

TTAB

Member of California
and Oregon State Bars

PETER H. SMITH
ATTORNEY AT LAW
1535 J STREET, SUITE A
MODESTO, CALIFORNIA 95354
WEBSITE: WWW.PHSMITH.COM
E-MAIL: PETERHSMITH@SBCGLOBAL.NET

Telephone (209) 579-9940
Facsimile (209) 579-9940

October 24, 2007

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

7/8/2009, 895

Re: Opposition No. 91162780 and Counterclaim for Cancellation
Applicant/Petitioner: Keith Cangiarella
Opposer/Respondent: Gold Shells, Inc. (aka Message In A Bottle, Inc.)

Ladies/Gentlemen:

I am enclosing the originals of (1) Opposition to Applicant's Motion to Dismiss, (2) Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion to Dismiss, and (3) Opposition to Applicant's Motion for Leniency and to Amend Petition to Cancel, each for filing in the above-referenced proceeding.

I am also enclosing a copy of the first page of each of these documents. Please endorse these pages with your file stamp and return them to me in the enclosed self-addressed, stamped envelope to acknowledge your receipt and filing of these documents.

Thank you.

Very truly yours,



Peter H. Smith

PHS/clf
Enclosures

cc: Gold Shells, Inc.
Mr. Roger Rojas

10-26-2007

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

In the Matter of Trademark Application Serial
No. 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

Opposition No. 91162780 and
Counterclaim for Cancellation

In the Matter of Trademark Registration No.
2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

GOLD SHELLS, INC.,
Respondent.

**OPPOSITION TO APPLICANT'S MOTION TO DISMISS OPPOSITIONS
AND AFFIDAVIT OF ROGER ROJAS**

Applicant Keith Cangiarella has filed a Motion to Dismiss the opposition proceeding herein and/or the opposition by Opposer Gold Shells, Inc., to Applicant's motion for summary judgment, and the recent affidavit of Roger Rojas, on the basis that Gold Shells, Inc., no longer exists as a corporate entity.

Opposer respectfully submits that Applicant is wasting the Board's time with such a motion, as Applicant's motion is based on the false assumption that Gold Shells, Inc., has been dissolved. As demonstrated by the new Affidavit of Roger Rojas, filed simultaneously herewith, that is not the case. Gold Shells, Inc., simply changed its name to Message In A Bottle, Inc., which has no effect on the present proceeding.

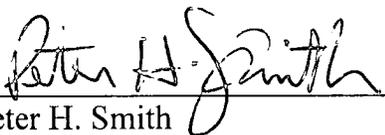
For the Board's information, Opposer confirms that this name change was made by corporate resolution dated July 10, 2007, but the undersigned saw no urgency in informing the Board or the

Applicant of this change since it has no substantive effect on the present proceeding, and in fact using the Opposer's new name in the context of this proceeding could cause confusion for all involved. For the purpose only of this proceeding, I propose to continue referring to Opposer as Gold Shells, Inc., with the understanding that its official corporate name is now Message In A Bottle, Inc.

Applicant's motion was declared by him to have been served on October 5, 2007, by first-class mail. Therefore, this response, being filed on October 24, 2007, is timely filed pursuant to 37 CFR §2.119(c), allowing an additional five days to the normal time for response under 37 CFR §2.127(a).

Opposer therefore respectfully requests that Applicant's motion be denied.

Dated: October 24, 2007



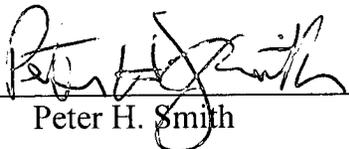
Peter H. Smith
Attorney at Law
1535 J Street, Suite A
Modesto, CA 95354
Telephone: (209) 579-9524
Facsimile: (209) 579-9940

Attorney for Opposer and Respondent
Gold Shells, Inc., now known as
Message In A Bottle, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Applicant's Motion to Dismiss Oppositions and Affidavit of Roger Rojas was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on October 24, 2007.

