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Filing date: **07/22/2010**

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

Proceeding	92044697
Party	Defendant Jeannette Martello
Correspondence Address	THOMAS J. DALY CHRISTIE PARKER & HALE LLP P.O. BOX 7068 PASADENA, CA 91109-7086 UNITED STATES pto@cph.com
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Date	07/22/2010
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**I. Introduction and Summary of Argument**

On March 12, 2010, after the present cancellation proceeding had been pending for almost five years, the Board set the testimony period for ACM Enterprises, Inc. (hereinafter "Petitioner") to close on June 15, 2010. On the morning of May 20, 2010, with still nearly four weeks remaining before the close of Petitioner's testimony period, counsel for Petitioner Marc E. Hankin (hereinafter "Hankin") indicated in an email to counsel for Respondent Thomas J. Daly (hereinafter "Daly") that he planned to "start taking [his] Testimony next week." Even after Daly briefly met with Hankin on May 21, 2010 and thereafter indicated his availability to meet with Hankin again, Hankin did not contact Daly for over a week. Finally, on May 30, 2010, Hankin contacted Daly and apologized that the "past week just got away from me."

Despite Hankin's previous statement that he planned to take testimony the week of May 24, 2010, Daly did not receive any further communication from Hankin until after Petitioner's testimony period had closed. On June 16, 2010, after not hearing from Hankin for over two weeks and after Petitioner's testimony period had already closed, Hankin presented two alternative settlement offers. The next day, Daly informed Hankin that Respondent rejected the settlement offers.

On July 7, 2010, Hankin filed a Motion to Reopen the Testimony Period for Party in Position of Plaintiff in which Hankin conceded that he "should have pressed harder to take the Testimony of his own Client during the Testimony Period," but instead chose to allow "the time period to expire without first moving for an Extension of the Testimony Periods." Nevertheless, Petitioner argued in its Motion that the testimony period should be reopened because its failure to take testimony during the assigned period was the result of Hankin's "excusable neglect." As

detailed below, however, Petitioner's delay was the result of Hankin's carelessness and inattention which cannot be excused by the mere existence of settlement negotiations.

Accordingly, Respondent Jeannette Martello, M.D. respectfully requests that the Board deny Petitioner's motion to reopen the testimony period. In addition, because Petitioner's testimony period has expired and Petitioner has not taken any testimony or offered any evidence, Respondent respectfully requests that the Board grant its motion to dismiss the cancellation with prejudice pursuant to 37 C.F.R. § 2.132(a).

## **II. Legal Standard**

### **a. Legal Standard for Reopening Testimony Period**

If a party fails to take testimony during the period set by the Board, the testimony period may be reopened only upon a showing of "excusable neglect" pursuant to Fed. R. Civ. P. 6(b). See Fed. R. Civ. P. 6(b)(1) ("When an act may or must be done within a specified time, the court may, for good cause, extend the time . . . on motion made after the time has expired if the party failed to act because of excusable neglect."); see also T.B.M.P. § 509.01(b)(1) ("The movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect.") (citing Fed. R. Civ. P. 6(b)). In determining whether a party's failure to comply with the testimony deadline resulted from "excusable neglect," the Board will consider: "(1) the danger of prejudice to the non-moving party, (2) the length of the delay and its potential impact on the judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the moving party, and (4) whether the moving party acted in good faith." Pioneer Investment Services Co. v. Brunswick Associates Ltd. Partnership, 507 U.S. 380, 113 S. Ct. 1489 (1993). The third Pioneer factor—the reason for the delay, including whether the delay was the result of counsel's inattention and carelessness—is the most important of the four

Pioneer factors. See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., 59 U.S.P.Q.2d 1369, 1371 (T.T.A.B. 2000) ("third and most important of the four factors"); Pumpkin Ltd. v. The Seed Corps, 43 U.S.P.Q.2d 1582, 1587 at n.7 (T.T.A.B. 1997).

**b. Legal Standard for Involuntary Dismissal**

Pursuant to Trademark Rule 2.132(a), dismissal with prejudice of a cancellation proceeding is appropriate "where the plaintiff's period for taking testimony has expired and the plaintiff has not taken any testimony or offered any evidence" in support of its claims during its assigned testimony period. 37 C.F.R. § 2.132(a); see also Atlanta-Fulton County Zoo Inc. v. DePalma, 45 U.S.P.Q.2d 1858, 1860 (T.T.A.B. 1998).

