAGE so as to be likely to cause confusion, mistake or to deceive (15 U.S.C. § 1052(d)); and
- C. EPage's mark EPAGE is famous and Registration No. 2,616,310 dilutes the distinctive nature of EPage's trademark (15 U.S.C. § 1125(c)).

Wherefore, Petitioner EPage prays that Registration No. 2,616,310 be cancelled.

Respectfully submitted,

DATED: March 14, 2003 **LEWIS BRISBOIS BISGAARD & SMITH, LLP**
DAVID N. MAKOUS
LEO A. BAUTISTA

By


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**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board

2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: May 21, 2003

Arter, Michael
5 Pendle Street Box Hill AUX
Melbourne Victoria, 03128

Cancellation No. 92041999

Reg. No. 2616310

LEO A. BAUTISTA
LEWIS BRISBIS BISGAARD & SMITH, LLP
221 N. GIGUEROA STREET SUITE 1200
LOS ANGELES, CA 90012

EPAGE

11-03-2003

U.S. Patent & TMOfo/TM Mail Rpt Dt. #74

V.

Arter, Michael

George Woods, Legal Assistant:

A petition, a copy of which is attached, has been filed to
cancel the above-identified registration.

Proceedings will be conducted in accordance with the
Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Patent and Trademark Rule 1.7 for expiration date
falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the
Trademark Rules of Practice, set forth in Title 37, part 2,
of the Code of Federal Regulations. The parties are
reminded of the recent amendments to the Trademark Rules
that became effective October 9, 1998. See Notice of Final
Rulemaking published in the *Official Gazette* on September
29, 1998 at 1214 TMOG 145. Slight corrections to the
rules, resulting in a correction notice, were published in
the *Official Gazette* on October 20, 1998 at 1215 TMOG 64.
A copy of the recent amendments to the Trademark Rules, as

well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open:	June 10, 2003	C
Discovery period to close:	December 07, 2003	C
30-day testimony period for party in position of plaintiff to close:	(opens) 2.5.04 March 06, 2004	C
30-day testimony period for party in position of defendant to close:	May 05, 2004	C
15-day rebuttal testimony period for plaintiff to close:	6.14.2004 (opens) June 19, 2004	C

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

**TTAB NOT CONCERNING CORRESPONDENCE PRESS
(TRADEMARK RULE 2.18)**

The Trademark Trial and Appeal Board will mail correspondence to only one address for each party.

If a party is located in the U.S., correspondence will be sent to the party's own address, unless (1) papers filed with the Board are filed by a party's attorney, (2) a written power of attorney is filed, (3) a written authorization of some other person entitled to be recognized is filed, or (4) the party requests in writing that correspondence be sent to another address. In these situations, correspondence will be sent, respectively, to (1) the attorney filing papers, (2) the attorney named in the power of attorney, (3) the other person designated in the written authorization, or (4) the other address specified by the party.

When one attorney or other authorized representative makes an appearance on behalf of a party, his address is noted on the proceeding file as the correspondence address. If a second attorney or other authorized representative makes an appearance on behalf of the party, and requests that correspondence be directed to him, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to the second attorney or other authorized representative, rather than to the first one. If the second attorney or other authorized representative does not request that correspondence be sent to him, the Board will continue to send correspondence to the first attorney or authorized representative.

If a power of attorney from a party to one attorney has been filed, and thereafter another attorney or authorized representative makes an appearance on behalf of the party and asks that correspondence be sent to him, the second attorney or authorized representative will be required to submit authorization, from the party or from the first attorney, for the requested change in correspondence address.

If a power of attorney from a party to one attorney has been filed, and thereafter a power of attorney from the party to another attorney is filed, the second power of attorney will be construed as a written request to change the correspondence address from the first attorney to the second one, even if there is no revocation of the first power, unless the party or the first attorney directs otherwise. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney has been filed, and thereafter that attorney files an "associated power of attorney" to another attorney, the correspondence address will remain unchanged, and the Board will continue to send correspondence to the first attorney, unless the first attorney or the party directs otherwise.

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. Thereafter, the correspondence address may be changed as described in Trademark Rule 2.18.