Dated: October 24, 2007



Peter H. Smith

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR §2.197

MARK: MESSAGE IN A BOTTLE

REGISTRATION NO.: 2,243,269

OPPOSITION NO.: 91162780

MAILING DATE: October 24, 2007

NAME OF PARTY FILING PAPER: Gold Shells, Inc.

TYPE OF PAPER BEING FILED: Opposition to Applicant's Motion to Dismiss Oppositions and Affidavit of Roger Rojas

I hereby certify that the above-identified Opposition to Applicant's Motion to Dismiss Oppositions and Affidavit of Roger Rojas, dated October 24, 2007, which is attached, is being deposited on October 24, 2007, with the United States Postal Service by first-class mail, postage prepaid under 37 C.F.R. §2.197 in an envelope addressed to:

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Peter H. Smith

Date: October 24, 2007

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

| | |
|--|--|
| <p>In the Matter of Trademark Application Serial No. 78/229,875 Mark: MESSAGE IN A BOTTLE</p> <p>GOLD SHELLS, INC., a California corporation, Opposer,</p> <p>v.</p> <p>KEITH CANGIARELLA, Applicant.</p> <hr/> <p>In the Matter of Trademark Registration No. 2,243,269 Mark: MESSAGE IN A BOTTLE</p> <p>KEITH CANGIARELLA, Petitioner,</p> <p>v.</p> <p>GOLD SHEELS, INC., Respondent.</p> | <p>Opposition No. 91162780 and Counterclaim for Cancellation</p> |
|--|--|

**AFFIDAVIT OF ROGER ROJAS IN SUPPORT OF OPPOSITION
TO APPLICANT'S MOTION TO DISMISS**

I, Roger Rojas, being sworn, say:

1. I am the Chief Executive Officer of Gold Shells, Inc., a California corporation. On July 10, 2007, Gold Shells, Inc., changed its name to Message In A Bottle., Inc., and on July 19, 2007, a certificate of an amendment to the articles of incorporation changing the name was filed with the California Secretary of State. A true and correct copy said certificate is attached hereto as Exhibit A.

2. There has been no change to Gold Shells, Inc., other than a change of its official corporate name, and it remains a California corporation in good standing.

The foregoing facts are known to be true of my own knowledge. I am competent to testify to

such facts, and would so testify if I appeared before the Board as a witness at the trial of this matter.

Dated: October 24, 2007

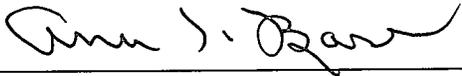


ROGER ROJAS

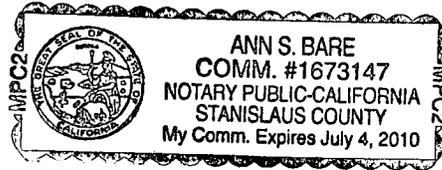
STATE OF CALIFORNIA)
) ss
COUNTY OF STANISLAUS)

On October 24, 2007, before me Ann S. Bare, a notary public, personally appeared ROGER ROJAS, proven to me to be the person whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.



My commission expires: _____



CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion to Dismiss was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on October 24, 2007.

Dated: October 24, 2007



Peter H. Smith

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR §2.197

MARK: MESSAGE IN A BOTTLE

REGISTRATION NO.: 2,243,269

OPPOSITION NO.: 91162780

MAILING DATE: October 24, 2007

NAME OF PARTY FILING PAPER: Gold Shells, Inc.

TYPE OF PAPER BEING FILED: Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion to Dismiss

I hereby certify that the above-identified Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion to Dismiss dated October 24, 2007, which is attached, is being deposited on October 24, 2007, with the United States Postal Service by first-class mail, postage prepaid under 37 C.F.R. §2.197 in an envelope addressed to:

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Peter H. Smith

Date: October 24, 2007



State of California Secretary of State

I, DEBRA BOWEN, Secretary of State of the State of California, hereby certify:

That the attached transcript of 1 page(s) has been compared with the record on file in this office, of which it purports to be a copy, and that it is full, true and correct.



IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of

JUL 24 2007

DEBRA BOWEN
Secretary of State

CERTIFICATE OF AMENDMENT OF
ARTICLES OF INCORPORATION

JUL 19 2007

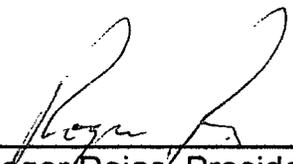
The undersigned certify that:

1. They are the president and the secretary, respectively, of Gold Shells, Inc., a California corporation, Secretary of State file no. 2545928.
2. Article One of the Articles of Incorporation of this corporation is amended to read as follows:

"1.1 The name of this corporation shall be Message In A Bottle, Inc."
3. The foregoing amendment of Articles of Incorporation has been duly approved by the board of directors.
4. The foregoing amendment of Articles of Incorporation has been duly approved by the required vote of shareholders in accordance with Section 902, California Corporations Code. The total number of outstanding shares of the corporation is 10,000,000. The number of shares voting in favor of the amendment equaled or exceeded the vote required. The percentage vote required was more than 50%.

We further declare under penalty of perjury under the laws of the State of California that the matters set forth in this certificate are true and correct of our own knowledge.

DATE: July 10, 2007



Roger Rojas, President



Adrianna Rojas, Secretary



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

In the Matter of Trademark Application Serial
No. 78/229,875

Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark Registration No.
2,243,269

Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

GOLD SHELLS, INC.,
Respondent.

Opposition No. 91162780 and
Counterclaim for Cancellation

**OPPOSITION TO APPLICANT'S MOTION
FOR LENIENCY AND TO AMEND PETITION TO CANCEL**

Applicant Keith Cangiarella has filed a motion dated October 5, 2007, asking the Board for leniency in his failure to file a prior motion to amend his counterclaim (which was filed on or about December 10, 2004) for cancellation of Opposer's existing service mark registration for MESSAGE IN A BOTTLE to include genericness as a ground for cancellation. Opposer Gold Shells, Inc., opposes this motion on the following grounds:

Applicant alludes to a somewhat oblique reference in his original counterclaim to the Opposer's predecessor's having filed his original service mark application "with the intent to avoid a potential descriptiveness refusal", and on that basis Applicant argues that he actually included genericness as a ground for cancellation. Opposer submits that this does not make sense for two reasons: (1) The counterclaim does not actually allege that the mark is descriptive; and (2) Even if the counterclaim is

read as having alleged descriptiveness, that is not the same as having alleged genericness, and it is clear that the counterclaim contained no allegation of genericness. Descriptiveness is not a possible ground for cancelling Opposer's incontestable registration. Thus, Applicant has tried to move for summary judgment based on an unplead allegation. A party may not obtain summary judgment on an issue that has not been pleaded. (TBMP §528.07(a); Fed. R. Civ. P. 56(a) and 56(b)).

Applicant then argues that Opposer did not object to the unplead claim of genericness. This, however, is not true. See Section B of Opposer's Part IV, "Analysis and Argument", on page 13 of Opposer's Opposition to Motion for Summary Judgment: "Applicant's Motion for Summary Judgment based on genericness is procedurally defective in that Applicant has not pleaded genericness in his pleadings herein." This was a clear objection to Applicant's raising the unplead claim. Opposer's following argument of lack of genericness in paragraph C of its argument (starting on page 14) is merely a fallback argument in the event that the Board should choose to consider Applicant's genericness allegation despite his having not pleaded it.

This is not the first time that the Applicant has asked for leniency due to his acting on his own behalf rather than through counsel. There is no basis for such leniency in the law or the rules. Opposer submits that Applicant's status as an "in pro per" party is irrelevant to any of the proceedings herein, including Applicant's Motion for Summary Judgment and his Motion to Amend Petition to Cancel. Opposer submits that Applicant is no more entitled to "leniency" than any other party, represented or unrepresented, and requests denial for his motion for leniency.

