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

Proceeding	92060018
Party	Plaintiff Todd Sean White
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Submission	Opposition/Response to Motion
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Attachments	Response to Motion to Substitute.pdf(100768 bytes )

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

Todd Sean White	)	
Petitioner,	)	Cancellation No.: 92060018
	)	
v.	)	Mark: Ripper
	)	
Gary L. Pifer	)	Mark Serial No.: 78687136
Respondent.	)	
	)	

**PETITIONER’S RESPONSE AND OBJECTION TO  
RESPONDENT’S MOTION TO SUBSTITUTE NEW PARTY**

Petitioner Todd Sean White, through his undersigned counsel, hereby responds and objects to Respondent Gary L. Pifer’s Motion to Substitute<sup>1</sup> Joe Faustine as Respondent in Cancellation Proceeding No. 92060018, which was submitted to the Board on August 7, 2015 (the “**Motion**”). Mr. Pifer apparently assigned Registration No. 3179987, which is the subject of this cancellation proceeding, to Mr. Faustine on June 23, 2015.<sup>2</sup> Petitioner objects to substitution of the respondent and submits that Mr. Pifer is a necessary party to this proceeding as the original applicant and owner of the subject registration.

Pursuant to TBMP § 512.01, when the mark in a registration that is the subject of an *inter partes* proceeding is assigned and such assignment is recorded in the Assignment Recordation Branch of the USPTO, the assignee may be substituted as respondent only if, 1) assignment occurred prior to commencement of the proceeding; or 2) the assignor is

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<sup>1</sup> Petitioner notes that Respondent’s motion was captioned “Motion to Transfer Respondent,” but is effectively a Motion to Substitute and was filed as such.

<sup>2</sup> Petitioner notes that the assignment documents were not served upon Petitioner’s counsel as required by 37 C.F.R. 2.119 and TBMP § 113.01, and were not attached to Respondent’s Motion.

no longer in existence; or 3) the discovery and testimony periods have closed; or 4) the plaintiff raises no objections to substitution. If, as is the case here, none of the preceding requirements are met, the assignee will be joined, rather than substituted, to facilitate discovery.

This proceeding was commenced upon Petitioner's filing with the Board of a Petition to Cancel on September 19, 2014, some nine months prior to assignment of the subject mark. There is nothing in the record tending to show that the assignor or his business is no longer in existence, and Mr. Pifer does not make any such claim in his Motion. The discovery and testimony periods in this proceeding have not closed and Mr. Pifer has not yet participated in any discovery, failing to both serve his initial disclosures by the August 6, 2015 deadline and to respond to Petitioner's discovery requests by the August 13, 2015 deadline for such response. Additionally, Petitioner hereby objects to substitution of Mr. Faustine as Respondent and the corresponding dismissal of Mr. Pifer, as requested in the Motion. Petitioner believes that Mr. Pifer is a necessary party to this proceeding and his continued involvement as Respondent is necessary to facilitate discovery as the original applicant and owner of the subject mark for nearly ten years.

Where, as here, the assignment occurred well after commencement of the proceeding and there is no evidence in the record tending to show that the assignor is no longer in existence, joinder, rather than substitution, is appropriate. See *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business

connected with mark no longer in existence). Furthermore, “[i]t is Board policy that when an assignment of an application occurs after the commencement of a proceeding, the assignee is joined as a party, rather than substituted.” *U.S. Olympic Comm.*, 29 U.S.P.Q.2d 1555, fn. 1 (Trademark Tr. & App. Bd. Oct. 20, 1993). For the reasons stated above, Joe Faustine should be joined as Respondent rather than substituted, and Gary L. Pifer should not be dismissed as requested in the Motion, but rather should remain as Respondent in this proceeding.

Respondent, in his Motion, also requests an extension of the time for filing his initial disclosures. Petitioner hereby objects to such extension. This is the second time that Respondent has failed to timely serve his initial disclosures and has failed to timely reply to Petitioner’s discovery requests, causing unnecessary delay in this proceeding. Due to Respondent’s first failure to serve initial disclosures the Board reset the trial dates by order on July 7, 2015, giving Respondent 30 days in which to serve initial disclosures.

Respondent failed to comply with the Board’s July 7, 2015 order, and instead waited until August 7, 2015, one day after the deadline for serving initial disclosures, to file his Motion. Respondent gives no explanation for his delay in filing his Motion despite knowing since at least June 23, 2015 that he assigned the mark to Mr. Faustine and knowing since at least July 7, 2015 that the deadline for filing initial disclosures was August 6, 2015. Respondent has made no attempt to contact Petitioner’s counsel to request an extension of the time for serving initial disclosures or responding to Petitioner’s discovery requests. In view of Respondent’s repeated failures to timely participate in discovery and failure to comply with the Board’s July 7, 2015 order,

Petitioner respectfully requests that Respondent's request for extension of time to file initial disclosures be denied and that Respondent again be ordered to participate in discovery as required by the Federal Rules of Civil Procedure and the Trademark Rules of Practice.

### **CONCLUSION**

In view of the foregoing, Petitioner hereby objects to substitution of the respondent and respectfully requests that Respondent's Motion be denied in all respects, that Mr. Faustine be joined rather than substituted, and that Respondent again be ordered to serve initial disclosures and to participate in discovery.

Dated: August 19, 2015

Respectfully submitted,

**/JMD/**

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the above PETITIONER'S RESPONSE AND  
OBJECTION TO RESPONDENT'S MOTION TO SUBSTITUTE NEW PARTY is  
being deposited with the U.S. Postal Service on August 19, 2015 via First Class Mail,  
postage prepaid, to Respondent at the following address:

Gary L. Pifer  
2356 Caddie Court  
Oceanside, CA 92056  
United States

Dated: August 19, 2015

**/JMD/**

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