**III. Statement of Facts**

On September 17, 2008, the Board suspended this cancellation proceeding for three months due to the parties' settlement discussions. (Declaration of Thomas J. Daly in Support of Respondent's Answer to Petitioner's Motion to Reopen the Testimony Period for Party in Position of Plaintiff and Cross-Motion for Involuntary Dismissal Under Trademark Rule 2.132(a) (hereinafter "Daly Decl.") ¶ 2; Exhibit A, Page 1). In doing so, the Board recognized that this cancellation proceeding had already "entered its third year" and therefore "[b]y the end of the [3-month] suspension . . . the parties will have had substantial time to engage in settlement." (Daly Decl. ¶ 2; Exhibit A, Page 1). The Board also indicated that no further extensions for purposes of settlement negotiations will be granted "absent a strong showing of good cause" including, at a minimum, "a written report, signed by both parties, informing the Board of (1) the settlement efforts the parties have made to date. . . (2) a list of issues which have been resolved and which remain for trial; and (3) a firm timetable for the resolution of this matter." (Daly Decl. ¶ 2;

Exhibit A, Page 2 n.1). Finally, the Board cautioned that "further extensions [for purposes of settlement negotiations] are unlikely to be granted." (Daly Decl. ¶ 2; Exhibit A, Page 2 n.1).

On March 12, 2010, after the present cancellation proceeding had been pending for almost five years, the Board resumed the proceedings and set forth the following Testimony

Period dates:

DISCOVERY PERIOD:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	<b>June 15, 2010</b>
Thirty-day testimony period for party in position of defendant to close:	August 14, 2010
Fifteen-day rebuttal testimony period to close:	September 28, 2010

Hankin and Daly entered the case on May 19, 2010 and May 14, 2010, respectively, on behalf of Petitioner and Respondent. On the morning of May 20, 2010, nearly four weeks before the close of Petitioner's testimony period, Hankin indicated in an email to Daly that he planned to "start taking [his] Testimony next week." (Daly Decl. ¶ 5; Exhibit D). On the same day, Daly replied to Hankin's email and reminded Hankin that Petitioner's "testimony period closes June 15" and informed Hankin that he had not yet been noticed regarding Hankin's planned testimony. (Daly Decl. ¶ 6; Exhibit E).

On May 20, 2010, Daly again indicated his willingness to meet with Hankin. (Daly Decl. ¶ 6; Exhibit E). The very next day, Daly met with Hankin over lunch and briefly discussed the case. (Daly Decl. ¶ 6). On Monday, May 24, 2010, Daly emailed Hankin and indicated that he was available and "prepared to discuss" the case further if Hankin so desired. (Daly Decl. ¶ 7; Exhibit F). Hankin did not reply to Daly's email until May 30, 2010, apologizing that the "past week just got away from me." (Daly Decl. ¶ 8; Exhibit G). Hankin then suggested that the parties talk on Tuesday, June 1, 2010. (Daly Decl. ¶ 8; Exhibit G). Nevertheless, Hankin did not

contact Daly on June 1, 2010, and Daly did not receive any further communication from Hankin until after Petitioner's testimony period had closed on June 15, 2010. (Daly Decl. ¶ 8).

On June 16, 2010, after not communicating with Daly for over two weeks and after the close of the Petitioner's testimony period, Hankin called Daly and extended two alternative settlement offers on behalf of Petitioner. (Daly Decl. ¶ 9). On June 17, 2010, Daly indicated to Hankin that Jeannette Martello, M.D. rejected both of the alternative settlement offers. (Daly Decl. ¶ 9; Exhibit H). Daly also indicated to Hankin that he did not believe Hankin had a proper basis for resetting the testimony period. (Daly Decl. ¶ 9; Exhibit H).

On July 7, 2010, Hankin filed a Motion to Reopen the Testimony Period for Party in Position of Plaintiff in which Hankin conceded that he "should have pressed harder to take the Testimony of his own Client during the Testimony Period," but instead chose to allow "the time period to expire without first moving for an Extension of the Testimony Periods."

#### **IV. Analysis**

Counsel's "carelessness and inattention per se do not constitute excusable neglect" under Rule 6(b). Wilson Sporting Goods Co. v. Northwestern Golf Company, 169 U.S.P.Q. 510, 511 (T.T.A.B. 1971); see also Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 U.S.P.Q.2d 1710, 1712 (Fed. Cir. 1991) (holding that "excusable neglect" results from "failure to take the proper steps at the proper time, not in consequence of the party's own carelessness, inattention, or willful disregard of the process of the court, but in consequence of some unexpected or unavoidable hindrance or accident") (citations omitted). For example, in Wilson Sporting Goods, the petitioner filed a motion to reopen the testimony period after failing to take any testimony during its scheduled period. The petitioner asserted that its failure was the result of excusable neglect because settlement negotiations were on-going between the parties in respect to five

other co-pending cancellation proceedings and because the present counsel was substituted late as counsel for the petitioner. Id. at 510-11. The Board rejected these arguments and held that the "petitioner was guilty of carelessness and inattention and was derelict in respect to the burden which a plaintiff in any litigation is automatically expected to assume." Id. at 511. Accordingly, the Board denied petitioner's motion to reopen the testimony period because petitioner's carelessness and inattention per se did not rise to the level of excusable neglect. Id.; see also, American Home Products Corporation v. David Kamenstein, Inc., 172 U.S.P.Q. 376 (T.T.A.B. 1971) (denying a motion to reopen the testimony period because counsel's failure to instruct the USPTO to direct notices setting the testimony periods to co-counsel constituted inexcusable neglect resulting from carelessness and inattention in respect to maintaining reasonable communication between co-counsel involved in the case); Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., 59 U.S.P.Q.2d 1369 (T.T.A.B. 2000) (denying the motion to reopen the testimony period because counsel's failure to maintain communications with prior trademark counsel constituted inexcusable neglect).

