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

Proceeding	92060348
Party	Plaintiff BuzzBallz, L.L.C.
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Attachments	Response to Show Cause Order.pdf(124008 bytes )

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

3 RE:    U.S. Trademark Registration No. 4618174 and 4646160  
4        Registered on October 7, 2014 and November 25, 2014

5 BuzzBallz, L.L.C.

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6        Petitioner,

§

§

7 v.

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Cancellation No. 92060348

Cancellation No. 92061050

8 BuzzBox Beverages, Inc.

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9        Registrant.

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10                   **PETITIONER’S RESPONSE TO THE BOARD’S ORDER TO SHOW CAUSE**

11 Commissioner for Trademarks  
12 P.O. Box 1451  
13 Alexandria, Virginia 22313-1451

14 To the Commissioner for Trademarks:

15                   **COMES NOW**, Petitioner BuzzBallz, L.L.C. who files this Response to the Board’s Order  
16 to Show Cause (the “Response”) and, in support of such Response, would show as follows:

17                   **I.        PROCEDURAL BACKGROUND**

18                   1.        On or about May 11, 2015, the Board consolidated and jointly suspended these  
19 cancellation proceedings pending disposition of the civil lawsuit between the parties filed under  
20 Case No. 5:14-cv-01725 in the United States District Court Central District of California (the  
21 “Civil Action”).

22                   2.        On or about June 27, 2016, the Court entered its Judgment on the Verdict in the  
23 Civil Action (the “Judgment”), wherein it held (i) that Registrant’s use of its word mark “BUZZ-  
24 BOX” (the subject of Registration No. 4618174, the involved registration in Cancellation No.

1 92060348) (the “BuzzBox Text”) has not caused a likelihood of confusion with the  
2 “BUZZBALLZ” marks in Petitioner’s pleaded Registration Nos. 3865524 and 4498235 (the  
3 “BuzzBallz Marks”); and (ii) that Registrant’s use of its graphic mark for the term “BUZZBOX”  
4 (the subject of Registration No. 4646160, the involved registration in Cancellation No. 92061050)  
5 (the “BuzzBox Graphic”) has caused a likelihood of confusion with the BuzzBallz Marks. Said  
6 Judgment was thereafter provided to the Board by Petitioner.

7 3. On or about August 11, 2016, the Board issued its show cause order, indicating  
8 that, based on the Judgment, it would be dismissing with prejudice Cancellation No. 92060348  
9 unless Petitioner showed cause why it should not be so dismissed and that it would be sustaining  
10 Cancellation No. 92061050 unless Registrant showed cause why it should not be so sustained.

11 4. Accordingly, Petitioner comes now to show cause why Cancellation No. 92060348  
12 should not be dismissed with prejudice but that an amendment of Registration No. 4618174 should  
13 be ordered to avoid confusion, as follows:

## 14 II. ARGUMENTS & AUTHORITIES

15 5. Cancellation No. 92060348 should not be dismissed and Registration No. 4618174  
16 should be amended in that, because the BuzzBox Text is without claim to any particular font, style,  
17 size, or color, the BuzzBox Text arguably encompasses the expression of the term “BUZZBOX”  
18 set forth in the BuzzBox Graphic, which the Judgment held infringed the BuzzBallz Marks. That  
19 is, because the BuzzBox Graphic is merely a stylized expression of the BuzzBox Text and such  
20 stylized expression has been found infringing, the BuzzBox Text should be amended to explicitly  
21 disclaim such expression to avoid any confusion, now or in the future, as to whether the owner of  
22 the BuzzBox Text may use the expression of that mark as found in the BuzzBox Graphic without  
23 infringement.

1           6.       “Under Trademark Act § 18, 15 U.S.C. § 1068, the Board has the authority to cancel  
2 registrations in whole or in part, to restrict the goods or services identified in an application or  
3 registration, or ‘to otherwise restrict or rectify...the registration of a registered mark.’ TBMP  
4 § 309.03(d) (emphasis added). Additionally, 37 CFR § 2.133(b) provides:

5                     If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds  
6 that a party whose application or registration is the subject of the proceeding is  
7 not entitled to registration in the absence of a specified restriction to the in-  
8 volved application or registration, the Board will allow the party time in which  
to file a motion that the application or registration be amended to conform to  
the findings of the Board, failing which judgment will be entered against the  
party.

9           7.       In this case, the Court in the Civil Action, which has concurrent jurisdiction with  
10 the Board to order cancellation or amendment of a registration, *see* 15 U.S.C. § 1119; *Phillip*  
11 *Morris USA, Inc. v. King Mountain Tobacco Co., Inc.*, 569 F.3d 932, 944 (9th Cir. 2009), has  
12 found that a specific expression of the term “BUZZBOX”—namely, the BuzzBox Graphic—in-  
13 fringes the BuzzBallz Marks. Because the BuzzBox Text is “without claim to any particular font,  
14 style, size, or color,” it implicitly includes the expression of the term “BUZZBOX” in the BuzzBox  
15 Graphic, which has been found to be infringing. Accordingly, pursuant to the Board’s authority  
16 under 15 U.S.C. § 1068, the BuzzBox Text should be amended to disclaim the expression of the  
17 term “BUZZBOX” set forth in the BuzzBox Graphic to avoid any suggestion that such expression  
18 may be used by the holder of the BuzzBox Text without infringement of the BuzzBallz Marks.  
19 For these reasons, Petitioner submits that there is good cause that Cancellation No. 92060348 not  
20 be dismissed with prejudice and requests that the Board amend Registration No. 4618174.

21           8.       Alternatively, to the extent the Board declines to exercise its authority under 15  
22 U.S.C. § 1068 and 37 CFR § 2.133(b), Petitioner respectfully requests that Cancellation No.  
23 92060348 be suspended for not less than sixty (60) days to permit Petitioner the opportunity to  
24

1 seek an order from the Court in the Civil Action requiring an amendment of Registration No.  
2 4618174 in accordance with its Judgment.

3 **III. PRAYER**

4 **WHEREFORE, PREMISES CONSIDERED,** Petitioner BUZZBALLZ, L.L.C. prays  
5 that the Board not dismiss Cancellation No. 92060348 with prejudice and order Registration No.  
6 4618174 to be amended to specifically disclaim the expression of the term “BUZZBOX” set forth  
7 in Registration No. 4646160. Alternatively, Petitioner prays that the Board suspend Cancellation  
8 No. 92060348 to permit Petitioner to seek an order of amendment from the Court in the Civil  
9 Action. Petitioner prays for such further relief, at law or in equity, to which it is entitled.

10 **DATED:** September 9, 2016

11 Respectfully submitted,  
**WILSON LEGAL GROUP P.C.**

12 By: /s/John T. Wilson

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17 **ATTORNEY FOR PETITIONER**  
18 **BUZZBALLZ, L.L.C.**

