

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration Nos 2,991,288
3,195,423

Mark: ZEN SPA AND WELLNESS
CENTER

Issued: September 6, 2005
January 9, 2007

ZEN SPA ENTERPRISES, INC.
D/B/A
ZEN SPA AND HEALTH STUDIO

Petitioner,

BODIES IN MOTION, INC.,

Registrant.

76578382

Cancellation No. 92047608

ZEN SPA ENTERPRISES, INC.'S OPPOSITION TO 'PETITION TO REVIVE'

COMES NOW Petitioner Zen Spa Enterprises, Inc. (hereinafter, "Zen Spa" or "Petitioner"), through the undersigned counsel, and respectfully alleges and prays:

I. Introduction

On May 30, 2008, Kevin L. and Lea P. Koon (hereinafter, the Koons) filed a "Petition to Revive" requesting, in essence, that they be allowed to answer Zen Spa's Petition to Cancel. The Koons alleged to have become owners of Registration Nos. 2991288 and 3195423 by way of an assignment executed by Registrant Bodies In Motion, Inc. on January 18, 2008. As explained below,



06-18-2008

the "Petition to Revive" should be denied because: (1) it is not an appropriate procedural vehicle to seek to answer a Petition to Cancel which has already been granted and (2) the Board's decision granting the Petition to Cancel is final and all deadlines for seeking reconsideration, filing an appeal or a civil action have elapsed.

II. Factual Background

Registrant Bodies In Motion, Inc., registered the service mark Zen Spa & Wellness Center in I.C. 44 on September 6, 2005 with Registration No. 2991288, alleging first use in commerce on January 1, 2004. On January 9, 2007 Bodies In Motion, Inc. registered Zen Spa & Wellness Center on I.C. 44 with Registration No. 3195423, alleging first use in commerce on January 5, 2004.

On April 30, 2007, Zen Spa filed a Petition to Cancel both Registration No. 2991288 and 3195423, averring ownership of the mark through prior use in commerce. That Petition, however, was returned on May 15, 2007, inasmuch as it was not accompanied by the appropriate fees. Accordingly, on May 25, 2007, Zen Spa duly filed a Petition to Cancel Registrations nos. 2991288 and 3195423 along with the required fees. See, Docket # 1, Petition to Cancel, Cancellation No. 92047608, available through TTABVue. On June 5, 2007, the Trademark Trial and Appeal Board ("the Board") issued a schedule for the cancellation proceedings, sent

to both Bodies In Motion, Inc. and Zen Spa. See, Docket # 2, "Notice and Trial Dates Sent", Cancellation No. 92047608, available through TTABVUE.

The Board, however, was not able to effect service of notice of the proceeding on Bodies in Motion, Inc., and, accordingly, on December 4, 2007, notified that service by publication would be effected by publication in the Official Gazette on January 1, 2008. See, Docket # 4, Cancellation No 92047608. The notice which was served by publication read as follows:

A petition to cancel the registration identified below having been filed, and the notice of such proceedings sent to registrant at the last known address having been returned by the Postal Service as undeliverable, notice is hereby given that unless the registrant listed herein, **its assigns** or legal representatives shall enter an appearance within thirty days of publication, the cancellation will proceed as in the case of default.

Bodies In Motion, Inc. Sherman Oaks, CA, Registration Nos. **2991288, 3195423** for the mark "**ZEN SPA AND WELLNESS CENTER**", Cancellation No. **92047608**.

Docket # 11, "Service by Publication", Cancellation No. 92047608, available through TTABVUE (emphasis added to phrase "**its assigns**"; remaining emphasis in the original).

On February 27, 2008, that is, more than thirty days after the notice of the cancellation proceeding had been published in the Official Gazette, and since no appearance had been entered, the Board issued a decision granting the Petition to Cancel. See, Docket # 12. More than three months later, on May 30,

2008, the Koons filed the "Petition to Revive" which Zen Spa herein opposes.