Additionally, "it is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay." Atlanta-Fulton County Zoo Inc. v. DePalma, 45 U.S.P.Q.2d 1858, 1859 (T.T.A.B. 1998) (citations omitted). In Atlanta-Fulton County, the opposer filed a motion to reopen the discovery and testimony periods and argued that its delay was the result of excusable neglect because the "parties were continuing to discuss settlement possibilities" during the time when the opposer inadvertently allowed its testimony period to expire. Id. The Board first held that the third, and "most dominant," Pioneer factor weighed in favor of denying the motion to reopen because the "opposer's failure to timely present evidence during the prescribed testimony period was due to circumstances wholly within its control" and

the opposer was in no way prevented from taking testimony. Id. The Board then held that contrary to the opposer's contentions, the record revealed that the parties were not "engaged in on-going bilateral settlement negotiations during the critical time period" up to and including the testimony deadline. Id. at 1859-60. Moreover, even if the parties were engaged in on-going settlement negotiations, the Board held that "the existence of such negotiations or offers, without more, does not excuse them from complying with the deadlines set by the Board or imposed by the rules." Id. at 1859. Additionally, the Board held that the second Pioneer factor—"the length of the delay and its potential impact on the judicial proceedings"—weighed in favor of finding inexcusable delay because the opposer's carelessness and inattention was "detrimental to the orderly administration of the opposition process." Id. at 1860. Finally, the Board noted that the remaining Pioneer factors weakly favored a finding of excusable delay because there was "no evidence of a bad faith attempt by opposer to delay" the case and there was "no specific prejudice to applicants beyond mere delay." Id. On balance, however, the Board concluded that a finding of inexcusable delay was supported by the most important Pioneer factors. Id. Accordingly, the Board denied the opposer's motion to reopen the testimony period and dismissed with prejudice the opposition pursuant to 37 C.F.R. § 2.132(a) because the plaintiff's testimony period had expired and the plaintiff had not taken any testimony nor offered any evidence. Id.

Just like in Wilson Sporting Goods, Petitioner's failure to follow the proper procedure of seeking an extension of the testimony period under 37 C.F.R. § 2.121(a) or moving for the proceedings to be suspended pursuant to 37 C.F.R. § 2.117(c) should not be excused. Notably, in Wilson Sporting Goods, the proceedings in five other co-pending cancellation proceedings were suspended by the Board in order to enable the parties to continue their settlement negotiations,

but the opposer's failure to seek to have the current proceedings suspended by the Board was held to constitute inexcusable neglect. Wilson Sporting Goods, 169 U.S.P.Q. at 510-11. Similarly, Petitioner's failure to comply with the established procedures for extending the testimony period or suspending the proceedings should not be excused and therefore the Petitioner's motion to reopen the testimony period should be denied.

The circumstances in the present case are remarkably similar to those of Atlanta-Fulton. Just like in Atlanta-Fulton, Petitioner's failure to take any testimony during the testimony period resulted from counsel's own carelessness and inattention which cannot be excused by the mere prospect of settlement. The third, and most important, Pioneer factor weighs heavily in favor of finding inexcusable delay, because Petitioner's failure to conduct testimony during the prescribed period was due to circumstances wholly within its control. That is, Hankin was in no way prevented from taking testimony. Rather, counsel for Petitioner was not only aware that Petitioner's testimony period would close on June 15, 2010, but Hankin also indicated to Daly that he planned to take testimony the week of May 24, 2010. The only explanation offered by Hankin for his failure to comply with the testimony date set by the Board is that as a result of his inattention the "week just got away from [him]." Additionally, any suggestion that the parties were engaging in bilateral settlement negotiations during and up to the close of Petitioner's testimony period is unfounded. To the contrary, Hankin did not present a settlement offer to Daly until June 16, 2010, one day **after** Petitioner's testimony period had already closed. More importantly, however, Petitioner's reliance on the existence of settlement negotiations to excuse its delay is misplaced because the Board in Atlanta-Fulton unequivocally held that the "mere existence of settlement negotiations alone does not justify a party's inaction or delay." Atlanta-Fulton, 45 U.S.P.Q.2d at 1859.

