

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

coggins/wellington

Mailed: October 24, 2006

Opposition No. 91165689

Pietrantonio Mendez &
Alvarez LLP

v.

Bodies In Motion, Inc.

Before Bucher, Rogers and Drost,
Administrative Trademark Judges.

By the Board:

On August 24, 2005, the Board denied opposer Pietrantonio Mendez & Alvarez LLP's (hereinafter "PMA") motion to substitute Zen Spa Enterprises, Inc., d/b/a Zen Spa & Health Studio (hereinafter "Zen"), as the party plaintiff. Further, the Board allowed PMA thirty days to affirm its standing to bring the instant opposition proceeding, failing which the opposition would be dismissed in accordance with Fed. R. Civ. P. 12(b)(6).

On September 23, 2005, PMA filed a response which consists of arguments in support of its previously-

denied motion to substitute Zen as the party plaintiff.¹ Indeed, opposer makes no attempt to argue that it has standing to bring the opposition. In view thereof, we treat PMA's showing as a motion for reconsideration of the Board's August 24, 2005 decision under Trademark Rule 2.127(b).

Before addressing opposer's constructive motion for reconsideration, we note the following history involving the institution of this proceeding.

On May 23, 2005, PMA, a law firm, filed two requests for extension of time to oppose application Serial Nos. 76578382 and 76578388 using the Electronic System for Trademark Trials and Appeals (ESTTA).² On the same date, the Board granted these requests and, clearly identifying PMA as the "potential opposer,"

¹ On June 6, 2006, PMA and Zen jointly filed a new power of attorney. This paper, as well as opposer's September 23, 2005 response, failed to indicate proof of service on applicant, as required by Trademark Rule 2.119. In order to expedite this matter, a copy of these papers is forwarded herewith to applicant's counsel, who on December 27, 2005 was newly appointed by submission of a power of attorney in the underlying applications. Opposer is reminded, however, that strict compliance with Trademark Rule 2.119 is required by the parties whenever papers are filed with the Board.

² A separate request for an extension of time to oppose application Serial No. 76578382 was filed in the name of Janine Guzman, Esq., an attorney with the PMA law firm. However, because only PMA filed an opposition, the extension request filed in Ms. Guzman's name is not at issue.

allowed PMA until June 25, 2005,³ to file a notice of opposition.

On June 27, 2005, PMA filed a notice of opposition against both applications. On June 28, 2005, this opposition proceeding was instituted.⁴

We now turn to PMA's constructive motion for reconsideration of the Board's August 24, 2005 order denying PMA's motion to amend the notice of opposition to substitute Zen as the opposer.

Generally, the premise underlying a motion for reconsideration under 37 CFR § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. See TBMP § 518 (2d ed. rev. 2004). Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the

³ Because June 25, 2005 fell on a Saturday, PMA was allowed until June 27, 2005 (the next business day) to take action. See Trademark Rule 2.196.

⁴ Although this opposition was instituted against application Serial Nos. 76578382 and 76578388, Registration No. 2991288 inadvertently issued from application Serial No. 76578382 on September 6, 2005. Because the Board's final determination herein is in applicant's favor and the inadvertent issuance was just discovered, the applicant has the option of keeping the registration or requesting that it be cancelled as inadvertently issued, restored to application status, and then reissued. See TBMP § 216 (2d ed. rev. 2004).

original motion. Rather, the motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board ruling to be reconsidered was in error and requires appropriate change. While PMA's motion for reconsideration contains many of the same arguments put forth by PMA in support of its original motion, the Board will nonetheless address these arguments for the sake of completeness.

Again, as with its original motion, PMA seeks to amend the complaint to substitute Zen as the party plaintiff. When it is shown to the satisfaction of the Board that a party in whose name a complaint was filed was misidentified by mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest. TBMP § 512.04 (2d ed. rev. 2004).

A misidentification by mistake means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. See *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638 (Fed.

Cir. 2003); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

The concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor and assignee, or survivor of a merger) and the relationship shared by "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§ 1055 and 1127. See *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000). It does not, however, include the attorney/client relationship. See *In re Spang Industries, Inc.*, 225 USPQ 888 (Comm'r 1985). Thus, the only basis opposer PMA may have for changing the party plaintiff is a claim of mistake.

