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

Proceeding	92061407
Party	Defendant Ellie Ann North, Francisco N. Gil, Vivian Gil Rovelli, Victoria Weingartner
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Cancellation No. 92061407

ADVANCE MARKETING PLUS CORP.

vs.

ELLIE ANN NORTH ET AL

_____ /

RESPONDENTS' MOTION TO DISMISS

Respondents, Ellie Ann North, Francisco Gil, Vivian Gil Rovelli and Victoria Weingartner (collectively “Respondents”) hereby file their Motion to Dismiss the Petition for Cancellation filed on April 22, 2015 by Advance Marketing Plus Corp. (the “Petitioner”) with the Trademark Trial and Appeal Board (the “Board”), Cancellation No. 92061407 (the “Petition”).

The Petition should be dismissed on three grounds. First, the Petition should be dismissed based on the doctrine of claim preclusion as the Petitioner previously filed an opposition in the trademark application for the HONGOSAN mark owned by the Respondents, Opposition No. 91157976 (the “Opposition”), involving the same parties and the same claims as the ones in the Petition, and the Opposition was dismissed with prejudice in favor of the Respondents (Section I). Second, the Petition should be dismissed because the Petitioner failed to state a claim for likelihood of confusion because the Petitioner failed to establish priority of use of the HONGOSAN mark (Section II). Third, the Petition should be dismissed because the Petitioner failed to state a claim for abandonment of the HONGOSAN mark by the Respondents (Section III).

I. THE PETITION SHOULD BE DISMISSED BASED ON THE DOCTRINE OF CLAIM PRECLUSION

Under the doctrine of claim preclusion, a judgment on the merits in a prior suit bars a second suit involving the same parties based on the same cause of action. *The Urock Network, LLC v. Umberto Sulpasso*, Cancellation No. 92058974, p. 4, TTAB, July 17, 2015. A copy of the Urock decision is attached as **Exhibit “1.”** Whether the judgment in the prior proceeding was the result of a dismissal with prejudice, it is a final judgment on the merits for claim preclusion purposes. *Id.* p. 6, citing *Morris v. Jones*, 329 U.S. 545, 550-551 (1947). Also, *Flowers Indus Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1583 (TTAB 1987). In *Urock*, the Board construed the respondent’s motion to dismiss based on claim preclusion as a motion for summary judgment. See *The Urock Network, LLC v. Umberto Sulpasso*, Cancellation No. 92058974, p. 2, TTAB, July 17, 2015. The Board granted the respondent’s motion for summary judgment because the petitioner filed a cancellation against the respondent based on the same grounds as the ones the petitioner previously filed against the same respondent in a prior opposition proceeding which was dismissed with prejudice by the Board. *Id.* p. 12.

a) The Parties in the Opposition and in the Cancellation Proceedings are the Same

On September 12, 2003, the Petitioner, Advanced Marketing Plus, Corp., filed a notice of opposition in the trademark application for the HONGOSAN mark, Appl. No. 78/125,003 owned by the Respondents, Ellie Ann North, Francisco Gil, Vivian Gil Rovelli, and Victoria Weingartner (a copy of the notice of opposition is hereby attached as **Exhibit “2”**). After multiple docket entries, the Petitioner filed an amended notice of opposition on December 2, 2005 (the “Amended Notice of Opposition”) (a copy of the Amended Notice of Opposition is hereby attached as **Exhibit “2”**). The Amended Notice of Opposition was the

operative pleading. In the Amended Notice of Opposition, the named parties were as follows: a) the Petitioner was Advanced Marketing Plus, Corp., and b) the Respondents were Ellie Ann North, Francisco Gil, Vivian Gil Rovelli, and Victoria Weingartner (Exh. 2, p.1).

In the instant proceeding, the parties are the same as the parties to the prior opposition proceeding. Indeed, Advanced Marketing Plus, Corp. filed the Petition and the Respondents are Ellie Ann North, Francisco Gil, Vivian Gil Rovelli, and Victoria Weingartner (see Petition, p. 1). As a result, there is an identity of the parties in the opposition and the cancellation proceedings.

b) The Same Claims Were Asserted in the Opposition and in the Cancellation by the Petitioner

As explained above, the Amended Notice of Opposition was the operative pleading in the opposition previously filed by the Petitioner. The Amended Notice of Opposition listed several grounds in support of the opposition. One of the grounds asserted in the Amended Notice of Opposition was the alleged likelihood of confusion between the Petitioner's mark and the Respondent's mark (Exh. 3, p. 1-2, ¶¶ 1-9). The Petitioner alleged that "there is a likelihood of confusion between Opposer's 'HONGOSAN' trademark for its goods and Joint Applicants' 'HONGOSAN' for its alleged goods" (Exh. 3, p. 2, ¶ 8). Another ground asserted in the Amended Notice of Opposition was the alleged abandonment of the HONGOSAN mark by the Respondents (Exh. 3, p. 3-4, ¶¶ 16-21). The Petitioner alleged that "the Joint Applicants ... have abandoned the trademark 'HONGOSAN'" (Exh. 3, p. 3, ¶ 16).

In the Petition, the Petitioner asserts only two grounds for cancellation that were previously asserted in the opposition. The first ground for cancellation asserted in the

Petition is entitled “priority” and alleges that the “Respondents’ mark HONGOSAN, when used for the above references goods, is *likely to cause confusion* or mistake in the market ... with Petitioner’s identical mark.” (Petition, p. 3, ¶7)(emphasis added). As a result, in the Petition, the Petitioner alleges a claim of likelihood of confusion between the Petitioner’s mark and the Respondents’ mark. Therefore, in both the opposition (Exh. 3, p. 1-2, ¶¶ 1-9) and the cancellation, the Petitioner asserted a claim of likelihood of confusion between the Petitioner’s mark and the Respondent’s Mark.

The second ground for cancellation asserted in the Petition is entitled “abandonment” and alleges that the “Petitioner has information and believes that Respondents have discontinued the use of its mark HONGOSAN and that Respondents has abandoned its mark HONGOSAN” (Petition, p. 3, ¶ 8). As a result, in the Petition, the Petitioner alleges a claim of abandonment of the HONGOSAN mark by the Respondents. Therefore, in both the opposition (Exh. 3, p. 3-4, ¶¶ 16-21) and the cancellation, the Petitioner asserted a claim of abandonment of the HONGOSAN mark by the Respondents.

c) There is an Earlier Judgment on the Merits of the Two Claims Asserted in the Petition

In the now terminated opposition, the Respondents filed a motion to dismiss the Amended Notice of Opposition (a copy of the Motion to Dismiss the Amended Notice of Opposition is hereby attached as **Exhibit “4”**). The Respondents’ Motion to Dismiss was granted by the Board on February 15, 2013, and the opposition was dismissed with prejudice (the “Order”) (a copy of the Order from the Board is hereby attached as **Exhibit “5”**). In the Order, the Board held that the “Applicant’s motion (filed December 12, 2012) to dismiss this opposition with prejudice, in accordance with the November 29, 2012 order issued in the

civil action styled Advance Marketing Plus, Corp. v. Marina Wholesale Co., Inc., Civil Action No. 07-CV-03536 (JLL), filed in the U.S. District Court District of New Jersey, is hereby granted as conceded ... Accordingly, the opposition is dismissed with prejudice.” (Exh. 5, Order, pp. 1-2).

