

ESTTA Tracking number: **ESTTA341765**

Filing date: **04/11/2010**

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

Proceeding	92044697
Party	Plaintiff ACM Enterprises, Inc.
Correspondence Address	David Hong Law Office of David Hong P.O. Box 2111 Santa Clarita, CA 91386-2111 UNITED STATES david.hong@dhpattentlaw.com, david_hong@sbcglobal.net
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	David Hong, Esq., CA SBN 195795
Filer's e-mail	david.hong@dhpattentlaw.com
Signature	/david hong, esq./
Date	04/11/2010
Attachments	2010-04-11_1st_Amd_Petition_2932593_w_EXH.pdf (23 pages)(432369 bytes)

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

Reg. No. 2932593) **CANCELLATION NO. 920044697**
Reg. Date: March 15, 2005)
Serial No. 76581387)
Filing Date: March 15, 2004)
Mark: SKIN DEEP)
_____)

FIRST AMENDED PETITION TO CANCEL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Madam/Sir:

Pursuant to the Trademark Trial and Appeal Board orders dated Sept. 22, 2009 and March 12, 2010, the Petitioner ACM ENTERPRISES, INC. presents its first amended petition to cancel. These Board orders directed the Petitioner to amend its fraud cause of action in view of In re Bose Corp., 476 F.3d 1331, 91 USPQ2d 1938 (Fed. Cir. 2009), see Paragraphs 11-17 of this pleading. Petitioner also amended Paragraph 1 (Petitioner's business address); Paragraph 3 (Respondent's attorney and correspondence information); Paragraphs 4 and 17 (Petitioner's use dates: on or about Sept. 1, 2003 in California and at least as early Jan. 23, 2004 in interstate commerce).

1. Petitioner, ACM Enterprises, Inc. DBA Skin Deep Laser Med Spa, a California corporation located and doing business at 425 S. Fair Oaks Ave., Suite B, Pasadena, CA 91105, believes that it is or will be damaged by U.S. Registration No. 2932593 for "Skin Deep" for Class 044 and hereby petitions to cancel this Registration.

2. Description of Respondent's Registration: Respondent filed U.S. Trademark Application No. 76581387 on March 15, 2004, for the mark "SKIN DEEP" in class 044 for medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services and claimed first use in commerce on Feb. 28, 2004 and first use anywhere on April 20, 2002. This mark was registered on the Principal Register on March 15, 2005. (See Exhibit 1.)

3. Respondent's Previous Attorney of Record for this Cancellation Proceeding was Brandon Tesser, Esq., Tesser & Ruttenberg, 12100 Wilshire Blvd., Suite 220, Los Angeles, CA 90025; Respondent's Owner of Record and current correspondence information: Jeannette Martello, 701 Fremont Avenue, South Pasadena, CA 91030.

4. Standing: Petitioner has been and is now, using the mark "SKIN DEEP LASER MED SPA" in connection with the sale of services: providing cosmetic medical treatments namely laser hair removal, wrinkle correction therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff on or about Sept. 1, 2003 in California and at least as early Jan. 23, 2004 in interstate commerce. This use has been valid and continuous since the date of first use and has not been abandoned.

5. Petitioner has filed for U.S. Trademark Application No. 78569772 on Feb. 17, 2005 for "SKIN DEEP LASER MED SPA" for International Class 044 for the services ("providing cosmetic medical treatments namely laser hair removal, wrinkle correction

therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff.”). (See Exhibit 2). This mark (SKIN DEEP LASER MED SPA) of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that respondent’s registered mark so resembles Petitioner’s mark (SKIN DEEP LASER MED SPA) previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

6. Count One: Allegation of Non-Use in Commerce. As grounds of this Petition, it is alleged: Respondent filed the following related trademark applications: In U.S. Serial No. 76581387 for “Skin Deep,” the Respondent submitted a specimen of use: a Feb. 18, 2004 Sales Receipt to the U.S. Patent and Trademark Office on March 15, 2004 for medical and health spa services. (See Exhibits 1, 3).

