

THIS ORDER IS NOT 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

mbm

Mailed: December 18, 2017

Opposition No. 91235923

*Signature Aesthetics, LLC*

*v.*

*David J. Witchell Salon & Spa, Inc.*

Before Wolfson, Greenbaum, and Pologeorgis,  
Administrative Trademark Judges.

By the Board:

This proceeding now comes before the Board for consideration of Applicant's motion (filed September 11, 2017) to dismiss the notice of opposition for lack of subject-matter jurisdiction under Fed. R. Civ. P. 12(b)(1). On September 26, 2017, in response to Applicant's motion to dismiss, Opposer filed a combined response to Applicant's motion to dismiss and cross-motion for leave to amend its notice of opposition, accompanied by an amended complaint. Applicant filed a response to Opposer's motion for leave to amend on October 16, 2017.

Applicant's involved application Serial No. 87236339 was published for opposition on April 4, 2017. On May 2, 2017, Elizabeth G. Whitaker filed a 90-day Request for an Extension of Time to Oppose the involved application in her name as an individual. The request was granted on the same day, and Ms. Whitaker was allowed until August 2, 2017 in which to file an opposition. *See* Trademark Rule

2.102, 37 C.F.R. § 2.102. On August 2, 2017, within the 90-day extension period granted to Ms. Whitaker, a notice of opposition was filed. The ESTTA filing cover page for the notice of opposition identifies the opposer as Ms. Whitaker, however, the attached notice of opposition identifies Signature Aesthetics, LLC (“Signature Aesthetics”) as the opposer.

In lieu of an answer, Applicant filed a motion to dismiss, contending that Signature Aesthetics is the named opposer in this proceeding and that Signature Aesthetics is not the same person to whom the 90-day extension of time was granted.<sup>1</sup> Under Fed. R. Civ. P. 15(b), a plaintiff may file an amended pleading once as a matter of course within 21 days of service of a motion to dismiss brought under Fed. R. Civ. P. 12(b). Applicant argues, however, that TBMP §§ 206.02 and 303.05(b) require that a showing of privity between the individual granted the extension of time to oppose and the entity filing the opposition must be made at the time the request for an extension is filed or in the initial notice of opposition. It is Applicant’s contention that the Board does not have jurisdiction, because Signature Aesthetics and Ms. Whitaker may not now demonstrate privity upon amendment of the pleading.

Trademark Rule 2.102(b), 37 C.F.R. § 2.102(b), provides that:

A request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time must be in the name of the person to whom the extension was granted, except that an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if

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<sup>1</sup> The Board may consider matters outside of the pleadings, such as the extension of time to oppose filed by Ms. Whitaker, on a motion to dismiss for lack of subject-matter jurisdiction without converting the motion into one for summary judgment. *See Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1873-74 n.2 (TTAB 2011).

the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

Nothing in Trademark Rule 2.102(b) prohibits a party from amending its pleading to demonstrate privity or to correct a mistake after a proceeding has been instituted. Applicant bases its argument in part on TBMP § 303.05(b), which provides that a showing of privity should include a recitation of facts on which the claim is based and must be submitted either with the opposition or in the time allowed by the Board in a letter requesting an explanation of a discrepancy.<sup>2</sup> If the Board issues a letter requiring the potential opposer to provide an explanation of a discrepancy, the potential opposer must provide a response for the proceeding to be instituted. *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1076 (TTAB 1993); *see also* TBMP § 303.05(b). Once a proceeding is instituted, however, nothing prohibits a plaintiff from seeking to amend its pleading to correct a mistake or make a showing of privity. *Cf. Custom Computer Servs., Inc. v. Paychex Props., Inc.*, 337 F.3d 1334, 67 USPQ2d 1638 (Fed. Cir. 2003) (finding that the Board erred in dismissing the proceeding where the plaintiff made a mistake as to the form of the correct plaintiff in its extension of time to oppose). Accordingly, Applicant is incorrect that Opposer's proposed amendment is untimely.

