

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

EJW/vv

Mailed: February 17, 2016

Opposition No. 91212231

*Dragon Bleu (SARL) and
VTEC Limited LLC, by assignment*

v.

VENM, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On December 27, 2015, Opposer and Counterclaim Respondent, Dragon Bleu (SARL), filed a motion to join VTEC Limited LLC, as a party plaintiff and as a party defendant in the counterclaim in the above-entitled proceeding. Said motion is uncontested.

With respect to the opposition, if a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted for the originally named party if the assignment occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or if the defendant raises no objection to substitution. TBMP § 512.01 (2015). However, it is the practice of the Board to join an assignee when the assignment occurred after the commencement of the proceeding, as in this case, in order to facilitate discovery. *See NSM Resources Corp. v.*

Microsoft Corp., 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *see also* TBMP § 512.01. An assignee will be joined, and permitted to take action in the case, provided that proof of the assignment has been submitted. A review of the USPTO Assignment Division database reveals that the assignment of U.S. Registration No. 3927787 was recorded with the Office.¹

As regards the counterclaim, if the mark in a registration which is the subject matter of an *inter partes* proceeding before the Board is assigned, together with registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Recordation Branch of the USPTO, as it has been in this case, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objections to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. TBMP § 512.01.

¹ See Reel/Frame 5428/0453 (recorded 3/20/2014), regarding U.S. Reg. No. 3927787. A review of the records for Registration Nos. 3896673, 4017907, and 4574014 reveals that the referenced registrations have not been assigned.

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Inasmuch as the assignment of U.S. Reg. No. 3927787 has been recorded and the assignment occurred after the commencement of this proceeding, the motion to join VTEC Limited as a party plaintiff and counterclaim defendant in this proceeding is **granted**. The Board's records shall be updated accordingly.

A copy of this order is sent to all parties listed below:

CC:

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