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

Proceeding	91185256
Party	Defendant Room Service Interiors Ltd.
Correspondence Address	Paul G. Juettner Greer, Burns & Crain, Ltd. 300 South Wacker Drive Chicago, IL 60606 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Paul G. Juettner
Filer's e-mail	pjuettner@gbclaw.net, tmdocket@gbclaw.net, jpionke@gbclaw.net
Signature	/Paul G. Juettner/
Date	08/26/2008
Attachments	74962-Motion-to-Dismiss.pdf (3 pages)(110927 bytes) 74962-Memorandum-Supporting-Motion-to-Dismiss.pdf (8 pages)(355176 bytes) 74962-exhibit-a.pdf (2 pages)(59980 bytes)

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

In the Matter of Application No.:)	
76/071,006 – Published September 25, 2007)	
For the mark –ROOMSERVICE)	
)	
Room Service Home, LP and R S Design, Inc.)	Opposition No.91185256
d/b/a Room Service by Ann Fox,)	
)	
Opposers,)	
)	
v.)	
)	
Room Service Interiors, Ltd.,)	
)	
Applicant.)	

**APPLICANT’S MOTION TO DISMISS OPPOSITION AS
UNTIMELY UNDER 15 U.S.C. §1063 WITH RESPECT TO OPPOSER
R S DESIGN, INC. AND FOR FAILURE TO STATE A CLAIM UNDER
RULE 12(b)(6) WITH RESPECT TO OPPOSER ROOM SERVICE HOME, LP**

Applicant Room Service Interiors, Ltd. (“Applicant”) moves this Honorable Board to dismiss the Notice of Opposition filed by Opposers Room Service Home L.P. (“Room Service Home”) and R S Design Inc., d/b/a Room Service by Ann Fox (“R S Design”) as untimely under 15 U.S.C. §1063 with respect to R S Design and for failure to state a claim upon which relief may be granted pursuant to Rule 12(b)(6) Fed.R.Civ.P. with respect to Room Service Home. Applicant submits herewith a Memorandum in support of its Motion, and more specifically avers as follows:

1. Applicant’s trademark application Serial No. 76/071,006 was published for opposition on September 25, 2007.
2. Room Service Home requested an extension of time to oppose, which was granted.

3. R S Design did not request and extension of time to oppose.
4. Within the extended period Room Service Home and R S Design joined together in filing the subject Notice of Opposition.
5. Room Service Home and R S Design are separate legal entities.
6. Opposers have not alleged that Room Service Home and R S Designs are in privity.
7. Under 15 U.S.C. §1063 and 37 C.F.R. §2.102(a), the Notice of Opposition by R S Design is untimely, and therefore R S Design must be dismissed.
8. Applicant's opposed trademark application was filed in the United States Patent and Trademark Office on June 15, 2000, claiming a convention priority date of December 17, 1999.
9. Room Service Home was formed in 2003, long after Opposer's filing and priority dates, and has not alleged use of its alleged ROOM SERVICE HOME name/mark prior to 2004.
10. Room Service Home has not and cannot allege use or registration of its name/mark ROOM SERVICE HOME prior to Applicant's filing and priority dates.
11. The only alleged basis for opposition is priority and likelihood of confusion.
12. Since Room Service Home has not and cannot allege priority it cannot prevail, and its Notice of Opposition must be dismissed under Rule 12(b)(6) of the Federal Rules of Civil Procedure for failure to state a claim upon which relief may be granted.

WHEREFORE, Applicant Room Service Interiors, Ltd. prays that its motion be granted and the Notice of Opposition be Dismissed.

Room Service Interiors, Ltd.

Date: August 26, 2008

By: /s/ Paul G. Juettner
Paul G. Juettner, Esq.
Greer, Burns & Crain, Ltd.
300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606-6771
Tel: (312) 360-0080
Fax: (312) 360-9315
Attorneys for Applicant

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S MOTION TO DISMISS OPPOSITION AS UNTIMELY UNDER 15 U.S.C. §1063 WITH RESPECT TO OPPOSER R S DESIGN, INC. AND FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6) WITH RESPECT TO OPPOSER ROOM SERVICE HOME, LP has been filed electronically through The Electronic System for Trademark Trials and Appeals ("ETTSa") of the U.S. Patent and Trademark Office, and a true and correct copy has been served on Applicant by facsimile and first class mail to Opposer's counsel on this 26 day of August 2008 at the following address:

John A. Thomas
Glast, Phillips & Murray, P.C.
13355 Noel Road, Suite 2200
Dallas, TX 75240

