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

Proceeding	91248129
Party	Defendant Pablo Prichard
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Attachments	2019.06.21 Motion to Dismiss Exhibits A and B.pdf(285316 bytes) 2019.06.21 Prichard Motion to Dismiss final.pdf(623306 bytes)

Exhibit A

SUPERIOR COURT OF ARIZONA
MARICOPA COUNTY

CV 2018-009323

04/23/2019

HONORABLE DANIEL G. MARTIN

CLERK OF THE COURT

J. Eaton

Deputy

PABLO PRICHARD

VICTORIA E AMES

v.

REMUS REPTA, et al.

MICHELLE HIBBERT SWANN

JUDGE DANIEL MARTIN

UNDER ADVISEMENT RULING

Pending before the Court is Plaintiffs Pablo Prichard, M.D. and Advanced Aesthetic Associates, PLLC's ("AAA") (collectively "Plaintiffs") Application for: (1) Temporary Restraining Order with Notice; and (2) Order to Show Cause Why Preliminary Injunction Should Not Be Issued, filed on September 28, 2018 under CV2018-056062 ("Application").¹ On February 1, 2019, the Court held an evidentiary hearing on the Application. The parties submitted closing memoranda on February 22, 2019. Also on February 22, 2019, Plaintiffs filed an Objection to Defendants' Post Hearing Brief. On March 19, 2019, Plaintiffs filed a Supplement to Plaintiffs' Post Hearing Brief. On March 20, 2019, Defendants filed a Response to Plaintiffs' Supplement to Their Posthearing Brief. Having considered the evidence presented and the arguments of counsel, the Court enters its ruling denying the Application.

FACTUAL AND PROCEDURAL HISTORY

The Court incorporates herein the factual and procedural history set forth in its December 13, 2018 Ruling (filed December 17, 2018) as to Plaintiff Pablo Prichard, M.D.'s June 25, 2018 Application for Mandatory Injunction With Notice. In their current application, Plaintiffs seek relief as to certain intellectual property. Specifically, Plaintiffs request the issuance of a

¹ By Order dated October 9, 2018, CV2018-056062 was consolidated into CV2018-009323.
Docket Code 926

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preliminary injunction enjoining Defendants Arizona Aesthetic Associates, LLC (“AzAA”), Remus Repta, M.D., and Lewis Andres, M.D. (collectively “Defendants”)

from (1) using the aaaplasticsurgery.com domain name for Arizona Aesthetic and the remaining Defendants’ cosmetic and reconstructive medical practice business purposes, (2) redirecting, discontinuing, replacing, disabling, or otherwise interfering with aaaplasticsurgery.com email addresses that are used by Plaintiffs and their staff and (3) using the tradename “AAA Plastic Surgery,” which is the property of AAA, for the benefit of Defendants and their business interests. Defendants should further be ordered to restore the AAA website content to the aaaplasticsurgery.com website as it existed prior to Defendants’ removing the AAA content and replacing it with Arizona Aesthetic content in August 2018.

Application, at 2.

DISCUSSION

The criteria for granting preliminary injunctive relief are: “(1) a strong likelihood of success on the merits, (2) the possibility of irreparable injury if the requested relief is not granted, (3) a balance of hardships favoring that party, and (4) public policy favoring a grant of the injunction.” *Ariz. Ass’n of Providers for Persons with Disabilities v. State*, 223 Ariz. 6, 12, ¶12, 219 P.3d 216, 222 (Ct. App. 2009) (citing *Shoen v. Shoen*, 167 Ariz. 58, 63, 804 P.2d 787, 792 (Ct. App. 1990)). The Court will assess each factor in turn.

Strong Likelihood of Success on the Merits

As to use of the aaaplasticsurgery.com domain name, this factor favors Defendants. The weight of the evidence presented at hearing demonstrated that Dr. Prichard began using the name AAA Plastic Surgery in or about 2005, well before Dr. Repta’s relocation to Phoenix and the commencement of Dr. Prichard’s and Dr. Repta’s joint ventures. However, the aaaplasticsurgery.com domain was not purchased until after Dr. Repta relocated to Phoenix and began practicing with Dr. Prichard. Plaintiffs acknowledge that Dr. Repta personally purchased the aaaplasticsurgery.com domain, but contend that Dr. Repta did so for the benefit of Dr. Prichard individually as well as Dr. Prichard’s company, AAA. In contrast, Dr. Repta asserts that he purchased the domain name for the benefit of Advanced Plastic Reconstruction, PLLC (“APR”), an entity jointly owned by Drs. Prichard and Repta and used as a clearinghouse for the payment of business expenses (including the salaries of other physicians with whom they associated, such as Dr. Andres).

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On the present record, the Court agrees with Plaintiffs that there is evidence to support their claim to ownership and control of the aaaplasticsurgery.com domain. However, the applicable standard on a request for injunctive relief is whether the moving party has demonstrated a *strong* likelihood of success on the merits, and here Plaintiffs have not met that burden.

As to the aaaplasticsurgery.com email addresses that are used by Plaintiffs and their staff, this factor favors Plaintiffs. The weight of the evidence presented at hearing (including the testimony of Jadie Peck and Randy Kates) demonstrated that in or about August 2018, Dr. Repta and/or others acting at his direction caused a disruption in the distribution of emails to individuals using the @aaaplasticsurgery.com domain. The evidence also demonstrated that the system was subsequently restored, though according to Ms. Peck, it remains “glitchy”. Further, it appears that Dr. Prichard’s employees are transitioning away from using the @aaaplasticsurgery.com domain to using the @drprichard.com domain. Nonetheless, as to this claim, Plaintiffs have met their burden to show a strong likelihood of success.

