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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	Response to Board Order/Inquiry
Filer's Name	Wendy Peterson
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Date	08/05/2013
Attachments	Show Cause, Amended Petition and Voluntary Amendment.pdf(104864 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

vs.

Thanh Nguyen

**PETITIONER’S REPLY TO ORDER TO SHOW CAUSE AND AMENDED PETITION
TO CANCEL**

The Petitioner hereby replies to the Board order to show cause why the Petition to Cancel TIPSY should not be dismissed. The district court found that Petitioner had infringed on Registrant’s TIPSY mark and permanently enjoined petitioner from using the TIPSY mark depriving Petitioner of his initial pleaded standing in this matter. Petitioner wishes to amend its Petition to Cancel to claim standing under without asserting proprietary rights. Petitioner has also filed a motion for a voluntary amendment to change its name as Petitioner to delete his dba.

Petitioner is a competitor of Registrant. Both Petitioner and Registrant have had salons that offer bar services and nail services. Petitioner intends to return to this business shortly after resolving business and legal issues. Under TBMP 309.03(b) Petitioner retains standing: A plaintiff need not assert proprietary rights in a term in order to have standing. For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff’s business) and that the plaintiff has an interest in using the term descriptively in its business.

Petitioner believes that it has shown good and sufficient cause to allow the Cancellation Proceeding to continue with the following amended claims.

AMENDED PETITION TO CANCEL

The above-identified Petitioner believes that it and other competitors will be damaged by continued registration of the TIPSYP mark for bar services shown in the above-identified registration and that the public will be harmed by continued 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 TIPSYP:

STANDING

1. Petitioner is a competitor of Registrant. Both Petitioner and Registrant have had salons that offer bar services and nail services. Petitioner intends to return to this business shortly after resolving business and legal issues.
2. Registrant and Petitioner were involved in litigation over the competitive use of the term TIPSYP as a trademark in their businesses. The litigation is now completed and the judgment is part of the record.
3. The finding of the court in the subject litigation was that TIPSYP for nail services was famous and hence distinctive under Florida law presumably for nail and salon services. Petitioner maintains that the finding of the court did not apply to bar services. Regardless, the finding of the Florida court was not that TIPSYP was distinctive for bar services under the Lanham Act.
4. A finding of the court in the subject litigation that TIPSYP was famous for any type of services under Florida law is not a finding that is not supported under the Lanham Act. Relevant purchasers would not view TIPSYP as a famous mark. See *In re Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1409 (TTAB 1998).

5. Registrant produced no evidence that TIPSY was well known outside of the local market or outside of Florida for bar services.
6. Registrant produced no evidence that even if the mark were famous for the nail services in the Florida registration that would lead to the conclusion that fame would transfer to use of the mark in connection with unrelated bar goods or services.

TIMELINESS OF PROCEEDING

7. Registrant Thanh Nguyen applied for the standard character mark TIPSY for *bar services* in application SN 77093533 on January 29, 2007 under Section 1(a).
8. TIPSY registered on Nov. 11, 2008 and was not an incontestable mark at the time of the original filing of this Petition to Cancel and is not an incontestable mark at the time of this amendment so the ground of descriptiveness is timely for this petition.

TIPSY IS A DESCRIPTIVE MARK FOR THE REGISTERED SERVICES

9. Registrant's use of the word TIPSY is descriptive for bar services.
10. 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 description is not limited to bar services provided in conjunction with nail services or spa services.
11. The term '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 get drunk or can purchase bar goods and drink on the premises. 'Topsy' is also the state of being drunk or slightly drunk.
12. 'Topsy' means "slightly drunk" (<http://www.thefreedictionary.com/tipsy>).
13. 'Topsy' happens at places where you drink. "Where to Get Topsy" (<http://tipsydiaries.com/category/where-to>).
14. 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/>.
15. Places where people get drunk are 'tipsy' places. "Topsy Towns: Where Are America's Drunkiest 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/>

16. Topsy’s Liquor World is a place to buy liquor (bar goods).

<http://www.tipsyliquorworld.com/>

17. Petitioner and the general public have a right to use the term ‘tipsy’ in a descriptive manner

- to describe consumers of bar services (consumers who get a little drunk or tipsy);
- to describe the purpose for bar services (to get tipsy); or
- to describe a place to consume alcohol (where to get tipsy); or
- to describe a place to buy alcohol (liquor store).

Registrant’s exclusive use of the term TIPSY for bar services or the associated goods is not supported by trademark law and not supported by public policy.

18. 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).

19. 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.

TIPSY DOES NOT CREATE A SEPARATE COMMERCIAL IMPRESSION AS A MARK FOR BAR SERVICES AND DOES NOT ACT AS A SERVICE MARK.

20. Registrant’s uses of the term TIPSY in commerce in the relevant period between application and before and at the time this petition to cancel was filed do not show

TIPSY for *bar services* in a commercial impression separately from the phrases TIPSY NAIL SPA AND SALON or TIPSY SALON AND SPA. See TMEP 1202.03(a).

21. Registrant's uses of the term TIPSY in commerce in the relevant period between application and before and at the time this petition to cancel was filed do not show TIPSY with a direct link to the registered class *bar services*.
22. 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 or Topsy Spa 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).
23. 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 and the type of goods and services being provided (Nail services) and is not a service mark.
24. Registrant's mark is not being used as a service mark and is void ab initio. *SHUTEMDOWN SPORTS, INC. v. LACY* (TTAB 2012).

ABANDONMENT

25. TIPSY has not been used as a mark in interstate commerce for bar services for more than three consecutive years and is prima facie abandoned.
26. Trademark Act Section 14(3), 15 U.S.C. § 1064(3), provides that a registration may be cancelled at any time if the registered mark has been abandoned. In pertinent part, Trademark Act Section 45, 15 U.S.C. § 1125, provides: A mark shall be deemed to be "abandoned" . . . [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

27. Registrant's advertising in interstate commerce from at least 2008-2012 does not show TIPSYP used for bar services but merely for nail services. The mark is prima facie abandoned for bar services.

The continuance of a federal registration for Registrant will unjustly harm Petitioner's rights to descriptively use the 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. The public is harmed by continued registration of this descriptive mark for bar services. Registrant's use in commerce of the term TIPSYP is not a service mark for bar services, is prima facie abandoned and violates trademark law. 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: August 5, 2013

Wendy Peterson, Attorney for Barry Biondo

Not Just Patents LLC

PO Box 18716

Minneapolis, MN 55418

WSP@NJPLS.COM

CERTIFICATE OF SERVICE

I hereby certify that on August 5, 2013, 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

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MOTION FOR VOLUNTARY AMENDMENT

The Petitioner asks the Board order for the grant of a voluntary amendment to change its name as Petitioner to comply with the district court order (already of record) and delete his dba and hence be known as Barry Biondo rather than Barry Biondo dba Topsy Spa and Salon.

Submitted By: /Wendy Peterson/

Date: August 5, 2013

Wendy Peterson, Attorney for Barry Biondo

Not Just Patents LLC

PO Box 18716

Minneapolis, MN 55418

WSP@NJPLS.COM

CERTIFICATE OF SERVICE

I hereby certify that on August 5, 2013, 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