PMA blames its misidentification error on its misinterpretation of the ESTTA extension request form. PMA states that it mistakenly placed its name instead of Zen's name in the "Potential Opposer Name" field in the extension request forms in ESTTA, and that it did not learn of its mistake until August 9, 2005⁵ when it noticed its name instead of Zen's name in the caption

⁵ Opposer PMA presumably means July 9, 2005 as the date on which it claims it learned of its mistake, since the notice of opposition was filed June 27, 2005 and the motion to substitute Zen was filed July 14, 2005.

of Office records regarding the instant opposition proceeding.

PMA's error in filing the extension requests, and ultimately the notice of opposition, in its own name was not a misidentification by mistake warranting an amendment of the complaint to substitute Zen as the party plaintiff under Fed. R. Civ. P. 15(a). PMA did not merely make a mistake in providing the form of Zen's name or entity type. PMA erred by providing its own name instead of Zen as the potential opposer. By naming itself as the potential opposer, PMA named a different existing legal entity than the actual party concerned with the applications, i.e., Zen.

Before permitting submission of an extension request, ESTTA creates a signature page and a separate validation page that both present the potential opposer's name, address, and entity designation for review and approval by the filer.⁶ These pages provided PMA with two additional opportunities to

⁶ The pages use the following pattern: "Pursuant to 37 C.F.R. Section 2.102, [*the name, address, entity type, and citizenship of potential opposer are then listed, based on the information provided by the ESTTA filer*] respectfully requests that he/she/it be granted a 30-day extension of time to file a notice of opposition against the above-identified mark."

notice its error in naming itself instead of Zen as the potential opposer in the extension requests.

Further, on May 25, 2005, the date on which PMA submitted the electronic extension requests, ESTTA generated and sent⁷ to PMA automatic responses to the requests. Each stated "The request to extend time to oppose is granted until 6/25/2005 on behalf of potential opposer Pietrantonio Mendez & Alvarez LLP." Upon reviewing the automatically generated ESTTA responses, PMA should have noticed its error in using these names instead of Zen's name as the potential opposer.

Finally, by filing two separate extension requests for application Serial No. 76578382, each utilizing a different name, i.e., PMA in one and Janine Guzman in the other, opposer clearly was aware that it was possible to file multiple extension requests in various names. Thus, it could also have filed one in the name of Zen, if it was unsure whether to list in the ESTTA extension request form the name of counsel or client.

⁷ Automatically generated responses in ESTTA are e-mailed to any e-mail addresses provided and also mailed to the street address provided. In the requests at issue the responses were e-mailed to jguzman@pmalaw.com and abeltran@pmalaw.com and also mailed to Janine Guzman, Esq., Pietrantonio Mendez & Alvarez LLP, 209 Muñoz Rivera Avenue Popular Center 19th Floor, San Juan, PR 00918.

PMA had until May 25, 2005 to correct its error by filing new extension requests in the name of the proper party before the end of the thirty-day period after publication of the marks in the *Official Gazette*.⁸

The ESTTA home page⁹ warns users:

Using ESTTA, you can make TTAB submissions online. While the different sections of the forms may appear straightforward and easy to fill out, you are strongly advised to read the instructions for EACH section prior to completing it. If you fail to follow the instructions, you might fill out sections of the form incorrectly and jeopardizing your legal rights.

Notwithstanding this warning, PMA misidentified the potential opposer in its extension requests.

PMA has not shown that the error in providing its own name instead of the name of its client Zen in its extension requests and notice of opposition was a misidentification by mistake within the meaning of Trademark Rule 2.102(b). The Board therefore denied PMA's proposed amendment of the notice of opposition to substitute a different party plaintiff. By its constructive request for reconsideration, PMA has not shown that the Board erred in any way. Accordingly,

⁸ The marks were published on April 26, 2005.

⁹ The ESTTA home page is <http://estta.uspto.gov/>.

PMA's motion for reconsideration of this decision is denied.

We now turn to PMA's standing to bring the instant opposition proceeding. In its September 23, 2005 response, PMA does not argue that it has standing to bring this opposition and admits that it is merely the law firm representing Zen and that Zen - not PMA - is the party in interest. An attorney/client relationship does not invest a law firm with the same right or interest as its client; while it may act on behalf of its client, it is not considered a party to an action. See *In re Spang Industries, supra*. In view thereof, we find that PMA has not pleaded its standing to bring this opposition and accordingly, the opposition is dismissed in accordance with Fed. R. Civ. P. 12(b)(6).

* * *