/s/ Paul G. Juettner

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

In the Matter of Application No.:)
76/071,006 – Published September 25, 2007)
For the mark –ROOMSERVICE)
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Room Service Home, LP and R S Design, Inc.) Opposition No. 91185256
d/b/a Room Service by Ann Fox,)
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**APPLICANT’S MEMORANDUM IN SUPPORT OF ITS
MOTION TO DISMISS OPPOSITION AS UNTIMELY UNDER
15 U.S.C. §1063 WITH RESPECT TO OPPOSER R S DESIGN,
INC. AND FOR FAILURE TO STATE A CLAIM UNDER RULE
12(b)(6) WITH RESPECT TO OPPOSER ROOM SERVICE HOME, LP.**

Applicant Room Service Interiors, Ltd. (“Applicant”) submits this memorandum in support of its Motion to Dismiss the Notice of Opposition filed by Opposers Room Service Home L.P. (“Room Service Home”) and R S Design, Inc., d/b/a Room Service by Ann Fox (“RS Design”) as untimely under 15 U.S.C. §1063 with respect to R S Design and for failure to state a claim upon which relief may be granted pursuant to Rule 12(b)(6) Fed.R.Civ.P. with respect to Room Service Home.

FACTS

For the purpose of this motion only Applicant accepts as true the well-pleaded factual allegations, but not assertions of law, of the Notice of Opposition.

The Parties

Applicant is a Canadian corporation. It filed the subject opposed application Serial No. 76/071,006 for ROOMSERVICE for ongoing television and radio programs in the field of architecture, antiques, furniture, interior design, and decorating on June 15, 2000, claiming a convention priority date of December 17, 1999.

Opposer R S Design is a Texas corporation having a place of business in Dallas, Texas. [Notice of Opposition ¶¶ 1, 3, 4] R S Design alleges use of the ROOM SERVICE mark since at least as early as 1987. R S Design has not alleged ownership of any trademark or service mark registrations.

Opposer Room Service Home is a Texas limited partnership formed on or about August 29, 2003. [Applicant's Exhibit A¹] The general partner of Room Service Home is Room Service Management, Inc., which is not a party to this opposition proceeding. [*Id.*] When Room Service Home was established, Ann Fox, Room Service, Inc.² filed a document with the Secretary of State of Texas stating:

“This letter constitutes the consent of the undersigned and hereby grants the authority to Room Service Home, L.P., a Texas limited partnership, and to the partners of such limited partnership, to forever use the name ‘Room Service Home, L.P.’, which name is similar to the name by which the undersigned heretofore conducted business.”

[Applicant's Exhibit A] Room Service Home alleges use of the ROOM SERVICE

¹ Applicant's Exhibit A is a copy of the corporate records of Opposer Room Service Home, LP. The Exhibit is outside the pleadings. Accordingly, the Board should treat the subject Motion to Dismiss as a motion for summary judgment under Rule 56, Fed.R.Civ.P. *See*, TBMP §503.04.

² The letter was signed by Ann Fox, President of Room Service, Inc., which on information and belief is a misnomer of Opposer, R S Design, Inc. d/b/a Room Service by Ann Fox.

HOME name/mark since 2004. [Notice of Opposition ¶¶ 2, 5] Room Service Home has not alleged ownership of any trademark or service mark registrations.

Opposers have alleged that R S Design and Room Service Home are “related companies³ with common ownership,” but have not alleged they are in privity.

Extension of Time to File Notice of Opposition

Room Service Home filed an extension of time to oppose Applicant’s application, which extension was granted. R S Design did not join in the extension request and did not request an extension of its own.

On October 25, 2007 the original publication period ended.

On November 23, 2007, Opposers Room Service Home and R S Design filed a Notice of Opposition.

ARGUMENT

A. The Opposition by R S Design is Untimely.

To timely oppose an application for trademark registration, a potential opposer must file a notice of opposition or a request for an extension of time within thirty days of publication. 15 U.S.C. §1063; 37 C.F.R. §2.102(a). A request for an extension of time must identify the potential opposer, and any opposition filed during an extension must be in the name of the person to whom the extension was granted or in the name of person in privity with the person who requested and was granted the extension of time. 37 C.F.R. §2.102(b). “An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party. For

³ Opposers allegations are insufficient to support a legal conclusion that they are “related companies” as defined in 15 U.S.C. §1127. See pp. 5-6 *infra*.

this reason, a request for a further extension of time to oppose, or an opposition filed during an extension of time, ordinarily must be filed in the name of the party to which the extension was granted.” TBMP §206.01. If an opposition is filed during an extension period and the opposer is not privy with the person who was granted an extension of time, the opposition will be dismissed. *In re Cooper*, 209 USPQ 670 (Comm’r 1980).

