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

Proceeding	91236414
Party	Defendant SKINBOSS INC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SKINBOSS, INC., Applicant, v. GREEN HEART LABS, LLC, Opposer.	Opposition No. 91236414 Serial No. 87129127 **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

COMES NOW Applicant, Skinboss, Inc. (hereinafter "Skinboss" or "Applicant"), and for its Opposition to Opposer's, Green Heart Labs, LLC (hereinafter "GHL" or "Opposer"), Motion for Leave to Amend Notice of Opposition ("Motion"), states as follows:

I. FACTUAL AND PROCEDURAL BACKGROUND.

Applicant applied to register the Mark SKINBOSS on August 5, 2016 under sections § 1(a) following the launch of Applicant's cosmetics. (Exhibit A, Declaration of Matthew Warner-Blankenship ("MWB Decl.") ¶ 3). The Application (Serial No. 87/129,127) was submitted without the designation of any Class, reciting the following description of goods and services:

> *Online cosmetic sales and distribution; curated cosmetic sales; sales of cosmetics and beauty supplies online; cosmetic sales; sales of personal hygiene and care products; perfumes; perfumery products; essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, bath powders, beauty masks, body creams, body powders, cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, night creams, shower gels, skin clarifiers, skin soaps, suntanning preparations, moisturizers, make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair lotions; hair shampoos; retail stores for cosmetics and beauty and personal hygiene products.*

After Skinboss submitted its Application, Ms. Tarah Hardy Ludlow, the Examining Attorney, contacted Skinboss on November 16, 2016. (MWB Decl. ¶ 4). In a subsequent conversation on November 22, 2016, Ms. Ludlow gave Skinboss the option to pursue the Application in classes 003 and 035. (MWB Decl. ¶ 5). Applicant elected to proceed in both classes. (MWB Decl. ¶ 6). Following discussions between the undersigned and Ms. Ludlow about the acceptability of the submitted specimen, Ms. Ludlow approved the specimen for both classes.

However, out of an abundance of caution, on November 30, 2016, Skinboss sought to amend the application's class 003 portion to a 1(b) filing basis for "Perfumes; perfumery; essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, bath powders, beauty masks, body creams, body powders, cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, night creams, shower gels, skin clarifiers, skin soaps, suntanning preparations, moisturizers; make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair lotions; hair shampoos"; and the services in class 035 under 1(a) 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." (MWB Decl. ¶¶ 8-9).

At this same time, Applicant's deposit account had insufficient funds due to an internal administrative mistake, which led to further correspondence with the Examining Attorney. As a

result of this discussion, the Examining Attorney issued a priority action on November 30, 2016 affording Applicant the ability to pay the required fees. (MWB Decl. ¶ 8). However, the class 003 goods were not amended to 1(b) at this time.

Several months later, on March 3, 2017, Skinboss received a cease and desist letter from Opposer's prior counsel, Mr. Travis Wilson. (MWB Decl. ¶ 11). As Skinboss was still working diligently to correct the USPTO's mistake with its Application, it reviewed the file status online and followed up with Ms. Ludlow on March 17, 2017 to determine whether the amendment to class 003 had been effectuated. MWB Decl. Ex. 2 Skinboss then responded to Mr. Wilson on March 24, 2017. In this response, Skinboss identified the class 003 goods as being applied-for under the 1(b) filing basis.

With no changes having yet been made to the Application, Skinboss continued to make multiple attempts to convert the class 003 goods to a 1(b) application, but were not able to complete this correction prior to publication of the mark. A final, transcribed voicemail documents these attempts with Ms. Kathryn Coward from April 12, 2017. (MWB Decl. ¶ 14 and Ex. 3). Unfortunately, these attempts to amend the filing basis were unsuccessful.

On May 23, 2017, Opposer filed a motion to extend the time to oppose. Just one day later, on May 24, 2017, HUGO BOSS Trade Mark Management GmbH & Co KG & HFC Prestige International Operations Switzerland Sarl filed a motion to extend their time to oppose.

