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Filing date: **06/24/2019**

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

Proceeding	92066817
Party	Plaintiff Premier Accessory Group, LLC
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Signature	/Michael Schwab/
Date	06/24/2019
Attachments	CODE RED MOTION TO JOIN.pdf(210785 bytes)



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

PREMIER ACCESSORY GROUP, LLC)	
)	Cancellation No. 92066817
Petitioner,)	
)	Registration Nos. 5,001,276 and
)	4,209,831
)	
FLI MARKETING INC. DBA EASY)	Marks: CODERED and Design
TO GET WIRELESS,)	
)	
Respondent.)	

Petitioner’s Motion to Join a Party to This Proceeding

Petitioner, Premier Accessory Group, LLC, in accordance with Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.133(a) and TBMP § 512 files this motion to join GastonCo, LLC (“GastonCo”) as a respondent in this action.

Procedural Background

1. Petitioner owns Application No 86819258 for the trademark CODE RED (“Petitioner’s Mark”) for goods in Classes 9 and 11.
2. The Examining attorney refused registration of Petitioner’s Mark based on an alleged likelihood of confusion with Registration Nos. 5001276 and 4209831¹ (“Respondent’s Registrations”) for the marks  and  for goods in Class 9.
3. On September 6, 2017 Petitioner filed a Petition for Cancellation against Respondent’s Registrations.

At the time the petition was filed the Trademark Office’s records indicated¹ that Respondent’s Registrations were owned by FLI Marketing, Inc. d/b/a Easy to Get Wireless (“FLI”).

¹ On April 19, 2019 Reg. No. 4209831 was canceled because Respondent did not file a declaration as required under Section 8 of the Trademark Act, 15 U.S.C. § 1058. This registration is no longer a bar to registration of Petitioner’s Mark.

4. On information and belief FLI and GastonCo are parties to an Asset Purchase Agreement dated February 2, 2017 (the "Purchase Agreement").
5. On information and belief pursuant to the Purchase Agreement all the right, title and interest to trademarks owned by FLI, including Respondent's Registrations, were sold, assigned and transferred to GastonCo.
6. On October 16, 2017 an Assignment purporting to assign Respondent's Registrations to GastonCo was filed with the Trademark Office² (Reel/Frame 618/0106) (DKT # 15). A copy of the Assignment and the Trademark Assignment Cover Sheet connected to the filing of the Assignment with the Trademark Office are attached.
7. On October 17, 2017 GastonCo filed an Answer to the Petition for Cancellation "as assignee of" FLI.

Arguments

8. 37 CFR §2.133(a) provides that a registration subject to a cancellation may not be amended "except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon a motion granted by the Board."
9. GastonCo did not seek Petitioner's consent and Board approval or file a motion with the Board to amend Respondent's Registrations.
10. If a mark that is the subject of, or relied upon in an *inter partes* before the Board is assigned "together with the application or registration," the assignee may be joined or substituted as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. TBMP § 512.01; *See NSM Resources Corp.; and Huck Doll LLC, joined as a party plaintiff v. Microsoft Corp.*, 113 USPQ2d 1029 (TTAB 2014). Further, after "the assignment is recorded in the Assignment Recordation Branch of the USPTO, the assignee may be substituted as a party if the assignment

² The date the Assignment was executed is not clear. The Trademark Assignment Cover Sheet indicates the Assignment was executed on February 2, 2017. However, the Assignment filed with the Trademark Office indicates that it was "[e]xecuted as of 11-10-17."

occurred prior to the commencement of the proceeding, the assignor is no longer in existence, the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed.”

