

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

Mailed: October 26, 2010

Cancellation No. 92053121
Registration No. 3405467

Linda M. Merritt
Fulbright & Jaworski LLP
2200 Ross Ave Ste 2800
Dallas TX 75201

Energy Efficiency Programs, Inc.

v.

Optimal Innovations Inc.

James T. Nikolai
Nikolai & Mersereau PA
900 2nd Ave S Ste 820
Minneapolis MN 55402-3813

Robert H. Coggins,
Interlocutory Attorney:

A petition to cancel the above-identified registration was filed October 8, 2010. Thereafter, an amended petition was filed October 14, 2010.

Petitioner's amended petition to cancel (filed October 14, 2010) is accepted as a matter of course and is petitioner's operative pleading in this proceeding. Fed. R. Civ. P. 15(a)(1). **Respondent's answer to the amended petition to cancel is due December 1, 2010.**

By way of background, petitioner filed the original petition to cancel on October 8, 2010. In the original petition, petitioner named Optimal Technologies International, Inc. ("OpTech"), as respondent. OpTech is, and was as the time the original petition to cancel was filed, listed as the owner of the subject registration in the Office's database.

After petitioner filed the original opposition, the Board instituted this cancellation proceeding on October 12, 2010, against Optimal Innovations Inc. ("OpInn"), as respondent. OpInn is the assignee of OpTech by way of an assignment filed with the Assignment Services Division at Reel 3740, Frame 0864, on March 17, 2008, a date that falls between the time the underlying application which matured into Registration No. 3405467 was approved for publication and was registered. The Board forwarded a copy of the institution order to OpInn's domestic representative, Linda M. Merritt.

Linda M. Merritt was identified as the domestic representative of OpInn in the March 17, 2008 assignment filed with the Assignment Services Division of the Office. The underlying application also shows that Ms. Merritt had been previously appointed as OpTech's attorney on September 11, 2007. Although William M. Bryner, was later appointed (on November 21, 2008) as respondent's attorney, and thereby supplanted Ms. Merritt as respondent's attorney, the designation of Ms. Merritt as domestic representative was not revoked.

The designation of a domestic representation is not the same as a power of attorney. The designation serves a different purpose, namely, to provide a contact and address for service of process. The designation of a domestic representative does not authorize the person designated to practice before the Office, e.g., to prepare or prosecute the application, or represent a party in a proceeding before the Office. 37 C.F.R. §§2.24(a)(3) and 11.5(b)(2). Similarly, a power of attorney does not serve as a designation of a domestic representative, unless the power of attorney specifically states that the attorney is also the domestic representative on whom may be served notices or process in proceedings affecting the mark. An appointment of domestic representative remains in effect unless specifically revoked or supplanted by appointment of a new domestic representative. See TMEP § 610. Accordingly, at the time the original petition to cancel was filed, Ms. Merritt was respondent OpInn's domestic representative due to her appointment in the assignment coversheet. The record does not show that Ms. Merritt's appointment has been revoked or supplanted.

The Board acknowledges that petitioner included proof that it forwarded a service copy of its original petition to respondent. However, by way of one of petitioner's October 14, 2010 filings, petitioner indicates that petitioner sent the original service copy to Mr. Bryner, as respondent's

presumed attorney, rather than to Ms. Merritt, as respondent's domestic representative. Petitioner states that it later sent a service copy of the original and amended petitions to Ms. Merritt.¹ As provided in amended Trademark Rule 2.111(a), a petitioner must include "proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record." The rule does not direct a petitioner to serve an attorney (e.g., Mr. Bryner), though an attorney should be served if the attorney is the respondent's designated domestic representative. For cancellation proceedings, the reference in the rule to the correspondence address is a reference to the address for the owner of the registration or the domestic representative, if one has been appointed. In this case, a domestic representative had been appointed. Petitioner's proof of service on the original petition (upon Mr. Bryner, as explained in an October 14th filing) was a technically defective, but curable, service. See *Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores*, 91 USPQ2d 1698 (TTAB 2009). Moreover, petitioner immediately served a copy of the original and amended petitions on Ms. Merritt, upon learning that she had been appointed as OpInn's domestic representative. Any future filing must be served on Ms. Merritt unless and until Ms. Merritt's appointment is specifically revoked or supplanted by appointment of a new domestic representative. If an attorney files an answer or other paper for respondent, thereby entering an appearance, petitioner may thereafter forward service copies to that attorney rather than to Ms. Merritt. (Of course, the mere appearance of another attorney will not automatically revoke or supplant Ms. Merritt's appointment as domestic representative.)

For the parties' convenience, an electronic version of the amended petition for cancellation is viewable in the electronic file for this proceeding via the Board's TTABVUE system at the following URL:
<http://ttabvueint.uspto.gov/ttabvue/v?pno=92053121&pty=CAN&no=4>.

As noted earlier in the order, respondent's answer is due December 1, 2010. The schedule is reset as follows:

¹ Petitioner's separate filing (on October 14, 2010) showing proof of service is discouraged. Petitioner should include a certificate of service in the same filing as the document to which the certificate of service applies.

Time to Answer	12/1/2010
Deadline for Discovery Conference	12/31/2010
Discovery Opens	12/31/2010
Initial Disclosures Due	1/30/2011
Expert Disclosures Due	5/30/2011
Discovery Closes	6/29/2011
Plaintiff's Pretrial Disclosures	8/13/2011
Plaintiff's 30-day Trial Period Ends	9/27/2011
Defendant's Pretrial Disclosures	10/12/2011
Defendant's 30-day Trial Period Ends	11/26/2011
Plaintiff's Rebuttal Disclosures	12/11/2011
Plaintiff's 15-day Rebuttal Period Ends	1/10/2012

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

A copy of this order is being mailed to each address below:

Linda M. Merritt
Fulbright & Jaworski LLP
2200 Ross Ave Ste 2800
Dallas TX 75201

Optimal Innovations Inc.
Chamberlain Place, Broad St
Bridgetown Barbados

James T. Nikolai
Nikolai & Mersereau PA
900 2nd Ave S Ste 820
Minneapolis MN 55402-3813

William M. Bryner
Kilpatrick Stockton LLP
1001 W 4th St
Winston-Salem NC 27101