

ESTTA Tracking number: **ESTTA434390**

Filing date: **10/06/2011**

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

Proceeding	92053787
Party	Defendant Metagenics, Inc.
Correspondence Address	DENNIS H CAVANAUGH D H CAVANAUGH ASSOCIATES 555 FIFTH AVENUE, 17TH FLOOR NEW YORK, NY 10017 UNITED STATES dhc@dhcavanaugh.net
Submission	Opposition/Response to Motion
Filer's Name	Dennis H. Cavanaugh
Filer's e-mail	dhc@dhcavanaugh.net
Signature	/Dennis H. Cavanaugh/
Date	10/06/2011
Attachments	Metagenics adv James - Memo in Opposition to Motion to Amend.pdf (5 pages) (26345 bytes) Metagenics adv James - DHC Declaration in Opposition to Motion to Amend with Exhibits.doc.pdf (16 pages) (736051 bytes)

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

-----X
Everett W. James aka Tad James, :
Petitioner, : Cancellation No.: 92053787
v. :
Metagenics, Inc., :
Registrant, :
-----X

**REGISTRANT’S MEMORANDUM IN OPPOSITION
TO PETITIONER’S MOTION TO AMEND PETITION FOR
CANCELLATION AND TO JOIN PARY DEFENDANT**

I. INTRODUCTION

This Memorandum of Law is submitted on behalf of Registrant Metagenics, Inc. (“Registrant” or “Metagenics”) in Opposition to Petitioner’s Motion to Amend Petition for Cancellation and to Join Party Defendant (“Petitioner’s Motion”). As demonstrated below, Petitioner has misinterpreted a 2006 corporate reorganization by Registrant to argue that Registrant has no rights in the trademark at issue. This argument is factually and legally erroneous.

II. ARGUMENT

1. The Facts Are Contrary To Petitioner’s Assertions

Petitioner’s motion is based on mistaken conclusions drawn from a cursory review of the records of the California Secretary of State. Specifically, Petitioner argues that the applicant for the registration that is the subject of this cancellation proceeding, Registration No. 3,467,675 (the “Registration”), did not own any rights in the mark. The actual facts prove the contrary, namely,

that the applicant for the Registration did own the right to the mark and was fully entitled to apply for the Registration.

Metagenics, Inc. was first incorporated in California on or about April 25, 1983 (the “California Corporation”). (The California Corporation is the corporation referred to by Petitioner as “Old Cal. Corp.”) The California Corporation was the applicant for and is the owner of Registration No. 2,818,514 for the mark FIRST LINE THERAPY on the Supplemental Register, which is not the subject of this cancellation.

On or about May 11, 2006, the California Corporation merged into Metagenics, Inc., a Delaware Corporation (the “Delaware Corporation”). A Certificate of Ownership and Merger was executed and filed with office of the Secretary of State of the State of Delaware. Cavanaugh Ex. A.¹ As a result of the merger, the California Corporation became a Delaware corporation, maintaining all of its preexisting rights, privileges and obligations. The records of the office of the Secretary of State of the State of California show that the California Corporation, designated Entity Number C1140233, was “merged out.” Cavanaugh Ex. B.

On or about May 17, 2006, the Delaware Corporation qualified to do business in California by filing the required documents to transact intrastate business in California. Cavanaugh Ex. A. The records of the office of the Secretary of State of the State of California show that the Delaware Corporation, designated Entity Number C2878746, is “active” and that the documents establishing its legal status in California were filed on May 17, 2006. Cavanaugh Ex. B.

¹ Reference to cited Declarations will be identified by the name of the affiant or declarant (*e.g.* Cavanaugh) followed by the paragraph number or exhibit of such Declaration (*e.g.* Cavanaugh ¶1 or Ex. A).

By merging into a Delaware corporation and qualifying to do business in California, Metagenics continued its business and the ownership of its trademarks and other intellectual property without interruption. Petitioner's Motion simply misinterprets what happened as a matter of corporate law.

2. The Registration Is Not *Void Ab Initio*

The applicant for the Registration at issue in this proceeding was Metagenics, Inc., the Delaware Corporation. At the time of the application, the merger had taken place and Metagenics, Inc. was a Delaware corporation. The initial identification of Metagenics, Inc. in the application as a California corporation was an inadvertent error. This error was corrected by Examiner's Amendment after discussion with Registrant's counsel.