Additionally, just like in Atlanta-Fulton, the second Pioneer factor weighs in favor of finding inexcusable delay, because Petitioner's failure to comply with the testimony period set forth by the Board is detrimental to the orderly administration of this cancellation proceeding which has now been pending for nearly five years. As the Board recognized in its September 17, 2008 decision, the parties have already had "substantial time to engage in settlement," and therefore any further extensions of time are unwarranted. Therefore, the second Pioneer factor coupled with the third Pioneer factor weigh heavily in favor of finding the Petitioner's delay inexcusable. Accordingly, Respondent respectfully requests that the Board deny Petitioner's motion to reopen the testimony period because Petitioner's failure to comply with its testimony deadline was the result of Hankin's inattention and carelessness which cannot be excused by the mere prospect of settlement. Moreover, because Petitioner's period for taking testimony has expired and Petitioner has not taken any testimony or offered any evidence, the cancellation should be dismissed with prejudice pursuant to 37 C.F.R. 2.132(a).

**V. Conclusion**

For the foregoing reasons, Respondent Jeannette Martello, M.D. hereby respectfully requests that the Board deny Petitioner's Motion to Reopen the Testimony Period for Party in Position of Plaintiff and dismiss the cancellation with prejudice pursuant to 37 C.F.R. 2.132(a).

Date July 22, 2010

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By Thomas J. Daly  
Thomas J. Daly  
Attorneys for Respondent  
P.O. Box 7068  
Pasadena, California 91109-7086  
pto@cph.com  
Phone: (626) 795-9900

# **Exhibit A**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

mc

Mailed: September 17, 2008

Opposition No. 92044697

ACM Enterprises, Inc.

v.

Jeannette Martello

**Ann Linnehan, Attorney**

Now before the Board is opposer's consented motion to extend proceedings in view of the parties' settlement discussions. Opposer's motion is GRANTED to the extent that proceedings are suspended for *three* months from the mailing date of this order, subject to the right of either party to request earlier resumption. If no word is sooner heard from either party, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

We note that this proceeding has entered its third year. By the end of the suspension granted herein, the parties will have had substantial time to engage in settlement. Accordingly, no further extensions for such

purposes will be granted absent a strong showing of good cause therefor.<sup>1</sup>

Trial dates upon resumption, including the close of discovery, are reset as follows:

Proceedings resume:	12/17/08
Discovery Period to close:	CLOSED
30-day testimony period for party in position of plaintiff to close:	3/17/09
30-day testimony period for party in position of defendant to close:	5/16/09
15-day rebuttal testimony period to close:	6/30/09

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>1</sup> Such a showing must include - at a minimum - a written report, signed by both parties, informing the Board of (1) the settlement efforts the parties have made to date, including dates and times at which the parties have met, conferred, or corresponded regarding settlement; (2) a list of issues which have been resolved and which remain for trial; and (3) a firm timetable for the resolution of this matter. The parties are cautioned, however, that further extensions are unlikely to be granted.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdnagmnt.htm>

# **Exhibit B**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

**From:** Marc E. Hankin [marc@hankinpatentlaw.com]  
**Sent:** Wednesday, May 19, 2010 10:24 AM  
**To:** Thomas Daly  
**Cc:** 'Kevin Schraven'  
**Subject:** Skin Deep Cancellation Substitution of Counsel

Dear Tom,

I hope that all is well with you.

I notice that you have just come into the Cancellation of Skin Deep by ACM Enterprises, Inc. I have been retained by ACM to represent them in this matter, replacing David Hong.

I would whether it would be possible to meet with you this Friday, May 21? I plan to be at the Provisors Lunch in the Tea Room at the Huntington Library/Gardens, and I would be pleased to come to your Offices either beforehand or afterwards. Let me know whether either works for you, and if so, what time? I prefer 10:30 am but I also could come by around 2:00 pm, if you prefer then.

Please let me know. Thanks!  
Marc

Marc E. Hankin, Esq.  
Selected as a Los Angeles Magazine Super Lawyer® 2004\*, 2007, 2008, 2009, 2010  
LET US PROTECT WHAT YOU HAVE IN MIND®  
Hankin Patent Law, A Professional Corporation  
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Unfair Competition, and Related Licensing and Litigations  
6404 Wilshire Boulevard, Suite 1020  
Los Angeles, CA 90048-5211  
Telephone No: (323) 944-0206  
Facsimile No: (323) 944-0209  
Cell Phone No: (310) 892-1613  
E-Mail: Marc@HankinPatentLaw.com  
www.HankinPatentLaw.com



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

**Change of Correspondence Address**

<b>Proceeding.</b>	92044697
<b>Plaintiff</b>	Plaintiff ACM Enterprises, Inc.

