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

Proceeding	92055403
Party	Defendant Thanh Nguyen
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Date	05/17/2012
Attachments	2012 05 17 Consent Motion to Re-Open Time in Which to Respond to Motion for Reconsideration.pdf (15 pages)(470127 bytes)

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

BARRY BIONDO, d/b/a
TIPSY SPA AND SALON INC.,

Petitioner,
v.

Cancellation No.: 92055403
Serial No.: 77093533

THANH NGUYEN, an individual,
Respondent.

**RESPONDENT'S CONSENT MOTION TO RE-OPEN THE TIME IN
WHICH TO RESPOND TO PETITIONER'S MOTION FOR RECONSIDERATION**

Respondent, THANH NGUYEN, by and through his undersigned attorneys, and pursuant to Trademark Rules of Practice Section 2.127, hereby file this Consent Motion to Re-Open the Time in which to Respond to Petitioner's Motion for Reconsideration, and in support thereof state as follows:

A. Facts.

1. On April 12, 2012, Respondents filed a Motion to Stay the Cancellation as a result of ongoing federal litigation concerning Thanh Nguyen's "Topsy" Mark. A copy of Respondent's Motion to Stay, excluding the Motion's exhibits, is attached as **Exhibit "A."**

2. Also on April 12, 2012, the TTAB granted Respondent's Motion to Stay finding that the litigation is capable of disposing some or all of the issues involved in the Cancellation. A copy of that Order is attached as **Exhibit "B."**

3. On April 14, 2012, Petitioner filed their Motion for Reconsideration of the Stay.

4. On April 27, 2012, Respondent received the Motion for Reconsideration due to a service of process error.

5. As a result, the parties agreed that Respondent would have thirty (30) days to respond to the Motion, requiring a response on or before May 23, 2012.

B. Brief.

Pursuant to Federal Rule of Civil Procedure 6(b), “[w]hen 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.” On April 27, 2012, immediately after receiving the Motion for reconsideration and discussing it with opposing counsel, Respondent filed for an Extension of Time to Answer, believing that to have been sufficient to extend the response period. That consent motion was filed within Respondent’s original time to respond. It was not until Respondent’s began to draft their response and upon speaking to the TTAB that the error was realized and immediate attempts were made to rectify the mistake. Respondent did not wholly fail to act, but instead inadvertently filed the incorrect motion. As a result, Respondent’s failure to seek an extension of the response time prior to the expiration of the original time period constitutes excusable neglect. Respondent has demonstrated good cause as to why Respondent should be permitted to respond no later than May 23, 2012.

WHEREFORE, Respondent, THANH NGUYEN requests that the Board: (1) re-open the time in which to Respond to Petitioner’s Motion for Reconsideration; (2) allow Respondents to respond to the Motion no later than May 23, 2012: and (3) that the Board

disregard Respondent's Consent Motion for Extension of Time to Answer, filed on May 17, 2012.

Respectfully submitted,

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CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that on the 17th day of May 2012, we electronically filed the foregoing document with the United States Patent and Trademark Office through the Trademark Trial and Appeal Board. We also certify that the foregoing document is being served this day on all counsel of record identified on the attached Service List by email.

Respectfully submitted,

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**BARRY BIONDO, d/b/a
TIPSY SPA AND SALON INC., a
Florida Corporation
vs.
THANH NGUYEN, an individual**

**Cancellation No.: 92055403
Serial No.: 77093533**

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

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Consent Motion to Re-Open Time in Which to Respond to Motion for Reconsideration.wpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BARRY BIONDO, d/b/a
TIPSY SPA AND SALON INC.,

Cancellation No.: 92055403
Serial No.: 77093533

v.

