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

Proceeding	91198059
Party	Plaintiff Skin Sense, Inc.
Correspondence Address	HOWARD A JACOBSON SKIN SENSE INC 300 WEST MILLBROOK ROAD RALEIGH, NC 27609 UNITED STATES howard@skinsense.com, howardajacobson@gmail.com
Submission	Motion to Compel Discovery
Filer's Name	Howard A Jacobson
Filer's e-mail	howard@skinsense.com
Signature	/Howard A Jacobson/
Date	02/07/2012
Attachments	Motion to Compel.pdf (4 pages)(71764 bytes) Surico - Motion to Compel - Email Serving Discovery.pdf (1 page)(71832 bytes) Surico - Motion to Compel - Email Requesting Responses.pdf (1 page)(70901 bytes) Surico - Motion to Compel - Email Second Requesting Responses.pdf (1 page)(70583 bytes) Surico - Motion to Compel - Email Serving Responses.pdf (1 page)(79963 bytes) Request for Documents - Skin Sense to Surico - First.02.pdf (6 pages)(65358 bytes) Request for Admission - Skin Sense to Surico - First.02.pdf (5 pages)(62775 bytes) Surico - Responses to Opposers First Set of Requests for Documents.pdf (2 pages)(103569 bytes) Surico Response to Opposers First Set of Requests for Admission.pdf (2 pages)(103118 bytes)

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

Skin Sense, Inc.,

Opposer

v.

Susan A. Surico,

Applicant.

Opposition No. 91198059

Application Serial No. 85064357

MOTION TO COMPEL AND FOR EXTENSION OF DISCOVERY AND 30-DAY TRIAL PERIOD

Opposer Skin Sense, Inc., a North Carolina limited liability company, (“Opposer”) moves for an order compelling applicant Susan Surico (“Applicant”) to respond to Opposer’s First Set of Requests for Admission and First Set of Requests for Documents and further moves for an extension of Opposer’s deadline to complete discovery, file pre-trial disclosures and complete Opposer’s 30-day trial period (now set to expire on February 11, 2012) on the grounds set forth below:

1. Opposer is the owner of the trademark and service mark SKIN SENSE, which opposer has used continuously in commerce since at least September 15, 1991 on and in connection with day spa services in the nature of skin care, body care, nail care and wellness and day spa goods in the nature of skin care, body care, nail care and wellness, including, but not limited to, lotions, cleansers, moisturizers, cosmetics, soaps, exfoliants, astringents, scrubs, masks, balms and body washes.
2. Opposer is engaged in its business nationwide and has established a reputation for high quality spa services and goods in locations around the United States.
3. Opposer is the owner of the federal registration of the service mark SKIN SENSE under Registration Number 2527398 for services including “spas in the nature of massage, skin care, manicure, pedicure and make-up.”
4. An integral and long-standing element of the business of Opposer and an inherent part of the provision of the services described in Opposer's Registration are the sale of skin, body and nail care products,

including, but not limited to, lotions, cleansers, moisturizers, cosmetics, soaps, exfoliants, astringents, scrubs, masks, balms and body washes in both organic and non-organic formulations.

5. Applicant seeks registration of the purported mark SKINSENSE ORGANIC in connection with the very same types of products sold for years by Opposer under its federally registered mark.

6. On November 11, 2011, before the expiration of the Discovery Period set by the Board, Opposer served upon Applicant Requests for Admission and Requests for Production of Documents. Responses to the Requests were due from Applicant no later than December 14, 2011. A copy of the email serving the Requests and the Requests themselves are attached.

7. On December 29, 2011, Opposer notified Applicant by electronic mail that her responses to the Requests were past due and requested that the responses be served by January 3, 2012. Applicant did not respond to Opposer's electronic mail, a copy of which is attached.

8. On January 11, 2012, Opposer again notified Applicant that she had not responded to Opposer's Requests and that she is obligated to respond to the Requests. A copy of the electronic mail from January 11, 2012 is attached.

9. On January 20, 2012, Applicant finally served purported responses to the Requests. Not only were the responses more than one month late, they purposefully and blatantly fail to provide substantive responses. Applicant refused to produce even a single document, failed entirely to comply with the Rules of the Board and the Federal Rules of Civil Procedure in composing the responses, and failed to admit or deny properly any of the Requests for Admission. Copies of Applicant's responses are attached.

10. Applicant's responses were untimely, resulting in a mandatory waiver of all objections to the Requests, and are a bad faith attempt to obstruct Opposer's right to discovery. Indeed, Applicant's responses are almost entirely non-responsive and deny Opposer access even to basic information related to Applicant's claimed use of and rights to her purported mark.

