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

Proceeding	91200327
Party	Plaintiff James Murta
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Submission	Motion to Amend Pleading/Amended Pleading
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 77886135

For the Mark: DERBY OF SAN FRANCISCO

_____)	
James Murta)	
)	
Petitioner)	
)	
v.)	OPPOSITION
)	PROCEEDING No. <u>91200327</u>
Victor Suarez)	
)	
Registrant)	
_____)	

/Kurt Leyendecker/
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AMENDED NOTICE OF OPPOSITION

Opposer James Murta (hereafter “Opposer”), a U.S. citizen located in Littleton, Colorado and having a mailing address of P.O. Box 620906, Littleton, CO 80162, believes he will be damaged by the registration of U.S. Application Serial No. by Victor Suarez (hereafter “Applicant”) of 741 Crestview Dr., Millbrae, CA 94030 for the mark DERBY OF SAN FRANCISCO in International Class 25 and hereby opposes the registration thereof.

GROUND FOR OPPOSITION:

As specifically and particularly provided for below, the Opposer alleges Applicant (i) committed fraud upon the Trademark Office in the filing and prosecution of Application No. 77886135 and (ii) applicant was not actively using the mark in commerce with any of the identified goods as of the application filing date. Therefore the subject mark, DERBY OF SAN FRANCISCO is not deserving of registration. Registration of the Applicant’s mark will hinder or prevent the allowance and eventual registration of the Opposer’s Intent to Use Application serial No. 77905692 for a similar mark, DERBY OF SAN FRANCISCO. Prosecution of the Opposer’s application has been suspended pending the disposition of the Applicant’s Application.

Statement of Facts

1. Applicant filed Trademark Application serial No. 77886135 (hereafter “Application”) for a Design plus the words DERBY OF SAN FRANCISCO (hereafter “the Mark”) on December 4, 2009 claiming use of the mark for hats,

jackets, jeans, pants, shirts and sweatshirts. The Applicant claimed a first use in commerce date and first use in interstate commerce date of August, 1997.

2. The Applicant provided specimens in support of his Application at the time of filing consisting of three photographs.
3. Each of the photos presented as specimens are labeled on the lower right hand corner with the name "CAPT. SPALDING."
4. On information and belief, CAPT. SPALDING. is the moniker of Stephen Haron, an ebay seller of vintage clothing.
5. On information and belief, Applicant does not have any association with CAPT. SPALDING.
6. On information and belief, Applicant obtained the three photos he used for his specimens from an ebay listing of a vintage Derby of San Francisco jacket sold by Capt. Spalding. in an auction that ended on Nov. 24, 2009.
7. On information and belief, Applicant was not using the Mark in interstate commerce as of December 4, 2009 in conjunction with shirts.
8. On information and belief, Applicant was not using the Mark in interstate commerce as of December 4, 2009 in conjunction with sweatshirts.
9. On information and belief, Applicant was not using the Mark in interstate commerce as of December 4, 2009 in conjunction with jackets.
10. On information and belief, Applicant was not using the Mark in interstate commerce as of December 4, 2009 in conjunction with pants.
11. On information and belief, Applicant was not using the Mark in interstate commerce as of December 4, 2009 in conjunction with hats.

12. Applicant maintains a website and blog at the domain derbyofsanfrancisco.com.

13. On October 24th, 2010, Applicant posted a Blog article discussing his efforts to bring the jacket to market. Applicant wrote:

... I thought I would start blogging and spilling the beans on updates on this jacket. ... So Mojo Labs has just boxed up all the components of the Jacket and we are sending it to the manufactures. ... See the thing about the lining and many parts of the Jacket are that it used to be manufactured in the good ol' USA but most of the suppliers sold their equipment to overseas companies or just shut down and closed the doors. I have a list of each supplier for each part of the jacket when it was produced here but all are out of business.

So it brings us to this cross road of starting from scratch. ... Where the hell do I begin? Well we began and finished. Now it goes to where it goes and gets made!

When will it be done? Spring 2011 (I hope)

14. On October 24th, 2010, Applicant posted another Blog article discussing his efforts to bring the jacket to market. Applicant wrote:

...

Today was an important meeting for Derby.... All items were sent out to the manufactures!

Today I have a better feeling in my stomach when I say "Spring 2011"!

15. On November 23, 2010, Applicant posted a Blog Article in response to a question posed to him. He wrote:

... Im not ging to stop at the classic bomber. I have plans on a few items just to have merchandise for the website but it won't be anything cheesy. I am in the process of contacting New Era for a line of cool hats which I have very very talented artists who work for many known companies. ... I do plan on a number of T-Shirts with images. and I am in the works having Rickshaw (richshawbags.com) create a Derby messenger bag for us. I do plan on a few Letterman, herringbone ool, Hemp,Leather Derby's. ...

16. On February 7, 2011, NAIDAJoy posted a Blog Article indicating a desire to buy a derby jacket and asking whether the jacket will be available by Christmas.

