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

Proceeding	91235923
Party	Defendant David J. Witchell Salon & Spa, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Signature Aesthetics, LLC Opposer v. David J. Witchell Salon & Spa, Inc., Applicant.	Opposition No. 91235923

MEMORANDUM OF APPLICANT DAVID J. WITCHELL SALON & SPA, INC. IN OPPOSITION TO OPPOSER'S MOTION TO AMEND

Opposer, Signature Aesthetics ("Signature") seeks to remedy a failure to meet the statutorily imposed opposition deadline with an amended pleading (which it seeks to file via motion). First, TBMP § 303.05(b) makes it mandatory that a showing of privity must be submitted with the Opposition, which clearly in the present case, Signature has not done. Second, the purported assignment[1], even if it is deemed to be a valid transfer instrument, does not convey causes of action or claims that the owner may have had, and therefore, Signature lacks standing. Signature has not demonstrated that causes of action and the right to oppose were ever assigned to it. Third, the Board lacks authority to extend a statutory deadline, and permitting the amendment would be extending the statutory deadline that

[1] Attached as Exhibit 2 to Signature's Motion

Signature did not meet. (See *e.g.*, Abraxis Bioscience, Inc. v. Navinta LLC, 625 F.3d 1359 (Fed. Cir., 2010)).

I. ARGUMENT

On May 2, 2017, Elizabeth Whitaker filed a request in Elizabeth Whitaker's name for a ninety-day extension of time to oppose David Witchell's Application. This request was made by Dr. Whitaker pursuant to the good cause requirement, which was based on a statement that Dr. Whitaker needed to investigate the claim. Accordingly, a ninety-day extension was granted to Dr. Whitaker. On August 2, 2017, Signature, a corporation alleged to have been formed on May 4, 2017[2], filed the Notice of Opposition ("Notice").

> "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, in the Official Gazette of the United States Patent and Trademark Office.
>
> (TBMP § 102.02 (June 2017) (citations omitted)

A. Signature Has Not Complied with TBMP § 303.05(b)

Signature's motion to amend its Notice must be denied because Signature did not meet the requirement for making the "showing" of privity. TBMP § 303.05(b) requires a mandatory submission with the opposition. A showing of privity must be submitted with the Opposition, which clearly in the present case, Signature has not done. TBMP § 303.05(b), in relevant part, provides that:

[2] See Exhibit 1 to Signature's Motion to Amend

303.05(b) Opposition Filed by Privy

> A party in privity with a potential opposer may step into the potential opposer's shoes and file a notice of opposition or may join with the potential opposer as a joint opposer. Thus, an opposition filed during an extension of time to oppose may be filed by a party other than the party to which the extension was granted, if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension. *Cf.* TBMP § 206.02.
>
> The "showing" of privity should be in the form of a recitation of the facts on which the claim of privity is based, and ***must be submitted*** either ***with the opposition***, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more differing parties, an explanation will be requested as to each differing party, and the opposition will not be accepted as to any differing party that fails to make a satisfactory showing of privity.
>
> * * *

(TBMP § 303.05(b) (June 2017) (notes omitted).)

In the present case, there was no letter from the Board requesting an explanation of the discrepancy. Therefore, what is at issue here is whether Signature submitted, with its opposition, as is required by § 303.05(b), a recitation of the facts on which its claim of privity is based. Signature did not, and therefore, has failed to comply with the mandatory requirement of Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 303.05(b).[3]

[3] 15 U.S.C. § 1063, the statue providing the rights to bring oppositions, provides that "[a]n opposition may be amended under such conditions as may be prescribed by the Director." The requirement set forth in TBMP § 303.05(b), being prescribed by the Director as mandatory, and not having been met by Signature, precludes the Motion and amendment sought by Signature.

Signature requests that the Board grant it leave to amend, but this is a mandatory requirement that must be submitted with the opposition, which Signature did not do. An amendment cannot be permitted.

Courts have determined that a provision directing that something "must" be done, is mandatory.