As a consequence, because the parties to the opposition and the cancellation proceedings are the same, because the claims alleged in the Petition are the same as the claims alleged in the opposition proceeding, and because the opposition was dismissed with prejudice by the Board, the Petition should be dismissed based on the doctrine of claim preclusion. See *The Urock Network, LLC v. Umberto Sulpasso*, Cancellation No. 92058974, TTAB, July 17, 2015. The Board may treat the present Motion to Dismiss as a motion for summary judgment. *Id.* If the Board chooses to do so, the Respondents respectfully request the Board to grant the Respondents’ motion for summary judgment. In the alternative, the Respondents hereby move the Board to dismiss the Petition based on the doctrine of claim preclusion.

II. THE PETITION SHOULD BE DISMISSED FOR FAILURE TO STATE A CLAIM OF LIKELIHOOD OF CONFUSION

To survive a motion to dismiss for failure to state a claim upon which relief may be granted, a notice of opposition need to allege facts that would, if proven, establish the opposer’s standing to maintain the proceeding and a ground for refusing registration to the applicant. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000). In order to plead a claim of likelihood of confusion, the opposer must plead that it has prior proprietary rights in the mark, and that the use of the parties’ marks in connection with their respective

goods or services would likely cause confusion. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Here, the Petitioner's cancellation is based on its alleged prior common law use of the mark, and the Petitioner's pending Application Serial No. 76488746 for the HONGOSAN mark. The Petitioner also alleges that the Respondents' mark is "likely to cause confusion or mistake in the market and with relevant purchasers with Petitioner's identical mark" (Petition, p. 3, ¶ 7). With respect to the Petitioner's use of the mark, the date of first use listed in the trademark application for the Petitioner's mark is February 2002 and the Petitioner's mark has allegedly been used since that date in connection with "antifungal preparation." (Petition, "Mark Cited by Petitioner as Basis for Cancellation;" *also see* Petition, p. 1, ¶1). Further, the Petitioner claims that it has used in commerce the Petitioner's mark "from a date prior to Respondents' adoption of the mark." (Petition, p. 3, ¶ 6).

However, the Respondents' first use of the Respondents' mark is September 1, 1995 (Petition, "Goods/Services Subject to Cancellation). Therefore, the Petitioner does not allege any fact supporting a claim of likelihood of confusion, as the Petitioner did not allege any fact supporting that it has any prior rights in the HONGOSAN mark. To the contrary, the facts in the Petition show that the Respondents have been using the Respondents' mark since September 1, 1995 while the Petitioner has been using the Petitioner's mark since February 2002. As a consequence, the Petitioner failed to plead that it has prior rights in the HONGOSAN mark. Thus, the Petitioner failed to state a claim for likelihood of confusion and priority, and the Petition should be dismissed on this basis.

III. THE PETITION SHOULD BE DISMISSED FOR ABANDONMENT OF THE MARK

In order to sufficiently plead a claim for cancellation of a mark on grounds of abandonment, the petitioner must plead the ultimate facts pertaining to the alleged abandonment. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925 (TTAB 2014). To adequately plead such a claim, the petitioner must recite facts which, if proven, would establish at least three consecutive years of non use, or alternatively, a period of non use of less than three years coupled with proof of intent not to resume use. *Id.*

In the Petition, the Petitioner simply alleges that the “Petitioner has information and believes that Respondents have discontinued the use of its mark HONGOSAN and that Respondents has abandoned its mark.” (Petition, p. 3, ¶ 8). Such allegation is insufficient as the Petitioner did not allege any fact either that the Respondents ceased use of the HOGOSAN mark for three consecutive years or that the Respondents ceased use of the HONGOSAN mark for less than three years coupled with proof of intent not to resume use. As a consequence, the Petitioner failed to state a claim for abandonment of the Respondents’ mark by the Respondents. The Respondents hereby move the Board to dismiss the Petition for failure to state a claim for abandonment.

WHEREFORE, the Respondents move the Board to grant summary judgment in favor of the Respondents based on the doctrine of claim preclusion, or, in the alternative, the Respondents move the Board to dismiss the Petition with prejudice for the reasons stated in this Motion to Dismiss.

Dated: August 26, 2015

Respectfully submitted
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CERTIFICATE OF SERVICE

I hereby certify that this Motion to Dismiss is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below. I hereby further certify that on the date indicated below true and complete copy of this Motion to Dismiss has been served on opposing counsel listed below by electronic mail.

/s/ Isabelle Jung

Isabelle Jung

August 26, 2015

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EXHIBIT 1

This Decision is a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: July 17, 2015

Cancellation No. 92058974

The Urock Network, LLC

v.

Umberto Sulpasso

**Before Seeherman, Ritchie and Hightower, Administrative Trademark
Judges.**

By the Board:

The Urock Network, LLC (“UNL”) seeks to cancel the registration of the mark

UROCK

owned by Umberto Sulpasso (“Mr. Sulpasso”) for “digital media, namely, CDs, DVDs, downloadable audio files, featuring music” in International Class 9 and “entertainment, namely, live performances by a musical band” in International Class 41.¹

In its petition to cancel, UNL pleads ownership of an application, Serial No. 85746452, for the mark THE UROCK NETWORK, which, as indicated in the

¹ Registration No. 4493189 issued March 11, 2014 based on Section 44(e).

ESTTA cover sheet² submitted with the petition, seeks registration of the mark for “downloadable MP3 files, MP3 recordings, on-line discussion board posts, webcasts, webinars and podcasts featuring music, audio books in the field of music, and news broadcasts” in International Class 9. UNL alleges that the continued registration of Mr. Sulpasso’s mark “creates confusion among consumers”; that it seeks cancellation on the ground of “[p]riority of first use and the likelihood of confusion for goods and services” under Section 2(d) of the Trademark Act; and that Mr. Sulpasso’s mark has “been cited against our application for registration under [application Serial No.] 85746452.”³ TTABVue Doc. 1 (at p. 1).

In lieu of an answer, Mr. Sulpasso filed a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) which the Board construed as a motion for summary judgment based on *res judicata* or claim preclusion.⁴ The motion has been fully briefed.

² Because the ESTTA cover sheet forms part of the petition to cancel, it provides details of Petitioner’s pleaded application (e.g., to establish the alleged goods or services in a plaintiff’s pleaded application or registration). See *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (“Since ESTTA’s inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board”); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (“[The ESTTA] form, along with any attached supplementary elaboration of the basis for the opposition, serves as the complaint in the opposition proceeding”); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) (“[T]he ESTTA generated filing form ... is considered part of the plaintiff’s initial pleading”).

³ The current owner for application Serial No. 85746452 is listed as John Kevin Timothy, whose relationship to UNL is discussed *infra*.

⁴ The judicial doctrine now generally known as claim preclusion was earlier known as *res judicata*. See *Senju Pharm. Co. v. Apotex Inc.*, 746 F.3d 1344, 110 USPQ2d 1261, 1263 (Fed. Cir. 2014). Because the Board construed Mr. Sulpasso’s motion to dismiss as a motion for summary judgment based on this doctrine, the Board’s July 28, 2014 order allowed the parties additional time to supplement their briefing. No supplemental briefing was submitted.

