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Date: November 13, 2003

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

**In the Matter of Application Serial No. 76/401734
Published in the Official Gazette on October 29, 2002**



11-13-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

ACTION SOFTWARE, INC.,

Opposer,

Opposition No. 91154431

v.

RIGHT ASCENSION, INC.,

Mark: ADE

Applicant.

**APPLICANT RIGHT ASCENSION, INC.'S BRIEF IN OPPOSITION TO
OPPOSER ACTION SOFTWARE, INC.'S MOTION TO SUSPEND PROCEEDINGS**

Commissioner for Trademarks
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NOW COMES the Applicant, Right Ascension, Inc. ("Applicant"), by its undersigned counsel, and, with this Brief, contests and urges this Trademark Trial and Appeal Board (the "Board") to deny the Motion to Suspend Proceedings Pending Outcome of Civil Action that has

been filed by Opposer, Action Software, Inc. (“Opposer”). While there are several reasons for Applicant’s opposition to the Motion to Suspend Proceedings, each of which is discussed more fully herein, the essential basis for denying Opposer’s Motion is that the pending civil litigation between the parties is not likely to dispose of the issues that are to be determined by the Board regarding the registration of Applicant’s mark.

1. Opposer has provided no basis for opposing Applicant’s registration or for suspending the Board’s Proceedings in this matter.

In its Notice of Opposition, Opposer failed to state how, or to give *any* reason why, it would be damaged by the registration of Applicant’s mark. Opposer has not complied, therefore, with a threshold requirement of this Board and the United States Patent and Trademark Office for opposing the registration, and the Opposition should be dismissed. Under such circumstances, Opposer certainly should not be permitted to stall Applicant’s registration effort any further. Instead, these proceedings should advance as currently scheduled.¹

Similarly, Opposer has failed to provide in its Motion to Suspend any specific basis for delaying these proceedings. Opposer merely argues that the civil case pending at 01-CV-0666 in the U. S. District Court for the Western District of Pennsylvania “will likely be dispositive of the issues before this Court.” As noted below, Right Ascension believes that argument to be incorrect, and that the civil litigation is not likely to resolve any issues to be considered by this Board or the Patent and Trademark Office. To assist the Board in weighing the argument raised in Opposer’s Motion, Right Ascension has attached to this Brief as Exhibit 1 a copy of its Memorandum in Opposition to Defendants’ Motion for Summary Judgment that was filed in the civil litigation, together with portions of material relevant to these proceedings that was included as exhibits to said Memorandum.²

¹ As of this date, the scheduled periods for discovery and plaintiff/Opposer’s testimony already have closed, and Opposer has not submitted a separate motion to extend the pretrial deadlines.

² Due to its voluminous nature – approximately four inches in thickness – and the inclusion of materials filed under seal, Right Ascension has not included with Exhibit “1” hereto all of the material that was attached to and filed with

Opposer has not cited any specific support for its contention that the pending motion in federal court will resolve the trademark opposition. The case law and other support cited in Opposer's Motion to Suspend generally concern this Board's authority and power to suspend proceedings and, so, are not specifically addressed in this Brief.³

2. The issues in this proceeding are not the same as those in the civil litigation.

An examination of the claims and defenses in the civil litigation involving these parties shows that, contrary to Opposer's argument, the issues to be resolved by the District Court and the issues to be resolved in this Opposition proceeding are not the same. (*See* the Amended and Supplemental Complaint, attached as an exhibit to Opposer's Motion to Suspend, and Exhibit "1" hereto). Of primary significance is that the relevant time period for the arguments and defenses in the civil litigation – late 2000 to early 2001 – is not the same time period that concerns the current registration application. In the approximately three years that have passed since the events that gave rise to the lawsuit, Applicant has continued to use ADE mark in connection with the offer and sale of its services and products. Thus, any finding by the District Court regarding the nature and use of the ADE mark during the time period relevant to that lawsuit should not control the decisions of this Board or, ultimately, the Patent and Trademark Office.