After some discussions, Opposer filed the present Opposition on August 30, 2017. The Opposition alleges Opposer is the owner of the application for SKINBOSS in class 003 and Class 21. Additionally, the Opposition states Opposer had used the SKINBOSS mark prior to Skinboss' use and acceptance of Skinboss' registration would cause "confusion, mistake, or

deception within the meaning of 15 U.S.C. § 1052(d)." (Opp. ¶ 9). The Opposition states no other claims. Skinboss filed an Answer to the Opposition on October 6, 2017.

Unfortunately, the corrections needing to be made to Skinboss' original Application had still not been completed, and Skinboss was told corrections could not be made until after the Opposition proceedings were finished. (MWB Delc. ¶ 13). Initially, this was not an issue in the proceedings because Opposer's Opposition did not include a claim for non-use under international class 003.

However, more than five (5) months after Skinboss' Answer was filed, and nearly six (6) months since the filing of the Opposition, counsel for Opposer emailed counsel for Skinboss on March 16, 2018. This was over three (3) months after Opposer filed its initial disclosures. On March 21, 2018, counsel for Opposer spoke to counsel for Skinboss concerning whether evidence existed to support Skinboss' use of the proposed mark within the class 003 registration. At that point Opposer had yet to serve any discovery on Skinboss. In fact, Opposer did not serve discovery requests until April 9, 2018, nearly seven (7) months after filings its Opposition.

Opposer filed a Motion for Leave to Amend ("Motion") its Opposition on April 24, 2018, without even waiting for Skinboss to respond to Opposer's discovery requests. The new claims Opposer wishes to add include claims for fraud and non-use of the mark within class 003. Following Opposer's Motion to Amend, Skinboss filed a motion on May 7, 2018 requesting the class 003 designation within the Application be divided from the Class 035. Skinboss also moved to amend the international class 003 application to a 1(b) filing basis. Opposer's Motion also include a motion to extend the trial deadlines in this case.

Presently, no new factual information has arisen that did not exist at the time of GHL's August 30, 2017 Opposition filing. Opposer's Motion should be denied because it is unduly delayed and Opposer has not shown good cause for its failure to diligently work-up its case.

II. STANDARD FOR MOTION FOR LEAVE TO AMEND.

Opposer has failed to meet the standards for a motion for leave to amend. A party may amend a pleading in an opposition proceeding only with the written consent of the opposing party or by the court's leave if the 21 days to amend as a matter of course has expired. Fed. R. Civ. P. 15(a)(2); *see also* T.B.M.P. § 507.01 and 37 C.F.R. § 2.107(a). Here, Opposer seeks to amend its Opposition outside of the 21-day window articulated in Rule 15(a)(2). Rule 15(a)(2) states "leave shall be freely given when justice so requires." Fed. R. Civ. P. 15(a). However, this does not mean the right to amend is absolute. *Mertens v. Hummell*, 587 F.2d 862, 865 (7th Cir. 1978).

Under Rule 15(a)(2), courts may deny a motion to amend if it finds "undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, [or] undue prejudice to the opposing party." *Foman v. Davis*, 371 U.S. 178, 182 (1962). The Board has adopted this standard. The Board may deny leave to amend "where there is undue delay, bad faith or dilatory motive on the part of the movant . . . undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc." *Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha Opposition*, 26 U.S.P.Q.2d 1503, at *3 (TTAB Feb. 3, 1993) (quoting *Forman v. Davis*, 331 U.S. 178, 182 (1962)). Importantly, a motion to amend should be denied when "the party seeking amendment knows or should have known of the facts upon which the proposed amendment is based but fails

to include them in the original complaint." *Las Vegas Ice and Cold Storage Co. v. Far West Bank*, 893 F.2d 1182, 1885 (10th Cir. 1990) (citation omitted).

Here, Opposer's Motion should be denied because it is unduly delayed, Opposer has no new facts to support its allegations, and granting Opposer's motion would be prejudicial to Skinboss.

III. OPPOSER'S MOTION FOR LEAVE TO AMEND IS UNTIMELY.

Opposer's Motion is untimely because the factual basis supporting its new claims existed at the time it filed its initial Opposition. Opposer's Opposition included only one claim: likelihood of confusion and prior use of the mark. Opposer would now like the Opposition to include claims for fraud upon the USPTO and non-use of the mark under a class 003 application. *See* Opposer's Mot. to Amend Ex. A. However, GHL's Motion to Amend is untimely because it should have known of the possibility of these claims when the Opposition was first filed.

