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

Proceeding	92060688
Party	Plaintiff Nodding Head Brewery
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Date	03/06/2015
Attachments	Resp to Motion to Suspend.pdf(222886 bytes)

More particularly, the bases for the cancellation, including the misrepresentations previously made by Rubicon to the U.S. Patent and Trademark Office as part of the original filing by Rubicon / Registrant, and now repeated in the just filed concurrent use application, cannot be hidden or side-stepped by any concurrent use filing. Indeed, any such misrepresentations by Registrant/Rubicon necessarily taint any attempt by Rubicon to rush through a separate concurrent use application.

Argument

The only reason presented by Rubicon in support of its Motion Rubicon is that “[b]ecause Petitioner’s Petition for Cancellation is based on Registrant’s use of the trademark in a geographically unrestricted area, the adjudication of Registrant’s concurrent use proceeding will dispose of some (if not all) of the issues in this proceeding.” (*See* Motion, at 1). This is simply wrong.

Nodding Head’s Petition to Cancel is *not* solely based on Rubicon’s geographically unrestricted use of the Monkey Knife Fight trademark. More accurately, Nodding Head’s Petition to Cancel is based on (a) the use, *anywhere*, by Rubicon of the Monkey Knife Fight trademark, which was created by Nodding Head and improperly usurped by Rubicon, and (b) the intentional misrepresentations made by Rubicon to the US Patent and Trademark Office in support of the Rubicon application for registration. Neither of these bases, that support the cancellation of the Rubicon registration, are affected by any concurrent use application filed by Rubicon.

First, as stated in Nodding Head’s Petition, since at least October 2002, Nodding Head has served and sold its Monkey Knife Fight beer products in Philadelphia, as well as other locations in Pennsylvania, and across the United States, in particular in Colorado. (*See* Petition, ¶ 5). Moreover, numerous marketing materials and advertisements for Nodding Head’s Monkey Knife Fight products have been published and made available across the United States, including in California (*See* Petition, ¶¶ 12, 13). Accordingly, the mere exclusion of Philadelphia from any new Rubicon application or registration cannot and does not cure any failure or problem with the Rubicon Registration.

Second, Nodding Head notes that the filing of the concurrent use application suffers from the exact same culpable statements as the original Rubicon application for registration. Petitioner Nodding Head notes that *once again*, Rubicon has authorized its counsel to declare and attest that:

“The signatory believes that to the best of the signatory's knowledge and belief, ***no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.*** The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, ***declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.***” (Rubicon Concurrent Use Application, filed February 23, 2015; Emphasis added).

This declaration and statement is plainly false. Moreover, both Rubicon and its counsel knew that such a statement was false when made to the US Patent and Trademark Office. Contrary to the Rubicon statement, there is another person (specifically, Nodding Head Brewery) that has “the [prior] right to use the mark in commerce, . . . in the identical form . . . as to be likely, when used on or in connection with the goods/services [beer products] of such other person, to cause confusion or mistake, or to deceive.”

Nodding Head still contends that Rubicon obtained Registration No. 4,478,085 for the “MONKEY KNIFE FIGHT” trademark only after seeing Nodding Head’s use of that mark on beer products; after deceiving Nodding Head into believing that Rubicon would abide by agreements reached with Nodding Head to only use the mark in California; and only after making critical, intentional misrepresentations to the US Patent and Trademark Office in its application for registration of the Monkey Knife Fight trademark. Any concurrent use application will have no import or effect on these bases for cancelling the Rubicon Registration.

For the reasons provided herein, Petitioner Nodding Head respectfully requests that the Board deny Rubicon’s Motion to Suspend, and order that Rubicon answer the pending petition to cancel within ten (10) days of the entry of such order so that this cancellation proceeding may move forward to a proper conclusion.

Respectfully submitted,

Dated: March 6, 2015

A handwritten signature in black ink, appearing to read 'Curt Decker', written over a horizontal line.

Curt Decker, Owner
Nodding Head Brewery
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing *Response and Opposition of Petitioner to Motion to Suspend* was served upon the following entities of record on March 6, 2015 in the manner identified:

By Federal Express and made available through the TTAB ESTTA system

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Curt Decker