The Board next turns to the proposed amended notice of opposition. An opposition filed by a party other than the one to whom an extension of time to oppose was

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<sup>2</sup> The Trademark Board Manual of Procedure, or TBMP, provides guidance to practitioners and includes citations to relevant authorities, but is not itself controlling. *See* Introduction to the Trademark Board Manual of Procedure (“The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board...”). *Cf. In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989).

granted will not be rejected on that basis if it is shown to the satisfaction of the Board that the other party is in privity with the party granted the extension or that the party in whose name the extension was requested was misidentified by mistake. *See Custom Computer Servs., Inc.*, 67 USPQ2d at 1639; *cf. Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1670-71 (TTAB 2015).

Signature Aesthetics contends that privity exists between Signature Aesthetics and Ms. Whitaker and that Applicant's motion to dismiss should therefore be denied. Specifically, Signature Aesthetics alleges that, on May 2, 2017, when Ms. Whitaker filed and was granted the request for an extension of time to oppose, she was the owner of common law rights to the mark EVERYONE WILL NOTICE. NO ONE WILL KNOW. for "medical services" and owner of the pleaded application Serial No. 87314510 for the same mark for those services in International Class 44. 6 TTABVue 4. On May 4, 2017, two days after the request for an extension of time to oppose was filed and granted, Ms. Whitaker incorporated Signature Aesthetics. *Id.* Ms. Whitaker then assigned all rights, title and interest in the mark and in application Serial No. 87314510 to Signature Aesthetics on May 10, 2017.<sup>3</sup> *Id.* Privity is generally recognized to include the relationship of successive owners of a trademark, such as an assignor and an assignee. *See Int'l Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000).

Insofar as Opposer has clearly alleged that Signature Aesthetics is the successor in interest of Ms. Whitaker's trademark rights, Opposer has sufficiently alleged

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<sup>3</sup> Recorded May 11, 2017, Reel/Frame No. 6059/0525.

privity. Accordingly, Applicant’s motion to dismiss is **denied** and Opposer’s cross-motion for leave to amend its pleading is granted. Opposer’s September 26, 2017 amended notice of opposition is accepted as the operative pleading in this case.<sup>4</sup> Fed. R. Civ. P. 15(a).

Proceedings herein are resumed. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to file and serve an answer or otherwise respond to the notice of opposition. Remaining dates are reset as follows:

Deadline for Discovery Conference	<b>February 17, 2018</b>
Discovery Opens	<b>February 17, 2018</b>
Initial Disclosures Due	<b>March 19, 2018</b>
Expert Disclosures Due	<b>July 17, 2018</b>
Discovery Closes	<b>August 16, 2018</b>
Plaintiff's Pretrial Disclosures Due	<b>September 30, 2018</b>
Plaintiff's 30-day Trial Period Ends	<b>November 14, 2018</b>
Defendant's Pretrial Disclosures Due	<b>November 29, 2018</b>
Defendant's 30-day Trial Period Ends	<b>January 13, 2019</b>
Plaintiff's Rebuttal Disclosures Due	<b>January 28, 2019</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>February 27, 2019</b>
<b>BRIEFS SHALL BE DUE AS FOLLOWS:</b>	
Plaintiff's Main Brief Due	<b>April 28, 2019</b>
Defendant's Main Brief Due	<b>May 28, 2019</b>
Plaintiff's Reply Brief Due	<b>June 12, 2019</b>

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<sup>4</sup> In Applicant’s response to Opposer’s motion for leave to amend its pleading, Applicant contends that the purported assignment of Ms. Whitaker’s rights in Application Serial No. 87314510 was invalid and that Signature Aesthetics does not have standing as a result. Standing is an element of Opposer’s claims and must be proven as part of Opposer’s case. *See Empresa Cubana del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). Although the Board has denied the motion to dismiss on the ground that Signature Aesthetics has sufficiently pleaded its privity with Ms. Whitaker and therefore Signature Aesthetics has sufficiently pleaded standing, proof of Signature Aesthetics’ standing must be determined at trial or if the case is decided upon summary judgment.

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).