

ESTTA Tracking number: **ESTTA892165**

Filing date: **04/24/2018**

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

Proceeding	91236414
Party	Plaintiff Green Heart Labs, LLC
Correspondence Address	MARK D KREMER CONKLE KREMER & ENGEL PLC 3130 WILSHIRE BLVD, SUITE 500 SANTA MONICA, CA 90403 UNITED STATES Email: lp@conklelaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Aleen Tomassian
Filer's email	lp@conklelaw.com
Signature	/Aleen Tomassian/
Date	04/24/2018
Attachments	9996 Mtn for Leave to Amend Ntc of Opp _2_.pdf(440521 bytes)

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

Green Heart Labs, LLC

Opposer,

v.

Skinboss Inc.

Applicant.

OPPOSITION No. 91236414

Serial No. 87/129,127

Mark: SKINBOSS

OPPOSER’S MOTION FOR LEAVE THE AMEND NOTICE OF OPPOSITION

Opposer, Green Heart Labs, LLC (“GHL”) hereby moves the Trademark Trial and Appeal Board (the “Board”) for leave to amend its Notice of Opposition under Federal Rules of Civil Procedure 15(a) to supplement the allegations made in its Notice of Opposition and to add causes of action for non-use and fraud.

Opposer’s Motion is supported by the Declaration of Aleen M. Tomassian attached hereto (“Tomassian Decl.”). Additionally, a Proposed First Amended Notice of Opposition is being submitted concurrently herewith. (See Ex. A.)

**MEMORANDUM IN SUPPORT OF OPPOSER’S MOTION TO LEAVE TO AMEND
NOTICE OF OPPOSITION**

Pursuant to Federal Rules of Civil Procedure 15(a), 37 C.F.R. § 2.107(a) and T.B.M.P. § 507, Opposer hereby requests that the Board grant Opposer leave to amend its Notice of Opposition.

Skinboss Inc.’s (“Skinboss” or “Applicant”) Application at issue in this Opposition Serial No. 87/129,127 seeks registration for various goods in International Class 3 and 35. Applicant claims a date of first use in commerce of August 5, 2016 in both classes. Applicant’s sole basis

for registration of the goods in Class 3 is Applicant's actual use of the mark in U.S. commerce under Section 1(a) of the Trademark Act.

Facts concerning Applicant's fraud in filing and prosecuting Application have recently come to light in discussions with Applicant's counsel. Namely, Opposer has discovered that Applicant has never used the applied for mark in connection with any goods in Class 3, and misrepresented its use with such goods when it filed its Application with the USPTO. Opposer therefore seeks leave to amend its Notice of Opposition to supplement the allegations made in its Notice of Opposition and to add causes of action for failure to use the mark in connection with Applicant's Class 3 goods ("non-use of the mark") and fraud.

During a telephone conference on or about March 21, 2018, Opposer's counsel informed Applicant's counsel that Opposer has been unable to find any proof that Applicant has ever used the applied for mark in connection with Class 3 goods at any time. [Tomassian Decl. ¶ 2] Indeed, not only is there no evidence that Applicant has used the SKINBOSS mark in connection with Class 3 goods, but Applicant's specimen of use submitted at the time the Application was filed only shows use in connection with Class 35 services. Applicant claimed in response that the Application gave a presumption of use of the SKINBOSS mark on Class 3 goods, and that the burden is on Opposer to show prior use.¹ [Tomassian Decl. ¶ 3, 4] Applicant noted that there might have been use of the SKINBOSS mark on Class 3 goods at the time of application, even if the mark is not being presently used in Class 3. Applicant declined to voluntarily produce any evidence of such use.

¹ Only a registration, not an application, affords a trademark claimant any presumptions regarding the validity or ownership of a trademark. *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1472 (Fed. Cir. 1987) ("[T]he act of filing a trademark application is accompanied by no legal presumption whatsoever." "[T]he mere act of filing an application for federal trademark registration is accompanied by no statutory presumption of entitlement.")

Applicant's unwillingness and apparent inability to point to any use of the SKINBOSS mark on Class 3 goods indicates that Applicant likely never had actual use of the SKINBOSS mark on Class 3 goods. If Applicant cannot show use as of the application date, such misrepresentations would amount to material misrepresentations of fact that Applicants knew or should have known were false or misleading. "The law is clear that an application can be held void if the plaintiff pleads and proves either fraud or non-use of a mark for all identified goods or services prior to the [declaration of use]." *Shutemdown Sports, Inc.*, 102 U.S.P.Q.2d 1036 (T.T.A.B. Feb. 22, 2012). Thus, Opposer requests leave to amend its Notice of Opposition to properly reflect the charges of failure to use the mark on goods identified in the Application and fraud based on these new findings.

