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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
Correspondence Address	THANH NGUYEN 1037 STATE ROAD 7, SUITE 112 WELLINGTON, FL 33414 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	Scott Konopka
Filer's e-mail	skonopka@pm-law.com, pgillman@pm-law.com, lchristian@pm-law.com, snickey@pm-law.com, mjohnston@pm-law.com
Signature	/Scott Konopka/
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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.,

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

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.

Attorneys at Law

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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.

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 “Topsy” 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,

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.
1000 S.E. Monterey Commons Blvd., Suite 306
Stuart, Florida 34996
Telephone (772) 221-7757
Facsimile (772) 781-6886
Counsel for THANH NYUGEN

By: /s/ Scott Konopka
SCOTT KONOPKA, ESQUIRE
Florida Bar No. 080489
E-mail: skonopka@pm-law.com
PAIGE GILLMAN, ESQUIRE
Florida Bar No. 58967
E-mail: pgillman@pm-law.com

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.

Attorneys at Law

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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,

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.
1000 S.E. Monterey Commons Blvd., Suite 306
Stuart, Florida 34996
Tel (772) 221-7757 / Fax (772) 781-6886
Counsel for Thanh Nguyen

By: /s/ Scott Konopka

SCOTT KONOPKA, ESQ.
Florida Bar No. 080489
E-mail: skonopka@pm-law.com
PAIGE GILLMAN, ESQ.
Florida Bar No. 58967
E-mail: pgillman@pm-law.com

SERVICE LIST

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.

Attorneys at Law

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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
Serial No.: 77093533**

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

Timothy L. Grice, Esq.
Timothy L. Grice, P.A.
319 Clematis Street
Suite 213
West Palm Beach, FL 33401
Tel (561) 802-4474 / Fax (561) 208-1303
Attorney for the Defendants, Barry Biondo
and Topsy Spa and Salon Inc.

Wendy Peterson, Esq.
Not Just Patents, LLC
P.O. Box 18716
Minneapolis, MN 55418
Attorney for Petitioners, Barry Biondo and
Topsy Spa and Salon, Inc.

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No.: 9:11-CV-81156-MIDDLEBROOKS

THANH NGUYEN, an individual, and
LUONG NGUYEN, an individual

Plaintiffs,

v.

BARRY BIONDO, an individual,
TIPSY SPA AND SALON INC., a Florida corporation

Defendants.

PLAINTIFFS' FIRST AMENDED COMPLAINT

Plaintiffs, THANH NGUYEN, an individual, and LUONG NGUYEN, an individual (collectively "Plaintiffs"), by and through their undersigned attorneys, sue Defendants, BARRY BIONDO, an individual, and TIPSY SPA AND SALON INC., a Florida corporation (collectively, "Defendants") for trademark infringement, cybersquatting, unjust enrichment, and breach of contract, and in support thereof state as follows:

JURISDICTION AND VENUE

1. This is an action for damages in excess of the jurisdictional amount of Seventy-Five Thousand (\$75,000.00) Dollars U.S., exclusive of reasonable attorneys' fees and costs.
2. This Court has subject matter jurisdiction over the claims in this action based on a federal question under 15 U.S.C. §1121(a), 28 U.S.C. § 1331, and 28 U.S.C. 1338(a), since it arises under the Lanham Act.

3. This Court has personal jurisdiction over each of the Defendants because: (a) at all relevant times, the Defendants, in connection with the allegations in this Complaint, have transacted business in the State of Florida; (b) the Defendants committed tortious acts within the State of Florida; (c) the Defendants have offices in the State of Florida and within this district; and (d) the Defendants have headquarters in the State of Florida and within this district. Further, the Defendants are engaged in solicitation and service activities within Florida and are breaching obligations under an agreement that required performance, in part, in this state.

4. This Court has personal jurisdiction over the Defendants by virtue of their substantial and continuous contacts with the State of Florida.

5. Venue is proper in this district pursuant 28 U.S.C. § 1391(a), (b) & (c).

6. Venue is proper in this district because the Defendants' acts, omissions, and the events giving rise to Plaintiffs' causes of action, occurred within or were directed to this district; and Defendants maintain headquarters in this district.

THE PARTIES

7. Plaintiff, THANH NGUYEN is a Florida resident and is otherwise sui juris. THANH NGUYEN owns United States Trademark number 77093533, and Florida State Trademark number T09000001204.

8. Plaintiff, LUONG NGUYEN is a Florida resident and is otherwise sui juris.

9. Defendant, TIPSYP SPA AND SALON INC., is an active Florida corporation with its principal address at 10120 Forest Hill Blvd., Suite 100, Wellington, Florida 33414.

10. Defendant, BARRY BIONDO, is a Florida resident and is otherwise sui juris.

BARRY BIONDO is a shareholder in TIPSY SPA AND SALON INC.

FACTS COMMON TO ALL CLAIMS

Opening of the Salons and Acquisition of the “Topsy” Mark

11. On January 29, 2007, THANH NGUYEN applied for federal trademark protection in the “Topsy” name and mark (the “Mark” or the “‘Topsy’ Mark”). On November 11, 2008, the United States Patent and Trademark Office granted THANH NGUYEN’s federal trademark application. A true and correct copy of Plaintiff’s federal “Topsy” Mark is attached hereto as **Exhibit “1.”**

12. On November 19, 2009, THANH NGUYEN was granted a Florida Trademark on the “Topsy” Mark. Plaintiff’s “Topsy” Mark is inherently distinctive (arbitrary, fanciful or novel) or suggestive or has acquired secondary meaning.

13. By virtue of the Plaintiff, THANH NGUYEN, use of the “Topsy” Mark in salon businesses having bar services and in which THANH NGUYEN has a financial interest, registration of the “Topsy” Mark with the United States Patent and Trademark Office, and registration of the “Topsy” Mark with the Florida Department of State, THANH NGUYEN enjoys the exclusive use of the “Topsy” Mark in connection with nail salon and spa services business, Plaintiff has acquired all rights in the “Topsy” Mark.

Expansion of the Business and association with BARRY BIONDO

14. After several years of utilizing the “Topsy” Mark in business, THANH NGUYEN and LUONG NGUYEN, associated with Defendant, BARRY BIONDO, to open a Topsy Nail Spa and Salon at 1037 State Road #7, Suite 112, Wellington, Florida 33414 (“Wellington Nail Spa and Salon”).

15. For a period of time, the parties jointly operated the Wellington Nail Spa and Salon

under the “Topsy” Mark.

16. In or about 2010, a disagreement occurred regarding the ownership and operation of the Wellington Nail Spa and Salon.

17. As a result of the disagreement, on or about March 11, 2010, THANH NGUYEN and LUONG NGUYEN, as sellers, and BARRY BIONDO, as buyer, entered into a Business Sale Agreement to resolve their disagreement. A true and correct copy of the Business Sale Agreement is attached hereto as **Exhibit “2.”**

18. Pursuant to the Business Sale Agreement, BARRY BIONDO purchased the fixtures, furnishings, and equipment of the Wellington Nail Spa and Salon, and the right to operate the Wellington Nail Spa and Salon as a competing business at the Wellington location for \$164,000.00. BARRY BIONDO agreed to pay a \$20,000 down payment and to pay the balance of the purchase price in weekly installment payments. *See Business Sale Agreement ¶¶ 1 & 2.*

19. The Business Sale Agreement permitted BARRY BIONDO to use the “Topsy” Mark in connection with the Wellington Nail Spa and Salon *only* for the period of one (1) year from the date of the Agreement.

20. The Business Sale Agreement specifically states that BARRY BIONDO did *not* purchase the “Topsy” name or the “Topsy” Mark. *See Business Sale Agreement ¶ 8.*¹

21. BARRY BIONDO agreed that he would not use the “Topsy” name or the “Topsy”

¹ Paragraph 8 of the Business Sale Agreement states in part, “The PARTIES further agree that BUYER shall be entitled, for a period of one (1) year after the execution of this document to continue operating the BUSINESS using the name ‘Topsy’. The PARTIES further agree that the right to the use of the name ‘Topsy’ or any mark associated with that business name is not being purchased by BUYER. The following assets are not part of the sale to BUYER and shall be retained by SELLERS: (a) all rights, marks, etc. associated with the name ‘Topsy’ (except that BUYER will be granted a one (1) year usage right of the name in order to transition into another name); and (b) all rights under contracts and commitments of SELLERS which are not expressly assumed by BUYER under the Agreement. As it related to the website, BUYER shall redirect the domain name Tipsyspa.com to another location without the name ‘Topsy’ after one (1) year.”

Mark after March 11, 2011, and that he would use a different name for his Wellington Nail Spa and Salon after March 11, 2011.

22. On July 16, 2010, shortly after the execution of the Business Sale Agreement, BARRY BIONDO incorporated TIPSYP SPA AND SALON INC., in order to operate the Wellington Nail Spa and Salon.