TBMP § 512.01. Otherwise, the assignee will be joined, rather than substituted. *Id.*

11. Here, joinder rather than substitution is appropriate because: (i) it is unclear whether the Respondent’s Registrations were assigned to GastonCo before or after the commencement of this proceeding; (ii) FLI and/or GastonCo did not seek the Petitioner’s consent or approval from the Board before it amended Respondent’s Registrations; and (iii) there is nothing in the record to indicate that the assignor, FLI, is no longer in existence. *See NSM Resources Corp.; and Huck Doll LLC, joined as a party plaintiff v. Microsoft Corp.*, 113 USPQ2d 1029 (TTAB 2014) (joinder, rather than substitution appropriate, where the assignment of the petitioner’s mark was executed after the proceeding commenced and there was no evidence in the records that the petitioner or the business connected to the mark no longer was in existence). Further, GastonCo will not be prejudiced by being joined in this action. It filed an Answer to the Petition to Cancel and participated in all aspects of discovery as the assignee of Respondent’s Registrations.

Conclusion

12. For the reasons stated above, Petitioner requests that GastonCo be joined as a respondent to this action.

Respectfully submitted,

Date: June 24, 2019



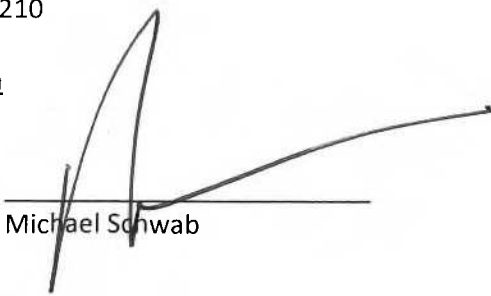
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Certificate of Service

I hereby certify that a true copy of the foregoing Petitioner's Brief, was served by e-mail and first class mail postage pre-paid this 24th day of June, 2019 upon counsel for Respondent:

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Michael Schwab

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

ETAS ID: TM447392

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL
SEQUENCE:	1

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
FLI Marketing, Inc. DBA Easy to Get Wireless		02/02/2017	Corporation: CALIFORNIA

RECEIVING PARTY DATA

Name:	GastonCo, LLC
Street Address:	1920 Palermo Ct.
City:	Vista
State/Country:	CALIFORNIA
Postal Code:	92081
Entity Type:	Limited Liability Company: CALIFORNIA

PROPERTY NUMBERS Total: 1

Property Type	Number	Word Mark
Registration Number:	5001276	CODERED

CORRESPONDENCE DATA

Fax Number:

Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

Phone: 760-942-9431
Email: malte@farnaeslaw.com
Correspondent Name: Malte Farnaes
Address Line 1: 2235 Encinitas Blvd.
Address Line 2: Suite 210
Address Line 4: Encinitas, CALIFORNIA 92024


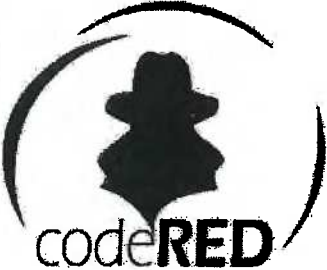
NAME OF SUBMITTER:	Malte Farnaes
SIGNATURE:	/malte farnaes/
DATE SIGNED:	10/16/2017

Total Attachments: 2

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ASSIGNMENT

WHEREAS, FLI Marketing, Inc., a California corporation, ("Assignor"), is the registered owner of the following trademarks (collectively the "Marks"):

	United States Patent and Trademark Office Registration number 5001276
	United States Patent and Trademark Office Registration number 4209831
CODERED	United States Patent and Trademark Office Serial number 86939873

WHEREAS, Assignor and GastonCo, LLC, a California limited liability company, ("Assignee") are parties to an Asset Purchase Agreement dated as of February 2, 2017 ("Purchase Agreement"); and

WHEREAS, Assignee desires to acquire Assignor's right, title and interest in the Marks.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is acknowledged, and pursuant to the Purchase Agreement, Assignor sells, assigns and transfers its entire right, title and interest in and to the Mark to Assignee, to be held and enjoyed by Assignee for its own use and benefit, and for its legal representatives and assigns, to the full end of the term for which any trademark or other right pertaining to the Marks is granted, as fully and entirely as it would have been held by Assignor had this assignment not been made.

Assignor further agrees to execute, deliver and record all instruments and documents as necessary to carry out the purpose of this Assignment as may be requested by Assignee from time to time.

Executed as of 11-10-17

ASSIGNOR

FLI Marketing, Inc.



Farris Isaacson, its Vice President