> The word **"must" is mandatory**.
>
> (Koenke v. Koenke, 458 N.Y.S.2d 718, 91 A.D.2d 1142 (N.Y.A.D. 3 Dept., 1983) citing (Rodriguez v. Rodriguez, 79 A.D.2d 550, 434 N.Y.S.2d 22)) (emphasis added)
>
> When a statute fixes the time within which an act ***must be done***, the courts have no power to enlarge it, although it relates to a mere question of practice. Jackson v. Wiseburn, 5 Wend. (N. X.) 136; Harris v. Mercur, 202 Pa. 313, 51 A. 969; Singer v. D. L. & W. R Co., 254 Pa. 502, 98 A. 1059; Mindlin v. O'Boyle, 283 Pa. 352, 129 A. 81.
>
> Cameron v. Fishman, 291 Pa. 12, 139 A. 383 (Pa., 1927) (emphasis added)

In the present case, Signature filed a Notice of Opposition on August 2, 2017 that did not contain a recitation of facts showing privity. Since TBMP § 303.05(b) is a mandatory requirement that Signature have included the statement, Signature's motion to amend must be denied, and the Opposition dismissed.

B. Signature Has Not Established a Transfer of Rights

Signature fails to establish a valid transfer of Dr. Whitaker's trademark application and the claim that Dr. Whitaker was investigating.

In its Motion, as a factual basis, Signature asserts that it received a transfer of the mark:

> Subsequently, on May 11, 2017, Dr. Whitaker executed and filed with the USPTO an assignment of the entire interest and goodwill of numerous trademarks owned by Dr. Whitaker, including, but not limited to the mark identified in Application Serial No. 87314510, "EVERYONE WILL NOTICE. NO ONE WILL KNOW". [Exhibit 2].
>
> (Opposer's Motion, third page, sixth full paragraph)[4]

In addition, Signature further claims to be the successor of the mark.

> On August 2, 2017, within the time granted by the extension of time to oppose Applicant's mark, Opposer filed its Notice of Opposition as a successor of ownership to Dr. Whitaker's mark at interest.
>
> (Opposer's Motion, fourth page, first full paragraph)

Even the factual basis of Signature's proposed amended Notice does not provide that Signature is the owner of the "application". Rather, the factual basis for the amendment is an ownership of the mark. The document that Signature points to (among the many in Exhibit 2) purporting to be an assignment, states that Elizabeth Whitaker filed for and "registered a mark." The mark EVERYONE WILL NOTICE. NO ONE WILL KNOW is not registered. Although a serial number is referenced, there is no specific language referencing the transfer of the trademark "application". Rather, the purported document references "the mark" and "the goodwill symbolized by the mark." Reference is made to the "Trademark", and there is a line that indicates the trademark and serial number. However, the document is silent on any transfer of a trademark "application".

[4] Entitled "Opposer's Motion For Leave To Amend Its Notice Of Opposition And To Dismiss Applicant's Motion To Dismiss As Moot" (referred to herein as "Opposer's Motion")

But putting aside whether the Exhibit 2 document is a valid transfer of rights, clearly, no causes of action have been transferred, nor has the right to recover damages been transferred, nor the right to proceed in the opposition. Assignments that fail to transfer a cause of action are deemed ineffective to confer standing.

> The March 15, 2007 assignments to AZ-UK ***did not assign the right to sue*** for past infringement, thus AZ-UK could not have assigned those rights to Abraxis on November 12, 2007, even if the November 12, 2007 assignment is "considered" to be retroactive. Therefore, Abraxis's complaint must be dismissed because Abraxis ***lacked standing at the time the action was filed and continues to lack standing*** to sue for past infringement.
>
> Abraxis Bioscience, Inc. v. Navinta LLC, 625. F.2d 1360, 1367 (Fed. Cir. 2010)

In the present case, Signature has not received a transfer of a cause of action (the claim that Dr. Whitaker was investigating) and lacks standing to oppose. Even if the document provided by Signature at Exhibit 2 of its Motion is considered an assignment, the "application" is not even mentioned, nor are rights to sue for past infringement, or any rights involving claims or causes of action, including the opposition, mentioned or transferred.

For the above reasons and for these additional reasons, Signature's Motion must be denied.

The time period for Signature to make the privity statement and establish those facts has passed. Signature cannot remedy the defect. Putting aside the issue of whether the Board even will regard what Signature attaches as Exhibit 2 to its

pleading (purporting to be an assignment) as a valid transfer of rights that give rise to standing,[5] the statutory deadline has not been met.

C. The Statutory Deadlines Are Not Extendible

Statutory deadlines are not extendible by the Board. Signature did not meet the statutory deadline, and accordingly, the opposition must be dismissed.

