ESTTA Tracking number: **ESTTA633510**
Filing date: **10/17/2014**

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

Proceeding	92057941
Party	Defendant Barnaby Heating & Air
Correspondence Address	BARNABY HEATING & AIR 4620 INDUSTRIAL ST STE C ROWLETT, TX 75088 UNITED STATES jcelum@celumlaw.com
Submission	Motion to Reopen
Filer's Name	Julie Celum Garrigue
Filer's e-mail	jcelum@celumlaw.com
Signature	/s/julie celum garrigue//
Date	10/17/2014
Attachments	10.17.2014 Motion to Join and Motion to Reopen and Extend.pdf(95205 bytes) 10.17.2014 Memorandum in Support of Motion to Join.pdf(175923 bytes)

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

CLOCKWORK IP, LLC	§	Mark: COMFORTCLUB
	§	
Petitioner	§	
	§	Cancellation No. 92057941
v.	§	In re Registration No. 3,618,331
	§	
BARNABY HEATING & AIR, LLC	§	
	§	
Respondent.	§	

RESPONDENT'S MOTION TO JOIN ASSIGNEE AND MOTION TO REOPEN DISCOVERY AND EXTEND THE TRIAL SETTING

Respondent Barnaby Heating & Air, LLC, ("Barnaby"), by and through its undersigned counsel, files this Motion to Join Assignee and Motion to Reopen Discovery and Extend the Trial Setting, and moves as follows:

A. Introduction

1. Petitioner is Clockwork IP, LLC, a Delaware limited liability company; Respondent is Barnaby Heating & Air, LLC, a Texas limited liability company.

2. Assignee, McAfee Heating & Air Conditioning Co., Inc., is an Ohio corporation, and is wholly unrelated to either Petitioner or Respondent, but all three (3) parties are in the heating and air conditioning trade. Petitioner and Respondent had an established business relationship prior to the initiation of this cancellation proceeding.

3. Petitioner filed its cancellation proceeding against Respondent for cancellation of Respondent's COMFORTCLUB mark, Registration No. 3,618,331.

4. Respondent assigned its Registration No. 3,618,331 on September 30, 2014 and it was recorded on October 14, 2014, Reel/Frame 5380/0159, which was subsequent to the commencement of this cancellation proceeding. *See* Respondent's Memorandum in Support of

Respondent's Motion to Join Assignee and Motion to Reopen Discovery and Extend the Trial Setting at Exhibit 1 – a true and correct copy of Notice of Recordation of Assignment, October 16, 2014.

5. Discovery in this proceeding closed on June 4, 2014. Petitioner served Respondent with written discovery requests after the close of discovery in this proceeding. Respondent did not serve Petitioner with written discovery requests. No written discovery has taken place with respect to Petitioner or Assignee, and Petitioner will not be prejudiced by the reopening of the discovery period in this proceeding. Petitioner's pretrial disclosures are due on November 1, 2014.

6. Assignee, McAfee Heating & Air Conditioning Co., Inc. is required for the resolution of this proceeding, is an indispensible party in interest, and must be joined.

7. If Assignee is joined and discovery is not reopened, Assignee will be prejudiced. Assignee agrees to be joined in this proceeding, only if discovery is reopened and Assignee is allowed to participate in discovery.

B. Authority

8. These motions are based upon the Federal Rules of Civil Procedure 17 - 21 and 25; TBMP §512; 37 CFR §2.102(b); 37 CFR §2.113(c); 37 CFR §2.113(d); 37 CFR §3.71; and 37 CFR §3.73(b). These motions are also based upon the supporting Memorandum filed herewith, the pleadings and papers on file in this matter, and the September 30, 2014 Assignment of the subject Registration No. 3,618,331, which was filed and recorded on October 14, 2014.

C. Conclusion and Prayer

9. As set forth above, Assignee, McAfee Heating & Air Conditioning Co., Inc. is willing to join this proceeding and is a necessary party that must be joined.

10. WHEREFORE, Respondent, Barnaby Heating & Air, LLC, respectfully requests that the Board:

a. GRANT Respondent's Motion to Join Assignee;

b. Enter an Order finding that Assignee, McAfee Heating & Air, Conditioning Co., Inc., be joined in this cancellation proceeding;

c. GRANT Respondent's Motion to Reopen Discovery and Extend the Trial Setting;

d. Order discovery be reopened and the trial setting extended; and

e. An award to Barnaby Heating & Air, LLC of such other and further relief as the Board deems just and appropriate.

