

ESTTA Tracking number: **ESTTA983804**

Filing date: **06/27/2019**

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

Proceeding	92067341
Party	Defendant International Watchman, Inc.
Correspondence Address	JOHN D GUGLIOTTA LAW OFFICES OF JOHN D GUGLIOTTA PE Esq LPA PO BOX 506 RICHFIELD, OH 44286 UNITED STATES johng@inventorshelp.com, nathan@inventorshelp.com 330-253-2225
Submission	Opposition/Response to Motion
Filer's Name	Nathan Gugliotta, Esq.
Filer's email	trademarks@inventorshelp.com, johng@inventorshelp.com, nathan@inventorshelp.com
Signature	/NJG/
Date	06/27/2019
Attachments	Response Reinstatement.pdf(155259 bytes) Exhibit 1.pdf(140634 bytes) Exhibit 2.pdf(170885 bytes) Exhibit 3.pdf(775158 bytes) Exhibit 4.pdf(106639 bytes) Exhibit 5.pdf(200256 bytes)

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

Cancellation No. 92067341
Registration No. 3907646

Watching Time, LLC

Petitioner,

v.

International Watchman, Inc.

Registrant.

**Registrant's Response to Petitioner's Motion to Resume Proceedings and Renew
Petitioner's Motions to Strike and Compel**

Registrant International Watchman, Inc. ("IW") respectfully responds to Petitioner Watching Time, LLC's ("WT") Motion to Resume Proceedings and Renew Petitioner's Motions to Strike and Compel, and Brief in Support of the same (together, the "Motion").

I. Background.

On November 18, 2017, Petitioner commenced this cancellation proceeding by filing a Petition to Cancel the Registrant's Mark. 1 TTABVUE. Registrant respectfully contends that Petitioner had and continues to have no standing to bring this proceeding, but nevertheless is seeking to cancel Registrant's mark on the grounds of genericness (1 TTABVUE 2-3), false suggestion of a connection (1 TTABVUE 3-6), and fraud (1 TTABVUE 6-7). On December 30, 2017, Registrant filed its Answer, which contained numerous affirmative defenses. 4 TTABVUE. On February 9, 2018, Petitioner filed a Motion to Strike the Affirmative Defenses from Registrant's Answer. 7 TTABVUE. On February 15, 2018, the Board suspended the proceedings pending disposition of Petitioner's Motion to Strike. 8 TTABVUE. On February 26, 2018, Registrant filed a Motion to Amend its Answer to the Petition to Cancel, amending numerous affirmative defenses.

9-10 TTABVUE. On June 30, 2018, the Board issued an order striking some affirmative defenses in Registrant's Amended Answer, permitting others, and resuming the proceedings. 15 TTABVUE. On July 20, 2018, Registrant filed a Second Amended Answer to the Petition to Cancel, whereby Registrant amended multiple affirmative defenses and omitting some others. 16 TTABVUE. On August 17, 2018, Petitioner filed a Motion to Strike the Affirmative Defenses from Registrant's Second Amended Answer. 20 TTABVUE.

On July 20, 2018, Registrant filed a Motion to Suspend the subject proceeding pending a civil action between the parties in the United States District Court for the Northern District of Ohio Case No 1:18 CV 1690 (the "Federal Case") which may have had a bearing on this proceeding. 18 TTABVUE. On September 24, 2018, the TTAB suspended this proceeding pending the outcome of the Federal Case. 27 TTABVUE. On June 20, 2019, Petitioner filed its Motion to Resume and Renew. 28 TTABVUE.

II. Motion to Resume.

A. The subject proceeding should be resumed.

Registrant agrees that, at this time, it is appropriate for the present proceeding to resume. However, Petitioner's Motion fraudulently misrepresents the nature and outcome of the Federal Case in front of the Board. In its Motion, Petitioner knowingly makes factually incorrect statements to the effect that "the Federal Case has been fully and finally determined with no appeal filed." (28 TTABVUE 4). In reality, the Federal Case was resolved as to all other defendant parties, with the Court issuing a permanent injunction against the other defendant parties. See a true and accurate copy of the Court's Permanent Injunction, attached as "Exhibit 1". With respect to Watching Time, LLC, the court dismissed the Federal Case on the the basis that the Court did not have jurisdiction over WT. See a true and accurate copy of the Court's Memorandum of Opinion and Order dismissing the Federal Case against WT, attached as "Exhibit 2". For Petitioner to view these facts and conclude that the Federal Case was "*fully and finally determined*" in its favor is well outside the

bounds of our reality. For Petitioner to repeatedly claim as much in front of the Board is a textbook example of fraud. In actuality, the Court dismissed the Federal Case as to WT on mere jurisdictional grounds, and thus issued no final determination of the Federal Case on its merits. See Exhibit 2.

