

ESTTA Tracking number: **ESTTA653292**

Filing date: **01/30/2015**

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
Filer's e-mail	mswyers@TheTrademarkCompany.com
Signature	/Matthew H. Swyers/
Date	01/30/2015
Attachments	Opp to Mot to Correct.pdf(280331 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 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 Motion to Grant Corrected Date of First Use Without Consent filed by Registrant, Cheytac USA, LLC (hereinafter “Registrant”) 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 (hereinafter also referred to as "Registrant's Motion") 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.

## ARGUMENT

As basis for the relief sought on Registrant's Motion to Grant Corrected Date of First Use Without Consent, 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. Registrant states in the instant motion: "The attached invoice shows the correct date that should have been posted. This invoice was the first use of the Mark" (see *Registrant's Motion*, pg. 3, ¶ 2). Despite the foregoing statement, the invoice attached to Registrant's Motion is dated May 9, 2012 not 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 Motion 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 Motion to Grant Corrected Date of First Use Without Consent.

DATED this 30<sup>th</sup> day of January, 2015.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esquire

344 Maple Avenue West, Suite 151

Vienna, VA 22180

Telephone (866) 455-8800 x704

Facsimile (270) 477-4574

mswyers@TheTrademarkCompany.com

Attorney for Petitioner

**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.	:	

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that I caused a copy of the foregoing this 30<sup>th</sup> day of January, 2015  
to be served, via first class mail, postage prepaid, upon:

JERRY ROMANOFF, ESQ.  
JERRY ROMANOFF P.C.  
4 OCEANVIEW CT.  
LONG BEACH, NEW YORK 11561-1164

/Matthew H. Swyers/  
Matthew H. Swyers