Motion for Summary Judgment⁵

Mr. Sulpasso asserts that he won a prior proceeding – Opposition No. 91197690 (“the ’690 opposition”)⁶ – involving the same parties and based on the same claims. Specifically, Mr. Sulpasso asserts that John Kevin Timothy, the opposer in the earlier proceeding, is in privity with UNL and that Timothy unsuccessfully asserted claims of likelihood of confusion under Section 2(d) against the underlying application that matured into Mr. Sulpasso’s Registration No. 4493189. In support of his motion, Mr. Sulpasso has submitted copies of the notice of opposition, the motion to dismiss the opposition, and the Board’s decision dismissing the opposition.

UNL concedes that it is the same party as the opposer in the ’690 opposition. TTABVue Doc. 6 (at p.3). However, UNL argues that the ’690 opposition was decided on a “[t]echnical [p]rocedure,” and that UNL’s marks and goods and services at issue in the ’690 opposition are different from the marks and goods and services at issue in this cancellation. *Id.* (at p.2).

⁵ Although Mr. Sulpasso has not yet made its initial disclosures, this motion is not premature. In general, a party may not file a motion for summary judgment until the party has made its initial disclosures. Trademark Rule 2.127(e)(1); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). However, this rule has two exceptions: 1) a motion asserting lack of jurisdiction by the Trademark Trial and Appeal Board; or 2) a motion asserting claim or issue preclusion. Trademark Rule 2.127(e)(1); *Zoba Int’l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion). Since this motion is based on claim preclusion, and we *sua sponte* converted it into a summary judgment motion, there is no prematurity issue.

⁶ Upon motion by Mr. Sulpasso (then the applicant) to dismiss the ’690 opposition pursuant to Trademark Act § 2.132(a) for UNL’s failure to take testimony or enter evidence, the Board dismissed the opposition with prejudice. *John Timothy v. Umberto Sulpasso* (Opposition No. 91197690) (TTAB Feb. 3, 2014).

Entry of summary judgment is appropriate only where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts on summary judgment; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Claim Preclusion

As explained by our primary reviewing court, the doctrines of claim preclusion and issue preclusion “preclude certain attempts at second litigation chances, but only in defined circumstances, reflecting the need to avoid depriving litigants of their first chances.” *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1171 (Fed. Cir. 2013). Under the doctrine of claim preclusion, “a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.” *Jet Inc. v. Sewage*

Aeration Sys., 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000) (*quoting Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)).

For claim preclusion to apply, therefore, there must be:

- (1) identity of parties (or their privies);
- (2) an earlier final judgment on the merits of a claim; and
- (3) a second claim based on the same set of transactional facts as the first.

Id.

We act with cautious restraint when applying this equitable doctrine, in the interests of both justice for the litigants and protecting the public from confusion. *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314 (Fed. Cir. 2005); *see also Sharp Kabushiki Kaisha v. ThinkSharp Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1379 (Fed. Cir. 2006).

- ***First Factor – Identity of Parties***

There is no dispute between the parties that Mr. Timothy and UNL are the same entity. Although the '690 opposition was brought by “John Kevin Timothy dba UROCK Radio,” and the present proceeding was filed by The Urock Network, LLC, UNL has conceded that it and the opposer in the '690 opposition are “the same person.” TTABVue Doc. 6 (at p.3). In this connection, we note that in the petition for cancellation Mr. Timothy identifies himself as acting manager of UNL.⁷ *See John W. Carson Found v. Toilets.com Inc*, 94 USPQ2d 1942, 1947 (TTAB 2010), (*citing Kraeger v. General Electric Co.*, 497 F.2d 468, 472 (2d. Cir. 1974) (The president and sole shareholder of a corporation was bound by the corporation's defeat in an action

⁷ The petition to cancel was also signed by Mr. Timothy.

that he effectively controlled); and *Vitronics Corp. v. Conceptronic, Inc.*, 27 USPQ2d 1046, 1049 (D.N.H. 1992) (founder and CEO of corporation in privity with corporation)). Further, Mr. Sulpasso is the same party as the applicant in the '690 opposition.

- ***Second Factor – An Earlier Final Judgment on the Merits of a Claim***

In its dismissal of the '690 opposition, after analyzing whether Mr. Timothy's motion to reopen his testimony period to submit late-filed testimony and evidence and subsequently denying that motion, the Board determined that Mr. Timothy "has offered no reasons why he was not diligent in prosecuting his case" and failed to properly introduce testimony or evidence in support of his case. Opp. No. 91197690 TTABVue Doc. 51 (at p.7). The Board went on to explain that "[Mr. Timothy] bears the burden of coming forward with evidence to support his case and it is clear that [Mr. Timothy] has not done so here." *Id.* As a result, the Board held that "[i]nasmuch as [Mr. Timothy] has not submitted any record evidence in support of his case, [Mr. Sulpasso's] motion for judgment is granted. Accordingly, the opposition is dismissed with prejudice." (emphasis deleted) *Id.* (at p.8).

Notwithstanding UNL's contention that claim preclusion is inapplicable here because the prior proceeding was ended by a "technical procedure," whether the judgment in the prior proceeding was the result of a dismissal with prejudice or even default, for claim preclusion purposes, it is a final judgment on the merits. *See, e.g., Morris v. Jones*, 329 U.S. 545, 550-51 (1947) ("A judgment of a court having jurisdiction of the parties and of the subject matter operates as res judicata, in the

absence of fraud or collusion, even if obtained upon a default.”) (citation omitted); *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 566 (CCPA 1979) (“Default judgments generally operate as res judicata”) (citations omitted); *see also Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1314-15 (TTAB 2010) (granting summary judgment to registrant on claim preclusion where petitioner’s prior opposition had been dismissed with prejudice for failure to prosecute the case); *La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a.*, 8 USPQ2d 1143, 1146 (TTAB 1988) (“Issue preclusion operates only as to issues actually litigated, whereas claim preclusion may operate between the parties simply by virtue of the final judgment.”); *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1583 (TTAB 1987) (claim preclusion applies “even when the prior judgment resulted from default, consent, or dismissal with prejudice”); *USOC v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (“default judgments generally operate as res judicata”).

In the circumstances presented here, we hold that the dismissal with prejudice of the ’690 opposition was a final judgment which may give rise to claim preclusion.

- ***Third Factor – A Second Claim Based on the Same Set of Transactional Facts as the First***

This case implicates the defensive doctrine of “bar,” wherein the Board must analyze whether the plaintiff can bring a subsequent case against a defendant. *See Jet Inc.*, 55 USPQ2d at 1856 (stating that the doctrine of claim preclusion “has come to incorporate common law concepts of merger and bar, and will thus also bar a second suit raising claims based on the same set of transactional facts”) (*citing*

Migra v. Warren City School Dist. Bd. of Educ., 465 U.S. 75, 77 n.1 (1984)). RESTATEMENT (SECOND) OF JUDGMENTS § 19 (1982) provides that “a valid and final personal judgment rendered in favor of the defendant bars another action by the plaintiff on the same claim.” This bar extends to relitigation of “claims that were raised or could have been raised” in an earlier action. *Allen v. McCurry*, 449 U.S. 90, 94 (1980) (emphasis added); *Migra*, 465 U.S. at 77 n.1. Thus, under claim preclusion, a plaintiff is barred from a “subsequent assertion of the same transactional facts in the form of a different cause of action or theory of relief.” *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1173 (Fed. Cir. 1989).