Under FRCP 15(a), the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless the entry of the proposed amendment unduly prejudices the adverse party. TBMP 507.02; *Karsten Mfg. Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006). Applicant will not be prejudiced by the addition of the new claims. Both parties have served initial discovery requests, and the issue of priority and non-use of the mark/fraud are closely related in this instance. Opposer's discovery requests already seek information regarding proof of use of the SKINBOSS mark in Class 3, and Applicant's statements made to the USPTO at the time of registration. Opposer informed Applicant of its intention to amend the Notice of Opposition on April 9, 2018, and asked whether Applicant would stipulate to an amendment. [Tomassian Decl. ¶ 5] After pressing Applicant a couple times to respond, Applicant finally responded on April 21, 2018, indicating that they would not stipulate to the amendment. [Tomassian Decl. ¶ 6]

Indeed, the Board regularly grants motions for leave to amend up to the opening of the initial trial period. *See, e.g. Hurley Int'l LLC*, 82 U.S.P.Q.2d 1339 (T.T.A.B. Jan. 23, 2007) (granting leave to amend to add a fraud claim, noting that “opposer’s motion for leave to file an amended notice of opposition was filed prior to the start of trial and the record does not indicate that applicants would be prejudiced by opposer’s addition of a fraud claim to the likelihood of confusion claim set forth in its notice of opposition.”) This Motion is being filed promptly after Opposer learned of Applicant’s non-use of the mark on any Class 3 goods and misrepresentations to the USPTO.

In light of the foregoing, justice requires the Board to grant leave to Opposer to amend its Notice of Opposition to include causes of action for non-use and fraud.

REQUEST FOR EXTENSION OF TRIAL DATES

Opposer respectfully requests a 60-day extension of all trial dates to allow the parties to conduct discovery on the newly added claims. Prior to the filing of this Motion, Opposer served discovery requests on Applicant. Applicant served discovery requests on Opposer on April 2, 2018. Extending the trial dates by 60 days will allow both parties sufficient time to conduct any necessary additional discovery on the new claims.

Dated: April 24, 2018

By: _____ /s Aleen Tomassian /s/

Mark D. Kremer
Aleen Tomassian
Attorneys for GREEN HEART LABS, LLC

CONKLE, KREMER & ENGEL
Professional Law Corporation
3130 Wilshire Boulevard, Suite 500
Santa Monica, California 90403-2351
Phone: (310) 998-9100
Fax: (310) 998-9109
a.tomassian@conklelaw.com
tm@conklelaw.com

DECLARATION OF ALEEN M. TOMASSIAN

I, Aleen M. Tomassian, hereby declare as follows:

1. I am an active member of the State Bar of California. I am a member of Conkle, Kremer & Engel, whose members are counsel of record for Opposer American International Industries. I make this declaration of facts known to me and, if called upon, I could and would testify competently to the facts stated herein.

2. On March 21, 2018, I participated in a telephone conference with Applicant's counsel. During the telephone conference, I stated that I had been unable to find any proof that Applicant has ever used the SKINBOSS Mark in connection with Class 3 goods at any time. I noted that I did not think that Applicant was using the mark on Class 3 goods at the time of registration and was thus not entitled to the registration.

3. In response, Applicant claimed that Applicant did not have to provide proof that it had been using the SKINBOSS Mark on Class 3 goods at the time of registration, because the Application gave rise to a presumption that the mark was used on Class 3 goods. Applicant stated that Applicant did not have the burden to prove anything, but rather the Opposer had the burden to prove that Opposer was using the SKINBOSS Mark prior to the date of first use claimed in the Application.

4. I responded that if Applicant had misrepresented to the USPTO that it was using the SKINBOSS Mark on Class 3 goods to obtain a registration, that would amount to fraud on the USPTO. Applicant's counsel responded that even if Applicant is not using the mark now, it is possible that Applicant was using the mark at the time of registration, but has since discontinued its use on Class 3 goods.

5. In an email sent on April 9, 2018, I informed Applicant's counsel of Opposer's intent to amend the Notice of Opposition to include claims for failure to use the mark on goods listed and fraud upon the USPTO. I asked whether Applicant would stipulate to the amendment. I received no response, and sent a followup email to Applicant's counsel on April 10, 2018.

6. On April 11, 2018, Applicant's counsel responded that he would speak to his client about the request. I followed up with Applicant's counsel on April 16, 2018. On April 21, 2018, Applicant's counsel sent an email stating that Applicant would not stipulate to an Amended Notice of Opposition.

