

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

MBA

Mailed: June 23, 2008

Opposition No. 91181767

Calista Tools, LLC

v.

Salon K Hair Products, LLC
and Salon K, LLC

**Before Seeherman, Bucher and Cataldo, Administrative
Trademark Judges**

By the Board:

This case now comes up for consideration of applicant Salon K Hair Products, LLC's motion, filed February 13, 2008, to amend its application for registration of TOOLS & Design to identify the application's and mark's owner as Salon K, LLC, rather than Salon K Hair Products, LLC. Opposer contests the motion, which is fully briefed, though as explained herein, not yet ready for decision.

Before addressing applicant's motion, however, we must address two preliminary issues. First, it appears that opposer is under the misimpression that it must respond to all portions of all filings by applicant, and that it must do so in the same format used in answers to pleadings. Specifically, opposer filed an "Answer of the Opposer to the Defenses Asserted by the Applicant," which is not provided

for under the Trademark Rules of Practice (and will not be considered). See TBMP § 311.03 (2d ed. rev. 2004). In addition, opposer's response to applicant's motion to amend is drafted, in part, in the same manner as answers to pleadings, though this too was unnecessary and inappropriate. See TBMP § 502.02 (addressing format of motions and briefs).

Second, and more importantly, we cannot determine precisely the grounds for opposition. For example, while it is clear that opposer believes that applicant's application was filed by the wrong party, opposer's claim that the current applicant lacked "standing" to file the application is not clear as to its basis for opposition. Notice of Opposition ¶ 8. "Standing" is a term used to indicate that the *opposer* has an interest in the proceeding, and therefore has the right to bring the action. Similarly, while opposer alleges that applicant made "material misrepresentations in its application," id. ¶ 9, it is not clear whether opposer intends to plead fraud. Finally, it appears that opposer's allegation that it "has used the word TOOLS," may be an attempt to plead a likelihood of confusion claim, but this too is far from clear. For all of these reasons, opposer is ordered to file an amended notice of opposition making clear the precise grounds for opposing the application. In doing so, opposer is strongly encouraged to consult, among other

sources, TBMP § 309.03, which sets forth some common grounds for opposition and methods of pleading.

Turning next to the motion to amend, applicant alleges that "counsel for Salon K, LLC and Salon K Hair Products, LLC inadvertently listed 'Salon K Hair Products, LLC' as the applicant for the 'Tools' Trademark," when Salon K, LLC should have been listed as applicant. Applicant claims that Salon K Hair Products, LLC did not exist until after the application filing date, whereas Salon K, LLC did exist on the application filing date. Applicant argues that the requested amendment "is insignificant to the trademark rights sought, as the salient dates concerning usage of the 'Tools' mark anywhere and in commerce are not affected by the amendment of the applicant's name."

In response to the motion, opposer argues that an application must be filed by the party which owns the mark, and if another party files the application, it is void. Opposer also questions applicant's claim that Salon K, LLC is the proper applicant, given applicant's answer to the notice of opposition, in which applicant states that its counsel "should have indicated the correct applicants' names for the 'Tools' Trademark as Casey Ray and Kim Meecey." Answer to Notice of Opposition, Affirmative Defenses ¶ 2.

The parties both cite Accu Personnel, Inc. v. Accustaff, Inc., 38 USPQ2d 1443 (TTAB 1996), but disagree

over whether the case supports applicant's request to amend.

In that case, the Board held as follows:

the mere fact that the entity named as applicant in the application did not exist in law as of the application filing date does not ipso facto render the application void *ab initio*, so long as the application was in fact filed, albeit in an incorrect name or with an incorrect entity designation, by the proper person, i.e., the commercial enterprise which ... was entitled to claim a bona fide intention to use the mark.

Accu Personnel, 38 USPQ2d at 1445. A more recent Board decision further explained the relevant law.

Where there exists as of the application filing date but a single continuing commercial enterprise which is the owner of the mark, and it is that entity which files the application, the application is deemed to have been filed by the owner of the mark even if the applicant, that single commercial enterprise, is misidentified in the application as to its name or entity designation (such as corporation, partnership, etc.). If the named applicant is merely an earlier or later manifestation of the same single continuing commercial enterprise which is the owner of the mark, a mistake in the manner in which that single entity is identified in the application is not fatal to the application but instead is a curable defect.

Great Seats, Ltd. v. Great Seats, Inc., 84 USPQ2d 1235, 1240 (TTAB 2007); see also, Custom Computer Services Inc. v. Paychex Properties Inc., 337 F.3d 1334, 67 USPQ2d 1638 (Fed. Cir. 2003). Unfortunately, however, the state of the current record does not allow us to apply these cases to the situation at hand.

Indeed, applicant's motion is unsupported by any evidence whatsoever, much less evidence which would establish what relationship, if any, exists between Kim Meecey, Casey Ray and Salon K Hair Products, LLC on the one hand, and Salon K, LLC on the other. There is also no evidence establishing which parties or nonparties have used the TOOLS & Design mark, when he, she, it or they used the mark, whether and when ownership of the mark was transferred, etc. Accordingly, we are unable to rule on applicant's motion to amend given the current record.

Furthermore, while opposer's grounds for opposition are unclear, as explained above, it appears that opposer intends to challenge the application as void because it was filed by the wrong (and nonexistent) party. Therefore, deciding the motion to amend would likely be tantamount to deciding at least one of the grounds for opposition, prior to trial, and without either party having filed a proper motion for summary judgment.

Under the circumstances, in addition to requiring opposer to file an amended and more clear notice of opposition, we hereby join Salon K, LLC as a party. TBMP § 512. This will facilitate discovery and the taking of evidence, and allow for development of a more complete record. Either party is free to file a proper motion for

summary judgment, with supporting evidence, which addresses the question of the appropriate applicant.

In summary, opposer is hereby allowed 30 days in which to submit an amended notice of opposition in accordance with the above discussion. Applicant is allowed until 30 days after service thereof in which to submit its answer to the amended notice of opposition. Discovery, trial and other dates are reset as follows:

Deadline for Discovery Conference	September 22, 2008
Discovery Opens	September 22, 2008
Initial Disclosures Due	October 22, 2008
Expert Disclosures Due	February 19, 2009
Discovery Closes	March 21, 2009
Plaintiff's Pretrial Disclosures	May 5, 2009
Plaintiff's 30-day Trial Period Ends	June 19, 2009
Defendant's Pretrial Disclosures	July 4, 2009
Defendant's 30-day Trial Period Ends	August 18, 2009
Plaintiff's Rebuttal Disclosures	September 2, 2009
Plaintiff's 15-day Rebuttal Period Ends	October 2, 2009

The parties are required to hold a discovery conference pursuant to the schedule as reset herein, even if they held a discovery conference pursuant to the schedule set forth in the Board's institution order of January 8, 2008, because,

among other things, opposer will be filing an amended notice of opposition.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>