

ESTTA Tracking number: **ESTTA758604**

Filing date: **07/15/2016**

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

Proceeding	92062088
Party	Defendant SurfSkate Industries, LLC
Correspondence Address	SUSAN M MULLHOLLAND GESMER UPDEGROVE LLP 40 BROAD STREET BOSTON, MA 02109 UNITED STATES trademarks@gesmer.com
Submission	Opposition/Response to Motion
Filer's Name	William E. Hilton
Filer's e-mail	william.hilton@gesmer.com, trademarks@gesmer.com, nieve.anjomi@gesmer.com
Signature	/William E. Hilton/
Date	07/15/2016
Attachments	92062088_Brief.pdf(153932 bytes ) 92062088_ExhibitA.pdf(2350765 bytes )

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

CARVER INTERNATIONAL, INC.	)	
	)	
Petitioner,	)	
	)	
v.	)	U.S. Reg. No. 3,839,107
	)	Cancellation No. 92/062088
SURFSKATE INDUSTRIES, LLC.	)	
	)	
	)	
Respondent.	)	

**OPPOSITION TO MOTION TO SUSPEND FOR CIVIL ACTION**

Respondent, SurfSkate Industries, LLC, hereby opposes Petitioner’s Motion to Suspend for Civil Action in the present action as well as in Cancellation No. 92063912 concerning Reg. No. 4,977,027, Registered June 14, 2016. Petitioner has made no motion to consolidate the two proceedings. The present cancellation petition was filed August 21, 2015, and Petitioner has conducted no discovery in the present action. The second cancellation petition was recently filed on June 16, 2016. Respondent opposes consolidation of the two cancellation petitions as well as the motion to suspend at least on the basis that the petitions were filed almost a year apart.

The basis for Petitioner’s present cancellation petition is that the design logo mark reprinted below includes a term (SURFSKATE) that Petitioner considers to be generic.



In Reg. No. 4,977,027, Respondent expressly disclaimed the term SURFSKATE.

Petitioner’s motion to stay asserts that the issues in a California Federal court action, Carver

International, Inc. v. Surfskate Industries, LLC, Civil Action No. 8:15-cv-01348-AG-DFM (C.D. Cal. 2015) are identical to those in the present cancellation petition. On June 24, 2016 however, Respondent filed in the District Court, a Motion to Dismiss all counts in Petitioner's Amended Complaint. The hearing on the Motion is set for August 8, 2016. Respondent believes that all Counts in the Amended Complaint will be Dismissed, and that a granting of a stay in the present Cancellation Proceeding is premature and futile, and further that Petitioner's Motion for a Stay at this stage is wasteful of the Board's resources. A copy of the Motion to Dismiss is attached hereto as Exhibit A.


In the Motion to Dismiss, Respondent establishes that the count for declaratory judgment of trademark non-infringement should be dismissed because no cease and desist correspondence was ever sent to Petitioner, or sent or authorized by Respondent. Respondent also establishes that the count for cancellation of Reg. No. 3,839,107 should also then be dismissed because no infringement allegation will remain at issue in the Federal court action. See Wham-O, Inc. v. Manley Toys, Ltd., No. CV 08-07830 CBM SSX, 2009 WL 6361387 at \*3, 92 U.S.P.Q.2d 1750 (citing Homemakers, Inc. v. The Chicago Home for the Friendless, 169 U.S.P.Q. (BNA) 262, 263 (7th Cir.1971) (per curiam) (holding that the court lacks jurisdiction to determine cancellation of a trademark if there is no independent claim of infringement)). Respondent further establishes that Petitioner's remaining state law counts must be dismissed because Petitioner seeks to enjoin Respondent's use of a term that Petitioner considers to be generic and to which Petitioner has no intellectual property rights. Petitioner has, and asserts, no valid and protectable right to the term that it seeks to have Respondent enjoined from using. Such claims must fail as a matter of law. See Kellogg Co. v. National Biscuit Co., 59 S.Ct. 109, 122, 83 L.Ed. 73, 39 U.S.P.Q. 296 (1938) ("Sharing in the goodwill of an article unprotected by patent or

trade-mark is the exercise of a right possessed by all – and in the free exercise of which the consuming public is deeply interested”).

The Federal court action has no basis in fact or law, and Respondent expects that the action will soon be dismissed. The present Motion to Suspend for Civil Action is therefore futile, and is at best premature.

Dated: July 15, 2016

GESMER UPDEGROVE LLP  
Attorney for the Respondent  
Surfskate Industries, LLC

By:  \_\_\_\_\_

William E. Hilton  
William.hilton@gesmer.com  
40 Broad Street  
Boston, MA 02109  
Telephone: (617) 350-6800  
Facsimile: (617) 350-6878

CERTIFICATE OF DEPOSIT AND SERVICE

I hereby certify that on July 15, 2016, I filed this document electronically with the Trademark Trial and Appeal Board and served a copy of the OPPOSITION TO MOTION To SUSPEND FOR CIVIL ACTION upon Petitioner’s counsel:

THOMAS J. SPEISS, III (SBN 200949)  
STRADLING YOCCA CARLSON & RAUTH, P.C.  
100 Wilshire Blvd., 4<sup>th</sup> Floor  
Santa Monica, California 90401  
Telephone: (424) 214-7042  
Facsimile: (424) 214-7010

Attorneys for Plaintiff,  
CARVER INTERNATIONAL, INC

by placing a copy in a separate envelope, with postage fully prepaid, for each address named above and depositing each in the U.S. Mail.

  
\_\_\_\_\_  
William E. Hilton

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

CARVER INTERNATIONAL, INC.	)	
	)	
Petitioner,	)	
	)	
v.	)	U.S. Reg. No. 3,839,107
	)	Cancellation No. 92/062088
SURFSKATE INDUSTRIES, LLC.	)	
	)	
	)	
Respondent.	)	

**EXHIBIT A**

**TO RESPONDENT'S OPPOSITION TO  
MOTION TO SUSPEND FOR CIVIL ACTION**

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.