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

Proceeding	91215512
Party	Defendant Cox, David
Correspondence Address	MARK S. HUBERT MARK S. HUBERT, P.C. 2300 SW FIRST AVE STE 101 PORTLAND, OR 97201-5047 UNITED STATES 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/
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**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

OPPOSITION TO OPPOSER’S MOTION FOR LEAVE TO AMEND

COMES NOW, David Cox (“Applicant”), by and through his attorney Mark S. Hubert, and opposes Opposer’s Motion for Leave to Amend.

Opposer has moved to amend their Complaint to add allegations that Applicant’s electronic vaporizer for which trademark registration is sought is illegal and that any trademark thereof would be unregistrable as being “not in lawful use in commerce.” Opposer’s arguments fails for several reasons:

1. Electric vaporizers are their own category of identification under International Classification 011 and can also be seen trademarked as electronic pipes in International Class 034;

2. Opposer's device is also an electric vaporizer, and like all electric vaporizers, is capable of use with any ignitable organic substance. Once sold, Applicant and Opposer have no control over any alleged unlawful use of their devices;
3. Electric vaporizers are not illegal to sell under 21 U.S.C § 863 (The Controlled Substances Act) and in fact, an entire industry has grown around them;
4. The Trademark Office has already approved numerous trademark registrations for electric vaporizers and retail outlets for electric vaporizers such as O-VAPE (4576033), Great Lakes Vapes (4508394), Wonder Vape (4521153), and CALI VAPE (4452756) which is prima facie acknowledgement of these device's legality when their primarily intended purpose is for use with non-controlled substances; and
5. Opposer has not pointed to a single instance wherein Applicant has directly stated, or marketed his electric vaporizer for use with controlled substances such marijuana. All Opposer's arguments rely on inferences they have drawn based on Opposer's interpretation of Youtube video footage and FaceBook /Twitter screen capture information. Opposer's argument is based on associations with cannabis but cites not one scintilla of evidence that the primary intention of Applicant's electric vaporizer is for other than use with his E-wax or nicotine fluid.

Applicant contends that Opposers' motion to amend the Complaint should be denied for the following reasons:

- Justice does not require amendment of the pleadings;
- Amendment does not serve any legitimate purpose;

- Denial of Opposer’s motion does not harm the merits of Opposer’ action;
- Neither justice nor judicial economy will be served by the proposed amendment;

DISCUSSION

Leave to Amend is Discretionary

Determining whether to grant leave to amend a pleading is an exercise in the Court’s discretion. *State Distributors, Inc. v. Glenmore Distilleries, Co.*, 738 F.2d 405, 416 (10th Cir. 1984); *Foman v. Davis*, 371 U.S. 178, 182 (1962) (granting or denying the “opportunity to amend is within the discretion of the District Court”). In making its decision, the Court must consider that the purpose of granting leave to amend is two fold: (1) to facilitate a decision on the merits, and (2) to ensure that all issues related to a specific transaction or occurrence are before the Court. *Filmtec Corp. v. Hydranautics*, 67 F.3d 931, 935 (Fed. Cir. 1995.)

In the present action, granting Opposer’s leave to amend their complaint to include allegations of unlawful use is unnecessary to facilitate a decision on the merits, *to wit*: which of the parties was the first to use in commerce. Furthermore, all issues necessary to resolve this opposition are already before the Court. Applicant’s first date of use in commerce is as stated in his trademark application, and all the Opposer need show to prevail is that their first date of use in commerce is indeed what they claim – before that of Applicant’s.

Leave Should Not Be Granted Automatically

Although leave to amend is freely granted, such leave is not automatic and the court should consider certain factors that would preclude amendment, such as bad faith and dilatory motive. *First City Bank, N.A. v. Air Aircraft Sales, Inc.*, 820 F.2d 1127, 1132 (10th Cir. 1987) (citing *Foman v. Davis*, 371 U.S. 178); *Bohen v. City of East Chicago*, 799 F.2d 1180, 1184 (7th Cir. 1986) (delay and prejudice may preclude automatic grant of amendment).