In the case of a party whose registration is the subject of a Board proceeding, any representative which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until another correspondence address is established in the manner described in Trademark Rule 2.18.

THE TRADEMARK TRIAL AND APPEAL BOARD WOULD LIKE YOU TO KNOW:

The TTAB Customer Service Center is available to

- *answer telephone inquiries
- *explain pertinent legal provisions and related administrative practices as they apply to specific cases
- *provide status information on pending cases
- *provide access to the files of pending cases
- *resolve problems

The telephone number for the TTAB Customer Service Center is (703) 308-9300, extension 0 [zero].

The Patent and Trademark Office has two special boxes for expedited processing and distribution of documents filed with the TTAB. Envelopes and transmittal letters for TTAB should be addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202, followed by one of the following designations

"Box TTAB Fee": for papers filed with the TTAB that include filing fees, such as notices of opposition, petitions to cancel, and notices of ex parte appeal
and

"Box TTAB": for all non-fee papers filed with the TTAB, such as requests for extensions of time to file notices of opposition and motions.

The TTAB Customer Service Center makes every effort to provide public access to application files, opposition files, cancellation files and concurrent use files immediately upon request for access. Files located will be made available in a central storage area accessible to the public. You can also access information about TTAB proceeding files online. Go to <http://www.uspto.gov/web/offices/dcom/ttab/> and click the "BISX LINK".

Any questions, comments, or suggestions concerning TTAB service should be directed to Jean Brown, TTAB Technical Program Manager, at (703) 308-9300, extension 123 or Afendi Ziad, Supervisory Legal Assistant at (703) 308-9300, extension 205.

NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)

The Trademark Trial and Appeal Board encourages you to consider alternative dispute resolution as a means of settling the issues raised in this opposition or cancellation proceeding. Although more than 95% of Board proceedings are decided prior to trial (by settlement or by entry of pre-trial judgment), alternative dispute resolution techniques might produce an earlier, mutually agreeable resolution of your dispute or might, at least, narrow the scope of discovery or the issues for trial. In either case, alternative dispute resolution might save you time and money.

Many non-profit organizations, both inside and outside the intellectual property field, offer alternative dispute resolution services. Listed below are the names and addresses of organizations that have indicated that they can make arrangements for alternative dispute resolution. The listings are given for your convenience; the Board does not sponsor nor endorse any particular organization's alternative dispute resolution services.

International Trademark Association Telephone: (212) 642-1726 Fax: (212) 768-7796 www.inta.org/adr/index.shtml e-mail: lstigliano@inta.org	CPR Institute for Dispute Resolution Telephone: (212) 949-6490 Fax: (212) 949-8859 www.cpradr.org e-mail: info@cpradr.org
American Intellectual Property Law Association (AIPLA) 2001 Jefferson Davis Highway Suite 203 Arlington, Virginia 22202 Telephone: (703) 415-0780 Fax: (703) 415-0786	
American Arbitration Association (AAA) Headquarters 140 West 51 st Street New York, New York 10020-1203 Telephone: (212) 484-3266 Fax: (212) 307-4387	

Finally, if the parties consider using alternative dispute resolution in this proceeding, the Board would like to know; and if the parties actually engage in alternative dispute resolution, the Board would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and with what general result. Such a statement from the parties is not required but would be helpful to the Board in assessing the value of alternative dispute resolution in Trademark Trial and Appeal Board proceedings.

PROCEEDING SYNOPSIS

United States Patent and Trademark Office - Trademark Trial and Appeal Board
Trademark Opposition and Cancellation Proceedings Under 15 USC 1063, 1064, 37 CFR 2.101 et seq.

FILING OPPOSITION/CANCELLATION

- ❖ Any person (Opposer) may file a Notice of Opposition within 30 days against any mark published under 15 USC 1062(a) in Official Gazette; may oppose in whole or part.¹
- ❖ Time for filing Notice may be extended by written request to TTAB. A first extension for not more than 30 days will be granted upon request. Further extensions may be granted for good cause. Extensions aggregating more than 120 days from pub. date not granted unless consented to by applicant or extraordinary circumstances. 37 CFR 2.102(c). Request should be in triplicate. 37 CFR 2.102(d).
- ❖ Any person (Petitioner) may file a Petition to cancel a registration in whole or in part, but only under conditions set forth in 15 USC 1064.² Geographic limitation will be considered by TTAB only in concurrent use proceeding. 37 CFR 2.99(h), 2.133(c).
- ❖ Opposer/Petitioner is in position of Plaintiff and Applicant/Respondent is Defendant. 37 CFR 2.116(b).
- ❖ Notice/Petition corresponds to complaint in civil action. 37 CFR 2.116(c).
- ❖ Amendment to pleadings in accord with Rule 15, Fed. Rules of Civil Procedure (FRCP). 37 CFR 2.107, 2.115.