Opposer cites *Karsten Mfg. Corp.* in support of its contention that the Board liberally grants leaves to amend. Mot. to Amend, pg. 3; 79 U.S.P.Q.2d 1783 (TTAB 2006). In *Karsten*, the Opposer requesting leave to amend stated that when the opposition was filed, the new claim did not exist, and the facts giving rise to this claim were not discovered until after a deposition had been completed for the case. *Id.* at *1. The Board granted the leave to amend, finding the Opposer had not delayed in filing the request to amend within a month of discovering the new factual information and claim. *Id.*

The facts in *Karsten* are very different than the facts in this case. Here, prior to filing its Motion, Opposer did not conduct any discovery despite having more than *seven months* from the date it filed its Opposition to serve discovery. In fact, Opposer did nothing to forward its case between the time it served its initial disclosures and the filing of its Motion except to discuss this

case informally with Applicant. Despite Applicant producing documents to Opposer in its initial disclosures, Opposer did not produce a single document to substantiate its claims in its initial disclosures. Since Opposer did not conduct any discovery prior to filing its Motion, Opposer has no "new" facts to support its new claims.

Furthermore, the "new" facts Opposer alleges to support their additional claims were discoverable from the outset of its Opposition. The contents of Skinboss' Application have been available for Opposer's examination since before it filed its Opposition. Opposer appears to claim it was not capable of discovering the basis for its claims for fraud and non-use of the mark until the March 21, 2018 telephone conversation with Skinboss' counsel.[1] Opposer states it can find no evidence that Skinboss' Application was properly filed or evidence supporting Skinboss' timeline of use of the mark. However, Opposer made no efforts to serve discovery until April, more than two weeks after the telephone conversation with Skinboss' counsel and more than *seven months* after it filed its Opposition.

The present Opposition is very similar to *Trek Bicycle Corporation v. Styletrek Limited*. In *Trek Bicycle*, the Board denied a motion for leave to amend filed *eight months* after the notice of opposition because the motion was based on facts well within the Opposer's knowledge at the time the notice was filed. 64 U.S.P.Q.2d 1540, *2 (Dec. 19, 2001). The Board stated that the amendment was "wholly silent as to why the [new] claim was not raised earlier." *Id.* The Opposition is also like *Media Online Inc. v. El Clasificado, Inc.* In *Media Online*, the Board

[1] Notably, Opposer misrepresents the March 21, 2018 phone conversation. Opposer's Motion to Amend construes the phone conversation as if Skinboss admitted to non-use and fraudulent misrepresentations in its Application. This cannot be further from the truth. During the phone conversation, Skinboss did nothing more than remind Opposer that Opposer holds the burden in this action and state it would be happy to respond to properly submitted discovery requests. Opposer also demanded evidence and admissions in the phone conversation. However, Opposer had yet to serve discovery requests. Applicant suggested that Opposer conduct discovery. Nevertheless, Opposer did not serve any discovery on Applicant until April 9, 2018, 19 days after the March 21 telephone call, one week after Applicant served discovery on Opposer, and more than *7 months* from the date Opposer filed its Opposition.

denied the opposer's request to amend its opposition to include a claim for fraud *seven months* after the opposition had been filed. 88 U.S.P.Q.2d 1285, *2 (Sept. 29, 2008). Again, the Board found the new claim was based on facts that were readily available to the opposer when the opposition was filed, and that the actions the opposer took to discover this information could have been done prior to filing the opposition. *Id.* Additionally, the Board found the opposer had failed to supply an adequate explanation for the delay in filing the motion to amend, and opposer shared in the "responsibility for moving the case forward and for preparing all possible claims for trial." *Id.*

This case is nearly identical to *Trek Bicycle Corporation* and *Media Online* because no new facts have developed since the Opposer filed its Opposition, other than the fact that a contested settlement call between counsel occurred, during which no new information came to light. Here, Opposer failed to review the publicly available facts and information available to it and conduct discovery until many months after filing the Opposition. Opposer has offered no explanation to the Board as to why it delayed its discovery efforts, especially in light of its unfounded concern that Skinboss lacks the evidence to support its Application. In fact, Opposer effectively admits it was capable of knowing, and thus filing, the newly alleged claims from the outset through its representations in its Motion. Opposer claims it pressed Skinboss about the Application, but was allegedly given no new evidence or explanations. If nothing new was gained from the conversations Opposer has recently had with Skinboss, then everything Opposer now knows is what they knew or could have known when it filed its Opposition. If the party moving to amend fails to plead facts it knew or *should have known*, then the motion for leave to amend should be denied. *Las Vegas Ice and Cold Storage Co.*, 893 F.2d at 1885 (emphasis added).

