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

Proceeding	91218280
Party	Plaintiff Mya Saray, LLC
Correspondence Address	M KEITH BLANKENSHIP DA VINCIS NOTEBOOK LLC 10302 BRISTOW CENTER DRIVE, NO 52 BRISTOW, VA 20136 UNITED STATES keith@dnotebook.com
Submission	Response to Board Order/Inquiry
Filer's Name	M. Keith Blankenship
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Signature	/M. Keith Blankenship/
Date	02/25/2015
Attachments	DNMYA-0051_280_Response Entry of Amendment.pdf(100502 bytes) Exhibit 1 Final.pdf(128837 bytes)

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

In the Matter of Application Serial No. 86/025,182
Published in the Official Gazette (Trademarks) on May 13, 2014.

MYA SARAY, LLC,

Opposer

v.

DABES, IBRAHIM DBA
DABES EGYPTIAN IMPORTS,

Applicant

Opposition No. 91218280

OPPOSER’S RESPONSE IN OPPOSITION TO ENTRY OF AMENDMENT

Opposer Mya Saray, LLC (“Mya Saray”) by and through its undersigned counsel, respectfully requests in this Response in Opposition to the Entry of Amendment by the Board to withdraw its Entry of Amendment of January 26, 2015. Opposer would show this Board:

1. Opposer and Applicant have not only the present proceeding before this Board, but also Cancellation No. 92060249 (“the ‘249 Cancellation”) seeking cancellation of Applicant’s U.S. TM Reg. No. 4536391 (the ‘391 trademark registration).

2. Counsel for Opposer and Applicant convened by telephoned on December 18, 2014 to discuss proceedings between the parties, and more specifically, in furtherance of a discovery conference scheduled for this proceeding.

3. During the discovery conference counsel for Opposer and Applicant discussed settlement of both the present Proceeding (“the ‘280 Opposition”) and the ‘249 Cancellation, and

Applicant inquired whether Opposer would settle based on a narrowing amendment, and after Opposer pointedly declined this settlement basis, Applicant asked whether Opposer would contest an amendment to narrow the Applicant's recitation of goods to simply "tobacco." Opposer requested time to consider the issue.

4. In a subsequent, written communication to Applicant's counsel consented to a narrowing amendment "to restrict the goods and services of applications **86025122 and 86025182** from 'tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas' to 'tobacco.'" See Exhibit 1 (emphasis added). In that writing, Opposer expressly asked Applicant's counsel if he correctly understood the nature of the amendment. Counsel for Applicant did not respond.

5. Counsel for Applicant did file a Motion to Amend the '182 application on January 20, 2015. Counsel for Opposer waited for a matching motion to amend the '122 application (i.e., the '391 registration), which never arrived.

6. In a follow up teleconference dated February 24, 2015, counsel for Opposer asked counsel for Applicant whether a companion motion to amend the '391 trademark registration (the '122 application) would be forthcoming. At the time, counsel for Applicant did not have plans to file any such motion.

7. The teleconference could be summarized as follows: counsel for Applicant believed that its request for consent applied only to the '182 application, for among other reasons, that the conference was occasioned by an upcoming deadline for a discovery conference for the '280 Opposition; counsel for Opposer believed the request for consent applied to both the '182 application for the '280 Opposition and the '391 trademark registration for the '249 Cancellation, because among other reasons counsel for both parties had only discussed settlement of both

Trademark Trial and Appeal Board proceedings and counsel for Opposer followed up with an written request to ensure that the consent applied to the ‘182 application and the ‘391 trademark registration. *See Exhibit 1.*

8. The response is not meant in any way to impugn or challenge Applicant’s motivation for filing its Motion to Amend in this proceeding without filing a companion motion to amend in the ‘249 Cancellation. In the undersigned’s discussion with counsel for Applicant on February 24, 2015, he found her explanation and rationale to be plausible and perfectly satisfactory. Nevertheless, there was a misunderstanding, and there was never a ‘meeting of the minds’ for consent for only a single Motion to Amend.

9. Allowing Applicant’s Motion to Amend would substantially harm Opposer for multiple reasons. Opposer purposefully and specifically agreed to amendment of both the ‘391 trademark registration and in concert with the ‘182 application.

10. The consideration for the agreement sought by Opposer was significant. Opposer in consenting to narrowing amendments of the ‘182 application and the ‘391 trademark registration diminishes its capacity to seek and utilize documents in discovery that may show that Applicant sought broader rights than it was entitled; Opposer gains by such a deal a more favorable outcome in the event of the Board disagreeing with its basis of opposition/cancellation. Applicant would gain by the entry of the narrowing amendment a stronger basis to defend its alleged trademark rights based on its more specific goods, while Applicant would lose the breadth of its prior recitation of goods.

