

ESTTA Tracking number: **ESTTA466673**

Filing date: **04/11/2012**

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

Proceeding	91201166
Party	Plaintiff Chang Oh Kim
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Submission	Other Motions/Papers
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Signature	/Je M. Cha, Esq./
Date	04/11/2012
Attachments	Breif in Response. Chang Oh Kim.pdf (6 pages)(171214 bytes)

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

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4 Application Serial No.: 85249961
5 MARK: PowerZen
6 Date of Publication: July 26, 2011
7 Date of Opposition Filed: August 15, 2011
8 Opposition No.: 91201166
9

10
11 PAULT SHIM,)
12) OPPOSER CHANG OH KIM'S BRIEF
13) IN RESPONSE TO APPLICANT
14) PAUL SHIM'S PETITION FOR
15) AMENDMENT AFTER PUBLICATION
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19 **TO APPLICANT AND TO ITS ATTORNEY OF RECORD:**

20 Opposer CHANG OH KIM (hereinafter refer to as the "Opposer") hereby submits the
21 written brief in response to Applicant PAULT SHIM's Petition for Amendment after Publication,
22 as follows:
23

24
25 **STATEMENT OF FACTS:**

26 Applicant PAUL SHIM (hereinafter refer to as "Applicant") filed the original application
27 for registration for the mark "PowerZen" on 02/26/2011 representing the dates of both first use
28 and first use in commerce as December 01, 2010.

1 The Application was published for opposition on July 23, 2011, and the opposition by this
2 Opposer was properly filed on August 15, 2011 claiming that the Opposer has used the mark in
3 commerce prior to Applicants alleged date of first use.
4

5 During the discovery period, Opposer has provided to the Applicant the evidences
6 establishing the priority of actual use date in the mark earlier than December 1, 2010.

7 Applicant, however, failed to establish the actual use date in the mark prior to the
8 Opposer's date of first use on September 2010. Instead, Applicant is now moving the Board to
9 amend the date of first use in the mark from December 1, 2010 to May 1, 2010, submitting series
10 of defective declarations and copies of invoices in support thereof.
11

12 The Applicant's declaration states that the Applicant acquired the right to use these marks
13 from Hoonam Kim in December 2010 and mistakenly believed the first date of use meant the first
14 date he used the mark under his company name only. (*Paragraph 3, Declaration of PAUL SHIM*)
15 And the declaration appears that it was signed off on October 31, 2011, more than 2 months after
16 the opposition was filed. The Applicant did not do anything to cure the alleged mistake after
17 signing the declaration for more than 5 months before finally deciding to amend the date of first
18 use.
19
20
21

22 **ARGUMENTS:**

23 First, an application subject to an opposition may not be amended in substance except with
24 the consent of the other party or parties and the approval of the Trademark and Appeal Board, or
25 upon motion granted by the Board. *37 CFR §2.133(a)*.

26 Applicant is attempting to change the date of first use before the date that he originally
27 represented in the application without consent by the Opposer. Since the priority date of use is the
28

1 key issue in this entire matter, it would materially change and alter the nature of the claims
2 imposing substantial prejudice to the Opposer if the Board grants the petition. Therefore, the
3 petition should be determined on the formal motion process.

4
5 Second, a proposed amendment to any application or registration which is the subject to an
6 inter partes proceedings must also comply with all other applicable rules and statutory provisions.
7 See Trademark Act § 7(e), 15 U.S.C. §1057; 37 CFR §2.71(b); 37 CFR §2.72; 37 CFR §2.173(a)
8 and 37 CFR §2.173(b); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433; 1435 (TTAB
9 2007); *Mason Engineering & Design Corp., v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB
10 1985)(*amendment to dates of use not supported by affidavit or declaration*).

11
12 37 CFR § 2.127(a) provides that every motion must be submitted in written form and must
13 meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and
14 shall embody or be accompanied by a brief.

