

ESTTA Tracking number: **ESTTA749487**

Filing date: **06/01/2016**

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

Proceeding	91227487
Party	Defendant BioNJ Inc.
Correspondence Address	DANA S. GROSS MORGAN LEWIS BOCKIUS 1111 PENNSYLVANIA AVE NW Attention: TMSU WASHINGTON, DC 20004-2578  trademarks@morganlewis.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Jane W. Wise
Filer's e-mail	trademarks@morganlewis.com, james.sims@morganlewis.com, dana.gross@morganlewis.com, jordana.rubel@morganlewis.com, jane.wise@morganlewis.com
Signature	/Jane W. Wise/
Date	06/01/2016
Attachments	Motion to Dismiss.pdf(2005483 bytes )

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

Patients Can't Wait, LLC,  
Opposer,

v.

BioNJ Inc.,  
Applicant.

Proceeding No. 91227487

Mark: BECAUSE PATIENTS CAN'T  
WAIT

Application Ser. No. 86/769,593

**MOTION TO DISMISS**

BioNJ Inc., ("BioNJ" or "Applicant"), a New Jersey non-profit corporation with its principal office at 1255 Whitehorse-Mercerville Road Building B, Suite 514 Trenton, New Jersey 08619, by and through its undersigned counsel, respectfully moves the Trademark Trial and Appeal Board (the "Board") of the United States Patent and Trademark Office ("USPTO") pursuant to 37 C.F.R. § 2.119 and Federal Rule of Civil Procedure 12(b)(5), to dismiss the above-captioned Notice of Opposition filed by Patients Can't Wait, LLC ("Opposer"), an Indiana limited liability company with its principal place of business at 12221 Leighton Court, Carmel, Indiana 46032, for lack of service. As set forth below, the Notice of Opposition was not served on BioNJ or its attorney of record according to the Board's rules, and accordingly, BioNJ respectfully requests that the Board dismiss the action and that Application Serial No. 86/769,593 be allowed.

BioNJ alleges the following facts in support of its motion:

**Factual Background**

1. On September 26, 2015, BioNJ filed an application for the mark BECAUSE PATIENTS CAN'T WAIT (App. Serial No. 86/769,593) for “[t]rade association services, namely, promoting the interests of research-based life sciences companies; arranging and conducting business conferences” in Class 35 (the “Application”). A printout from the Trademark Status & Document Retrieval (“TSDR”) database is attached as Exhibit A.

2. On April 05, 2016, the Application was published for opposition in the *Trademark Official Gazette*.

3. On April 22, 2016, Opposer electronically filed a Notice of Opposition, which resulted in the institution of the above-captioned Proceeding No. 91227487.

4. The Certificate of Service attached to the Notice of Opposition signed by Opposer states: “The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.”

5. Opposer neither served the Notice of Opposition on BioNJ’s attorney of record, Dana S. Gross of Morgan, Lewis & Bockius LLP, nor on BioNJ. See Declaration of Dana S. Gross at ¶ 4, attached as Exhibit B, and Declaration of Randi Bromberg at ¶ 3, attached as Exhibit C.

6. Opposer did not file any extensions of time with the Board to oppose the Application.

7. The opposition period for the Application expired on May 5, 2016, pursuant to 37 C.F.R. § 2.101(c).

**Argument**

Pursuant to 37 C.F.R. § 2.101(a), an opposition proceeding is commenced by filing a timely Notice of Opposition with the required fee. The notice must include proof of service on the applicant, or where applicable, its attorney or domestic representative of record, at the correspondence address of record at the USPTO. An opposition is commenced only when two conditions are fulfilled: (1) opposer makes sufficient efforts to serve the Notice of Opposition, and (2) the Board is notified of the service at the time the Notice of Opposition is filed. *See Springfield, Inc. v. XD*, 86 USPQ2d 1063 (TTAB 2008).

As an attorney of record was appointed in connection with the Application, Opposer was required under 37 C.F.R. § 2.101(a) to serve a copy of the Notice of Opposition on the attorney of record for Applicant. 37 C.F.R. § 2.101(b). Dana S. Gross of Morgan, Lewis & Bockius, LLP is identified as the attorney of record for Applicant. *See Exhibit B at ¶ 2*. Mr. Gross did not receive a service copy of the Notice of Opposition from Opposer through First Class Mail or by any other means. *Id.* at ¶ 4. BioNJ also did not receive a service copy of the Notice of Opposition from Opposer through First Class Mail or by any other means. *See Exhibit C at ¶ 3*. Further, if the service copy of the Notice of Opposition was returned to the Opposer as undeliverable, the Opposer was obligated under 37 C.F.R. § 2.101(a) to notify the Board within ten days of its receipt of the returned copy. To Applicant's knowledge, no such notification was provided to the Board. Accordingly, as Opposer did not serve a copy of the Notice of Opposition on Applicant's attorney of record or on Applicant, and because to Applicant's knowledge, the Board was not notified by the Opposer that the service copy

of the Notice of Opposition was returned as undeliverable, Opposer did not effectuate service of the Notice of Opposition, and the Board should not have instituted this proceeding.

