

ESTTA Tracking number: **ESTTA973278**

Filing date: **05/13/2019**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Remus Repta		
Entity	Individual	Citizenship	UNITED STATES
Address	15205 N. Kierland Blvd, Suite 200 Scottsdale, AZ 85254 UNITED STATES		

Attorney information	Michelle H. Swann Radix Law, PLC. 15205 N. Kierland Blvd, Suite 200 Scottsdale, AZ 85254 UNITED STATES reid@radixlaw.com, swann@radixlaw.com 6026069323		
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Applicant Information

Application No	88197995	Publication date	04/30/2019
Opposition Filing Date	05/13/2019	Opposition Period Ends	05/30/2019
Applicant	Pablo Prichard Suite 1003 9250 North 3rd Street SCOTTSDALE, AZ 85020 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 2005/09/30 First Use In Commerce: 2005/09/30 All goods and services in the class are opposed, namely: Plastic surgery services; Cosmetic surgery services; Reconstructive surgery services; Trauma Surgery Services; Migrainesurgery services; Providing a website featuring information about a holistic cosmetic and plastic surgery practice
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Grounds for Opposition

The mark is generic	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1

Attachments	Notice of Opposition.pdf(51107 bytes)
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Signature	/s/ Michelle H. Swann
Name	Michelle H. Swann
Date	05/13/2019

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

In the Matter of Application Serial No. 88197995

Applicant: AAA Plastic Surgery
Filed: November 17, 2018
Published: April 30, 2019

Remus Repta,

Opposer,

v.

Pablo Prichard

Applicant.

NOTICE OF OPPOSITION

Opposer Remus Repta is an Arizona individual and business partner of Applicant Pablo Prichard. Dr. Repta and Dr. Prichard have been engaged in litigation for almost one year regarding various business disputes, including administration of a website (@aaaplasticsurgery.com) that the doctors used since 2008 to advertise their medical practice. Applicant seeks to register “AAA Plastic Surgery” as a trademark in order to deprive Dr. Repta of the value of the domain name that he owns --

@aaaplasticsurgery.com. Dr. Repta will be damaged by registration of the above-identified mark (“AAA Plastic Surgery”), Serial No. 88197995 in International Class 4 for the goods and services set forth in Applicant’s application filed on November 17, 2018, published in the *Official Gazette* on April 30, 2019, to the extent Dr. Prichard intends to use the AAA Plastic Surgery trademark to rest control of the

@aaaplasticsurgery.com domain name from Dr. Repta, which is currently the subject of pending litigation, Prichard et al. v. Repta et al., Maricopa County Superior Court, CV2018-056062. Dr. Repta therefore opposes the application on the following grounds:

1. Remus Repta is a plastic surgeon living in Arizona and has been business partners with Applicant Pablo Prichard, a plastic surgeon living in Arizona, since 2008. Currently, they own no fewer than five active and inactive companies together, and have been engaged in a business divorce over the active entities since June 2018.
2. Applicant Pablo Prichard is an Arizona resident.
3. Applicant filed a trademark application for the “AAA Plastic Surgery” and identified himself as the owner. Subsequently, the application was amended to make clear that Dr. Prichard does not seek the exclusive right to use “plastic surgery.”
4. Dr. Prichard is not the exclusive user of “AAA Plastic Surgery”; if anyone is the user of “AAA Plastic Surgery” it is a limited liability company owned by Dr. Repta and Dr. Prichard, Advanced Plastic Reconstruction, PLLC (“APR”).
5. Dr. Repta purchased the aaaplasticsurgery.com domain name in 2008 in order to advertise his medical practice with Dr. Prichard. That medical practice used the name “Advanced Aesthetic Associates,” and that medical practice was financially supported through APR. Dr. Prichard has applied for a trademark for “Advanced Aesthetic Associates,” but Dr. Repta does not object to that application.
6. Dr. Prichard has admitted that Dr. Repta, alone, is the owner of the aaaplasticsurgery.com domain name.
7. Historically APR paid for the design and maintenance of their (former) medical group’s marketing at the aaaplasticsurgery.com website. The doctors’

joint entity, APR, paid for the costs of designing the group website as well as any content changes until 2015, when active management of the website terminated.

