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

Proceeding	91202802
Party	Defendant Reson A/S
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Submission	Motion to Suspend for Civil Action
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Signature	/Richard Z. Lehv/
Date	04/30/2012
Attachments	Opposition to Motion to Suspend (F1002123).PDF ( 14 pages )(553541 bytes )

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

R2SONIC, LLC,

Opposer

-against-

RESON A/S,

Applicant.

Opposition No. 91202802

**APPLICANT'S BRIEF  
IN OPPOSITION TO OPPOSER'S MOTION  
FOR SUSPENSION**

On April 11, 2012, Opposer, R2Sonic, LLC, moved to suspend this opposition proceeding pursuant to 37 C.F.R. §2.117(a), pending a civil action between the parties. Applicant, Reson A/S, opposes the motion to suspend because, as set forth in detail below, the civil action does not involve the trademark involved in this opposition. Thus, the civil action has no bearing on any issues before the Board.

**FACTUAL BACKGROUND**

**I. PARTIES**

Applicant is a leading manufacturer of high quality underwater acoustic systems, specializing in the design and development of sonar equipment, echo sounders, transducers, hydrophones, and accompanying software. Applicant owns U.S. Trademark Registration No. 3,382,049 for the mark RESON for underwater acoustic systems and computer software in the field of underwater acoustics in International Class 9 and related services in International Class 42.

In addition, Applicant has filed Application Serial No. 79/088,219, to register a design mark consisting of "three semi-circles that are stacked vertically and appear like sound waves, each

progressively getting smaller. There are two curved lines connected to the largest semi-circle at the bottom,” as shown here:



for use with various underwater acoustic systems and computer software for use in underwater acoustics in International Class 9, and related services in International Class 42, (the “Design Mark”). The Design Mark is the subject of this opposition.

Opposer is in the business of making and selling products for the underwater acoustics market, including sonar equipment. (Opposer’s Brief at 1). Opposer engages in this business under the name and mark R2SONIC. Opposer also uses the following stylized version of its mark in connection with its business.



(Opposer’s Brief at 3).

## **II. OPPOSITION PROCEEDING**

On November 30, 2011 Opposer initiated this proceeding by filing a Notice of Opposition to Application Serial No. 79/088,219, the Design Mark, alleging that the Design Mark “is merely descriptive” of Applicant’s claimed goods. (Notice of Opposition at ¶¶ 6, 8). The only issue before the Board in this proceeding is whether the Design Mark “is merely descriptive” under Section 2(e)(1) of the Lanham Act. (Notice of Opposition at ¶ 7).

## **III. CIVIL ACTION**

On February 24, 2010, over one and a half years before this Opposition was filed, Applicant filed a civil action against Opposer and other defendants in Superior Court of the State of California for the County of Santa Barbara, Case. No. 1342087 (the “Civil Action”). Applicant alleged in its complaint, in pertinent part, that Opposer infringed Applicant’s RESON mark

because its name, R2SONIC, “is stylized and designed to look confusingly similar to the name ‘RESON.’” (Opposer’s Brief at Exhibit A, ¶ 48). In its Answer in the Civil Action, attached hereto as Exhibit 1, Opposer alleged that “there is no likelihood of confusion between the ‘R2Sonic’ mark and the alleged ‘Reson’ mark as they are used in commerce.” (Exhibit 1 at ¶ 15). The Design Mark at issue in this opposition is not mentioned in the complaint or answer in the Civil Action. Accordingly, the likelihood of confusion between the R2SONIC and RESON marks is the only trademark-related issue in the Civil Action. The Design Mark is not involved in the Civil Action.

### ARGUMENT

Because the marks involved in the Civil Action, namely RESON and R2SONIC, are completely different from the Design Mark now before the Board, there is no reason whatsoever to suspend this opposition proceeding. Opposer’s arguments to the contrary are contrived, speculative and belied by its pleadings in the Civil Action.