**BARRY BIONDO's Breach of the Business Sale Agreement, Infringement
on Plaintiff's "Tippy" Mark, and Misrepresentations to the USPTO**

23. In direct violation of Plaintiff's rights, and in contravention of the express terms of the Business Sale Agreement, BARRY BIONDO and the TIPSYP SPA AND SALON INC., continued to use the "Tippy" Mark and "Tippy" name after March 11, 2011.

24. BARRY BIONDO and the TIPSYP SPA AND SALON INC., continue to use a mark that is identical or confusingly similar to Plaintiff's "Tippy" Mark, in connection with Defendants' nail salon and spa² services, which include bar services, and in direct competition with Plaintiffs' business.

25. The Defendants are improperly using an identical or substantially similar counterfeit "Tippy" mark on their business facade, in print advertising, in television advertising, on the Internet under www.Tipsyspa.com, on the Internet in search engines, on the Internet in their web sites' metatags, and in other mediums. See **Composite Exhibit "3"** for examples of Defendants' continued use of Plaintiff's name and Mark.

26. Further, BARRY BIONDO has failed to pay the amounts due and owing under the

² BARRY BIONDO has now relocated the Wellington Nail Spa and Salon to 10120 Forest Hill Blvd., Suite 100, Wellington, Florida 33414.

Business Sale Agreement.

27. In a blatant attempt to circumvent Plaintiff's rights in the "Topsy" Mark, BARRY BIONDO, d/b/a TIPSY SPA AND SALON, filed a federal trademark application for "Topsy Spa Salon." A true and correct copy of BARRY BIONDO's trademark application dated March 21, 2011, serial number 85272051, is attached hereto as **Exhibit "4."**

28. The federal trademark application filed by BARRY BIONDO, d/b/a TIPSY SPA AND SALON, was filed on March 21, 2011, a mere ten days after BARRY BIONDO was required to cease using Plaintiff's "Topsy" Mark.

29. In connection with the application for the federal trademark, BARRY BIONDO falsely swore to the USPTO the following declaration:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

30. Defendants are continuing to intentionally and improperly use an identical or substantially similar counterfeit to Plaintiff's "Topsy" Mark in connection with their nail and salon business, in direct competition with Plaintiffs.

31. The "Topsy" mark being used by the Defendants is identical or confusingly similar to

Plaintiff's "Topsy" Mark.

32. Defendants' use of an identical or substantially similar counterfeit "Topsy" name and mark is an intentional attempt to confuse the public into believing the Defendants' business and services are associated with Plaintiff's business and services.

33. The Defendants' intentional use of the identical or substantially similar counterfeit "Topsy" Mark is causing substantial customer confusion as to the sponsorship of the goods and services, and harming the reputation of Plaintiff's business and the "Topsy" Mark.

34. Defendants are intentionally attempting to palm off the name and reputation of Plaintiff's "Topsy" Mark and are creating a false designation of the origin of Defendants' services.

35. Defendants are direct competitors of Plaintiffs.

36. As of the filing date of this Verified Complaint, the Defendants are continuing to use an identical or substantially similar "Topsy" Mark.

37. Plaintiffs' have retained the undersigned law firm and have agreed to pay it a reasonable fee for the services related to this matter.

38. All conditions precedent to the initiation and maintenance of this action have been performed, have occurred, are excused, or have been waived.

39. Plaintiffs' are entitled to their costs and attorneys fees in this action pursuant to the Business Sale Agreement, and 15 U.S.C. § 1117.

Count I
(Trademark Infringement Under Section 32(1) of the
Lanham Act (15 U.S.C. §1114))

40. Plaintiff, THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set

forth herein.

41. This is a claim for damages and injunctive relief under the Lanham Act by Plaintiff THANH NGUYEN, against all Defendants.

42. The “Topsy” Mark, and the goodwill of the business associated with it in the State of Florida and throughout the United States, are of great and incalculable value, are highly distinctive and arbitrary, and have become universally associated in the public mind with the services of the very highest quality and reputation in spa and salon services with bar services in the “Topsy” Mark.

43. Without THANH NGUYEN’S authorization or consent, and having knowledge of THANH NGUYEN’S well-known and prior rights in the “Topsy” Mark, Defendants have advertised, marketed, and offered services in or affecting interstate commerce using the infringing “Topsy” Mark to the consuming public in direct competition with THANH NGUYEN’S “Topsy” Mark long after the March 11, 2011, date on which Defendant, BARRY BIONDO was required to cease using the “Topsy” Mark under the Agreement.

44. Defendants’ use of copies, counterfeits, or colorable imitations of the “Topsy” Mark in the form of the infringing mark is likely to cause and is causing confusion, mistake and deception among the general purchasing public, including initial interest confusion.

45. Defendants’ unauthorized use of the infringing mark on or in connection with its services was done with notice and full knowledge that such was not authorized or licensed by THANH NGUYEN after March 11, 2011. Defendants have used and continue to willfully use the infringing mark with the intent to confuse, mislead, or deceive customers, purchasers, and members of the general public as to the origin, source, sponsorship, or affiliation of Defendants’ salon

services, and with the intent to trade on the “Topsy” Mark’s reputation and goodwill.

46. As a direct and proximate result of Defendants’ conduct, THANH NGUYEN has suffered damage to its valuable “Topsy” Mark, and other damages, in an amount that exceeds \$75,000.

47. THANH NGUYEN does not have an adequate remedy at law, and will continue to be damaged by Defendants’ actions unless this Court enjoins Defendants from such business practices.

WHEREFORE, Plaintiff, THANH NGUYEN, respectfully requests this Court enter Judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON INC., and in favor of Plaintiff THANH NGUYEN for the following:

- a. Granting, pursuant to 15 U.S.C. § 1117, an accounting, an award of the Defendants’ profits, and any other damages should the court find the award based on profits inadequate;
- b. Granting, pursuant to 15 U.S.C. §1117, an award of attorneys’ fees, and costs;
- c. Granting an award of damages, exemplary damages consisting of treble damages and punitive damages in an amount sufficient to deter the Defendants from engaging in unlawful conduct in the future, pre-and post-judgment interest, costs and attorneys’ fees;
- d. Granting a temporary, preliminary, and permanent injunction preventing BARRY BIONDO, TIPSY SPA AND SALON, INC., and their agents with knowledge of this injunction, from further engaging in the unlawful conduct

set forth in this Complaint;

- e. Granting all further relief this court finds equitable and just.

Count II

(False Designation of Origin under Lanham Act 43(a) (15 U.S.C. § 1125(a))

48. Plaintiff THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

49. THANH NGUYEN is the sole owner of the “Topsy” Mark. The “Topsy” Mark is arbitrary, fanciful or suggestive marks. The “Topsy” Mark has come to symbolize the reputation for quality and excellence in spa and salon services, and THANH NGUYEN has build up and owns valuable goodwill that is symbolized by the “Topsy” Mark. Members of and consumers in the market for luxury spa and salon services which also feature bar services identify the “Topsy” Mark as the source of that service which employs use of the “Topsy” Mark.

50. Defendants’ use of reproductions, copies, counterfeits, or colorable imitations of the “Topsy” Mark in the form of the infringing mark constitute false designations of the origin and/or sponsorship of Defendants’ services in violation of Section 43(a) of the Lanham Act.

51. Defendants’ unauthorized use of the infringing mark on or in connection with Defendants’ services, as alleged above, is likely to confuse, mislead, or deceive customers, purchasers, and members of the general public as to the origin, source, sponsorship, or affiliation of Defendants’ services, including as to initial interest confusion, and is likely to cause such people to believe in error that Defendants’ services have been authorized, sponsored, approved, endorsed, or licensed by THANH NGUYEN, or that Defendants are in some way affiliated with THANH NGUYEN.

52. Defendants unauthorized use of the infringing mark on or in connection with its services was done with notice and full knowledge that such use was not authorized or licensed by THANH NGUYEN. Defendants have used and continue to use the infringing mark with the intent to confuse, mislead, or deceive customers, purchasers, and members of the general public as to the origin, source, sponsorship, or affiliation of Defendants' services, and with the intent to trade on THANH NGUYEN'S reputation and goodwill.

53. As a direct and proximate result of Defendants' conduct, THANH NGUYEN has suffered damage to its valuable "Topsy" Mark, and other damages, in an amount that exceeds \$75,000.

54. THANH NGUYEN does not have an adequate remedy at law, and will continue to be damaged by Defendants' actions unless this Court enjoins Defendants from such business practices.

