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

Proceeding no.	92080112
Party	Defendant Chipsticks LLC
Correspondence address	SCOTT MYERS CHIPSTICKS LLC 309 CALLE DE ANDALUCIA REDONDO BEACH, CA 90277 UNITED STATES Primary email: scottyemyers@gmail.com Secondary email(s): scottmyers@chipsticks.llc 310-924-0359
Submission	Response to Board Order/Inquiry
Filer's name	Scott Myers
Filer's email	scottmyers@chipsticks.llc
Signature	/Scott Myers/
Date	08/04/2022
Attachments	Reply To Order On Cancellation Proceedings Requiring Pleadings to Be Attached.pdf(179152 bytes) Complaint.pdf(299258 bytes) Defendant Response To Complaint.pdf(1727627 bytes) Defendant Second Motion To Dismiss.pdf(1318605 bytes) Opposition To Motion To Dismiss.pdf(5526974 bytes)

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RESPONSE IN SUPPORT OF MOTION TO SUSPEND PROCEEDING

PENDING CIVIL LITIGATION

Scott Myers, for Chipsticks LLC, hereby submits this reply in support of their motion for suspension of proceeding pending civil litigation for the reasons as follows.

As mentioned in the motion, this response will use the term “The Plaintiff” as referring to Scott Myers (Sole member and Legal Representative of Chipsticks LLC), and “The Defendant” as referring to Fiatte Kang.

Attached you will find the complaint filed in civil court case #2-22-cv-00737-FLA-PLAx. Please keep in mind that the complaint bears a different case number on the front. This was because it was transferred shortly into the process to a different judge, Fernando Aenlle-Rocha.

You will also find The Defendant’s answer to the complaint, The Defendant’s motion to dismiss, and The Plaintiff’s opposition with exhibits. Please

take careful note as to the judicial estoppel committed by The Defendant in her attempt to flip flop on likelihood of confusion.

This civil action commenced over 6 months ago. The Plaintiff filed the complaint alleging **trademark infringement**. This is not a trademark registration dispute. This is a **trademark infringement** dispute as filed in the complaint. “The PTO itself cannot decide issues of trademark infringement, either by way of injunctive relief or damages.” *Calista Enters. Ltd. v. Tenza Trading Ltd.*, No. 3:13-cv-01045-SI, at *8 (D. Or. Nov. 19, 2013). The Defendant has now attempted to challenge the validity of the mark. However, the trademark is deemed valid until proven otherwise by The Defendant. See *Bhasin v. C & H Clubs, Inc.*, 2017 WL 5973280 at *2 (C.D. Cal. July 28, 2017). “Second, the TTAB proceedings are subject to relitigation, which makes deferral to the TTAB inefficient where pending infringement claims are at issue.” *Calista Enters. Ltd. v. Tenza Trading Ltd.*, No. 3:13-cv-01045-SI, at *7 (D. Or. Nov. 19, 2013). Further, the cancellation of a registration does not invalidate the trademark. See 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:3 (4th ed. 2005).

It is well settled that those district courts have the authority to cancel trademarks if they deemed them invalid. See *15 U.S.C. § 1119*.

The Defendant has cited *Tigercat Int'l, Inc. v. Caterpillar Inc., No. 16-1047 (D. Del. May 2, 2018)*, as the only case law to support their reason for denying the motion to suspend and their attempt to get the civil proceedings suspended pending the TTAB outcome. However, the only reason why that case was suspended pending the TTAB proceeding was because of how far along the TTAB proceeding had gone before the start of the civil action. To reiterate, in that case a TTAB proceeding was already in progress before the civil action. However, the civil action here started months before this.

In that same case, “The TTAB proceeding has been pending for three years and was nearing completion at the time Tigercat filed its Complaint. (D.I. 7 at 2-3.) As noted above, discovery before the TTAB was extensive: consisting of 106 interrogatories, 172 document requests, 332 requests for admission, the production of 35,000 pages of documents, and 22 depositions.” *Tigercat Int'l, Inc. v. Caterpillar Inc.*, Civil Action No. 16-cv-1047-GMS, at *9 (D. Del. May 2, 2018). The Defendant says that “This is the same case here.” This isn’t remotely close to true.

The Defendant cites no other case law supporting their position. Again, the issue The Plaintiff, Scott Myers, raises is one of trademark infringement. This is

the action in civil court. The Defendant has decided to commit judicial estoppel and attempt to switch venues stating a validity defense. The Plaintiff also notes that the only reason why The Defendant initiated the proceeding was due to a threat to The Plaintiff. They threatened to only file the petition if The Plaintiff did not drop the civil litigation. This motion here isn't an attempt to make arguments as to whether the mark is valid or not as that would be determined in the civil court. However, the registration certificate "shall be prima facie evidence of the validity of the registered mark." See *15 U.S.C. § 1057(b)*. But again, the invalidity of a registration does not mean that there are no trademark rights.

If this suspension were denied it would be extremely prejudicial to The Plaintiff's rights to his trademark. In the same case as cited by The Defendant, "TigerCat, on the other hand, will not receive a binding and prompt declaration of its rights in its mark to which it is entitled. See *Rhoades*, 504 F.3d at 1164 ("[W]here as here, there is a potential infringement lawsuit, federal courts are particularly well-suited to handle the claims so that parties may quickly obtain a determination of their rights without accruing potential damages."); *Goya*, 846 F.2d at 854 ("Whether a litigant is seeking to halt an alleged infringement or, as in this case, seeking a declaration of non-infringement, it is entitled to have the infringement issue resolved promptly so that it may conduct its business affairs in

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