Trademark Rule 2.117(a) provides that “[w]hensoever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding *which may have a bearing on the case*, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.” 37 C.F.R. § 2.117(a) (emphasis added). Thus, Rule 2.117(a) sets out a condition precedent to any suspension, namely, that the civil action “may have a bearing” on the Board proceeding.

This condition has been interpreted by the Board, in the very case cited by Opposer, as requiring that the civil action “*involve[e] the same mark* or the opposed application.” *New Orleans Louisiana Saints LLC and NFL Properties v. Who Dat?, Inc.* 99 U.S.P.Q. 2d 1550 (T.T.A.B. 2011) (emphasis added). Moreover, “the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board’s decision in the opposition.” *Id.* Here, scrutiny of the pleadings shows that the Design Mark is *not* involved in the Civil Action. The Civil Action involves only the marks RESON and

R2SONIC (Opposer's Brief at Exhibit A, ¶ 48; Exhibit 1 at ¶ 15), not the Design Mark. Opposer has not cited any decisions in which the Board suspended an opposition where the mark in the opposition was *not* involved in the civil action, and we have been unable to find any such decisions.

Opposer tries to conjure up a purported connection between the Civil Action and this opposition proceeding, by making completely speculative arguments. It argues that the Civil Action could have some bearing on this proceeding because one embodiment of Applicant's RESON mark includes the Design Mark adjacent to the word RESON, as shown below.



(Opposer's Brief at 3). Although Opposer claims that it "*expects to demonstrate* [the] nondistinctiveness" (emphasis added) of the Design Mark in the Civil Action, this seems implausible, since the Design Mark is not the subject of any claim in the pleadings in the Civil Action.

The issue before the California court is whether Opposer's R2SONIC trademark infringes Applicant's RESON trademark. (Opposer's Brief at Exhibit A, ¶ 48; Exhibit 1 at ¶ 15). It is not at all clear why, in the context of examining these two marks, the court would opine on the protectability of a design element found in one embodiment of the RESON mark that *is not* found in the R2SONIC mark, which is shown on page 2, above. Accordingly, the California court would have no basis for examining whether Applicant's Design Mark is protectable, and Opposer has not made any allegations on that issue in the Civil Action.

As the Board explained in its *Who Dat?* decision, a suspension is warranted only where a "decision by the district court may be binding on the Board." 99 U.S.P.Q. 2d at 1550. A court decision will be binding on the Board if an issue in the Board proceeding "was raised, litigated, and actually decided" by the court. *Checkpoint Sys., Inc. v. Check Point Software Technologies, Ltd.*, Opposition Nos. 102,309; 105,259, 2002 WL 1181046 (T.T.A.B. May 31, 2002) (*citing Jet*

*Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1365-1366; 55 USPQ2d 1854, 1859 (Fed. Cir. 2000)). Such “[i]ssue preclusion is applicable when it is shown that there is an identity of the issues between the present proceeding and a prior proceeding; that the issues were actually litigated in the prior proceeding; that the determination of the issues was necessary to the resulting judgment in the prior proceeding; and that the party defending against preclusion had a full and fair opportunity to litigate the issues in the prior proceeding.” *Id.* As demonstrated above, Opposer’s argument fails on all counts. There is no identity of the issues between the Civil Action and this proceeding, because they involve different marks and different legal claims. The issue of protectability of the Design Mark cannot be found anywhere in the parties’ pleadings. And consideration of the issue of protectability of the Design Mark is unnecessary for the resolution of the issues actually before the California court, namely, the likelihood of confusion between RESON and R2SONIC marks. Accordingly, the Civil Action will have no *res judicata* effect in this opposition proceeding. Suspending this opposition will only prejudice Applicant as it will create a prolonged delay and uncertainty as to the resolution of Opposer’s claims concerning the validity of Applicant’s Design Mark.

### **CONCLUSION**

Because the Civil Action concerning the parties RESON and R2SONIC marks will have no

bearing on this opposition proceeding concerning the Design Mark, the Board should deny Opposer's motion to suspend.