I declare under penalty of perjury under the laws of the State of California and United States of America that the foregoing facts are true and correct, and that this declaration was executed on April 23, 2018.

/s/Aleen M. Tomassian/s/

Aleen M. Tomassian

Exhibit A

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

Green Heart Labs, LLC

Opposer,

v.

Skinboss Inc.

Applicant.

OPPOSITION No. 91236414

Serial No. 87/129,127

Mark: SKINBOSS

FIRST AMENDED NOTICE OF OPPOSITION

Opposer, Green Heart Labs, LLC (“GHL”), a limited liability company organized and existing under the laws of Oregon, believes it will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. 87/129,127. Opposer hereby opposes same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1063(a).

As grounds for opposition, Opposer hereby alleges as follows:

1. Opposer is the owner of the application for SKINBOSS (Serial No. 87165752) (the “GHL Application”) in Class 3 for “Non-medicated skin care preparations” and Class 21 for “Bath products, namely, loofah sponges; Bath sponges; Body scrubbing puffs; Exfoliating cloths; Exfoliating mitts; Exfoliating pads; Scrub sponges; Scrubbing brushes; Washing cloths; Cleaning cloths.” Attached as Exhibit 1 is a true and correct printout from the United States Patent and Trademark Office electronic database showing the current status of the application as of August 28, 2017.

LIKELIHOOD OF CONFUSION AND PRIOR USE

2. Opposer has used its SKINBOSS Mark in interstate commerce in the United States continuously since June 2012 in connection with the sale, marketing, advertising and promotion of the goods set forth in the GHIL Application.

3. As a result of its continuous use of the SKINBOSS mark to identify its goods and Opposer as their source, Opposer owns valid and subsisting common law rights to the SKINBOSS Mark.

4. Opposer's SKINBOSS Mark is distinctive to both the consuming public and Opposer's trade.

5. Upon information and belief, Applicant, Skinboss, Inc. ("Applicant"), a corporation organized and existing under the laws of Connecticut, filed the subject application for SKINBOSS (Serial No. 87129127) in Class 3 for, among other goods, "skin cleansing creams, skin creams . . . skin moisturizers . . . skin clarifiers, skin soaps" and Class 35 for "Computerized online ordering services featuring cosmetics; retail and on-line store services featuring curated cosmetics; on-line retail store services featuring cosmetics and beauty supplies; on-line retail store services featuring cosmetics, personal hygiene and care products; retail store services featuring cosmetics and beauty and personal hygiene products."

6. Applicant allegedly began using the proposed mark on August 5, 2016, at least four (4) years after Opposer began using the Opposer's SKINBOSS mark.

7. Applicant's proposed mark SKINBOSS is identical to Opposer's SKINBOSS mark. Both marks consist of the unitary word "SKINBOSS" in standard characters.

8. The goods and services covered by the Applicant's subject application are similar to the goods Opposer offers under its SKINBOSS mark. Opposer's application includes skin care preparations in Class 3, while Applicant's subject application covers skin cleansing creams, skin

creams, skin moisturizers, skin clarifiers, skin soaps, and other related goods in Class 3 (the “Class 3 Goods”). Applicant’s Class 35 services, which, among other things, include on-line retail store services featuring cosmetics and beauty supplies, are closely related to Opposer’s goods, such that confusion is likely to arise if Applicant is granted a registration for the SKINBOSS Mark in Class 35.

9. Applicant’s proposed mark should be denied registration because it is identical to Opposer’s previously-used SKINBOSS mark and is therefore likely, when used in connection with the alleged goods and services of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

FRAUD ON THE USPTO

10. Applicant does not currently and has never used the SKINBOSS mark on the Class 3 Goods.

11. In order to obtain registration for SKINBOSS, Applicant filed a declaration of use stating under oath that the applied-for mark had been in use on the Class 3 Goods at the time the Application was filed.

12. However, Applicant knew that it was not using the SKINBOSS Mark on the Class 3 Goods at the time the Application was filed, or made the statement with reckless disregard for the truth.

13. Applicant initially filed its Application in Class 35 for goods and services. The Examiner issued an Office Action stating that Applicant identified goods and services that fall into two classes, and that the goods fall into Class 3. In an email to Applicant’s counsel, the Examiner noted that “if you wish to proceed with Class 3 a better specimen will need to be provided.” At that point, Applicant could to have only reasonably understood that use of the

SKINBOSS Mark on Class 35 services would not support a use-based application for the Class 3 Goods.