Although Mr. Sulpasso compares the commercial impressions made by marks UNL asserted here and in the '690 opposition (THE UROCK NETWORK and UROCK RADIO, respectively), he does not need to do so, as that is not pertinent to the issue before us. When, as here, the Board analyzes the *defensive* doctrine of bar, we need determine only whether the proceedings arise from the same transactional facts and thus could have been brought in the previous proceeding.⁸

The Court of Appeals for the Federal Circuit has stated that it is guided by the analysis set forth in the Restatement (Second) of Judgments in determining whether a plaintiff's claim in a particular case is barred by claim preclusion. *See Jet*

⁸ In contrast, it is the doctrine of “merger,” or *offensive* claim preclusion, that requires an assessment of whether a party's new mark makes the same commercial impression as its previously litigated mark and whether the goods or services are the same. *See, e.g., Sharp Kabushiki Kaisha*, 79 USPQ2d at 1378-79; *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187, 189-90 (Fed. Cir. 1984).

Inc., 55 USPQ2d at 1856; *Chromalloy American Corp.*, 222 USPQ at 189-90. Section 24 of the Restatement (Second), which addresses splitting claims, provides that:

(1) When a valid and final judgment rendered in an action extinguishes the plaintiff's claim pursuant to the rules of merger or bar . . . the claim extinguished includes all rights of the plaintiff to remedies against the defendant with respect to all or any part of the transaction, or series of connected transactions, out of which the action arose.

(2) What factual grouping constitutes a "transaction", and what grouping constitutes a "series", are to be determined pragmatically, giving weight to such considerations as whether the facts are related in time, space, origin or motivation, whether they form a convenient trial unit, and whether their treatment as a unit conforms to the parties' expectations or business understanding or usage.

Furthermore, Section 25 of the Restatement provides that the rule of Section 24 applies to extinguish a claim by the plaintiff against the defendant even though the plaintiff is prepared in the second action:

(1) To present evidence or grounds or theories of the case not presented in the first action, or

(2) To seek remedies or forms of relief not demanded in the first action.

To assess whether the claims are based on the same set of transactional facts, comment b to Section 24 of the Restatement considers whether there is a common nucleus of operative facts. As noted, relevant factors include whether the facts are so woven together as to constitute a single claim in their relatedness in time, space, origin, or motivation, and whether, taken together, they form a convenient unit for trial purposes. *Id.* The same comment notes that:

Though no single factor is determinative, the relevance of trial convenience makes it appropriate to ask how far the witnesses or proofs in the second action would tend to overlap the witnesses or proofs relevant to the first. If there is a substantial overlap, the second action should ordinarily be held

precluded. But the opposite does not hold true; even when there is not a substantial overlap, the second action may be precluded if it stems from the same transaction or series.

Id. Courts have defined “transaction” in terms of a “core of operative facts,” the “same operative facts,” or the “same nucleus of operative facts,” and “based on the same, or nearly the same, factual allegations.” *Jet Inc.*, 55 USPQ2d at 1856 (*quoting Herrmann v. Cencom Cable Assoc., Inc.*, 999 F.2d 223, 226 (7th Cir. 1993)); *see also United States v. Haytian Rep.*, 154 U.S. 118, 125 (1894) (“One of the tests laid down for the purpose of determining whether or not the causes of action should have been joined in one suit is whether the evidence necessary to prove one cause of action would establish the other.”).

Applying this analysis, we reiterate first that the mark that UNL asserts in this cancellation is THE UROCK NETWORK, and that the basis asserted for cancellation is priority of use and likelihood of confusion. Specifically, UNL alleges use of the mark THE UROCK NETWORK “on a continuing basis from a date which supersedes registrant by 10 years.” TTABVue Doc. 1 (at p.1). Looking to the ’690 opposition, we note the body of the complaint in the ’690 opposition alleges priority and apparent likelihood of confusion based on common law rights in UROCK and various URLs “including but not limited to urockradio.net, **the urocknetwork.com**, **.net**, urock.info, urocradio.net in all about 15 names.” (emphasis added) Opp. No. 91197690 TTABVue Doc. 1 (at p.1).⁹ More specifically, in

⁹ While not specifically addressed in the body of the complaint, the ESTTA coversheet in the ’690 opposition indicates Mr. Timothy also alleged rights in application Serial No. 85047110 for the mark UROCK RADIO and based the opposition on the ground of priority and likelihood of confusion under Trademark Act § 2(d). *See UMG Recordings Inc. v. Mattel Inc.*,

his Memorandum in Support of [His] Motion for Summary Judgment in the prior '690 opposition proceeding,¹⁰ Mr. Timothy specifically asserted:

Also commencing in 1999, and continuously through the present day, Opposer has been providing radio broadcasting and entertainment services under one or more of a family of service marks including, but not limited to: . . . THE UROCK NETWORK . . . and/or other derivatives of the names and marks UROC and UROCK (hereinafter collectively the "UROCK Marks.").

Opp. No. 91197690 TTABVue Doc. 20 (at p.4.)

UNL's argument that the '690 opposition was focused on rights in the mark UROCK RADIO thus is unpersuasive. The alleged prior use of the mark THE UROCK NETWORK clearly not only relates to, but was a part of, the '690 opposition. There can be no question that the '690 opposition and this cancellation necessarily involve the same nucleus of operative facts such that both proceedings stem from the same set of transactional facts. UNL and its alter ego Mr. Timothy, plainly not only had the facts necessary to bring the claim of likelihood of confusion relating to alleged priority rights in the mark THE UROCK NETWORK based on prior use at the time of filing the '690 opposition, but he actually included that mark in the '690 proceeding. *See Akhenaten v. Najee, LLC*, 544 F.Supp.2d 320, 330 (S.D.N.Y. 2008) (Plaintiff's alleged use and registration of FUBU and similar marks

100 USPQ2d 1868, 1872-73 (TTAB 2011) (Where counterclaim did not identify particular registration to which counterclaim applies, counterclaim found to pertain to registration identified in the ESTTA filing form. "[T]he Board considers the ESTTA filing form and the attachment thereto, *i.e.*, the statement of grounds for the petition to cancel, to comprise a single document"); *PPG Industries Inc.*, 73 USPQ2d at 1928 (the ESTTA cover sheet is read in conjunction with the notice of opposition as an integral component).

¹⁰ The Board may take notice of filings in other TTAB proceedings. *Kraft, Inc. v. Balin*, 209 USPQ 877, 881 n.8 (TTAB 1981).

could have been raised in the prior action, and therefore, the subsequent action is barred by *res judicata*).