She wrote:

... Can you give me an idea when these jackets will be available for purchase and a price range. My husband wants one for Christmas and is willing to wait, but depending on when they are coming out I may the jacket for his birthday or another celebration.

17. On February 7, 2011, Applicant posted a Blog Article in response to the question referenced in the previous paragraph. He wrote:

We are in the process of opening right now and yes we will have the Jacket in red. When? I cannot answer that exactly!

18. In the first quarter of 2011, Applicant created a profile at Convozine.com, a website. According to the site it is “an expanding network of zines that lets people create and share content, upload images, find the new/important/awesome --- and be part of diverse, growing communities built around what they’re interested in.” Applicant published the following profile:

I'm not to sure what it is I need to put in this white rectangle with it's little black outline, but I will try and see if my ADHD won't kick in. This Zine is going to show what myself as a business owner is going thru in the trying to form and brand Derby again as well as daily business. Will I be able to accurately tell the stories which I encounter? Will I be able to translate what visions and experiences I have properly? Wow, This should be an experience. Will a 10th grade drop out be able to do this? Yeah... This should be a breeze.

Emphasis added.

19. On March 13, 2011, Applicant published an article at convozine.com entitled “Perseverance”. In the article, the Applicant wrote:

... But here are a few quotes I found in the first few chapters

that I will share with you and give my "Art Of War" commentary!

...

2. "Some people chose their path in life. Some people have it thrust on them. And then there are some who discover their calling almost by accident, never having looked for it"

-Over the past 15 or so years I have printed Derby shirts, stickers, and other little knick nacks. But oneday I said "I'm going to make this jacket".

... No I don't think everyone will love the products I introduce. No I don;t think everyone is happy with the progress of the jacket and the brand. No I don't think it will be perfect and the best thing since sliced bread. No I don't think about listening to people and their negative comments. No I don't think I will cater to anyone's time lines or deadlines, it will get done when it is ready, when it perfect.

20. On March 13, 2011, Applicant published an article at convozine.com entitled "The Reveal". The article pertained to Applicant's release and sale of a single messenger bag. In the article, the Applicant wrote:

... So people have been asking me when will I release this Jacket. To be honest with you I was trying to hold out until "Cinco De Mayo". That is where my heart is set. Derby is like a sand castle. It takes time to build one, it takes creativity to sculpt one, and yes, it can crumble if not done right.

...

It has a velcro lock on the front. We used the traditional lining form a Derby Jacket which has an awesome paisley which is copyrighted by the United States Copyright Center. Almost like a Nike Swoosh! So you know it is original and only made by us. We have thousands of yard of this material and will do some cool stuff with it in the future. I just dislike someone calling me a liar. I will only sell one of these. It is being announced here on Convazine which I am beginning to love.

you can bid on the bag here.....<http://tinyurl.com/derbysfbag>

We hope you enjoy this awesome one of a kind (for a few months) messenger bag!

21. On 12/07/2009, Applicant posted a thread on Yelp.com entitled “Derby of San Francisco Back in Business as of December 1st 2009 in which he discusses his plans to manufacture and sell a derby-style jacket. Applicant wrote:

As of December 1st 2009 we have begun the process of bringing back the DERBY. We will be manufacturing the original DERBY OF SAN FRANCISCO Jacket with original art, metal zippers, correct tags and leathers and the best part of it? THEY WILL ALL BE MANUFACTURED HERE IN SAN FRANCISCO! We found one of the original manufactures of the jackets from the 60's and he is very excited as well as us for bringing this jacket back. We will start with BLACK, UPS BROWN, NAVY, GREY, TAN, AND WE WILL ADD RED AND WHITED QUANTITIES. WE MAY ALSO ADD A PINK AND LIGHT BLUE FOR WOMEN. We are open to any pre-production suggestions you may have. We hope to bring a little bit of San Francisco history back to the city!

22. In an October 8, 2010 facebook post, the Applicant wrote that the jacket is scheduled to be released in the Spring of 2011.

23. In a December 9, 2010 facebook post, Applicant indicated that he was contemplating selling his prototype 2XL black derby on ebay stating that **“it would be the first jacket to be made in over 25 years ...”** (emphasis added).

24. On February 13th, 2011 facebook post, Applicant wrote that they were getting very close and that in a few days “you will be able to reserve your derby”; he also wrote in a comment that “any reservations before the time it is released won’t be honored”.

25. In an April 20, 2011 facebook post, Applicant indicated that the production on the jacket’s zipper was to be delayed at least 90 days.

26. In a June 13th, 2011 facebook post, the Applicant wrote that the design for his jacket's zipper by YKK of Japan was complete and ready for his approval. He further indicated that the jacket should be done in 45-90 days.
27. In an office action issued on March 16, 2010, the Examiner found the mark to be one or the other of Geographically Deceptive and Geographically Deceptively Misdescriptive.
28. In an office action response dated August 6, 2010, the applicant responded stating that the rejection was inappropriate since the identified goods "are produced in the San Francisco area".
29. As of the date of the office action response indicating that the good's were to be made in San Francisco, the applicant had not made any of the listed goods in San Francisco.
30. In a facebook post dated Nov 11, 2011, applicant wrote that the Derby of San Francisco jackets were being made overseas. Applicant further lamented that textile companies don't exist in the U.S. anymore.