7. In U.S. Serial No. 76579565 for “Skin Deep Laser MEDSPA,” the Respondent submitted three specimens of use: two Sales Receipts dated Feb. 28, 2004 and one Sales Receipt dated Feb. 29, 2004 to the U.S. Patent and Trademark Office on March 4, 2004 for medical and health spa services. This application is currently abandoned (as of July 1, 2005). (See Exhibits 4-7).

8. In U.S. Serial No. 76581391 for “Skin Deep Laser,” the Respondent submitted a specimen of use: a Feb. 28, 2004 Sales Receipt to the U.S. Patent and Trademark Office on March 15, 2004 for medical and health spa services. (See Exhibits 8-9).

9. On this information and belief, Petitioner alleges that Respondent did not use the mark “Skin Deep” in commerce as listed on its trademark application (Serial No. 76581387) because Respondent alleges using three separate marks (“Skin Deep,” “Skin Deep Laser” and “Skin Deep Laser Medspa”) within a same time period (February 2004) for the same medical and health spa services.

10. Count Two: Lack of Use as a Mark Prior to Application or Registration. On information and belief, Petitioner alleges Respondent did not use the mark “Skin Deep” prior to Application or Registration. Looking at all three of the above mentioned Respondent applications, Respondent submitted sales receipts for medical and health spa services within the same time period (Feb. 2004) for the same services (medical and health spa services); Petitioner alleges that Respondent cannot have used all three marks for the same services prior to application or registration. (See Exhibits 1, 3-9).

11. Count Three: Fraud. Petitioner alleges Respondent’s registration for “Skin Deep” was obtained fraudulently in that the Respondent failed to use the mark in commerce as applied in the following applications and as evidenced in the submitted trademark application specimens (for Application No. 76581387, 76579565 and 76581391), which fail to show use of the applied for marks in interstate commerce. Said statement was

made by an authorized agent of respondent (Jeannette Martello) with the knowledge and belief that said statement was false. (See Exhibits 1, 3-9).

12. Respondent is the listed owner of several U.S. Trademark Registrations using the mark SKIN DEEP, including: **Reg. 2932593** (Medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services); **Reg. 2777522** (Entertainment services, namely, providing a radio program in the fields of medicine, surgery, health, health care, beauty, skin care, cosmetic surgery and plastic surgery); **Reg. 3094594** (Magazines in the field of medicine, surgery, health, health care, beauty, skin care, cosmetic surgery and plastic surgery); **Reg. 3387207** (Retail store services featuring skin care products and beauty and health products; providing consumer information in the field of health and medicine, skin care, plastic surgery). To obtain federal registration, the applicant must show use of the applied for mark in commerce with the listed goods or services. *See Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a); TMEP 806.*

13. In the instant cancellation proceeding, the specimen for **Reg. 2932593** (Serial No. 76581387) is a sales receipt (Customer: Christine Burgs, dated Feb. 18, 2004), which appears to show the following information: **SKIN DEEP, 701 Fremont Ave., South Pasadena, CA** and a description (**Glycolic Peel**). This Feb. 19, 2004 Sales Receipt does not show use of the mark "SKIN DEEP" in interstate commerce, as defined in TMEP 806. (See Exhibit 3).

14. In U.S. Serial No. 76579565 for “Skin Deep Laser MEDSPA,” the Respondent submitted three specimens of use: two Sales Receipts dated Feb. 28, 2004 and one Sales Receipt dated Feb. 29, 2004 to the U.S. Patent and Trademark Office on March 4, 2004 for medical and health spa services. (See Exhibits 4-7). These Sales Receipt specimens for the '565 application do not show use of the applied for mark (Skin Deep Laser MEDSPA) in interstate commerce, as defined in TMEP 806.