Opposer respectfully moves the Board to order Applicant to provide all requested documents and to respond properly to the Requests. Opposer further moves the Board to extend only Opposer's time for conducting discovery so that Opposer may have the documents and responses and make any further necessary motions

regarding them. Finally, Opposer further moves the Board to extend the time for Opposer's Pre-Trial Disclosures and 30-Day Trial Period to begin no sooner than 45 days after the date that the Board orders Applicant to supply the documents and responses.

This 7th day of February 2012.

Respectfully submitted

/s/Howard Jacobson/
Attorney for Opposer

300 West Millbrook Road
Raleigh, NC 27609
(919) 645-9779
howard@skinsense.com

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **MOTION TO COMPEL AND FOR EXTENSION OF DISCOVERY** has been served by electronic mail on the following parties at the e-mail addresses listed below.

Susan A. Surico : susansurico@yahoo.com

Dated: February 7, 2012

/s/Howard A. Jacobson/



Howard Jacobson <howard@envisionsmg.com>

Discovery

1 message

Howard Jacobson <howard@envisionsmg.com>

Fri, Nov 11, 2011 at 2:43 PM

To: Susan Surico <susansurico@yahoo.com>

Attached please find discovery requests in the Skin Sense v. Surico matter.

Howard A. Jacobson

4306 Page Road

Morrisville, NC 27560

[\[919\] 341.9140](tel:9193419140) : Google Voice[\[919\] 794-5480](tel:9197945480) : Fax

Observations and commentary on Twitter: @longoutlook

**If I spend somebody else's money on somebody else,
I'm not concerned about how much it is,
and I'm not concerned about what I get.
And that's government.**

-- Milton Friedman

2 attachments**Request for Admission - Skin Sense to Surico - First.02.pdf**

62K

**Request for Documents - Skin Sense to Surico - First.02.pdf**

64K



Howard Jacobson <howard@envisionsmg.com>

Discovery

1 message

Howard Jacobson <howard@envisionsmg.com>
To: Susan Surico <susansurico@yahoo.com>
Cc: Howard Jacobson <howardajacobson@gmail.com>

Thu, Dec 29, 2011 at 12:17 PM

Ms. Surico.

On November 11, Skin Sense served you with discovery requests in the Skin Sense v. Surico matter. We have not received your responses. Please send them to us by January 3, 2012.

Howard A. Jacobson

4306 Page Road
Morrisville, NC 27560
[\[919\] 341-9140](tel:9193419140) : Google Voice
[\[919\] 794-5480](tel:9197945480) : Fax

Observations and commentary on Twitter: @longoutlook

**If I spend somebody else's money on somebody else,
I'm not concerned about how much it is,
and I'm not concerned about what I get.
And that's government.**
-- Milton Friedman



Howard Jacobson <howard@envisionsmg.com>

Discovery

1 message

Howard Jacobson <howard@envisionsmg.com>

Wed, Jan 11, 2012 at 5:18 PM

To: Susan Surico <susansurico@yahoo.com>

Ms. Surico.

I have not received a response from you to my last email about discovery. You are obligated to provide responses to the discovery. If I must make a motion to compel you to respond the Board has the authority to require you to pay the attorney's fees incurred by Skin Sense in making the motion.

Howard A. Jacobson

4306 Page Road

Morrisville, NC 27560

[\[919\] 341-9140](tel:9193419140) : Google Voice

[\[919\] 794-5480](tel:9197945480) : Fax

Observations and commentary on Twitter: @longoutlook

Be always at war with your vices,
at peace with your neighbors, and
let each new year find you a better man.

~Benjamin Franklin



Howard Jacobson <howard@envisionsmg.com>

Response to Discovery

Susan Surico <susansurico@yahoo.com>

Fri, Jan 20, 2012 at 2:32 PM

Reply-To: Susan Surico <susansurico@yahoo.com>

To: "howard@skinsense.com" <howard@skinsense.com>

Cc: "susansurico@yahoo.com" <susansurico@yahoo.com>

See Attached Response to your Discovery Questions.

Susan Surico

9340 E. Redfield Rd. #2047

Scottsdale, AZ 85260

2 attachments



In response to Opposers first set of requests for documents to applicant.pdf

102K



Response to Opposers first set of requests for admission to applicant.pdf

101K

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

Skin Sense, Inc.,

Opposer

v.

Susan A. Surico,

Applicant.