WHEREFORE, Plaintiff THANH NGUYEN, respectfully request this Court enter Judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON INC., and in favor of Plaintiff, THANH NGUYEN, for the following:

- a. Granting, pursuant to 15 U.S.C. § 1116, a temporary, preliminary and permanent injunction prohibiting Defendants or their respective officers, agents, servants, employees, and/or all other persons, businesses or entities acting in concert or participation with them from 1) using Plaintiff's "Topsy" name or the "Topsy" Mark or any confusingly similar variations thereof, alone or in combination with any other letters, words, letter strings, phrases, or designs, in commerce or in connection with any business or for any other purpose (including, but not limited to, on building facades, print advertising,

television advertising, radio advertising, websites and/or domain names); 2) transferring, assigning, selling, or attempting the disposition of Plaintiff's "Topsy" name or "Topsy" Mark to any third party; and 3) whatever other injunctive relief this court deems reasonable and just according to the principals of equity;

- b. Granting, pursuant to 15 U.S.C. §1118, an order permanently enjoining and directing Defendants and their respective officers, agents, servants, employees, and/or all other persons, businesses or entities acting in concert or participation with them, to deliver up for destruction all promotional materials, building facades, handouts, advertisements, labels, signs, prints, packages, wrappers, photographs, videos, truck or vehicle paintings or logos, websites, internet marketing, software, business cards, or any other reproduction, copy, or confusingly similar variations of Plaintiff's "Topsy" Mark, and all plates, molds, matrices, and other means of making or duplicating the same;
- c. Granting, pursuant to 15 U.S.C. §1117, an award of actual damages in an amount to be proven at trial but in no event less than \$75,000, such amount to be trebled pursuant to 15 U.S.C. §1117(a), for an accounting, disgorgement and restitution by Defendants to THANH NGUYEN of all amounts derived by Defendants by virtue of its unlawful conduct, such amount to be trebled pursuant to 15 U.S.C. §1117(a), punitive damages, prejudgment interest,

attorneys' fees and costs; and

- d. Granting all further relief that this Court finds equitable and just.

Count III
(Cybersquatting-Damages)

55. Plaintiff THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

56. This is a claim for damages for Cybersquatting by Plaintiff, THANH NGUYEN, against all Defendants.

57. Defendants' have a bad faith intent to profit from the "Topsy" Mark.

58. Defendants have registered, traffic in, and use a domain name, www.Tipsyspa.com that is identical, confusingly similar, or dilutive of the "Topsy" Mark.

59. As a direct and proximate result of the Defendants' conduct, Plaintiff, THANH NGUYEN, has suffered, and will continue to suffer, monetary damages.

WHEREFORE, Plaintiff THANH NGUYEN, respectfully requests this Court enter Judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON INC., and in favor of Plaintiff for the following:

- a. Granting, pursuant to 15 U.S.C. § 1117, an accounting and an award of the Defendants' profits, damages sustained by Plaintiff, THANH NGUYEN, the costs of this action, and any other damages should the court find the award based on profits inadequate;
- b. Granting, pursuant to 15 U.S.C. §1117, an award of attorneys' fees;
- c. Granting an award of damages, exemplary damages consisting of treble

damages and punitive damages in an amount sufficient to deter the Defendants from engaging in unlawful conduct in the future, pre-and post-judgment interest, costs and attorneys' fees;

d. Granting all further relief this court finds equitable and just.

**Count IV
(Cybersquatting - Injunction)**

60. Plaintiff, THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

61. This is a claim by THANH NGUYEN, against Defendants, for injunctive relief to prevent Cybersquatting.

62. Defendants have a bad faith intent to profit from the “Topsy” Mark.

63. Defendants have registered, traffic in, and use a domain name, www.Tipsyspa.com that is identical, confusingly similar, or dilutive of the “Topsy” Mark.

64. As a direct and proximate result of the Defendants’ conduct, Plaintiff, THANH NGUYEN, has suffered, and will continue to suffer irreparable injury to his business, reputation, and goodwill.

WHEREFORE, Plaintiff, THANH NGUYEN, respectfully requests this Court enter Judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON INC., and in favor of Plaintiff THANH NGUYEN, for the following:

a. Granting, pursuant to 15 U.S.C. § 1116, a temporary and permanent injunction prohibiting Defendants or their respective officers, agents,

servants, employees, and/or all other persons, businesses or entities acting in concert or participation with them from 1) using the “Topsy” Mark or any confusingly similar variations thereof on the Internet or on a domain name, alone or in combination with any other letters, words, letter strings, phrases, or designs, in commerce or in connection with any business or for any other purpose and 2) whatever other injunctive relief this court deems reasonable and just according to the principals of equity;

- b. Granting, pursuant to 15 U.S.C. §1117, an award of attorneys’ fees; and
- c. Granting all further relief this court finds equitable and just.

**Count V
(Unjust Enrichment)**

65. Plaintiff, THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

66. This is a claim by THANH NGUYEN, against Defendants, for unjust enrichment.

67. As a direct and proximate result of the Defendants’ conduct complained of herein, Plaintiff, THANH NGUYEN, has suffered and will continue to suffer loss of reputation, and pecuniary damages.

68. Plaintiff, THANH NGUYEN, has created value and generated goodwill in the “Topsy” Mark.

69. The Defendants have traded on this value and goodwill, and on THANH NGUYEN’s reputation through deceptive, unfair and unlawful practices in using Plaintiff’s “Topsy” Mark after March 11, 2011.

70. As a result of the Defendants' actions, a benefit has been bestowed upon the Defendants and the Defendants have realized and generated economic and other benefits at THANH NGUYEN's expense.

71. Plaintiff, THANH NGUYEN, has not authorized, acquiesced in, or otherwise agreed to the Defendants' use of the Plaintiff's "Topsy" Mark past March 11, 2011.

72. It would be inequitable for the Defendants to retain the benefits accrued through their unlawful conduct.

WHEREFORE, Plaintiff THANH NGUYEN, respectfully requests this Court enter judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON INC., for damages, interest, and for any other relief this Court deems equitable and just.

Count VI
(Breach of Contract- Damages)

73. THANH NGUYEN and LUONG NGUYEN re-allege and affirm paragraphs 1 through 39 as if set forth herein.

74. THANH NGUYEN, LUONG NGUYEN and BARRY BIONDO entered into the Business Sale Agreement on or about March 11, 2010.

75. BARRY BIONDO has materially breached the Business Sale Agreement by continuing to use the "Topsy" name and "Topsy" Mark in connection with the Defendants' business and services after March 11, 2011.

76. BARRY BIONDO has materially breached the Business Sale Agreement by continuing to use the "Topsy" name and "Topsy" Mark in connection with the Defendants' business

and services after March 11, 2011.

77. BARRY BIONDO has materially breached the Business Sale Agreement by failing to pay the amounts due and owing under the Business Sale Agreement.

78. BARRY BIONDO has materially breached the Business Sale Agreement by failing to redirect the domain name www.Tipsyspa.com to a domain name that does not include the "Topsy" name and Mark.

79. THANH NGUYEN and LUONG NGUYEN have suffered damages as a result of BARRY BIONDO's breach of contract.

80. Pursuant to the Business Sale Agreement, THANH NGUYEN and LUONG NGUYEN are entitled to their attorneys' fees and costs in this action.

WHEREFORE, Plaintiffs, THANH NGUYEN and LUONG NGUYEN, respectfully request this Court enter judgment against Defendant BARRY BIONDO for damages, punitive damages, attorneys fees and costs, interest to the fullest extent permissible by Florida law, and for any other relief this Court deems equitable and just.

Count VII
(Breach of Contract- Injunction)

81. Plaintiffs, THANH NGUYEN and LUONG NGUYEN, re-allege and affirm paragraphs 1 through 39 as if set forth herein.

82. This is a cause of action for both temporary and permanent injunctions in favor of Plaintiffs THANH NGUYEN and LUONG NGUYEN, to enjoin Defendant, BARRY BIONDO'S continued use of the "Topsy" Mark.

83. Defendant, BARRY BIONDO, agreed not to use Plaintiff, THANH NGUYEN'S

“Topsy” Mark one (1) year after the execution of the Business Sale Agreement.

84. BARRY BIONDO is violating the Agreement by continuing to use the “Topsy” Mark in conjunction with his spa and salon after March 11, 2011.

85. Plaintiffs, THANH NGUYEN and LUONG NGUYEN, have no adequate remedy at law.

86. The issuance of an injunction is in the public interest.

87. The Defendants’ acts, unless restrained by the Court, have and will continue to cause irreparable injury to THANH NGUYEN and to the public.

88. Plaintiffs are likely to succeed on the merits.

WHEREFORE, Plaintiffs THANH NGUYEN and LUONG NGUYEN, respectfully request this Court enter Judgment against Defendants BARRY BIONDO and TIPSY SPA AND SALON, INC., and in favor of Plaintiffs THANH NGUYEN and LUONG NGUYEN, granting them a preliminary and permanent injunction preventing Barry Biondo, Topsy Spa and Salon, Inc., and any agents of Defendants with notice of the injunction from using the “Topsy” Mark in connection with their spa and salon services, attorney fees and costs.

