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Filing date: **08/04/2014**

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

Proceeding	92055679
Party	Plaintiff Your Photo On Canvas, LLC
Correspondence Address	ROGER N BEHLE JR FOLEY BEZEK BEHLE & CURTIS LLP 575 ANTON BLVD, STE 710 COSTA MESA, CA 92626 UNITED STATES rbehle@foleybezek.com, ehuffman@foleybezek.com
Submission	Other Motions/Papers
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Signature	/roger n. behle, jr./
Date	08/04/2014
Attachments	YPOC Status Update 080414.pdf(151773 bytes) RNB Decl ISO YPOC Status Update 080414.pdf(185658 bytes)

In its motion requesting the stay, Malovani Design claimed the Civil Action involved “common questions of law and fact” to those in this TTAB proceeding. Specifically, Malovani Design identified the trademark infringement claim in the Civil Action (brought by Adam Malovani – not Malovani Design) as the claim which involved these common questions.

In its July 30, 2014 Response to the Board, however, Malovani Design did not apprise the Board that Mr. Malovani dropped the trademark infringement claim in the middle of trial. (See, Trial Transcript dated March 12, 2013, attached to the Declaration of Roger N. Behle, Jr., as Ex. A). Instead, Malovani Design reported that a verdict was rendered by the jury in favor of Mr. Malovani, but did not tell the Board that the verdict was on other claims – presumably because it wanted the Board to think the trademark infringement claim was adjudicated in favor of Mr. Malovani. It was not.

This history, however, may be moot in light of the subsequent settlement of the Civil Action. In July of 2013, the parties to the Civil Action settled. As Malovani Design noted in its Response, the Settlement Agreement contained a waiver and release, including a waiver and release of the claim that Mr. Malovani owns the trademark YOUR PHOTO ON CANVAS. Thus, Mr. Malovani has released any claim to ownership of the trademark YOUR PHOTO ON CANVAS. Further, according to Malovani Design, this release is binding upon it as Mr. Malovani’s “affiliate.”

Thus, to the extent Malovani Design is proposing that these consolidated TTAB proceedings be dismissed *because* the subject application (Ser. No. 85/25823) is being withdrawn and the subject registration (Reg. No. 4151869) is being abandoned in light of the Settlement Agreement, Opposer/Petitioner consents to dismissal on those conditions. If, however, Malovani Design is suggesting otherwise, namely, that it maintains all of its ownership claims despite the release in the Settlement Agreement, then Opposer/Petitioner does not consent to dismissal.

Dated: August 4, 2014

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Opposer/Petitioner,
Your Photo On Canvas, LLC.

CERTIFICATE OF SERVICE

It is hereby certified that on the 4th day of August, 2014, the foregoing RESPONSE OF OPPOSER/PETITIONER TO BOARD'S REQUEST FOR STATUS UPDATE OF CIVIL ACTION and DECLARATION OF ROGER N. BEHLE, JR. were served on Registrant by sending copies thereof to:

ROBERT M. GILCHREST
SILVERMAN SHIN BYRNE & GILCHREST LLP
500 South Grand Avenue, Suite 1900
Los Angeles, CA 90071
UNITED STATES

Registrant, by first-class, postage-prepaid mail.

Dated: August 4, 2014

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Opposer/Petitioner
Your Photo On Canvas, LLC.

upon information and belief, and as to those statements, I believe them to be true. If called upon, I could and would competently testify thereto under oath.

2. Attached hereto as Exhibit A is a true and correct copy of relevant pages from the trial transcript of *Malovani v. Doe* (USDC Case No. SACV 11-0787-AG) dated March 12, 2013.

I declare the foregoing under penalty of perjury under the laws of the United States of America this 4th day of August 2014, at Orange County, California.

/s/ Roger N. Behle, Jr.
Roger N. Behle, Jr.

