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

Proceeding	92044697
Party	Plaintiff ACM Enterprises, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

ACM Enterprises, Inc., Petitioner,
- against -
Martello, Jeannette, M.D., Respondent.

Cancellation No.: 92044697

Filed: July 1, 2005

**Petitioner's Combined Opposition to Motion for Summary Judgment and
Motion for Amendment of the Pleadings**

The Petitioner responds to the motions for summary judgment and for amendment of the pleadings, filed on or about Sept. 24, 2009.¹ In addition to this opposition, there are Petitioner's Exhibits and Declaration of Colin Hurren and Declaration of David Hong.

I. Respondent's Delay of 3.5 years is completely unreasonable.

Respondent filed her instant motion to amend her answer to include counts of fraud and lack of standing by Petitioner. However, Respondent had more than 3.5 years to raise these issues after receiving the pertinent Jan. 24, 2006 discovery responses and documents from Petitioner.

Under FRCP 15(a), leave to amend pleadings shall be freely given when justice so requires. However, the Board must determine whether entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See

¹ According to the ESTTA Tracking No. ESTTA308107, it appears that Respondent filed her instant motions for summary judgment and amendment of the pleadings on Sept. 24, 2009 but did not simultaneously serve Petitioner's attorney with service copy of said motions and a proof of service. In a Sept. 28, 2009 order, TTAB required Respondent to serve Petitioner with a copy of her motion and to file proof of service with the Board. Petitioner's attorney received a copy of the instant motions on Oct. 1, 2009 via USPS Mail, but a proof of service was not attached to the Respondent's Motions. It appears that Respondent filed a separate proof of service of the instant motions with a Board and sent a separate copy to Petitioner's counsel on or about Oct. 3, 2009. Due to this confusion of service, the Petitioner presently responds to both the motions for summary judgment and for amendment of the pleadings.

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993). The Board must also consider whether there is any undue prejudice to the Petitioner and whether the amendment is legally sufficient. See Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974). With regard to prejudice, the timing of the motion for leave to amend is a major factor in this analysis. See TBMP § 507.02.

First, Respondent has not provided a proper proposed amendment to the answer. Second, Respondent has unreasonably delayed in bringing this request to amend. In response to the allegation of lack of standing, please see the Petitioner's own trademark applications for the mark SKIN DEEP LASER MEDSPA (78/569,772 and 78/569,898). (Pet. Exhibit Pages 1-2).

In addition, the Petitioner disclosed a Feb. 1, 2004 Facilities Services Agreement, during the Jan. 24, 2006 discovery production. A copy of the first and last pages of this confidential agreement was provided in Jan. 24, 2006 Petitioner document production, which is over **3.5 years** from the filing of these Sept. 24, 2009 motions. (Pet. Exhibit Pages 3-4).

Further, on March 3, 2008, Respondent's former counsel Mr. Brandon Tesser, Esq. requested a copy of the 2004 Facilities Services Agreement. (Pet. Exhibit Pages 5-6). This supplemental request is over 2 years from the date of Petitioner's Jan. 24, 2006 document production.

On March 12, 2008, Petitioner timely forwarded a redacted copy of this confidential 2004 Facilities Services Agreement that highlighted the license provision; these documents clearly disclose the license of the mark SKIN DEEP LASER MEDSPA from the facilities service management company (Petitioner ACM Enterprises, Inc., dba

Skin Deep Laser Med Spa, Inc.) to the medical doctor (Berger Medical Corp.). This license of the use of the Petitioner's marks shows proper standing by the Petitioner. This March 12, 2008 supplemental discovery disclosure is over **18 months** prior to the filing of Respondent's Sept. 24, 2009 motions.

The Board has denied leave to amend where the delay was only 8 months, which is much shorter than the 18 months or 3.5 years here. See Trek Bicycle Corp. v. StyleTrek Ltd., 64 USPQ2d 1540 (TTAB 2001).

Respondent had ample time to raise these issues and file a timely motion to amend.² It is unreasonable to allow Respondent to raise issues that she could have investigated during the allotted discovery periods.

Considering this 18 month or 3.5 year delay and the vitriolic nature of Respondent's instant motions, Petitioner will be unjustly harmed by allowing these allegations to be introduced into Respondent's answer. Petitioner respectfully requests the Board to deny Respondent's motion to amend.

II. Respondent's Motion for Summary Judgment should be denied.

"In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine issues of material fact to be tried. The non-moving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary

² On Nov. 29, 2007, TTAB denied Petitioner's own Motion to Amend the Pleadings and Motion for Summary Judgment based on a delay. It would be only fair to deny Respondent's motions on a similar delay.

judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the non-moving party." See TBMP 528.01

There are still issues of material fact to be decided in the originally filed Petition to Cancel. As grounds for Cancellation, Petitioner alleges priority of use and likelihood of confusion under Section 2(d) of the Trademark Act; Petitioner also alleges that (1) Respondent did not use the mark "Skin Deep" in commerce as listed on its trademark application (Serial No. 76581387); (2) Respondent did not use the mark "Skin Deep" prior to Application or Registration; (3) Respondent's registration for "Skin Deep" was obtained fraudulently. (See 7-1-2005 Petition for Cancellation. ¶¶5-13).