Count VIII
(Common Law Trademark Infringement)

89. Plaintiff, THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

90. Defendants conduct as described above constitutes trademark infringement and passing off in violation of the common law of the State of Florida.

91. Defendants acts of trademark infringement constitute intentional misconduct and/or

gross negligence within the meaning of Fla. Stat. § 768.72(2)(a)-(b), entitling THANH NGUYEN to both compensatory damages in an amount to be determined at trial, but in no event less than \$75,000, and punitive damages under the common law and under Fla. Stat. § 768.72.

92. THANH NGUYEN does not have an adequate remedy at law, and will continue to be damaged by Defendants' actions unless this Court enjoins Defendants from such business practices.

93. THANH NGUYEN has a clear legal right to injunctive relief.

WHEREFORE, THANH NGUYEN respectfully requests this Court enter a permanent injunction preventing BARRY BIONDO, TIPSY SPA AND SALON, INC., and any agents of Defendants with knowledge of the injunction from using the "Topsy" Mark in connection with their spa and salon services, damages, punitive damages, prejudgment interest, attorney's fees and costs.

Count IX
(Trademark Dilution, Fla. Stat. § 495.151 et seq.)

94. Plaintiff, THANH NGUYEN, re-alleges and affirms paragraphs 1 through 39 as if set forth herein.

95. Plaintiff, THANH NGUYEN is the sole owner of the "Topsy" Mark. THANH NGUYEN has used and continues to use the "Topsy" Mark in commerce, including in Florida and in interstate commerce.

96. Defendants actions as described above have caused and will cause injury to THANH NGUYEN'S business reputation and/or dilution of the distinctive quality of the "Topsy" Mark as defined in Fla. Stat. § 495.151.

97. As a direct and proximate result of Defendants' conduct, THANH NGUYEN has suffered damage to its valuable "Topsy" Mark, and other damages.

98. THANH NGUYEN does not have an adequate remedy at law, and will continue to be damaged by Defendants' actions unless this Court enjoins Defendants from such business practices.

WHEREFORE, THANH NGUYEN respectfully requests that this Court enter an injunction against Defendants BARRY BIONDO and TIPSY SPA AND SALON, INC. and any agents of Defendants with knowledge of the injunction from using the "Topsy" Mark in connection with their spa and salon services, damages, attorney's fees and costs, and such further relief this Court finds equitable and just.

Respectfully submitted,

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.
1000 S.E. Monterey Commons Blvd., Suite 306
Stuart, Florida 34996
Tel (772) 221-7757 / Fax (772) 781-6886
Attorneys for the Plaintiffs, Thanh Nguyen and Luong Nguyen

By: /s/ Scott Konopka
SCOTT KONOPKA, ESQ.
Florida Bar No. 080489
E-mail: skonopka@pm-law.com
PAIGE HARDY, ESQ.
Florida Bar No. 58967
E-mail: phardy@pm-law.com

SERVICE LIST

THANH NGUYEN AND LUONG NGUYEN

vs.

BARRY BIONDO AND TIPSYP SPA AND SALON, INC.

CASE NO: 9:11-CV-81156-MIDDLEBROOKS

United States District Court, Southern District of Florida

Timothy L. Grice, Esq.
Timothy L. Grice, P.A.
319 Clematis Street
Suite 213
West Palm Beach, FL 33401
Tel (561) 802-4474 / Fax (561) 208-1303
*Attorney for the Defendants, Barry Biondo
and Tipsy Spa and Salon Inc.*

Scott Konopka, Esquire
Email: skonopka@pm-law.com
Page, Mrachek, Fitzgerald & Rose, P.A.
1000 SE Monterey Commons Blvd.
Suite 306
Stuart, FL 34996
Tel (772) 221-7757 / Fax (772) 781-6886
*Attorneys for the Plaintiffs, Thanh Nguyen
and Luong Nguyen*

Paige Hardy, Esquire
Email: phardy@pm-law.com
Page, Mrachek, Fitzgerald & Rose, P.A.
1000 SE Monterey Commons Blvd.
Suite 306
Stuart, FL 34996
Tel (772) 221-7757 / Fax (772) 781-6886
*Attorneys for the Plaintiffs, Thanh Nguyen
and Luong Nguyen*

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Complaint_Filed as Exhibit.doc

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
WEST PALM BEACH DIVISION**

THANH NGUYEN, et al.,

CASE NO. 11-81156 - CIV-
MIDDLEBROOKS/JOHNSON

Plaintiffs,

v.

BARRY BIONDO, an individual, TIPSY SPA
AND SALON INC., a Florida Corporation,.,

Defendants.

**DEFENDANTSS. BARRY BIONDO'S AND TIPSY SPA AND SALON INC.'S
ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM**

Defendants, BARRY BIONDO, an individual, and TIPSY SPA AND SALON INC., a Florida corporation, (hereinafter "Defendants"), through their undersigned counsel, answers Plaintiff's Complaint as follows:

1. Defendants without sufficient knowledge of the allegations in paragraph 1 to admit or deny, and therefore denies.
2. Defendants without sufficient knowledge of the allegations in paragraph 2 to admit or deny, and therefore denies.
3. Defendants without sufficient knowledge of the allegations in paragraph 3 to admit or deny, and therefore denies.
4. Defendants without sufficient knowledge of the allegations in paragraph 4 to admit or deny, and therefore denies.
5. Defendants without sufficient knowledge of the allegations in paragraph 5 to admit or deny, and therefore denies.
6. Defendants without sufficient knowledge of the allegations in paragraph 6 to admit or deny, and therefore denies.
7. Defendants without sufficient knowledge of the allegations in paragraph 7 to admit or deny, and therefore denies.

8. Defendants without sufficient knowledge of the allegations in paragraph 8 to admit or deny, and therefore denies.
9. Defendants admit the allegations in paragraph 9.
10. Defendants admit the allegations in paragraph 10.
11. Defendants without sufficient knowledge of the allegations in paragraph 11 to admit or deny, and therefore denies.
12. Defendants without sufficient knowledge of the allegations in paragraph 12 to admit or deny, and therefore denies.
13. Defendants deny the allegations in paragraph 13.
14. Defendants without sufficient knowledge of the allegations in paragraph 14 to admit or deny, and therefore denies.
15. Defendants without sufficient knowledge of the allegations in paragraph 15 to admit or deny, and therefore denies.
16. Defendants without sufficient knowledge of the allegations in paragraph 16 to admit or deny, and therefore denies.
17. Defendants without sufficient knowledge of the allegations in paragraph 17 to admit or deny, and therefore denies.
18. Defendants without sufficient knowledge of the allegations in paragraph 18 to admit or deny, and therefore denies.
19. Defendants without sufficient knowledge of the allegations in paragraph 19 to admit or deny, and therefore denies.
20. Defendants deny the allegations in paragraph 20.
21. Defendants deny the allegations in paragraph 21.
22. Defendants admit the allegations in paragraph 22.
23. Defendants deny the allegations in paragraph 23.
24. Defendants deny the allegations in paragraph 24.
25. Defendants deny the allegations in paragraph 25.
26. Defendants deny the allegations in paragraph 26.
27. Defendants deny the allegations in paragraph 27.
28. Defendants deny the allegations in paragraph 28.
29. Defendants deny the allegations in paragraph 29.

30. Defendants deny the allegations in paragraph 30.
31. Defendants deny the allegations in paragraph 31.
32. Defendants deny the allegations in paragraph 32.
33. Defendants deny the allegations in paragraph 33.
34. Defendants deny the allegations in paragraph 34.
35. Defendants deny the allegations in paragraph 35.
36. Defendants deny the allegations in paragraph 36.
37. Defendants without sufficient knowledge of the allegations in paragraph 37 to admit or deny, and therefore denies.
38. Defendants deny the allegations in paragraph 38.
39. Defendants without sufficient knowledge of the allegations in paragraph 39 to admit or deny, and therefore denies.

Count I

(Trademark Infringement Under Section 32(1) of the Lanham Act (15 U.S.C. §1114)

40. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.
41. Defendants are without sufficient knowledge of the allegations in paragraph 41 to admit or deny, and therefore denies.
42. Defendants without sufficient knowledge of the allegations in paragraph 42 to admit or deny, and therefore denies.
43. Defendants deny the allegations in paragraph 43.
44. Defendants deny the allegations in paragraph 44.
45. Defendants deny the allegations in paragraph 45.
46. Defendants deny the allegations in paragraph 46.
47. Defendants deny the allegations in paragraph 47.

Count II

(False Designation of Origin under Lanham Act 43(a) (15 U.S.C. § 1125(a))

48. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

49. Defendants are without sufficient knowledge of the allegations in paragraph 49 to admit or deny, and therefore denies.