Dated: October 17, 2014

Respectfully submitted,

Celum Law Firm, PLLC

//s//Julie Celum Garrigue
JULIE CELUM GARRIGUE

Texas Bar No. 24031924
11700 Preston Rd., Suite 660
PMB 560
Dallas, TX 75230
Phone: 214.334.6065
Facsimile: 214.504.2289
Email: jcelum@celumlaw.com

Counsel for Respondent,
Barnaby Heating & Air, LLC

CERTIFICATE OF CONFERENCE

I hereby certify that I conferred with counsel for Assignee, McAfee Heating & Air Conditioning Co., Inc. and Assignee consents to being joined a party to this action if it is given the chance to conduct the appropriate discovery in this cancellation proceeding. I hereby certify that I contacted counsel for Petitioner, Purvi Patel Albers, about the general contents of this motion and counsel for Petitioner does not consent to the joinder of Assignee, McAfee Heating &

Air Conditioning Co., Inc., or to reopen discovery and extend the trial setting.

//s//Julie Celum Garrigue
JULIE CELUM GARRIGUE

CERTIFICATE OF SERVICE

I hereby certify that a true copy of **RESPONDENT'S MOTION TO JOIN ASSIGNEE AND MOTION TO REOPEN DISCOVERY AND EXTEND THE TRIAL SETTING AND RESPONDENT'S MEMORANDUM IN SUPPORT OF RESPONDENT'S MOTION TO JOIN ASSIGNEE AND MOTION TO REOPEN DISCOVERY AND EXTENT THE TRIAL SETTING** was served on counsel for Petitioner and counsel for Assignee, this 17th day of October 2014, by filing electronically via the ESTTA and by email to:

Purvi Patel Albers
Haynes and Boone, LLP
2323 Victory Avenue, Suite 700
Dallas, TX 75219
Phone: 214-651-591 7
Facsimile: 214-200-0812
Email: *patelp@haynesboone.com*

Counsel for Petitioner,
Clockwork IP, LLC

Melissa Replogle, Esq.
Replogle Law Office, LLC
2312 Far Hills Ave., #145
Dayton, OH 45419
Phone: 937.369.0177
Facsimile: 937.999.3924
Email: melissa@reploglelawoffice.com

Counsel for Assignee,
McAfee Heating & Air Conditioning Co., Inc.

//s// Julie Celum Garrigue
JULIE CELUM GARRIGUE

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

CLOCKWORK IP, LLC	§	Mark: COMFORTCLUB
	§	
Petitioner	§	
	§	Cancellation No. 92057941
v.	§	In re Registration No. 3,618,331
	§	
BARNABY HEATING & AIR, LLC	§	
	§	
Respondent.	§	

RESPONDENT'S MEMORANDUM IN SUPPORT OF ITS MOTION TO JOIN ASSIGNEE AND MOTION TO REOPEN DISCOVERY AND TO EXTEND THE TRIAL SETTING

Respondent Barnaby Heating & Air, LLC, ("Barnaby"), by and through its undersigned counsel, files this Respondent's Memorandum in Support of its Motion to Join Assignee and Motion to Reopen Discovery and to Extend the Trial Setting, and moves as follows:

A. Introduction and Background

1. Petitioner is Clockwork IP, LLC ("Petitioner"), a Delaware limited liability company; Respondent is Barnaby Heating & Air, LLC ("Respondent"), a Texas limited liability company.

2. Assignee is McAfee Heating & Air Conditioning Co., Inc. ("Assignee"), an Ohio corporation. Assignee is wholly unrelated to Petitioner or Respondent, but all three (3) parties are in the heating and air conditioning trade. Petitioner and Respondent had an established business relationship prior to the initiation of this cancellation proceeding.

3. On May 12, 2009, Respondent received registration from the U.S. Trademark Office for the service mark, COMFORTCLUB, U.S. Registration No. 3,618,331.

4. On March 20, 2013, and with full knowledge of the four-plus years existence of Respondent's U.S. Service Mark Registration No. 3,618,331 in the COMFORTCLUB mark, Petitioner filed its U.S. Trademark Application, Serial No. 85880911, based upon Section 1(b),

Intent-To-Use, for the identical COMFORTCLUB mark. Following the receipt of a May 21, 2013 Office Action, citing a 2(d) – Likelihood of Confusion refusal of Petitioner's application for COMFORTCLUB, Petitioner initiated this cancellation proceeding against Respondent for the cancellation of Respondent's COMFORTCLUB mark. Petitioner abandoned its U.S. Trademark application on October 27, 2013.