15
16 Here, the Applicant's Petition for Amendment After Publication does not contain any brief
17 and failed to state any statement of grounds as specifically required by 37 CFR § 2.127(a), instead,
18 the petition contains one bold underlined sentence that reads "**First Date of Use is amended to be**
19 "**May 1, 2010,**" instead of "**December 1, 2010.**"

20
21 Furthermore, a motion that does not expressly state that the non-moving party has
22 consented to the motion will not be granted as conceded until after passage of sufficient time for
23 filing and receipt by the Board of a brief in response. If a motion is contested by the non-moving
24 party by filing an opposition brief or presenting a responsive argument in a telephone conference,
25 the Board will decide the motion on its merits. Since the petition failed to state whether or not the
26 non-moving party consented to the motion, it should not be granted as conceded and should be
27 decided on its merits.
28

1 As to the declarations, 37 CFR §2.20 provides that: “Instead of an oath, affidavit,
2 verification, or sworn statement, the language of 28 U.S.C. 1746, or the following language, may
3 be used:
4

5 The undersigned being warned that willful false statements and the like are punishable by
6 fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements
7 and the like may jeopardize the validity of the application or document or any registration
8 resulting therefrom, declares that all statements made of his/her own knowledge are true;
9 and all statements made on information and belief are believed to be true.”
10

11
12 Here, no declarations attached to the petition contain the above statutory languages. The
13 declarations only contain the language being effective and bound by the State of California.
14 Therefore, the petition failed to meet the statutory requirements by failing to contain a full
15 statement of grounds accompanied by a brief, and by failing to attach declarations with statutory
16 language therein. Therefore, the petition should be denied.
17

18 Finally, an unconsented motion to amend in substance is generally deferred until final
19 decision or until the case is decided upon summary judgment. *Fort Howard Paper Co. v. C.V.*
20 *Gambina, Inc.*, 4 USPQ2d 1552 (TTAB 1987) (motion to amend dates of use deferred); and
21 *Mason Engineering & Design Corp., v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.4 (TTAB
22 1985) (same).
23

24 Here, since the Opposer is contesting the petition for amendment in substance by filing this
25 brief, the Applicant’s petition being unconsented petition to amend in substance, should be denied,
26 or, in the alternative, deferred until final decision or until the case is decided upon summary
27 judgment.
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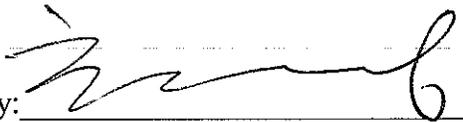
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CONCLUSION:

Based on the foregoing, the Opposer requests that the Board denies the Applicant's
Petition for Amendment After Publication.

Dated: April 11, 2012

LAW OFFICES OF J.M. CHA
& ASSOCIATES

By: 

Je M. Cha
Attorney for Opposer,
Chang Oh Kim

1 **PROOF OF SERVICE**

2 **STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

3 I reside in the county of Los Angeles, State of California. I am over the age of 18 and not
4 a party to the within action; my address is 3200 Wilshire Blvd., Suite 1207-South Tower, Los
5 Angeles, CA 90010.

6 On April 11, 2012, I served the foregoing document described as APPLICANT CHANG
7 OH KIM'S BRIEF IN RESPONSE TO APPLICANT PAUL SHIM'S PETITION FOR
8 AMENDMENT AFTER PUBLICATION, upon interested Parties in this action:

9 (X) by placing the original and/or a true copy thereof enclosed in (a) sealed
10 envelope(s) addressed as follows:

11 Young Bom Lee, Esq. Attorney for Applicant
12 Law Office of Lee & Associates Phone: (213) 368-7717
13 3530 Wilshire Blvd., Suite 1280 Fax: (213) 368-7718
14 Los Angeles, CA 90010

15 (X) by **REGULAR MAIL**: I deposited such envelop in the mail at Los Angeles,
16 California. The envelop was mailed with postage thereon fully prepaid.

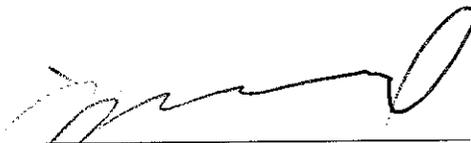
17 () by **FACSIMILE MACHINE**: I transmitted a true copy of said document(s) by
18 facsimile machine, and no error was reported. Said fax transmission(s) were
19 directed as indicated on the service list.

20 () by **OVERNIGHT MAIL**: I caused such documents to be sent via Overnight
21 Express or Federal Express, which was directed as indicated on the service list.

22 () by **PERSONAL SERVICE**: I caused such envelope(s) to be delivered by hand to
23 the above addressee(s).

24 I declare under penalty of perjury under the laws of the United States of America that the
25 foregoing is true and correct.

26 Executed on April 11, 2012 at Los Angeles, California.

27 
28 Je M. Cha