50. Defendants deny the allegations in paragraph 50

51. Defendants deny the allegations in paragraph 51.

52. Defendants deny the allegations in paragraph 52.

53. Defendants deny the allegations in paragraph 53.

54. Defendants deny the allegations in paragraph 54.

Count III

(Cybersquatting- Damages)

55. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

56. Defendants without sufficient knowledge of the allegations in paragraph 60 to admit or deny, and therefore denies.

57. Defendants deny the allegations in paragraph 57.

58. Defendants deny the allegations in paragraph 58.

59. Defendants deny the allegations in paragraph 59.

Count IV

(Cybersquatting – Injunction)

60. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

61. Defendants without sufficient knowledge of the allegations in paragraph 61 to admit or deny, and therefore denies.

62. Defendants deny the allegations in paragraph 62.

63. Defendants deny the allegations in paragraph 63.

64. Defendants deny the allegations in paragraph 64.

Count V

(Unjust Enrichment)

65. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

66. Defendants without sufficient knowledge of the allegations in paragraph 66 to admit or deny, and therefore denies.

67. Defendants deny the allegations in paragraph 67.

68. Defendants without sufficient knowledge of the allegations in paragraph 68 to admit or deny, and therefore denies.

69. Defendants deny the allegations in paragraph 69.

70. Defendants deny the allegations in paragraph 70.

71. Defendants deny the allegations in paragraph 71.

72. Defendants deny the allegations in paragraph 72.

Count VI

(Breach of Contract - Damages)

73. Defendant, BARRY BIONDO, adopts and re-alleges responses to allegations in paragraphs 1-39 as if fully stated herein.

74. Defendant, BARRY BIONDO, admit the allegations in paragraph 74.

75. Defendant, BARRY BIONDO, denies the allegations in paragraph 75.

76. Defendant, BARRY BIONDO, denies the allegations in paragraph 76.

77. Defendant, BARRY BIONDO, denies the allegations in paragraph 77.

78. Defendant, BARRY BIONDO, denies the allegations in paragraph 78.

79. Defendant, BARRY BIONDO, denies the allegations in paragraph 79.

80. Defendant, BARRY BIONDO, denies the allegations in paragraph 80.

Count VII

(Breach of Contract- Injunction)

81. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

82. Defendants without sufficient knowledge of the allegations in paragraph 82 to admit or deny, and therefore denies.

83. Defendants deny the allegations in paragraph 83.

84. Defendants deny the allegations in paragraph 84.

85. Defendants deny the allegations in paragraph 85.

86. Defendants deny the allegations in paragraph 86.

87. Defendants deny the allegations in paragraph 87.

88. Defendants deny the allegations in paragraph 88.

Count VIII

(Common Law Trademark Infringement)

89. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

90. Defendants deny the allegations in paragraph 90.

91. Defendants deny the allegations in paragraph 91.

92. Defendants deny the allegations in paragraph 92.

93. Defendants deny the allegations in paragraph 93.

Count IX

(Trademark Dilution, Fla. Stat. § 495.151 *et seq.*)

94. Defendants adopt and re-allege responses to allegations in paragraphs 1-39 as if fully stated herein.

95. Defendants without sufficient knowledge of the allegations in paragraph 95 to admit or deny, and therefore denies.

96. Defendants deny the allegations in paragraph 96.

97. Defendants deny the allegations in paragraph 97.

98. Defendants deny the allegations in paragraph 98.

FIRST AFFIRMATIVE DEFENSE

Defendants or related third parties were authorized to use the trademarks and service marks alleged pursuant to the Lanham Act.

SECOND AFFIRMATIVE DEFENSE

The goodwill of the trademarks and service marks identified in the Complaint is not exclusively owned by Plaintiff and accordingly, some or all of Plaintiffs' claims are barred.

THIRD AFFIRMATIVE DEFENSE

Plaintiff does not have exclusive rights and privileges in some or all of the trademarks and service marks identified in the Complaint.

FOURTH AFFIRMATIVE DEFENSE

Some or all of Plaintiff's claims are barred by the doctrine of equitable estoppel.

FIFTH AFFIRMATIVE DEFENSE

Some or all of Plaintiff's claims is barred by the doctrine of laches.

SIXTH AFFIRMATIVE DEFENSE

Plaintiff does not have clear title to all or some of the trademarks and service marks, and therefore lack standing to bring the claims asserted in the Complaint.

SEVENTH AFFIRMATIVE DEFENSE

Defendants are entitled to a setoff as a result of Plaintiff's prior breach of the business sale agreement and other related agreements.

EIGHTH AFFIRMATIVE DEFENSE

Some or all of Plaintiffs' claims are barred by the doctrine of unclean hands.

NINTH AFFIRMATIVE DEFENSE

Some or all of Plaintiff's claims are barred by virtue of their prior breach of the business sale agreement with Defendants or related third parties.

TENTH AFFIRMATIVE DEFENSE

Some or all of Plaintiff's claims are barred by their wrongful and/or unlawful acts of duress where the Defendants were coerced into entering into a contract; where the Defendants were threatened and pressured with physical and economical harm, and damage to services.

DEFENDANTS' COUNTERCLAIM

Defendants, BARRY BIONDO, an individual, and TIPSY SPA AND SALON INC., a Florida corporation, (hereinafter "Defendants"), through their undersigned counsel, countersue Plaintiff's, THANH NGUYEN, an individual, and LOUNG NGUYEN, an individual, (hereinafter collectively refer to as "Plaintiffs") for fraudulent procurement of Federal Registered Trademark, Breach of Contract and Breach of Implied Warranty of Fair Dealings, and in support thereof state as follows:

JURISDICTION

1. The Court has supplemental jurisdiction of this Counterclaim under 28 U.S.C. § 1367(a) because it arises out of the same transaction and occurrence alleged in the plaintiff's complaint so as to form a part of the same case or controversy within the meaning of Article III of the United States Constitution.
2. The Court has original subject matter jurisdiction over this Counterclaim pursuant to 15 U.S.C. § 1120 because it is federal question arising under the Section 38 of the Lanham Act.

COUNT I

(Federal Trademark Registration with False or Fraudulent Representations)

3. On January 29, 2007, Plaintiff, THANH NGUYEN, applied for a federal trademark for the "Topsy" mark; and on the application for the said federal trademark the Plaintiff stated that the services provided in connection with his mark "Topsy" were "nail,

hair cutting and spa services; bar services". A true and correct copy of the Plaintiff's application for "Topsy" mark is attached hereto and incorporated herein as **Exhibit 1**.

4. At the same time the Plaintiff, THANH NGUYEN, filed the above mentioned federal trademark application for the "Topsy" Mark, he submitted specimens identifying his use of his mark in commerce. A true and correct copy of these specimens are attached hereto and incorporated herein as **Exhibit 2**.

5. On May 17, 2007, United States Patent and Trademark Office (USPTO) filed their first office action refusing the Plaintiff's application for the "Topsy" mark, for several reasons where one being the following :

Definite Recitation of Services Requirements

Amendment of Recitation

"The wording "nail" and "spa" in the identification of services is indefinite and must be clarified. Applicant must amend this wording to specify the common commercial or generic name for the services. If there is no common commercial or generic name for the services, then applicant must describe the nature of the services as well as their main purpose, channels of trade, and the intended consumer(s).

The applicant may adopt the following identification and classification, if accurate: "Nail care salons, hair cutting services and health spa services, namely cosmetic body care services; bar services in International Class 44."

(A true and correct copy of the First Office Action is attached as **Exhibit 3**.)

6. On November 20, 2007, the Plaintiff filed a response to the USPTO office action objecting to their other refusals mentioned in the office action but accepting the USPTO suggestion to the amendment of the services requirements for the "Topsy" mark. (A true and correct copy of this Plaintiff's Response to First Office Action is attached as **Exhibit 4**.)

7. Moreover on January 04, 2008, the Plaintiff amended his application for the "Tipsy" mark to reflect that the services connected with the "Tipsy" mark are "Nail care salons, hair cutting services and health spa services, namely cosmetic body care services; bar services in International Class 44." (A true and correct copy of this Plaintiff's First Amendment to his Federal Trademark Application is attached as **Exhibit 5.**)

8. On January 09, 2008, USPTO filed their second office action refusing the Plaintiff's application for the "Tipsy" mark, for likelihood of confusion with other federally registered trademarks, more specifically the following was stated:

The applicant's (Plaintiff, THANG NGUYEN) services, "nail care salons, hair cutting services and health spa services, namely, cosmetic body care services", is related to registrant's goods, "hair styling preparations, hair care preparations", because the goods and services involve nail, hair and cosmetic body care. Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. (A true and correct copy of the Second Office Action is attached as **Exhibit 6.**)

9. On July 11, 2008, the Plaintiff filed a response to the USPTO second office action objecting to their refusal, but amending the identification of services connected with the "Tipsy" to delete "Nail care salons, hair cutting services and health spa services, namely cosmetic body care services" leaving only "bar services". (A true and correct copy of this Plaintiff's Response to Second Office Action is attached as **Exhibit 7.**)

10. Moreover on July 15, 2008, the Plaintiff amended his application for the "Tipsy" mark to delete "Nail care salons, hair cutting services and health spa services, namely cosmetic body care services" leaving only "bar services". (A true and correct copy of this Plaintiff's Second Amendment to his Federal Trademark Application is attached as **Exhibit 6.**)

11. After which on November 11, 2008, USPTO granted the Plaintiff's federal trademark for the "Tipsy" mark for services connected with bar services.

