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Filing date: **01/19/2016**

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

| | |
|------------------------|--|
| Proceeding | 92060464 |
| Party | Plaintiff Safeside Tactical, LLC |
| Correspondence Address | MATTHEW H SWYERS THE TRADEMARK COMPANY 344 MAPLE AVENUE WEST SUITE 151 VIENNA, VA 22180 UNITED STATES mswyers@thetrademarkcompany.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Matthew H. Swyers, Esq. |
| Filer's e-mail | mswyers@thetrademarkcompany.com |
| Signature | /Matthew H. Swyers/ |
| Date | 01/19/2016 |
| Attachments | Opposition to Registrants Amended Second Motion to Grant Corrected Date of First Use Without Consent.pdf(241898 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. | : | |

**OPPOSITION TO REGISTRANT’S AMENDED SECOND MOTION TO GRANT
CORRECTED DATE OF FIRST USE WITHOUT CONSENT**

COMES NOW the Petitioner, Safeside Tactical, LLC, (hereinafter “Petitioner”), by and through counsel, The Trademark Company, PLLC, and files the instant Opposition to the Amended Second Motion to Grant Corrected Date of First Use Without Consent filed by Registrant, Cheytac USA, LLC (hereinafter “Registrant”) on or about December 30, 2015 and states 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 January 27, 2015 Registrant's former counsel, the late Jerry Romanoff, President of Cheytac USA, LLC; David McCutcheon and Petitioner's undersigned counsel timely held the mandatory Discovery Conference in this matter.

13. 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.

14. 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.

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

16. 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. Per the Board's new trial order entered on or about June 5, 2015 the discovery period opened in this case on July 6, 2015 and closed on January 2, 2016.

17. 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.

18. Counsel for Petitioner emailed courtesy copies of Petitioner's aforementioned discovery requests to Registrant's Counsel on July 6, 2015.

19. 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.

20. 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.

19. 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.

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.

25. On or about November 25, 2015 Petitioner filed an 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.

26. On or about November 28, 2015 the Board entered an Order allowing the thirty (30) day or until on or about December 28, 2015 to file an Opposition to Petitioner's Motion for Summary Judgment.

27. On or about December 22, 2015 Registrant filed an Opposition to Petitioner's Motion for Summary Judgment and corresponding Exhibits A-J.

28. On or about December 22, 2015 Registrant filed a Second Motion to Grant Corrected Date of First Use Without Consent.

29. On or about December 30, 2015 Registrant filed an Amended Second Motion to Grant Corrected Date of First Use Without Consent.

30. On or about January 11, 2016 Petitioner filed a Reply in Support of Petitioner's Motion for Summary Judgment filed on December 22, 2015.

31. Petitioner's Motion for Summary Judgment filed on December 22, 2015 is still pending before the Board.

ARGUMENT

As basis for the relief sought on Registrant's Second Amended Motion to Grant Corrected Date of First Use Without Consent filed on or about December 30, 2015, Registrant contends that it made a good faith error in listing the date of first use in commerce on its underlying application for Registrant Mark as December 15, 2012 rather than June 24, 2011. It has been well established that an applicant is entitled to prove an earlier date of use than the date alleged in its application, but its proof must be clear and convincing and must not be characterized by contradiction, inconsistencies or indefiniteness. *See: Threshold.TV, Inc. v. Metronome Enters, Inc.*, 96 U.S.P.Q.2d 1031, 1036 (T.T.A.B. 2010); *See Also: Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). In the instant matter the Registrant has not provided clear and convincing evidence of its continuous use of Registrant's Mark since Registrant's proposed amended first use date of June 24, 2011.

Pursuant to TBMP § 514.01 "a registration which is the subject of a Board inter partes proceeding may not be amended or the mark disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board". In the instant matter, Petitioner has not provided its consent to the instant motion. Furthermore TBMP § 514.03 provides that "an unconsented motion to amend which is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b). If granted, the Registrant's Motion, would affect the core issues of priority of use and a likelihood of confusion in the instant proceeding in violation of Trademark Rule 2.133(a).

In sum, Petitioner respectfully submits to the Board that Registrant is not entitled to the relief sought in Registrant's Amended Second Motion to Grant Corrected Date of First Use Without Consent as Registrant has not met the evidentiary burden to warrant the proposed amendment to Registrant's date of first use in commerce. Moreover, Registrant's unconsented motion to amend is a Motion in substance and would affect the core issues in this proceeding.

WHEREFORE Petitioner, by counsel, respectfully requests that the Board deny Registrant's Amended Second Motion to Grant Corrected Date of First Use Without Consent.

DATED this 19th day of January, 2016.

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 19th day of January, 2016 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