Respectfully submitted,

Dated: New York, New York  
April 30, 2012

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 

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Alexander L. Greenberg  
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*Attorneys for Applicant Reson A/S*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 30th day of April 2012, I caused a true and correct copy of the foregoing Applicant's Brief in Opposition to Opposer's Motion for Suspension to be served by First Class U.S. mail, postage prepaid, on the correspondent of record, Jane Shay Wald, Irell & Manella LLP, 1800 Avenue of the Stars, Suite 900, Los Angeles, CA 90067.

  
Alexander L. Greenberg

# Exhibit 1

1 SEED MACKALL LLP  
2 1332 ANACAPA STREET, SUITE 200  
3 POST OFFICE BOX 2578  
4 SANTA BARBARA, CALIFORNIA 93120  
5 TELEPHONE: (805) 963-0669  
6 TELEFAX: (805) 962-1404  
7 Peter A. Umoff, Bar No. 091220  
8 Alan D. Condren, Bar No. 180624  
9 Attorneys for Defendants R2Sonic, LLC,  
10 Jens Steenstrup, Mark Chun, Kirk Hobart,  
11 Cris Sabo, and Charles Brennan

**FILED**  
SUPERIOR COURT of CALIFORNIA  
COUNTY of SANTA BARBARA

MAR 26 2010

GARY M. BLAIR, Executive Officer  
BY Joseph Garnica  
JOSEPH GARNICA, Deputy Clerk

8 SUPERIOR COURT, STATE OF CALIFORNIA  
9 COUNTY OF SANTA BARBARA, ANACAPA DIVISION

11 RESON A/S and RESON, INC., a California ) Case No. 1342087  
12 Corporation, )  
13 ) (Assigned For All Purposes To Judge  
14 Plaintiffs, ) George C. Eskin, Dept. 5)  
15 v. )  
16 R2SONIC, LLC, a California Limited ) ANSWER TO UNVERIFIED  
17 Liability Company; JENS STEENSTRUP, ) COMPLAINT  
18 an individual; MARK CHUN, an individual; )  
19 KIRK HOBART, an individual; CRIS )  
SABO, an individual; CHARLES )  
BRENNAN, an individual; and DOES 1 )  
through 100, inclusive, )  
Defendants. )

Complaint filed: February 24, 2010

20 COME NOW Defendants R2Sonic, LLC, Jens Steenstrup, Mark Chun, Kirk Hobart, Cris  
21 Sabo, and Charles Brennan (collectively referred to as the "Answering Defendants"), and for  
22 themselves and no other Defendant, answer the unverified Complaint filed herein by Plaintiffs  
23 Reson A/S and Reson, Inc., as follows:

24 GENERAL DENIAL

25 1. Pursuant to the provisions of Code of Civil Procedure § 431.30, the Answering  
26 Defendants deny, generally and specifically, each and every allegation contained in the Complaint,  
27 and specifically deny that Plaintiffs are entitled to any relief whatsoever by reason of any act,  
28 negligence, carelessness, breach of duty, or omission on the part of these Answering Defendants.

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**FIRST SEPARATE DEFENSE**

2. The Complaint fails to state facts sufficient to constitute a cause of action.

**SECOND SEPARATE DEFENSE**

3. Plaintiffs lack standing to assert the causes of action alleged in the Complaint.

**THIRD SEPARATE DEFENSE**

4. Plaintiffs are barred from any relief by the applicable statutes of limitation.

**FOURTH SEPARATE DEFENSE**

5. Plaintiffs are barred from any relief by the doctrine of laches.

**FIFTH SEPARATE DEFENSE**

6. Plaintiffs are barred from any relief by the doctrine of estoppel.

**SIXTH SEPARATE DEFENSE**

7. Plaintiffs are barred from any relief by the doctrine of waiver.

**SEVENTH SEPARATE DEFENSE**

8. Plaintiffs are barred from any relief by the doctrine of unclean hands.

**EIGHTH SEPARATE DEFENSE**

9. Plaintiffs are barred from any relief by the doctrine of preemption.

**NINTH SEPARATE DEFENSE**

10. Plaintiffs are barred from any relief by the doctrine of acquiescence.

**TENTH SEPARATE DEFENSE**

11. Plaintiffs are barred from any monetary recovery because they have not lost money or property as a result of any alleged unfair competition.