The case at bar is an action that highlights the reasons for limitations to amendment of the pleadings. As proposed, the Amended Complaint is not offered to cure any deficiency related to the sufficiency of claims, jurisdictional defects, or otherwise. Principally, the Amended Complaint is offered to add claims to a legal proceeding that will be adjudicated on Opposer's ability to provide substantial evidence to establish that they indeed do have an earlier date of first sale in commerce. In fact, the likely outcome of permitting the Opposer's motion to amend their complaint is protracted litigation, burdensome discovery, and considerable additional expense by all parties. Opposer's amendment will bring into issue the legality of a device which has been around for years, available online, in countless malls and corner stores and has received numerous federally registered trademarks here in the USA.

Factors for Judicial Consideration on Motion for Leave to Amend Pleadings

According to the landmark case on this topic, *Foman v. Davis*, 371 U.S. 178, the Court may deny a motion to amend for the following reasons: (1) undue delay, (2) bad faith or dilatory motive by the movant, (3) repeated failure to cure

deficiencies by amendments previously allowed, (4) undue prejudice to the opposing party, (5) and futility of the amendment. *See also Zenith Radio Corp. v. Hazeltine Research, Inc.*, 401 U.S. 321, 330-331 (1971). Subsequent federal cases, in multiple circuits, regarding amendments to pleadings have identified another factor for consideration, judicial economy. *Chitimacha Tribe of La. V. Harry L. Laws Co.*, 690 F.2d 1157, 1163 (5th Cir. 1982) (“In keeping with the purposes of the rule, the court should consider judicial economy and whether the amendments would lead to expeditious disposition of the merits of the litigation”); *Perrian v. O’Grady*, 958 F.2d 192, 195 (7th Cir. 1992) (justification for denying leave includes prejudice to judicial system and public’s interest in prompt resolution of disputes, even if there is no prejudice to the opposing party).

In the action before the Court, at least four factors are present that justify denial of Plaintiffs’ motion for leave to amend their Complaint.

a. Undue Delay and Bad Faith

First, permitting amendment to add allegations of unlawful use would create and foster undue delay in resolving this matter. As it stands this is a straightforward case of first use in commerce. Who can prove what date. In all likelihood the matter will be resolved between the parties once their discovery has come out. The issue of unlawful use is but a bad faith, strongarm technique to have Applicant cancel his application. In fact, Opposer demanded that Applicant withdraw his application by August 1, 2014 or Applicant’s attorney would be reported to his state bar for multiple felonies associated with the application of Applicant’s mark. (Copy of this

letter is appended as Applicant's EXHIBIT A) This report to Applicant's Attorney's state Bar was indeed made and immediately dismissed by the Oregon State Bar.

b. Undue Prejudice to Defendants

Second, permitting amendment to add an allegation of unlawful use would impose undue prejudice on the Applicant. Fundamentally, and without exception, the addition of such an allegation would cause undue delay as stated above, drastically increase the scope of discovery, contribute to additional and protracted litigation expense, and result in an exponential increase in attorneys' fees. *See e.g. Ruotolo v. City of New York*, 514 F.3d 184, 192 (2d Cir. 2008) (in order to gauge prejudice, the Court should consider, among other things, whether amendment would require the opponent to expend significant additional resources to conduct discovery and prepare for trial, or would significantly delay resolution of the dispute).

Opposer brought this opposition based on their allegations of an earlier date of sale in commerce and should be willing to stand by this alone. The issue of unlawful use is a red herring and goes against the Trademark Office's current practice of allowing the registration of trademarks for electric vaporizers and pipes.

c. Futility of Amendment

Third, permitting amendment to add unlawful use would be futile as Applicant's electric vaporizer would only be unlawful use if it was indeed drug paraphernalia as established by the Controlled Substances Act. *21 U.S.C. 863 (d)*. requires that to be designated as drug paraphernalia, electric vaporizers must be

“primarily intended or designed” for use with controlled substances. 21 U.S.C § 863

regulates the sale of drug paraphernalia as follows:

(a) In general

It is unlawful for any person—

- (1) to sell or offer for sale drug paraphernalia;
- (2) to use the mails or any other facility of interstate commerce to transport drug paraphernalia; or
- (3) to import or export drug paraphernalia.

Notably 21 U.S.C § 863 provides exemptions, which allow the lawful sale of electronic cigarettes and vaporizers traditionally intended for use with tobacco products.