As to Plaintiffs’ claims to protectable interests in the tradename “AAA Plastic Surgery” (and associated marks), this factor favors Defendants. The present record is factually insufficient for the Court to make a determination as to Plaintiffs’ requested relief, particularly in view of the fact that Plaintiffs’ recent application for trademark protection remains pending before the United States Patent and Trademark Office.

Irreparable Injury

As to use of the aaaplasticsurgery.com domain name, this factor favors Defendants. The evidence demonstrated that after the dispute arose between Drs. Prichard and Repta that gave rise to this litigation, Dr. Repta removed the content from the website at aaaplasticsurgery.com and uploaded new content that promoted AzAA, Dr. Repta, and Dr. Andres. On September 7, 2018, Dr. Prichard demanded that Dr. Repta turn over control of the aaaplasticsurgery.com domain to Dr. Prichard. Dr. Repta declined. Shortly thereafter, however, Dr. Repta removed the AzAA content and showed the site as “under construction”. The site has since been partially restored to its original iteration, and in that condition promotes the services of Drs. Prichard, Repta, and Andres (a somewhat unusual circumstance in view of the current litigation among the parties).

Dr. Prichard contends that because the aaaplasticsurgery.com website belongs to AAA (a contested fact), Dr. Repta should not be able to exercise any control over it, nor should Dr. Repta or Dr. Andres be permitted to post their practice information on the site. For his part, Dr. Andres does not object to his profile information being removed from the site.

The Court’s irreparable injury analysis as to the aaaplasticsurgery.com website is informed, in part, by the fact that Dr. Prichard maintains a separate website at drprichard.com, and there is very little evidence in the record as to the extent to which Dr. Prichard relies on traffic from the

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aaaplasticsurgery.com website. More importantly, however, the present record does not support Plaintiffs' claims that Dr. Repta's actions (and by extension the actions of the remaining defendants) as to the aaaplasticsurgery.com website "are damaging Plaintiffs' reputation; interfering with Plaintiffs' medical practice; interfering with communicating with patients, vendors, staff and the public; and misdirecting and misleading the public." Plaintiffs' Memorandum, at 9. These claims, as well as concerns raised under the Health Insurance Portability and Accountability Act of 1996 ("HIPAA"), are too speculative to support a present conclusion of irreparable injury.

As to the @aaaplasticsurgery.com email addresses that are used by Plaintiffs and their staff, this factor favors Defendants. As set forth above, the disruption to the email system caused by Dr. Repta created hardship; however, such hardship did not rise to the level of irreparable injury.

As to use of the tradename "AAA Plastic Surgery," this factor favors Defendants. Absent a showing of a strong likelihood of success on the merits as to this claim, Plaintiffs also fail to demonstrate irreparable injury.

Balance of Hardships

As to use of the @aaaplasticsurgery.com domain name, this factor favors neither Plaintiffs nor Defendants. As set forth above, Drs. Prichard and Repta acquired this domain after Dr. Repta relocated to Phoenix and began practicing with Dr. Prichard, and the question of ownership and control of the domain remains a contested fact. Further, the extent to which the aaaplasticsurgery.com website presently generates traffic to the physicians' individual websites remains unclear.

As to the @aaaplasticsurgery.com email addresses that are used by Plaintiffs and their staff, this factor slightly favors Plaintiffs. But, in view of the fact that Dr. Prichard's staff appear not to be making use of those email addresses (instead using @drprichard.com), the hardship is deemed marginal.

As to use of the tradename "AAA Plastic Surgery," this factor slightly favors Plaintiffs for the sole reason that Dr. Prichard had begun using this name prior to Dr. Repta's arrival in Phoenix. However, pending a determination that Plaintiffs in fact have a protectable interest in that name (and any associated marks), the Court is unable to conclude that the balance of hardships tips strongly in Plaintiffs' favor.

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Public Policy

Plaintiffs' Application implicates two issues of public policy: patient privacy and intellectual property rights. However, the evidence of record is insufficient to support a finding that either policy matter supports the issuance of the requested injunctive relief.

CONCLUSION

Having considered all of the evidence and the relevant factors, the Court concludes that Plaintiffs have failed to meet their burden as to any of the matters on which they have sought injunctive relief, and accordingly that the Application should be denied. However, some guidance is appropriate for the disposition of the aaoplasticsurgery.com website, and the Court provides that guidance below.

ORDERS

IT IS ORDERED denying the Application.

As to the aaoplasticsurgery.com website,

IT IS ORDERED that not later than May 15, 2019, Dr. Prichard shall, in writing to counsel for Defendants, elect one of the following temporary measures to remain in place pending the resolution of this matter (or further order of the Court upon stipulation of the parties): (1) revision of the aaoplasticsurgery.com content to provide three links: (a) one that directs visitors to drprichard.com, (b) one that directs visitors to drrepta.com, and (c) one that directs visitors to albertandresmd.com; or (2) allow Dr. Repta to "park" the aaoplasticsurgery.com website. In the event Dr. Prichard elects option (1), Drs. Prichard, Repta, and Andres shall share equally in the costs associated with revising and maintaining the website.

/s/ Daniel G. Martin

HON. DANIEL G. MARTIN
JUDGE OF THE SUPERIOR COURT

Exhibit B

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N THE SUPERIOR COURT OF THE STATE OF ARIZONA
IN AND FOR THE COUNTY OF MARICOPA

PABLO PRICHARD,)
)
Plaintiff,) CASE NO. 2018-092376
)
v.)
)
REMUS REPTA, et al.,)
)
Defendants.)
_____)

Maricopa County Superior Court
Phoenix, Arizona
February 2, 2019
2:08 p.m.

