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

Proceeding	92055403
Party	Plaintiff Barry Biondo dba Topsy Spa and Salon
Correspondence Address	WENDY PETERSON NOT JUST PATENTS LLC PO BOX 18716 MINNEAPOLIS, MN 55418 UNITED STATES wsp@njpls.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Wendy Peterson
Filer's e-mail	wsp@NJPLS.com
Signature	/Wendy Peterson/
Date	06/12/2012
Attachments	Motion to Amend and Amended Petition to Cancel.pdf (6 pages)(90113 bytes)

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

In the matter of Trademark Registration No 3529699

For the mark “**TIPSY**”

Cancellation Proceeding 92055403

Registered on November 11, 2008

Barry Biondo dba Tippy Spa and Salon

vs.

Thanh Nguyen

MOTION TO AMEND PETITION TO CANCEL

Petitioner Barry Biondo dba Tippy Spa and Salon moves the Board under TBMP 507 and Fed. R. Civ. P. 15(a) (Amendments Before Trial) to allow Petitioner the right, as a matter of course in this stage of the proceeding, to amend its pleading.

Submitted By: /Wendy Peterson/

Date: June 12, 2012

Wendy Peterson, Attorney for Barry Biondo and Tippy Spa and Salon Inc.

Not Just Patents LLC

PO Box 18716

Minneapolis, MN 55418

WSP@NJPLS.COM

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AMENDED PETITION TO CANCEL

The above-identified Petitioner believes that it will be damaged by continued registration of the TIPSY mark for bar services shown in the above-identified registration, and hereby amends its Petition to Cancel the same.

Based upon information and belief, Petitioner avers the following regarding the continued registration of the mark TIPSY:

1. Standing: Petitioner is a competitor of Registrant. Both Petitioner and Registrant have salons that offer bar services and nail services.
2. Registrant and Petitioner are involved in litigation over the competitive use of the term TIPSY as a trademark in their businesses. Petitioner does not lose standing as a competitor under any conditions in the subject litigation even if Petitioner loses some or all trademark rights.
3. Registrant Thanh Nguyen registered the standard character mark TIPSY for the *bar services* in application SN 77093533 on January 29, 2007 under Section 1(a).

4. TIPSY IS A GENERIC MARK FOR THE REGISTERED SERVICES Registrant's use of the word TIPSY is generic for bar services or so highly descriptive that it is incapable of acquiring distinctiveness under the two part *Ginn* test: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986).
5. The applicable class of goods or services is bar services or bar goods, meaning alcohol for consumption on the premises. Note that Registrant's services are not limited to bar services provided in conjunction with nail services or spa services.
6. The Board has held in the past that a term which is the generic name of a particular category of goods is likewise generic for any services which are directed to or focused on that class of goods. See: *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001)(RUSSIANART generic for particular field or type of art and also for dealership services directed to that field). Petitioner avers that for purposes of this analysis that a finding that Registrant's services or goods are generic is directed toward the service being generic.
7. 'Topsy' is well understood by the relevant public as being the result of consuming bar goods or receiving bar services. 'Topsy' places are where people are drunk or can purchase bar goods and drink on the premises and 'tipsy' is the state of being drunk or slightly drunk.
8. 'Topsy' means "slightly drunk" (<http://www.thefreedictionary.com/tipsy>).
9. 'Topsy' happens at places where you drink. "Where to Get Topsy" (<http://tipsydiaries.com/category/where-to>).
10. Bar goods are well known to make you tipsy as in "How Getting Topsy May Inspire Creativity: A new study finds that men who got moderately drunk on vodka cranberries did better on tests of inspired thinking." <http://healthland.time.com/2012/03/22/how-getting-tipsy-may-inspire-creativity/>.
11. Places where people get drunk are 'tipsy' places. "Topsy Towns: Where Are America's Drunkest Cities? Which cities are most likely to break out the bubbly this New Year's

Eve?” <http://newsfeed.time.com/2011/12/31/tipsy-towns-where-are-americas-drunkest-cities/>

12. Petitioner’s right to use the term ‘tipsy’ in a descriptive manner to describe the consumers of its bar services (consumers who get a little drunk or tipsy), the purpose for the services (to get tipsy) or a place to consume alcohol (where to get tipsy) is supported not just by trademark law but also by public policy.
13. The two major policy reasons for not protecting descriptive marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods or services; and (2) to avoid the possibility of costly infringement suits brought by the registrant. This thus enables businesses and competitors to have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (C.C.P.A. 1968); *Armour & Co. v. Organon Inc.*, 245 F.2d 495, 114 USPQ 334, 337 (C.C.P.A. 1957); *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1526-1527 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000).
14. Registrant’s mark TIPSY describes the intended purpose of Registrant’s services, to allow consumers to ‘get TIPSY’ while having their nails or hair done and it describes the intended user of the services as being ‘TIPSY’ and describes the result of the consumption of Registrant’s bar goods ‘Getting tipsy from drinking wine or beer.’
15. Petitioner has shown standing on one ground as a competitor, and now has the right to assert any other grounds in a Cancellation proceeding, See TMBP 309.03(b) Standing.
16. TIPSY DOES NOT CREATE A SEPARATE COMMERCIAL IMPRESSION AS A MARK AND DOES NOT ACT AS A SERVICE MARK. Registrant’s uses of the term TIPSY in commerce do not show TIPSY in a commercial impression separately from the phrase TIPSY NAIL SPA AND SALON. The size, appearance, and dominance of the word TIPSY does not differentiate it from the commercial impression of the phrase TIPSY NAIL SPA AND SALON. See TMEP 1202.03(a).
17. Registrant’s use of TIPSY in commerce is not used as a single distinct term, it is used as an adjective in the trade name Topsy Nail Bar and Salon. The trade name elements

NAIL SPA AND SALON are not descriptive or generic words for *bar services* and are a distinctive part of the commercial impression when used with TIPSY. The terms TIPSY and NAIL SPA AND SALON are not separable as Registrant uses them in commerce. *In re National Institute for Automotive Service Excellence*, 218 USPQ 745 (TTAB 1983).

18. TIPSY IS A DESCRIPTIVE TERM THAT MERELY PROVIDES INFORMATIONAL MATTER. Registrant's use of TIPSY in commerce merely informs potential customers of the name of the business at a particular location or of the type of goods and services being provided and is not a service mark.

19. Registrant's mark is not being used as a service mark and is void ab initio.

SHUTEMDOWN SPORTS, INC. v. LACY (TTAB 2012).

The continuance of a federal registration for Registrant will unjustly harm Petitioner's rights to descriptively use the generic or highly descriptive term 'tipsy' to describe the purpose of Petitioner's bar services and the effect that Petitioner's bar goods will have on the consumer. Registrant's use in commerce of the term TIPSY is not a service mark for bar services. Petitioner respectfully requests that the amended Petition to Cancel be granted and that Cancellation is sustained in favor of Petitioner.

Submitted By: /Wendy Peterson/

Date: June 12, 2012

Wendy Peterson, Attorney for Barry Biondo and Topsy Spa and Salon Inc.

Not Just Patents LLC

PO Box 18716

Minneapolis, MN 55418

WSP@NJPLS.COM

CERTIFICATE OF SERVICE

I hereby certify that on June 12, 2012, the Petition to Cancel was served upon Registrant's attorneys by email as agreed at:
skonopka@pm-law.com, pgillman@pm-law.com, lchristian@pm-law.com,
snickey@pm-law.com, mjohnston@pm-law.com

By: /Wendy Peterson/ Date: April 12, 2012
Wendy Peterson, Attorney for Barry Biondo and Topsy Spa and Salon Inc.