

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

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Mailed: March 20, 2009

Cancellation No. 92045081

Money Corp.

v.

TTT Moneycorp Limited

**By the Trademark Trial and Appeal Board:**

By order dated April 24, 2007, the Board denied the parties' cross-motions for summary judgment. As part of the aforementioned order, the Board also required respondent to inform the Board whether it filed a timely Section 8 affidavit in regard to its Registration No. 2396878, which is subject to this proceeding. Additionally, the Board noted in its April 24, 2007 order that respondent, subsequent to the commencement of this case, filed a Section 8 affidavit with respect to its Registration No. 2399042, also subject to this case, whereby it deleted certain services from its originally issued registration, namely, issuing traveler's cheques, commodity brokerage services and banking services. The Board noted that these deletions were made without petitioner's consent. In view thereof, the Board required respondent to show cause why judgment should not be

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entered against respondent with respect to the services deleted from its Registration No. 2399042.

In its May 24, 2007 response, respondent stated that it timely filed a Section 8 affidavit with respect to its Registration No. 2396878. Respondent further noted that, as with its Registration No. 2399042, respondent deleted "issuing traveler's cheques, commodity brokerage services and banking services" from the identification of its originally-issued Registration No. 2396878 when it filed its Section 8 affidavit in connection thereto. Moreover, respondent stated that its decision not to use the marks identified in Registration Nos. 2396878 and 2399042 in commerce in connection with the deleted services was made well prior to the commencement of this case for business reasons unrelated to petitioner or this proceeding. Specifically, respondent contends that, by no later than January 1, 2005, respondent determined that its U.S. business would not expand to cover the deleted services and the period of non-use of the marks identified in Registration Nos. 2396878 and 2399042 in commerce with any of the deleted services exceeded three-years following the registration date for each registration and prior to the institution of this proceeding. Accordingly, respondent claims that it was required to delete these services when it filed its Section 8 affidavits in order to comply with the requirements of Section 8 of the Lanham Act. Respondent's

response is supported by the declaration of Matthew Cook, respondent's solicitor.

Trademark Rule 2.134(b) states that

[a]fter the commencement of a cancellation proceeding, if it comes to the attention of the [TTAB] that the respondent has permitted his involved registration to be cancelled under Section 8..., an order may be issued allowing respondent a set time . . . in which to show cause why such cancellation or failure to renew should not . . . result in entry of judgment.

In establishing the rules of entry of judgment under such circumstances, the Board elaborated on circumstances that would constitute good cause. The Board specifically noted that

[i]f respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of non-use which commenced well before respondent learned of the existence of the proceeding, judgment will be entered against it only and specifically on the grounds of abandonment.

Response to Comments, Trademark Rule 2.134(b), Fed. Reg. 23133 (1983).

In view of the operation of Trademark Rule 2.134(b) and the Board's comments relating thereto and since respondent has sufficiently demonstrated that it abandoned use of its marks in Registration Nos. 2396878 and 2399042 in relation to the deleted services well prior to the commencement of this case for business purposes unrelated to this proceeding or petitioner, judgment is hereby entered against respondent solely on the ground of

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abandonment in connection with the deleted services in both of the aforementioned registrations. See *Marshall Field & Co. v. Mrs. Field Cookies*, 11 UPSQ2d 1154 (TTAB 1989). This case, however, will proceed with petitioner's asserted claim of priority and likelihood of confusion.

As a final matter, it has come to the Board's attention that respondent has permitted its Registration No. 2463593, which is also subject to this proceeding, to be cancelled under Section 8 of the Trademark Act.

In view thereof, respondent is allowed until twenty days from the mailing date of this order to show cause why such cancellation should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party, and should not result in entry of judgment against respondent as provided by Trademark Rule 2.134(a) with respect to its Registration No. 2463593. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent. See Trademark Rule 2.134(b).

If, in response to this order, respondent submits a showing that its failure to file a Section 8 affidavit was the result of inadvertence or mistake, judgment will not be entered against it. In that case, petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without

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prejudice as moot with respect to Registration No. 2463593. See *C. H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) and TBMP § 602.02(b).

Proceedings otherwise remain suspended.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>