BEFORE THE HONORABLE DANIEL G. MARTIN
SUPERIOR COURT JUDGE

TRANSCRIPT: APPLICATION FOR PRELIMINARY INJUNCTION

Transcript prepared by:
VERBATIM REPORTING & TRANSCRIPTION, LLC

1 Q And you know why we are here?

2 A Yes.

3 Q And you own a business of medical practice; is
4 that right?

5 A That's correct.

6 Q What is the name of that?

7 A Advanced Aesthetic Associates.

8 Q When did you start that business?

9 A 2005.

10 Q Did you -- when you started that business, was
11 it your own practice?

12 A That's correct.

13 Q Has anybody ever been in practice with you?

14 A No, nobody else has owned that practice. No.

15 Q And what kind of a practice is that?

16 A It's a plastic surgeon reconstructive surgery
17 practice.

18 Q And have you consistently practiced plastic
19 surgery under the name Advanced Aesthetics Associates
20 since you started in 2005?

21 A Yes.

22 Q When you started in 2005, did you also develop
23 marketing materials for your practice?

24 A I did, yes.

25 Q And have you used those marketing materials

1 consistently since that time?

2 A Yes.

3 Q Okay. Do you have a logo for your practice?

4 A Yes.

5 Q Let me show you what has been marked as Exhibit
6 27.

7 MS. AMES: Your Honor, if I may approach.

8 THE COURT: You may. It's your witness,
9 you are free to approach.

10 MS. AMES: Thank you.

11 BY MS. AMES:

12 Q Let me show you what has been marked as Exhibit
13 27. Do you recognize that?

14 A Yes, I do.

15 Q What is it?

16 A It is my logo followed by my practice.

17 Q Your practice name?

18 A My practice name it looks like.

19 Q And when did you start using your logo?

20 A Started using this logo in 2005, when I designed
21 it with a designer.

22 Q And have you used that consistently since 2005?

23 A Yes.

24 Q And have you always paired that with the name
25 Advanced Aesthetic Associates?

1 A Yes, the 99 percent of the time. Every once in
2 a while, I will use just the logo as kind of a pice of
3 art, 99 percent of the time it's paired with the name.

4 Q Has anybody else used that logo?

5 A Yes. I have allowed some other physicians to
6 use that logo.

7 Q Okay. And we will talk about that in a few
8 minutes.

9 Did you pay for the design of that logo?

10 A Yes.

11 Q Did anybody else contribute to that?

12 A No.

13 Q Have you ever used that logo with anything other
14 than your practice?

15 A I don't believe so.

16 Q Okay. Let me show you what has been marked
17 Exhibit 79. It's a few pages, so if you want to take a
18 look at that. Do you recognize Exhibit 79?

19 A Yes, ma'am, it's my card.

20 Q So this appears to be a business card that says
21 Advanced Aesthetic Associates on it. Do you see that?

22 A That's correct.

23 Q Do you know when this card was created?

24 A This particular iteration, looks like it's 2007,
25 according to this date.

1 Q Okay.

2 A At least that's when it went to the printers.

3 Q Okay. And you see your logo on there in the
4 corner, is that the same --

5 A Yes.

6 Q -- logo you looked at a minute ago?

7 A Yes, as well as the watermark background.

8 Q And it says Advanced Aesthetic Associates. Do
9 you see that?

10 A Yes.

11 Q And do you see that Advanced Aesthetic
12 Associates is stacked?

13 A Yes. That was on purpose, specifically because
14 I used the name AAA Plastic Surgery.

15 Q And at this time, in 2007, you were -- where was
16 your practice located?

17 A At this time it was in 9327 North Third Street,
18 Suite 200.

19 Q In Phoenix?

20 A Yes.

21 Q And did you have any other doctors working with
22 you at that time?

23 A No. I was in an office of another doctor, a
24 family practitioner, and it was an office-share.

25 Q You were sharing the office? You didn't have a

1 joint practice?

2 A No, that's correct.

3 Q There is a phone number on here, 480Plasurg. Do
4 you see that?

5 A Yes.

6 Q What is that?

7 A That's my phone number that -- it has to do with
8 my name a long time ago when I first decided to use AAA
9 Plastic Surgery, I wanted Plasurg as my phone number and I
10 spent a long time trying to obtain that phone number.

11 Q Why Plasurg?

12 A Because it's part of my name.

13 Q Which name?

14 A AAA Plastic Surgery.

15 Q Let me ask you how you -- you refer to your
16 practice as AAA Plastic Surgery. Tell me about how you
17 arrived at that.

18 A So back when I was in Michigan before I even
19 came down to Phoenix, I had the idea of wanting to have a
20 first name in any kind directory that would be
21 alphabetized and so I was trying to think of a lot of
22 different words. And none of the words would be first in
23 the directory and so I thought of AAA, three A's in a row
24 would be first. Some I thought of AAA Plastic Surgery,
25 but I didn't want to make it sound super generic.

1 So I actually reverse engineered the name,
2 Advanced Aesthetic Associates, just because those words
3 fit AAA and so I never really specifically chose Advanced
4 Aesthetic Associates, it's big of a big, huge mouthful and
5 kind of not a really fantastic name, but it fits my whole
6 idea of AAA.

7 Q Have you -- but you have always used Advanced
8 Aesthetic Associates as your name?

9 A Yes.

10 Q And you have always practiced under that name?

11 A That's correct.

12 Q And I believe you also referred to yourself as
13 AAA Plastic Surgery; is that right?

14 A Correct.

15 Q Have you done that consistently?

16 A Yes.

17 Q When did you start doing that?

18 A In 2005.

19 Q Okay. Let's look at -- if you take a look at --
20 it's four pages back, it's Bates Number at the bottom is
21 Repta003865. Do you see that?

22 A 3865?

23 Q 3865. It's a g-mail.

24 A Yes.

25 Q Appears to be to Advanced Aesthetic

1 consistently since that time?