As can be seen by a review of the documents from the civil case that now have been submitted to this Board by the parties, the trademark-related issues in the civil litigation are entirely based upon Opposer having copied materials wholesale from Applicant's web site in the form of digital files, some of which contained Applicant's ADE mark. Opposer then placed

the Memorandum in Opposition to Defendants' Motion for Summary Judgment. Instead, only Exhibit "D" of the Memorandum (Declaration of Mike Barry) and sub-exhibit "F" thereto have been included in Exhibit "1" hereto. Upon request, Right Ascension will provide to the Board additional material that was filed as exhibits to the Memorandum in Opposition to Defendants' Motion for Summary Judgment.

³ Those sections of Opposer's Motion, including the citations listed therein, appear to have been taken directly from the Trademark Trial and Appeal Board Manual of Procedure, § 510.02.

these materials on its own web site, with little or no alteration, in order to benefit commercially from not having to prepare or obtain such materials by its own expense and efforts.

Opposer's defense of the trademark infringement claims in the civil litigation, as well as in these proceedings, consists of nothing more than spurious attempts to deflect attention from the fact that it copied and used materials from Applicant's web site, some of which still contained Applicant's ADE service mark when placed by Opposer on its web site. (*See, e.g.*, Exhibit "D", sub-exhibit "F", of the Memorandum in Opposition to Defendants' Motion for Summary Judgment, attached as part of Exhibit "1" hereto). There is no claim by Opposer in the civil litigation or in these proceedings that it created the ADE mark or a similar mark, that it is entitled to use the ADE mark, that it wants to use the ADE mark, or that the registration of the mark by Applicant will harm Opposer in any way.

Instead, Opposer has focused only upon Applicant's use of its mark on certain product images that appeared on its adultdvdempire.com web site, and then has argued that by placing its mark on such images Right Ascension was attempting to claim creative ownership of such products. Right Ascension has made no such claims, however, and has denied the otherwise unsupported allegations by Opposer. It is readily apparent that Right Ascension merely was the on-line retailer of various products made by others, namely, third party movie studios. It also is undisputed that Applicant used and uses the mark in other ways.

3. The pending civil litigation will not dispose of the issues to be determined by these proceedings.

As noted above, while Opposer may be able to point to the presence of the same issues in the civil litigation that it has asserted in its Notice of Opposition, the issues apply to very different facts, circumstances and claims. As a result, the pending civil litigation, which will determine whether Opposer is liable for, *inter alia*, trademark infringement, will not determine whether or not Applicant's mark can be registered at this time.

Moreover, Opposer's Motion to Suspend implies that a ruling is imminent on its summary judgment motion filed in the civil litigation, when, in fact, that is not likely to be the case. As a more accurate indication of the time within which the parties realistically can expect to conclude their civil litigation, a motion to dismiss filed by other defendants in the civil litigation remains pending after more than a year. Also, Right Ascension has established that a myriad of factual issues exist that, it believes, preclude any adverse summary disposition of its claims under 15 U.S.C. §1125(a) and (c) and its common law claims related to the ADE mark.

A suspension of the opposition proceedings at this point would only serve to delay indefinitely the registration process and the benefits of trademark registration to which Right Ascension otherwise is entitled. On the other hand, allowing the process to continue as scheduled and, even, the successful registration of the mark by Applicant will not affect the course or outcome of the civil litigation.

In summary, Opposer's motion to suspend these proceedings should be denied because (a) Opposer has not sufficiently alleged any harm or damage that it might incur from the registration of Applicant's mark; (b) Opposer has not sufficiently identified how the resolution of issues in the civil litigation will resolve the issues in these proceedings; (c) the issues in the civil litigation are not the same as the issues in this Opposition proceeding; and (d) the pending civil litigation will not dispose of or have a bearing upon the issues to be determined by these proceedings.

WHEREFORE, the Applicant, Right Ascension, Inc., contests the Motion to Suspend Proceedings filed by Opposer, Action Software, Inc., and respectfully requests that the Board deny said Motion and move forward with the proceedings as scheduled.

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