12. Plaintiff intentionally deceived the USPTO by deleting services (Nail care salons, hair cutting services and health spa services, namely cosmetic body care services) that they were and currently are providing in connection with their "Topsy" mark from his federal trademark application for the "Topsy" mark to avoid USPTO refusal of the application.

13. The USPTO would not have granted the Plaintiff's trademark application for the "Topsy" mark if he had not misrepresented that his services in connection with the "Topsy" was limited to bar services.

WHEREFORE, Defendants respectfully requests that this Court enter judgment in favor of Defendants against the Plaintiffs and grant the following relief:

- a. General and compensatory damages, and loss of profits from the Plaintiffs, jointly and severally, pursuant to *15 U.S.C. § 1117*.
- b. Attorney fess and costs from Plaintiffs, jointly and severally, pursuant to *15 U.S.C. § 1117*.
- c. Cancellation of the Plaintiff Federal Trademark Registration pursuant to *15 U.S.C. § 1064(3)*.
- d. Exemplary and punitive damages from the Plaintiffs, jointly and severally.
- e. That the Defendants be granted such other and further relief as this Court may deem just and proper.

WHEREFORE, having fully answered the FIRST AMENDED Complaint, the Defendants, TIPSY SPA AND SALON INC. and BARRY BIONDO, and pray for the relief as stated in their Counterclaim, and the Defendants has retained the services of the undersigned attorney and are obligated to pay their attorney reasonable attorneys' fees and costs, and Defendants hereby demand a trial by jury of all issues so triable by right.

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Document has been filed with the Clerk of the Court using its CM/ECF system and CM/ECF system will send a notice of the electronic filing to the following:

Scott W. Konopka, Esq.
Page Mrachek Fitzgerald & Rose
1000 SE Monterey Commons Boulevard
Suite 306
Stuart, FL 34996
772-221-7757
Fax: 772-781-6886
Email: skonopka@pm-law.com
Attorney for Plaintiffs

Dated: March 8, 2012

/s/ Timothy L. Grice
Timothy L. Grice, Esq.
Attorney for Defendantss
Law Office of Timothy L. Grice, P.A.
319 Clematis Street - Suite 213
West Palm Beach, FL 33401
Telephone: (561) 802-4474
Facsimile: (561) 208-1303
Email: TGrice@TimothyGriceLaw.com

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No.: 9:11-CV-81156-MIDDLEBROOKS

THANH NGUYEN, an individual, and
LUONG NGUYEN, an individual,

Plaintiffs,

v.

BARRY BIONDO, an individual,
TIPSY SPA AND SALON INC., a Florida corporation,

Defendants.

**PLAINTIFFS, THANH AND LUONG NGUYENS', MOTION TO DISMISS
DEFENDANTS/COUNTER-PLAINTIFFS' COUNTERCLAIM FOR FEDERAL
TRADEMARK REGISTRATION WITH FALSE OR FRAUDULENT
REPRESENTATIONS**

Plaintiffs, THANH NGUYEN and LUONG NGUYEN, by and through their undersigned attorneys, and pursuant to Federal Rule of Civil Procedure 12(b)(6), move to Dismiss Defendants/Counter-Plaintiffs', BARRY BIONDO and TIPSY SPA AND SALON INC., Counterclaim for "Federal Trademark Registration with False or Fraudulent Representation." In support, Plaintiffs state as follows:

A. Factual Background.

This case involves a dispute over the ownership and use of the service mark "Topsy" (the "Mark" or "Topsy Mark"), which is a federally registered service mark owned by Plaintiff, THANH NGUYEN. THANH NGUYEN and Defendant, BARRY BIONDO, are using the Topsy Mark to operate competing hair and nail salons in South Florida. The parties were previously in business

together. Plaintiff LUONG NGUYEN and Defendant BARRY BIONDO owned the Tippy Spa and Salon of Wellington, and the Plaintiffs and Defendant BARRY BIONDO operated the salon together. *See* D.E. 30. A dispute occurred after BARRY BIONDO removed LUONG NGUYEN as an officer and froze her out from the bank account. This led to the execution of a Business Sale Agreement, pursuant to which BARRY BIONDO agreed to buy the business from Plaintiffs, and to cease and desist from using the Mark after March 11, 2011. Instead of complying with the Business Sale Agreement, BARRY BIONDO refused to pay the amounts due, continued to use the Mark after March 11, 2011, and attempted to register his own virtually identical Tippy service mark under Florida and federal law.

Plaintiffs sued for infringement of the Tippy service mark and for breach of contract. Defendants have now asserted a Counterclaim against Plaintiffs for “Federal Trademark Registration with False or Fraudulent Representations.” The sole basis for the fraud claim is the following allegation in paragraph 13 of the Counterclaim: “The USPTO would not have granted the Plaintiffs’ trademark application for the ‘Tippy’ mark if he had not misrepresented that his services in connection with the ‘Tippy’ [mark] was limited to bar services.” There is no allegation that Counter-plaintiffs were injured by this conduct. The Counterclaim should be dismissed because Counter-plaintiffs lack standing to assert a fraud on the USPTO, and because they cannot assert sufficient facts to support a claim for fraud.

B. Legal Standard.

“A motion to dismiss a counterclaim pursuant to Federal Rule of Civil Procedure 12(b)(6) is evaluated in the same manner as a motion to dismiss a complaint.” *Fabricant v. Roebuck*, 202 F.R.D. 306, 308 (S.D. Fla. 2001). (citation omitted). “[T]he analysis of a 12(b)(6) motion is limited

primarily to the face of the complaint and attachments thereto.” *Id.* at 1368. In order to survive a motion to dismiss, the complaint must state a plausible claim for relief. *See Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556 (2007). The “plausibility standard” is met when a plaintiff “plead[s] factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949 (2009) (citing *Twombly*, 550 U.S. at 556). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Ashcroft*, 129 S Ct. at 1949.

In order to allege standing to assert a fraud in connection with a trademark application, ____.

“To establish a prima facie case of fraud in procuring a trademark registration, a party must show, by clear and convincing evidence, that: (1) the challenged statement was a false representation regarding a material fact; (2) the registrant knew the representation was false (scienter); (3) the registrant intended to deceive the PTO; (4) the PTO reasonably relied on the misrepresentation; and (5) the party suffered damages proximately resulting from such reliance.” *Pandora Jewelers 1995, Inc. v. Pandora Jewelry, LLC*, No. 09-61490-Civ., *14 (S.D. Fla. June 2, 2011) (citations omitted). According to 15 U.S.C. § 1120, “[a]ny person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.”

“A party that seeks the cancellation of a trademark registration for fraudulent procurement ‘bears a heavy burden of proof.’” *Id.* (quoting *In re Bose Corp.*, 580 F. 3d 1240, 1243 (Fed. Cir. 2009)). “[A]bsent the requisite intent to mislead the PTO, even a material misrepresentation would

not qualify as fraud under the Lanham Act warranting cancellation.” *Pandora Jewelers*, at *14 (quoting *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (T.T.A.B. 1981)). A challenge to a trademark registration puts the registrants subject belief at issue and failure to prove that element is dispositive of the claim. See *Pandora Jewelers*, at *14 (quoting *Stanfield v. Osborne Indus.*, 52 F. 3d 867, 874 (10th Cir. 1995)). For Defendants to prevail on a claim of fraud, “they must necessarily have proven a false material statement by the plaintiff of a fact that would have constituted grounds for denial of the registration had the truth been known.” *Citibank, N.A. v. Citibanc Group, Inc.*, 724 F. 2d 1540, 1544 (11th Cir. 1984). (citations omitted).