15. In U.S. Serial No. 76581391 for “Skin Deep Laser,” the Respondent submitted a specimen of use: a Feb. 28, 2004 Sales Receipt (Customer: Christine Burgs) to the U.S. Patent and Trademark Office on March 15, 2004 for medical and health spa services. (See Exhibits 8-9). These specimens for the '391 application do not show use of the applied for mark (Skin Deep Laser) in interstate commerce, as defined in TMEP 806.

16. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to respondent.

17. Petitioner was damaged by Respondent’s alleged false statements and the registration issued. Petitioner has continuously used the mark (Skin Deep Laser Med Spa) on or about Sept. 1, 2003 in California and at least as early Jan. 23, 2004 in interstate commerce, and Petitioner’s continued and legal use of said mark will be impaired by the

continued registration of said mark of respondent. As a result, Petitioner respectfully requests that the Commissioner grant this Petition and cancel Registration No. 2932593.

Respectfully Submitted,

/david hong, esq./

David Hong, Esq., Reg. No. 45704, CA SBN 195795

Attorney for Petitioner, ACM Enterprises, Inc.

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: FIRST AMENDED PETITION TO CANCEL (7 pages) and Nine (9) Exhibits (16 pages), were sent by e-mail and first class U.S. Mail on April 11, 2010, in an envelope addressed to: **Dr. Jeannette Martello, M.D., 701 Fremont Avenue, South Pasadena, CA 91030;**

E-Mail: drmartello@hotmail.com, martello@skindeepworld.com.

/david hong/

David Hong

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2005-07-01 16:40:17 ET

Serial Number: 76581387

Registration Number: 2932593

Mark

"Skin Deep"

(words only): "SKIN DEEP"

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-03-15

Filing Date: 2004-03-15

Transformed into a National Application: No

Registration Date: 2005-03-15

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-03-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Martello, Jeannette](#)

Address:

[Martello, Jeannette](#)
[501 Floral Park Terrace](#)
[South Pasadena, CA 91030](#)
[United States](#)

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: (626) 403-1747

Petition to Cancel, Reg. 2932593
EXHIBIT 1

Fax Number: (626) 403-1784

GOODS AND/OR SERVICES

International Class: 044

medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services

First Use Date: 2002-04-20

First Use in Commerce Date: 2004-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-15 - Registered - Principal Register

2005-02-02 - PAPER RECEIVED

2004-12-21 - Published for opposition

2004-12-01 - Notice of publication

2004-10-13 - Law Office Publication Review Completed

2004-10-04 - Assigned To LIE

2004-09-30 - Approved for Pub - Principal Register (Initial exam)

2004-09-30 - Examiners amendment e-mailed

2004-09-30 - Examiners Amendment -Written

2004-09-26 - Case file assigned to examining attorney

2004-03-31 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Petition to Cancel, Reg. 2932593
EXHIBIT 1

JEANNETTE MARTELLO
501 FLORAL PARK TERRACE
SOUTH PASADENA CA 91030

Phone Number: (626) 403-1747

Fax Number: (626) 403-1784

Petition to Cancel, Reg. 2932593
EXHIBIT 1

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2005-07-01 16:41:52 ET

Serial Number: [78569772](#)

Registration Number: (NOT AVAILABLE)

Mark

SKIN DEEP LASER
MED SPA

(words only): [SKIN DEEP LASER MED SPA](#)

Standard Character claim: [Yes](#)

Current Status: [Newly filed application, not yet assigned to an examining attorney.](#)

Date of Status: [2005-03-03](#)

Filing Date: [2005-02-17](#)

Transformed into a National Application: [No](#)

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [L3D -TMEG Law Office 103 - Docket Clerk](#)

Date In Location: [2005-03-16](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [ACM Enterprises, Inc DBA Skin Deep Laser Med Spa](#)

Address:

[ACM Enterprises, Inc DBA Skin Deep Laser Med Spa](#)
[1981 New York Drive](#)

Petition to Cancel, Reg. 2932593
EXHIBIT 2

Altadena, CA 91001

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 044

International Class 044: Providing cosmetic medical treatments namely laser hair removal, wrinkle correction therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff

First Use Date: 2003-09-01

First Use in Commerce Date: 2004-01-16

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "LASER MED SPA"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-01 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Michelle Katz (Attorney of record)

MICHELLE KATZ

4205 KESTER AVE

SHERMAN OAKS, CA 91403-4134

Phone Number: (818) 783-9729

Fax Number: (818) 990-8281

SKIN DEEP

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/18/2004	

Sold To
Christine Burgs

Check No.	Payment Method	Project
	Cash	

Description	Qty	Rate	Amount
Glycolic peel.		125.00	125.00
Sales payment		-125.00	-125.00
Thank you for your business.			Subtotal \$0.00

Sales Tax (8.25%)	\$0.00
Total	\$0.00

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2005-07-01 16:55:07 ET

Serial Number: 76579565

Registration Number: (NOT AVAILABLE)

Mark

SKIN DEEP Laser MEDSPA

(words only): [SKIN DEEP LASER MEDSPA](#)

Standard Character claim: No

Current Status: [Abandoned-Failure To Respond Or Late Response](#)

Date of Status: 2005-06-30

Filing Date: 2004-03-04

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 110](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [M1X -TMO Law Office 110 - Examining Attorney Assigned](#)

Date In Location: 2005-06-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Martello, Jeannette Y](#)

Address:

[Martello, Jeannette Y](#)
[701 Fremont Avenue](#)
[South Pasadena, CA 91030](#)
[United States](#)

Legal Entity Type: [Individual](#)

Country of Citizenship: [United States](#)

Phone Number: [\(626\) 403-1747](#)

Petition to Cancel, Reg. 2932593
EXHIBIT 4

Fax Number: (626) 403-1784

GOODS AND/OR SERVICES

International Class: 044

medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services

First Use Date: 2004-02-18

First Use in Commerce Date: 2004-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-06-30 - Abandonment Notice Mailed - Failure To Respond

2005-06-30 - Abandonment - Failure To Respond Or Late Response

2005-02-28 - Amendment From Applicant Entered

2005-02-02 - Unresponsive paper received

2005-02-02 - PAPER RECEIVED

2004-10-04 - Non-final action e-mailed

2004-10-04 - Non-Final Action Written

2004-09-20 - Case file assigned to examining attorney

2004-03-19 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Brandon Tesser (Attorney of record)