In this instant motion, the Respondent has failed to show there are no issues of material fact to be decided.

A. Petitioner has proper standing to bring this Petition to Cancel.

Petitioner affirms its proper right to standing as the trademark owner of the SKIN DEEP LASER MEDSPA mark. Petitioner also denies the allegation that it is "illegally using the name SKIN DEEP LASER MEDSPA." (See Respondent's Sept. 23, 2009 MSJ, pages 9-19).

A trademark holder can establish and continue use of a mark through a license to a third party. See TMEP Sec. 1201.03(f) License and Franchise Situations: "Ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by a controlled licensee even when the only use of the mark has been made, and is being made, by the licensee. Turner v. HMH Publishing Co., Inc., 380 F.2d 224, 229, 154 USPQ 330, 334 (5th Cir. 1967), cert. denied, 389 U.S. 1006, 156 USPQ 720 (1967)."

Without any limitations on proof of its trademark use, Petitioner is the owner of the trademark SKIN DEEP LASER MEDSPA for the services listed on its two service mark applications (78/569,772 and 78/569,898). (Pet. Exhibit Pages 1-2). Petitioner licensed use of its mark to Berger Medical Corp. (medical doctor) and acted as the facilities services management company for this Berger Medical Corp. for the SKIN DEEP LASER MED SPA facility in Pasadena, CA. (Pet. Exhibit Page 12). See also Petitioner's Response to Special Interrogatory No. 4. (Pet. Exhibit Pages 14-23 show pages 1-9 and 25 of this discovery response).

As of May 1, 2008, Petitioner ACM Enterprises, Inc. entered into a new facilities services management agreement with Dr. John Gross, M.D., a respected plastic surgeon and new medical director of the SKIN DEEP LASER MED SPA. (Pet. Exhibit Pages 24-26 and 32-36).

Both facilities services agreements with Dr. Berger and Dr. Gross had provisions wherein Petitioner licensed use of its marks to the respective medical corporations at the SKIN DEEP LASER MED SPA facility in Pasadena, CA. (Pet. Exhibit Pages 12 and 25 and 32-36). This practice is fair and proper. There is no fraud. At the time of the filing and presently, Petitioner has proper standing to bring this action against Respondent's registration.

B. Respondent's "Timeline of Undisputed Facts" are inappropriate conclusions.

Petitioner disputes "Respondent's Timeline of Undisputed Facts" on pages 2-7 of Respondent's Sept. 24, 2009 Motion. Presenting a statement of facts is part of any motion, but making "colored" conclusions under the heading of "undisputed facts" is improper and irrelevant.

In addition, Respondent has cited from the divorce proceeding of Mr. Colin Hurren (Petitioner's president) to attempt to discolor and to attack the character of Mr. Hurren (See Respondent's Sept. 23, 2009 MSJ Exhibit, pages 91-150).

C. Respondent's Proposed Count 1: Allegation of Unclean Hands

An allegation of not paying sales tax is not relevant or germane to a Trademark Office proceeding. Respondent's allegation is ridiculous, unprofessional and presented solely to harass the Petitioner. The Board should reject this allegation.

Petitioner denies any wrong doing and has always paid its taxes; ACM Enterprises, Inc. has fully participated in an audit and been cleared by the Franchise Tax Board of California. See Decl. of Colin Hurren, dated Nov. 3, 2009.

F. Respondent's Proposed Count 2: Allegation of Bad Faith (MSJ, page 8) and Fraud (MSJ, page 19-25).

Petitioner denies these allegations of bad faith and fraud. These allegations are not relevant to this cancellation proceeding. If Respondent wants to raise these bad faith allegations, Respondent can file her opposition in Petitioner's applications for SKIN DEEP LASER MEDSPA (78/569,772 and 78/569,898).

Similarly, the Petitioner denies any violation of the CA Bus. & Prof. and CA Corp. Codes on Pages 9-19 of the Respondent's MSJ brief. Respectfully, the Trademark Board is not the proper entity to decide these allegations -- rather, the Medical Board of California. Considering that the Petitioner has managed the SKIN DEEP LASER MEDSPA facility for over 5 years, it is safe to assume that the Med. Board of California is satisfied with the business practices of the medical doctor and the facilities manager. In fact, this Pasadena, CA facility (SKIN DEEP LASER MEDSPA) has been awarded

"Best Med Spa in Pasadena" by the Pasadena Weekly from 2004 to 2008. (Pet. Exhibit pages 27-31).

