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

Proceeding	92060464
Party	Plaintiff Safeside Tactical, LLC
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Submission	Opposition/Response to Motion
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Date	11/25/2015
Attachments	Petitioners Opposition to Respondents Motion to Reopen Time to Respond.pdf(325443 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

In the matter of U.S. Registration No. 4,509,171;
For the mark SAFESIDE;
Registered on the Principal Register on April 8, 2014.

Safeside Tactical, LLC,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92060464
	:	
CheyTac USA, LLC,	:	
	:	
Registrant.	:	

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTIONS
TO REOPEN TIME TO RESPOND**

COMES NOW the Petitioner, Safeside Tactical, LLC, (hereinafter “Petitioner”), by and through counsel, The Trademark Company, PLLC, and files the instant Opposition to the Registrant’s Motion to Reopen Time to Respond to Petitioner’s Motion for Summary Judgment and Registrant’s Motion to Reopen Time to Respond to the Board’s Order on Registrant’s Motion to Grant Corrected Date of First Use Without Consent as follows:

STATEMENT OF FACTS

1. Registrant contends that it is the owner of U.S. Registration No. 4,509,171 for the mark SAFESIDE (hereinafter “Registrant’s Mark”) authorized for use in connection with the following goods, namely: “Ammunition for firearms; Breeches of firearms; Firearm sights; Firearms; Foresights for firearms; Gunsights for firearms; Non-telescopic gun sights for firearms; Supplemental chambers for firearms,” (hereinafter “Registrant’s Goods”) in International Class 13.
2. Registrant filed its Application for Registrant’s Mark for use in connection with Registrant’s Goods on or about February 2, 2013.
3. Registrant’s Application for Registrant’s Mark received U.S. Serial No. 85/839,213.
4. On or about April 8, 2014, Registrant’s Mark published on the Principal Register and received U.S. Registration 4,509,171.

5. Registrant's Registration claims a date of first use in commerce of Registrant's Mark for Registrant's Goods on December 15, 2012.

6. Petitioner is the owner of Federal Trademark Application Serial No. 86/201,940 for the mark SAFESIDE TACTICAL (hereinafter "Petitioner's Mark") for use in connection with the following services, namely: "On-line retail store services featuring firearms and related items; Retail store services featuring firearms and related items," (hereinafter "Petitioner's Services") covered in International Class 35.

7. Petitioner's Application claims a date of first use of Petitioner's Mark in connection with Petitioner's Services on November 15, 2012 and a date of first use in commerce on December 2, 2012.

8. On or about December 1, 2014 Petitioner filed a Petition to Cancel Registrant's Registration for Registrant's Mark on the grounds of priority of use and likelihood of confusion pursuant to Trademark Act Section 2(d).

9. On or about January 9, 2015 Registrant filed an Answer to the Petition to Cancel.

10. On or about January 15, 2015 Registrant filed a Motion to Grant Corrected Date of First Use Without Consent pursuant to 37 CFR § 2.175 and TBMP § 514.01 seeking an order from the Board amending the date of first use claimed on Registrant's Registration from December 15, 2012 to June 24, 2011.

11. On or about February 9, 2015 the Board entered an Order allowing Registrant until on or about March 11, 2015 to submit the required fee and/or declaration in support of the amendment to Registrant's Registration as set out in Registrant's Motion to Grant Corrected Date of First Use Without Consent.

12. On or about February 9, 2015 Registrant filed a Reply in Support of Registrant's Motion to Grant Corrected Date of First Use Without Consent.

13. On or about February 13, 2015 Petitioner served its Initial Disclosures to Counsel for Registrant by U.S. Mail.

14. On or about June 5, 2015 the Board entered an Order denying Registrant's Motion to Grant Corrected Date of First Use Without Consent and resetting the trial dates in the instant case.

15. On or about July 6, 2015 Petitioner served Petitioner's First Set of Requests for Admissions, Requests for Production of Documents and Requests for Interrogatories to Registrant by U.S. Mail. *See* Petitioner's Motion for Summary Judgment, Exhibit A.

16. Counsel for Petitioner emailed courtesy copies of Petitioner's aforementioned discovery requests to Registrant's Counsel on July 6, 2015. *See* Petitioner's Motion for Summary Judgment, Exhibit B.