Contrary to Petitioner's assertion, Metagenics, the Delaware Corporation was the owner of the mark when the application was filed. Therefore, the application was not void pursuant to TMEP 1201.02(b). The correction by the Examiner of the mistake in the state of incorporation of the applicant demonstrates that this was an error that could be corrected pursuant to TMEP 1201.02(c).

As demonstrated above, Metagenics, the Delaware Corporation was the owner of the mark at the time of filing the application. Thus, *Huang v. Tzu Wei Chen Foods Co., Ltd.*, 849 F.2d 1458, 7 USPQ.2d 1335 (Fed. Cir. 1988), cited by Opposer, does not apply. Registrant has complied with 15 U.S.C. §1051 and the Registration was not *void ab initio*.

3. There Is No Additional Third Party To Add

There is only one Metagenics, Inc. in existence, namely, the Delaware Corporation which is qualified to do business in California. There is no additional third party to add to this proceeding.

III. CONCLUSION

For all of the foregoing reasons, Registrant respectfully requests that Petitioner's motion be denied in its entirety, and that the Board grant such other and further relief as it deems just and proper.

Dated: New York, New York
October 6, 2011

Respectfully submitted,

METAGENICS, INC.

/Dennis H. Cavanaugh/

By _____

Dennis H. Cavanaugh
D H CAVANAUGH ASSOCIATES
Attorneys for Registrant
555 Fifth Avenue, 17th Floor
New York, New York 10017
Tel: (212) 856-1710
Fax: (212) 856-7211
Email: dhc@dhcavanaugh.net

CERTIFICATE OF SERVICE

DENNIS H. CAVANAUGH, declares that:

I am counsel for the Registrant in the captioned action, and on the execution date which appears below, a true copy of the foregoing was served on Petitioner's counsel by causing the same to be sent via email to the following email addresses:

mhsia@caedes.com
cmiwa@caedes.com

2. Pursuant to 28 U.S.C. §1746, I declare under penalty of perjury that all of the foregoing is true and correct.

Dated: New York, New York
October 6, 2011

/Dennis H. Cavanaugh/
By _____
Dennis H. Cavanaugh

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

-----X
Everett W. James aka Tad James, :
Petitioner, : Cancellation No.: 92053787
v. :
Metagenics, Inc., : **DECLARATION OF**
Registrant, : **DENNIS H. CAVANAUGH**
-----X

DENNIS H. CAVANAUGH declares that:

1. I am the principal of D H Cavanaugh Associates, counsel for Registrant, and am submitting this declaration in support of Registrant’s opposition to Applicant’s motion to amend petition for cancellation and to join party defendant.

2. Attached hereto and identified as Cavanaugh Exhibit A are true and accurate copies of the Certificate of Qualification of Metagenics, Inc., a Delaware corporation, issued by the office of the Secretary of State for the State of California on or about May 18, 2006; the Statement and Designation by Foreign Corporation filed with the office of the Secretary of State for the State of California on or about May 17, 2006; and the Certificate of Ownership and Merger re Merger of Metagenics, Inc., a California Corporation into Metagenics, Inc., a Delaware Corporation and the certification of same by the Secretary of State of the State of Delaware.

3. Attached hereto and identified as Cavanaugh Exhibit B are true and accurate copies of pages of the website of the office of the Secretary of State of the State of California showing search results for “Metagenics” showing the entity numbers for Metagenics, Inc., a former “merged out” California corporation, and Metagenics, Inc., a Delaware corporation.

4. Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Executed on October 6, 2011

/Dennis H. Cavanaugh/

Dennis H. Cavanaugh

CERTIFICATE OF SERVICE

DENNIS H. CAVANAUGH, declares that:

I am counsel for the Registrant in the captioned action, and on the execution date which appears below, a true copy of the foregoing was served on Petitioner's counsel by causing the same to be sent via email to the following email addresses:

mhsia@cades.com
cmiwa@cades.com

2. Pursuant to 28 U.S.C. §1746, I declare under penalty of perjury that all of the foregoing is true and correct.

Dated: New York, New York
October 6, 2011

/Dennis H. Cavanaugh/
By _____
Dennis H. Cavanaugh

EXHIBIT A

2878746

State of California
Secretary of State

CERTIFICATE OF QUALIFICATION

I, BRUCE McPHERSON, Secretary of State of the State of California, hereby certify that on the **17th day of May 2006**, **METAGENICS, INC.**, a corporation organized and existing under the laws of **Delaware**, complied with the requirements of California law in effect on that date for the purpose of qualifying to transact intrastate business in the State of California, and that as of said date said corporation became and now is qualified and authorized to transact intrastate business in the State of California, subject however, to any licensing requirements otherwise imposed by the laws of this State.

IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of May 18, 2006.



A handwritten signature in black ink, appearing to read "Bruce McPherson".

BRUCE McPHERSON
Secretary of State

2878746



State of California
Secretary of State

I, BRUCE McPHERSON, Secretary of State of the State of California, hereby certify:

That the attached transcript of 1 page(s) has been compared with the record on file in this office, of which it purports to be a copy, and that it is full, true and correct.



IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of

MAY 18 2006

A handwritten signature in cursive script, reading "Bruce McPherson".

BRUCE McPHERSON
Secretary of State

2878746

ENDORSED - FILED
in the office of the Secretary of State
of the State of California

MAY 17 2006

**STATEMENT AND DESIGNATION
BY FOREIGN CORPORATION**

METAGENICS, INC.

(Name of Corporation)

Metagenics, Inc.

, a corporation organized and existing under the laws of Delaware, makes the following statements and designation:
(State or Place of Incorporation)

- 1. The address of its principal executive office is 100 Avenida La Pata, San Clemente, California 92673
- 2. The address of its principal office in the State of California is 100 Avenida La Pata, San Clemente, California 92673

DESIGNATION OF AGENT FOR SERVICE OF PROCESS IN THE STATE OF CALIFORNIA
(Complete either Item 3 or Item 4.)

- 3. (Use this paragraph if the process agent is a natural person.)

_____, a natural person residing in the State of California, whose complete address is _____

_____ is designated as agent upon whom process directed to this corporation may be served within the State of California, in the manner provided by law.

- 4. (Use this paragraph if the process agent is a corporation.)

CT Corporation System, a corporation organized and existing under the laws of Delaware, is designated as agent upon whom process directed to this corporation may be served within the State of California, in the manner provided by law.

NOTE: Corporate agents must have complied with California Corporations Code Section 1505 prior to designation.

- 5. It irrevocably consents to service of process directed to it upon the agent designated above, and to service of process on the Secretary of State of the State of California if the agent so designated or the agent's successor is no longer authorized to act or cannot be found at the address given.

Paul E. Komey
(Signature of Corporate Officer)

Paul E. Komey, Secretary
(Typed Name and Title of Officer Signing)



State of California
Secretary of State



I, BRUCE McPHERSON, Secretary of State of the State of California, hereby certify:

That the attached transcript of 4 page(s) has been compared with the record on file in this office, of which it purports to be a copy, and that it is full, true and correct.



IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of

MAY 18 2006

BRUCE McPHERSON
Secretary of State

Delaware

PAGE 1

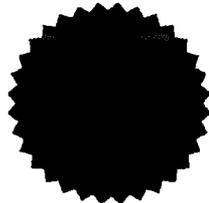
The First State

ENDORSED - FILED
in the office of the Secretary of State
of the State of California

MAY 17 2006

I, HARRIET SMITH WINDSOR, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY THE ATTACHED IS A TRUE AND CORRECT COPY OF THE CERTIFICATE OF OWNERSHIP, WHICH MERGES:

"METAGENICS, INC.", A CALIFORNIA CORPORATION,
WITH AND INTO "METAGENICS, INC." UNDER THE NAME OF
"METAGENICS, INC.", A CORPORATION ORGANIZED AND EXISTING UNDER
THE LAWS OF THE STATE OF DELAWARE, AS RECEIVED AND FILED IN THIS
OFFICE THE ELEVENTH DAY OF MAY, A.D. 2006, AT 6:44 O'CLOCK P.M.



4102265 8100M

060465885

Harriet Smith Windsor

Harriet Smith Windsor, Secretary of State

AUTHENTICATION: 4749954

DATE: 05-16-06

CERTIFICATE OF OWNERSHIP
AND MERGER
RE MERGER OF
METAGENICS, INC., A CALIFORNIA CORPORATION
INTO
METAGENICS, INC., A DELAWARE CORPORATION

Jeffrey J. Katke and Paul E. Komney certify that:

FIRST: They are the Chairman and Chief Executive Officer and the Secretary, respectively, of Metagenics, Inc., a California corporation (the "Disappearing Corporation").