2 A Yes.

3 Q And you also see the phone number 480Plasurg?

4 A Yes.

5 Q Have you used that consistently since that time?

6 A Yes.

7 Q And the Plasurg is the AAA Plastic Surgery?

8 A Yes.

9 Q I want to talk to you a little bit about your
10 use of the AAA Plastic Surgery prior to July 2008. Let me
11 just put a timeframe on this.

12 Do you remember when Dr. Repta came to Phoenix?

13 A It was about July of 2008.

14 Q Okay. So I want to talk to you a little bit
15 about your practice and your use of your name and AAA
16 Plastic Surgery and Advanced Aesthetic Associates prior to
17 his arriving here in Phoenix.

18 A Uh-huh.

19 Q You told us why you used -- why you decided to
20 use AAA or why you decided back in 2005 to use AAA,
21 Advanced Aesthetic Associates. And we have -- we have a
22 few examples of your using AAA early on, and I want to ask
23 you about them.

24 Let me ask you to take a look at Exhibit 3. Do
25 you know what that is?

1 A Yes. It's a letter between myself and John C.
2 Lincoln Hospital.

3 Q Okay. And this is to Cathy Lindstrom (ph) at
4 John C. Lincoln?

5 A Yes.

6 Q Who is Cathy at John C. Lincoln?

7 A She was the vice-president for ancillary
8 services, I think ancillary services. Something like
9 that.

10 Q So the subject line on this is: AAA Collections
11 at JCL. Do you see that?

12 A Yes.

13 Q Why -- what is this all about?

14 A Well, at this point in time, I was -- based on
15 my reputation at the hospital, I was -- I tried to get the
16 hospital to -- I was trying to sponsor Remus to come to
17 Phoenix and get him basically free money, \$400,000 of --
18 of money just for -- for me negotiating that with the
19 hospital.

20 Q Okay. This particular e-mail seems to be,
21 however -- and I think we will get to that in a minute.

22 But this particular e-mail seems to be the
23 beginning of a chain where you are talking about AAA
24 Collections. Do you see that?

25 A Yes.

1 Q And then if I -- if you flip to the third page,
2 which is Prichard 002866, you can see the collection
3 document attached. It's dated February 2008. Do you see
4 that?

5 A Yes.

6 Q And it says Advanced Aesthetic Associates?

7 A Yes.

8 Q Is that right?

9 A Uh-huh.

10 Q And that's -- is that what you mean by AAA?

11 A Yes.

12 Q Did John C. Lincoln know your practice as AAA?

13 A Yes.

14 Q Take a look at Exhibit 4. Now, Exhibit Number
15 4, do you recognize this?

16 A Yes.

17 Q It seems to me to be an e-mail from Dr. Repta to
18 you dated March 31, 2008; is that right?

19 A Yes.

20 Q Okay. Now, Dr. Repta hadn't arrived in Phoenix
21 yet at this point, had he?

22 A No.

23 Q Had he even finished his residency?

24 A No. Well, I think he may have been in a
25 fellowship.

1 Q I'm sorry, he what?

2 A I think he was still -- still training.

3 Q Okay. And it appears to me -- and correct me if
4 I'm wrong -- that there's an attachment to this because
5 there's a proposal for a website from -- not Interactive,
6 if you flip back three pages, do you see that?

7 A Yes.

8 Q What is this proposal all about?

9 A Well, I asked him to help me out with building a
10 website. And so I asked him to reach out to a couple
11 different designers to get proposals for a website.

12 Q So if you look at 2869, which is three pages
13 back, the proposal is actually addressed to
14 (indiscernible). Do you see that?

15 A Yes.

16 Q But it appears to be a proposal for a website to
17 you had input into because -- well, I will take that back.

18 Let's look at -- let me ask you to look at page
19 2876 of that same proposal. Now, again, at this point, in
20 March 2008, you had already been practicing as Advanced
21 Aesthetic Associates for about three years; is that right?

22 A That's correct.

23 Q And you had already decided on the AAA Plastic
24 Surgery name as an alternative name --

25 A Yes.

1 Q -- for your practice?

2 And you had already shared that information with
3 Dr. Repta; is that right?

4 A Oh, we had numerous conversations about it when
5 I was still in Michigan before I even came down here.

6 Q So let's look at 2876 -- Prichard 2876. And
7 down under Bullet Point 15, do you see that? Conduct
8 essentially post-launch promotion?

9 A Yes.

10 Q And then there's a Point A and then a Point B.
11 And then right under Point B, there is a sentence is that
12 starts with: This site will be constructed according to
13 the site map referenced in the attached document titled
14 AAA Site Map. Do you see that?

15 A Yes.

16 Q Why do you think that Etna -- why, if you know,
17 why was Etna referring to the proposed website as AAA --
18 as an AAA site map for that website?

19 A Because that's what I was calling it.

20 Q Had you spoken with anyone at Etna?

21 A No.

22 Q Is --

23 A Not at that time.

24 Q Had you spoken with Dr. Repta about what you had
25 wanted for your web site?

1 What would the problem be if the website was
2 parked?

3 A Then people, number one, would think that
4 something's going on with my practice, why would my
5 website be parked. Are they having problems, that that
6 looks like something is in chaos there.

7 Q What if the website just said, Click here on
8 left for Dr. Prichard, click here on right for Dr. Repta?
9 What's the problem with that?

10 A Dr. Repta is no longer associated with -- I have
11 no longer given him permission to associate his name with
12 my practice, so that would be a problem with that.

13 Q Well, he personally bought the
14 AAAPlasticSurgery.com domain, didn't he?

15 A On my behalf, yes.

16 Q And he continues to pay for it to this day;
17 isn't that right?

18 A I'm happy to refund him the 12.95 that he pays
19 for the website every year.

20 Q And the content was designed using money from
21 APR, your joint company; isn't that true?

22 A So, when he came into town and had no contacts
23 of his own, I let him associate with my name, gave him
24 permission to use my name and be in my office and for
25 that, there was a fee involved. And he was developing

1 this website while he was living for free at my house,
2 rent-free, utilities-free, and I asked him to help me out
3 in this way. And he did. But -- but, no, no way did it
4 confer any kind of ownership from that.