Signature's Notice of Opposition pleading filed on August 2, 2017 did not identify the required privity. No timely pleading was filed by Signature that set out privity. Rather, the original Notice of Opposition pleading even sets forth different and potentially contrary facts. In the original Notice of Opposition, Signature pleaded factual assertions claiming that it was using the mark EVERYONE WILL NOTICE. NO ONE WILL KNOW as early as November 2, 2016.[6] Signature, however, did not even exist until May 4, 2017.[7] Moreover, the proposed amended pleading now claims that Signature and Dr. Whitaker use the mark EVERYONE WILL NOTICE. NO ONE WILL KNOW, which itself raises further questions:

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[5] The assignment language does not mention the "application", nor does it convey claims or causes of action, and therefore Signature lacks standing to proceed, so the motion to amend is therefore futile.

[6] The original pleading provides that Signature uses the mark: "Opposer is the owner of United States Trademark Application Serial No. 87314510 for the mark "EVERYONE WILL NOTICE. NO ONE WILL KNOW". As indicated in this application, since at least as early as November 2, 2016, Opposer has been, and is now, using in interstate commerce, the mark "EVERYONE WILL NOTICE. NO ONE WILL KNOW" in connection with 'Medical services.' " (Signature August 2, 2017 Notice of Opposition, par. 1)

[7] See Opposer's Exhibit 1 to Opposer's Motion.

> ...As indicated in this application, since at least as early as November 2, 2016, Opposer or its predecessor in interest, has been, and is now, using in interstate commerce, the mark "EVERYONE WILL NOTICE. NO ONE WILL KNOW" in connection with "Medical services.
>
> (Signature's Proposed First Amended Notice of Opposition, par. 6)

The statutory basis for an opposition proceeding is contained in 15 U.S.C. § 1063, which, in pertinent part, provides and a person:

> . . . may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, ***within thirty days*** after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition ***shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause*** when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. . . .
>
> (15 U.S.C. § 1063, emphasis added)

Signature moves the Board for an order to amend the pleading, but the deadline is statutory and, therefore, the relief sought by Signature cannot be granted. A parallel are the statutory deadlines for renewing a registration (15 U.S.C. § 1059)

> Renewal of registration
>
> (a) Period of renewal; time for renewal
> Subject to the provisions of section 1058 of this title, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director. Such application may be made at any time within 1 year before the end of

> each successive 10-year period for which the registration was issued or renewed, or it may be made within a grace period of 6 months after the end of each successive 10-year period, upon payment of a fee and surcharge prescribed therefor. If any application filed under this section is deficient, the deficiency may be corrected within the time prescribed after notification of the deficiency, upon payment of a surcharge prescribed therefor.
>
> (15 U.S.C. 1059(a))

Even where a party made a showing of a specimen to demonstrate use of the mark, but another party signed the document, an amendment was not permitted, since the statutory deadline had passed (and the registration is cancelled). United Tactical Sys., LLC v. Real Action Paintball, Inc., (N.D. Cal. 2017)

In the present case, Applicant submits that Signature's motion to amend must be denied because the statutory deadlines were not met, and pursuant to the Statute governing the opposition (15 U.S.C.§ 1063), and the requirements established under TBMP § 303.05(b), the Board cannot grant Signature's Motion.

D. Signature's Amendment, If Permitted, Would be Prejudicial to Applicant

Finally, the inconsistency of Signature's claim in its original Notice, of Signature's continued use of the mark as early as November 2, 2017 (before Signature even existed), and Signature's claim to own an application (that it received by assignment from Dr. Whitaker), when the word "application" does not even appear in the purported transfer instrument, and the circumvention of the statutory deadlines, if permitted to support the Signature amendment, are

prejudicial to Applicant David J. Witchell. If Signature's amendment is permitted, the Applicant will be faced with the task of determining what is actually being pleaded.

For the above reasons, the Motion to Amend should be denied.

Dated: October 16, 2017

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MEMORANDUM OF APPLICANT DAVID J. WITCHELL SALON & SPA, INC. IN OPPOSITIONS TO OPPOSER'S MOTION TO AMEND has been served on JungJin Lee, Erin C. Bray, and Heather M. Dent by forwarding said copy on October 16, 2017 via email and first class mail to:

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