III. Request for Sanctions, FRCP 11, TBMP 527.02

Respondent has clearly violated FRCP 11 and TBMP 527.02 by presenting allegations of "Sales Tax Evasion" (Respondent's MSJ, pages 7-8) and of "Illegal Use of the Name Skin Deep Laser Med Spa" (Respondent's MSJ, pages 9-19). These allegations were for the sole purpose of harassing the Petitioner. Further, submitting the divorce proceeding documents (In Re Marriage of Hurren, LASC No. GD 030122) of Petitioner's President Mr. Hurren was clearly intended to harass Mr. Hurren. (See Respondent's Sept. 23, 2009 MSJ Exhibit Pages 91-150).

Petitioner respectfully requests that the Board invoke its inherent powers and issue sanctions against the Respondent and deny these motions.

DATED: Nov. 3, 2009

By: /david hong, esq./
David Hong, Esq., Attorney for Petitioner

Certificate of Service

I hereby certify that I am not a party to this case and a true and correct copy of the following documents:

1. Petitioner's Combined Opposition to Motion for Summary Judgment and Motion for Amendment of the Pleadings (7 pages);
2. Declaration of Colin Hurren in Support of Petitioner's Opposition to Motions for Summary Judgment and Amendment of the Pleadings (1 page);
3. Declaration of David Hong in Support of Petitioner's Opposition to Motions for Summary Judgment and Amendment of the Pleadings (2 pages);
4. Petitioner's Exhibits (36 pages), **were sent by first class U.S. Mail on Nov. 3, 2009**, in an envelope addressed to:

Dr. Jeannette Martello, M.D., 701 Fremont Avenue, South Pasadena, CA 91030.

/david hong/
David Hong

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
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ACM Enterprises, Inc.,

Petitioner,

- against -

Martello, Jeannette, M.D.

Respondent.

Cancellation No.: 92044697

Filed: July 1, 2005

**Declaration of David Hong in Support of Petitioner's Opposition to Motions for
Summary Judgment and Amendment of the Pleadings**

1. My name is David Hong, Esq., and I am the Attorney for the Petitioner ACM ENTERPRISES, INC. My business address is P.O. Box 2111, Santa Clarita, CA 91386-2111. I am fully competent to make this declaration, and I have personal knowledge of the facts stated in this declaration. To my knowledge, all of the facts stated in this declaration are true and correct.

2. On Nov. 2, 2009, I conducted an Internet Search at the Medical Board of California's database for Fictitious Name Permit for "SKIN DEEP", and I printed out and created a PDF (1 page) for "SKIN DEEP LASER MED SPA A MEDICAL CORPORATION, FNP31957" listing; the website address: (Pet. Exhibit Page 32). See TBMP 528.05(e) and FRCP 56(e) regarding Internet evidence.

3. On Nov. 2, 2009, I conducted an Internet Search at the Website for the Medical Board of California, <http://licenselookup.mbc.ca.gov/licenselookup> for "JOHN GROSS," and I printed out and created a PDF (2 pages) for. (Pet. Exh. Page 33-34).

4. On Nov. 2, 2009, from the Secretary of State of California website for Business Entity Search and Corporations (<http://kepler.sos.ca.gov/>), I did a search for "ACM Enterprises" and "John Gross" and printed out the results in PDF format (Pet. Exhibit Pages 35-36),

5. On Nov. 3, 2009, I printed out pages 1-9 and page 25 from Respondent's Responses to Petitioner's First Set of Interrogatories, dated Dec. 9, 2005 (Pet. Exhibit Pages 14-23).

6. On Nov. 2, 2009, at the USPTO Website, I printed out TESS printouts in PDF format for U.S. Trademark Appl. Serial No. 78569772 and (Pet. Exhibit Pages 1-2).

7. I declare under penalty of perjury (28 U.S.C. 1746) that the foregoing is true and correct.

Dated: Nov. 3, 2009

/david hong, esq./
David Hong, Esq.
Attorney for Petitioner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
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ACM Enterprises, Inc.,

Petitioner,

- against -

Martello, Jeannette, M.D.

Respondent.

Cancellation No.: 92044697

Filed: July 1, 2005

**Declaration of Colin Hurren in Support of Petitioner's Opposition to Motions
for Summary Judgment and Amendment of the Pleadings**

1. My name is Mr. Colin Hurren, and I am the President of ACM ENTERPRISES, INC. My business address is 425 S. Fair Oaks Ave., Unit B, Pasadena, CA 91105. I am fully competent to make this declaration, and I have personal knowledge of the facts stated in this declaration. To my knowledge, all of the facts stated in this declaration are true and correct.

2. During February of 2009, my company ACM Enterprises, Inc. was audited by the CA Franchise Tax Board regarding an allegation of unpaid sales taxes. After fully participating with the CA Franchise Tax Board audit, ACM Enterprises, Inc. was cleared of any sales tax violation. ACM Enterprises, Inc. has properly paid its sales taxes to the CA Franchise Tax Board. I declare under penalty of perjury (28 U.S.C. 1746) that the foregoing is true and correct.

Dated: Nov. 3, 2009



Mr. Colin Hurren, President
ACM Enterprises, Inc.