

ESTTA Tracking number: **ESTTA46150**

Filing date: **09/23/2005**

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

<b>Proceeding</b>	91165689
<b>Party</b>	Plaintiff Pietrantonio Mendez  Pietrantonio Mendez & Alvarez LLP 209 Muñoz Rivera Avenue Popular Center 19th Floor San Juan, PR 00918 UNITED STATES
<b>Correspondence Address</b>	Janine Guzman, Esq. Pietrantonio Mendez & Alvarez LLP 209 Muñoz Rivera Avenue Popular Center 19th Floor San Juan, PR 00918 UNITED STATES jguzman@pmalaw.com, abeltran@pmalaw.com
<b>Submission</b>	Response to Board Order/Inquiry
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<b>Date</b>	09/23/2005
<b>Attachments</b>	Motion in Compliance with Boards Resolution of August 24, 2005.pdf ( 5 pages )

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

Opposition No. 91165689

In the matter of trademark  
applications Serial Nos. 76578388 and 76578382

For the mark ZEN SPA & WELLNESS CENTER  
Published in the Official Gazette on 04/26/05

PIETRANTONI, MÉNDEZ & ÁLVAREZ, LLP  
Opposer

v.

BODIES IN MOTION, INC.  
Applicant

MOTION IN COMPLIANCE WITH BOARDS RESOLUTION OF AUGUST 24, 2005

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD:

COMES NOW, PIETRANTONI MÉNDEZ & ÁLVAREZ on behalf of  
Opposer Zen Spa Enterprises Inc. d/b/a/ Zen Spa & Health Studio  
("Zen Spa & Health Studio"), and respectfully alleges and prays  
as follows:

1. On April 11, 2005 Zen Spa and Health Studio retained  
the Law Firm Pietrantoni, Méndez and Álvarez ("PMA") to provide  
legal services for corporate and business matters.

2. On May 23, 2005, PMA filed a request for extension of  
time to oppose to application Serial No. 76578388, on behalf of  
Zen Spa & Health Studio, through the Electronic System for  
Trademark Trial and Appeals (ESTTA) on the PTOnet.

3. When completing said request for extension of time a window requesting the Potential Opposer Information appears requesting certain information. Among other things, one must respond to the question of whether the opposer is represented by counsel and immediately thereafter, the "name and address" must be filled out. In completing the form in this case was mistakenly understood that the "name and address" requested, was of the counsel that represents the opposer, rather than the opposer itself. Therefore, our firm's name and address was included, rather the opposer's.

4. On June 27, 2005, PMA filed a Notice of Opposition through the ESTTA on the PTOnet, on behalf of Zen Spa & Health Studio. This time the system did not ask again for the opposer's information. Therefore we filed our client's notice of opposition, without being asked for its information again.

5. On August 9, 2005 when PMA verified the system to see if any answer to the Notice of Opposition was filed, it learned of the mistake made, since, instead of Zen Spa & Health Studio being identified as the opposer, PMA was appearing in the captions of the case and also as the attorneys representing Zen Spa & Health Studio.

6. On July 14, 2005, PMA filed a Motion to Amend Notice of Opposition, requesting that the opposer's appearing name, Pietrantoni, Méndez & Álvarez, be changed to it client's name,

which is the party with interest and not PMA, which is the law firm that represents it.

7. On August 24, 2005, the Trademark Trial and Appeal Board denied the Motion to Amend Notice of Opposition and granted 30 days to PMA to affirm its standing to bring this opposition proceeding.

8. In compliance with the Board's resolution, PMA is submitting its position.

9. Trademark Rule 2.102 (b) states the following:

The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during the extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time

10. According to the previous cited Rule 2.102 (b) Zen Spa & Health, through its attorneys, PMA timely filed a request for extension of time. It was an involuntary mistake made in the filing of the request for extension of time, when entering the opposer's information in the ESTTA, that caused the confusion in this case. Rule 2.102 (b) specifically, states that an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake.

11. When PMA entered the electronic system to timely file the Notice of Opposition on behalf of Zen Spa & Wellness Center, the system did not ask again for the opposer's information and therefore, it was not possible to be aware of the previous mistake. Nevertheless, all documentation included in the Notice of Opposition supports the contention that Zen Spa & Health Studio is the party in the case and that PMA is its legal representative.

12. PMA is still the legal representative of Zen Spa & Health Studio

13. None of the cases related to the interpretation of Trademark Rule 2.102 (b) relate to extensions of time or notices of opposition filed through ESTTA. Therefore, this is a novel situation. See, Cass Logistics Inc. v. McKesson Corporation DBA McKerson Transportation Systems, 1193 WL 236535.

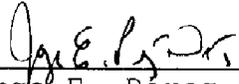
14. If this Board does not allow the opposer's name to be changed, and dismisses its opposition, Zen Spa's rights will be unfairly prejudiced, because it will not have the option to file the notice of opposition again.

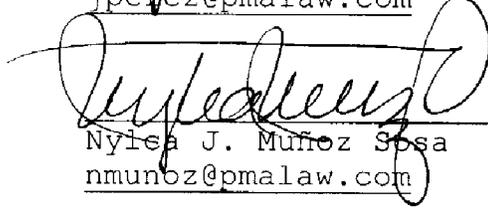
15. Considering that both, the request of extension of time and the Notice of Opposition, were timely filed that throughout this matter it has been clearly established that the opposer is indeed Zen Spa and Health Studio, represented by PMA, that a simple mistake was made, perhaps prompted by an unclear

form, that our client would be seriously prejudiced by this mistake, that the requested amendment does not prejudice anyone, and that Trademark Rule 2.102(b) clearly states that an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake, this Honorable Board should allow the amendment of the notice of opposition in order to proceed with the opposition proceedings timely instituted.

In view of the above, Pientrantoni, Méndez and Álvarez on behalf of Zen Spa & Health Studio, respectfully requests this Honorable Board to accept this Motion and allow the amend to the Notice of Opposition in order to have Zen Spa & Health Studio as the Opposer, and not the law firm which represents them.

Attorneys for Opposer,  
Zen Spa & Health Studio:

  
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Date: September 23, 2005.