Decision

Based on the record before us, we find that there is no genuine dispute as to the applicability of claim preclusion in this case in light of the Board's February 3, 2014 decision rendered in Opposition No. 91197690. UNL's arguments and evidence are insufficient to show the existence of a genuine dispute as to a material fact for trial. Therefore, Mr. Sulpasso's motion for summary judgment is **GRANTED**. Judgment is entered against UNL, and the petition for cancellation is **DISMISSED with prejudice**.¹¹

¹¹ We note that UNL, in the last paragraph of its response to the motion for summary judgment makes reference to "the likelihood of 'Abandonment'" of respondent's mark and the asserted failure of respondent's band to perform "in front of a paying audience in the USA" as a reason why this case should proceed. This throw-in sentence in the conclusion to the response is not a sufficient pleading of a new claim, and petitioner has not submitted a proposed amended pleading. Thus, this throw-in sentence will receive no further consideration. See TBMP § 507.01 ("A signed copy of the proposed amended pleading should accompany a motion for leave to amend a pleading."). Furthermore, absent an allegation that the facts have changed substantially since the '690 opposition, this claim is likely barred by *res judicata*.

EXHIBIT 2

TTAB

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

In the matter of trademark application Serial No. 78/125,003
For the mark "HONGOSAN"
Published in the Official Gazette on June 3, 2003

Advance Marketing Plus, Corp.,)
a Florida corporation,)
)
Opposer,)
)
vs.)
)
Ellie Ann North,)
Francisco N. Gil,)
Vivian Gil Rovelli,)
Victoria Weingartner)
)
Joint Applicants.)

Opposition No.



09-12-2003
U.S. Patent & TMO/c/TM Mail Rpt Dt. #78

NOTICE OF OPPOSITION

COMES NOW the Opposer, Advance Marketing Plus, Corp. ("Advance Marketing Plus" or "Opposer"), a Florida corporation having an address at 10306 USA Today Way, Miramar, Florida 33025, and opposes Application Serial No. 78/125,003, owned by Joint Applicants Ellie Ann North, having an address of 1018 Paterson Plank Road, North Bergen, New Jersey 07047; Francisco N. Gil, having an address of 4309 Kennedy Blvd., North Bergen, New Jersey 07047; Vivian Gil Rovelli, having an address of 199 Hillcrest, Leonia, New Jersey 07605; and Victoria Weingartner, having an address of 159 Herman Street, Hackensack, New Jersey 07601 ("Joint Applicants"). Opposer believes that it is or will be damaged by Serial No. 78/125,003, and alleges the following for opposition of same:

09/26/2002TJA

FIRST GROUND FOR OPPOSITION

1. The alleged trademark sought to be opposed is Serial No. 78/125,003, for the alleged mark "HONGOSAN", for use in connection with "antifungal remedies in the forms of liquid, soap, spray, powder, talk [sic], ointment and creme [sic]" in International Class 05.

2. Joint Applicants claim a filing date of April 29, 2002 based on an intent-to-use basis, and claim a date of first use (presumably outside of the United States) of June 15, 1995 and date of first use in commerce of September 1, 1995, a date prior to filing of the intent-to-use application.

3. Opposer adopted the trademark "HONGOSAN" for use in connection with an "antifungal preparation" in International Class 05. Since its adoption, Opposer has continuously used the "HONGOSAN" trademark in interstate commerce for and in connection with such goods and has not abandoned this mark.

4. Opposer has expended considerable time, money, and effort in promoting its goods under the "HONGOSAN" trademark. The strength of the "HONGOSAN" trademark has continuously grown, such that Opposer has established exceedingly valuable goodwill in the "HONGOSAN" trademark.

5. Opposer has applied to register the trademark "HONGOSAN" for use in connection with an "antifungal preparation" in the U.S. Patent and Trademark Office and has been assigned Serial No. 76/488,746.

6. The alleged trademark of the Joint Applicants, Serial No.

78/125,003, is identical or highly similar to Opposer's "HONGOSAN" trademark.

7. The goods identified in Joint Applicant's application are highly similar to Opposer's goods.

8. There is a likelihood of confusion between Opposer's "HONGOSAN" trademark for its goods and Joint Applicant's "HONGOSAN" trademark for its goods, as set forth in Serial No. 78/125,003.

9. If Joint Applicants are permitted to obtain a registration for the mark "HONGOSAN" for and in connection with "antifungal remedies in the forms of liquid, soap, spray, powder, talk [sic], ointment and creme [sic]", there will be a continued likelihood of confusion, mistake, and deception among the consuming public and the trade, all in violation of §2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

SECOND GROUND FOR OPPOSITION

10. Upon information and belief, Opposer alleges that the Joint Applicants did not have a *bona fide* intention to use the trademark "HONGOSAN" in commerce at the time the application was filed.

11. The Joint Applicant's application for "HONGOSAN" is *void ab initio* since the Joint Applicants did not have a *bona fide* intent to use the mark as Joint Applicants, but instead have allowed others, possibly other types of legal entities, to use the mark.

12. Upon information and belief, Opposer alleges that Joint Applicants had not made *bona fide* use of Joint Applicant's mark,

09/20/2008 11:42 AM

pursuant to the requirements of 15 U.S.C. §§1051, 1127, as of the date of first use, September 1, 1995, as alleged in their application, or at any time thereafter.

13. Upon information and belief, Opposer alleges that the Joint Applicants have failed to use the alleged trademark "HONGOSAN" in interstate commerce.

14. Upon information and belief, Opposer alleges that the alleged use of the mark, if any, was made in another form, and that such use does not provide a basis for Joint Applicants to register the mark "HONGOSAN".

15. Opposer alleges that the use of the mark "HONGOSAN" by a related entity does not provide a basis for Joint Applicants to register the mark because Joint Applicants did not allege that use of the mark by a related entity was controlled by Joint Applicants with respect to the nature and quality of the goods used in connection with the mark.

THIRD GROUND FOR OPPOSITION

16. The Joint Applicants, to the extent that they ever enjoyed any trademark rights, have abandoned the trademark "HONGOSAN".

17. Upon information and belief, Joint Applicants, in filing for their application, merely attempted to reserve a right in the mark without *bona fide* use of the mark in the ordinary course of trade.

18. Upon information and belief, there has been a break in the chain of priority, to the extent any priority ever existed, of

the Joint Applicant's use of the trademark "HONGOSAN".

19. Upon information and belief, the break in the chain of priority occurred for more than three (3) years, thus constituting abandonment under 15 U.S.C. §1127.

20. Upon information and belief, Joint Applicants have no intent to resume such use (if any ever occurred) of the trademark "HONGOSAN".

21. The Joint Applicants, to the extent that any trademark rights ever existed, have forfeited the trademark "HONGOSAN".

FOURTH GROUND FOR OPPOSITION

22. Upon information and belief, Opposer alleges that the Joint Applicants fraudulently stated in a September 26, 2002 correspondence to the United States Patent and Trademark Office that the mark has been in use by Joint Applicants since September 1995.

23. Upon information and belief, Joint Applicants knew or should have known that they made a false, material misrepresentation to the United States Patent and Trademark Office when they stated that they applied for mark "HONGOSAN" was currently in use in United States commerce by Joint Applicants.

24. Upon information and belief, the United States Patent and Trademark Office would not have issued the mark for publication in the *Official Gazette* had it known that the Joint Applicants did not control the nature and quality of the goods used in connection with the mark in United States Commerce.

25. Upon information and belief, Joint Applicants knew or

09/20/03 09:07:12 AM

should have known that it made a false, material misrepresentation to the United States Patent and Trademark Office in claiming a *bona fide* use in commerce of the "HONGOSAN" mark in their Application based upon Section 1(a) of the Lanham Act.