Opposition No. 91198059

Application Serial No. 85064357

OPPOSER’S FIRST SET OF REQUESTS FOR DOCUMENTS TO APPLICANT

Pursuant to 37 C.F.R. § 2.116 and Rule 34 of the Federal Rules of Civil Procedure (“Rules”) and ancillary Rules as applicable, Opposer Skin Sense, Inc. requests the production (“Requests”) by Applicant Susan A. Surico of the documents and things specified below. Inspection and / or production will occur at the offices of Defendants’ counsel at 4306 Page Road, Morrisville, North Carolina 27560 at 10:00 a.m. on December 5, 2011 or by electronic mail or other electronic delivery means on or before such date..

DEFINITIONS

A. “Opposer” means the Opposer in this case and his, her or its managers, officers, directors, employees, agents, representatives, and attorneys.

B. “Applicant” or “You” means the Applicant in this case and her managers, officers, directors, employees, agents, representatives and attorneys.

C. “Document” means each and every thing in any form on or in which any writing, recording, image or information may be stored, preserved or depicted for any period of time as defined in Rule 34.

D. “Related to” or “relating to” means identifying, mentioning, concerning or otherwise pertaining to in any way directly or indirectly or by name or reference.

REQUESTS FOR PRODUCTION

You are requested to produce the following:

1. All Documents relating to Your use in any form of the words SKINSENSE or SKIN SENSE.

ANSWER:

2. All Documents relating to each and every product offered by You bearing the words SKINSENSE or SKIN SENSE.

ANSWER:

3. All Documents relating to the first date on which You used in any form the words SKINSENSE or SKIN SENSE.

ANSWER:

4. All Documents relating to the first date on which You used the words SKINSENSE or SKIN SENSE on or in connection with each of the products ever offered by You.

ANSWER:

5. All Documents relating to the first date on which You used the words SKINSENSE or SKIN SENSE on or in connection with each of the products ever offered by You.

ANSWER:

6. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Opposer only uses Skinsense as a service business name and not in conjunction with any skincare or product line”.

ANSWER:

7. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Skinsense is only used to identify a service business”.

ANSWER:

8. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Opposer, according to his website, is only doing business in the state of North Carolina”.

ANSWER:

9. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “According to Opposer’s website, there is not a single product listed that has the Skinsense name on it or even the word Organic”.

ANSWER:

10. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Since Opposer does not have any products with the name Skinsense on them, it would not confuse potential customers”.

ANSWER:

10. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “All products on website are manufactured by other companies”.

ANSWER:

11. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “As a service business only”.

ANSWER:

12. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Would not Mislead purchasers of Applicant’s products”.

ANSWER:

13. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “The Opposer carries national brands not connected with the service business name”.

ANSWER:

14. All Documents relating to Your contention in Your Response to First Amended Opposition to Application that “Would not be deceptive”.

ANSWER:

14. All Documents relating to any investigation or research of the words SKINSENSE or SKIN SENSE.

ANSWER:

15. All Documents relating to Your selection of the words SKINSENSE for use in connection with Your business.

ANSWER:

16. All Documents upon which You intend to rely or that you intend to offer into evidence in the trial of this matter.

ANSWER:

Respectfully submitted

/s/Howard Jacobson/
Attorney for Opposer

300 West Millbrook Road
Raleigh, NC 27609
(919) 645-9779
howard@skinsense.com

CERTIFICATE OF SERVICE

I hereby certify that the foregoing FIRST AMENDED NOTICE OF OPPOSITION has been served by electronic mail on the following parties at the e-mail addresses listed below.

Susan A. Surico : susansurico@yahoo.com

Dated: October 26, 2011

/s/Howard A. Jacobson/

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

Skin Sense, Inc.,

Opposer

v.

Susan A. Surico,

Applicant.

Opposition No. 91198059

Application Serial No. 85064357

OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSION TO APPLICANT

Pursuant to 37 C.F.R. § 2.116 and Rule 36 of the Federal Rules of Civil Procedure (“Rules”) and ancillary Rules as applicable, Opposer Skin Sense, Inc. requests the admission (“Requests”) by Applicant Susan A. Surico of the truth of the matters specified below.

DEFINITIONS

- A. “Opposer” means the Opposer in this case and his, her or its managers, officers, directors, employees, agents, representatives, and attorneys.
- B. “Applicant” or “You” means the Applicant in this case and her managers, officers, directors, employees, agents, representatives and attorneys.
- C. “Document” means each and every thing in any form on or in which any writing, recording, image or information may be stored, preserved or depicted for any period of time as defined in Rule 34.
- D. “Related to” or “relating to” means identifying, mentioning, concerning or otherwise pertaining to in any way directly or indirectly or by name or reference.

REQUESTS FOR ADMISSION

You are requested to admit the truth of the following matters:

1. You do not use the words SKINSENSE or SKIN SENSE on or in connection with any

product.