14. Instead of restricting the Application solely to Class 35 goods, Applicant elected to submit an additional filing fee in order to amend the Application to seek a multi-class registration of the mark in both Class 3 and Class 35. Though Applicant paid an additional filing fee to expand the Application seeking registration in an additional class and was placed on notice that its specimen for Class 35 was insufficient to support a 1(a) use-based application for the mark in Class 3, Applicant chose not to satisfy the Examiner's explicit request for an acceptable specimen in Class 3. By proceeding to seek registration for a mark that was not being used in commerce in accordance with the requirements of the Lanham Act, Applicant knowingly, or with reckless disregard for the truth, deceived the USPTO by representing that it had used the mark in commerce in both Class 3 and Class 35.

15. In its initial Application, Applicant stated that the SKINBOSS Mark was first used in commerce as early as August 5, 2016. By filing a 1(a) use-based Application for both goods that are covered in Class 3 and services that are covered in Class 35, Applicant misrepresented to the USPTO that it was using the SKINBOSS Mark as early as August 5, 2016 for the Class 3 Goods. Opposer has found no evidence, and Applicant has refused to provide any, that Applicant was using the SKINBOSS Mark on the Class 3 Goods at the time it submitted its Application and supporting Declaration of Use. Instead of amending the application into a mixed 1(a)/1(b) application, Applicant maintained a 1(a) use-based Application in both Classes 3 and 35. When Applicant submitted its Application and supporting Declaration of Use, and in subsequent statements to the USPTO, Applicant knew it was not

using the SKINBOSS Mark on the Class 3 Goods, or made the statement with reckless disregard for the truth.

16. Applicant's fraudulent misrepresentation regarding the alleged use of the SKINBOSS Mark on the Class 3 Goods was material, as the USPTO reasonably relied on the misrepresentation and would not have published the mark for opposition had Applicant admitted that it had committed fraud on the USPTO by submitting a 1(a) use-based application, despite knowledge that it had not used the SKINBOSS Mark on the Class 3 Goods.

17. Because Applicant committed fraud on the USPTO, its Application for SKINBOSS must be denied registration as to the Class 3 Goods.

NON-USE OF THE MARK

18. Opposer is informed and believes that Applicant does not currently and has never used the SKINBOSS mark any goods in Class 3, includign but not limited to the Class 3 Goods identified in the Application.

19. Applicant filed a 1(a) use-based Application for SKINBOSS in Class 3. Because Applicant does not currently and has never used the SKINBOSS Mark on any Class 3 goods, the Application must be denied registration as to the Class 3 Goods.

WHEREFORE, Opposer respectfully prays that its opposition be sustained and that registration to Applicant be refused.

Dated: April 24, 2018

By: /s Aleen Tomassian /s/

Mark D. Kremer
Aleen Tomassian
Attorneys for GREEN HEART LABS, LLC

CONKLE, KREMER & ENGEL
Professional Law Corporation
3130 Wilshire Boulevard, Suite 500
Santa Monica, California 90403-2351
Phone: (310) 998-9100
Fax: (310) 998-9109
m.kremer@conklelaw.com
a.tomassian@conklelaw.com
tm@conklelaw.com

Exhibit 1



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Aug 30 05:33:54 EDT 2017

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) | [PREV LIST](#) | [CURR LIST](#) | [NEXT LIST](#)
[FIRST DOC](#) | [PREV Doc](#) | [NEXT Doc](#) | [LAST Doc](#)

Please logout when you are done to release system resources allocated for you.

List At: OR to record: **Record 2 out of 2**

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

SKINBOSS

Word Mark SKINBOSS

Goods and Services IC 003. US 001 004 006 050 051 052. G & S: Non-medicated skin care preparations. FIRST USE: 20120600. FIRST USE IN COMMERCE: 20120600

IC 021. US 002 013 023 029 030 033 040 050. G & S: Bath products, namely, loofah sponges; Bath sponges; Body scrubbing puffs; Exfoliating cloths; Exfoliating mitts; Exfoliating pads; Scrub sponges; Scrubbing brushes; Washing cloths; Cleaning cloths. FIRST USE: 20120600. FIRST USE IN COMMERCE: 20120600

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 87165752

Filing Date September 9, 2016

Current Basis 1A

Original Filing Basis 1A

Owner (APPLICANT) Green Heart Labs LIMITED LIABILITY COMPANY OREGON 8895 Towne Centre Dr. Suite 105 San Diego CALIFORNIA 92122

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#) [PREV LIST](#) [CURR LIST](#) [NEXT LIST](#)
[FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)