26. Upon information and belief, the United States Patent and Trademark Office would not have issued the mark for publication in the Official Gazette, but for its reasonable reliance on Joint Applicant's false, material misrepresentation of their use in commerce of the "HONGOSAN" mark.

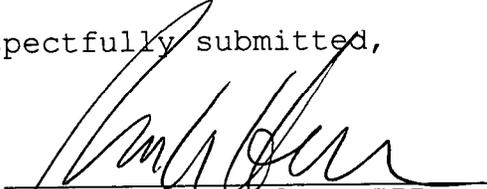
27. Because of Joint Applicant's false, material misrepresentations to the United States Patent and Trademark Office damage has occurred, and therefore registration of the applied-for mark must be refused.

WHEREFORE, Opposer prays that this Opposition be granted and that the aforesaid application Serial No. 78/125,003 be denied registration.

A duplicate copy of this Notice of Opposition and the fee required in § 2.6(a)(16) are enclosed herewith.

Respectfully submitted,

Dated: 9/12, 2003

By: 

John Cyril Malloy, III
Florida Bar No. 964,220
Frank Herrera
Florida Bar No. 494,801
MALLOY & MALLOY, P.A.
Attorneys for Opposer
2800 S.W. Third Avenue
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008
Email: fh@malloylaw.com

08/20/2003 11:48

CERTIFICATE OF EXPRESS MAILING

I HEREBY CERTIFY that a true and correct copy of the foregoing document is being deposited by United States Express Mail, Label No. EL 920410809 US, in an envelope addressed to: TTAB BOX FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia, 22202-3513, this 12th day of September, 2003.

Respectfully submitted,

By:

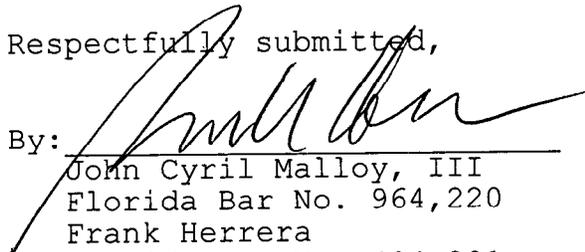

John Cyril Malloy, III
Florida Bar No. 964,220
Frank Herrera
Florida Bar No. 494,801
MALLOY & MALLOY, P.A.
Attorneys for Opposer
2800 S.W. Third Avenue
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008
Email: fh@malloylaw.com

EXHIBIT 3

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

ADVANCE MARKETING PLUS, CORP.))	
Opposer,))	
v.))	Opposition No. 91157976
ELLIE ANN NORTH, FRANCISCO))	
GIL, VIVIAN GIL ROVELLI and))	
VICTORIA WEINGARTNER))	
Joint Applicants.))	

OPPOSER’S AMENDED NOTICE OF OPPOSITION

COMES NOW Opposer, Advance Marketing Plus, Corp., (“AMP”), a Florida corporation having an address at 10306 USA Today Way, Miramar, Florida 33025, and pursuant to this Board’s October 19, 2005 Order hereby files its Amended Notice of Opposition against Application Serial No. 78/125,003, filed by Joint Applicants Ellie Ann North, having an address of 1018 Paterson Plank Road, North Bergen, New Jersey 07047; Francisco N. Gil, having an address of 4309 Kennedy Blvd., North Bergen, New Jersey 07047; Vivian Gil Rovelli, having an address of 199 Hillcrest, Leonia, New Jersey 07605; and Victoria Weingartner, having an address of 159 Herman Street, Hackensack, New Jersey 07601 (hereinafter collectively referred to as “Joint Applicants”). Opposer believes that it is or will be damaged by Serial No. 78/125,003, and alleges the following for opposition of same:

FIRST GROUND FOR OPPOSITION

1. The alleged trademark sought to be opposed is Serial No. 78/125,003, for the alleged mark “HONGOSAN”, for use in connection with “antifungal remedies in the forms of liquid, soap, spray, powder, talk [sic], ointment and crème [sic]” in International Class 05.
2. Joint Applicants filed the subject trademark application on April 29, 2002 based on an intent-to-use basis and by stating a date of first use anywhere of June 15,



1995 and date of first use in commerce of September 1, 1995.

3. At least as early as February of 2002, Opposer adopted the trademark "HONGOSAN" for use in connection with an "antifungal preparation". Since its adoption, Opposer has continuously used the "HONGOSAN" trademark in interstate commerce for and in connection with such goods and has not abandoned this mark. Since Joint Applicants have not made any *bona fide* use of their alleged mark, prior to Opposer's first use date, Opposer enjoys priority of use. Alternatively, if Joint Applicants made some *bona fide* use of the mark prior to Opposer's use, a break in the chain of priority/abandonment has occurred such that Opposer now enjoys priority of use throughout the United States.

4. Opposer has expended considerable time, money, and effort in promoting its goods bearing the "HONGOSAN" trademark throughout all areas of the United States as well as in several foreign countries by way of television, radio, print and other means. The notoriety and strength of Opposer's "HONGOSAN" trademark has continuously grown, such that Opposer has established exceedingly valuable goodwill in the "HONGOSAN" trademark.

5. On February 10, 2003 Opposer applied to register its trademark "HONGOSAN" for use in connection with an "antifungal preparation" in the United States Patent and Trademark Office and was assigned Serial No. 76/488,746.

6. The Joint Applicants' alleged trademark, Serial No. 78/125,003, is identical or highly similar to Opposer's "HONGOSAN" trademark.

7. The goods identified in the Joints Applicants' application are highly similar to Opposer's goods.

8. There is a likelihood of confusion between Opposer's "HONGOSAN" trademark for its goods and Joint Applicants' "HONGOSAN" for its alleged goods as set forth in their pending application Serial No. 78/125,003.

9. If Joint Applicants are permitted to obtain a registration for the mark "HONGOSAN" for and in connection with "antifungal remedies in the forms of liquid, soap, spray, powder, talk [sic], ointment and cr me [sic]", there will be a continued likelihood of confusion, mistake, and deception among the consuming public and the trade, all in violation of §2(d) of the Lanham Act, 15 U.S.C. §1052(d).

SECOND GROUND FOR OPPOSITION

10. Upon information and belief, Opposer alleges that the Joint Applicants did not have a *bona fide* intention to use the trademark "HONGOSAN" on any or all of the applied for goods in commerce at the time the application was filed.

11. The Joint Applicants' application for "HONGOSAN" is *void ab initio* since the Joint Applicants did not have a *bona fide* intent to use the mark as Joint Applicants, but instead have allowed others, possibly by other legal entities, to use the mark.

12. Upon information and belief, Opposer alleges that Joint Applicants had not made *bona fide* use of Joint Applicants' mark pursuant to the requirements of 15 U.S.C. §§1051, 1127, as of the date of first use, September 1, 1995, as alleged in their application, or at any time thereafter.

13. Upon information and belief, Opposer alleges that the Joint Applicants have failed to use the alleged trademark "HONGOSAN" on any or all of the applied for goods in interstate commerce.

14. Upon information and belief, Opposer alleges that the alleged use of the mark, if any, was made in another form, and that such use does not provide a basis for Joint Applicants to register the mark "HONGOSAN".

