ESTTA Tracking number: **ESTTA653078**
Filing date: **01/29/2015**

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

| | |
|---|---|
| Proceeding | 91215512 |
| Party | Defendant<br>Cox, David |
| Correspondence Address | MARK S HUBERT<br>MARK S HUBERT PC<br>2300 SW FIRST AVE STE 101<br>PORTLAND, OR 97201-5047<br>UNITED STATES<br>markhubert@pacifier.com;nicoleh@pacifie |
| Submission | Opposition/Response to Motion |
| Filer's Name | Mark S. Hubert, Attorney for Defendant |
| Filer's e-mail | markhubert@pacifier.com |
| Signature | /Mark S. Hubert/ |
| Date | 01/29/2015 |
| Attachments | 15-0129 Response to Sanctions Motion.pdf(2641459 bytes )<br>Exhibts for Sanctions Response.pdf(2681250 bytes ) |

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

| | | |
|---|---|---|
| BODY VIBE INTERNATIONAL, LLC | : | |
| Opposer | : | Opposition Proceeding No. 91215512 |
| v. | : | |
| DAVID COX | : | Serial No. 85966358 |
| Applicant | : | |

*Re:* *Trademark Opposition*
Serial. No. 85966352
For: DR. VAPE
By: David Cox
For: Class 011. Electric Vaporizers

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR SANCTIONS**

COMES NOW, David Cox ("Applicant"), by and through his attorney Mark S. Hubert, and files his Response to the Motion for Sanctions, filed by Body Vibe International, LLC ("Opposer") in the above-identified proceeding.

Applicant has attempted to minimize the rulings in this case before the TTAB and eliminate the need for Opposer's Motion for Sanctions (see TTAB docket entry #12) by acquiescing to Opposer's request to amend Applicant's Answer to paragraph 7 of Opposer's First Amended Notice of Opposition as set forth in the Motion for Sanctions served on Applicant December 19, 2014. On January 13, 2015 Applicant filed his related Motion to Amend Answer to First Amended Notice of Opposition and the Amended Answer. See TTAB docket entry 10. Applicant asserts that his Answer is within conformity with Rule 11.

## ARGUMENT

Opposer served his proposed Motion for Sanctions on December 19, 2015, which was 35 days before the Jan 23, 2015 close of the discovery period. (See Exhibit A – Opposer's Certificate of Service) Therein, Opposer asserted that Applicant did not answer paragraph 7 of Opposer's First Amended Notice of Opposition in conformance with Rule 11.

Paragraph 7 of Opposer"s First Amended Notice of Opposition reads: (See TTAB docket entry # 6)

reads:

> 7. On information and belief, a YouTube video located at the URL (https://www.youtube.com/watch?v=QbNPOKswWR4#t=Il1) entitled "Hundreds Attend Marijuana Conference," contains recorded television footage of Applicant David Cox, confirming that his DR. VAPE branded electric vaporizer products that are the subject of this opposition are marketed and sold in interstate commerce primarily for use with cannabis which is currently illegal under federal law given that it is drug paraphernalia. (See Controlled Substances Act aka CSA §863) (Screen capture of aforementioned video is attached as Exhibit A which, on information and belief, depicts Applicant David Cox, marketing his DR. VAPE branded electric vaporizers at a marijuana conference.) In view of this information, on information and belief, Opposer believes that Applicant has in its possession, discoverable information that will establish that his electric vaporizers are intended for use primarily with cannabis and therefore constitute drug paraphernalia under The Controlled Substances Act. (See also attached Exhibit B which. on information and belief, depicts Applicant's June 2014 FaceBook posting that promotes a "Bud of the Month" cannabis to utilize in connection with his goods.)

