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

Proceeding	92061664
Party	Plaintiff Boston Iced Tea Company, Inc.
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Date	08/11/2015
Attachments	Boston Iced Tea Opposition to MTD 081115.pdf(131444 bytes )

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

**In the matter of:** Trademark Registration No. 4703971, on the Principal Register  
**Mark:** Boston Tea  
**Date Filed:** June 2, 2015

<p>BOSTON ICED TEA COMPANY, INC.,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p>BBK PICTURES, INC.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No. 92061664</p>
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**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO DISMISS THE  
CANCELLATION PROCEEDING**

**I. INTRODUCTION**

Registrant wants the Board to summarily dismiss the current Petition to Cancel (“Petition”), on the grounds that Petitioner should have brought the matter as a compulsory counterclaim in a separate opposition proceeding filed by the Registrant against Petitioner (“Opposition”). However, Registrant’s motion must be denied for three (3) simple reasons:

1. Registrant’s registration did not issue until more than one (1) year after Petitioner filed its answer in the Opposition proceeding, until more than six (6) months after discovery had closed in the Opposition proceeding, until more than a month after Registrant filed its trial brief in the Opposition Proceeding, and until after Petitioner had already prepared its trial brief in the Opposition proceeding (and was uploading the same with the Board). Petitioner could not control or anticipate when (or even if) a registration would issue. Indeed, the current Petition could not have been made the subject of a compulsory counterclaim unless and until a registration issued.

2. Registrant never raised its registration as the basis or grounds of the Opposition proceeding (until filing its Reply Brief, per below), as no registration existed at the time the Opposition was filed. Therefore, Petitioner could not have provided any defenses to a registration that did not exist, nor could Petitioner have included the registration as a counterclaim to the Opposition unless and until the registration issued. By the time that occurred, discovery had been closed for more than six (6) months, Registrant had already filed its Main Brief and Petitioner had already prepared its Response Brief.

3. Registrant finally asserted its registration (for the first time in the Opposition proceeding) in its Reply Brief, filed on April 1, 2015 (Reply Brief, p. 1). As a result of having relied upon its registration for the first time in the Opposition, Registrant is barred under the express language of TBMP 313.04 from challenging Petitioner's Petition: "A plaintiff may not, by failing to plead a registration on which it intends to rely, deprive a defendant of its right to petition to cancel the registration, either by counterclaim *or by separate petition, at such time as opposer seeks to rely upon the registration*" (emphasis added). TBMP 313.04; *see*, 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 95-96 (TTAB 1984). *See also* Notice of Final Rulemaking, 46 Fed. Reg. 6940 (January 22, 1981). TBMP 313,04 goes on to state: "Even if the defendant knows grounds for cancellation of a plaintiff's unpleaded registration when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration *unless and until the plaintiff pleads the registration*" (emphasis added). Under this clear authority, Petitioner is well within its rights to challenge the now-pleaded registration in a Petition to Cancel.

## II. STATEMENT OF FACTS

Registrant filed its application to register Registrant's mark on February 8, 2011. The USPTO published the Registrant's mark for opposition on December 20, 2011, with the deadline to oppose running on January 19, 2012. The application for Registrant's mark was abandoned for failure to file a statement of use or extension; however, a petition to revive the application was filed and the application was revived on September 07, 2012. Notably, Registrant did not file a statement of use until March 23, 2014, one year to the day after Petitioner filed its trademark application. Registrant's registration did not issue until March 17, 2015.

As noted, Petitioner filed an application to register its mark on March 23, 2013 (Application 85/884,091). Registrant opposed the registration on December 24, 2013

(Opposition No. 91214191). In the Opposition proceeding, the parties agreed to Accelerated Case Resolution (ACR), and the Board initially issued a schedule with the following dates: Answer due on February 2, 2014, Discovery to close on August 31, 2014, Plaintiff's 30-day trial period to end on November 29, 2014, Defendant's 30-day trial period to end on January 28, 2015, and Plaintiff's rebuttal period to end on March 14, 2015. However, Registrant failed to keep with the existing expedited schedule.