Black’s Law Dictionary defines “privity” as having a “mutual or successive relationship to the same rights of property. In its broadest sense, ‘privity’ is defined as mutual or successive relationships to the same right of property, or such an identification of interest of one person with another as to represent the same legal right.” *Id. See also, International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000). Having a common owner does not establish privity between companies. *Custom Computer Services, Inc. v. Payshex Properties Inc.*, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003)(two companies were not related by privity where the founder of one of the entities was an owner of the other). A non-exclusive license is not a privity relationship. *Takaido v. Honda Associates, Inc.*, 179 USPQ 861, 862 (TTAB 1973).

In the present case, Room Service Home requested and was granted an extension of time to oppose the subject application. The subject opposition was filed during the extension period. Opposer, R S Design did not request an extension of time to oppose. Further, the Notice of Opposition does not allege that R S Design is in privity with Room Service Home. Thus, the opposition by R S Design is untimely.

The Notice of Opposition does not allege facts sufficient to support a privity relationship, i.e., that one Opposer is a successor or assign of the other or that the Opposers have a mutual relationship to the same property right. It is doubtful that such an

allegation could be made. Room Service Home was formed in 2004. According to Opposers' allegations, after 2004 R S Design continued using its name/mark concurrently with Room Service Home using its name/mark, i.e. Room Service Home did not succeed to the business of R S Design. [Opposition ¶ 1]

Further, the Notice of Opposition does not allege that Opposers mutually own a property right (name or mark) upon which the opposition is based. Indeed, Opposers allege that R S Design has operated its business under the name/mark "ROOM SERVICE" and/or "ROOM SERVICE BY ANN FOX." Opposers further allege that Room Service Home has used another name/mark, namely "ROOM SERVICE HOME." Although the name/mark used by R S Design is similar to the name/mark used by Room Service Home, they are not the same mark. Opposers themselves recognized the distinction when Ann Fox consented to Room Service Home's perpetual use of the name "Room Service Home, L.P., which name is similar to the name by which the undersigned heretofore conducted business." [Applicant's Exhibit A] Based on the facts alleged in the Notice of Opposition and admission in Applicant's Exhibit A, the Board can only conclude that R S Design and Room Service Home independently use their respective names/marks, i.e., they do not mutually own a property right on which the opposition is based.

Further, privity is not established by a conclusory allegation that the Opposers are "related companies"⁴ with common ownership." [Notice of Opposition ¶2] To the

⁴ TBMP §206.02 suggests that privity includes the relationship of related companies within the meaning of Sections 5 and 45 of the Act. However, the cases cited in the TBMP do not support the proposition. It is submitted that privity cannot be established merely by a related companies relationship, and that mutual or successive ownership of the same name or mark is required.

contrary, the alleged facts and Applicant's Exhibit A show that Opposers are not legally "related companies" within the meaning of the Trademark Law.

The term "related company" is legally defined as "any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used." 15 U.S.C. §1127. In the Notice of Opposition, there is no allegation that one Opposer controls the nature and quality of the services of the other. Indeed, Opposers independently use their respective names/marks. Second, Room Service Home has not and cannot allege that it controls R S Design's use of its name/mark, as it did not exist until long after R S Design began using its name/mark. Third, when Room Service Home was established, R S Design filed a document with the Secretary of State of Texas granting perpetual consent to Room Service Home to use the name "Room Service Home, LP."

[Applicant's Exhibit A] This consent was unconditional, did not purport to be an assignment or license, and did not contain any provision permitting R S Design to control the use of the "Room Service Home" name/mark or the nature or quality of the goods sold under the name/mark. Thus, R S Design has not and cannot allege that it controls Room Service Home's use of its name/mark. Because Opposers independently use and control their respective names and service marks, and do not control the nature or quality of the goods/services of the other, they are not related companies as a matter of law. 15 U.S.C. §1127.

Because R S Design is not in privity with Room Service Home, it cannot benefit from the extension of time filed by Room Service Home. 37 C.F.R. §2.102(b); *In re*

Cooper, supra. The notice of opposition by R S Design was after the expiration of the opposition period, and as such is untimely. R S Design must be dismissed.