5 Q That's what this is all about, isn't it? He was
6 a few years behind you in school and you feel like you
7 helped him grow his practice and now you are mad at him?

8 A No. I -- if he goes his own way and stops
9 interfering with my practice, I'm totally good. It's the
10 interference with my pass-through that I'm mad about.

11 Q Why not change AdvancedAestheticAssociates.com
12 to a website that you want?

13 A We -- I have used AAA Plastic Surgery since
14 inception. This is the entire reason why I chose the name
15 Advanced Aesthetic Associates. That was, I think, pretty
16 clear rather early on, but that's the reason why I need
17 that name, because it's my name.

18 Q In December of 2017, you gave a deposition in a
19 lawsuit that involved Dr. Andres?

20 A Yes.

21 MR. FRUTKIN: Exhibit 116, Your Honor.

22 THE COURT: Thank you, Mr. Frutkin.

23 BY MR. FRUTKIN:

24 Q In this lawsuit, you are trying to disinterest
25 yourself from Dr. Andres because he was being accused of

1 Q What would you change on Exhibit 35, if you had
2 control?

3 A Well, I would, of course, put my phone numbers
4 on to show how patients can reach me. And I would not
5 include surgeons who are no longer associated, are no
6 longer given permission to associate with my name.

7 MR. FRUTKIN: May I have one second, Your
8 Honor.

9 THE COURT: Of course.

10 (Pause).

11 MR. FRUTKIN: Okay. I move that we
12 introduce all of the exhibits that I have used in cross
13 examination.

14 THE COURT: Ms. Ames?

15 MS. AMES: No, objection.

16 MR. FRUTKIN: I have nothing further of the
17 witness.

18 THE COURT: Thank you, Counsel.

19 Jamie, let's show the admission of Exhibits
20 75, 90, 93, 94, 96, 107, 115 and we'll take 116, even
21 though it's a deposition.

22 (Defendant's Exhibits 75, 90, 93, 94,
23 96, 107, 115 and 116 were admitted.)

24 THE COURT: Redirect?

25 MS. AMES: Thank you, Your Honor.

1 BY MS. JUDD:

2 Q Ms. Peck, what is your professional position?

3 A Office manager.

4 Q And who are you the office manager for?

5 A Dr. Prichard.

6 Q And that's Advanced Aesthetic Associates's
7 practice?

8 A Yes, correct.

9 Q How long have you worked for Dr. Prichard
10 through that practice?

11 A For six years.

12 Q And did you -- what do you understand Advanced
13 Aesthetic Associates to be a reference to?

14 A AAA Plastic Surgery.

15 Q What is that?

16 A It's Advanced Aesthetic Associates or Dr.
17 Prichard's company.

18 Q Is it Dr. Repta's company?

19 A No.

20 Q Do you currently work just for Dr. Prichard?

21 A Yes.

22 Q Did you previously work for Dr. Repta?

23 A Yes.

24 Q When did you stop working for Dr. Repta?

25 A Around 2015, somewhere in that timeframe.

1 Q In your current position as the office manager,
2 what are your duties generally?

3 A I maintain the office, staff, patient care,
4 manage some billing accounts.

5 Q So do you have -- do you handle patient care
6 issues?

7 A Yes.

8 Q Do you also handle some business matters for Dr.
9 Prichard?

10 A Correct.

11 MS. JUDD: If I may approach the witness
12 with exhibits?

13 THE COURT: You may, Counsel. Your witness
14 so you are free to approach.

15 MS. JUDD: Thank you.

16 BY MS. JUDD:

17 Q Ms. Peck, I'm handing you Exhibits 28, 29, 30
18 and 31. Now, Exhibit 28 is the AAA logo -- excuse me, 27.
19 Do you have Exhibit 27?

20 A I do not.

21 Q I will grab that for you. I have handed Exhibit
22 27 as well. So --

23 A Yes.

24 Q So 27, that's AAA, or Advanced Aesthetic
25 Associates, logo; is that correct?

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

REMUS REPTA;

Opposer,

v.

PABLO PRICHARD,

Applicant.

Proceeding Number: **91248129**

Application Serial No: **88/197,995**

Registration No. N/A

Published: April 30, 2019

Mark: **AAA Plastic Surgery**

Class: **44**

APPLICANT’S MOTION TO DISMISS OPPOSITION

Pursuant to Rule 12(b)(6), Fed. R. Civ. P. (“Federal Rule”) and Rule 2.11 of the Trademark Rules of Practice (“TM Rule”), Applicant Pablo Prichard (“Dr. Prichard”), by his undersigned counsel, hereby moves to dismiss the Opposition filed by Remus Repta, M.D. (“Dr. Repta”), dated May 13, 2019, for failure to state a claim upon which relief may be granted.

The Trademark Trial and Appeal Board follows Federal Rule 12(b) which requires that a party filing a complaint, which would include an Opposition to Registration, be plead by asserting proper grounds for the stated opposition and proper pleading of the

claim or claims asserted. TM Rule §2.104. Here, Dr. Repta has utterly failed to identify any cognizable claims; in fact, not a single claim has been specifically asserted. Even giving the most generous reading to the allegations plead in order to divine some claim, the allegations taken together cannot support any viable claim. None of the claims that could possibly be taken from the allegations plead could support a valid opposition. Therefore, the opposition should be dismissed in its entirety.