For example, Registrant repeatedly failed to appear for deposition – the most recent instance of which Registrant cancelled the morning of the deposition, further the delaying the timely processing of the case. Registrant requested an initial extension, which was reluctantly granted by the Board. When Registrant continued to delay and failed to appear for deposition, Registrant requested a second continuance of dates. The Board again gave Registrant more time, resetting the dates as follows: Plaintiff's Main Brief due on February 15, 2015, Defendant's Response Brief due on March 17, 2015, and Plaintiff's reply brief due on April 1, 2015. The Registrant's subject mark was registered on March 17, 2015.

### **III. ARGUMENT**

In the current case, Registrant's mark was registered more than one (1) year after the Opposition was filed, after Registrant had submitted its Main Brief, and on the same day that Petitioner's Response Brief was prepared and being filed. On this record, the challenge to Registrant's registration cannot be deemed waived unless brought by compulsory counterclaim. A counterclaim is only compulsory if the facts are known prior to the filing of an answer. See *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ 1395, 1397 (TTAB 1989) (“defense of the validity of a registration pleaded in an opposition [must] be asserted with the answer”). Here, Registrant's registration did not issue until more than one (1) year after the time to file an Answer to the Opposition. Further, even if Petitioner wanted to file an opposition to Registrant's application it could not have done so as the time to oppose Registrant's application expired on January 19, 2012. Therefore, Petitioner could not have brought this issue as a counterclaim to the Opposition.

As noted, Registrant finally asserted its registration (for the first time in the Opposition proceeding) in its Reply Brief, filed on April 1, 2015 (Reply Brief, p. 1). As a result of having relied upon its registration for the first time in the Opposition, Registrant is barred under the express language of TBMP 313.04 from challenging Petitioner's Petition: “A plaintiff may not,

by failing to plead a registration on which it intends to rely, deprive a defendant of its right to petition to cancel the registration, either by counterclaim *or by separate petition, at such time as opposer seeks to rely upon the registration*” (emphasis added). TBMP 313.04; *see*, 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 95-96 (TTAB 1984). *See also* Notice of Final Rulemaking, 46 Fed. Reg. 6940 (January 22, 1981). TBMP 313,04 goes on to state: “Even if the defendant knows grounds for cancellation of a plaintiff’s unpleaded registration when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration *unless and until the plaintiff pleads the registration*” (emphasis added). Under this clear authority, Petitioner is well within its rights to challenge the now-pleaded registration in a Petition to Cancel.

Finally, the interests of justice require allowing Petitioner to cancel the subject registration. *See’s Candy Shops, supra*, 12 USPQ 1395 (“when a pleader fails to set up a counterclaim through oversight, inadvertence, or excusable neglect, or when justice requires, he may, by leave of court, set up the counterclaim by amendment”). It is patently unjust to bar Petitioner from pursuing its valid Petition because Registrant decided to make the registration part of the Opposition in its Reply Brief on April 1, 2015. In the interest of justice, Petitioner should be allowed to proceed with the Petition.

#### IV. CONCLUSION

Based on the foregoing, Petitioner requests the TTAB deny Registrant’s Motion to Dismiss

Dated: August 11, 2015

FOLEY BEZEK BEHLE & CURTIS, LLP

*/Roger N. Behle, Jr./* \_\_\_\_\_

Roger N. Behle, Jr.

Attorney for Petitioner BOSTON ICED TEA  
COMPANY, INC.

CERTIFICATE OF SERVICE

It is hereby certified that on the 11th day of August, 2015, the foregoing PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS THE CANCELLATION PROCEEDING was served on Registrant by sending a copy thereof to:

BBK PICTURES, INC.  
c/o Dina Leytes  
GRIESING LAW, LLC  
1717 Arch Street Suite 3630  
Philadelphia, PA 19103  
UNITED STATES  
Phone: 215-732-3924  
[dleytes@griesinglaw.com](mailto:dleytes@griesinglaw.com)

Registrant, by first-class, postage-prepaid mail. Electronic copies were also served via email.

Dated: August 11, 2015

FOLEY BEZEK BEHLE & CURTIS, LLP

*/Roger N. Behle, Jr./* \_\_\_\_\_  
Roger N. Behle, Jr.  
Attorney for Petitioner  
Boston Iced Tea Company, Inc.