Furthermore, Opposer's contention that "Applicant has refused to provide" any evidence that Applicant was using the SKINBOSS Mark on class 003 goods at the time it submitted its application is misleading at best. Applicant did not file the subject application in class 003 at all. Opposer failed to conduct any discovery until April 2018 and waited more two weeks to serve discovery after the March 21 telephone conversation even after counsel for Applicant welcomed discovery requests.

Furthermore, allowing Opposer to add such claims would be highly prejudicial to Skinboss. Skinboss has done nothing to procedurally delay in this matter and is eager for an outcome. Meanwhile, Opposer has not diligently moved its case forward. Adding two new claims to this matter would only be rewarding Opposer for its lack of diligence while requiring Skinboss to spend more time and resources on matters Opposer could have raised from the outset of its Opposition.

Opposer's Motion is unduly delayed and should be denied. Opposer could have added its fraud and non-use claims at the outset and diligently forward its case, but it chose not to. *See* Opposer's Mot. to Amend Ex. A at ¶¶ 10–19 (showing Opposer's claims are solely based on the pleadings in this matter). Allowing Opposer to add its claims would prejudice Skinboss. Thus, Opposer's Motion should be denied.

III. OPPOSER'S MOTION SHOULD BE DENIED BECAUSE IT IS FUTILE.

Opposer's Motion should also be denied because it is futile. *Commodore Electronics Ltd.*, 26 U.S.P.Q.2d 1503 at *3 (quoting *Forman*, 331 U.S. at 182). As explained above, Opposer has no new information to substantiate its claims of fraud and non-use. At the time Opposer filed its Motion, it had not received discovery responses from Skinboss. Furthermore, nothing in Skinboss' discovery responses substantiate Opposer's claims. In fact, Skinboss' discovery

responses establish that Skinboss had no intent to commit fraud has in fact been using the "SKINBOSS" mark.

Furthermore, Opposer is unable to set forth any facts to plead its fraud claim "with particularity" as required by Federal Rule of Civil Procedure 9(b). *See* Fed. R. Civ. P. 9(b) ("In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally."). Opposer cannot event allege generally that Skinboss had the intent to commit fraud on the USPTO because Skinboss affirmatively answered "no" to one of Opposer's request for admission asking Skinboss to admit to the same, and Skinboss has repeatedly informed Opposer of the uncommon circumstances involving Skinboss' Application. Thus, Opposer's Motion is futile and should be denied.

IV. OPPOSER'S MOTION FOR AN EXTENSION OF THE TRIAL DATES SHOULD BE DENIED.

Opposer's request to extend trial dates, including an extension of the discovery deadline, should be denied because Opposer has failed to present good cause for the extensions. A party requesting an extension of trial dates must show good cause for the requested extension. *Miss Universe L.P., LLLP and IMG Universe, LLC v. Linda Grandia*, Opposition No. 91220573, 2018 WL1557270, *1 (TTAB March 28, 2018). "To show good cause, the moving party must set forth **with particularity** the facts said to constitute good cause and must demonstrate that the requested extension is not necessitated by the moving party's own lack of diligence or unreasonable delay." *Id.* (emphasis added); *see also Procyon Pharmaceuticals, Inc. v. Procyon Biopharma Inc.*, 61 U.S.P.Q.2d 1542 (TTAB Nov. 26, 2001) (finding detailed information must be presented showing good cause to support request for extension). The Board should deny a request for an extension of time related to discovery when the requesting party is delayed in

serving discovery until right before the discovery deadline without showing good cause. *National Football League*, *NFL Properties LLC v. DNH Management, LLC*, 85 U.S.P.Q.2d 1852, *1 (TTAB Jan. 29, 2008) [hereinafter *NFL*].