Brandon Tesser

TESSER & RUTTENBERG

Petition to Cancel, Reg. 2932593
EXHIBIT 4

12100 Wilshire Boulevard, Suite 220.
LOS ANGELES CA 90025

Phone Number: 310.207.4022

Fax Number: 310.207.4033

Petition to Cancel, Reg. 2932593
EXHIBIT 4

Skin Deep Laser MEDSPA
 701 Fremont Ave.
 South Pasadena, CA 91030

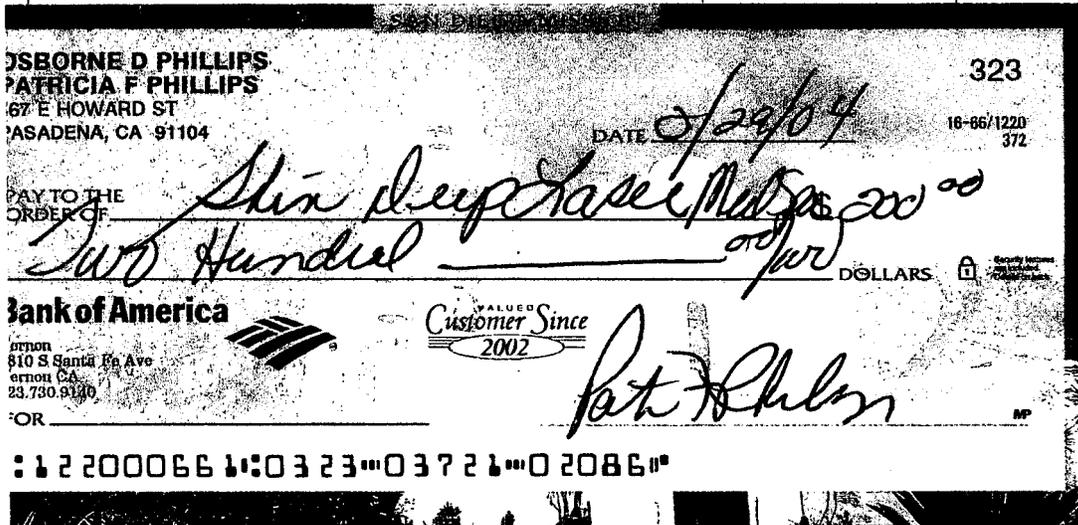
Sales Receipt

Date	Sale No.
2/29/2004	3

Sold To
Patricia Phillips

Check No.	Payment Method	Project
322	Check	

Description	Qty	Rate	Amount
Laser spider vein treatment of both cheeks		200.00	200.00
Payment		-200.00	-200.00



Thank you for your business.

Total \$0.00

Skin Deep Laser MEDSPA

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	2

Sold To
Annette Palazuelos

Check No.	Payment Method	Project
	VISA	

Description	Qty	Rate	Amount
Laser hair removal of mustache.		100.00	100.00
Payment		-100.00	-100.00
Total			\$0.00

Thank you for your business.

Skin Deep Laser MEDSPA

701 Fremont Ave.

South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	1

Sold To
Linda Palazuelos

Check No.	Payment Method	Project
	ATM	

Description	Qty	Rate	Amount
Laser hair removal of bilateral armpits		150.00	150.00
Laser hair removal of mustache.		100.00	100.00
Payment		-250.00	-250.00
Thank you for your business.		Total	\$0.00

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2005-07-01 16:58:46 ET

Serial Number: 76581391

Registration Number: (NOT AVAILABLE)

Mark

"Skin Deep Laser"

(words only): "SKIN DEEP LASER"

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2004-09-30

Filing Date: 2004-03-15

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:
[HINES REGINA C Employee Location](#)

Current Location: M5R -TMO Law Office 114 - Legal Instruments Examiner

Date In Location: 2005-03-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Martello, Jeannette](#)

Address:

[Martello, Jeannette](#)
[501 Floral Park Terrace](#)
[South Pasadena, CA 91030](#)
[United States](#)

Legal Entity Type: Individual

Petition to Cancel, Reg. 2932593
EXHIBIT 8

Country of Citizenship: [United States](#)

Phone Number: [\(626\) 403-1747](#)

Fax Number: [\(626\) 403-1784](#)

GOODS AND/OR SERVICES

International Class: [044](#)

[medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services](#)

First Use Date: [2004-02-18](#)

First Use in Commerce Date: [2004-02-28](#)

Basis: [1\(a\)](#)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

[2005-03-01 - Amendment From Applicant Entered](#)

[2005-02-02 - Unresponsive paper received](#)

[2005-02-02 - PAPER RECEIVED](#)

[2004-09-30 - Non-final action e-mailed](#)

[2004-09-30 - Non-Final Action Written](#)

[2004-09-26 - Case file assigned to examining attorney](#)

[2004-03-31 - New Application Entered In Tram](#)

CORRESPONDENCE INFORMATION

Correspondent

[BRANDON TESSER, \(Attorney of record\)](#)

[BRANDON TESSER,
TESSER & RUTTENBERG
12100 WILSHIRE BOULEVARD
SUITE 220](#)

Petition to Cancel, Reg. 2932593
EXHIBIT 8

LOS ANGELES, CA 90025
Phone Number: (626) 403-1747
Fax Number: (626) 403-1784

Skin Deep Laser

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	1

Sold To
Christine Burgs

Check No.	Payment Method	Project
	Cash	

Description	Qty	Rate	Amount
Laser hair removal.		150.00	150.00
Payment		-150.00	-150.00
Thank you for your business.		Total	\$0.00