MAILING PROCEDURES

- ❖ Certificate of Mailing or Transmission and Express Mail procedures effective for all papers. 37 CFR 1.8, 1.10.

INSTITUTION OF PROCEEDING; WITHDRAWAL

- ❖ TTAB examines Notice/Petition for formal requirements and sends notification to Defendant, generally within few weeks of filing date. Duplicate copy of Notice/Petition and Exhibits sent to Defendant. 37 CFR 2.105, 2.113.
- ❖ Notice/Petition may be withdrawn without prejudice before Defendant files Answer. 37 CFR 2.106(c), 2.114(c). With written consent of Defendant, later withdrawal may be without prejudice.
- ❖ Defendant may not abandon application or surrender registration without prejudice except with written consent of Plaintiff. 37 CFR 2.135, 2.134.

ANSWER; MOTIONS

- ❖ Time for Answer set by TTAB for 40 days from Notification mailing date.³ Counterclaim should be filed with answer or promptly upon discovery of information supporting Counterclaim. 37 CFR 2.106(b), 2.114(b).

- ❖ Time for reply to Counterclaim set by TTAB for not less than 30 days from TTAB action mailing date. 37 CFR 2.106(b), 2.114(b).
- ❖ Motions may be brought before TTAB in writing and with Brief in support. Brief in opposition thereto, 15 days (30 days for summary judgment motion). Briefs limited to 25 pages. Reply Brief, if filed, 15 days, limited to 10 pages. Reconsideration 30 days after decision; Opposition Brief, 15 days. 37 CFR 2.127. Most motions used in Federal practice are applicable.
- ❖ Motions for Summary Judgment, to Compel, and to Test Sufficiency of Responses to Requests for Admissions, if filed, due before Plaintiff testimony period opens. 37 CFR 2.127(e), 2.120(e), 2.120(h).

TRIAL DATES

- ❖ TTAB issues Order setting opening and close of Discovery and Trial dates. Discovery set for period of 180 days; 30-day Pl. Testimony period closes 90 days after close of Discovery period; 30-day Def. Test. period closes 60 days after Pl. Test. period; 15-day Pl. Rebuttal Test. period closes 45 days after Def. Test. period. 37 CFR 2.120(a), 2.121.
- ❖ In cases where Counterclaim filed, TTAB sets additional time periods for testimony and briefing.

DISCOVERY PERIOD

- ❖ Interrogatories, Reqs. for Prod. Of Docs. & Things, and Reqs. for Adm., if served, must be served by last day of Discovery period. Written Responses within 30 days from date of service of Disc. Reqs. FRCP apply except as otherwise provided. 37 CFR 2.116, 2.120(a). Extension of Time to respond to discovery granted upon cause or by stipulation.⁴
- ❖ Interrogatories limited to proceeding total of 75, counting subparts; additional interrogatories allowed upon motion for good cause or by stipulation. 37 CFR 2.120(d)(1).
- ❖ Discovery Depositions (noticed and taken within Disc. Period) in District where deponent resides or is employed. 37 CFR 2.120(a), 2.120(b). Either party may request designation of witnesses under FRCP 30(b)(6), 31(a).

PLAINTIFF'S TRIAL PERIOD

- ❖ Plaintiff's Testimony-In-Chief. Opens 60 days after Discovery Period closes, and runs for 30 days (refer to Order).

