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

Proceeding	91213483
Party	Plaintiff Energy Heating LLC
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Signature	/MEM/
Date	03/04/2016
Attachments	March 4, 2016 Response to Status Inquiry.pdf(33301 bytes )

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

ENERGY HEATING LLC, an Idaho limited liability company,

Opposer,

v.

HEAT ON-THE-FLY, LLC, a Louisiana limited liability company,

Applicant.

Opposition No. 91213483

Application Serial No. 85/797,416

**OPPOSER’S RESPONSE TO INQUIRY INTO STATUS OF CIVIL ACTION**

Opposer Energy Heating LLC (“Opposer”), through its undersigned counsel, Davis Wright Tremaine LLP, hereby responds to the Board’s status inquiry of February 4, 2016. The trial portion of Case No. 4:13-cv-10 has concluded, with the jury finding that the phrase “Heat On-The-Fly” is generic. A copy of the Amended Judgment In A Civil Case is attached as Annex A. The parties are currently involved in post-trial briefing before the United States District Court of the District of North Dakota. Opposer therefore respectfully requests that this Opposition remain suspended pending final determination of the civil action.

DATED this 4th day of March, 2016.

Respectfully submitted,

s/Matthew E. Moersfelder

By: F. Ross Boundy  
Matthew E. Moersfelder  
Attorneys for Applicant  
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**CERTIFICATE OF FILING**

I hereby certify that OPPOSER'S RESPONSE TO INQUIRY INTO STATUS OF CIVIL ACTION is being filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: March 4, 2016 s/Matthew E. Moersfelder

**CERTIFICATE OF SERVICE**

I hereby certify that OPPOSER'S RESPONSE TO INQUIRY INTO STATUS OF CIVIL ACTION is being duly served upon on Applicant's counsel by mailing copies thereof via the U.S. Postal Service in sealed envelopes as first-class mail with postage thereupon fully prepaid and addressed to the following address:

Seth M Nehrbass, Esq.  
Garvey, Smith Nehrbass & North, LLC  
3838 N Causeway Blvd Ste 3290  
Metairie, Louisiana 70002

Date: March 4, 2016 s/Matthew E. Moersfelder

# ANNEX A

Local AO 450 (rev. 5/10)

**United States District Court**  
*District of North Dakota*

Energy Heating, LLC, an Idaho limited liability company; Rocky Mountain Oilfield Services, LLC, an Idaho limited liability company,  
Plaintiff/Counterclaim Defendants,

vs.

Heat On-The-Fly, LLC, a Louisiana limited liability company, and Super Heaters North Dakota, a North Dakota limited liability company,  
Defendants,

and

Heat On-The-Fly, LLC, a Louisiana limited liability company,  
Counterclaimant.

Heat On-The-Fly, LLC, a Louisiana limited liability company,  
Third-Party Plaintiff/Counterclaim Defendant,

vs.

Marathon Oil Corporation,  
Third-Party Defendants/Counterclaimant.

**AMENDED**  
**JUDGMENT IN A CIVIL CASE**

Case No. 4:13-cv-10

**Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict.

**Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

**Decision on Motion.** This action came before the Court on motion. The issues have been considered and a decision rendered.

**Stipulation.** This action came before the court on motion of the parties. The issues have been resolved.

**Dismissal.** This action was voluntarily dismissed by Plaintiff pursuant to Fed. R. Civ. P. 41(a)(1)(ii).

**IT IS ORDERED AND ADJUDGED:**

Pursuant to the Order filed at Docket # 616:

1. The trademark for "Heat On-The-Fly" is **INVALID** and unenforceable as it is a generic term.
2. The claim for the tort of Deceit is **DISMISSED WITH PREJUDICE**.
3. **DAMAGES** in the amount of \$750,000 are **AWARDED** for the intentional tortious conduct of HOTF.
4. The court **DECLINES** to order prejudgment interest.

Pursuant to the Order filed at Docket # 619:

HOTF's inequitable conduct renders the '993 Patent unenforceable. Energy Heating and Marathon's claims for Declaratory Judgment on the issue of Inequitable Conduct are **GRANTED**.

Date: January 20, 2016

ROBERT J. ANSLEY, CLERK OF COURT

by: /s/ Ashley Sanders, Deputy Clerk