

ESTTA Tracking number: **ESTTA746997**

Filing date: **05/17/2016**

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

Proceeding	92061629
Party	Defendant Matey Michael Ghomeshi
Correspondence Address	MATEY MICHAEL GHOMESHI MOBILE BLACK BOX P O BOX 95 ONTARIO, CA 91762-8095 UNITED STATES mg@mobileblackbox.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Matey Michael Ghomeshi
Filer's e-mail	mg@mobileblackbox.com
Signature	/Matey Michael Ghomeshi/
Date	05/17/2016
Attachments	Motion To Dismiss.pdf(50386 bytes) EXHIBIT A - Declaration of Matey Michael Ghomeshi.pdf(31628 bytes) EXHIBIT B - Petition for Cancellation.pdf(99311 bytes) EXHIBIT C - Petitioner Envelope.pdf(393483 bytes) EXHIBIT D - USPTO Envelope.pdf(924505 bytes)

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

In the Matter of Registration No. 3,798,681

STRONGVOLT, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92061629
)	
MATEY MICHAEL GHOMESHI,)	
)	
Respondent.)	
)	
)	

MOTION TO DISMISS
AND SUPPORTING BRIEF

Respondent Matey Michael Ghomeshi, with his address at PO Box 95, Ontario, CA 91762 (hereinafter “Respondent”), respectfully moves the Board pursuant to 37 C.F.R §2.119; §2.111 and Fed. R. Civ. P. 12(b), to dismiss the above captioned Petition for Cancellation filed by Petitioner Strongvolt Inc. (hereinafter “Petitioner”), with offices at Suite 210, 3930 Oregon Street, San Diego, California 92104, for **lack of timely service**. Included in this motion is a supporting brief. The facts supporting this motion are set forth in the Declaration of Respondent, Matey Michael Ghomeshi, attached hereto as EXHIBIT A.

Factual Background

Respondent registered MobileBlackBox trademark No. 3,798,681 on June 8, 2010. The record indicates that the trademark was registered on June 08, 2010. Per CFR §2.111(b), the petition for cancellation period expired on June 08, 2015. On June 05, 2015 Petitioner electronically filed Petition For Cancellation which resulted in the above-captioned cancellation No. 92061629. The Board instituted the above-captioned proceeding on June 05, 2015, and mailed notice to Respondent via First Class mail postmarked on June 09, 2015 (EXHIBIT D). Respondent received Board notice via US First Class mail on June 15, 2015. Petitioner was required to mail petition via USPS

First Class mail to Respondent's address; instead The Petition For Cancellation was hand delivered and placed in Respondent's PO Box address on June 25, 2015. The Petitioner's envelope does **not** have any postage **nor** USPS postmark imprinted on the envelope (Exhibit C). Petitioner did not timely serve the Petition For Cancellation on Respondent nor did the Petitioner serve the Petition via US First Class mail as stated in Petitioner's Certificate of Service (Exhibit B).

The USPTO record indicates that the Respondent's MobileBlackBox mark was registered on June 8, 2010. Per 37 C.F.R. §2.111(b), Lanham ACT 14(1) the petition for cancellation period expired on June 08, 2015. Petitioner's Petition For Cancellation and Certificate of Service, as downloaded from the "TTABVUE" database, is attached as EXHIBIT B. The Petitioner's Certificate of Service indicates that Petitioner served a copy of the filing via First Class Mail on June 05, 2015. Petitioner never mailed the Petition For Cancellation via First Class mail on June 05, 2015 as indicated in Petitioner's Certificate of Service. Petitioner never served Respondent with the Petition For Cancellation before June 25, 2015. *See* 37 C.F.R. §2.111(b); §2.119(b)(6); §2.111(c)(4) and *Ghomeshi Decl.*, ¶3.

Argument

Pursuant to 37 C.F.R. §2.111(a) A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee. The petition must include proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record in the Office, as detailed in §§ 2.111(b); §2.111(c)(4) and 2.119. Proof of service assumes actual service on the Respondent; *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008). Since, Petitioner did not actually serve Respondent until June 25, 2015, Petitioner did not comply with the minimum requirements to institute a cancellation proceeding.