III. Motion to Renew.

A. Petitioner's Motion to Strike and Compel should not be renewed.

Pursuant to the Board's September 24, 2018 Order (27 TTABVUE 4), Registrant respectfully requests that the Board not renew Petitioner's Motion to Strike Affirmative Defenses from Registrant's Second Amended Answer, filed August 17, 2018 (20 TTABVUE) and Petitioner's Motion to Compel Discovery, filed August 30, 2018. 23 TTABVUE.

B. Registrant should not be subject to sanctions.

Petitioner claims many times in its Motion that “[w]hen Registrant filed its Federal Case, it knew it had no chance of succeeding and did so only to harass Petitioner and delay this cancellation proceeding.” 28 TTABVUE 5. In fact, Registrant had no such knowledge nor intent, but rather brought good faith claims against Petitioner. In bringing the Federal Case, Registrant filed in the Northern District of Ohio on the good faith belief that Petitioner would be subject to jurisdiction in such Court, due to Petitioner's telephone number, as listed in this present action, having a “330” area code. This is an area code in Summit County, Ohio, within the Northern District of Ohio. Additionally, the Federal Case was not, despite Petitioner's fraudulent misrepresentations to the Board to the contrary, fully nor finally determined on the merits, but merely on jurisdictional grounds. See Exhibit 2. Registrant is still of the good-faith and well-reasoned belief that Petitioner committed the claims contained in the Federal Case against it — namely, of a civil conspiracy to injure Registrant.

Regardless of the merits of Petitioner's petition for sanctions contained in the Motion, it has serious procedural defects that warrant the Board dismissing such claims. Specifically, TMBP § 527.02 governs the procedures for moving for sanctions in an inter partes proceeding. Specifically,

TMBP § 527.02 adopts Fed. R. Civ. P. 11, which clearly states that “[a] motion for sanctions must be made separately from any other motion and must describe the specific conduct that allegedly violates Rule 11(b). The motion must be served ... but it must not be filed or be presented to the court if the challenged paper, claim, defense, contention, or denial is withdrawn or appropriately corrected within 21 days after service or within another time as the court sets. ...” Fed. R. Civ. P. 11(c).

TBMP § 527.02 clearly states that “[a] motion for sanctions under Fed. R. Civ. P. 11(c) is governed by, and should not be filed in violation of, Fed. R. Civ. P. 11(b). If the Board finds that a motion for Fed. R. Civ. P. 11(c) sanctions itself violates the provisions of Fed. R. Civ. P. 11(b), an appropriate Fed. R. Civ. P. 11(c) sanction may be entered against the party that filed the motion.

Consequently, Petitioner’s petitions for sanctions on Registrant and Registrants attorneys is improper, as it clearly violated the Rules of Civil Procedure, as adopted by TMBP § 527.02, and thus should not be considered by the Board.

1. Registrant’s lawsuit against Petitioner did not fail on the merits.

As it did in the Federal Case, Petitioner continues to misrepresent the context and nature of the complaint here to this Board. When reading the entirety of the Complaint itself in context, it is clear that the Federal Case did not include claims of trademark infringement nor unfair competition against WT, but instead a related claim of civil conspiracy. See a true and accurate copy of the Complaint in the Federal Case with exhibits omitted, attached as “Exhibit 3”. Indeed, the Complaint itself acknowledges that WT has admitted to not using the Mark in commerce (and thus not having standing to bring this cancellation proceeding), and thus makes clear the nature of the claims. Id.

Petitioner further fraudulently misrepresents the nature of the outcome in the Federal Case by stating “Registrant knew at the time of filing its Complaint that the District Court would dismiss with prejudice Claim No. 2: Ohio Unfair Competition and Claim No. 3: Civil Conspiracy against Petitioner for lack of subject matter jurisdiction.” 28 TTABUE 7. This, simply put, is a fiction. The

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.