Applicant believes this paragraph is poorly constructed, as it contains multiple assertions/allegations and attempts to elicit Applicant to address all of the compounded assertions with one blanket admission or denial. Opposer makes a statement of fact and then draws a conclusion as to what they believe that statement

of fact means. Applicant simply disagrees with Opposer's assertions/conclusions contained in Paragraph 7, and has formulated his answer accordingly. There is no intent to cause unnecessary delay, or increase the cost of litigation, which is evident in light of both of Applicant's answers. Opposer has taken a foolish legal position in an attempt to drive up litigation costs and drag out this opposition.

Applicant's original answer read (See TTAB docket entry # 5):

> 7. Admit the existence of said YouTube video. Deny Applicant's device is marketed and sold in interstate commerce primarily for use with cannabis.

Applicant felt that this original answer did meet the requirements of Rule 11, however, Applicant attempted to dissect Opposer's compound (run on) assertion into its component parts and answer these assertions individually in his proposed amended answer. Applicant's proposed amended answer seeks to clarify any confusion as to the actual scope of the admissions or denials, to Opposer's allegation 7. It also provides the reasoning for his answer. Applicant's proposed amended answer reads (See TTAB docket # 10)

> 7. Admit the existence of said YouTube video. Deny Applicant's device is marketed and sold in interstate commerce primarily for use with cannabis. Opposer has produced no direct evidence of any sales or marketing directed toward the "<u>use</u> of Applicant's device <u>primarily</u> for use with cannabis". Deny that Applicant's device is drug paraphernalia under the Controlled Substances Act. Deny that Applicant has "a Facebook posting that promotes a Bud of the Month cannabis <u>to utilize in connection with his goods.</u>" However, admit that the entity "Dr. Vape Inc." has its own small business facebook page. One of the postings thereon depicted a "Bud of the Month" advertisement from a local newspaper. In this advertisement medical marijuana dispensaries can purchase space showing their "bud of the month." Applicant, on behalf of Dr. Vape Inc. purchased a spot on this advertisement as the sponsor. It bears the text "Brought to you by Dr. Vape" but it does not discuss, display or promote the utilization of cannabis in connection with the Dr. Vape goods. Therefore, deny that applicant's June

2014 facebook posting promotes "Bud of the Month" cannabis to utilize in connection with his goods.

Applicant asserts that his proposed answer is long and clear, and individually address the numerous, compound allegations of Opposer's allegation 7 within the scope of Rule 11. It also avoids making a blanket admission or denial to the compound, run-on aspects of Opposer's assertions/conclusions. Otherwise, if taken in their entirety, Applicant would answer "denied" to each of the sentences of the allegation/conclusion written in allegation 7.

Applicant is not interested in Opposer's interpretation of whether its perceived Rule 11 issue has been cured with Applicant's Proposed Amended Answer (see TTAB docket entry # 10). Applicant in his December 30, 2014 letter to Mr. Philbrick (Exhibit B), acknowledged that a specific assertion, a parenthetical reference to an Exhibit B depicting a FaceBook posting, had not been specifically addressed in Applicant's Answer (See TTAB docket entry # 5). When Applicant sought Opposer's permission to file an Amended Answer, and when that permission was denied, Applicant filed its Motion (See TTAB docket # 10).

Applicant is awestruck that Opposer considers Applicant's Motion to Amend to be "frivolous" when it was precipitated by Opposer's threat of sanctions. Actually, one could say that this entire issue was precipitated by Opposer's poorly worded allegations.

Again, after viewing Opposer's proposed Motion for Sanctions, Applicant sought permission to file an Amended Answer from Opposer's attorney in his December 30, 2014 letter to Mr. Philbrick (Exhibit B). However, Opposer's response contained in Mr. Philbrick's January 9, 2015 letter suggested that Opposer be

allowed to review any proposed Answer prior to submission to the TTAB (Exhibit C), and that his consent to filing would be predicated on his determination that the defect had been cured. Simply stated, Opposer does not get to dictate the form of Applicant's Answer, and Applicant saw Opposer's suggestion to engage in a review-and-consent process as a letter writing campaign in an attempt to push the opportunity to "cure" Opposer's perceived deficiency beyond the "safe harbor" provision of Rule 11. Thus, leaving a motion for sanctions before this Board without any attempt to cure the alleged deficiency by the Applicant on the record. Accordingly, Applicant sought the permission of the TTAB to amend his answer as allowed under FRCP 15(a).

