ESTTA Tracking number: **ESTTA747303**

Filing date: **05/18/2016**

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

Proceeding	92056649
Party	Defendant Around the Clock Homecare Group, LLC
Correspondence Address	MICHAEL A ESSIEN ESSIEN LAW OFFICE PLLC 245 RUTH STREET NORTH, SUITE 201 SAINT PAUL, MN 55119 UNITED STATES messien@essienlaw.com
Submission	Other Motions/Papers
Filer's Name	Michael A Essien
Filer's e-mail	messien@essienlaw.com
Signature	/Mike Essien/
Date	05/18/2016
Attachments	ATC v Around the clock Status 051816.pdf(124400 bytes)

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

IN THE MATTER OF Trademark Registration No. 4,135,525
For the Mark: AROUND THE CLOCK HOME CARE

ATC HEALTHCARE SERVICES, INC **Petitioner,** **v.** **AROUND THE CLOCK HOME CARE GROUP, LLC** **Respondent**	**Cancellation No: 92056649**

RESPONDENT'S STATUS OF CIVIL ACTION

Respondent, AROUND THE CLOCK HOME CARE, LLC ("AROUND THE CLOCK"), by and through its attorney, hereby files this status report and in response to Petitioner's Status Report of May 09, 2016.

Respondent notes that the Parties stipulated to Dismissal with Prejudice and executed a Settlement Agreement governing their respective rights, obligations and agreements as to all claims in this action. The Settlement Agreement provides that "Plaintiff and Defendant desire to settle fully and finally all differences between them, including but not limited to those differences embodied in the

aforementioned Complaint and any related claims, charges or complaints without further litigation." As a part of the settlement, the Parties agreed that Respondent's mark would continue to be used but that the description of services provided under the mark would be restricted by amending the identification of goods or services from "home health care services" to "home care services excluding any medical, health or palliative services".

Respondent agrees to the restriction of its services and asserts same to be in compliance with 37 CFR § 2.173 as it is a restriction and does not require republication of the mark. Viewed under any reasonable standard, the amendment to the description of goods or services as proposed cannot be deemed "potentially adding services."

Respondent notes that Section 2.3 of the Settlement Agreement does not in any way imply an abandonment as it clearly restricts use of Respondent's mark as agreed to in Section 1.1. Petitioner's attempt to mislead the Board can only be seen as such and may be read as misrepresenting to the Board, the terms of the Settlement Agreement. Respondent asserts that Petitioner agreed to the terms as reduced to writing, stipulated to dismissal with prejudice, and must not attempt to circumvent such by inserting new terms to the Agreement, implying actions that are not readable from the plain understanding of the Settlement Agreement under any reasonable standard, or taking a position directly contrary to its obligations under the Settlement Agreement. Petitioner agreed, at paragraph 2.7, to support Respondent's proposed amendment to the description of services, and its arguments that the proposed amendment should not be acceptable, that the mark has been abandoned or that the mark should be cancelled are in direct contravention to the obligations under the Settlement Agreement.[1]

[1] Respondent notes that Petitioner argues it only has to support the requested amended description of services "if requested by the USPTO". Because Petitioner was required by the rules governing this proceeding to submit a

Restated, Respondent agrees to the restriction as agreed in the Settlement Agreement to the description of services as "**home care services excluding medical, health or palliative services.**" With this amendment, Respondent further agrees to the Dismissal of the instant Cancellation Proceeding as stipulated in the Civil Action – 14-CV-1162 (DSD/HB). Nothing in the submissions by the Parties calls for an addition of services or implied abandonment as asserted by the Petitioners.

Respondent reserves all rights.[2]

Respectfully submitted,

Dated: May 18, 2016

By ___/Mike Essien/_____
Michael A. Essien, Atty No. 031741X
ESSIEN LAW OFFICE, PLLC
245 Ruth Street North, Suite 201
Saint Paul, Minnesota 55125
(651) 340-4310 *Telephone*
(651) 340-4311 *Facsimile*

Attorney for Respondent,
Around the Clock Home Care Group, LLC.

status report regarding the settled litigation which presented the same claims as this cancellation proceeding, Respondent submits that the rule imposes a request that the Petitioner accurately report to this Board.

[2] Respondent also reserves all of its rights to return to the District Court of Minnesota in the Civil Action to seek specific enforcement, damages or other compensation relating to the Settlement Agreement should the Petitioners continue to prevail on the Board in contravention of the Settlement Agreement.

CERTIFICATE OF TRANSMITTAL – ESTTA

I hereby certify that this correspondence is being electronically transmitted through on-line TTAB filing systems, ESTTA on May 18, 2016

/Mike Essien/
Michael A. Essien

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing was served via both email to JMulrooney@kwbhlaw.com, and First Class U.S. Mail, postage prepaid this 18th day of May 2016 upon the following:

Michael G. Monyok, Esq.
KEEVICAN WEISS BAURIE & HIRSCH
1001 Liberty Avenue Federated Investors Towers, 11th Floor
Pittsburgh, PA 15222
JMulrooney@kwbhlaw.com
Counsel for Petitioner

Dated: May 18, 2016

By ___/Mike Essien/_____
Michael A. Essien, Atty No. 031741X
ESSIEN LAW OFFICE, PLLC
245 Ruth Street North, Suite 201
Saint Paul, Minnesota 55125
(651) 340-4310 *Telephone*
(651) 340-4311 *Facsimile*

Attorney for Respondent,
Around the Clock Home Care Group, LLC.