

ESTTA Tracking number: **ESTTA660347**

Filing date: **03/11/2015**

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

Proceeding	91218280
Party	Defendant Ibrahim Dabes dba Dabes Egyptian Imports
Correspondence Address	PAUL D BIANCO FLEIT GIBBONS GUTMAN BONGINI & BIANCO PL 21355 E DIXIE HWY, STE 115 MIAMI, FL 33180-1244 UNITED STATES tmmiami@fggbb.com
Submission	Other Motions/Papers
Filer's Name	Paul D. Bianco
Filer's e-mail	tmmiami@fggbb.com
Signature	/Paul D. Bianco/
Date	03/11/2015
Attachments	reply to opp response.pdf(147561 bytes) exhibit a.pdf(264984 bytes) exhibit b.pdf(266056 bytes)

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

In re Application No. 86/025,182
For the Mark: AMY GOLD TOBACCO MOLASSES (design)
Published in the Official Gazette on May 13, 2014

Mya Saray, LLC,)	
)	
Opposer,)	Opposition No.: 91218280
)	
v.)	
)	
Dabes, Ibrahim DBA)	
Dabes Egyptian Imports,)	
)	
Applicant.)	

**APPLICANT’S REPLY TO OPPOSER’S RESPONSE IN
OPPOSITION TO ENTRY OF AMENDMENT**

Ibrahim Dabes (“Applicant,”) by and through its undersigned counsel replies as follows to Opposer’s Response in Opposition to Entry of Amendment.

As an initial matter, Applicant regrets any confusion that may have occurred in this Proceeding.

As set forth below, Applicant respectfully submits to the Trademark Trial and Appeal Board (the “Board”) that Applicant reasonably believed Applicant had the consent of Mya Saray, LLC (“Opposer”) to amend the identification of goods at the time its Motion to Amend was filed.

Although there are two pending proceedings before the Board wherein Applicant and Opposer are named parties, Applicant specifically requested Opposer’s consent to amend the identification of goods in the application for the mark AMY GOLD TOBACCO MOLASSES

(design), which is the subject of this Proceeding ‘280. The other proceeding, as referenced in Opposer’s response, is Cancellation Proceeding ‘249 which was filed on October 29, 2014 against US Registration No. 4,536,391.

In a telephonic conference on October 14, 2014—before Cancellation Proceeding ‘249 was ever filed—counsel for Applicant first suggested limiting the goods to “tobacco” as a way to settle the present Proceeding ‘280. Again, counsel for Applicant brought up these same terms in a Discovery Conference of December 18, 2014 for the subject mark. As evidenced in Exhibit A, there is no question that the Discovery Conference was held for the purpose of discussing the subject Proceeding ‘280. When it was not readily accepted as a term for settling the present Proceeding ‘280, counsel for Applicant requested consent to file the amendment in the subject Application. Counsel for Applicant never mentioned a narrowing amendment with respect to Cancellation Proceeding ‘249. In fact, as evidenced in the email of January 20, 2015 “Exhibit B,” counsel for Opposer states that the Discovery Conference was held “expressly for the ‘280 action,” and wishes to implement—nearly a month after the conference and after consent was expressly given—the same terms in the other proceeding.

As already made of record, counsel for Opposer provided consent in the email of December 29, 2014 to amend the identification of goods in the subject Application to “tobacco.” Although the email also includes an application number corresponding to the registration in the Cancellation Proceeding ‘249, there is no mention that consent was granted *provided that* the amendment was filed in both proceedings. As explained above, this condition was never the understanding of the parties because Applicant had only requested consent to amend the subject Application in this Proceeding ‘280. In the absence of anything to show that this condition was intended, none is created by a statement that provides consent in each proceeding. With respect

to Cancellation Proceeding '249, counsel for Applicant did not have Applicant's instructions to file a narrowing amendment.

As restricting the goods and services from "tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas" to "tobacco" was the amendment discussed, counsel for Applicant filed its Motion for Amendment with consent in the subject Application on January 20, 2015. It was not until February 24, 2015, the day before Opposer filed its Response that counsel for Opposer reached out expressing an issue with the Motion.

While it is true that the email of December 29, 2014 does reference the application number corresponding to the registration of Cancellation Proceeding '249, the email does not state that Opposer's consent was conditioned on the amendment being filed in both proceedings.

For the foregoing reasons, Applicant respectfully submits that Applicant reasonably believed Applicant had the consent of Mya Saray, LLC ("Opposer") to amend the identification of goods at the time its Motion to Amend was filed.

Respectfully submitted,

Dated: March 11, 2015

By: /Paul D. Bianco/_____

Paul D. Bianco
FLEIT GIBBONS GUTMAN
BONGINI & BIANCO PL
21355 East Dixie Highway, Suite 115
Miami, FL 33180
Telephone: (305) 830-2600

CERTIFICATE OF SERVICE

It is hereby certified that a copy of APPLICANT'S REPLY TO OPPOSER'S RESPONSE IN OPPOSITION TO ENTRY OF AMENDMENT was served by First Class Mail to M. Keith Blankenship, Da Vinci's Notebook, LLC, 10302 Bristow Center Dr., No. 52, Bristow, VA 20136, Attorney for Opposer, on this 11th day of March 2015.

