

ESTTA Tracking number: **ESTTA758595**

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

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

Proceeding	92063912
Party	Defendant Surfskate Industries LLC
Correspondence Address	SURFSKATE INDUSTRIES LLC 614 S FEDERAL HIGHWAY , STE 300 FORT LAUDERDALE, FL 33301 UNITED STATES
Submission	Opposition/Response to Motion
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Date	07/15/2016
Attachments	92063912_Brief.pdf(155414 bytes) 92063912_ExhibitA.pdf(2474558 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. 4,977,027
)	Cancellation No. 92/063912
SURFSKATE INDUSTRIES, LLC.)	
)	
)	
Respondent.)	

OPPOSITION TO MOTION TO SUSPEND FOR CIVIL ACTION

Respondent, Surfskate Industries, LLC, hereby opposes Petitioner's Motion to Suspend in Cancellation No. 92063912 concerning Reg. No. 4,977,027, Registered June 14, 2016. Petitioner has made no motion to consolidate this proceeding with that of Cancellation No. 92/062088 for Registration No. 3,839,107, which was filed August 21, 2015. 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: _____


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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)
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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

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EXHIBIT A

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

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