This case is analogous to *Springfield Inc. v XD*, in which the opposer filed a notice of opposition with a certificate of service, but never actually served the applicant. *Id.* The Board held that the opposer did not comply with the service requirement and stated that opposer's notice of opposition should not have received a filing date, and the proceeding should not have been instituted. *Id.* The Board dismissed the opposition as a nullity. Similarly, in

the instant case, Petitioner failed to comply with the service requirement within the Petition for cancellation period, which expired on June 08, 2015, and this case should be dismissed as well.

The Petitioner was required to serve Respondent by (1) delivering a copy of the paper to Respondent; (2) leaving a copy at Respondent's usual place of business; (3) leaving a copy at Respondent's residence, with a member of the person's family over 14 years of age and of discretion; (4) transmission by "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail; or (5) transmission by overnight courier. Since the Petitioner did none of these before June 25, 2015, and did not include the same in a proper certificate of service, it did not effectuate service and this proceeding should not have been instituted.

The time for filing a petition for cancellation is statutory §2.111(b) and cannot be waived by the Board.

The filing date for a petition for cancellation is dependent on, among other things, forwarding of a service copy and inclusion of proof of service when the petition is filed. 37 C.F.R. §2.111(b); §2.111(c)(4).

Thus, if a Petitioner's service of a petition for cancellation, or its submission of a proper proof of service, occurs after the 5 year period after registration date, the filing date would fall outside the cancellation period and the Board would refuse the Petition For Cancellation as untimely *Lanham ACT 14(1)*. In *Springfield Inc. v XD*, 86 USPQ2d 1063 (TTAB 2008) (notice of opposition filed through ESTTA on the last day of the opposition period included a proof of service, but inasmuch as there was no actual service on applicant, opposer failed to comply with service requirement of 37 CFR §§ 2.101(a) and 2.101(d)(4); notice of opposition should not have received a filing date and proceeding should not have been instituted; case dismissed as a nullity).

The only way Petitioner may effectuate service at this time, is to refile or amend the Petition For Cancellation with a new Certificate of Service. However, the Petition For Cancellation period has expired *Lanham ACT 14(1)*; 37 C.F.R. §2.111(b) , Petitioner has no opportunity to cure the defect. In *Schott v. L'Wren Scott*, the opposer failed to include a certificate of service in its notice of opposition, 88 USPQ2d 1862 (TTAB 2008). It also failed to actually serve the notice of opposition on the applicant. *Id.* The opposer sought to amend the notice of opposition to include a certificate of service and actually serve the amended notices of opposition. *Id.* The Board held that oppose could not, by filing amended notices, cure its failure to properly serve the original notices of opposition. *Id.* A notice of opposition can be amended as of right, only if the original notice of opposition was proper. Because the original opposition was not properly served in a timely manner, prior to the close of the opposition period, the opposition was dismissed as a nullity. *Id.* Likewise, because within petition for cancellation

contained a false certificate of service and the petition for cancellation was not served via First Class mail nor within the petition for cancellation period, it should be dismissed as a nullity.

WHEREFORE, Respondent respectfully prays that Motion to Dismiss be granted.

Dated: May 17, 2016

Respectfully submitted,

By: / Matey Michael Ghomeshi /
Matey Michael Ghomeshi
PO Box 95
Ontario, CA 91762-8095
Tel: (909) 215-8869

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion To Dismiss And Supporting Brief together with exhibits, was served on Petitioner, StrongVolt, Inc., by mailing said copy on May 17, 2016, via First Class Mail, postage prepaid, to:

Charles F. Reidelbach, Jr, Esq.
Higgs, Fletcher & Mack LLP
401 West "A" Street, Suite 2600
San Diego, CA 92101-7910

Dated: May 17, 2016

By: / Matey Michael Ghomeshi /

EXHIBIT A

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

In the Matter of Registration No. 3,798,681

STRONGVOLT, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92061629
)	
MATEY MICHAEL GHOMESHI,)	
)	
Respondent.)	
)	
)	