/Paul D. Bianco/
Paul D. Bianco

FLEIT GIBBONS GUTMAN
BONGINI & BIANCO PL

From: M. Keith Blankenship <keith@dnotebook.com>
Sent: Wednesday, December 17, 2014 1:29 PM
To: Lourdes Perez
Cc: Paul Bianco; Dinah Fuentes
Subject: Re: Opposition Proceeding No. 91218280 - Mya Saray, LLC v. Dabes, Ibrahim - Mark: AMY GOLD TOBACCO MOLASSES; Our Ref.: 7400-T14-410Opp

Follow Up Flag: Follow up
Flag Status: Completed

2:00pm is good. I'll await your call.

M. Keith Blankenship
Da Vinci's Notebook, LLC
10302 Bristow Center Dr.
No. 52
Bristow, VA 20136
703-581-9562
keith@dnotebook.com

On Dec 16, 2014, at 3:17 PM, Lourdes Perez <lperez@fggbb.com> wrote:

Dear Mr. Blankenship,

Thank you for your email. We are available this Thursday at 2:00pm EST. Please let us know if this is a good time for you.

Kind regards,

 Lourdes Perez, Esq.
Attorney at Law, Registered to Practice before the U.S. Patent and Trademark Office
FLEIT GIBBONS GUTMAN BONGINI & BIANCO PL
21355 E. Dixie Highway, Suite 115, Miami, FL 33180, USA
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From: M. Keith Blankenship: [<mailto:keith@dnotebook.com>]
Sent: Monday, December 15, 2014 11:14 AM
To: Lourdes Perez
Cc: Paul Bianco; Constanza Lombardi
Subject: Re: Opposition Proceeding No. 91218280 - Mya Saray, LLC v. Dabes, Ibrahim - Mark: AMY GOLD TOBACCO MOLASSES

Ms. Perez,

I believe that we are about due for a **discovery conference**. Do you have availability between now and Thursday for this? In the meantime, I attach proposed versions of a **26f report and a protective order** as perhaps a starting point for discussion.

M. Keith Blankenship
Da Vinci's Notebook, LLC
10302 Bristow Center Dr.
No. 52
Bristow, VA 20136
703-581-9562
keith@dnotebook.com

From: M. Keith Blankenship <keith@dnotebook.com>
Sent: Tuesday, January 20, 2015 3:33 PM
To: Lourdes Perez
Cc: Paul Bianco; Dinah Fuentes
Subject: Re: Cancellation Proceeding No. 92060249 - Initial Disclosures and Discovery Requests

Follow Up Flag: Follow up
Flag Status: Flagged

Lourdes,

Although we had a **discovery conference in December expressly for the '280 action**, I wasn't sure whether we would apply those results to the '249 action. Offhand, I don't know why we wouldn't. **Whatever we sort out for the '280 action, do you agree that the same should apply to the '249 action** (e.g., protective order, discovery plan, etc.)?

M. Keith Blankenship
Da Vinci's Notebook, LLC
10302 Bristow Center Dr.
No. 52
Bristow, VA 20136
703-581-9562
keith@dnotebook.com

On Jan 20, 2015, at 3:28 PM, M. Keith Blankenship <keith@dnotebook.com> wrote:

Lourdes,

Please find as attached courtesy copies of the initial disclosures for the '249 action as well as our first set of discovery requests.

M. Keith Blankenship
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<DNMYA-0053_DocReqs_249_AsSent.pdf>
<DNMYA-0053_Rule 26a disclosures_AsSent.pdf>
<DNMYA-0053_Interrogatories_249_AsSent.pdf>

On Jan 20, 2015, at 3:01 PM, Lourdes Perez <lperez@fggbb.com> wrote:

Dear Mr. Blankenship,

Please find attached our initial disclosures. A copy is being sent via first class mail. Also attached are the revisions to the Discovery Plan. Please let us know if you have any questions or would like to discuss.

Kind regards,
Lourdes

Lourdes Perez, Esq.

Attorney at Law, Registered to Practice before the U.S. Patent and Trademark Office

<image001.png>

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From: M. Keith Blankenship [<mailto:keith@dnotebook.com>]

Sent: Monday, December 29, 2014 10:03 PM

To: Lourdes Perez

Cc: Paul Bianco; Dinah Fuentes

Subject: Re: Opposition Proceeding No. 91218280 - Mya Saray, LLC v. Dabes, Ibrahim - Mark: AMY GOLD TOBACCO MOLASSES; Our Ref.: 7400-T14-410Opp

Ms. Perez,

Mya Saray does consent to a motion to restrict the goods and services of applications 86025122 and 86025182 from "tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas" to "tobacco."

(I believe that this is the amendment that we discussed. If not, please send me the express language of the amendment that you propose. Also, if you could send along an updated version of the Discovery Plan, with our disagreements and modifications, that would be much appreciated.)

M. Keith Blankenship
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Dear Mr. Blankenship,

Thank you for your email. We are available this Thursday at 2:00pm EST. Please let us know if this is a good time for you.

Kind regards,

<image001.png> Lourdes Perez, Esq.
Attorney at Law, Registered to Practice before the U.S. Patent and Trademark Office
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<26f Agreement_91218280-rev. 1.docx><20150120 initial disclosures.pdf>