B. Room Service Home Cannot Allege Priority Over Applicant.

The Board may dismiss a claim if it appears that the opposer can prove no set of facts in support of pled allegations which would entitle him to relief. Fed.R.Civ.P. 12(b)(6); TBMP §503.02. In the present case, the remaining Opposer, Room Service Home cannot prove priority and therefore cannot prevail on a Section 2(d) priority and likelihood of confusion claim.

Applicant's opposed trademark application was filed in the United States Patent and Trademark Office on June 15, 2000, claiming a convention priority date of December 17, 1999. Room Service Home was formed in 2003, long after Opposer's filing and priority dates. The earliest date of use alleged by Room Service Home is 2004 long after Applicant's filing and priority dates. [Notice of Opposition ¶¶ 2, 5] Room Service Home cannot benefit from any alleged earlier use of R S Design because Room Service Home is not a successor or assign of R S Design. See *infra* at p. 5. Thus, Room Service Home has not and cannot allege use or registration of its alleged mark ROOM SERVICE HOME prior to Applicant's filing and priority dates.

The only alleged basis for opposition is priority and likelihood of confusion. Since Room Service Home has not and cannot allege priority it cannot prevail, and its Notice of Opposition must be dismissed under Rule 12(b)(6) of the Federal Rules of Civil Procedure for failure to state a claim upon which relief may be granted.

CONCLUSION

For the forgoing reasons, Applicant prays that its Motion to Dismiss be granted and that the Notice of Opposition be dismissed.

Room Service Interiors, Ltd.

Date: August 26, 2008

By: /s/ Paul G. Juettner
Paul G. Juettner, Esq.
Greer, Burns & Crain, Ltd.
300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606-6771
Tel: (312) 360-0080
Fax: (312) 360-9315
Attorneys for Applicant

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS OPPOSITION AS UNTIMELY UNDER 15 U.S.C. §1063 WITH RESPECT TO OPPOSER R S DESIGN, INC. AND FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6) WITH RESPECT TO OPPOSER ROOM SERVICE HOME, LP has been filed electronically through The Electronic System for Trademark Trials and Appeals ("ET TSA") of the U.S. Patent and Trademark Office, and a true and correct copy has been served on Applicant by facsimile and first class mail to Opposer's counsel on this 26 day of August 2008 at the following address:

John A. Thomas
Glast, Phillips & Murray, P.C.
13355 Noel Road, Suite 2200
Dallas, TX 75240

/s/ Paul G. Juettner

SEP 05 2003

CERTIFICATE OF LIMITED PARTNERSHIP

OF

Corporations Section

ROOM SERVICE HOME, L.P.

THIS CERTIFICATE OF LIMITED PARTNERSHIP OF ROOM SERVICE HOME, L.P. (this "Certificate") is dated as of August 29, 2003, and is made by Room Service Management, Inc., as General Partner of ROOM SERVICE HOME (the "Partnership") for the purpose of complying with Section 2.01 of the Texas Revised Limited Partnership Act (the "Act"):

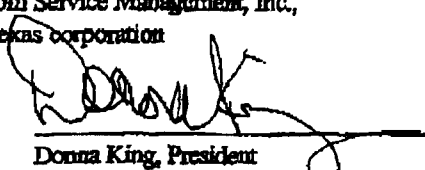
1. The name of the limited partnership is Room Service Home, L.P.
2. The address of the registered office of the Partnership is 4354 Lovers Lane, Dallas, Texas 75225, and the name and address of the registered agent for service of process is Ann Fox.
3. The address of the principal office of the Partnership in the United States where records are to be kept or made available under the Act is 4354 Lovers Lane, Dallas, Texas 75252.
4. The name and the street address of the business of General Partner of the Partnership is as follows: Room Service Management, Inc., 4354 Lovers Lane, Dallas, Texas 75225.

EXECUTED this the 29th day August, 2003.

ROOM SERVICE HOME, L.P.,
a Texas limited partnership

By: Room Service Management, Inc.,
a Texas corporation

By:


Donna King, President

EXHIBIT

A

ANN FOX
Room Service, Inc.
4354 Lovers Lane
Dallas, Texas 75225

August 28, 2003

Secretary of State of Texas
Corporations Section
1019 Brazos Street
The Earl Rudder Building
Austin, Texas 78701

Re: Consent to Use of Corporate Name

Ladies and Gentlemen:

This letter constitutes the consent of the undersigned and hereby grants the authority to Room Service Home, L.P., a Texas limited partnership, and to the partners of such limited partnership, to forever use the name "Room Service Home, L.P.", which name is similar to the name by which the undersigned heretofore conducted business.

Very truly yours,

Room Service, Inc.,
a Texas corporation

By: 
Ann Fox, President

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