11. The set of circumstances that actually transpired is of considerable detriment to Opposer. The ‘182 application that Applicant amended to narrow was, of Applicant’s two trademark filings, the more vulnerable to attack based on breadth as recent information acquired

by Applicant indicates that the '391 trademark registration is more likely to be applied to Applicant's products generally, while the mark of the '182 application is more likely to be utilized with only tobacco. Indeed, the mark of the '182 application specifically states in its design "GOLD TOBACCO" - which would certainly be awkwardly applied to, say, a hookah. In other words, Applicant by its recent actions sheds its highly vulnerable recitation of goods for a single mark. Opposer would only assent to such an arrangement in return for some accommodation, which Opposer believes that it received when it consented to the amendment of *both* the '182 application and the '391 trademark registration.

12. Litigation agreements are construed according to the principles of contract construction and their formation requires a "meeting of the minds." *Cf. Bose Corp. v. Ejaz*, 732 F.3d 17, 21-22 (1st Cir. 2013)(A court will only enforce a settlement agreement when there is a "meeting of the minds"); *Herrington v. County of Sonoma*, 12 F.3d 901, 907 (9th Cir.1993) ("a court will ordinarily apply the usual rules of contract construction" to interpret Rule 68 settlement agreements); *Radecki v. Amoco Oil Co.*, 858 F.2d 397, 400 (8th Cir.1988) ("[t]o decide whether there has been a valid offer and acceptance for the purpose of Rule 68, courts apply the principles of contract law"); *Johnson v. University College of the Univ. of Ala.*, 706 F.2d 1205, 1209 (11th Cir.) (Rule 68 settlement agreement void unless there was a "meeting of the minds" under basic contract law principles), *cert. denied*, 464 U.S. 994 (1983).

13. Opposer asks this Board to withdraw the Entry of Amendment of January 26, 2015, and to the extent that Applicant still desires to amend its recitation of goods, to file such motion lacking the uncontested designation.

DATED: February 25, 2015

By: /M. Keith Blankenship/
Attorney for Opposer
M. Keith Blankenship, Esq.
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the forgoing Notice of Opposition has been served on counsel for Applicant by mailing said copy via First Class Mail, postage prepaid to:

Ms. Lourdes Perez and Dr. Paul D. Bianco
Fleit Gibbons Gutman Bongini & Bianco PL
21355 E Dixie Hwy Ste 115
Miami, Florida 33180-1244
United States

this 25th day of February, 2015

By M. Keith Blankenship/
M. Keith Blankenship

Exhibit 1

From: M. Keith Blankenship keith@dnotebook.com
Subject: Re: Opposition Proceeding No. 91218280 - Mya Saray, LLC v. Dabes, Ibrahim - Mark: AMY GOLD TOBACCO MOLASSES; Our Ref.: 7400-T14-410Opp
Date: December 29, 2014 at 10:03 PM
To: Lourdes Perez lperez@fggbb.com
Cc: Paul Bianco pbianco@fggbb.com, Dinah Fuentes dfuentes@fggbb.com

Ms. Perez,

Mya Saray does consent to a motion to restrict the goods and services of applications 86025122 and 86025182 from "tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas" to "tobacco."

(I believe that this is the amendment that we discussed. If not, please send me the express language of the amendment that you propose. Also, if you could send along an updated version of the Discovery Plan, with our disagreements and modifications, that would be much appreciated.)

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On Dec 16, 2014, at 3:17 PM, Lourdes Perez <lperez@fggbb.com> wrote:

Dear Mr. Blankenship,

Thank you for your email. We are available this Thursday at 2:00pm EST. Please let us know if this is a good time for you.

Kind regards,

<image001.png>

Lourdes Perez, Esq.
Attorney at Law, Registered to Practice before the U.S. Patent and Trademark Office
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From: M. Keith Blankenship: [<mailto:keith@dnotebook.com>]
Sent: Monday, December 15, 2014 11:14 AM
To: Lourdes Perez
Cc: Paul Bianco; Constanza Lombardi
Subject: Re: Opposition Proceeding No. 91218280 - Mya Saray, LLC v. Dabes, Ibrahim - Mark: AMY GOLD TOBACCO MOLASSES

Ms. Perez,

I believe that we are about due for a discovery conference. Do you have availability between now and Thursday for this? In the meantime, I attach proposed versions of a 26f report and a protective order as perhaps a starting point for discussion.

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