Please change the correspondence address for the above party here as follows:

<b>Old Correspondence Address</b>	David Hong Law Office of David Hong P.O. Box 2111 Santa Clarita, CA 91386-2111 UNITED STATES david.hong@dhpatentlaw.com, david_hong@sbcglobal.net
<b>New Correspondence Address</b>	Marc E. Hankin Hankin Patent Law, APC 6404 Wilshire Blvd., Suite 1020 Los Angeles, CA 90048 UNITED STATES marc@hankinpatentlaw.com, kevin@hankinpatentlaw.com, courtfiling@hankinpatentlaw.com Phone:310-892-1613

**Certificate of Service**

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.

Respectfully submitted,  
/Marc E. Hankin/  
Marc E. Hankin  
Marc@HankinPatentLaw.com  
05/19/2010

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# **Exhibit C**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

**From:** Thomas Daly  
**Sent:** Thursday, May 20, 2010 9:56 AM  
**To:** 'marc@hankinpatentlaw.com'  
**Subject:** RE: Skin Deep Cancellation Substitution of Counsel

Marc,

Thanks for making contact. Unfortunately, I already have meetings scheduled around the lunch at Huntington. Also, as you note, I've just come into this matter. I'm still trying to get all the files transferred so that I can get fully up to speed. However, I agree that a meeting would be a good idea. Do you have time next week for a meeting? Thursday and Friday are generally open for me. I look forward to hearing from you. Thanks.

Tom Daly

-----Original Message-----

**From:** Marc E. Hankin [mailto:marc@hankinpatentlaw.com]  
**Sent:** Wednesday, May 19, 2010 10:24 AM  
**To:** Thomas Daly  
**Cc:** 'Kevin Schraven'  
**Subject:** Skin Deep Cancellation Substitution of Counsel

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I hope that all is well with you.

I notice that you have just come into the Cancellation of Skin Deep by ACM Enterprises, Inc. I have been retained by ACM to represent them in this matter, replacing David Hong.

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Please let me know. Thanks!  
Marc

Marc E. Hankin, Esq.  
Selected as a Los Angeles Magazine Super Lawyer® 2004\*, 2007, 2008, 2009,  
2010  
LET US PROTECT WHAT YOU HAVE IN MIND®  
Hankin Patent Law, A Professional Corporation  
Patents, Trademarks, Copyrights, Trade Secrets,  
Unfair Competition, and Related Licensing and Litigations

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[www.HankinPatentLaw.com](http://www.HankinPatentLaw.com)

# **Exhibit D**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

**From:** Marc E Hankin [Marc@HankinPatentLaw.com]  
**Sent:** Thursday, May 20, 2010 10:20 AM  
**To:** Thomas Daly  
**Subject:** Re: Skin Deep Cancellation Substitution of Counsel

Tom,

The problem is that I need to start taking my Testimony next week, so I wanted to sit down with you to, (a) make a schedule, and (b) see whether there is any way that two highly experienced lawyers, both new to a case, with no baggage, might re-open the settlement talks, albeit briefly, to see if there is any way to avoid transferring the funds from our Trust Accounts to our Mortgage Accounts . . . .

Thanks,  
Marc

Marc E. Hankin  
Hankin Patent Law, APC  
Cell: (310) 892-1613

---

**From:** "Thomas Daly" <Thomas.Daly@cph.com>  
**Date:** Thu, 20 May 2010 09:55:53 -0700  
**To:** <marc@hankinpatentlaw.com>  
**Subject:** RE: Skin Deep Cancellation Substitution of Counsel

Marc,

Thanks for making contact. Unfortunately, I already have meetings scheduled around the lunch at Huntington. Also, as you note, I've just come into this matter. I'm still trying to get all the files transferred so that I can get fully up to speed. However, I agree that a meeting would be a good idea. Do you have time next week for a meeting? Thursday and Friday are generally open for me. I look forward to hearing from you. Thanks.

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**Sent:** Wednesday, May 19, 2010 10:24 AM  
**To:** Thomas Daly  
**Cc:** 'Kevin Schraven'  
**Subject:** Skin Deep Cancellation Substitution of Counsel

Dear Tom,

I hope that all is well with you.

I notice that you have just come into the Cancellation of Skin Deep by ACM Enterprises, Inc. I have been retained by ACM to represent them in this matter, replacing David Hong.

I would whether it would be possible to meet with you this Friday, May 21? I plan to be at the Provisors Lunch in the Tea Room at the Huntington Library/Gardens, and I would be pleased to come to your Offices either beforehand or afterwards. Let me know whether either works for you, and if so, what time? I prefer 10:30 am but I also could come by around 2:00 pm, if you prefer then.

Please let me know. Thanks!  
Marc

Marc E. Hankin, Esq.