DECLARATION OF MATEY MICHAEL GHOMESHI

1. I, Matey Michael Ghomeshi, with address at PO Box 95, Ontario, CA 91762, am the Registrant for U.S. Trademark No. 3,798,681, for the mark MobileBlackBox.
 2. I received via First Class mail on June 15, 2015; the Trademark Trial and Appeal Board's (hereinafter "the Board") order instituting Cancellation Petition No. 92061629. The envelope was postmarked June 09, 2015.
 3. I did receive a copy of the Petition For Cancellation from Petitioner Strongvolt Inc., which was placed in my address of record at PO Box 95, Ontario, CA 91762 on June 25, 2015.
 4. The Petition For Cancellation I received from Petitioner did not have any postage nor USPS postmark.
 5. I am personally aware of no attempts by Petitioner to effect service of process on me at my address of record, PO Box 95, Ontario, CA 91762 prior to June 25, 2015.
 6. I certify under penalty of perjury under 28 U.S.C. §1746 that the foregoing is true and correct.
- The undersigned being warned that willful and false statement and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such

willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his knowledge are true; and all statements made on information and belief are believed to be true.

Dated: May 17, 2016

By: / Matey Michael Ghomeshi /

Matey Michael Ghomeshi

EXHIBIT B

ESTTA Tracking number: **ESTTA676677**

Filing date: **06/05/2015**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	StrongVolt, Inc.		
Entity	Corporation	Citizenship	California
Address	3930 Oregon Street San Diego, CA 92104 UNITED STATES		

Attorney information	Charles F. Reidelbach, Jr. Higgs Fletcher & Mack LLP 401 West A Street, Suite 2600 San Diego, CA 92101 UNITED STATES trademarks@higgslaw.com Phone:619-236-1551		
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Registration Subject to Cancellation

Registration No	3798681	Registration date	06/08/2010
Registrant	Ghomeshi, Matey Michael PO Box 95 Ontario, CA 917628095 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2003/01/16 First Use In Commerce: 2003/01/16 Cancelled goods and services in the class: Audio speakers for computers; portable electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, image and audio files; audio-video media players for automobiles; audio and video recorders; digital video and event recorders that activate from automotive impact; transmitters for video signals for transmission over twisted pair cables
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Grounds for Cancellation

Other	Void based on non-use
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Attachments	Petition for Cancellation of MOBILEBLACKBOX.pdf(122472 bytes) Exhibit A - MOBILEBLACKBOX Registration.pdf(573723 bytes) Exhibit B - BLKBOX Application.pdf(44452 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/charlesfreidelbachjr/
Name	Charles F. Reidelbach, Jr.
Date	06/05/2015

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

StrongVolt, Inc.

Petitioner,

-against-

Matey Michael Ghomeshi

Registrant.

Cancellation No.:

Regarding Reg. No. 3798681

PETITION FOR CANCELLATION

StrongVolt, Inc. (“Petitioner”), a California corporation located at 3930 Oregon Street, San Diego, California 92104, believes that it is being damaged by Registration No. 3798681 and hereby petitions to cancel same as to the following goods in International Class 009: “audio speakers for computers; portable electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, image and audio files; audio-video media players for automobiles; audio and video recorders; digital video and event recorders that activate from automotive impact; transmitters for video signals for transmission over twisted pair cables,” on the following grounds:

1. Upon information and belief, Matey Michael Ghomeshi ("Registrant"), an individual with an address of P.O. Box 95 Ontario, California 91762-8095, is the owner of United States Trademark Registration No. 3798681 for MOBILEBLACKBOX and Design for use in connection with “audio speakers for computers; portable electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, image and audio files; audio-video media players for automobiles; audio and video recorders; digital video and event recorders that activate from automotive impact; analog and digital audio signal transmitters; transmitters for video signals for transmission over twisted pair cables” in International Class 009 alleging dates of first use of January 16, 2003 (the “‘681 Registration”). *See* Exhibit A.