SECOND: The Disappearing Corporation owns all of the outstanding shares of each class of stock of Metagenics, Inc., a Delaware corporation (the "Surviving Corporation").

THIRD: The Board of Directors of the Disappearing Corporation duly adopted the following resolutions, pursuant to which "Corporation" was defined as Metagenics, Inc., a California corporation and "Surviving Corporation" was defined as Metagenics, Inc., a Delaware corporation:

WHEREAS, the Board has determined that it is in the best interests of the Corporation and its shareholders for the Corporation to reincorporate as a Delaware corporation and to effect such reincorporation by merger (the "Merger") of the Corporation with and into Metagenics Delaware (the "Surviving Corporation"), with the Surviving Corporation being the surviving entity in such Merger and such Merger being effective prior to the consummation of the initial public offering of the Corporation's Common Stock;

NOW, THEREFORE, BE IT RESOLVED, that the Merger is hereby approved substantially upon the following principle terms:

- A. The Corporation will merge with and into the Surviving Corporation and the separate existence of the Corporation will cease. The Surviving Corporation's Certificate of Incorporation will not be affected by the Merger and from and after the effectiveness of the Merger, the directors and officers of the Surviving Corporation will continue to be the directors and officers of the Surviving Corporation.
- B. Prior to the effectiveness of the Merger, the Surviving Corporation will be registered and qualified to do business in the State of California.
- C. Subject to all the restrictions and duties of the Corporation and any requirements of law, upon the effectiveness of the Merger, the Corporation's property, rights, privileges, powers and franchises, and all debts due to the Corporation and each and every other interest of the Corporation shall be vested in and devolved upon the Surviving Corporation without further act or deed.

D. Upon the effectiveness of the Merger, all the rights of creditors and all liens upon any property of the Corporation will be preserved unimpaired, and all debts, liabilities and duties of the Corporation shall be assumed by, and attach to, the Surviving Corporation, and may be enforced against the Surviving Corporation to the same extent as if such debts, liabilities and duties had been incurred or contracted by the Surviving Corporation.

E. Upon the effectiveness of the Merger, (1) each holder of one or more shares of Common Stock, no par value, of the Corporation ("Corporation Common Stock") will receive .40 shares of Common Stock, \$0.001 par value, of the Surviving Corporation ("Surviving Corporation Common Stock") in exchange for each share of Corporation Common Stock then currently held by such holder, rounded up or down to the nearest whole share and (2) each holder of one or more shares of Series A Preferred Stock, no par value, of the Corporation ("Corporation Preferred Stock") will receive one (1) share of Series A Preferred Stock, \$0.001 par value, of the Surviving Corporation in exchange for each share of Corporation Preferred Stock then currently held by such holder, rounded up or down to the nearest whole share. On the effective date of the Merger, all issued and outstanding shares of the capital stock of the Corporation, by virtue of the Merger and without any action on the part of any holder thereof, will no longer be outstanding and shall at such time be cancelled, be retired and cease to exist.

F. Upon the effectiveness of the Merger, each share of capital stock of the Surviving Corporation that was issued and outstanding immediately prior to the Merger will no longer be outstanding and will at such time be cancelled and retired and will cease to exist, without payment of any consideration therefor.

G. Upon the effectiveness of the Merger, each option to acquire one (1) share of Corporation Common Stock that was outstanding immediately prior to the effectiveness of the Merger will be converted into an option to acquire .40 shares of Surviving Corporation Common Stock (the foregoing resolutions set forth in paragraphs (A) – (G), collectively, the "Merger Resolution").

FOURTH: As required by Section 253(a) of the Delaware General Corporation Law, the merger of the Disappearing Corporation into the Surviving Corporation as described in the Merger Resolution has been adopted, approved, certified, executed and acknowledged by the Disappearing Corporation in accordance with the laws of the State of California.

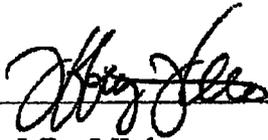
FIFTH: The Surviving Corporation survives the merger and being qualified in the State of California, may be served with process in the State of California in any proceeding for enforcement of any obligation of the Surviving Corporation as well as for enforcement of any obligation of the Surviving Corporation arising from the merger, and it does hereby appoint [CT Corporation] as its agent to accept service of process in any such suit or other proceeding.