Opposer has not shown good cause for its request for an extension of the trial dates. Here, Opposer failed to diligently work-up its case, despite having the burden to prove its claims. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1370, 63 U.S.P.Q.2d 1303 (Fed. Cir. 2002) ("The burden of proof rests with the opposer, and thus, it [falls] to [the opposer] to produce sufficient evidence to support the ultimate conclusion of likelihood of confusion."). Opposer filed its initial disclosures on December 8, 2017. Opposer did not produce any documents in its initial disclosures. Then, on March 16, 2018, Opposer's counsel reached out to Skinboss' counsel via email for the first time since serving it initial disclosures. Even then, Opposer did not serve discovery until April 9, 2018, nearly *seven months* after filing its Opposition, and *less than a month before* the discovery deadline. Opposer even failed to depose a representative of Skinboss during the discovery period. *See NFL*, 85 U.S.P.Q.2d 1852 at *1 (holding that a motion to extend trial dates should ordinarily be denied when, in part, the oppose fails to "depose its adversary during the prescribed discovery period"). Opposer offered no explanation for this lack of diligence and delay in serving discovery in its Motion, nor did Opposer attempt to produce evidence showing good cause for its requested extension of trial dates. Opposer has only provided a "mere unexplained delay in initiating action in an affected time period." *Procyon Pharmaceuticals, Inc.*, 61 U.S.P.Q.2d 1542 at *2.

Opposer's current need for the extension stems solely from its own lack of diligence and unreasonable delay in this case. That does not constitute "good cause." Thus, the Opposer's request for an extension of the trial dates should be denied.

V. CONCLUSION

For all the reasons stated herein, Skinboss respectfully requests the Board deny Opposer's Motion in its entirely and grant Skinboss any further relief the Board deems just and proper.

/s/ Matthew Warner-Blankenship
Matthew Warner-Blankenship
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Attorneys for GREEN HEART LABS, LLC

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposition To Opposer's Motion For Leave To Amend Notice Of Opposition has been served on Aleen Tomassian by forwarding said copy on May 14, 2018, via email to: Aleen Tomassian, a.tomassian@conklelaw.com.

Signature: /s/ Matthew Warner-Blankenship
Date: May 14, 2018

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

SKINBOSS, INC., Applicant, v. GREEN HEART LABS, LLC, Opposer.	Opposition No. 91236414 Serial No. 87129127 **EXHIBIT A** **DECLARATION IN SUPPORT OF APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

I, Matthew Warner-Blankenship, declare under the penalty of perjury as follows:

1. I Represent Skinboss, Inc. I make this Declaration in support of Applicant Skinboss, Inc.'s ("Skinboss") Opposition to Opposer's Motion for Leave to Amend Notice of Opposition.

2. On or about July 1, 2016, Skinboss approached me about filing a trademark application relating to their new business. After discussing 15 U.S.C. §1051(a) and 15 U.S.C. §1051(b) ("1(a)" and "1(b)") applications with Jason Caligiore, one of the co-owners of Skinboss, Skinboss elected to file a 1(a) application for SKINBOSS once their new website went live.

3. On August 5, 2016, I discussed the live website with Mr. Caligiore and I filed the application for SKINBOSS, without designating a class, for:

> *Online cosmetic sales and distribution; curated cosmetic sales; sales of cosmetics and beauty supplies online; cosmetic sales; sales of personal hygiene and care products; perfumes; perfumery products; essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, bath powders, beauty masks, body creams, body powders, cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, night creams, shower gels, skin clarifiers, skin soaps,*

suntanning preparations, moisturizers, make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair lotions; hair shampoos; retail stores for cosmetics and beauty and personal hygiene products.

4. On November 16, 2016, I received an email from the Examining Attorney, Ms. Tarah Hardy Ludlow, identifying goods/services that fall into two classes: international class 003 and international class 035. Ms. Ludlow also requested a new specimen at this time.