- ❖ Testimony taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Plaintiff serves Transcript of testimony and copies of documentary exhibits on adverse party within 30 days after completion of taking testimony. Certified transcript and exhibits filed with TTAB. 37 CFR 2.125.
- ❖ Notice of Reliance as appropriate on Discovery Deps., Adms. and Int. Answers, with copies of same, due before close of Test. 37 CFR 2.120.⁵
- ❖ Involved app. or reg. files are in evidence for relevant and competent purposes. Publications in gen. Circ. or in libraries, and official records, may be received if appropriate Notice of Reliance is filed and copies submitted within Test. period. 37 CFR 2.122.
- ❖ Motion under 37 CFR 2.132, if filed, due after close of Pl.'s Test. period & before opening of Def.'s.

DEFENDANT'S TRIAL PERIOD

- ❖ Opens 30 days after close of Pl.'s Test. period. Runs for 30 days.
- ❖ Test. taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Notice of Reliance on Discovery responses also due within Test. period, if filed. 37 CFR 2.120.
- ❖ Notice of Reliance on gen. circ. publ. and official records due within Test. period, if filed. 37 CFR 2.122.
- ❖ Def. serves Test. transcript on Pl. within 30 days and files certified transcript and exhibits with TTAB. 37 CFR 2.125.

PLAINTIFF'S REBUTTAL PERIOD

- ❖ Rebuttal Test. period for Pl. opens 30 days after close of Def.'s Test. period and runs for 15 days.
- ❖ Pl. may file Notice of Reliance under 37 CFR 2.120, 2.122, with matter relied on, and take Test. to rebut Def. Test. and other evidence.
- ❖ Pl. serves and files Transcript of Rebuttal Test. and exhibits in accordance with 37 CFR 2.125.

BRIEFS; ORAL HEARING

- ❖ Pl. Brief due 60 days after Rebuttal period closing.⁶
- ❖ Def. Brief, if filed, due 30 days after Pl. Brief due.
- ❖ Pl. Reply Brief, if filed, due 15 days after Def. Brief due. 37 CFR 2.128.

- ❖ Separate Request for Oral Hearing, if filed, due not later than 10 days after Reply Brief due. 37 CFR 2.129.

- ❖ TTAB Notice of Oral Hearing sent to all parties.

Oral Hearing before panel of at least three TTAB judges. 30 minutes for each party. 37 CFR 2.129.

DECISION; RECONSIDERATION; APPEAL

- ❖ TTAB Deliberation. Writing of Opinion and Decision in due course.
- ❖ Request for rehearing, reconsideration or modification, if filed, due within one month. Brief

in opposition due within 15 days. 37 CFR 2.129(c).

- ❖ Any Appeal from TTAB Decision due within two months of Decision or two months after denial of req. for recon. See especially 37 CFR 2.129(d).

NOTE: Footnotes and TTAB addresses and telephone number appear on the back of this sheet.

FOOTNOTES

- (1) Opposer may be any legal entity including a corporation. Opposer must believe that opposer would be damaged by registration of the mark and state the reasons. 15 USC 1063 and 37 CFR 2.101. Notice of Opposition need not be verified. \$200 required fee for each class for each person opposing. 37 CFR 2.6, 2.101(b). May be signed by attorney. 37 CFR 2.101(b). Duplicate copy including exhibits required. Order status and title copies of pleaded registrations in advance and attach to Notice/Petition or introduce as evidence during Testimony-In-Chief period. 37 CFR 2.122.
- (2) Action, grounds and requirements (Footnote 1) for initiation of Cancellation proceeding are similar to those for an Opposition proceeding and are covered in 15 USC 1064, 1092 and 37 CFR 2.111, 2.112. \$200 required fee per class, per person. Duplicate copy required.
- (3) Except Notice/Petition, each paper must be served on opponent. Statement of service (date and manner) is required. Period to respond to Motions and Discovery Requests is extended 5 days when service is by first-class mail, "Express Mail," or overnight courier. 37 CFR 2.119. Action due on weekend or D.C. holiday can be taken on next business day. 37 CFR 1.7.
- (4) Resetting of time to respond to Discovery Request does not result in extension of Discovery period and subsequent testimony periods unless requested. 37 CFR 2.120(a). All consented extensions of time should be filed in triplicate and list specific dates for all subsequent periods affected.
- (5) Except for 37 CFR 2.122(e) documents, documents produced in response to Requests for Production cannot be made of record by Notice of Reliance alone. 37 CFR 2.120(j)(ii).
- (6) Briefs should be typewritten or printed, double-spaced, in at least pica or eleven-point type, on letter paper (8½ x 11). Three copies of briefs required. Alphabetical index of cases required. Length limit of 55 pages, including table of contents, index of cases, description of record, statement of issues, recitation of facts, argument, and summary. Reply brief 25 pages total. 37 CFR 2.128(b).