15. Opposer alleges that the use of the mark "HONGOSAN" by a related entity, if at all, does not provide a basis for Joint Applicants to register the mark because Joint Applicants did not allege that use of the mark by a related entity was controlled by Joint Applicants with respect to the nature and quality of the goods used in connection with the mark.

THIRD GROUND FOR OPPOSITION

16. The Joint Applicants, to the extent that they ever enjoyed any trademark rights, have abandoned the trademark "HONGOSAN".

17. Upon information and belief, Joint Applicants, in filing their application, merely attempted to reserve a right in the mark without *bona fide* use of the mark in the ordinary course of trade.

18. Upon information and belief, there has been a break in the chain of priority, to the extent any priority ever existed, of the Joint Applicants' use of the trademark "HONGOSAN".

19. Upon information and belief, the break in the chain of priority occurred for more than three (3) years, thus constituting abandonment under 15 U.S.C. §1127.

20. Upon information and belief, Joint Applicants have no intent to resume such use (if any ever occurred) of the trademark "HONGOSAN".

21. The Joint Applicants, to the extent that any trademark rights ever existed, have forfeited the trademark "HONGOSAN".

FOURTH GROUND FOR OPPOSITION

22. Upon information and belief, Opposer alleges that the Joint Applicants fraudulently stated in a September 26, 2002 correspondence to the United States Patent and Trademark Office that the mark has been in use on all listed goods by Joint Applicants since September 1995.

23. Upon information and belief, Joint Applicants knew or should have known that they made a false, material misrepresentation to the United States Patent and Trademark Office when they stated that they applied for mark "HONGOSAN" was currently in use on all applied for goods in United States commerce by Joint Applicants.

24. Upon information and belief, the United States Patent and Trademark Office would not have issued the mark for publication in the *Official Gazette* had it known that the Joint Applicants did not control the nature and quality of the goods used in connection with the mark in United States Commerce.

25. Upon information and belief, Joint Applicants knew or should have known that they made a false, material misrepresentation to the United States Patent and Trademark Office in claiming a *bona fide* use in commerce of the "HONGOSAN" mark in their application based upon Section 1(a) of the Lanham Act.

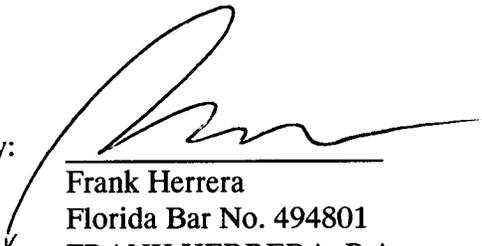
26. Upon information and belief, the United States Patent and Trademark Office would not have issued the mark for publication in the *Official Gazette*, but for its reasonable reliance on the Joint Applicants' false, material misrepresentation of their use in commerce of the "HONGOSAN" mark on all applied for goods.

27. Because of the Joint Applicants' false, material misrepresentations to the United States Patent and Trademark Office damage has occurred and continues to occur, and therefore registration of the applied-for-mark must be refused.

WHEREFORE, Opposer prays that this Opposition be granted and that the aforesaid application Serial No. 78/125,003 be denied registration.

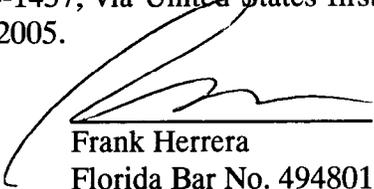
Dated: November 18, 2005

By:


Frank Herrera
Florida Bar No. 494801
FRANK HERRERA, P.A.
Lawyers Plaza, Fifth Floor
2250 S.W. Third Avenue,
Historic Coral Way,
Miami, Florida 33129
Tel.: (305) 860-8910
Fax.: (305) 860-8944
fh@frankherrerapa.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served on Brewster Taylor, Esq., STITES & HARBISON, PLLC, TransPotomac Plaza, 1199 North Fairfax Street, Suite 900, Alexandria, Virginia 22314-1437, via United States first class mail, postage pre-paid this 18 day of November, 2005.


Frank Herrera
Florida Bar No. 494801

CERTIFICATE OF EXPRESS MAILING

I HEREBY CERTIFY that a true and correct copy of the foregoing was deposited by United States Express Mail, Label No. ED 721843213 US in an envelope addressed to: United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451, this 18 day of November, 2005.

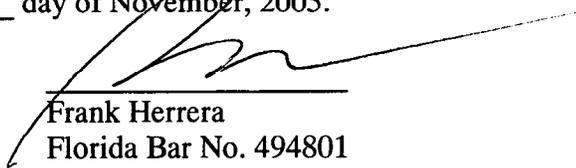

Frank Herrera
Florida Bar No. 494801

EXHIBIT 4

ESTTA Tracking number: **ESTTA510417**

Filing date: **12/12/2012**

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

Proceeding	91157976
Party	Defendant Ellie Ann North et al
Correspondence Address	BREWSTER TAYLOR STITES HARBISON PLLC 1199 NORTH FAIRFAX STREET, SUITE 900 ALEXANDRIA, VA 22314 UNITED STATES btaylor@stites.com
Submission	Other Motions/Papers
Filer's Name	BREWSTER TAYLOR
Filer's e-mail	BTAYLOR@STITES.COM
Signature	/bt/
Date	12/12/2012
Attachments	APPLICANT'S MOTION TO DISMISS OPPOSITION WITH PREJUDICE.pdf (8 pages)(213389 bytes)

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

ADVANCE MARKETING PLUS, CORP.,)

Opposer,)

v.)

ELLIE ANN NORTH, FRANCISCO)
GIL, VIVIAN GIL ROVELLI and)
VICTORIA WEINGARTNER,)

Applicants)

Opposition No. 91157976

APPLICANTS' MOTION TO DISMISS OPPOSITION WITH PREJUDICE

Further to the order of the Trademark Trial and Appeal Board dated August 27, 2012, and pursuant to a settlement agreement between the parties and the order of the U.S. District Court District of New Jersey dated November 29, 2012 (attached as Exhibit A), Applicants hereby move for dismissal with prejudice of the above opposition.

On August 2, 2007, Opposer Advance Marketing Plus Corp. filed a motion with the Trademark Trial and Appeal Board for suspension of this proceeding pending disposition of a civil action in the U.S. District Court for the District of New Jersey, attaching a copy of the complaint and stating that "resolution of this matter would appear to be better resolved in the United States District Court".

In the attached order of November 29, 2012, the U.S. District Court enters judgment in the civil action in favor the defendants/counterclaimants on their unopposed motion to "enforce the settlement Agreement and enter judgment in favor of defendants/counterclaimants". The Court entered judgment for the Applicants, "in the sum of \$234,560.61 plus interest from August 1, 2012, plus attorneys' fees in an amount to be awarded upon submission of an Affidavit of Legal Services by defendants' counsel" and further ordered that "the parties are to take steps in conformance with this Order to request from the Trademark Trial and Appeal Board a dismissal of Proceeding No. 91127976 presently pending before said Board".

As shown by the e-mail correspondence of December 11 between the undersigned and Opposer's counsel of record (copies of which are attached as Exhibit B), counsel for Applicant contacted Opposer's counsel of record and was advised that Opposer's counsel of record had "not been counsel for AMP for several years". However, the counsel of record has not withdrawn as counsel or been replaced by new counsel in these proceedings.