I. Background

Dr. Prichard is a medical doctor specializing in cosmetic and reconstructive surgery. He began practicing medicine as a cosmetic and reconstructive surgeon in the Phoenix/Scottsdale, Arizona area in 2005 through his medical practice, Advanced Aesthetic Associates (“AAA”), an entity formed by him and for which he has always been the sole member. AAA has used the tradename of AAA and AAA Plastic Surgery since its formation in 2005. Dr. Prichard attempted to obtain the domain name aaaplasticsurgery.com, but it was not available for purchase until 2008.

In 2008, Remus Repta, M.D. (“Dr. Repta”), completed his residency and moved to the Phoenix/Scottsdale area and began practicing as a cosmetic and reconstruction surgeon out of Dr. Prichard’s AAA office. Dr. Repta never became a member or owner of AAA. Instead, Dr. Repta created his own practice, Remus Repta, M.D., PLLC (“Repta PLLC”), and saw patients out of Dr. Prichard’s AAA office. Dr. Repta or his medical surgical practice Repta PLLC, were charged rent for use of AAA office space. Dr. Repta billed all of his patients through Repta PLLC, and Dr. Repta and Repta PLLC had their own bank accounts, billing records, malpractice insurance and developed their own website, logo and trademarks. Dr. Repta was permitted by Dr. Prichard to associate himself with Dr. Prichard’s AAA practice by appearing in some of AAA promotional materials. And, around this same time, Dr. Repta offered to assist Dr. Prichard in creating a new website for Dr. Prichard’s AAA practice. At Dr. Prichard’s direction, Dr. Repta purchased

aaaplasticsurgery.com. Dr. Prichard and AAA were at all times the intended third-party beneficiaries of this domain name which Dr. Repta held in constructive trust for Dr. Prichard and AAA.

Dr. Repta admits that Dr. Prichard alone rightfully owns the tradename and trademark Advanced Aesthetic Associates and its associated A/Face logo (*see* Opposition at ¶5 (“Dr. Prichard has applied for the trademark for ‘Advanced Aesthetic Associates’, but *Dr. Repta does not object to that application.*”) (emphasis added)). Dr. Repta does not and cannot allege that that AAA and AAA Plastic Surgery have ever been used by Dr. Repta to identify a plastic surgery practice other than its use to direct visitors to the Advanced Aesthetic Associates website.

Finally, Dr. Repta admits that since approximately 2012, the building from which Advanced Aesthetic Associates operates, located at 8900 E. Raintree Drive, Scottsdale, Arizona (the “Raintree Facility”), has had the name “AAA Plastic Surgery” prominently displayed on the west facing exterior wall, visible to the public, to indicate that Advanced Aesthetic Associates – “AAA” was located in that building.

Instead of any relevant allegations, which Dr. Repta cannot make, Dr. Repta’s Notice of Opposition, which must be read carefully to tease out possible claims, which are wholly missing from the opposition, appears to be based solely on his allegations that 1) the specimens submitted by Dr. Prichard in support of his application for registration of the AAA Plastic Surgery mark do not show Dr. Prichard used the mark AAA Plastic Surgery “exclusively” to identify his practice (Opposition at ¶¶4, 10, 11); 2), that Dr. Prichard did not personally pay for the aaaplasticsurgery.com domain name or solely pay for the marketing information created and posted at that aaaplasticsurgery.com website (Opposition at ¶¶6, 7, 11); 3), that Dr. Prichard did not personally pay for the AAA Plastic Surgery sign placed on the building advertising that his Advanced Aesthetic Associates practice was in the building (Opposition at ¶11), and 4) it is Dr. Repta’s belief that the AAA Plastic Surgery mark is generic and is used only in conjunction with the

aaaplasticsurgery.com domain name (Opposition at ¶¶13, 16). Assuming the facts alleged are true for the purpose of the Opposition only, none of these allegations support a proper basis for opposition and thus the Opposition must be dismissed.

II. There is no basis for opposing Dr. Prichard's application

The standard on a motion to dismiss pursuant to Federal Rule 12(b)(6) is well-settled. In short, a court may dismiss a claim if, after accepting all well-pleaded allegations in the complaint as true and drawing all reasonable factual inferences in the plaintiff's favor, the complaint does not allege "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570, 127 S.Ct. 1955 (2007).

Similarly, one filing an opposition to a trademark application must set forth a plain statement showing why 1) the opposer believes he would be damaged by the registration of the opposed mark, and 2) state the grounds for opposition, which is supported and explained in the required accompanying statement. 37 C.F.R. §§2.101(b)(1) and 2.104(a); TBMP §309.03(a)(2); *Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998)(a party opposing a registration must assert a statutory ground which negates the applicant's entitlement to registration and at the pleading stage allege sufficient facts in support of both); *see generally* 37 C.F.R. § 2.112(a) (1997) (The petition to cancel or oppose must set forth a "short and plain statement showing why the petitioner believes it is or will be damaged by the registration [*and*] state the grounds for cancellation") (emphasis in original).

None of the allegations asserted by Dr. Repta are sufficient to meet the requirements for a valid opposition.

A. Exclusive use of a Trademark is not required for registration

Dr. Repta alleges that Dr. Prichard is not the "exclusive" user of the AAA Plastic Surgery mark. (Opposition at ¶4). This allegation misses the point. There is no requirement that Dr. Prichard be the exclusive user of his mark before he sought protection of it through

the USPTO. It is only required that he demonstrate he has priority of use by being the first to actually use the trademark. *Sengoku Works Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1219 (9th Cir.), *as modified*, 97 F.3d 1460 (9th Cir. 1996) (“It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.”); *Emergency One, Inc. v. Am. Fire Eagle Engine Co., Inc.*, 332 F.3d 264, 267 (4th Cir. 2003) (“When more than one user claims the exclusive right to use an unregistered trademark, priority is determined by ‘the first actual use of [the] mark in a genuine commercial transaction.’” *Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 358 (6th Cir.1998).”). Dr. Repta does not claim any priority of use, because he cannot.