17. The deadline for Registrant to submit its responses to Petitioner's First Set of Requests for Admissions, Requests for Production of Documents and Requests for Interrogatories to Registrant was on or about August 10, 2015.

18. As of the filing date of Petitioner's instant opposition, no response has been received from Registrant in response to Petitioner's First Set of Admissions to Registrant. *See* Petitioner's Motion for Summary Judgment, Exhibit C.

19. On or about August 26, 2015 Petitioner filed a Motion for Summary Judgment and corresponding Exhibits A-C on the following grounds:

- a. Priority and likelihood of confusion with Petitioner's Claimed Mark pursuant Section 2(d) of the Trademark Act; and
- b. No genuine issues of material fact exist that can contradict Petitioner's claims of priority of use over Registrant.

20. On or about September 10, 2015 the Board entered an Order suspending the instant proceeding pending the disposition of Petitioner's Motion for Summary Judgment.

21. The deadline for Registrant to file a Response to Petitioner's Motion for Summary Judgment was on or about September 30, 2015.

22. On or about November 6, 2015 Registrant's new counsel filed a Notice of Appearance as Counsel for Registrant stating that Registrant's former counsel, Gerald Romanoff, passed away on April 4, 2015. *See* Registrant's Notice of Appearance of Counsel¹.

23. On or about November 6, 2015 Registrant, by counsel, filed a Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment and corresponding Exhibits A-C.

24. On or about November 9, 2015 Registrant, by counsel, filed a Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent (collectively, with the Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment hereinafter referred to as "Registrant's Motions to Reopen") and corresponding Exhibits A-D.

ARGUMENT

The Registrant alleges that good cause and excusable neglect exists to warrant a reopening of time for Registrant to respond to both the Petitioner's Motion for Summary Judgment filed on August 26, 2015 and the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent issued on June 5, 2015 stemming from the death of Registrant's former counsel, Gerald Romanoff, from complications with cancer on April 4, 2015.

In Registrant's Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent the Registrant, Registrant cites *Pioneer Investment Services Co.*, 507 U.S. 308, 395 (1993) as a precedent of addressing the definition of "excusable neglect".

To determine whether a party's neglect is excusable is:

At the bottom and equitable one, taking account of all relevant circumstances surrounding the party's omission. These include... [1] the danger of prejudice to the [non-moving party], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

¹ While saddened on a human level over the death of Mr. Romanoff upon a full evaluation of the facts of the instant motion it is clear that Mr. Romanoff's untimely demise is wrongfully being used as a basis for the instant motion whereas all of the facts before the board clearly establish it was a lack of diligence on the part of the Registrant that caused the delay by and through corporate restructuring and/or general apathy.

i. Third Pioneer Factor- The reason for the delay, including whether it was within the reasonable control of the Registrant.

In subsequent applications of this test to determine excusable neglect by the Circuit Courts of Appeal, several courts have stated that the third Pioneer Factor may be considered the most important factor in a particular case. *See: Pumpkin Ltd v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn. (TTAB 1997). Turning to the instant matter, the cause and length of Registrant's delay in participating in formal litigation in this matter after Mr. Romanoff's passing can only be attributed to Registrant's lack of diligence.

In support of Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment Registrant provided Mr. Romanoff's obituary notice as Exhibit A verifying Registrant's former counselor's passing on April 4, 2015. Moreover, in support of Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment Registrant includes a signed Affidavit of David McCutcheon, President of Cheytac USA, LLC verifying as follows:

- *"I did not immediately learn, bout Mr. Romanoff's death until several weeks after his passing. Once I was notified about Mr. Romanoff's death, I made my best and good faith efforts to retrieve the files in this matter in Mr. Romanoff's custody."* See Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment, Exhibit B, Section 3.

Contradictory to the sworn statement above, in the signed Affidavit of David McCutcheon, President of Cheytac USA, LLC filed in support of Registrant's Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent, Mr. McCutcheon provides the following verified statement:

- *"I did not immediately learn about Mr. Romanoff's death until approximately ten (10) days after his passing. Once I was notified about Mr. Romanoff's death, I made my best and good faith efforts to retrieve the files in this matter in Mr. Romanoff's custody with the assistance of Mr. Mark Stern, a non-trademark attorney who at the time was serving as my corporate counsel for Cheytac USA, LLC."* See Registrant's Motion to Reopen Time to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent, Exhibit E, Section 5.