Applicants respectfully request that pursuant to the Settlement Agreement and the Court order that the Opposition proceedings be dismissed "in conformance with this Order", the above Opposition be dismissed with prejudice.

Respectfully Submitted,
STITES & HARBISON, PLLC



Brewster Taylor
Transpotomac Plaza
1199 North Fairfax St., Ste. 900
Alexandria, Virginia 22314
(703) 739-4900
December 12, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANTS' MOTION TO DISMISS OPPOSITION WITH PREJUDICE** was served via first class mail, postage prepaid, on this 12TH day of December, 2012, upon Opposer's counsel of record at his current address:

Frank Herrera
H New Media Law
1445 N. Congress Ave.
Suite 7
Delray Beach, Florida 33445



Brewster Taylor

EXHIBIT A

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

ADVANCE MARKETING PLUS, CORP. :

Plaintiff, :

v. :

MARINA WHOLESALE CO., INC., :
IMPERIAL DRUG & SPICE CORP., :
ELLIE ANN NORTH, FRANCISCO N. :
GIL, VIVIAN GIL ROVELLI AND :
VICTORIA WEINGARTNER, :

Defendants. :

CIVIL ACTION NO.: 07-CV-03536 (JLL)

AMENDED ORDER

This matter comes before the Court upon the application of defendants/counterclaimants for an order to enforce the settlement agreement and enter judgment in favor of defendants/counterclaimants. The Court having considered the motion papers filed herein, there being no opposition thereto, and good cause having been shown,

IT IS on this 29 day of November, 2012,

ORDERED that defendants' motion to enforce the settlement agreement is GRANTED; and it is further

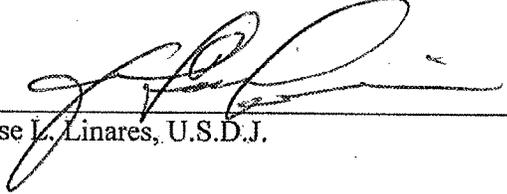
ORDERED that judgment is entered in favor of defendants/counterclaimants Marina Wholesale Co., Inc., Imperial Drug & Spice Corp., Ellie Ann North, Francisco N. Gil, the Estate of Vivian Gil Rovelli and Victoria Weingartner and against plaintiff Advance Marketing Plus, Corp. in the sum of \$234,560.61 plus interest from August 1, 2012, plus attorney's fees in an amount to be awarded upon submission of an Affidavit of Legal Services by defendants' counsel; and it is further

ORDERED that defendants' counsel shall submit an Affidavit of Legal Services within 14 days; and it is further

ORDERED that the parties are to take steps in conformance with this Order to request from the Trademark Trial and Appeal Board a dismissal of Proceeding No. 91127976 presently pending before said Board; and it is further

ORDERED that plaintiff shall have 60 days from the date of this Order to satisfy the judgment in full, failing which plaintiff will have no rights in the HONGOSAN mark and the HONGOSAN mark will be owned by the defendants Ellie Ann North, Francisco N. Gil, The Estate of Vivian Gil Rovelli and Victoria Weingartner, free and clear of any interest the plaintiff Advance Marketing Plus, Corp. may have had.

SO ORDERED.



Jose L. Linares, U.S.D.J.

EXHIBIT B

Kirylo, Pat

From: Frank Herrera <fherrera@hnewmedia.com>
Sent: Tuesday, December 11, 2012 3:43 PM
To: Taylor, Brewster
Cc: Frank Herrera; Taube, Mari-Elise; Kirylo, Pat
Subject: Re: Advanced Marketing Plus v. Ellie Ann North et al. (Opposition No. 91157976)

Brewster:

I have not been counsel for AMP for several years and have no contact with them. Best.

Frank Herrera

H New Media Law
1445 N. Congress Avenue
Suite 7
Delray Beach, Florida 33445
305.965.5148
fherrera@hnewmedia.com

hnewmedia.com

On Dec 11, 2012, at 3:38 PM, Taylor, Brewster wrote:

Dear Frank:

As you are aware, the above opposition has been suspended for five years pending disposition of the civil action initiated in the U.S. District Court in New Jersey by Advanced Marketing Plus. Attached hereto is an order issued by the Court on November 29 which orders that the parties request dismissal of the opposition. I would appreciate it if you would let me know by return when you will file and serve a withdrawal of the Notice of Opposition.

Sincerely,
Brewster

Brewster B. Taylor

Member
Direct: 703-837-3906
Fax: 703-518-2936
btaylor@stites.com

STITES & HARBISON PLLC
1199 N. Fairfax Street, Suite 900, Alexandria, VA 22314
[About Stites & Harbison](#) | [Bio](#) | [V-Card](#)

NOTICE: This message is intended only for the addressee and may contain information that is privileged, confidential and/or attorney work product. If you are not the intended recipient, do not read, copy, retain or forward this message or any attachment. Please notify the sender immediately and delete all copies of the message and any attachments. Neither the transmission of this message or any attachment, nor any error in transmission, constitutes a waiver of any applicable legal privilege. To ensure compliance with requirements imposed by the IRS, we inform you that any U.S. federal tax advice contained in this communication (including any attachments) is not intended or written to be used, and cannot be used, for the purpose of avoiding penalties under the Internal Revenue Code.

<Second Amended Order 11 29 12.pdf>

EXHIBIT 5

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

nmt/wbc

Mailed: February 15, 2013

Opposition No. 91157976

Advance Marketing Plus,
Corp.

v.

Ellie Ann North, Francisco
Gil, Vivian Gil Rovelli, and
Victoria Weingartner

By the Trademark Trial and Appeal Board:

Applicant's motion (filed December 12, 2012) to dismiss this opposition with prejudice, in accordance with the November 29, 2012 order issued in the civil action styled *Advance Marketing Plus, Corp. v. Marina Wholesale Co., Inc.*, Civil Action No. 07-CV-03536 (JLL), filed in the U.S. District Court District of New Jersey,¹ is hereby granted as conceded. See Trademark Rule 2.127(a) and Fed.

¹ The court ordered the dismissal of "Proceeding No. 91127976." As the parties are involved in only one proceeding before the Board, Opposition No. 91157976, and there is no proceeding no. 91127976 currently before the Board, the Board presumes the court ordered a dismissal of opposition no. 91157976.

Opposition No. 91157976

R. Civ. P. 12(b). Accordingly, the opposition is dismissed with prejudice.²

A copy of this order has been sent to all persons listed below.

cc:

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² In view of this order, opposer's attorney's request (filed January 16, 2013) to withdraw as counsel of record in this case is moot. The Board notes, however, that such request is not in compliance with Trademark Rule 2.19(b) and Patent and Trademark Rule 10.40 in that the request (1) does not include a statement that the attorney has notified opposer of his desire to withdraw as counsel in this case; (2) does not include a statement that all papers and property to which opposer is entitled have been delivered to opposer; (3) a statement that the unearned portion of any fee paid in advance has been refunded; and (4) proof of service upon opposer. Accordingly, if there is any further activity in connection with this proceeding, opposer's attorney may be required to take appropriate steps to withdraw from this case.