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

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| Proceeding | 92055403 |
| Party | Plaintiff Barry Biondo dba Topsy Spa and Salon |
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| Submission | Opposition/Response to Motion |
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| Date | 04/14/2012 |
| Attachments | Opposition to Motion to Suspend.pdf (6 pages)(46383 bytes) |

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

In the matter of Trademark Registration No. 3529699

Cancellation No. 92055403

For the mark: TIPSY

Registration Date: November 11, 2008

Barry Biondo dba Topsy Spa and Salon

vs.

Thanh Nguyen

**REQUEST FOR RECONSIDERATION &
OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND**

Petitioner Barry Biondo requests reconsideration of the granting of the Motion to Suspend and requests allowing Petitioner to oppose the Motion. Petitioner believes that granting this Motion without giving Petitioner a chance to be heard is not only prejudicial to Petitioner but also does not allow a possible economical disposition of this registration that is fatally flawed on its face before it becomes an issue before the district court. If the application is void, it should be set aside in the interests of public policy in an economical way. For the parties to litigate on the complex issues of infringement when the application is void ab initio is not a desirable outcome under the Federal Rules of Procedure where the goals are to avoid unnecessary cost or delay. See Fed. R. Civ. P. 42(a).

The Board is allowed to consider if a proceeding is closest to issuance of a Board final decision, because that decision may have a bearing on the common claims in the other oppositions. 37 CFR Section 2.117(a) (Trademark Rule 2.117(a)). The issues of registerability in this proceeding rely only the record making it a candidate for a potentially quick final decision.

The Board has found that suspension of a proceeding is not mandatory when claims are not duplicates of those in other proceedings. *New Orleans Louisiana Saints v. Who Dat?, Inc.*, (TTAB 2011).

The Board has found that allowing carelessness in the goods descriptions results in registrations that are improperly accorded legal presumptions in connection with goods on which the mark is not used. *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006). In the present case, the record shows that the original services description involving nail services was not a careless service description but the amendment to overcome the likelihood of confusion refusal that narrowed the services to just *bar services* was careless in its presumption that the specimen still supported a proper use in commerce. Allowing this registration to continue with improperly accorded legal presumptions would be improper and prejudicial to Petitioner.

The subject Petition for Cancellation involves only issues of registerability. This proceeding is based solely on the four corners of the record of Registrant's application. There are no pleaded issues in common between the lawsuit pleaded by Registrant in the Motion to Suspend and the Petition to Cancel. Since the cancellation pleadings are not based on issues outside the pleadings and outside underlying registerability and the application itself, the Board decision is not merely advisory in this case. For instance, there are no facts outside the record or the pleading that can change the fact that the specimen is deficient to show the mark functioning as a mark for bar services. All of the pleadings in the Petition to Cancel are based on the application itself except for Petitioner's standing which is admitted by Registrant in the Motion to Suspend on multiple grounds.

**REGISTRANT'S MOTION TO SUSPEND IS A COLLATERAL ATTACK WHOSE
WEIGHT SHOULD BE CONSIDERED LIGHTLY**

Petitioner has made a prima facie case that Registrant mark did not function as a mark in the application at the time he filed the underlying application based on use in commerce under § 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Registrant has not taken any action to contradict the accuracy or probative value of Petitioner's showing. See *Shutemdown Sports, Inc. v. Lacy*,

92049692 (TTAB 2012). The application is prima facie void ab initio and should not be taken lightly.

When deciding issues of a similar manner, the Board will weigh the savings in time, effort, and expense, which may be gained against any prejudice or inconvenience that may be caused thereby. TBMP 511.