Dr. Prichard sought an injunction to prevent Dr. Repta from using the *aaaplasticsurgery.com* domain name and associating with Dr. Prichard’s AAA practice or using any associated tradenames or trademarks. The action before Maricopa County Superior Court resulted in the court finding that “the weight of the evidence presented at the hearing demonstrated that Dr. Prichard began using the name AAA Plastic Surgery in or about 2005, well before Dr. Repta’s relocation to Phoenix and the commencement of Dr. Prichard and Dr. Repta’s joint ventures.” *See* Minute Entry dated 4/23/2019 at p.2, attached hereto as **Ex. A**. The Court also “agree[d] with Plaintiffs [Dr. Prichard and Advanced Aesthetic Associates] that there is evidence to support their claim to ownership and control of the *aaaplasticsurgery.com* domain.” *Id.* at p.3. And finally, the Court found Dr. Prichard met his burden to show a strong likelihood of success on the claim that Dr. Repta had interfered with *aaaplasticsurgery.com* email addresses used by Dr. Prichard’s staff. *Id.* at p.3.

However, the Maricopa County Superior Court did not impose an injunction because it found that the record was insufficient for the Court to make a determination

regarding the AAA Plastic Surgery tradename “*particularly in view of the fact that Plaintiffs’ [Dr. Prichard] recent application for trademark protection remains pending before the United States Patent and Trademark Office.*” *Id.* at 3 (emphasis added). In short, the court recognized that the issuance of the trademark registration would resolve the trademark and domain name issue between the parties and therefore the Maricopa County Court need not make the determination prior to the registration determination by the Trademark Trial and Appeal Board. *Id.* at 4 (“pending a determination that Plaintiffs in fact have a protectable interest in [the AAA Plastic Surgery] name (and associated marks)¹, the Court is unable to conclude the balance of hardships tips strongly in Plaintiffs’ favor.”).

Any use of the AAA Plastic Surgery mark by others, including Dr. Repta or other companies (including Advanced Plastic Reconstruction) were permissive uses, done with Dr. Prichard’s knowledge and agreement under an implied license, which has since been expressly revoked. *See* Feb. 2, 2019 hearing transcript at 56:10-12, 56:22-57:4, attached hereto as **Ex. B**. Absent an allegation of prior use, the mere fact that Dr. Prichard allowed others to use the AAA Plastic Surgery mark does not support a valid basis for opposition. *See Coach House Rest., Inc. v. Coach & Six Restaurants, Inc.*, 934 F.2d 1551, 1558–59 (11th Cir. 1991) (finding that permission to use logo did not result in acquiescence of conveying trademark rights to allow a permissive user of the trademark to establish superior trademark rights).

B. The specimens submitted by Dr. Prichard with his TM Application support his use of the AAA Plastic Surgery mark.

Dr. Repta alleges that the specimens submitted by Dr. Prichard in support of this trademark application do not show Dr. Prichard used AAA Plastic Surgery to advertise his practice group apart from the aaplasticsurgery.com domain name. (Opposition at

¹ The marks associated with AAA Plastic Surgery are “Advanced Aesthetic Associates” and the A/face logo (see specimens to TM Application 88197991).

¶11). This assertion is belied by Dr. Prichard’s specimen submissions themselves and Dr. Repta’s allegations. *See* Dr. Prichard’s Trademark Application No. 88/197,995, the subject of Dr. Repta’s opposition, and specimens thereto (showing the AAA Plastic Surgery signage on the exterior of the building) and Opposition at ¶11 (showing Dr. Repta’s acknowledgement that the AAA Plastic Surgery sign was a submitted specimen and used as submitted on the building from which Dr. Prichard practiced, without reference to aaaplasticsurgery.com).

Dr. Prichard arrived at this name – AAA Plastic Surgery while he was still in his residency and began using it immediately after he completed his residency and started practicing in Arizona in 2005, well before Dr. Repta arrived in the Phoenix/Scottsdale and began his own practice, as Dr. Repta was a number of years behind Dr. Prichard with his education, residency and fellowship. *See* Feb. 2, 2019 hearing transcript at 10:3-11:18, 16:7-13, 57:13-17, attached hereto as **Ex. B**. Dr. Prichard decided on Advanced Aesthetic Associates, AAA and AAA Plastic Surgery as the name and trademarks for his practice to be first in alphabetic directories and reversed engineered the Advanced Aesthetic Associates name from AAA and has consistently referred to his practice as AAA and AAA Plastic Surgery since 2005. *See* Feb. 2, 2019 hearing transcript at 10:15-11:18, attached hereto as **Ex. B**. This is how Dr. Prichard identified his practice within the field before Dr. Repta’s arrival. *See* Feb. 2, 2019 hearing transcript at 16:9-18:13, attached hereto as **Ex. B** (Dr. Prichard’s testimony referencing an exhibit showing JCL [John C. Lincoln Hospital] knew his practice at AAA by February 2008). Even in correspondence with Dr. Repta before Dr. Repta completed his training and arrived in Arizona, Dr. Prichard identified his practice as Advanced Aesthetic Associates and AAA Plastic Surgery. *See* Feb. 2, 2019 hearing transcript at 18:14-20:5, attached hereto as **Ex. B**. Dr. Prichard’s logo stacks the “A”s in Advanced Aesthetic Associates because Dr. Prichard has used “AAA Plastic Surgery” since at least 2007. *See* Feb. 2, 2019 hearing transcript at 9:3-24, attached hereto as **Ex. B**. Dr. Prichard has used AAA Plastic Surgery continuously and

consistently for over 13 years in connection with his plastic surgery practice. See Feb. 2, 2019 hearing transcript at 6:6-9:24, attached hereto as **Ex. B**. And Dr. Prichard's Office Manager understands AAA Plastic Surgery to be a reference to Dr. Prichard's practice. Feb. 2, 2019 hearing transcript at 94:9-95:4, attached hereto as **Ex. B**. Thus, Dr. Prichard is synonymous with AAA Plastic Surgery and used this trademark before Dr. Repta even started practicing.