C. Argument.

i. Defendants’ Fail To State A Cause of Action Because They Lack Standing

In order to assert a claim for fraud on the USPTO, a plaintiff must allege that it was somehow damaged by the fraud. Here, Counter-plaintiffs simply allege at paragraph 13 of the Counterclaim that the USPTO would not have granted a trademark but for the fraud. There is no allegation that the Counter-plaintiffs were somehow damaged. Further, it would be impossible for Counter-plaintiffs to allege damages, because they contractually agreed to stop using the Mark well after the trademark was issued by the USPTO. The Business Sale Agreement specifically precluded Defendants from using the Mark. Prior to execution of the Business Sale Agreement, the parties operated the Topsy Spa and Salon of Wellington. Defendants *benefitted* from the use of Plaintiff’s “Topsy” Mark, and they continue to benefit from using Plaintiff’s Mark. Given that Counter-plaintiffs were benefitted and have been unable to allege any damages, they lack standing to assert a claim under 15 U.S.C. § 1120. Therefore, the Counterclaim should be dismissed.

ii. LUONG NGUYEN is not an owner of the Mark and therefore the claims against her should be dismissed.

Counter-Plaintiffs attempt to assert a claim for fraud against both THANH NGUYEN and his mother, LUONG NGUYEN, but the sole registrant and owner of the Mark is THANH NGUYEN. LUONG NGUYEN is not an owner of the Mark, and she did not file the application for the Mark. This is obvious from the USPTO filings attached to the Counterclaim. Therefore, there is no basis for a claim against LUONG NGUYEN, she is simply THANH NGUYEN's mother, and she should be dismissed from the Counterclaim.

iii. Defendants Have Not Asserted, and Cannot Assert, That There Was a Fraud on the USPTO

Counter-plaintiffs allege that THANH NGUYEN committed fraud when he disclaimed classification 44 (e.g., nail care salons, hair care services), but retained classification 43 (e.g. bar services) in his federal service mark application filed with the USPTO, then used the Mark to operate a hair and nail salon business that served beer and wine. The Counterclaim does not assert any specific fraudulent representation. Rather, the basis for the claim is that THANH NGUYEN would not have been granted a service mark had he informed the USPTO that he would use his Mark in connection with the disclaimed classification 44 (e.g., nail care salons, hair care services). This allegation is illogical and in contravention of the law on trademarks.

Unlike the registration of a patent, a trademark registration of itself does not create the underlying right to exclude. Nor is a trademark created by registration. While federal registration triggers certain substantive and procedural rights, the absence of federal registration does not unleash the mark to public use. The Lanham Act, (§1125(a)) protects unregistered marks as does the common law.

See San Juan Prods., Inc. v. San Juan Pools of Kansas, Inc., 849 F.2d 468, 474 (10th Cir. 1988).

Thus, even if the service mark registration were procured by fraud, which it was not, the underlying rights protect the rights in the mark.

Further, there is no prohibition on his use of the Mark within and beyond the classification of the service mark. It is not a fraud to use a registered service mark for services that are beyond those that are protected by federal law. *See Innovation Ventures, LLC v. Bhelliom Enterprises Corp.*, 2010 WL 3170080 *2 (E.D.Mich.2010). “[T]he rights of the owner of a registered trademark are not limited to protection with respect to the specific goods stated on the certificate ... but extend to any goods related in the minds of consumers in the sense that a single producer is likely to put out both goods.” *E. Remy Martin & Co., S.A. v. Shaw-Ross Intern. Imports, Inc.*, 756 F. 2d 1525, 1530 (11th Cir. 1985) (citations omitted). “The sole purpose of a classification of goods, however, is for internal administration within the PTO. The class to which a product may be assigned does not limit or extend the registrant’s rights and has no bearing on likelihood of confusion.” *Malarkey-Taylor Assoc., Inc. v. Cellular Telecom. Ind. Assoc.*, 929 F. Supp. 473, 476 (D.C. Cir. 1996). (citations omitted). “[I]nfringement can be found and prohibited even if the use of the registered mark is upon goods having different descriptive properties than those set forth in the registration” *Charles Schwab & Co., Inc v. Hibernia Bank*, 665 F. Supp. 800, 804 (N.D Cal. 1987). Where parties use of their marks is identical, the Patent and Trademark Office’s classification system is not a hurdle to a claim for trademark infringement. *See Universal Nutrition Corp. v. Carbolite Foods*, 325 F. Supp. 2d 526, 532 (D. New Jersey 2004). Accordingly, the facts alleged by Counter-plaintiffs, even if true, do not state a cause of action for fraud.

Moreover, THANH NGUYEN owns common law rights in the Tipsy name under Florida law, independent of his registration. He is seeking to vindicate those rights in this action. See Amended Complaint, ¶ 12 [D.E. 30]. As a result, THANH NGUYEN was not only permitted to use the Mark in connection with hair and nail services, he can do so to the exclusion of others. See *San Juan Prods., Inc. v. San Juan Pools of Kansas, Inc.*, 849 F.2d 468, 474 (10th Cir.1988) (“Trademark rights are created by use, not registration.”).

As noted by McCarthy on Trademarks, common law rights allow an owner to expand beyond the protections afforded by a federal mark:

It is difficult to understand why defendants in many trademark infringement suits expend so much time, effort and money in vigorously pursuing the claim that plaintiff's federal registration was obtained by fraud. It has been held several times that even if defendant succeeds in proving that the plaintiff's registration was fraudulently obtained, plaintiff's common law rights in the mark continue unabated and are sufficient to require an injunction against an infringing defendant. In addition, plaintiff's separate federal rights in unregistered marks under Lanham Act § 43(a) continue unabated even if a registration is disregarded or cancelled.

6 MCCARTHY ON TRADEMARKS § 31.60 (4th ed.2010). Accordingly, there is no basis for Counter-plaintiffs' allegation that THANH NGUYEN committed fraud on the USPTO when he disclaimed classification 44, because THANH NGUYEN made no misrepresentations to the USPTO, and THANH NGUYEN had common law rights to use the Mark in connection with a nail care salon and hair care services.

WHEREFORE, Plaintiffs, THANH NGUYEN and LUONG NGUYEN, respectfully request this Court enter an Order: (1) granting their Motion to Dismiss Defendants' Counterclaim with prejudice; (2) reserving jurisdiction to award Plaintiffs' attorneys fees and costs; and (3) awarding the Plaintiffs any further relief this Court deems equitable and just.

Respectfully Submitted,

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.
1000 S.E. Monterey Commons Blvd., Suite 306
Stuart, Florida 34996
Telephone (772) 221-7757
Facsimile (772) 781-6886

By: /s/ Scott Konopka
SCOTT KONOPKA, ESQUIRE
Florida Bar No. 080489
E-mail: skonopka@pm-law.com
PAIGE HARDY, ESQUIRE
Florida Bar No. 58967
E-mail: phardy@pm-law.com

SERVICE LIST

THANH NGUYEN AND LUONG NGUYEN
vs.
BARRY BIONDO AND TIPSY SPA AND SALON, INC.
CASE NO: 9:11-CV-81156-MIDDLEBROOKS
United States District Court, Southern District of Florida

Timothy L. Grice, Esq.
Email: tgrice@timothygricelaw.com

Timothy L. Grice, P.A.
319 Clematis Street
Suite 213
West Palm Beach, FL 33401
Tel (561) 802-4474 / Fax (561) 208-1303

*Attorney for the Defendants, Barry Biondo and
Topsy Spa and Salon Inc.*

Scott Konopka, Esquire
Email: skonopka@pm-law.com

Page, Mrachek, Fitzgerald & Rose, P.A.
1000 SE Monterey Commons Blvd.
Suite 306
Stuart, FL 34996

Tel (772) 221-7757 / Fax (772) 781-6886

*Attorneys for the Plaintiffs, Thanh Nguyen and
Luong Nguyen*

Paige Hardy, Esquire
Email: phardy@pm-law.com
Page, Mrachek, Fitzgerald & Rose, P.A.
1000 SE Monterey Commons Blvd.

Suite 306
Stuart, FL 34996
Tel (772) 221-7757 / Fax (772) 781-6886

*Attorneys for the Plaintiffs, Thanh Nguyen and
Luong Nguyen*

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

In the matter of the trademark application Serial No. 85272051

For the Mark TIPSYP SPA SALON

Published in Official Gazette on September 20, 2011.

THANH NYUGEN, an individual

V.

BARRY BIONDO, an individual, AND
TIPSYP SPA AND SALON, INC.,
a Florida Corporation

NOTICE OF OPPOSITION

THANH NYUGEN, an individual, whose address is 4906 Grassleaf Circle, Palm Beach Gardens, Florida, 33418, believes that he will be damaged by registration of the mark shown in the above identified application, and hereby opposes same. The grounds for the opposition are as follows:

1. On January 29, 2007, THANH NGUYEN applied for federal trademark protection in the "Tipsy" name and mark (the "Mark" or the "Tipsy" Mark). On November 11, 2008, the United States Patent and Trademark Office granted THANH NGUYEN's federal trademark application.

2. On November 19, 2009, THANH NGUYEN was granted a Florida Trademark on the "Tipsy" Mark. THANH NYUGEN's "Tipsy" Mark is inherently distinctive (arbitrary, fanciful or novel) or suggestive or has acquired secondary meaning.