Petitioner is asking the Board to weigh the Petitioner's likelihood of success on the merits and allow consideration on whether the underlying application is void based solely on the record before the USPTO. In contrast, Registrant is asking the Board to suspend an inquiry into the registerability of a mark based on a district court case dealing with state law, contract law, common law rights and the validity of the registration based on other issues than those in the subject pleadings--all collateral matters. Giving a heavy weight to the disposition of these collateral matters over the heavy weight of an undenied prima facie case of invalidity is prejudicial not just to Petitioner but also eliminates the potential savings in time, effort and expense that can be gained by dealing with this registerability issue now when it is little and deals only with the underlying application before it grows up and becomes complex and dependent on evidence, testimony, affirmative defenses, counterclaims, etc. The damage to all, even to Registrant, only grows as the district court case proceeds while ignoring the potential for a quick resolution of a very pertinent underlying matter.

**REGISTRANT'S MOTION TO SUSPEND DISREGARDS THE BOARD'S
TRADITIONAL REALM AND PRIMARY JURISDICTION AND DISREGARDS THE
POTENTIAL FOR AN ECONOMIC DISPOSITION OF ISSUES**

When an issue involves technical questions of fact uniquely within the expertise and experience of its agency, the Board can act on its primary jurisdiction. *Nader v. Allegheny Airlines, Inc*, 426 U.S. 290, 96 S.Ct. 1978, 48 L.Ed.2d 643 (1976). See, e.g., *Far East Conference v. United States*, 342 U.S. 570, (antitrust action challenging shipping rates properly within primary jurisdiction of the Federal Maritime Board); *Texas & Pacific Ry. v. Abilene Cotton Oil Co.*, 204 U.S. 426, S.Ct. 350, 51 L.Ed. 553 (1907) (shipper challenging carrier's rate must seek redress initially through the Interstate Commerce Commission); *Danna v. Air France*, 463 F.2d 407 (2d Cir. 1972) (claim

under Federal Aviation Act challenging reasonableness and discriminatory effect of airline's tariff initially a question for Civil Aeronautics Board). Application of the doctrine is appropriate in this proceeding (while not mandatory) because the issues involved regard technical issues of the registerability of a mark based solely on the record.

Petitioner is asking the Board to review whether the application should have been refused as being fatally flawed on its face. The Board is uniquely qualified to review its own case file and determine if the prosecution was flawed and to act on correcting this flaw without the involvement of the district court thus avoiding the district court having to hear all the collateral issues regarding this registration that are involved in the pending litigation.

Based on a finding that the record on its face supports the conclusion that Registrant's mark does not function as a mark and was not in use at the time of filing of his application, the Board can hold the application void ab initio. This leaves much of the district court case moot. The district court need not discuss the remaining elements of other claims based on the void mark or render a decision on any other claims regarding the void mark. See *Shutemdown Sports, Inc. v. Lacy*, 92049692 (TTAB 2012). Staying this proceeding is more likely to prolong the dispute than lead to its economical disposition which should not be favored by the Board.

REGISTRANT'S MOTION TO SUSPEND IS PREJUDICIAL TO PETITIONER

Suspending this proceeding without giving Petitioner a chance to object prejudices Petitioner and favors Registrant. A void ab initio registration as an underlying basis for a district court proceeding wastes the resources of the district court. Granting the motion will cause unnecessary delays and cost and put the court in the position where the Board should be, to examine the record of an application and determine if the trademark examiner erred in determining the sufficiency of the specimen to support the applicable services definition and use as a mark. Petitioner asks that the Board reconsider the grant the Motion to Suspend for these reasons and the previously pleaded reasons.

Submitted By: /Wendy Peterson/

Date: April 14, 2012

Wendy Peterson, Attorney for Petitioner Barry Biondo dba Topsy Spa & Salon

CERTIFICATE OF SERVICE

I hereby certify that on April 14, 2012, the foregoing was served upon Registrant by first class mail to:

THANH NGUYEN
1037 STATE ROAD 7, SUITE 112
WELLINGTON, FL 33414
UNITED STATES

By: /Wendy Peterson/

Date: April 14, 2012

Wendy Peterson, Attorney for Applicant, Barry Biondo dba Topsy Spa & Salon