Proof of service assumes actual service on the applicant. See *Springfield*, 86 USPQ2d at 1064 (“Proof of service is meaningless in the absence of actual service in accordance with the statements contained in the proof of service”). As in the instant proceeding, in *Springfield Inc. v XD*, the opposer filed a Notice of Opposition with a Certificate of Service, but never actually served the applicant. *Id.* The Board held that the opposer did not comply with the service requirement, that opposer’s Notice of Opposition should not have received a filing date and that the proceeding should not have been instituted, and dismissed the opposition as a nullity. *Id.* Similarly, in the instant case, Opposer failed to comply with the service requirement, so the opposition should be dismissed.

The time for filing a Notice of Opposition is set by statute and cannot be waived by the Board. If an opposer’s actual service of a Notice of Opposition, or its submission of a proper proof of service, occurs after the close of the opposition period, the filing date of such Notice of Opposition falls outside the opposition period and the Board should refuse the opposition as untimely. See *Springfield*, 86 USPQ2d at 1064 (opposition dismissed where Notice of Opposition was filed on the last day of the opposition period including certificate of service, but opposer never actually served applicant); see also *Schott Ag v. LWren Scott*, 88 U.S.P.Q.2d 1862, 1864 (TTAB 2008) (holding that where service was defective, opposer could not amend its original Notice of Opposition to cure the defective service because the statutory period had closed).

Likewise, here, Opposer should not be allowed to amend its Notice of Opposition, as the opposition period closed on May 5, 2016, and the Notice of Opposition was not actually served within the statutory period. Accordingly, the opposition should be dismissed as a nullity.

WHEREFORE, BioNJ prays that the Motion to Dismiss be granted, that Proceeding No. 91227487 be dismissed, and that Application Serial No. 86/769,593 be allowed.

Dated: June 1, 2016

Respectfully submitted,

BioNJ Inc.

By: 

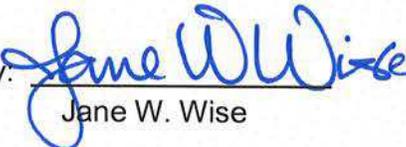
James R. Sims III  
Dana S. Gross  
Jordana S. Rubel  
Jane W. Wise  
Morgan, Lewis & Bockius LLP  
1111 Pennsylvania Ave., N.W.  
Washington, DC 20004  
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james.sims@morganlewis.com  
dana.gross@morganlewis.com  
jordana.rubel@morganlewis.com  
jane.wise@morganlewis.com

*Attorneys for Applicant*  
BioNJ Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that on June 1, 2016, I caused a true and complete copy of the foregoing MOTION TO DISMISS and the attached Exhibits to be sent to the Opposer via First Class U.S. Mail at the following address:

Jeff Kasher  
Patients Can't Wait, LLC  
12221 Leighton Court  
Carmel, IN 46032

By:   
Jane W. Wise

# **Exhibit A**

Generated on: This page was generated by TSDR on 2016-05-31 20:01:20 EDT

Mark: BECAUSE PATIENTS CAN'T WAIT

BECAUSE PATIENTS CAN'T WAIT

US Serial Number: 86769593

Application Filing Date: Sep. 26, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Opposition Pending

The pending trademark application has been examined by the Office and was published for opposition, at which time one or more oppositions were filed but they have not yet been decided.

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Apr. 22, 2016

Publication Date: Apr. 05, 2016

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## Mark Information

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Mark Literal Elements: BECAUSE PATIENTS CAN'T WAIT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*...\* identify additional (new) wording in the goods/services.

For: Trade association services, namely, promoting the interests of research-based life sciences companies; arranging and conducting business conferences

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

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## Basis Information (Case Level)

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Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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## Current Owner(s) Information

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Owner Name: BioNJ Inc.