5. Discovery in this proceeding closed on June 4, 2014 and Petitioner's pretrial disclosures are due on November 1, 2014. Following the close of discovery, Petitioner served Respondent with written discovery requests, to which Respondent has responded. Respondent has not served Petitioner with written discovery requests.

6. Following the close of discovery, Respondent learned that Assignee has used the COMFORTCLUB mark in commerce, for pre-paid heating and air conditioning plans, continuously since as early as 1999. On September 30, 2014, Respondent assigned its COMFORTCLUB mark, U.S. Registration No. 3,618,331, to Assignee and it was recorded October 14, 2014, Reel/Frame 5380/0159, which was subsequent to the commencement of this cancellation proceeding and subsequent to the close of discovery in this proceeding. Exhibit 1 – a true and correct copy of Notice of Recordation of Assignment, October 16, 2014.

7. Given the Assignment and Assignee's use of the COMFORTCLUB mark since 1999, a date prior to Petitioner's alleged date of first use, and Respondent's date of first use in commerce, Assignee is required for the resolution of this proceeding and is an indispensible party in interest. Assignee must be joined and provided the opportunity to participate in meaningful discovery.

B. Argument and Authority

8. As authorized by Federal Rules of Civil Procedure 17, 19, 20, 21 and 25, and as set forth in TBMP §512, and in keeping with the Board's usual practice, the Board may order an absent

party joined when the absent party is required for the suit to proceed, and the suit cannot proceed in equity and good conscience without that party. *See* FED. R. CIV. P. 17, 19, 20, 21 and 25; *see also* TBMP §512; s*ee, e.g.,* 37 CFR §2.l13(c); 37 CFR §2.l13(d), 37 CFR §3.71 and 37 CFR §3.73(b); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ 2d 1433, 1434 n. 2 (TTAB 2007) (applicant's motion to join another defendant granted where assignment of application occurred after commencement of proceeding); *Pro-Cuts v. Schilz-Price Enterprises Inc.,* 27 USPQ 2d 1224, 1229 (TTAB 1993); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ 2d 1137, 1138 n. 4 (TTAB 1990) ("in accordance with the Board's usual practice" assignee joined after filing copy of an assignment which occurred subsequent to commencement of proceeding); and *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 857 n. l (TTAB 1986) (assignee joined where papers filed by parties indicated registration had been assigned).

9. Discovery in this matter closed on June 4, 2014. Following the close of the discovery, Respondent learned that Assignee has used the COMFORTCLUB mark in commerce since 1999. Respondent's assignment to Assignee conveyed its entire interest and goodwill in the COMFORTCLUB mark and U.S. Registration No. 3,618,331 and Assignee is an indispensible party, because complete relief is not possible among the existing parties. FED. R. CIV. P. 19(a); *Hood ex rel. Miss. v. City of Memphis*, 570 F.3d 625, 629-30 (5th Cir. 2009), cert. denied, 130 S. Ct. 1319 (2010).

10. Assignee has agreed to be joined in this proceeding and is required for the complete resolution of the dispute. Following a decision by the Board in the underlying cancellation proceeding, Assignee can enforce its ownership in the COMFORTCLUB mark and its common law priority in the COMFORTCLUB mark as against Petitioner, thus complete relief is not possible in the current cancellation proceeding. If the Board finds a party is necessary to the

litigation under Fed. R. Civ. Pro. 19, the party must be joined if possible. *Western Worldwide Enterprises Group Inc.,* 17 USPQ 2d at 1138, n. 4. Given Assignee's consent to be joined in this proceeding, the Board must order Assignee be joined.

11. As owner by assignment of the COMFORTCLUB mark, U.S. Registration No. 3,618,331, and as the common law owner of the COMFORTCLUB mark, Assignee has a legally protected interest in the subject matter of this action. FED. R. CIV. P. 19. To proceed without Assignee would impair or impede Assignee's ability to protect its interest in this proceeding and is in direct contradiction with the applicable Federal Rules of Civil Procedure. FED. R. CIV. P. 19(a)(2); *see Dawavendewa v. Salt River Project Agric. Improvement & Power Dist*., 276 F. 3d 1150, 1155 (9th Cir. 2002).