**RELIEF REQUESTED**

WHEREFORE, Applicant respectfully requests that Opposer's Motion for Sanctions be dismissed.

Respectfully submitted this 29th day of January 2015,

By: _____

Mark S. Hubert, OSB No. 982564
Mark S. Hubert P.C.
2300 SW First Ave, Suite 101
Portland, OR 97201
Telephone: (503) 234 7711
markhubert@pacifier.com
Attorney for Applicant, David Cox

## CERTIFICATE OF SERVICE

The undersigned does hereby certify that on this 29st day of January 2015, a true and correct copy of this **APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR SANCTIONS** in Opposition 91215512 has been served upon the Attorney for Opposer by mailing the same by U.S. Mail, first-class, postage paid, to the Attorney at his address of record, as follows:

Thomas P. Philbrick
Allmark Trademark
2089 Avy Ave.
Menlo Park, CA 94025

By: _____

Mark S. Hubert, OSB No. 982564
Mark S. Hubert P.C.
2300 SW First Ave, Suite 101
Portland, OR 97201
Telephone: (503) 234 7711
markhubert@pacifier.com
Attorney for Applicant, David Cox

# EXHIBIT A

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR RULE 11 SANCTIONS WITH REGARD TO APPLICANT's ANSWER FILED ON OCTOBER 17, 2014** has been served on Applicant's attorney of record by mailing said copy on December 19, 2014 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.
Attn: Mark S. Hubert, Esq.
2300 SW First Ave., Suite 101
Portland, OR 97201

By: _____

Thomas P. Philbrick

Dated: December 19, 2014

# EXHIBIT B

**MARK S. HUBERT, P.C.**
Patent Prosecution & Intellectual Property Litigation

2300 SW First Avenue, Suite 101
Portland, OR 97201
Telephone: (503) 234-7711

December 30, 2014

Thomas P. Philbrick
Allmark Trademark
2089 Avy Ave.
Menlo Park, CA 94025

Mr. Philbrick;

**RE: Permission to File Amended Pleading**

I am in receipt of your proposed Motion for Rule 11 Sanctions, dated December 19, 2014. It appears that I did not address what you consider an allegation in paragraph 7 of your First Amended Notice of Opposition. Since it was contained in quotation marks, and prefaced with "*See*" I did not treat it as anything other than a reference.

I have prepared Applicant's First Amended Answer to First Amended Notice of Opposition and I am prepared to file it, however since more than 20 days have passed pursuant to FRCP 15(a) and TBMP 507.02 I may amend its pleading only by written consent of every adverse party or by leave of the Board. I am assuming that you have, or are giving me this written consent in paragraphs 1 and 2, pages 4 and 5 of your Opposer's Motion for Rule 11 Sanctions With Regard to Applicant's Answer Filed on October 17, 2014.

Please confirm if this is the case. Upon confirmation I will file the amendment as unopposed and preface it with a statement as to your written permission.

Cordially,

Mark S. Hubert

Mark S. Hubert*◆
markhubert@pacifier.com

Nicole E. Hyatt◆
nicoleh@pacifier.com

*Oregon State Bar Member
◆Registered to Practice Before the USPTO

## CERTIFICATE OF SERVICE

The undersigned does hereby certify that on this 30st day of December 2014, a true and correct copy of this letter **(RE: Permission to File Amended Pleading)** in Opposition 91215512 has been served upon the Attorney for Opposer by mailing the same by U.S. Mail, first-class, postage paid, to the Attorney at his address of record, as follows:

Thomas P. Philbrick
Allmark Trademark
2089 Avy Ave.
Menlo Park, CA 94025

And By email to tom@allmarktrademark.com

By: _____

Mark S. Hubert, OSB No. 982564
Mark S. Hubert P.C.
2300 SW First Ave, Suite 101
Portland, OR 97201
Telephone: (503) 234 7711
markhubert@pacifier.com
Attorney for Applicant, David Cox