2. Petitioner is the owner of United States Trademark Application No. 86312338 for BLKBOX in International Class 009 for “cell phone battery chargers; solar battery chargers; stand-alone audio speakers; carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, stand-alone speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones, tablets and MP3 players” (the “‘338 Application”). *See* Exhibit B. Petitioner hereby gives notice that, in accordance with Trademark Rule 2.122(d), it will rely on said application as evidence on its behalf in this proceeding, and status copies thereof will be introduced into evidence during Petitioner’s testimony period.

3. Petitioner’s BLKBOX trademark is inherently distinctive as used in connection with its goods.

4. Petitioner’s BLKBOX trademark has been actively and continuously used in connection with such goods since at least as early as January 1, 2013. As a result of Petitioner’s active use, promotion, and advertising of its trademark in connection with all of the described goods, Petitioner’s BLKBOX trademark has acquired extensive value and goodwill and is well known and recognized by consumers and the trade as identifying Petitioner's goods.

5. Based on likelihood of confusion, the ‘681 Registration has been cited as a bar to registration of Petitioner’s ‘338 Application by the USPTO. The Examiner has stated that Registrant’s mark is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Registrant with Petitioner, or as to the origin, sponsorship, or approval of Registrant’s goods or commercial activities with Petitioner.

6. Upon information and belief, Registrant did not use the trademark on each and every good recited in its ‘681 Registration within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. 1051 and 1127. Registrant’s business is and was at the time of filing the ‘681 Registration limited to the sale of FM transmitters which may be properly described only as “analog and digital audio signal transmitter[s].” Specifically, Registrant has not used the trademark in its ‘681 Registration in United States commerce in conjunction with the following

goods: “audio speakers for computers; portable electronic devices for recording, organizing, transmitting, manipulating and reviewing text, data, image and audio files; audio-video media players for automobiles; audio and video recorders; digital video and event recorders that activate from automotive impact; transmitters for video signals for transmission over twisted pair cables” since its alleged dates of first use of January 16, 2003, or even since the filing of its trademark application for the ‘681 Registration on August 3, 2009. Accordingly, the ‘866 Registration is void in its entirety, or at least with respect to the goods described above.

7. If Registrant is permitted to continue to maintain its ‘681 Registration for the recited goods, it casts a cloud upon Petitioner’s own right to continue to use, protect, develop and to expand the use of Petitioner’s BLKBOX trademark in the United States. Such registration is thus a source of damage and injury to Petitioner.

WHEREFORE, Petitioner believes that it will be damaged by Registration No. 3798681 and prays that this Petition for Cancellation be sustained in favor of Petitioner, that judgment be entered against Registrant and that U.S. Trademark Registration No. 3798681 be canceled with respect to the recited goods as identified above.

DATED: June 5, 2015

HIGGS, FLETCHER & MACK LLP



By: _____

Charles F. Reidelbach, Jr., Esq.
California State Bar No. 167482
Michael J. Hoisington, Esq.
California State Bar No. 201679
401 West "A" Street, Suite 2600
San Diego, CA 92101-7910
Telephone: 619.236.1551
Facsimile: (619) 696-1410
Email: trademarks@higgslaw.com
ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION was served on June 5, 2015 to Registrant Matey Michael Ghomeshi as follows:

Via Email: mg@mobileblackbox.com

Via First Class Mail: P.O. Box 95
Ontario, California 91762-8095

Dated: June 5, 2015

By:



Meilani N. Rivera, Paralegal

EXHIBIT C

CFR

HFM | HIGGS
FLETCHER
& MACK^{USA}

401 West A Street, Suite 2600
San Diego, CA 92101

Matey Michael Ghomeshi
P.O. Box 95
Ontario, California 91762-8095

EXHIBIT D

ent and Trademark Office
ademarks

13-1451
um in Ten Days

USE \$300



AN EQUAL OPPORTUNITY EMPLOYER

92061629
MATEY MICHAEL GHOMESHI
PO BOX 95
ONTARIO, CA 91762-8095