5. On November 22, 2016, I had a subsequent conversation with the Ms. Ludlow. During that conversation, Ms. Ludlow indicated that she had re-evaluated the specimen we submitted when we filed and had determined that it was acceptable to support both classes. Following a conversation with interlocutory attorney granting me permission to do so, I had a follow-up conversation about this with the Ms. Ludlow on May 10, 2018. During the May 10, 2018 conversation, Ms. Ludlow confirmed that her belief was that the specimen was acceptable in both classes 003 and 035.

6. After discussions with Mr. Caligiore informing him that the specimen was acceptable, we elected to pursue both classes. I was out of the office for the Thanksgiving holiday, but I emailed Ms. Ludlow confirmation of this discussion on November 23, 2016 and submitted payment for the second class via a TEAS online filing, electing to draw from our firm's deposit account. I was unaware at the time that several patent fees were drawn from the deposit account at that time and there were insufficient fees in the account to cover the additional class fee. Ms. Ludlow informed me of the insufficiency via email that same day.

7. Following delays due to the holidays, I had further discussions with Mr. Caligiore about the sale of goods labeled "SKINBOSS," and I followed up with Ms. Ludlow on November 29, 2016 by email about amending the SKINBOSS application. *See* Exhibit 1.

8. On November 30, 2016, several events occurred. Ms. Ludlow issued a priority action at approximately 2PM Eastern Time. The action indicated that insufficient fees were paid. I am unaware of when the fees were eventually drawn from our firm's deposit account.

9. I also spoke with Ms. Ludlow on November 30, 2016, to address the fee issue and the class 003 goods. At that time, it was my belief that we would be paying the fees *and* converting the class 003 goods to 1(b).

10. In our conversation of May 10, 2018, Ms. Ludlow informed me that given the amount of time that had passed, she had no direct recollection of our discussion of November 30, 2016, but she indicated that I would have to make such a change via an electronic filing. My recollection of the events at this time are that I assumed that we were going to be proceeding with a 1(b) filing basis for class 003 and a 1(a) filing basis for class 035.

11. On or about March 3, 2017, we were contacted by Travis Wilson, initial counsel for Green Heart Labs.

12. In investigating our client's application in response to Mr. Wilson's letter, I discovered that no change had been made to the filing basis of class 1(b). I emailed Ms. Ludlow on March 17, 2017 to confirm that was in fact the case. *See* Exhibit 2.

13. The application published for opposition on March 21, 2017. I do not have any recollection of any conversations with Ms. Ludlow between March 17 and March 21, 2017.

14. Subsequently, on or about April 12, 2017, I corresponded with Kathryn Coward at the USPTO in an attempt to pull back and divide the application. *See* Exhibit 3. This attempt was ultimately unsuccessful.

Date: May 14, 2018

Signed /s/ M. Warner-Blankenship
M. Warner-Blankenship

Copies to:

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Attorneys for GREEN HEART LABS, LLC

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing Declaration In Support of Applicant's Opposition To Opposer's Motion For Leave To Amend Notice Of Opposition has been served on Aleen Tomassian by forwarding said copy on May 14, 2018, via email to: Aleen Tomassian, a.tomassian@conklelaw.com.

Signature: /s/ Matthew Warner-Blankenship
Date: May 14, 2018

Warner-Blankenship, Matt

From: Warner-Blankenship, Matt
Sent: Tuesday, November 29, 2016 6:08 PM
To: Hardy, Tarah
Subject: RE: U.S. Trademark App. No. 87129127 - Informal Inquiry

Tarah:

My apologies for coming back to this, but am I able to make a further amendment to the description for one of the classes in this matter? I appreciate any assistance you can provide.

Thanks,
Matt

From: Hardy, Tarah [mailto:Tarah.Hardy@USPTO.GOV]
Sent: Wednesday, November 23, 2016 11:58 AM
To: Warner-Blankenship, Matt
Subject: RE: U.S. Trademark App. No. 87129127 - Informal Inquiry

I can withdraw from your deposit account. I'll go ahead and issue the amendment.

From: Warner-Blankenship, Matt [mailto:MattWarner-Blankenship@davisbrownlaw.com]
Sent: Wednesday, November 23, 2016 12:31 PM
To: Hardy, Tarah <Tarah.Hardy@USPTO.GOV>
Cc: Kenin, Angie D. <angiekenin@davisbrownlaw.com>
Subject: RE: U.S. Trademark App. No. 87129127 - Informal Inquiry

Thanks again, Tarah. We will proceed with both classes and the descriptions that you have provided. Should I submit payment directly, or can you draw it from our deposit account (122250)?