# EXHIBIT C

# ALLMARK TRADEMARK ®

*2089 Avy Ave.*
*Menlo Park, CA 94025*
*Telephone: 650-233-2789*
*Fax: 650-233-2791*


January 9, 2015

**VIA FIRST CLASS MAIL and EMAIL TO markhubert@pacifier.com**

Mark S. Hubert, P.C.
Attn: Mark S. Hubert, Esq.
2300 SW 1st Ave., Suite 101
Portland, OR 97201

**Re: David Cox's request for permission to file Amended Answer Pleading in Dr. Vape trademark opposition number 91215512**

Dear Mr. Hubert,

We are in receipt of your December 30, 2014 letter with the caption of "RE: Permission to File Amended Pleading." We appreciate your apparent willingness to attempt to resolve the Rule 11 violations contained in your October 17, 2014 answer to first amended opposition. However, your December 30th letter only indicates a willingness to amend the answer relating to the referenced FaceBook allegation. While certainly one of the problems with your amended answer, it certainly isn't the only violation as discussed in our draft motion for Rule 11 sanctions.

Our concern with simply granting my client's unconditional consent for you to file an amended answer is that given your December 30th letter, your amended answer sounds like it would almost certainly contain what in our view are similar and/or identical Rule 11 violations with perhaps the only cure being in relation to the allegation regarding your clients FaceBook page. This would leave my client in the predicament of seeing your amended answer only upon its filing and then having to draft a different and revised Rule 11 motion for service on your office, with a renewed waiting period before service at the TTAB. This obviously isn't practical nor what is contemplated under the Rule 11 procedure.

In an effort to avoid the anticipated merry-go-round of revised and resubmitted Rule 11 Motions, Body Vibe suggests what it believes to be a reasonable compromise. In an effort to resolve this Rule 11 issue short of TTAB intervention, Body Vibe requests that it be permitted to review your proposed amended answer draft before it is submitted at the TTAB. If Body Vibe believes the Rule 11 issues to be cured in the draft amended answer, then it will provide its consent for the filing of the amended answer. On the

other hand, if any of the Rule 11 issues outlined in its draft motion for Rule 11 sanctions remain, then it will not provide its consent and will instead proceed with the filing of the motion at the TTAB.

To be clear, under Rule 11, Body Vibe is entitled to admissions or denials of the allegations in paragraph 7 that are presented in a good faith manner, not simply evasive statements such as "said YouTube video exists." To comply with the spirit of Rule 11, everything contained in paragraph 7 needs to be expressly admitted or denied in a clear manner so that Body Vibe knows where Mr. Cox stands. Further, Mr. Cox's catch-all denial in paragraph 15 of its October 17th answer needs to be clarified to determine if he is denying significant portions of Body Vibe's paragraph 7 of its amended notice of opposition.

We trust that Mr. Cox is agreeable to Body Vibe's request to review the proposed amended answer before consent to file can be contemplated. Please provide your response and the amended answer draft by 5pm Pacific Time on January 14th, otherwise Body Vibe will proceed with the filing of the Rule 11 motion with the TTAB. Please call or email with any follow up questions that you may have. Thank you.

Sincerely,

Thomas P. Philbrick, Esq.
John E. Russell, Esq.
ALLMARK TRADEMARK ®
Attorneys for Body Vibe International, LLC
Phone: (650)233-2789
Email: tom@allmarktrademark.com

CC: Body Vibe International, LLC

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR RULE 11 SANCTIONS AGAINST APPLICANT WITH RESPECT TO ANSWER FILED OCTOBER 17, 2014** has been served on Applicant's attorney of record by mailing said copy on January 23, 2015 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.
Attn: Mark S. Hubert, Esq.
2300 SW First Ave., Suite 101
Portland, OR 97201

By: _____

Thomas P. Philbrick

Dated: 01/23/2015