Selected as a Los Angeles Magazine Super Lawyer® 2004\*, 2007, 2008, 2009, 2010

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Hankin Patent Law, A Professional Corporation

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Unfair Competition, and Related Licensing and Litigations

6404 Wilshire Boulevard, Suite 1020

Los Angeles, CA 90048-5211

Telephone No: (323) 944-0206

Facsimile No: (323) 944-0209

Cell Phone No: (310) 892-1613

E-Mail: [Marc@HankinPatentLaw.com](mailto:Marc@HankinPatentLaw.com)

[www.HankinPatentLaw.com](http://www.HankinPatentLaw.com)

# **Exhibit E**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

---

**From:** Thomas Daly  
**Sent:** Thursday, May 20, 2010 4:24 PM  
**To:** 'Marc@HankinPatentLaw.com'  
**Subject:** RE: Skin Deep Cancellation Substitution of Counsel

I'm willing to talk next week. I understand your testimony period closes June 15. Has any testimony been noticed? I wasn't aware of any. I'm not sure what testimony you plan to take next week as I may not have received the files reflecting the testimony you are referring to.

-----Original Message-----

**From:** Marc E Hankin [mailto:Marc@HankinPatentLaw.com]  
**Sent:** Thursday, May 20, 2010 10:20 AM  
**To:** Thomas Daly  
**Subject:** Re: Skin Deep Cancellation Substitution of Counsel

Tom,

The problem is that I need to start taking my Testimony next week, so I wanted to sit down with you to, (a) make a schedule, and (b) see whether there is any way that two highly experienced lawyers, both new to a case, with no baggage, might re-open the settlement talks, albeit briefly, to see if there is any way to avoid transferring the funds from our Trust Accounts to our Mortgage Accounts . . . .

Thanks,  
Marc

Marc E. Hankin  
Hankin Patent Law, APC  
Cell: (310) 892-1613

---

**From:** "Thomas Daly" <Thomas.Daly@cph.com>  
**Date:** Thu, 20 May 2010 09:55:53 -0700  
**To:** <marc@hankinpatentlaw.com>  
**Subject:** RE: Skin Deep Cancellation Substitution of Counsel

Marc,

Thanks for making contact. Unfortunately, I already have meetings scheduled around the lunch at Huntington. Also, as you note, I've just come into this matter. I'm still trying to get all the files transferred so that I can get fully up to speed. However, I agree that a meeting would be a good idea. Do you have time next week for a meeting? Thursday and Friday are generally open for me. I look forward to hearing from you. Thanks.

Tom Daly

-----Original Message-----

**From:** Marc E. Hankin [mailto:marc@hankinpatentlaw.com]  
**Sent:** Wednesday, May 19, 2010 10:24 AM  
**To:** Thomas Daly

**Cc:** 'Kevin Schraven'

**Subject:** Skin Deep Cancellation Substitution of Counsel

Dear Tom,

I hope that all is well with you.

I notice that you have just come into the Cancellation of Skin Deep by ACM Enterprises, Inc. I have been retained by ACM to represent them in this matter, replacing David Hong.

I would whether it would be possible to meet with you this Friday, May 21? I plan to be at the Provisors Lunch in the Tea Room at the Huntington Library/Gardens, and I would be pleased to come to your Offices either beforehand or afterwards. Let me know whether either works for you, and if so, what time? I prefer 10:30 am but I also could come by around 2:00 pm, if you prefer then.

Please let me know. Thanks!

Marc

Marc E. Hankin, Esq.

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[www.HankinPatentLaw.com](http://www.HankinPatentLaw.com)

# **Exhibit F**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

## Thomas Daly

---

**From:** Thomas Daly  
**Sent:** Monday, May 24, 2010 4:22 PM  
**To:** 'Marc@HankinPatentLaw.com'  
**Subject:** SKIN DEEP Matter

Marc,

I have now received all the files from my client and have begun reviewing them. I also had a chance to meet with my client. If you would still like to meet to discuss the matter, I now believe I am prepared to discuss it with you. My schedule is generally open starting Wednesday of this week. Please let me know if you are still interested in talking and, if so, when you would like to get together. I look forward to hearing from you.

Thomas J. Daly  
Christie, Parker & Hale, LLP  
350 W. Colorado Blvd., Suite 500  
Pasadena, CA 91105  
(626) 795-9900

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# **Exhibit G**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

**From:** Marc E Hankin [Marc@HankinPatentLaw.com]  
**Sent:** Sunday, May 30, 2010 5:36 PM  
**To:** Thomas Daly  
**Cc:** Hayley Hughes  
**Subject:** Re: SKIN DEEP Matter

Tom,

I am sorry, but this past week just got away from me. Let's speak on Tuesday.