SIXTH: The Merger shall be effective on May 11, 2006.

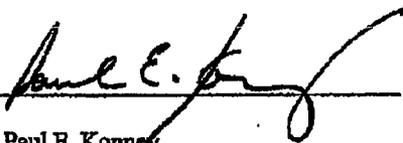
[Signature Page Follows]

We further declare under penalty of perjury under the laws of the State of Delaware that the matters set forth in this certificate are true and correct of our own knowledge.

Dated: April 25, 2006

By: 

Name: Jeffrey J. Katke
Title: Chairman and Chief Executive Officer

By: 

Name: Paul E. Komney
Title: Secretary



EXHIBIT B



Secretary of State Administration Elections Business Programs Political Reform Archives Registries

Business Entities (BE)

Online Services

- **Business Search**
- **Disclosure Search**
- **E-File Statements**
- **Processing Times**

Main Page

Service Options

Name Availability

Forms, Samples & Fees

Annual/Biennial Statements

Filing Tips

Information Requests
(certificates, copies & status reports)

Service of Process

FAQs

Contact Information

Resources

- **Business Resources**
- **Tax Information**
- **Starting A Business**
- **International Business Relations Program**

Customer Alert

(misleading business solicitations)

Business Search - Results

Data is updated weekly and is current as of Friday, September 23, 2011. It is not a complete or certified record of the entity.

- Select an entity name below to view additional information. Results are listed alphabetically in ascending order by entity name.
- For information on checking or reserving a name, refer to **Name Availability**.
- For information on ordering certificates, copies of documents and/or status reports or to request a more extensive search, refer to **Information Requests**.
- For help with searching an entity name, refer to **Search Tips**.
- For descriptions of the various fields and status types, refer to **Field Descriptions and Status Definitions**.

Results of search for " METAGENICS " returned 3 entity records.

Entity Number	Date Filed	Status	Entity Name	Agent for Service of Process
C1140233	04/25/1983	MERGED OUT	<u>METAGENICS, INC.</u>	PAUL E KONNEY
C2878746	05/17/2006	ACTIVE	<u>METAGENICS, INC.</u>	PAUL E KONNEY
C1797855	01/17/1997	SUSPENDED	<u>METAGENICS, NORTHERN CALIFORNIA, INC.</u>	JOSEPH E MUDD

[Modify Search](#) [New Search](#)

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Business Entity Detail

Data is updated weekly and is current as of Friday, September 23, 2011. It is not a complete or certified record of the entity.

Entity Name:	METAGENICS, INC.
Entity Number:	C1140233
Date Filed:	04/25/1983
Status:	MERGED OUT
Jurisdiction:	CALIFORNIA
Entity Address:	100 AVENIDA LA PATA
Entity City, State, Zip:	SAN CLEMENTE CA 92673
Agent for Service of Process:	PAUL E KONNEY
Agent Address:	100 AVENIDA LA PATA
Agent City, State, Zip:	SAN CLEMENTE CA 92673

* Indicates the information is not contained in the California Secretary of State's database.

- If the status of the corporation is "Surrender," the agent for service of process is automatically revoked. Please refer to California Corporations Code [section 2114](#) for information relating to service upon corporations that have surrendered.
- For information on checking or reserving a name, refer to [Name Availability](#).
- For information on ordering certificates, copies of documents and/or status reports or to request a more extensive search, refer to [Information Requests](#).
- For help with searching an entity name, refer to [Search Tips](#).
- For descriptions of the various fields and status types, refer to [Field Descriptions and Status Definitions](#).

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Business Entity Detail

Data is updated weekly and is current as of Friday, September 23, 2011. It is not a complete or certified record of the entity.

Entity Name:	METAGENICS, INC.
Entity Number:	C2878746
Date Filed:	05/17/2006
Status:	ACTIVE
Jurisdiction:	DELAWARE
Entity Address:	100 AVENIDA LA PATA
Entity City, State, Zip:	SAN CLEMENTE CA 92673
Agent for Service of Process:	PAUL E KONNEY
Agent Address:	100 AVENIDA LA PATA
Agent City, State, Zip:	SAN CLEMENTE CA 92673

* Indicates the information is not contained in the California Secretary of State's database.

- If the status of the corporation is "Surrender," the agent for service of process is automatically revoked. Please refer to California Corporations Code [section 2114](#) for information relating to service upon corporations that have surrendered.
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