Owner Address: 1255 Whitehorse-Mercerville Road  
Building B, Suite 514  
Trenton, NEW JERSEY UNITED STATES 08619

Legal Entity Type: non-profit corporation

State or Country: NEW JERSEY  
Where Organized:

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: Dana S. Gross

Docket Number: 097024-0028

Attorney Primary Email Address: [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)

Attorney Email Authorized: Yes

### Correspondent

Correspondent Name/Address: DANA S. GROSS  
MORGAN LEWIS BOCKIUS  
1111 PENNSYLVANIA AVE NW ATTENTION: TMSU  
WASHINGTON 20004-2578

Phone: 202-739-5151

Fax: 202-739-3001

Correspondent e-mail: [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Apr. 22, 2016	OPPOSITION INSTITUTED NO. 999999	227487
Apr. 22, 2016	OPPOSITION PAPERS RECEIVED AT TTAB	
Apr. 05, 2016	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 05, 2016	PUBLISHED FOR OPPOSITION	
Mar. 16, 2016	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 01, 2016	LAW OFFICE PUBLICATION REVIEW COMPLETED	70633
Feb. 24, 2016	ASSIGNED TO LIE	70633
Jan. 25, 2016	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 22, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jan. 22, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jan. 22, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 15, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jan. 15, 2016	NON-FINAL ACTION E-MAILED	6325
Jan. 15, 2016	NON-FINAL ACTION WRITTEN	83169
Jan. 14, 2016	ASSIGNED TO EXAMINER	83169
Oct. 02, 2015	NOTICE OF PSEUDO MARK E-MAILED	
Oct. 01, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 30, 2015	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

TM Attorney: KIDWELL WALKER, JACLYN

Law Office Assigned: LAW OFFICE 112

### File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 01, 2016

## Proceedings

### Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding [91227487](#)

Filing Date: Apr 22, 2016

Number: \_\_\_\_\_

Status: Pending

Status Date: Apr 22, 2016

Interlocutory MIKE WEBSTER  
Attorney:

**Defendant**

Name: BioNJ Inc.

Correspondent DANA S. GROSS  
Address: MORGAN LEWIS BOCKIUS  
1111 PENNSYLVANIA AVE NW Attention: TMSU  
WASHINGTON DC , 20004-2578

Correspondent e-mail: [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BECAUSE PATIENTS CAN'T WAIT	Opposition Pending	<a href="#">86769593</a>	

**Plaintiff(s)**

Name: Patients Can't Wait, LLC

Correspondent jeff kasher  
Address: Patients Can't Wait, LLC  
12221 Leighton Court  
Carmel IN UNITED STATES , 46032

Correspondent e-mail: [kasher.lisa@gmail.com](mailto:kasher.lisa@gmail.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
PATIENTS CAN'T WAIT			

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 22, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 22, 2016	Jun 01, 2016
3	PENDING, INSTITUTED	Apr 22, 2016	

## **Exhibit B**

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

Patients Can't Wait, LLC,  
Opposer,

v.

BioNJ Inc.,  
Applicant.

Proceeding No. 91227487

Mark: BECAUSE PATIENTS CAN'T  
WAIT

Application Ser. No. 86/769,593

**DECLARATION OF DANA S. GROSS IN SUPPORT OF  
APPLICANT'S MOTION TO DISMISS**

I, Dana S. Gross, declare as follows:

1. I am an attorney at Morgan, Lewis & Bockius LLP. The facts set forth in this Declaration are based on my personal knowledge, unless otherwise noted.
2. I am listed as the Attorney of Record in connection with Application Serial No. 86/769,593, which is the application filed by BioNJ Inc. ("Applicant") for the mark BECAUSE PATIENTS CAN'T WAIT. Attached as Exhibit 1 hereto is a printout from the Trademark Status & Document Retrieval ("TSDR") page for the Application.
3. On April 22, 2016, Jeffery Kasher of Patients Can't Wait, LLC ("Opposer") filed a Notice of Opposition opposing the registration of Application Serial No. 86/769,593 in which he stated that he served the Notice of Opposition on BioNJ by First Class Mail.
4. I never received a service copy of the Notice of Opposition sent by Opposer via First Class Mail or by any other means.

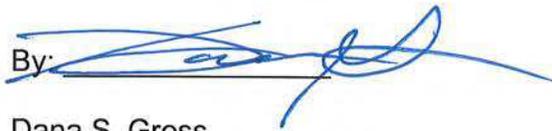
5. I was notified of the institution of the Opposition proceeding through an email notification from the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

6. Opposer has not contacted me to attempt service since the above-captioned proceeding was instituted.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct under to 28 U.S.C. § 1746.