12. In determining whether Assignee is a necessary party under Rule 19, the Board should consider whether, in the absence of Assignee, complete relief can be accorded to Petitioner. *Id.*; *see also Shermoen v. United States,* 982 F. 2d 1312, 1317 (9th Cir. 1992). The Board should also consider whether a judgment in this cancellation proceeding for Petitioner or Respondent will also subject the parties to the risk of incurring double, multiple, or otherwise inconsistent obligations. Fed. R. Civ. P. 19(a)(2); *see Symes v. Harris*, 472 F. 3d 754, 760 (10th Cir. 2006). If Assignee satisfies either of these alternative tests, it is necessary to the instant litigation. *See Clinton v. Babbitt*, 180 F. 3d 1081, 1088 (9th Cir. 1999).

13. Assignee, with indisputable—and primary—rights to the COMFORTCLUB mark, which remains absent from this cancellation proceeding, will likely attempt to vindicate its own rights one day. Just adjudication of claims requires the Board protect a party's right to be heard and to participate in adjudication of a claimed interest. *Shermoen,* 982 F. 2d at 1317. Because proceeding without such an integral party may prejudice the missing party's rights or risk

duplicative lawsuits, Assignee is a required party under Rule 19.

14. Rule 20(a)(2) of the Federal Rules of Civil Procedure provides that "[a party] . . . may be joined in one action as [a respondent] if: (A) any right to relief is asserted against them jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences; and (B) any questions of law or fact common to [respondents] will arise in the action." FED. R. CIV. P. 20. Rule 21 further provides that on motion, or on its own, a court may at any time, on just terms, add or drop a party. FED. R. CIV. P. 21. As stated by the Supreme Court in *United Mine Workers of America v. Gibbs*, "Under the rules, the impulse is toward entertaining the broadest possible scope of action consistent with fairness to the parties; joinder of claims, parties and remedies is strongly encouraged." 383 U.S. 715, 724 (1966). Rule 20 "is to be construed liberally in order to promote trial convenience and to expedite the final determination of disputes, thereby preventing multiple lawsuits." *League to Save Lake Tahoe v. Tahoe Reg. Plan Agcy.,* 558 F.2d 914, 917 (9th Cir. 1977), citing *Mosley v. General Motors Corp*., 497 F.2d 1330 (8th Cir. 1974). Here, Assignee has a vested interest in the final determination of this dispute, should be joined and provided the opportunity to participate in this proceeding.

C. Conclusion and Prayer

15. As set forth above, Assignee, McAfee Heating & Air Conditioning Co., Inc. is willing to join this proceeding and is a necessary party that must be joined.

16. WHEREFORE, Respondent, Barnaby Heating & Air, LLC, respectfully requests that the Board:

a. GRANT Respondent's Motion to Join Assignee;

b. Enter an Order finding that Assignee, McAfee Heating & Air, Conditioning Co.,

Inc., be joined in this cancellation proceeding;

c. GRANT Respondent's Motion to Reopen Discovery and Extend the Trial Setting;

d. Order discovery be reopened and the trial setting extended; and

e. An award to Barnaby Heating & Air, LLC of such other and further relief as the Board deems just and appropriate.

Dated: October 17, 2014

Respectfully submitted,

Celum Law Firm, PLLC

//s//Julie Celum Garrigue
JULIE CELUM GARRIGUE

Texas Bar No. 24031924
11700 Preston Rd., Suite 660
PMB 560
Dallas, TX 75230
Phone: 214.334.6065
Facsimile: 214.504.2289
Email: jcelum@celumlaw.com

Counsel for Respondent,
Barnaby Heating & Air, LLC

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCTOBER 16, 2014

PTAS

MELISSA REPLOGLE
2312 FAR HILLS AVE.
PMB 145
DAYTON, OH 45419

900304052

UNITED STATES PATENT AND TRADEMARK OFFICE
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RECORDATION DATE: 10/14/2014

REEL/FRAME: 5380/0159
NUMBER OF PAGES: 5

BRIEF: ASSIGNS THE ENTIRE INTEREST

ASSIGNOR:
BARNABY HEATING & AIR LLC

DOC DATE: 09/30/2014
CITIZENSHIP: TEXAS
ENTITY: LIMITED LIABILITY COMPANY

ASSIGNEE:
MCAFEE HEATING AND AIR CONDITIONING CO., INC.
4770 HEMPSTEAD STATION DR.
KETTERING, OHIO 45429

CITIZENSHIP: OHIO
ENTITY: CORPORATION

SERIAL NUMBER: 77420784
REGISTRATION NUMBER: 3618331
MARK: COMFORTCLUB
DRAWING TYPE: STANDARD CHARACTER MARK

FILING DATE: 03/13/2008
REGISTRATION DATE: 05/12/2009

ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION

EXHIBIT 1