(f) Exemptions

This section shall not apply to—

- (1) any person authorized by local, State, or Federal law to manufacture, possess, or distribute such items; or
- (2) any item that, in the normal lawful course of business, is imported, exported, transported, or sold through the mail or by any other means, and traditionally intended for use with tobacco products, including any pipe, paper, or accessory.

The fact that the Trademark Office has already been allowing registration of goods, *to wit*: electric vaporizers and pipes in International Class 001, and the registration of services, *to wit*: sales of electric vaporizers and pipes in International Class 034 is prima facie evidence of their legality.

If electric vaporizers are found to be unlawful use then both Opposer’s application and Applicant’s application must be declared rejected as they are both for trademarks of functionally identical devices.

d. Judicial Economy

Fourth, permitting amendment to add allegations of unlawful use will not serve judicial economy. The objective of the judicial process is “to secure the just, speedy, and inexpensive determination of every action.” *See* Fed. R. Civ. P. 1. In consideration of the foregoing, the amendment proposed by the Opposer is contrary

to the purposes and objectives of the Rules of Civil Procedure. This is a case of the first use in commerce – nothing further.

4. Balancing of Harms and Prejudices

Full consideration of whether to permit amendment of the Complaint by the Opposer requires the Court to balance the prejudice to the Applicant if leave to amend is granted against the harm to the Opposer if leave to amend is denied. *Dussouy v. Gulf Coast Inv. Corp.*, 660 F.2d 594, 598 (5th Cir. 1981) (in consideration of the *Foman* factors, the court may weigh the prejudice to the non-movant if leave is granted against the harm to the movant if leave is denied).

The Applicant has identified at least four grounds for which the Opposer's motion for leave should be denied. The Opposer, however, identifies but two principal reasons to grant amendment: (1) the case is at an early stage; and (2) the evidence was not available to the Opposer at the time their initial pleading was drafted. (See Opposer's Motion for Leave to File First Amended Complaint p. 4.)

CONCLUSION

WHEREFORE, the Applicant respectfully requests the Court to deny Opposer's Motion for Leave to File Amended Complaint.

Applicant's electric vaporizer, (like Opposer's electric vaporizer) is lawfully sold for use with non-contraband smoke-able products. Currently, such electric vaporizers (a form of which is an electronic or e-cigarette) are distributed nationwide and can be found in every convenience store or shopping mall.

Applicant does not advertise his device for use with cannabis related products. The

test for whether such a device is unlawful is based on whether the primary intention or design is for use with controlled substances and has nothing to do with any associations that may arise by virtue of the use of his lawful device after the point of sale.

Respectfully submitted this 13th day of August, 2014,

By: /s/ Mark S. Hubert
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 FILING

I HEREBY CERTIFY that the foregoing document was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board's ESTTA electronic filing system, this 13^h day of August, 2014.

By: */s/ Mark S. Hubert*

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 13th day of August 2014, a true and correct copy of this "OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND" 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: */s/ Mark S. Hubert*

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

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

Dear Mr. Hubert,

07.21.14

Your client David Cox, through you his attorney of record Mark Hubert, has filed a trademark application at the USPTO with Serial No. 85966352.

BodyVibe International is presently disputing this application filing via the ongoing opposition case No. 91215512.

It has come to my attention that your client's application could be regarded as an "unlawful use" application considering that the product being trademarked is used for human body cannabis inhalation. A considerable amount of evidence has been collected to substantiate this illegal use, even though the Dr. Vape website says the + Dr. Vape vaporizers are only used for nicotine-free glycerin. (see attached evidence)

Unlawful Use

Although the Board in *Automedx* held that use of a mark in association with the sale of a medical device, *before* the FDA approved it for commercial sale, was trademark "use," trademark applicants should tread lightly in grounding trademark rights on sales of products and services that have not yet crossed all legal hurdles. As a general rule, use of a mark must be legal use to establish trademark rights. This principle would clearly apply, for instance, if the goods or services were themselves illegal—such as an application to register a mark for use on illicit drugs. In such cases, U.S. courts will generally apply the unlawful use doctrine preventing a trademark owner from securing trademark rights from unlawful sales of goods or services.

