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

Proceeding	91252817
Party	Defendant John Zox
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Attachments	2020-09-23 Zox Opposition to Motion to Substitute w Exhibits.pdf(264481 bytes )

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

HOUSE OF KUIPERS, LLC,

Opposer,

v.

JOHN ZOXX,

Applicant.

Opposition No. 91252817

Application Serial No. 88/228,839

Mark: ZOXX

**APPLICANT’S MEMORANDUM OF LAW IN OPPOSITION TO  
OPPOSER’S MOTION TO SUBSTITUTE**

Applicant/Counterclaim Plaintiff John Zox (“Applicant”) submits this memorandum of law in opposition to Opposer/Counterclaim Defendant House of Kuipers, LLC’s (“Opposer”) Motion to Substitute Zox, LLC for House of Kuipers, LLC as party Opposer/Counterclaim Defendant in this proceeding (Dkt. No. 18).<sup>1</sup> For the foregoing reasons, Opposer’s motion to substitute should be denied, and Zox, LLC should instead be joined as a party in this proceeding.

“If a mark pleaded by a plaintiff is assigned and a copy of the assignment is filed with the Board, the assignee *ordinarily* will be substituted for the originally named party *if* the assignment occurred prior to the commencement of the proceeding, *if* the discovery and testimony periods have closed, *if* the assignor is no longer in existence, or *if* the defendant raises no objection to substitution; *otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence.*” TBMP § 512.01 (emphasis

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<sup>1</sup> The Board has construed Opposer’s “Notice of Change of Ownership” as a motion to substitute parties. (Dkt. No. 19.)

added).

Not one of the four circumstances for ordinarily allowing for substitution exists in the instant case. First, the assignment of the relevant registrations from Opposer to Zox, LLC occurred on May 14, 2020, *after* the commencement of this action on December 10, 2019. Second, the discovery and testimony periods remain open. (*See* Scheduling Order, Dkt. No. 13.) Third, the assignor House of Kuipers LLC remains active and in existence according to the California Secretary of State business entity database.<sup>2</sup> Finally, Applicant objects to the substitution and requests that House of Kuipers LLC remain a party to “facilitate the taking of discovery,” as it may have documents and testimony in its possession, custody, and control relevant to the claims and defenses in this proceeding, notwithstanding the assignment of the right, title, and goodwill in the relevant registrations to Zox, LLC. TBMP § 512.01.

Accordingly, because none of the circumstances for ordinarily allowing for substitution are met, “*the assignee will be joined, rather than substituted*,” to facilitate the taking of discovery and the introduction of evidence.” TBMP § 512.01 (emphasis added); *see also NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1434 n.2 (TTAB 2007) (applicant’s motion to join another defendant granted where assignment of application occurred after proceeding commenced).

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<sup>2</sup> A true and correct copy of the California Secretary of State business entity database website showing the active status of Opposer House of Kuipers, LLC, available at <https://businesssearch.sos.ca.gov/CBS/SearchResults?filing=&SearchType=LPLLC&SearchCriteria=house+of+kuipers&SearchSubType=Keyword> (accessed September 23, 2020) is attached hereto as **Exhibit A**.

For the foregoing reasons, Opposer's motion to substitute Zox, LLC for Opposer should be denied, and Zox, LLC should instead be joined as a party in this proceeding.

Dated: September 23, 2020  
New York, New York

Respectfully submitted,

**LOMBARD & GELIEBTER LLP**

/s/ Darren M. Geliebter

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# **Exhibit A**

Alex Padilla  
California Secretary of State







## Business Search - Results

The California Business Search is updated daily and reflects work processed through Tuesday, September 22, 2020. Please refer to document [Processing Times](#) for the received dates of filings currently being processed. The data provided is not a complete or certified record of an entity.

- Select an entity name below to view additional information. Results are listed alphabetically in ascending order by entity name, or you can select a column title to change the sort order.
- To refine the search results, enter a word or a string of words in the "Narrow search results" box. The "Narrow search results" will search on all fields of the initial search results.
- For information on checking or reserving a name, refer to [Name Availability](#).
- For information on requesting a more extensive search, refer to [Information Requests](#).
- For help with searching an entity name, refer to [Search Tips](#).
- For descriptions of the various fields and status types, refer to [Frequently Asked Questions](#).

Results of search for LP/LLC Name keyword "house of kuipers" returned 1 entity record (out of 1 record found).

Show  entities per page      Narrow search results:

 Entity Number	 Registration Date	 Status	 Entity Name	 Jurisdiction	 Agent for Service of Process
201316810028	06/10/2013	ACTIVE	<a href="#">HOUSE OF KUIPERS, LLC</a>	CALIFORNIA	JASON SCOTT KUIPERS

Showing 1 to 1 of 1 entities

[Previous](#) [1](#) [Next](#)

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