ANSWER:

2. You only use the words SKINSENSE as the name of Your business.

ANSWER:

3. You do not use the words SKINSENSE or SKIN SENSE to identify any product.

ANSWER:

4. You do not use the words SKINSENSE or SKIN SENSE to identify any service.

ANSWER:

5. Opposer uses the SKIN SENSE mark on or in connection with spa services.

ANSWER:

6. Opposer uses the SKIN SENSE mark on or in connection with skin care products.

ANSWER:

7. Your use of the words SKINSENSE on or in connection with skin care products likely would mislead consumers to believe that some relationship exists between You and Opposer.

ANSWER:

8. Your use of the words SKINSENSE on or in connection with skin care products likely would mislead consumers to believe that Opposer is the source of Your products.

ANSWER:

9. Your use of the words SKINSENSE on or in connection with skin care products likely would mislead consumers to believe that Opposer endorses Your products.

ANSWER:

10. An internet search using the word SKINSENSE could yield a result that includes Your website.

ANSWER:

11. An internet search using the word SKINSENSE would yield a result that includes Opposer's website.

ANSWER:

12. You offer products bearing the word SKINSENSE through your internet website.

ANSWER:

13. You offer skin care products bearing the word SKINSENSE.

ANSWER:

Respectfully submitted

/s/Howard Jacobson/
Attorney for Opposer

300 West Millbrook Road
Raleigh, NC 27609
(919) 645-9779
howard@skinsense.com

CERTIFICATE OF SERVICE

I hereby certify that the foregoing FIRST AMENDED NOTICE OF OPPOSITION has been served by electronic mail on the following parties at the e-mail addresses listed below.

Susan A. Surico : susansurico@yahoo.com

Dated: October 27, 2011

/s/Howard A. Jacobson/

In The United States Patent And Trademark Office

Before The Trademark Trial and Appeal Board

Skin Sense, Inc.,- Opposer

Vs

Susan A. Surico, - Applicant

Opposition No. 91198059

Application Serial No. 85064357

In Response to Opposer's First Set of Requests For Documents to Applicant

According to the Board's decision documented on March 8, 2011, p. 8. States that ".....the discovery topics should be focused on the likelihood of confusion factors....."

The Opposer's Requests for Applicant to produce documents in Requests numbered 1-16 are irrelevant to the Board's decision on March 8, 2011.

- 1. Irrelevant**
- 2. Irrelevant**
- 3. Irrelevant**
- 4. Irrelevant**
- 5. Irrelevant**
- 6. Irrelevant**
- 7. Irrelevant**
- 8. Irrelevant**
- 9. Irrelevant**
- 10. Irrelevant**
- 11. Irrelevant**
- 12. Irrelevant**
- 13. Irrelevant**
- 14. Irrelevant**
- 15. Irrelevant**

16. Irrelevant

Respectfully Submitted

/Susan A. Surico/

9340 E. Redfield Rd. #2047

Scottsdale, AZ 85260

(480) 609-8715

susansurico@yahoo.com

Certificate Of Service

I hereby certify that the foregoing Response to Opposer's First Set of Requests For Documents to Applicant has been served by electronic mail on the following parties at the e-mail addresses listed below.

Howard A. Jacobson: howard@skinsense.com

Dated: January 20, 2012

/Susan A. Surico/

In The United States Patent and Trademark Office

Before The Trademark Trial and Appeal Board

Skin Sense, Inc., Opposer

Vs.

Susan A. Surico, Applicant

Opposition No. 91198059

Applicsation Serial No. 85064357

In Response to Opposer's First Set of Requests For Admission To Applicant

- 1. The name of my product line is SkinSense Organic**
- 2. SkinSense is not the name of my business**
- 3. The name of my product line is SkinSense Organic**
- 4. I do not use the name SkinSense to identify a service business**
- 5. I do not use the name Skin Sense to identify a spa service business**
- 6. The name of my product line is SkinSense Organic**
- 7. No it would not lead to the confusion or mislead consumers to believe that a relationship exists between the Opposer and Applicant**
- 8. SkinSense Organic is a product name not a Service business**
- 9. Would not mislead consumers to believe that Opposer endorses my products.**
- 10. I don't know**
- 11. I don't know**
- 12. SkinSense Organic**
- 13. SkinSense Organic**

Respectfully Submitted

/Susan A. Surico/

Applicant

9340 E. Redfield Rd. #2047

Scottsdale, AZ 85260

(480) 609-8715

susansurico@yahoo.com

Certificate of Service

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Howard A. Jacobson: howard@skinsense.com

Dated: January 20, 2012

/Susan A. Surico/