3. By virtue of the THANH NGUYEN's use of the "Tipsy" Mark in salon businesses having bar services and in which THANH NGUYEN has a financial interest, registration of the "Tipsy" Mark with the United States Patent and Trademark Office, and

registration of the "Topsy" Mark with the Florida Department of State, THANH NGUYEN enjoys the exclusive use of the "Topsy" Mark in connection with nail salon and spa services business, THANH NYUGEN has acquired all rights in the "Topsy" Mark.

4. After several years of utilizing the "Topsy" Mark in business, THANH NGUYEN associated with BARRY BIONDO, to open a Topsy Nail Spa and Salon at 1037 State Road #7, Suite 112, Wellington, Florida 33414 ("Wellington Nail Spa and Salon").

5. For a period of time, the parties jointly operated the Wellington Nail Spa and Salon under the "Topsy" Mark.

6. In or about 2010, a disagreement occurred regarding the ownership and operation of the Wellington Nail Spa and Salon.

7. As a result of the disagreement, on or about March 11, 2010, THANH NGUYEN joined by another owner in the business, LUONG NGUYEN, as sellers, and BARRY BIONDO, as buyer, entered into a Business Sale Agreement to resolve their disagreement.

8. Pursuant to the Business Sale Agreement, BARRY BIONDO purchased the fixtures, furnishings, and equipment of the Wellington Nail Spa and Salon, and the right to operate the Wellington Nail Spa and Salon as a competing business at the Wellington location for \$164,000.00. BARRY BIONDO agreed to pay a \$20,000 down payment and to pay the balance of the purchase price in weekly installment payments.

9. The Business Sale Agreement permitted BARRY BIONDO to use THANH NGUYEN's "Topsy" Mark in connection with the Wellington Nail Spa and Salon only for the period of one (1) year from the date of the Agreement.

10. The Business Sale Agreement specifically states that BARRY BIONDO did

not purchase THANH NGUYEN's "Topsy" name or the "Topsy" Mark.

11. BARRY BIONDO agreed that he would not use THANH NGUYEN's "Topsy" name or the "Topsy" Mark after March 11, 2011, and that he would use a different name for his Wellington Nail Spa and Salon after March 11, 2011.

12. On July 16, 2010, shortly after the execution of the Business Sale Agreement, BARRY BIONDO incorporated TIPSY SPA AND SALON INC., in order to operate the Wellington Nail Spa and Salon.

13. In direct violation of THANH NYUGEN's rights, and in contravention of the express terms of the Business Sale Agreement, BARRY BIONDO and TIPSY SPA AND SALON INC., continued to use the "Topsy" Mark and "Topsy" name after March 11, 2011.

14. BARRY BIONDO and TIPSY SPA AND SALON INC., continue to use a mark that is identical or confusingly similar to THANH NYUGEN's "Topsy" Mark, in connection with BARRY BIONDO's and TIPSY SPA AND SALON, INC. s' nail salon and spa services, which include bar services, and in direct competition with THANH NYUGEN's business.

15. BARRY BIONDO and TIPSY SPA AND SALON INC., are improperly using an identical or substantially similar counterfeit "Topsy" mark on their business facade, in print advertising, in television advertising, on the Internet under www.Tipsyspa.com, on the Internet in search engines, on the Internet in their web sites' metatags, and in other mediums.

16. In a blatant attempt to circumvent THANH NYUGEN's rights in the "Topsy" Mark, BARRY BIONDO, d/b/a TIPSY SPA AND SALON, filed a federal trademark application for "Topsy Spa Salon."

17. The federal trademark application filed by BARRY BIONDO, d/b/a TIPSY

SPA AND SALON, was filed on March 21, 2011, a mere ten days after BARRY BIONDO was required to cease using THANH NYUGEN's "Topsy" Mark.

18. BARRY BIONDO and TIPSY SPA AND SALON, INC. are continuing to intentionally and improperly use an identical or substantially similar counterfeit to THANH NYUGEN's "Topsy" Mark in connection with their nail and salon business, in direct competition with THANH NYUGEN.

19. The "Topsy" mark being used by the BARRY BIONDO and TIPSY SPA AND SALON, INC. is identical or confusingly similar to THANH NYUGEN's "Topsy" Mark.

20. BARRY BIONDO's and TIPSY SPA AND SALON, INC.'s use of an identical or substantially similar counterfeit "Topsy" name and mark is an intentional attempt to confuse the public into believing BARRY BIONDO's and TIPSY SPA AND SALON, INC.'s business and services are associated with THANH NYUGEN's business and services.

21. BARRY BIONDO's and TIPSY SPA AND SALON, INC.'s intentional use of the identical or substantially similar counterfeit "Topsy" Mark is causing substantial customer confusion as to the sponsorship of the goods and services, and harming the reputation of THANH NYUGEN's business and the "Topsy" Mark.

22. BARRY BIONDO and TIPSY SPA AND SALON, INC. are intentionally attempting to palm off the name and reputation of THANH NYUGEN's "Topsy" Mark and are creating a false designation of the origin of BARRY BIONDO's and TIPSY SPA AND SALON, INC.'s services.

23. BARRY BIONDO and TIPSY SPA AND SALON, INC. are direct competitors of THANH NYUGEN.

24. THANH NGUYEN, has continually used the "Topsy" Mark in commerce and

in connection with the sale and advertising of the goods and services available at his full service salon and spas that incorporate nail and salon services together with the opportunity for its patrons to purchase and enjoy beer and wine.

25. BARRY BIONDO and TIPSYP SPA AND SALON, INC. are intentionally and willfully using the "Topsy" Mark or a mark which is identical or confusingly similar to the "Topsy" Mark, in commerce and in connection with the sale or advertising of goods and services available at their competing salon and spa.

26. BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s use of the "Topsy" Mark, or a mark which is identical or confusingly similar to the "Topsy" Mark, is likely to cause confusion, mistake, or deception among consumers as to the affiliation, connection or association of BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s goods and services, with THANH NGUYEN's goods and services.

27. BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s use of the "Topsy" Mark, or a mark which is identical or confusingly similar to the "Topsy" Mark, is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of their goods, services, or commercial services.

28. BARRY BIONDO and TIPSYP SPA AND SALON, INC. are willfully and intentionally using a counterfeit of the "Topsy" Mark with knowledge that the mark is a counterfeit mark, in connection with the sale, offering for sale, or distribution of their goods and services.

29. As a direct and proximate result of BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s conduct, THANH NGUYEN, has suffered, and will continue to suffer, irreparable injury to his business, reputation, and goodwill.

30. There is a likelihood of deception and consequent injury due to BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s violations of the Lanham Act.

31. BARRY BIONDO and TIPSYP SPA AND SALON, INC. have a bad faith intent to profit from the "Topsy" Mark.

32. BARRY BIONDO and TIPSYP SPA AND SALON, INC. have registered, traffic in, and use a domain name, www.Tipsyspa.com that is identical, confusingly similar, or dilutive of the "Topsy" Mark.

33. As a direct and proximate result of BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s conduct, they have engaged in abusive registration of a domain name, because their domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; and the holder of the domain name has no rights or legitimate interest in respect of the domain name; and the domain name has been registered and is used in bad faith.

34. As a direct and proximate result of BARRY BIONDO's and TIPSYP SPA AND SALON, INC.'s conduct, they have violated the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d).

Dated this 14th day of October, 2011.

Respectfully Submitted,

PAGE, MRACHEK, FITZGERALD & ROSE, P.A.
1000 S.E. Monterey Commons Blvd., Suite 306
Stuart, Florida 34996
Telephone (772) 221-7757
Facsimile (772) 781-6886
Counsel for THANH NYUGEN

By:


SCOTT KONOPKA, ESQUIRE

Florida Bar No. 080489

E-mail: skonopka@pm-law.com

PAIGE HARDY, ESQUIRE

Florida Bar No. 58967

E-mail: phardy@pm-law.com

BRYAN McLAUGHLIN, ESQUIRE

Florida Bar No. 0059306

E-mail: bmclaughlin@pm-law.com

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

RK/mc

Mailed: January 24, 2012

Opposition No. 91202097

Thanh Nguyen

v.

Barry Biondo and
Topsy Spa and Salon, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

On December 16, 2011, opposer filed a motion to suspend this proceeding pending final determination of a civil action between the parties.¹ No response was filed by applicant. In view thereof, opposer's motion is hereby **GRANTED** as conceded. See Trademark Rules 2.127(a) and 2.117(a). Accordingly, proceedings are **SUSPENDED** pending final disposition of the civil action between the parties.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the

¹ *Thanh Nguen and Luong Nguyen v. Barry Biondo and Topsy Spa and Salon Inc.*, Civil Action No. 9:11-cv-81156-DMM in the United States District Court for the Southern District of Florida.

EXHIBIT
E

Opposition No. 91202097

suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

* * *