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

Proceeding	91190654
Party	Defendant Hidden Creations
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Attachments	6-8 Response to Opposer's Motion to Suspend_FINAL.pdf (6 pages)(448112 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 77/520,947
Published in the *Official Gazette* on December 16, 2008
Mark: SHAKE-N-GROW

OMS Investments, Inc.)	
)	Opposition No. 91190654
Opposer,)	
)	<u>APPLICANT'S RESPONSE TO</u>
)	<u>OPPOSER'S MOTION TO</u>
)	<u>SUSPEND</u>
)	<u>ON THE MERITS</u>
)	
)	
)	
v.)	
)	
Hidden Creations)	
)	
)	
Applicant.)	

Applicant's Response to Opposer's Motion to Suspend with Merits:

HIDDEN CREATIONS (Applicant) rejects Opposers argument to suspend this case to be reviewed by the related Federal civil proceeding of *OMS Investments, Inc. and The Scotts Company LLC v. Gail Smith*, Case No. 2:10-CV-01037 currently pending in the United States District Court Eastern District of California on the grounds of lack of federal subject-matter jurisdiction and a failure to present a justifiable case or controversy.

Applicant submits the following Points and Authorities:

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1. TTAB Proper Initial Jurisdiction: 15 U.S.C. §1067(a)

Applicant submits that any issues relevant to “trade dress,” color schemes, tarnishment, blurring etc. are to be heard first before the TTAB.

“(a) In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Director shall give notice to all parties and *shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.*” [Emphasis added]

Case Law: “An opposition to a registration may be initiated by “[a]ny person who believes that he would be damaged by the registration of a mark,” 15 U.S.C. Sec. 1063, and *the TTAB is established “to determine and decide the respective rights of registration” in contested proceedings,* 15 U.S.C. Sec. 1067.” Goya Foods,

Inc. v. Tropicana Products, Inc. (1988) 846 F.2d 848 at 852. [Emphasis added]

2. Appeal Only After TTAB Proceeding: 15 U.S.C. §1071(1)

An applicant for registration of a mark, *party to an interference proceeding,* party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section [1058](#) of this title, or an applicant for renewal, *who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit...*

3 . The Doctrine of Primary Jurisdiction in Trademark cases

"The doctrine of primary jurisdiction represents a version of the administrative exhaustion requirement under circumstances in which a judicially cognizable claim is presented but `enforcement of the claim requires the resolution of issues which, *under a regulatory scheme*, have been placed within the *special competence of an administrative body....*' United States v. Western Pacific R.R., 352 U.S. 59, 64, 77 S.Ct. 161, 165, 1 L.Ed.2d 126 (1956).

The rationale for the doctrine is two-fold. First, it ensures " '[u]niformity and consistency in the regulation of business entrusted *to a particular agency*.' " Nader v. Allegheny Airlines, Inc., 426 U.S. 290, 303-04, 96 S.Ct. 1978, 1987, 48 L.Ed.2d 643 (1976) (quoting Far East Conference v. United States, 342 U.S. 570, 574, 72 S.Ct. 492, 494, 96 L.Ed. 576 (1952)). Second, the doctrine is intended to recognize that, with respect to certain matters, "the expert and specialized knowledge of the agencies" *should be ascertained before judicial consideration of the legal claim*. United States v. Western Pacific R.R., supra, 352 U.S. at 64, 77 S.Ct. at 165." Goya Foods, Inc. at 851. Cited by: United States of America ex rel. R.C. Taylor III (2004) 345 F.Supp.2d 340

4. Decisions of TTAB is Controlling on Issues of Facts

"Thus, although the PTO's determination in the registration proceedings *is considered controlling in the civil action on issues of fact* "unless the contrary is established by testimony which in character and amount carries thorough conviction," Wilson Jones Co. v. Gilbert & Bennett Manufacturing Co., 332 F.2d 216, 218 (2d Cir.1964) (citations omitted), this ostensibly deferential standard is substantially qualified because "[t]he civil action before the District Court is intended to be a trial de novo." Id. "[W]hen registration

decisions of the Patent and Trademark Office are litigated in a district court pursuant to 15 U.S.C. Sec. 1071(b), the proceeding is virtually de novo, since additional cross-examination and presentation of additional testimony is permitted. The record made in the Patent and Trademark Office is admitted in evidence, but the fact finding of that office is not conclusive, nor is the court's consideration limited to that record." Continental Connector Corp. v. Continental Specialties Corp., supra, 413 F.Supp. at 1350 (citations omitted). See also American Bakeries Co. v. Pan-O-Gold Baking Co., supra, 650 F.Supp. at 567; Sonora Cosmetics, Inc. v. L'Oreal S.A., 631 F.Supp. 626, 629 (S.D.N.Y.), aff'd mem., 795 F.2d 1005 (2d Cir.1986); Sam S. Goldstein Industries, Inc. v. Botany Industries, Inc., supra, 301 F.Supp. at 731. Goya Foods, Inc. at 852, 853. [Emphasis added]

5. Declaratory Judgment of Suspension Not Binding on Appeal

Applicant proffers that any order granting suspension of this case if granted in error will not be binding on Appeal. In a 2009 case where the TTAB granted a motion to suspend the case while issues of infringement were still being determined by the PTO, the District Court reversed the Motion to Suspend:

"Wham-O subsequently filed a motion pursuant to Trademark Rule 2.117(a) (37 C.F.R. § 2.117(a)) and Trademark Board Manual of Procedure ("TBMP") § 510.02(a) *asking the TTAB to suspend* the cancellation proceedings pending the disposition of the civil action between the parties. The TTAB suspended the proceedings on March 19, 2009.

Manley moved to dismiss the declaratory-judgment action with prejudice based on: (1) lack of subject-matter jurisdiction; (2) the complaint's failure to present a case or controversy as required by Article III of the U.S. Constitution; and (3) the fact that the issues presented in

the case are identical to those pending before the TTAB.”

“The court held, however, that it lacked original jurisdiction over the case because “the courts do not have ‘jurisdiction under the Declaratory Judgment Act to determine the validity of [a] trademark where there is no issue of infringement.’” Wham-O, Inc. v. Manley Toys, Ltd., 2:08-cv-07830-CBM (C.D. Cal. Aug. 13, 2009)

http://www.finnegan.com/files/upload/Incontestable_Sep09_3.html

Wherefore, Applicant prays, based on the above Points and Authorities, that this Motion to Suspend be denied.

Dated: June 8, 2010

/s/Gail E. Smith Pro Se
Gail Smith Pro Se

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANTS RESPONSE TO THE OPPOSER'S MOTION TO SUSPEND WITH MERITS has been properly served on the OPPOSER via email addressed to ssking@manatt.com & patradmarks@manatt.com on this 8th day of June, 2010.

s. /Gail E. Smith/
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