Best,
- Matt

DAVISBROWN
Matthew Warner-Blankenship | Patent Attorney | 515-246-7805 | www.DavisBrownLaw.com
The Davis Brown Tower | 215 10th Street, Suite 1300 | Des Moines, Iowa 50309 | Fax: 515-243-0654

From: Hardy, Tarah [mailto:Tarah.Hardy@USPTO.GOV]
Sent: Wednesday, November 16, 2016 3:19 PM
To: Warner-Blankenship, Matt
Subject: U.S. Trademark App. No. 87129127 - Informal Inquiry

Hello,

I am currently reviewing the trademark application for the mark SKINBOSS. No conflicting marks were found. However, before the mark can proceed to publication a few items need to be addressed. First you have identified goods/services that fall into two classes. You may limit to one class or pay an additional $275 for the extra class. Please also note that the term sales is considered indefinite and will need to be clarified. I suggest the following if accurate:

Exhibit 1

Perfumes; perfumery; essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, bath powders, beauty masks, body creams, body powders, cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, night creams, shower gels, skin clarifiers, skin soaps, suntanning preparations, moisturizers; make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair lotions; hair shampoos, in International Class 3.

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, in International Class 35.

Please note that if you wish to proceed with Class 3 a better specimen will need to be provided. I can make the changes to the ID through examiner's amendment and also add the fee with an email authorization. If you wish to add Class 3 you can provide the specimen through our online response form. Promptly let me know what you'd like done.

Sincerely,

Tarah Hardy Ludlow
Trademark Attorney
USPTO - Law Office 110
571-272-9361
571-273-9110 (fax)

Warner-Blankenship, Matt

From: Warner-Blankenship, Matt
Sent: Friday, March 17, 2017 1:31 PM
To: Tarah.Hardy@USPTO.GOV
Cc: Kenin, Angie D.
Subject: U.S. Trademark App. No. 87129127 - SKINBOSS

Tarah:

Are you available sometime this afternoon to discuss the above matter briefly?

I'd like to make sure that the amendment to class 3 is effectuated and the fees are properly paid.

Thanks,
Matt

Matthew Warner-Blankenship
Patent Attorney | Davis Brown Law Firm | 515-246-7805
mwb@davisbrownlaw.com | www.DavisBrownLaw.com

Exhibit 2

Warner-Blankenship, Matt

From: evm3@davisbrownlaw.com
Sent: Wednesday, April 12, 2017 12:13 PM
To: Warner-Blankenship, Matt
Subject: Voice Message from 15712729468 ("15712729468") on 4/12/17 12:10 PM for 7805
Attachments: 041217-121012-7805-605-1.wav

Mutare

Voice Message from 15712729468 ("15712729468") on 4/12/17 12:10 PM (57 second msg)

MESSAGE:

"Hi good afternoon this is Catherine Coward United States patent and trademark office calling in reference to skin boss 87129127. I'm attempting to pull this application back. So far I have been unsuccessful. If I cannot pull it back it will go to registration. We have one more means that we're going to use to try and pull it back but I have no idea whether it will be successful and I'm gonna step away from my desk for several hours so I won't be able to get back to you today I might be able to touch bases with you tomorrow and let you know if we were successful but there's a very good chance that we may not be able to pull this one back but I will let you know as soon as I know for absolute sure but I did want to give you that information before I left for the day. Again Catherine Coward United States patent and trademark office. My direct line 571-272-9468. Thank you. Goodbye."

Read
Click to read the transcription of your voice message.

Mark
Mark this message read in your voice mailbox.

Exhibit 3

Contacts
View or update your EVM contacts.

Update
Update your EVM settings.

Delete
Delete this message from your voice mailbox.

Delete All
Delete all messages from your voice mailbox.

There are 422 new and 1 old messages in your mailbox.

CERTIFICATE OF FILING

I hereby certify that this Applicant's Opposition To Opposer's Motion For Leave To Amend Notice Of Opposition is being filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: May 14, 2018 /s/Matthew Warner-Blankenship