

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

Faint

Mailed: May 21, 2009

Opposition No. 91188736

Anastasia Beverly Hills, Inc.

v.

Anastasia Marie Laboratories,
Inc.

**Before Bucher, Kuhlke and Bergsman,
Administrative Trademark Judges.**

By the Board:

Before the Board is applicant's fully-briefed motion to dismiss, filed March 18, 2009.¹ Applicant argues that because opposer served the notice of opposition via the U.S. Postal Service later the same day as the filing of the notice of opposition, the allegation of service in the notice of opposition did not comply with Trademark Rule 2.119(a) which requires that proof of service be made before the paper will be considered by the Office. Applicant relies on the Board's ruling in *Springfield Inc. v. XD*, 86 USPQ2d 1063, (TTAB 2008) where the Board held that, "[p]roof of service is meaningless

¹ The motion to dismiss was first filed on March 16, 2009. On March 18, 2009 applicant filed an amended version noting that it had failed to include certain language in the attached declaration, and asking the Board to substitute the revised motion. The motion is granted to the extent that the amended motion and attachments are now the operative papers before us, with a filing date of March 18, 2009, the date the answer was due. Applicant's answer and counterclaim were filed March 16, 2009.

in the absence of actual service in accordance with the statements contained in the proof of service." *Id.* at 1064.

In response, opposer declares in a declaration with attached copies of filing receipts for the relevant documents, that the notice of opposition was filed via ESTTA at 7:20 PST on January 24, 2009 and the notice was deposited in the outgoing mail slot of the Sierra Madre Post Office with an attached certified First Class Mail label at 8:11 PST on the same date. Opposer argues that it is neither practical nor efficient to first prepare a paper version of the notice, verify it has been deposited with the U.S. Postal Service, and then file an electronic version of the opposition via ESTTA. In fact, opposer argues, the notice of opposition that is filed at that point would not be the same as the one mailed earlier, since the earlier version would not contain the ESTTA cover sheet.

Further, opposer argues there is no mention in the Trademark Rules, or the Notice of Final Rulemaking, of a time of day when service must be effected, only a date, namely the "date and manner in which service was made." Trademark Rule 2.119(a). Opposer contends that applicant ignores the Board's subsequent ruling in *Equine Touch Foundation, Inc. v. Equinology, Inc.*, Cancellation No. 92050044, 2009 WL 625593 (TTAB 2009) (publication pending), in which the Board held that where proof of service was amended to reflect a filing date after filing of the petition for cancellation, the prior failure of service was cured, and the proceeding was awarded a

new filing date. *Id.* It was noted in *Equine Touch* that if the case were an opposition proceeding and the deadline for filing the notice of opposition had passed before the time for filing the subsequent proof of service, proof of subsequent service on defendant, or its counsel would be insufficient and the case would have to be dismissed as a nullity. *Id.* Opposer notes that the date for filing a notice of opposition pursuant to an extension was January 24, 2009, a Saturday. Under Trademark Rule 2.196, the notice of opposition in this proceeding would have been timely filed on Monday, January 26, 2009, and was in fact filed and served on January 24, 2009, thus opposer argues any defect in service was cured by subsequent service on the same day as the filing.

In reply, applicant argues that "the rules are the rules" and opposer's filing was defective "due to the fact that they had not served [a]pplicant but misstated to the Office that they had done so. Their claim that the defective opposition was 'cured' by service before the deadline is baseless." Applicant contends that the only way to "cure" the deficiency was for opposer to serve applicant and re-file the notice of opposition.

Applicant's reading and interpretation of Trademark Rule 2.119(a) is incorrect and frankly borders on a Rule 11 violation. Fed. R. Civ. P. 11.² While the Trademark Rules

² Applicant is advised of the Board's inherent authority to sanction parties when they abuse procedure by, inter alia, filing frivolous motions. See *Schering-Plough Animal Health Corporation v. Aqua Gen AS*, 90 USPQ2d 1184 (TTAB 2009) (finding filing of untenable motion to dismiss may subject counsel to Rule 11 sanctions); see also *International*

require proof of service of the notice of opposition to be filed together with the filing of the notice itself, an electronically filed notice cannot be served until after it has been filed with the Board via ESTTA. Thus service of the notice of opposition on the same date as the filing of the notice meets this requirement.³

Accordingly, applicant's motion to dismiss is DENIED.

Reset Dates

Dates are reset as set out below.

Answer to Counterclaim Due	June 25, 2009
Deadline for Discovery Conference	July 25, 2009
Discovery Opens	July 25, 2009
Initial Disclosures Due	August 24, 2009
Expert Disclosures Due	December 22, 2009
Discovery Closes	January 21, 2010
Plaintiff's Pretrial Disclosures	March 7, 2010
30-day testimony period for plaintiff's testimony to close	April 21, 2010
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	May 6, 2010
30-day testimony period for defendant and plaintiff in the counterclaim to close	June 20, 2010
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	July 5, 2010
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	August 19, 2010

Finance Corp. v. Bravo Co., 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (Board prohibited opposer from filing any further motions to compel without prior Board permission); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (Board possesses inherent authority to control disposition of cases on its docket which necessarily includes inherent power to enter sanctions).

³ This comports with the Federal Rules. As stated in the commentary to Fed. R. Civ. P. 3, "the first step in an action is the filing of the complaint, followed by service." Fed. R. Civ. P. 3 advisory committee note.

Counterclaim Plaintiff's Rebuttal Disclosures Due	September 3, 2010
15-day rebuttal period for plaintiff in the counterclaim to close	October 3, 2010
Brief for plaintiff due	December 2, 2010
Brief for defendant and plaintiff in the counterclaim due	January 1, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	January 31, 2011
Reply brief, if any, for plaintiff in the counterclaim due	February 15, 2011

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