Thank you very much,  
Marc

Marc E. Hankin  
Hankin Patent Law, APC  
Cell: (310) 892-1613

---

**From:** "Thomas Daly" <Thomas.Daly@cph.com>  
**Date:** Mon, 24 May 2010 16:22:07 -0700  
**To:** <Marc@HankinPatentLaw.com>  
**Subject:** SKIN DEEP Matter

Marc,

I have now received all the files from my client and have begun reviewing them. I also had a chance to meet with my client. If you would still like to meet to discuss the matter, I now believe I am prepared to discuss it with you. My schedule is generally open starting Wednesday of this week. Please let me know if you are still interested in talking and, if so, when you would like to get together. I look forward to hearing from you.

Thomas J. Daly  
Christie, Parker & Hale, LLP  
350 W. Colorado Blvd., Suite 500  
Pasadena, CA 91105  
(626) 795-9900

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# **Exhibit H**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

## Thomas Daly

---

**From:** Thomas Daly  
**Sent:** Thursday, June 17, 2010 5:47 PM  
**To:** 'Marc@HankinPatentLaw.com'  
**Subject:** SKIN DEEP Matter

Marc,

My client has decided to reject both of the alternative settlement offers you extended on behalf of your client yesterday. Although, as stated yesterday, I do not believe you have a proper basis for resetting your testimony period, please let me know if you will be filing a motion to do so. Otherwise, we will be filing a motion for directed verdict.

Thomas J. Daly  
Christie, Parker & Hale, LLP  
350 W. Colorado Blvd., Suite 500  
Pasadena, CA 91105  
(626) 795-9900

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# **Exhibit I**

**ACM Enterprises, Inc. v. Jeannette Martello, M.D.; Cancellation No. 92044697**

**Exhibit offered by Jeannette Martello, M.D., by and through  
Counsel of Record Thomas J. Daly**

**Thomas Daly**

**From:** Marc E. Hankin [marc@hankinpatentlaw.com]  
**Sent:** Thursday, June 17, 2010 5:59 PM  
**To:** Thomas Daly  
**Subject:** RE: SKIN DEEP Matter

Tom,

That is a disappointment, but yes, we will be filing a Motion to reset all of the Testimony Periods.

It is really too bad that you chose not to cooperate in this matter, but I guess that we will not get to litigate as adversaries again.

Best of luck,  
Marc

**From:** Thomas Daly [mailto:Thomas.Daly@cph.com]  
**Sent:** Thursday, June 17, 2010 5:47 PM  
**To:** Marc@HankinPatentLaw.com  
**Subject:** SKIN DEEP Matter

Marc,

My client has decided to reject both of the alternative settlement offers you extended on behalf of your client yesterday. Although, as stated yesterday, I do not believe you have a proper basis for resetting your testimony period, please let me know if you will be filing a motion to do so. Otherwise, we will be filing a motion for directed verdict.

Thomas J. Daly  
Christie, Parker & Hale, LLP  
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Pasadena, CA 91105  
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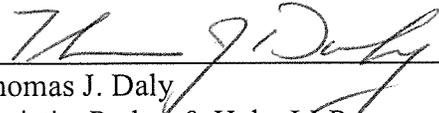
**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on July 22, 2010, the foregoing **RESPONDENT'S ANSWER TO PETITIONER'S MOTION TO REOPEN THE TESTIMONY PERIOD FOR PARTY IN POSITION OF PLAINTIFF AND RESPONDENT'S CROSS-MOTION FOR INVOLUNTARY DISMISSAL UNDER TRADEMARK RULE 2.132(a)** is being electronically transmitted to the

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

It is further certified that on July 22, 2010, the foregoing **RESPONDENT'S ANSWER TO PETITIONER'S MOTION TO REOPEN THE TESTIMONY PERIOD FOR PARTY IN POSITION OF PLAINTIFF AND RESPONDENT'S CROSS-MOTION FOR INVOLUNTARY DISMISSAL UNDER TRADEMARK RULE 2.132(a)** is being served by mailing a copy thereof by first-class mail addressed to:

Marc E. Hankin, Esq.  
Hankin Patent Law, A Professional Corporation  
6404 Wilshire Boulevard, Suite 1020  
Los Angeles, California 90048-5211

By  \_\_\_\_\_  
Thomas J. Daly  
Christie, Parker & Hale, LLP  
P.O. Box 7068  
Pasadena, CA 91109-7068

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

ACM Enterprises, Inc.,	)	
	)	
Petitioner,	)	Cancellation No. 92044697
	)	
v.	)	DECLARATION OF THOMAS J. DALY
	)	IN SUPPORT OF RESPONDENT'S
Martello, Jeannette, M.D.,	)	ANSWER TO PETITIONER'S MOTION
	)	TO REOPEN THE TESTIMONY
Respondent.	)	PERIOD FOR PARTY IN POSITION OF
	)	PLAINTIFF AND CROSS-MOTION FOR
	)	INVOLUNTARY DISMISSAL UNDER
	)	TRADEMARK RULE 2.132(a)
	)	

---

I, Thomas J. Daly, declare as follows:

1. I am an attorney at law in good standing and licensed to practice before the U.S. Patent and Trademark Office. I am counsel of record for Respondent Jeannette Martello, M.D. in the instant action. I am over the age of eighteen and am competent to testify to the facts stated below. Unless otherwise stated, I make this declaration based upon my personal knowledge. If called as a witness, I could and would testify competently to the matters stated herein.