Dated: June 1, 2016

By:



Dana S. Gross

## **Exhibit 1**

### **Declaration of Dana S. Gross**

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Mark: BECAUSE PATIENTS CAN'T WAIT

BECAUSE PATIENTS CAN'T WAIT

US Serial Number: 86769593

Application Filing Date: Sep. 26, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Opposition Pending

The pending trademark application has been examined by the Office and was published for opposition, at which time one or more oppositions were filed but they have not yet been decided.

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Apr. 22, 2016

Publication Date: Apr. 05, 2016

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## Mark Information

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Mark Literal Elements: BECAUSE PATIENTS CAN'T WAIT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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## Goods and Services

---

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*...\* identify additional (new) wording in the goods/services.

For: Trade association services, namely, promoting the interests of research-based life sciences companies; arranging and conducting business conferences

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

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## Basis Information (Case Level)

---

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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## Current Owner(s) Information

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Owner Name: BioNJ Inc.

Owner Address: 1255 Whitehorse-Mercerville Road  
Building B, Suite 514  
Trenton, NEW JERSEY UNITED STATES 08619

Legal Entity Type: non-profit corporation

State or Country NEW JERSEY  
Where Organized:

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: Dana S. Gross

Docket Number: 097024-0028

Attorney Primary [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)  
Email Address:

Attorney Email Yes  
Authorized:

### Correspondent

Correspondent DANA S. GROSS  
Name/Address: MORGAN LEWIS BOCKIUS  
1111 PENNSYLVANIA AVE NW ATTENTION: TMSU  
WASHINGTON 20004-2578

Phone: 202-739-5151

Fax: 202-739-3001

Correspondent e-mail: [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)

Correspondent e-mail Authorized: Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Apr. 22, 2016	OPPOSITION INSTITUTED NO. 999999	227487
Apr. 22, 2016	OPPOSITION PAPERS RECEIVED AT TTAB	
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Oct. 01, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 30, 2015	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

TM Attorney: KIDWELL WALKER, JACLYN

Law Office LAW OFFICE 112  
Assigned:

### File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 01, 2016

## Proceedings

### Summary

Number of 1  
Proceedings:

### Type of Proceeding: Opposition

Proceeding [91227487](#)

Filing Date: Apr 22, 2016

Number: \_\_\_\_\_

Status: Pending

Status Date: Apr 22, 2016

Interlocutory Attorney: MIKE WEBSTER

**Defendant**

Name: BioNJ Inc.

Correspondent Address: DANA S. GROSS  
MORGAN LEWIS BOCKIUS  
1111 PENNSYLVANIA AVE NW Attention: TMSU  
WASHINGTON DC , 20004-2578

Correspondent e-mail: [trademarks@morganlewis.com](mailto:trademarks@morganlewis.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BECAUSE PATIENTS CAN'T WAIT	Opposition Pending	<a href="#">86769593</a>	

**Plaintiff(s)**

Name: Patients Can't Wait, LLC

Correspondent Address: jeff kasher  
Patients Can't Wait, LLC  
12221 Leighton Court  
Carmel IN UNITED STATES , 46032

Correspondent e-mail: [kasher.lisa@gmail.com](mailto:kasher.lisa@gmail.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
PATIENTS CAN'T WAIT			

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 22, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 22, 2016	Jun 01, 2016
3	PENDING, INSTITUTED	Apr 22, 2016	

## **Exhibit C**

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

Patients Can't Wait, LLC,  
Opposer,

v.

BioNJ Inc.,  
Applicant.

Proceeding No. 91227487

Mark: BECAUSE PATIENTS CAN'T  
WAIT

Application Ser. No. 86/769,593

**DECLARATION OF RANDI BROMBERG IN SUPPORT OF  
APPLICANT'S MOTION TO DISMISS**

I, Randi Bromberg, declare as follows:

1. I am the Vice President, Communications and Marketing at BioNJ Inc. ("BioNJ" or "Applicant"). The facts set forth in this Declaration are based on my personal knowledge, unless otherwise noted.
2. On April 22, 2016, Jeffery Kasher of Patients Can't Wait, LLC ("Opposer") filed a Notice of Opposition opposing the registration of Application Serial No. 86/769,593 in which he stated that he served the Notice of Opposition on BioNJ by First Class Mail.
3. BioNJ never received a service copy of the Notice of Opposition from Opposer sent via First Class Mail or by any other means.
4. Opposer has not contacted BioNJ to attempt service since the above-captioned proceeding was instituted.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct under to 28 U.S.C. § 1746.

Dated: June 1, 2016

By: Randi Bromberg  
Randi Bromberg