Based on the foregoing, it is assumed that the Registrant became aware of Mr. Romanoff's death on April 14, 2015. As such, the Registrant has waited a time period of over six and half (6 ½) months to take any sort of action in this proceeding or secure new counsel. Moreover, in attempt to justify its aforementioned delay, Mr. McCutcheon makes the following sworn statements:

- *“From the time of Mr. Romanoff’s passing until October 2015, Cheytac USA, LLC was undergoing a dramatic company-wide organizational restructuring. See Registrant’s Motion to Reopen Time to Respond to the Board’s Order on Registrant’s Motion to Grant Corrected Date of First Use Without Consent, Exhibit E, Section 6.*
- *“Due to circumstances surrounding Mr. Romanoff’s death and burial services, it took over a month to retrieve files, but once they were obtained, I immediately sought referrals to other suitable attorneys who could serve as substitute counsel in this matter.” See Registrant’s Motion to Reopen Time to Respond to the Board’s Order on Registrant’s Motion to Grant Corrected Date of First Use Without Consent, Exhibit E, Section 7.*
- *“The combination of this lack of assistance [referring to referrals from former corporate counsel Mark Stern] and the company-wide organizational restructuring added significant challenges, financial limitations and unavoidable delays to my ability to find and retain suitable substitute counsel.” See Registrant’s Motion to Reopen Time to Respond to the Board’s Order on Registrant’s Motion to Grant Corrected Date of First Use Without Consent, Exhibit E, Section 10.*

As stated above, Mr. Romanoff's obituary notice was attached as Exhibit A to Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment. As such, Mr. Romanoff's funeral service took place on April 6, 2015. As such it is a quandary as to why the circumstances surrounding Registrant's former counselor's death on April 4, 2015 and burial services on April 6, 2015 would cause Registrant a one (1) month delay in receiving Registrant's files for this case. In any event, assuming Mr. McCutcheon's verified statement is accurate, the Registrant was in possession of its files for a time period of or about six (6) months prior to taking any sort of action in this case.

Furthermore, the registration of Petitioner's Mark has been in limbo since the time this proceeding was instituted. If the Registrant's Motions to Reopen time are granted, it would prolong this period of uncertainty with regards to Petitioner's Mark and which would significantly affect Petitioner's business decisions. Additionally, if this matter were to proceed the Petitioner would be burdened by additional litigation expenses. Moreover, Registrant's Motions to Reopen are Motions in substance and

would affect the core issues in this proceeding. As such, it is respectfully submitted that the Petitioner would be greatly prejudiced should the relief sought in Registrant's Motions to Reopen be granted.

It is also important to note that early on in this case David McCutcheon was present during conference calls between Mr. Romanoff and Petitioner's Counsel. As such, Mr. McCutcheon has been fully aware since the onset of this matter that Petitioner was represented by the undersigned counsel.

In sum, the reasons for Registrant's delay and the length of that delay in responding to both the Petitioner's Motion for Summary Judgment and the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent, namely, Mr. Romanoff's death over seven (7) months ago and the restructuring of Registrant's business do not meet the requisite standard to be considered excusable neglect.

CONCLUSION

WHEREFORE Petitioner, by counsel, respectfully requests the Board deny Registrant's Motion to Reopen Time to Respond to Petitioner's Motion for Summary Judgment, deny Registrant's Motion to Reopen Time for Registrant to Respond to the Board's Order on Registrant's Motion to Grant Corrected Date of First Use Without Consent and grant Petitioner's Motion for Summary Judgment and that this matter be dismissed with prejudice.

DATED this 25th day of November, 2015.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

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Attorney for Petitioner

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The Trademark Trial and Appeal Board**

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Petitioner,	:	
	:	
vs.	:	Cancellation No. 92060464
	:	
CheyTac USA, LLC,	:	
	:	
Registrant.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 25th day of November, 2015 to
be served, via first class mail, postage prepaid, upon:

MILO S COGAN
FISHERBROYLES LLP
4140 ROSWELL ROAD
ATLANTA, GA 30342

/Matthew H. Swyers/
Matthew H. Swyers