**ELEVENTH SEPARATE DEFENSE**

12. Plaintiffs are not entitled to injunctive or equitable relief because they will not suffer irreparable harm.

**TWELFTH SEPARATE DEFENSE**

13. Plaintiffs are not entitled to injunctive or equitable relief because they have an adequate remedy at law.

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**THIRTEENTH SEPARATE DEFENSE**

14. Plaintiffs are barred from any relief because their alleged trademark is invalid.

**FOURTEENTH SEPARATE DEFENSE**

15. Plaintiffs are barred from any relief because there is no likelihood of confusion between the "R2Sonic" mark and the alleged "Reson" mark as they are used in commerce.

**FIFTEENTH SEPARATE DEFENSE**

16. Plaintiffs are barred from any relief because there is no likelihood that the potential customers of Plaintiffs will be confused or misled as to whether the source of Defendants' products is associated with, endorsed by, or sponsored by Plaintiffs.

**SIXTEENTH SEPARATE DEFENSE**

17. Plaintiffs are barred from any relief because they cannot demonstrate that their alleged mark has been damaged or harmed.

**SEVENTEENTH SEPARATE DEFENSE**

18. Plaintiffs are barred from any relief because Plaintiffs' alleged trade dress is functional, not distinctive, has not acquired secondary meaning, and is incapable of legal protection.

**EIGHTEENTH SEPARATE DEFENSE**

19. Plaintiffs are barred from any relief because damages, if any, are speculative.

**NINETEENTH SEPARATE DEFENSE**

20. Plaintiffs are barred from any relief because their alleged trademark is not inherently distinctive and has not acquired secondary meaning.

**TWENTIETH SEPARATE DEFENSE**

21. Plaintiffs are barred from any relief by the doctrine of fair use.

**TWENTY-FIRST SEPARATE DEFENSE**

22. Plaintiffs are barred from any relief to the extent Plaintiffs are required to submit their causes of action to binding arbitration.

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1 WHEREFORE, Answering Defendants pray for judgment against Plaintiffs as follows:

- 2 1. That Plaintiffs are not entitled to any relief by virtue of their Complaint;  
3 2. For Answering Defendant's costs of suit and attorneys' fees incurred herein; and,  
4 3. For such other and further relief as the Court deems proper.

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6 DATED: March 26, 2010

SEED MACKALL LLP

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By: 

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Peter A. Umoff

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Alan D. Condren

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Attorneys for Defendants R2Sonic, LLC,  
Jens Steenstrup, Mark Chun, Kirk Hobart,  
Cris Sabo, and Charles Brennan

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PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF SANTA BARBARA:

I am employed in the County of Santa Barbara, State of California. I am over the age of 18 years and not a party to the within action; my business address is 1332 Anacapa Street, Suite 200, Santa Barbara, CA 93101.

On March 26, 2010, I served the foregoing document described as **ANSWER TO UNVERIFIED COMPLAINT** on interested parties in this action by placing true copies thereof enclosed in sealed envelopes addressed as stated on the attached Service List as follows:

       (BY MAIL) I deposited such envelope in the mail at Santa Barbara, California. The envelope was mailed with postage thereon fully prepaid.

  X   (BY MAIL) I am "readily familiar" with the firm's practice of collecting and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Santa Barbara, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

       (BY PERSONAL SERVICE) I delivered such envelope by hand to the offices of the addressee.

  X   (State) I declare under penalty of perjury under the laws of the State of California that the above is true and correct. Executed on March 26, 2010, at Santa Barbara, California.

  
Cynthia J. Kantor-Schumacher

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SERVICE LIST

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