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

|                        |                                                                                                                                        |
|------------------------|----------------------------------------------------------------------------------------------------------------------------------------|
| Proceeding             | 91185256                                                                                                                               |
| Party                  | Defendant<br>Room Service Interiors Ltd.                                                                                               |
| Correspondence Address | Paul G. Juettner<br>Greer, Burns & Crain, Ltd.<br>300 South Wacker Drive<br>Chicago, IL 60606<br>UNITED STATES<br>pjuettner@gbclaw.net |
| Submission             | Reply in Support of Motion                                                                                                             |
| Filer's Name           | Paul G. Juettner                                                                                                                       |
| Filer's e-mail         | pjuettner@gbclaw.net                                                                                                                   |
| Signature              | /Paul G. Juettner/                                                                                                                     |
| Date                   | 09/25/2008                                                                                                                             |
| Attachments            | DG4765.pdf ( 5 pages )(16097 bytes )                                                                                                   |

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

In the Matter of Application No.: )  
76/071,006 – Published September 25, 2007 )  
For the mark –ROOMSERVICE )  
)  
Room Service Home, LP and R S Design, Inc. ) Opposition No. 91185256  
d/b/a Room Service by Ann Fox, )  
)  
Opposers, )  
)  
v. )  
)  
Room Service Interiors Ltd., )  
)  
Applicant. )

APPLICANT’S REPLY TO OPPOSERS’ RESPONSE  
TO APPLICANT’S MOTION TO DISMISS AS  
UNTIMELY AND FOR FAILURE TO STATE A CLAIM

Applicant Room Service Interiors, Ltd. (“Applicant”) submits this memorandum in reply to Opposers’ Room Service Home L.P. (“Room Service Home”) and R S Design, Inc., d/b/a Room Service by Ann Fox (“R S Design”) Response to Applicant’s Motion to Dismiss as Untimely and for Failure to State a Claim. It is submitted that this Reply is properly limited to issues raised in Opposer’s Response, and should be considered by the Board in accordance with 37 CFR §§ 2.127(a) and (e)(1).

As an initial matter, because both parties have submitted evidence outside the pleadings, the Board should treat the subject Motion to Dismiss as a motion for summary judgment under Rule 56, Fed.R.Civ.P. *See*, TBMP §503.04.

Applicant does not oppose Opposer’s Motion to Amend for Leave to Amend Notice of Opposition. For the purposes of this Motion only, Applicant accepts as true the

well-pleaded factual allegations, but not assertions of law, of the Amended Notice of Opposition.

#### Opposers Are Not in Privity

Opposers assert that Room Service Home and R S Design are in privity.

[Amended Notice of Opposition ¶8] The facts, however, show the opposite – that privity is lacking. Both parties cite *Black’s Law Dictionary* for the proposition that “privity” means mutual or successive relationships to the same right of property. Opposers do not assert successive relationships to any property. The question is whether Opposers have a mutual relationship to the same right of property.

RS Design is alleged to use the ROOM SERVICE mark in connection with retail store services and interior design services. [Amended Notice of Opposition ¶¶ 1, 9, 10]

Room Service Home is alleged to use the ROOM SERVICE HOME mark in connection with an online store and website. [Amended Notice of Opposition ¶¶ 7, 11] Opposers do not dispute Applicant’s Exhibit A wherein Ann Fox consented to Room Service Home’s perpetual use of the name “Room Service Home, L.P.” without qualification or limitation.

Interestingly, the allegations of Amended Notice of Opposition and Opposer’s Response are silent as to any allegation of ownership of the ROOM SERVICE and ROOM SERVICE HOME marks. The evidence is clear that R S Design allegedly owns the ROOM SERVICE mark for retail store services and interior design services, while Room Service Home allegedly owns the ROOM SERVICE HOME mark for online sales. There is no basis to conclude the Opposers have a mutual interest (ownership) in the same property right (mark).

Thus, as a matter of law there is no privity.

#### Opposers are Not Related Parties

Opposers assert that privity includes the relationship of related companies within the meaning of Sections 5 and 45 of the Trademark Act. [Opposers' Response ¶ 23] Applicant respectfully disagrees. In *Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc.*, 211 USPQ 352, 358 (TTAB 1981) the Board equated privity to a relationship of an exclusive importer, distributor or licensee – none of which apply here. Contrary to Opposers' argument, the Board did not state that privity could be established by showing control over manufacturing. *Id. F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co.*, 140 USPQ 281, is 1963 Commissioner of Patents decision that does not mention privity at all. In this decision, the Commissioner allowed a wholly owned subsidiary to proceed with an opposition filed during an extension that had been requested by the subsidiary's parent corporation. In the present case, R S Design is neither a subsidiary nor a parent of Room Service Home. Indeed, there is no corporate family relationship between Opposers.

As a matter of law, Opposers are not related companies. Opposers' related companies argument is predicated on Ann Fox's ownership interests in both Opposers. The argument totally ignores, however, the separate corporate legal existence of R S Design, Inc. and Room Service Home LLP. The two companies are not related because despite having a common shareholder (Ann Fox) neither company is alleged to control the other's use of its mark. Specifically, there is no allegation that R S Design controls the Room Service Home's use of ROOM SERVICE HOME. And, there is no allegation that

Room Service Home controls R S Design's use ROOM SERVICE. Because neither Opposer controls the other, they cannot be related parties. The fact that Ann Fox is a shareholder of R S Design and a shareholder of Room Service Management, LLC which is the general partner of Room Service Home, does not satisfy the control requirement of the related company doctrine. See Applicant's Main Brief at p. 6. Ann Fox may be actively involved in both companies, and the two Opposers may collaborate with each other, but that does not make them "related companies" within the meaning of Sections 5 and 45 of the Trademark Act.

#### CONCLUSION

Because Opposers are not in privity, Applicant's Motion to Dismiss must be granted.

Room Service Interiors, Ltd.

Date: September 25, 2008

By:           /s/ Paul G. Juettner            
Paul G. Juettner, Esq.  
Greer, Burns & Crain, Ltd.  
300 South Wacker Drive, Suite 2500  
Chicago, Illinois 60606-6771  
Tel: (312) 360-0080  
Fax: (312) 360-9315  
Attorneys for Applicant

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S REPLY TO OPPOSERS' RESPONSE TO APPLICANT'S MOTION TO DISMISS AS UNTIMELY AND FOR FAILURE TO STATE A CLAIM has been filed electronically through The Electronic System for Trademark Trials and Appeals ("ET TSA") of the U.S. Patent and Trademark Office, and a true and correct copy has been served on Opposers by facsimile and first class mail to Opposers' counsel on this 25 day of September 2008 at the following address:

John A. Thomas  
Seth A. Horwitz  
Glast, Phillips & Murray, P.C.  
13355 Noel Road, L.B. 48  
2200 One Galleria Tower  
Dallas, TX 75240-1518  
Fax: 972-419-8329

/s/ Paul G. Juettner