Even though Oregon has passed Marijuana Legalization Statutes for personal medical use (see <http://www.katu.com/politics/local/Oregon-State-House-votes-to-legalize-medical-marijuana-dispensaries-212804501.html>.) the federal government still considers it to be an illegal drug, and as such, all paraphernalia is also illegal under: **21 U.S. Code § 863 - Drug paraphernalia**

(a) In general

It is unlawful for any person—

- (1) to sell or offer for sale drug paraphernalia;**
- (2) to use the mails or any other facility of interstate commerce to transport drug paraphernalia; or**
- (3) to import or export drug paraphernalia.**

(b) Penalties

Anyone convicted of an offense under subsection (a) of this section shall be imprisoned for not more than three years and fined under title 18.

(c) Seizure and forfeiture

Any drug paraphernalia involved in any violation of subsection (a) of this section shall be

subject to seizure and forfeiture upon the conviction of a person for such violation. Any such paraphernalia shall be delivered to the Administrator of General Services, General Services Administration, who may order such paraphernalia destroyed or may authorize its use for law enforcement or educational purposes by Federal, State, or local authorities.

(d) “Drug paraphernalia” defined

The term “drug paraphernalia” means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under this subchapter. It includes items primarily intended or designed for use in ingesting, inhaling, or otherwise introducing marijuana, [1] cocaine, hashish, hashish oil, PCP, methamphetamine, or amphetamines into the human body, such as—

(1) metal, wooden, acrylic, glass, stone, plastic, or ceramic pipes with or without screens, permanent screens, hashish heads, or punctured metal bowls;

(2) water pipes;

(3) carburetion tubes and devices;

(4) smoking and carburetion masks;

(5) roach clips: meaning objects used to hold burning material, such as a marijuana cigarette, that has become too small or too short to be held in the hand;

(6) miniature spoons with level capacities of one-tenth cubic centimeter or less;

(7) chamber pipes;

(8) carburetor pipes;

(9) **electric pipes;**

(10) air-driven pipes;

(11) chillums;

(12) bongs;

(13) ice pipes or chillers;

(14) wired cigarette papers; or

(15) cocaine freebase kits.

(e) Matters considered in determination of what constitutes drug paraphernalia

In determining whether an item constitutes drug paraphernalia, in addition to all other logically relevant factors, the following may be considered:

(1) instructions, oral or written, provided with the item concerning its use;

(2) descriptive materials accompanying the item which explain or depict its use;

(3) national and local advertising concerning its use;

(4) the manner in which the item is displayed for sale;

(5) whether the owner, or anyone in control of the item, is a legitimate supplier of like or related items to the community, such as a licensed distributor or dealer of tobacco products;

(6) direct or circumstantial evidence of the ratio of sales of the item(s) to the total sales of the business enterprise;

(7) the existence and scope of legitimate uses of the item in the community; and

(8) expert testimony concerning its use.

(f) Exemptions

This section shall not apply to—

(1) any person authorized by local, State, or Federal law to manufacture, possess, or distribute such items; or

(2) any item that, in the normal lawful course of business, is imported, exported, transported, or sold through the mail or by any other means, and traditionally intended for use with tobacco products, including any pipe, paper, or accessory.

David Cox admitted, in his first USPTO response filed by you, his Attorney, on April 24, 2014, that the +Dr. Vape Vaporizer is used for Cannabis inhalation and was sold in interstate commerce which is in direct violation of **21 U.S. Code § 863 - Drug paraphernalia:**

12. Opposer claims that Applicant's mark "Dr. Vape" is likely to cause confusion with Opposer's purported mark "Dr. Vape" but cites no acts by any consumer that support this. Applicant, David Cox, has been selling his cannabis-associated vaporizer in interstate commerce at least as early as May 31, 2013. Applicant cannot find any trade presence of any "Dr. Vape" trademarked electric vaporizer products other than his own in class 011. This includes industry searches for marketing, customer surveys etc. via the internet and trade marketing publications.

Mr. Hubert, you then realized that you had provided **inculpatory evidence** of the felonious acts committed by your client David Cox and subsequently removed the "cannabis-associated vaporizer" wording from the same # 12 response" below:

12. Opposer claims that Applicant's mark "Dr. Vape" is likely to cause confusion with Opposer's purported mark "Dr. Vape" but cites no acts by any consumer that support this. Applicant, David Cox, has been selling his vaporizer in interstate commerce at least as early as May 31, 2013. Applicant cannot find any trade presence of any "Dr. Vape" trademarked electric vaporizer products other than his own in class 011. This includes industry searches for marketing, customer surveys etc. via the internet and trade marketing publications.