THANH NGUYEN, an individual,
_____ /

MOTION TO STAY CANCELLATION
PENDING THE OUTCOME OF FEDERAL LITIGATION

COMES NOW, Respondent, THANH NGUYEN, pursuant to Trademark Rules of Practice Sections 2.117(a) and (c), and hereby moves to stay this matter, as follows:

A. Facts

The parties are currently involved in federal litigation regarding the same mark at issue in this proceeding, captioned *Thanh Nguyen, an Individual, and Luong Nguyen, an Individual, Plaintiffs, vs. Barry Biondo, an Individual, and Topsy Spa and Salon Inc., a Florida corporation*, Case No.: 9:11-CV-81156-Middlebrooks, in the United States District Court for the Southern District of Florida. A true and correct copy of the Amended Complaint filed in the District Court for the Southern District of Florida is attached hereto as **Exhibit "A."** Petitioners in this case filed an Answer, Affirmative Defenses and a Counterclaim alleging Federal Trademark Registration with False or Fraudulent Representations. A true and correct copy of the Answer, Affirmative Defenses and Counterclaim is attached hereto as **Exhibit "B."** In response, Plaintiffs filed a Motion to Dismiss that Counterclaim which is currently pending in the Southern District of Florida. A true and correct copy of the Motion to Dismiss the Counterclaim is attached hereto as

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EXHIBIT

A

Exhibit "C." This Counterclaim is based solely on the Registrant's deletion of "nail, hair cutting and spa services" from Mr. Nguyen's trademark application classification which originally included "nail, hair cutting and spa services; bar services." As a result of that deletion, Mr. Nguyen's federal trademark is only listed in the "bar services" classification, a classification which is accurate in light of the services provided in connection with his "Topsy" mark. Mr. Nguyen also holds a valid Florida trademark which encompasses salon services, chemical treatments, manicures, pedicures, massages, facials, waxes, eyelash services and bar and food services (FL trademark No.:W09000047355) as well as common law trademark rights in the "Topsy" mark beginning in 2006. At issue in both the federal lawsuit and the instant matter are the validity of the "Topsy" mark.

Additionally, simultaneous to the filing of the federal litigation, Respondent in this matter filed a Notice of Opposition to Applicant, Barry Biondo's trademark registration of "Topsy," Opposition No. 91202097. A true and correct copy of the Notice of Opposition is attached hereto as **Exhibit "D."** As a result of the ongoing federal litigation, that Opposition is now stayed pending the outcome of the federal litigation. A true and correct copy of the Order granting Petitioner's Motion to Stay is attached hereto as **Exhibit "E."**

The allegations in the federal litigation mirror those filed in the USPTO Opposition as well as this Cancellation. The federal district court lawsuit arises out of Defendants' intentional infringement of Respondent's properly registered trademark, "Topsy," which Petitioner now seeks to cancel in retaliation for the filing of the Opposition to his infringing "Topsy" mark.

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Plaintiff THANH NGUYEN and Defendants operate competing nail salons and spas which serve beer and wine to customers. Plaintiff THANH NGUYEN is the registered owner of the Topsy mark at issue in this Cancellation as well as the federal litigation. Defendant BARRY BIONDO entered into a Business Sale Agreement with Plaintiffs which granted BIONDO the contractual right to use the Topsy mark until March 11, 2011. In violation of the agreement and Plaintiff THANH NGUYEN's intellectual property rights, BIONDO and his company continued to use the mark after March 11, 2011. BIONDO also failed to pay Plaintiffs the amounts due under the Business Sale Agreement and filed for his own "Topsy" trademark on March 21, 2011, just ten (10) days after he was required to stop using Plaintiff/Respondent's "Topsy" mark in connection with the same business concept.

Plaintiffs' Amended Complaint asserts claims for Trademark Infringement Under Section 32(1) of the Lanham Act (Count I), False Designation of Origin under Section 43(a) of the Lanham Act (Count II), Cybersquatting- Damages (Count III), Cybersquatting- Injunctive Relief (Count IV), Unjust Enrichment (Count V), Breach of Contract- Damages (Count VI), Breach of Contract- Injunction (Count VII), Common Law Trademark Infringement (Count VIII), and Trademark Dilution, Fla. Stat. § 495.151 (Count IX). The resolution of these allegations along with Petitioner/Defendant's Counterclaim are determinative as to Biondo's rights in his registration as well as Mr. Nguyen's alleged fraud on the USPTO in his application, and therefore this cancellation matter should be stayed

pending a determination of all issues by the United States District Court for the Southern District of Florida.