ADDRESSES AND TELEPHONE

All papers not requiring a fee should be mailed to:

**Box TTAB No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513**

NOTE: For papers with fee, use "Box TTAB Fee"

TTAB Office Location and Telephone Number

**2900 Crystal Drive
South Tower, Suite 9B40
Arlington, Virginia 22202-3513**

Telephone: (703) 308-9300

22849-9
PTO
C

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: July 22, 2003

Cancellation No. 92/041,999

EPage

v.

Michael Arter

11-03-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #74

Andrew P. Baxley, Interlocutory Attorney:

The Board inadvertently forwarded the notice instituting this proceeding and a copy of the petition to cancel that was intended for registrant with insufficient postage for international air mail. The error is regretted.

Accordingly, the above notice, with enclosure, is remailed to registrant with proper international air mail postage.

If there has been any transfer of interest in the involved registration, registrant must so advise the Board and registrant must submit copies of the appropriate documents. See Section 10 of the Trademark Act and Patent and Trademark Rules 3.71 and 3.73.

In view of the circumstances herein, the time for filing an answer to the petition to cancel is extended to forty days from the mailing date of this order. Any discovery requests or notices served that remain unanswered

→ 8/31/03

Cancellation No. 41,999

as of the mailing date of this order must be reserved in accordance with the rules, unless otherwise agreed to by the parties.

In accordance with the Trademark Rules of Practice, discovery is open, and the close of discovery and testimony dates are set as indicated below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

DISCOVERY PERIOD TO CLOSE:

Plaintiff's 30-day testimony period to close:

Defendant's 30-day testimony period to close:

15-day rebuttal testimony period to close:

1/16/04

3/16/04

4/15/04

5/15/04

6/14/04

7/14/04

7/29/04

Briefs shall be filed in accordance with Trademark Rule 1.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Copy

Sender's address:

5 Pendle Street,
Box Hill,
(City of) Melbourne
(State of) Victoria 03128
AUSTRALIA

Telephone: 61-3-9898-5777
Cell/Mobile: 61-(0)411-174-107
Email: michaelarter@lexicon.net

23 July 2003

D

Commissioner for Trademarks
(Box TTAB)
2900 Crystal Drive
Arlington, VA 22202
UNITED STATES OF AMERICA

Dear Madam / Sir

Cancellation proceedings - Trademark
Serial number: 75870294
Registration number: 2616310
Mark: EPAGES ANYWHERE!

I am the owner of the above trademark.

I recently became aware that a "cancellation proceeding" was filed against my trademark and is now pending.

However, I have not received a copy of the petition to cancel nor any other details relating to this cancellation proceeding.

When I rang the Trademark Trial and Appeal Board to find out details, they advised that a copy of the notice of cancellation proceedings was mailed to me on 21 May 2003, but was returned to the USPTO because of insufficient postage paid. However, I was also advised that this letter/notice was never re-sent to me.

Without details of the cancellation proceedings, I am not able to respond.

Therefore, to help me respond and defend my trademark, I would greatly appreciate if you would:

- a) Send to me copies of the notice of the proceedings and other relevant information;
- b) Re-set all dates in relation to these proceedings; &
- c) (When assigned) Advise the name and direct telephone (& fax) number of the USPTO legal assistant/para-legal assigned to this case.

If you have any queries, please do not hesitate to contact me at the above address / telephone number.

Thank you very much.

Yours sincerely

A handwritten signature in black ink, appearing to read 'M. Arter', with a stylized flourish at the end.

Michael Arter

cc: Scott R. Maynard & David N. Makous
Attorneys for Petitioner, EPage
LEWIS BRISBOIS BISGAARD & SMITH LLP
221 N. Figueroa Street, Suite 1200
Los Angeles, CA 90012
(213) 250-1800