

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

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

GCP

Mailed: June 20, 2016

Opposition No. 91226968

Makin International, LLC

v.

Ashleigh Mason, LLC

Before Richey, Deputy Chief Administrative Trademark Judge, Bergsman, and
Pologeorgis,
Administrative Trademark Judges.

By the Board:

This proceeding now comes before the Board for consideration of Opposer's
response (filed May 4, 2016) to the Board's show cause order issued on April 19, 2016.

Background

Applicant's involved application Serial No. 86677899 was published for opposition
on November 17, 2015. On December 11, 2015, Trademark Lawyer Law Firm
(hereinafter referred to as "TLLF"), a law firm, filed a request for an extension of time
to oppose application Serial No. 86677899 using the Electronic System for Trademark
Trials and Appeals ("ESTTA"). On the same date, the Board granted the request and,
clearly identifying TLLF as the "potential opposer," allowed TLLF until March 16,
2016 to file a notice of opposition.

On March 16, 2016, within the extension period granted to TLLF, a notice of opposition was filed. The ESTTA cover sheet for the notice of opposition, as well as the body of attached complaint, however, identifies Makin International, Inc. as the Opposer. The opposition was automatically instituted and assigned Opposition No. 91226968.

Inasmuch as the name of the Opposer on the ESTTA filing cover sheet and as set forth in the body of the notice of opposition (i.e., Makin International, Inc.) differs from the name of the party to whom the extension of time was granted (i.e., TLLF), the Board, by order dated May 19, 2016, required Opposer to show cause why this opposition should not be dismissed without prejudice because the opposition appears to have been filed by a party other than the one to whom the extension of time to oppose was granted.

In its May 4, 2016, response to the Board's show cause order, Opposer maintains the following:

1. On November 12, 2015, Opposer sent correspondence, by and through its attorneys, to Applicant to assert its trademark rights in its ASHLEY MASON mark;
2. At least as early as November 12, 2015, Applicant was therefore on notice that Opposer believed that it had superior rights to the ASHLEY MASON mark;
3. Opposer informed Applicant that it was prepared to file an opposition against registration of Applicant's involved mark;

4. In a letter dated November 25, 2015, Applicant, by and through her attorney, acknowledged receipt of Opposer's November 12, 2105 correspondence;
5. On December 12, 2015, Opposer sent further correspondence to Applicant informing that it had sought an extension of time to oppose Applicant's involved application, and that it intended to oppose the application if alternate resolution could not be reached;
6. On March 16, 2016, Opposer filed its notice of opposition. At that time, Opposer discovered that a clerical error in the request for extension of time to oppose resulted in the appearance that Opposer's counsel was the party in interest, and not merely representatives of Opposer's interest in the matter;
7. In an effort to remedy the clerical error, Opposer's counsel filed the notice of opposition on Opposer's behalf and listed Opposer as the party in interest;
8. At no time from November 2105 to March 16, 2016 did Applicant indicate confusion, prejudice, or undue delay with regard to the interested party in this pending matter;
9. The mistake in identification occurred in this matter did not misidentify the party in interest to such an extent as to make Applicant unaware of the potential conflict between the parties' respective marks; and
10. In addition, Opposer requests that this proceeding be consolidated with a related Board proceeding, i.e., Opposition No. 91226919.

Decision

An opposition filed by a party other than the one to whom an extension of time to oppose was granted will not be rejected on that ground if it is shown to the satisfaction of the Board that either (1) the other party is in privity with the party granted the extension, or (2) the party in whose name the extension was requested was misidentified through mistake. *See* Trademark Rule 2.102(b), 37 CFR § 2.102(b). The showing should be in the form of a recitation of facts upon which either the claim of privity or misidentification is based, and must be submitted either with the opposition or during the time allowed by the Board in its action requesting an explanation of the discrepancy. *See* TBMP §§ 206.02 and 206.03 (2015) and authorities cited therein.

The concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor and assignee, or survivor of a merger) and the relationship shared by “related companies” within the meaning of Sections 5 and 45 of the Trademark Act, 15 U.S.C. §§ 1055 and 1127. *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000). It does not, however, include the attorney/client relationship. *See In re Spang Industries, Inc.*, 225 USPQ 888 (Comm’r 1985).

Moreover, “misidentified through mistake,” as used in Trademark Rule 2.102(b), means a mistake in the form of the potential opposer’s name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. *See Custom Computer Services, Inc. v. Paychex*

Properties, Inc., 337 F.3d 1334, 67 USPQ2d 1638 (Fed. Cir. 2003); and *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993).

Opposer's argument that its counsel had apprised Applicant that it intended to oppose Applicant's involved mark and would be filing this opposition is irrelevant to the issue of whether the party that filed this opposition is in privity with the entity that obtained the extension of time to file the opposition. The record clearly demonstrates that TLLF was the entity that obtained the extension of time to oppose. Based on the record, TLLF is not in privity with Opposer. Moreover, Opposer's argument that it was a clerical error to identify TLLF as the potential opposer is unavailing since it does not constitute a misidentification through mistake under Trademark Rule 2.102(b). *See, e.g., Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667 (TTAB 2015).

In view of the foregoing and in light of the fact that the allotted time to file a notice of opposition against the involved application has expired, the opposition is dismissed ***without prejudice*** as untimely.¹

¹ Opposer is not without recourse, as it may file a petition to cancel if and when the mark in the involved application registers. Furthermore, Opposer's request to consolidate this proceeding with Opposition No. 91226919 is deemed moot in light of this order and therefore will be given no further consideration.