Mr. Hubert, your act of removing the cannabis wording from his response in this filed USPTO legal document, supports the conclusion that you have now committed multiple felonies yourself through this act of concealment, including but not limited to:

"Misprision of felony" under [18 U.S.C. § 4](#)

Whoever, having knowledge of the actual commission of a felony cognizable by a court of the United States, conceals and does not as soon as possible make known the same to some judge or other person in civil or military authority under the United States, shall be fined under this title or imprisoned not more than three years, or both.

This offense, however, requires active concealment of a known felony rather than merely failing to report it.

The Federal misprision of felony statute is usually only used in prosecutions against defendants who have a special duty to report a crime, such as a government official.

Mr. Hubert you are an "Officer of the Court" as a bar member of the State of Oregon, and as such, you could be considered to be a government official. See https://en.wikipedia.org/wiki/Officer_of_the_court

Also, you violated § 550 18 U.S.C. § 2(a). Section 2(b) which makes clear the legislative intent to punish as a principal not only one who directly commits an offense but also one who "aids, abets, counsels, commands, induces or procures" another to commit an offense, but also anyone who causes the doing of an act which if done by him directly would render him guilty of an offense against the United States. It removes all doubt that one who puts in motion or assists in the illegal enterprise or causes the commission of an indispensable element of the offense by an innocent agent or instrumentality is guilty as a principal even though he intentionally refrained from the direct act constituting the completed offense.

In summary, the Dr. Vape application is an unlawful use application and cannot be applied-for as a federal trademark, since the trademarked product, as used in connection with the goods identified in the first opposition response, is not in lawful use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127.

To qualify for federal trademark registration, the use of a mark in commerce must be lawful. *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 526, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (stating that "[a] valid application cannot be filed at all for registration of a mark without 'lawful use in commerce'"); TMEP §907; see *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *CreAgri, Inc. v. USANA Health Scis., Inc.*, 474 F.3d 626, 630, 81 USPQ2d 1592, 1595 (9th Cir. 2007). Thus, any goods to which the mark is applied must comply with all applicable federal laws. See *In re Midwest Tennis & Track Co.*, 29 USPQ2d 1386, 1386 n.2 (TTAB 1993) (noting that "[i]t is settled that the Trademark Act's requirement of 'use in commerce,' means a 'lawful use in commerce,' and [that the sale or] the shipment of goods in violation of [a] federal statute . . . may not be recognized as the basis for establishing trademark rights" (quoting *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB 1982))); *In re Pepcom Indus., Inc.*, 192 USPQ 400, 401 (TTAB 1976); TMEP §907.

The Controlled Substances Act (CSA) prohibits, among other things, manufacturing, distributing, dispensing, or possessing certain controlled substances, including marijuana and marijuana-based preparations. 21 U.S.C. §§812, 841(a)(1), 844(a); see also 21 U.S.C. §802(16) (defining "[marijuana]"). In addition, the CSA makes it unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, i.e., "any equipment, product, or material of any kind which is primarily intended or designed for

use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under [the CSA].” 21 U.S.C. §863.

NOT IN LAWFUL USE IN COMMERCE – MARIJUANA-RELATED GOODS – BASED ON IDENTIFICATION

Based on the above accusations against you Mr. Hubert and your client, David Cox has no standing to even file a Federal TM application or defend the opposition case.

If you agree with this analysis, I would suggest that you report these crimes to the USPTO administrative judge immediately and abandon the +Dr. Vape USPTO trademark application, otherwise, you could be in violation of the "Misprision of Felony" statutes under 18 U.S.C § 4.

If neither of these actions takes place prior to August 1, 2014. Then I will have to report these felonious acts to the Federal authorities and the Oregon State bar in order to protect myself from prosecution under the "Misprision of Felony" statute 18 U.S.C § 4.

Sincerely,

/Adele Podgorny, R.N. /

Adele Podgorny, R.N.

Managing Member
BodyVibe International, LLC
11445 E. Via Linda St. #2626
Scottsdale, AZ 85259
Cell: 714.267.0340
Email: adele@bodyvibeusa.com
www.bodyvibeusa.com