Applicant cites TBMP §528.07(b). However, the relevant part of that section says, ". . . if a

party seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, and the party moving for summary judgment treats the unpleaded matter on its merits, and does not object thereto on the ground that the matter is unpleaded, the Board may deem the pleadings to have be amended, by agreement of the parties, to allege the matter.” (Emphasis added). In this case, as noted, Opposer clearly objected that the matter was unpleaded, and included argument on the unpleaded claim of genericness only in the event that the Board viewed the claim as having been pleaded.

As to the amendment of pleadings, the Federal Rules of Civil Procedure apply to the Board’s proceedings. See 37 CFR §2.116. Fed.R.Civ.P. Rule 15(a) says, except for situations not applicable here, “. . . a party may amend the party’s pleading only by leave of court or by written consent of the adverse party; and leave shall be freely given when justice so requires.” (Emphasis added.). However, in this case, Applicant clearly does not have the written consent of Opposer for amendment of his counterclaim, and justice clearly does not require the amendment. Applicant filed his counterclaim on December 10, 2004, yet seeks to bring in a very substantive and serious amendment through the back door of his motion dated October 5, 2007, almost three years later. The discovery period has been completed, and Opposer submits that it would be prejudiced by allowing the counterclaim to be amended to include a genericness allegation at this stage of the proceedings. TMBP §507.02(a) says, “The timing of a motion for leave to amend under Fed.R.Civ.P. 15(a) plays a large role in the Board’s determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no

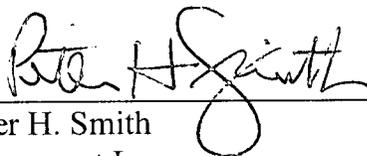
question of newly discovered evidence) may render the amendment untimely. See Long John Silver's, Inc., vs. Lou Scharf, Inc., 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on eight additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed, and the discovery period had already been extended).

In the present case, Applicant is not able to argue that his motion to amend is based on any new evidence or new information which was not available to him at the time he filed the counterclaim in 2004.

Applicant's motion was declared by him to have been served on October 5, 2007, by first-class mail. Therefore, this response, being filed on October 24, 2007, is timely filed pursuant to 37 CFR §2.119(c), allowing an additional five days to the normal time for response under 37 CFR §2.127(a).

For the above reasons, Opposer respectfully requests that Applicant's Motion for Leniency and to Amend Petition to Cancel be denied.

Dated: October 24, 2007



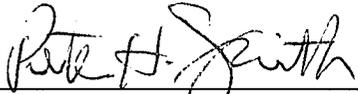
Peter H. Smith
Attorney at Law
1535 J Street, Suite A
Modesto, CA 95354
Telephone: (209) 579-9524
Facsimile: (209) 579-9940

Attorney for Opposer and Respondent
Gold Shells, Inc., now known as
Message In A Bottle, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Applicant's Motion for Leniency and to Amend Petition to Cancel was mailed by first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on October 24, 2007.

Dated: October 24, 2007



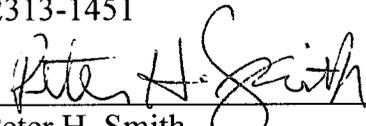
Peter H. Smith

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR §2.197

MARK: MESSAGE IN A BOTTLE
REGISTRATION NO.: 2,243,269
OPPOSITION NO.: 91162780
MAILING DATE: October 24, 2007
NAME OF PARTY FILING PAPER: Gold Shells, Inc.
TYPE OF PAPER BEING FILED: Opposition to Applicant's Motion for Leniency and to Amend Petition to Cancel

I hereby certify that the above-identified Opposition to Applicant's Motion for Leniency and to Amend Petition to Cancel, dated October 24, 2007, which is attached, is being deposited on October 24, 2007, with the United States Postal Service by first-class mail, postage prepaid under 37 C.F.R. §2.197 in an envelope addressed to:

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Peter H. Smith
Date: October 24, 2007