EXHIBIT A

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

HONORABLE ANDREW J. GUILFORD, JUDGE PRESIDING; COURTROOM 10D

CERTIFIED TRANSCRIPT

Adam Malovani, et al.,)
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Plaintiff(s),)
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)
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vs.) No. SACV 11-0787-AG (MLGx)
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)
)
John S. Doe, et al.,)
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)
)
Defendant(s).)
)
)
)
_____)

REPORTER'S DAILY TRANSCRIPT OF TRIAL PROCEEDINGS
SANTA ANA, CALIFORNIA
TUESDAY, MARCH 12, 2013

DENISE PADDOCK
CSR 10199, CMRS, RMR, CRR
transcripts@ocrecord.com
U.S. DISTRICT COURT REPORTER

1 due on -- in May of 2012 for the September 11 trial date.

2 We received disclosures from -- from Defendants,
3 and they didn't list Mr. Gitler.

4 We received a supplemental disclosure in June of
10:32 5 2012.

6 That didn't -- didn't -- it didn't disclose
7 Mr. Gitler.

8 This court continued the September trial date on
9 August 1st, from September 11 to October 2nd.

10:33 10 And then on August 24th, 2012, we received another
11 disclosure that, for the first time, listed Mr. Gitler.

12 There -- there -- there was no leave of court to do
13 a late designation of Mr. Gitler at the time; and, of course,
14 that's well within 120 days of either the September 11 trial
10:33 15 date or the October 2nd trial date.

16 And this court's scheduling order is very specific
17 that expert disclosures have to be done 120 days in advance
18 of trial.

19 THE COURT: Okay. Were you able to take any
10:33 20 depositions of this expert?

21 MR. GILCHREST: No, Your Honor.

22 THE COURT: And why is that?

23 MR. GILCHREST: There was a late disclosure.

24 We saw no need to take his testimony.

10:33 25 And, Your Honor, the -- the report that he

1 submitted, it's on the trademark issue, and I've advised
2 counsel over the weekend that Plaintiffs are withdrawing the
3 trademark infringement claim.

4 And of course the judge -- the court took under
10:34 5 submission the Rule 50 motion on the false designation.

6 THE COURT: Whoa, you're withdrawing the trademark
7 infringement claim?

8 MR. GILCHREST: Correct.

9 THE COURT: Oh, that would have been helpful.

10:34 10 My helpers are in back working on jury
11 instructions, et cetera, and we don't have to worry about
12 trademark anymore.

13 MR. GILCHREST: Correct, Your Honor.

14 THE COURT: A wise decision, I would suggest.

10:34 15 In that regard, tell me what you are -- what you do
16 want to go to the jury?

17 MR. GILCHREST: The breach of fiduciary duty claim.

18 The --

19 THE COURT: Based on the existence of a
10:34 20 partnership?

21 MR. GILCHREST: Partnership, joint venture,
22 whatever the nature of the relationship.

23 THE COURT: A joint venture is a partnership.

24 Okay.

10:34 25 MR. GILCHREST: The breach of contract claim.

1 in the best interest of the jury.

2 I will have to think of some other equitable way to
3 balance things out given what we've talked about here, and I
4 appreciate what you've asked for.

18:30 5 MR. BEZEK: Just give us 41, and that will be fine.

6 THE COURT: If the parties want to work something
7 out amongst themselves, they may, subject to my approval,
8 because there's a lot of issues involved here.

9 MR. BEZEK: Thank you, Your Honor.

18:30 10 (Adjournment at 18:30 to resume on Wednesday,
11 March 13, 2013 at 8:00 a.m. Next session reported
12 by Denise Paddock.)

13 ***

14 Certificate

15 I hereby certify that the foregoing is a true and
16 correct transcript of the stenographically recorded
17 proceedings in the above matter.

18 Fees charged for this transcript, less any circuit
19 fee reduction and/or deposit, are in conformance with the
20 regulations of the judicial conference of the United States.

21 U.S. DISTRICT COURT

22 Date: April 26, 2013

23 / s / DENISE PADDOCK
24 CMRS, RMR, CRR, CSR 10199
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