ARGUMENTS FOR REFUSING REGISTRATION:

31. Applicant committed fraud in both the filing of the Application and the prosecution thereof making multiple material false statements with the intent to deceive the Patent and Trademark office as evidenced by the facts provided. Three instances of fraud are pled with particularity below. Applicant also had no bono fide use of the mark in commerce as to the listed goods as of the date of the application's filing. Finally in the alternative, even if the Applicant had sold

goods prior to the filing date, the goods were one of Geographically Deceptive and Geographically Deceptively Misdescriptive.

I. Applicant committed fraud on the USPTO by listing goods he was not selling under the Mark in the Application

32. In filing the Application, Applicant directly and through his filing attorney, knowingly listed shirts, sweatshirts, jackets, pants and hats as goods with which the Mark was being used in commerce at least as early as the time of filing.
33. Considering jackets, statements made by the Applicant various media as described above and presented in the various exhibits clearly indicate that the Applicant had not sold a jacket prior to the filing of the Application. One of the most telling statements appeared in a facebook comment posted by Applicant as described in paragraph 23 wherein he essentially indicates that if he sold a prototype on ebay, it would be the first Derby of San Francisco jacket sold in 25 years.
34. The Application was filed by Applicant's attorney, Matthew Swyers, an experienced trademark attorney who based on a TESS system search has filed over 2800 federal trademark applications. Mr. Swyers clearly has and had knowledge concerning the legal requirements of trademark applications generally and specifically, the requirement that the Mark needed to be in use with reference to each good listed in the recitation of goods on the Application at the time of filing. Mr. Swyers no doubt informed his client of the legal requirements concerning the listing of goods in a 1(a) application.

35. Considering Applicant had knowledge of the legal requirements concerning the listing of goods in a trademark application and considering that he had not sold or was not currently selling all or some of the listed goods in commerce, Applicant intentionally deceived the Trademark Office by filing the Application with the listed set of goods. Alternatively, if Mr. Swyers did not properly advise Applicant of the legal requirements concerning the listing of goods, he did so with reckless disregard for the law, his ethical duties to his state bar and the United States Trademark Office and his client. Since Mr. Swyers was acting as the legal agent of the Application this reckless disregard is imputed to the Applicant. This reckless disregard concerning the submission of the Application also demonstrates intent to deceive.

II. Applicant committed Fraud on the USPTO by providing as a specimen a jacket that Applicant had not produced or sold.

36. In responding to the Office Action of March 10, 2011,

37. Applicant knew that he did not manufacture and/or sell the specific jacket listed and shown in the specimen photographs. Applicant further knew that the trademarks shown in the photos were not his own but rather the marks of the original manufacturer of the Derby of San Francisco jacket.

38. Applicant actively captured the specimen photographs from a listing on ebay by another and provided those photographs to his attorney for inclusion in the Application as specimens.

39. Applicant through his attorney declared that the specimens to be of a jacket with the trademark on the label and tag.
40. Despite the foregoing knowledge, Applicant intentionally deceived the Trademark Office by filing the Application with specimens showing a jacket that he did not manufacture or sell. Alternatively, the Applicant exercised reckless disregard for the legal requirements concerning the submission of specimens in the Application. This reckless disregard concerning the submission of the Application also demonstrates intent to deceive.

III. Applicant committed fraud on the USPTO when he knowingly represented the listed goods were made in San Francisco.

41. In response to the Office Action of March 10, 2010, applicant represented to the Examiner that the listed goods were made in the San Francisco area when as of the date of the response the listed goods had been made overseas or had not been made at all.
42. The misrepresentation was material in overcoming a rejection proffered by the Examiner that the use of the mark in relation of the listed goods were one of Geographically Deceptive and Geographically Deceptively Misdescriptive.

IV. There was no bona fide use of the mark in commerce prior to the filing date of the use-based application concerning one or more of the listed goods.

V. The use of the mark on one or more of the listed goods is alternatively Geographically Deceptive and Geographically Deceptively Misdescriptive

43. The applicant erroneously represented to the Examiner in a response to a rejection in the alternative for being Geographically Deceptive or Geographically Deceptively Misdescriptive that the listed goods were made in the San Francisco area.

44. In response to the applicant's representation the rejection was lifted.

WHEREFORE:

Opposer, by counsel, prays that the opposition be granted and the registration of the Application be denied.

LEYENDECKER & LEMIRE LLC,
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Date 011/23/11

CERTIFICATE OF SERVICE

I, Kurt P. Leyendecker, Esq., certify that on this 23rd day of November, 2011, a true and correct copy of the foregoing was filed with the Trademark Trial and Appeal Board via the Electronic System for Trademark Trials and Appeals and was sent by U.S. Mail to:

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