8. Since 2008, the aaoplastisurgery.com website was used to advertise primarily three doctors – Dr. Prichard, Dr. Repta, and another doctor – and the practice group they referred to as “Advanced Aesthetic Associates.”

9. In September 2018, Dr. Prichard filed a (second) lawsuit against Dr. Repta relating to Dr. Repta’s continued use of the aaoplasticsurgery.com domain name. Dr. Prichard sought a preliminary injunction to force Dr. Repta to turn the control of the domain name over to Dr. Prichard. On April 30, 2019, the Maricopa County Superior Court denied that request.

10. Dr. Prichard’s November 17, 2018 trademark application for the “AAA Plastic Surgery” word mark attaches specimens that purport to show his “use” of the “AAA Plastic Surgery”. Those specimens are: (1) a photograph of a sign posted the doctors’ ambulatory surgery center; (2) a logo drawing for “Advanced Aesthetic Associates” (the “Logo Drawing”) that includes the aaoplasticsurgery.com domain name; (3) a shopping bag that includes the Logo Drawing and aaoplasticsurgery.com domain name; (4) a brochure that includes the Logo Drawing and aaoplasticsurgery.com domain name; (5) a business card that identifies, in generic typeface, “Advance Aesthetic Associates” and the aaoplasticsurgery.com domain name. The specimens do not show that Dr. Prichard exclusively, used “AAA Plastic Surgery” to advertise his practice group apart from Dr. Repta’s aaoplasticsurgery.com domain name.

11. One of Dr. Prichard’s exemplars of “AAA Plastic Surgery” is a sign posted on the doctors’ co-owned building. Dr. Prichard did not purchase that sign, was not the exclusive user of the sign (which was used to advertise the doctors’ practice group, not just Dr. Prichard), and is not the owner of the sign.

12. The other exemplars of the use of “AAA Plastic Surgery” rely on the aaaplasticsurgery.com domain name.

13. A trademark identifies the particular source of goods or services; it is a brand. In order to identify a particular source, a trademark must be more a generic name for the good or service.

14. The PTO Trademark Manual of Examination Procedure states:

1215.02(a) Use Applications.

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark, as depicted on the specimen, must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name addressed used to access a website. See *In re Roberts*, 87 USPQ2d 1474, 1479 (TTAB 2008) (finding that *irestmymcase* did not function as a mark for legal services, where it is used only as part of an address by means of which one may reach applicant’s website, or along with applicant’s other contact information on letterhead); *In re Eilberg*, 49 USPQ2d 1955, 1957 (TTAB 1998).

...

If the proposed mark is used in a way that would be perceived as nothing more than an Internet address where the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

15. Further, the Manual states:

1215.02(b) Advertising One’s Own Products or Services on the Internet is not a Service.

Advertising one’s own products or services is not a "service" under the Trademark Act. *In re Reichhold Chems., Inc.*, 167 USPQ 376 (TTAB 1970). See TMEP §§1301.01(a)(ii) and 1301.01(b)(i). Therefore, businesses that create a website for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimen of use makes it clear that the website merely advertises the applicant’s own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the

meaning of the Trademark Act. The statutory basis for the refusal is Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127.

16. Dr. Prichard has not demonstrated that the “AAA Plastic Surgery” trademark has been used other than as an information indication of the aaaplasticsurgery.com domain name.

17. Registration of Applicant’s mark would cause damage to Opposer within the meaning of 15 U.S.C. § 1063(a).

WHEREFORE, Opposer requests that the registration sought by Applicant be refused, that this Notice of Opposition be sustained, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

DATED: May 13, 2019

Respectfully submitted,

By: /s/ Michelle H. Swann
Michelle H. Swann

Attorneys for Opposer Remus Repta

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on counsel for Application, this 13th date of May, 2019, by sending same via First Class Mail, postage prepaid, to:

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By: /s/ Michelle H. Swann
Michelle H. Swann