B. Brief

"It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case." *Arcadia Group Brands Ltd. v. Studio Moderna SA*, 2011 WL 3218630 *2, Opp. No. 91169226, Can. No. 92049146 (TTAB January 6, 2011); Trademark Rule 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). This is true even when the district court action may not dispose of all the issues before the Board as the standard is whether it may have a bearing on the case. See Trademark Rule 2.117(a). "The Board's final decision would be merely advisory, and not binding in respect to the proceeding pending before the federal district court." *Arcadia Group Brands*, 2011 WL3218630 *3 (citing *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971)). "In contrast, the federal court determination of a trademark issue normally has a binding effect in subsequent proceedings before the Board involving the same parties and issue." *Id.*

In the instant case, the federal district court action includes allegations of trademark infringement, unfair competition, customer confusion, as well as the alleged fraudulent registration of the trademark which is the subject of this Petition for Cancellation. The outcome of which would have a bearing, and likely be determinative, as to the validity of the registration of Respondent's "Tippy" mark. Petitioners district court Counterclaim

asserts a similar claim against Respondent, Thanh Nguyen's registration of the "Topsy" mark which is currently awaiting a potentially dispositive ruling by the Court by way of a Motion to Dismiss. That Counterclaim alleges that Thanh Nguyen's registration is somehow fraudulent based on his deletion of "nail care salons" etc. from the classification and proceeding only under "bar services" in spite of the fact that Petitioner admits that Respondent does in fact use the "Topsy" mark in connection with bar services, and has offered bar services at all material times. Therefore, until a resolution in the district court action is reached the cancellation should be stayed in order to avoid inconsistent results and duplicative efforts by all parties.

WHEREFORE Respondent, THANH NGUYEN, requests this Board: (1) grant this Motion to Stay the Cancellation proceeding pending the outcome of the federal litigation; (2) to reset all discovery deadlines according; and (3) for any other relief that this Board deems equitable and just.

Respectfully submitted,

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CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that on the 12th day of April 2012, we electronically filed the foregoing document with the United States Patent and Trademark Office through the Trademark Trial and Appeal Board. We also certify that the foregoing document is being served this day on all counsel of record identified on the attached Service List by email and U.S. Mail.

Respectfully submitted,

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SERVICE LIST

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SERVICE LIST

**BARRY BIONDO, d/b/a
TIPSY SPA AND SALON INC., a
Florida Corporation
vs.
THANH NGUYEN, an individual**

**Cancellation No.: 92055403
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**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: April 12, 2012

Cancellation No. 92055403

Barry Biondo dba Topsy Spa
and Salon

v.

Thanh Nguyen

**George C. Pologeorgis,
Interlocutory Attorney:**

On April 12, 2012, respondent filed a motion to suspend this proceeding pending final determination of a civil action between the parties in the United States District Court for the Southern District of Florida.¹ Respondent included a copy the civil action complaint with his motion.

Respondent's motion for suspension of this Board proceeding is granted as well taken. It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or

¹Case No. 9:11:CV-81156, styled *Thanh Nguyen and Luong Nguyen v. Barry Biondo and Topsy Spa and Salon, Inc.*, filed on or about February 17, 2012.

Cancellation No. 92055403

have a bearing on the Board case.² See Trademark Rule 2.117(a).

A review of the complaint in the civil case indicates that a decision by the district court could be dispositive of, or have a bearing on, the issues in this cancellation proceeding.

Accordingly, proceedings herein are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

² Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board, whereas the Board decision is merely advisory to the district court. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Further, Board decisions are appealable to the district court. See Section 21 of the Trademark Act, and *Goya Foods, Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, at 1953 (2d Cir. 1988).