III. Discussion

A. A Petition to Revive is not available in these circumstances

The Koons seek permission to answer a Petition to Cancel which has been granted and rendered unappealable by expiration of the applicable deadlines to appeal or commence a civil action (see discussion below) by way of a "Petition to Revive". Such a request is procedurally defective, as Petitions to Revive are not available in *inter partes* proceedings before this Board.

Chapter 1700 of the Trademark Manual of Examining Procedure, 5th Ed. (TMEP), states the circumstances in which petitions may be taken to the Director. Among the issues that commonly arise in Petitions to the Director are Petitions to Revive. This type of petition is used to revive applications that have been abandoned because the applicant did not timely respond to an Office action or notice of allowance, when the delay was unintentional. See, TMEP § 1714.

Clearly, this type of Petition is not available in the circumstances of this case. The case at hand does not deal with an application that has been deemed abandoned, but rather with a registration which was successfully cancelled at the request of another party. The Koons did not fail to respond to an office

action or a notice of allowance from the U.S.P.T.O.; they failed to enter an appearance as required in an *inter partes* proceeding before this Board and did not answer a Petition to Cancel, even though they were on notice of the pendency of that Petition. As such, a Petition to Revive is procedurally unavailable in this case.

B. Registrant and its successors had notice of the cancellation proceedings and failed to take action within the applicable deadlines

As explained above, the procedural mechanism invoked by the Koons is not available before this Board. Moreover, the time for opposing Petitioner's Petition to Cancel and even the time for seeking reconsideration and/or appealing the Board's decision have long since elapsed, making such decision final. As such, the Koons' very untimely request that they be allowed to answer the complaint should be denied. That denial of this untimely and procedurally unavailable "Petition to Revive" is the appropriate course of action is further buttressed by the fact that the Koons knew or should have known of the pending cancellation proceedings, had notice thereof through publication in the Official Gazette and could have timely entered an appearance in such proceedings but failed to do so.

Per the Koons' own factual account, there can be no doubt that they knew or should have known of the pending

cancellation proceedings. At § 2 of their "Petition", the Koons allege that they began negotiations with Registrant to purchase the marks on August 2007. As set forth above and as appears on the TTAB's docket, publicly available through TTABVUE, at that time Zen Spa had filed its May 25, 2007 Petition to Cancel and the Board had attempted to serve Notice thereof on June 5, 2007. Moreover, while its first Petition to Cancel was returned to Zen Spa, at the time assignees began their negotiations a new Petition to Cancel had been filed and the Board had mailed notice thereof, along with the applicable deadlines, to Registrant. These developments were readily ascertainable by the Koons, through minimum effort by accessing the U.S.P.T.O.'s website and verifying the status of the marks.

It bears noting that the Koons were clearly aware of their duty to verify the status of the registrations, **as they aver that they had determined that an opposition or cancellation proceeding had been instituted** and that it had been dismissed and **they further aver that they inquired of Registrant Bodies in Motion, Inc. whether it had been served.** A review of the status of the marks would have shown that a cancellation proceeding was pending and that the only reason why Registrant Bodies in Motion, Inc. had not been served was because the Board's notice had been returned as undeliverable. As such,

the Koons knew or had to know that notice would be served by publication. See, TBMP §310.02.

Moreover, on December 2007, when the Koons aver they concluded negotiations, the Board had determined that service by publication was necessary. **On January 1, 2008, immediately prior to the alleged date of the execution of the assignment,** the Board effected service by publication and notified not only Registrants, **but also any assignees,** that the above captioned cancellation proceeding was in progress and that an appearance had to be entered in a term of thirty days or otherwise default judgment would be entered.

Despite the admonition in the notice that the cancellation of Registrations nos. 2991288 and 3195423 would take place via default if no appearance were entered in thirty (30) days, the Board did not order such cancellation until almost sixty days had elapsed since the notice was published in the Official Gazette. In the meantime, per the Koons' account of the events leading up to their assignment, the agreement for such assignment was executed on January 18, 2008 and submitted for recordation on February 11, 2008.