C. Personal payment for the cost of acquiring a domain name and developing website content is not a valid basis for opposing the registration of the underlying trademark.

Dr. Repta alleges that Dr. Prichard does not own the aaaplasticsurgery.com² domain name and did not solely pay for the content posted to the website. Neither of these allegations form a basis for a valid opposition. (Opposition at ¶¶6 and 7).

The most Dr. Repta can argue is that Dr. Prichard extended an implied license for him to use AAA Plastic Surgery when the parties worked cooperatively. See *Eagle Hospital v. SRG Consulting*, 2005 WL 8160544, at *6 (N.D. Ga. March 24, 2005) (“[a]cquiescence to one’s use of a trademark is analogous to an implied license to use the mark.”). (citations omitted). Such an implied license, however, is terminable at will. *Id*; see also *Menendez v. Holt*, 128 U.S. 514, 524 (1888) (“[W]here consent by the owner to use of his trademark by another is to be inferred from his knowledge and silence merely, ‘it lasts no longer than the silence from which it springs; it is, in reality, no more than a revocable license’”) (citations omitted); McCarthy on *Trademarks and Unfair Competition* § 25:31 (5th ed.) (“Once a ...license contract is terminated, there is no doubt that the former ... licensee has no authorization or consent to continue use of the mark. After the permission to use the mark has ended, use of the mark must cease.”).

² Dr. Repta wrongly asserts that Dr. Prichard admits to Dr. Repta's ownership of the aaaplasticsurgery.com domain name. Dr. Prichard has consistently held that Dr. Repta purchased the domain name at Dr. Prichard's direction and that Dr. Prichard and his AAA practice are the intended third-party beneficiaries. Nevertheless, for purposes of this Motion to Dismiss, we assume, without agreeing, that Dr. Repta's allegation as asserted is true, as we must.

No dispute exists that Dr. Prichard unequivocally revoked any authorization for Dr. Repta to use AAA Plastic Surgery. Feb. 2, 2019 hearing transcript at 56:10-12, 62:3-6, attached hereto as **Ex. B**. In addition, or alternatively, Dr. Repta abandoned any alleged rights to associate with AAA Plastic Surgery when he established his own branding after his practice matured. Registration of a domain name that contains protected marks of another, does not establish the registrant's right to use that domain name or protected mark. *See* 15 U.S.C. § 1125. Moreover, Dr. Repta has not and cannot explain how contributing to the cost of website content design gains Dr. Repta any rights to use the name AAA Plastic Surgery, knowing that Dr. Prichard used this name long before Dr. Repta began to practice or initially registered the domain name.

D. Conclusory allegations of generic nature of a trademark are insufficient.
(Opposition at ¶¶13, 16)

Dr. Repta alleges that the AAA Plastic Surgery mark is generic and used only to indicate the aaaplasticsurgery.com domain name (Opposition at ¶¶13, 16). This is plainly wrong. As outlined in Section II.B *supra*, this allegation is contradicted by Dr. Repta's other assertions and Dr. Prichard's specimen submissions. (*See* Dr. Prichard's Trademark Application No. 88/197,995, the subject of Dr. Repta's opposition, and specimens thereto).

Interestingly, the only aspect of the trademark AAA Plastic Surgery that Dr. Repta really opposes is Dr. Prichard's right to the domain name aaaplasticsurgery.com, despite Dr. Prichard using AAA Plastic Surgery, AAA and Advanced Aesthetic Associates in a myriad of other manners as the context, spacing and other factors allow to advertise, market, promote and refer to his practice. It is clear that Dr. Repta is simply cybersquatting and holding hostage the aaaplasticsurgery.com domain name due to the falling out between the parties.

III. No cognizable claim of legal damage

Allegations in support of plaintiff's belief of damage must have a "reasonable basis

in fact.” *Richie v Simpson*, 170 F3d 1092, 50 USPQ2d 1023, 1027 (Fed/ Cir. 1999) (citations omitted). Here, the alleged facts show that Dr. Repta has asserted no legal damage to support an opposition, because he cannot. The mere purchase of a domain name by an opposer that may not later be used without infringing on the rights of the registrant, or an allegation of use by others is not sufficient to establish damages required for the opposition of a trademark. *Am. Novawood Corp. v. U. S. Plywood-Champion Papers, Inc.*, 426 F.2d at 827, 57 CCPA at 1282, 165 USPQ at 616-17 (C.C.P.A. 1970) (an opposer’s rights in the mark must be superior to appellee’s right or the opposer cannot be legally “damaged,” by the issuance of a registration to the applicant.). Because Dr. Repta does not, and cannot allege superior rights in the mark, he cannot be legally damaged, and thus his opposition must be dismissed on this ground alone. *Hollowform, Inc. v. AEH*, 515 F.2d 1174, 1176 (C.C.P.A. 1975) (citing *Am. Novawood Corp.* at 823, 57 CCPA 1276).

IV. Conclusion

Therefore, for all of the reasons stated herein, Dr. Repta’s Opposition should be dismissed because it states no cognizable claim nor alleges any actual damages as a result of Dr. Prichard’s registration of AAA Plastic Surgery.

Respectfully submitted,

Date: June 21, 2019

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Motion to dismiss the Opposition Action was electronically filed with the Trademark Trial and Appeal Board this 21st day of June, 2019.

A handwritten signature in cursive script, reading "Vanessa Lencastre".

(Signature)

June 21, 2019
(Date of Signature)