2. Exhibit A is a true and correct copy of the Board's September 17, 2008 decision suspending this cancellation proceeding for three months due to the parties' settlement discussions. In this September 17, 2008 decision, the Board recognized that this cancellation proceeding had "entered its third year" and therefore "[b]y the end of the [3-month] suspension . . . the parties will have had substantial time to engage in settlement." The Board also indicated that no further extensions for purposes of settlement negotiations will be granted

"absent a strong showing of good cause" and cautioned that "further extensions [for purposes of settlement negotiations] are unlikely to be granted."

3. Exhibit B is a true and correct copy of an email from Attorney Mark E. Hankin (hereinafter "Hankin") to me on May 19, 2010, nearly one month before the close of Petitioner's testimony period.

4. Exhibit C is a true and correct copy of an email from me to Hankin on May 20, 2010, in which I agreed that a "meeting would be a good idea" and indicated that I was available both on Thursday and Friday to meet with Hankin.

5. Exhibit D is a true and correct copy of an email from Hankin to me on May 20, 2010 in which Hankin indicated that he planned "to start taking [his] Testimony next week."

6. Exhibit E is a true and correct copy of an email in which I replied to Hankin's May 20, 2010 email and reminded Hankin that Petitioner's "testimony period closes June 15" and indicated to Hankin that I had not yet been noticed regarding Hankin's planned testimony. In this same email, I again expressed my willingness to meet with Hankin. The very next day, I met with Hankin over lunch and briefly discussed the case.

7. Exhibit F is a true and correct copy of an email from me to Hankin on May 24, 2010, in which I indicated that I was available and "prepared to discuss" the case further if Hankin so desired.

8. Exhibit G is a true and correct copy of an email from Hankin on May 30, 2010 in which Hankin apologized to me because the "past week just got away from [him]." Hankin then suggested that he and I talk on Tuesday, June 1, 2010. I never heard from Hankin on Tuesday, June 1, 2010 and I did not receive any further communication from Hankin until after Petitioner's testimony period had closed on June 15, 2010.

9. On June 16, 2010, after Petitioner's testimony period had already closed and after not communicating with me for over two weeks, Hankin called me and extended two alternative settlement offers on behalf of Petitioner. Exhibit H is a true and correct copy of an email from me to Hankin on June 17, 2010, in which I indicated to Hankin that my client, Jeannette Martello, M.D., had decided to reject both of the alternative settlement offers proposed on June 16, 2010 by Hankin. In this same email, I also indicated to Hankin that I believed Hankin did not have a proper basis for resetting the testimony period.

10. Exhibit I is a true and correct copy of an email from Hankin to me on June 17, 2010 in which Hankin indicated that he would be filing a motion to reset all of the testimony periods. On July 7, Hankin filed a Motion to Reopen the Testimony Period for Party in Position of Plaintiff in which Hankin conceded that he "should have pressed harder to take the Testimony of his own Client during the Testimony Period," but instead chose to allow "the time period to expire without first moving for an Extension of the Testimony Periods."

I, the undersigned, declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the

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///

Cancellation No. 92044697

like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the relevant registration.

Dated July 22, 2010

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By Thomas J. Daly  
Thomas J. Daly  
Attorneys for Respondent  
P.O. Box 7068  
Pasadena, CA 91109-7086  
pto@cph.com  
Phone: (626) 795-9900

AGJ PAS909593.1-\* -07/22/10 3:26 PM

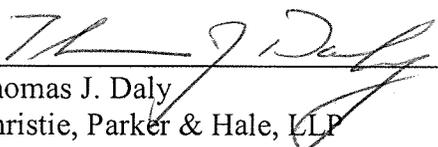
**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on July 22, 2010, the foregoing **DECLARATION OF THOMAS J. DALY IN SUPPORT OF RESPONDENT'S ANSWER TO PETITIONER'S MOTION TO REOPEN THE TESTIMONY PERIOD FOR PARTY IN POSITION OF PLAINTIFF AND RESPONDENT'S CROSS-MOTION FOR INVOLUNTARY DISMISSAL UNDER TRADEMARK RULE 2.132(a)** is being electronically transmitted to the

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Marc E. Hankin, Esq.  
Hankin Patent Law, A Professional Corporation  
6404 Wilshire Boulevard, Suite 1020  
Los Angeles, California 90048-5211

By   
Thomas J. Daly  
Christie, Parker & Hale, LLP  
P.O. Box 7068  
Pasadena, CA 91109-7068