That is to say, at the time the agreement was executed, the Koons as well as Bodies In Motion, Inc., had notice, via the publication on the Official Gazette, that the cancellation of Registrations Nos. 2991288 and 3195423 was going forward and

that they had a thirty day term to enter an appearance in such proceedings. It bears noting that an assignee may appear and take action in matters pending before the TTAB or USPTO, in order to protect the registration or application, so long as it establishes its ownership. Indeed, the rules regarding practice before this Board, set forth in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) explicitly state:

When a mark which is the subject of a Federal [...] registration has been assigned [...] any action with respect to the [...] registration which may or must be taken by the [...] registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded **or that proof of the assignment has been submitted.**

TBMP §124 (emphasis added). See also, Trademark Manual of Examining Procedure (TMEP) §502.01; Rules of Practice & Federal Statutes (U.S.P.T.O. May 13, 2008, available through the USPTO website) §§3.71, 3.73.

Pursuant to the above cited rules, the Koons could and should have entered an appearance in the above captioned cancellation proceedings. They failed to do so, despite the fact that at the time they executed the assignment, they had notice, via the publication in the Official Gazette, of such proceedings and were in time to enter a timely appearance and make whatever arguments or requests they deemed appropriate. The fact that the assignment had not yet been recorded was no

bar for entering an appearance; as TBMP §124 makes clear that an assignee will be allowed to take action regarding a registration so long as it submits proof of the assignment or the assignment is recorded.

Moreover, at the time the assignment was recorded, on February 11, 2008, per the Koons' account, although the thirty day term for entering an appearance had elapsed, the Board had not yet entered its order for cancellation of Registration Nos. 2991288 and 3195423. Still, the Koons failed to take any action concerning such registrations before the Board entered its February 27 order for a cancellation of the registrations and for three months subsequent thereto.

Once the Board issued its decision, the parties had one month to request rehearing, reconsideration, or modification of the decision. See, TBMP §804. The time for filing an appeal or commencing a civil action, as allowed by 15 U.S.C. §1071, is two months from the date of the decision. See, TBMP § 902.02. As such, by April 27, 2008, all deadlines for requesting review of the Board's decision, whether via reconsideration to the Board or appeal or commencement of a civil action had elapsed. Nonetheless, the Koons procrastinated for more than one additional month before filing the "Petition to Revive", which, as explained above, is not available in proceedings before this Board.

In light of the above, the Koons' untimely attempt to answer a Petition for Cancellation of which they had notice through publication in the Official Gazette, and which has already been granted by the Board via a final decision, should be denied.

IV. Conclusion

Per the foregoing arguments, the Koons "Petition to Revive" should be denied and the cancellation of Registration Nos. 2991288 and 3195423 should proceed as ordered.

Respectfully submitted,

PIETRANTONI MÉNDEZ & ALVAREZ LLP
BANCO POPULAR CENTER
SUITE 1901, 19TH FLOOR
209 MUÑOZ RIVERA AVENUE
SAN JUAN, PUERTO RICO 00918

/s/ Néstor M. Méndez Gómez
NÉSTOR M. MÉNDEZ-GÓMEZ ESQ
nmendez@pmalaw.com
Attorney for Zen Spa

CERTIFICATE OF SERVICE

I hereby certify that on this date, a copy of this document has been sent to Ralph H. Dougherty, Dougherty & Associates, 6100 Fairview Rd., Ste. 550, Charlotte, North Carolina, 28210.

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing document is being filed electronically with the TTAB via ESTTA on this

day, June 16, 2008, and also, this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, PO Box 1451, Alexandria, VA 22313-1451.

PIETRANTONI MÉNDEZ & ALVAREZ LLP
BANCO POPULAR CENTER
SUITE 1901, 19TH FLOOR
209 MUÑOZ RIVERA AVENUE
SAN JUAN, PUERTO RICO 00918

/s/ Néstor M. Méndez Gómez
NÉSTOR M. MÉNDEZ-GÓMEZ ESQ
nmendez@pmalaw.com
Attorneys for Zen Spa

Dated: June 16, 2008.