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

Proceeding	92063367
Party	Defendant Buss General Partner Co. Ltd.
Correspondence Address	BUSS GENERAL PARTNER CO LTD 11765 SUMMIT CRESCENT, DELTA, CANADA
Submission	Reply in Support of Motion
Filer's Name	Mark C. Johnson
Filer's e-mail	mjohnson@rennerotto.com, ngingo@rennerotto.com, eorsine@rennerotto.com
Signature	/Mark C. Johnson/
Date	05/31/2016
Attachments	20160531 Reply in Support of Motion.pdf(251673 bytes) 20160531 Decl. MCJ in Support of Motion.pdf(1074115 bytes)

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

SERIOUS, INC. Petitioner v. BUSS GENERAL PARTNER CO. LTD. Respondent.	Cancellation No. 92/063,367 Registration No. 4,017,207 Mark: BASEBOARDERS

REPLY IN SUPPORT OF MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(a)

Respondent brought the Civil Action in the United States District Court for the Northern District of Ohio against Petitioner on June 23, 2015, and Respondent is entitled to a swift resolution of the Civil Action. Indeed, Respondent is amenable to continuing this proceeding so long as it is truly distinct from the Civil Action and does not prevent or delay Respondent's pursuit of its rights in the Civil Action. To that end, Respondent reached out to Petitioner after receiving Petitioner's opposition brief and offered to withdraw the present motion to stay if:

1. Serious waives any right to argue descriptiveness with regard to Buss General's claimed trademark rights during the District Court Proceeding (to the extent any such rights even exist in light of Serious' failure to state any defense or counterclaim involving descriptiveness); and
2. Serious will not seek to stay or otherwise delay the resolution of the District Court Proceeding pending the outcome of the Cancellation Proceeding.

(Ex. A, Declaration of Mark Johnson ("Johnson Decl.") at Ex. 1.)

Petitioner has not agreed to refrain from challenging Respondent's trademark rights based on descriptiveness in the Civil Action, nor has Petitioner agreed that it will not seek to stay the Civil Action. *Id.* at ¶ 2-3. Certainly, if Petitioner is unwilling to waive the right to challenge the trademark during the Civil Action based on descriptiveness, the Civil Action would involve issues in common with those in this proceeding, the district court's findings would be binding on the Board, and the Board therefore should suspend this proceeding pending final resolution of the Civil Action. See *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). The Board should not give Petitioner a second bite at the apple.

It is apparent that Petitioner's initiation of this cancellation proceeding is a last ditch effort to delay the inevitable judgment that Petitioner has violated Buss General's federal and common law trademark rights. Petitioner's counsel essentially admitted as much, noting, albeit incorrectly, "Briefly, a determination by TTAB that the mark is not registrable would end the civil action." (Johnson Decl. at Ex. 2.) Of course this is not true. Even if one were to accept Petitioner's flawed assumption that it can show in this proceeding that Respondent's mark is unregistrable due to descriptiveness, the Civil Action involves claims independent of Petitioner's rights in its BASEBOARDERS mark. In any event, discovery in the Civil Action closes on June 30, 2016 and the Civil Action will be resolved long before the parties submit their Trial Briefs to the Board in this proceeding.

Petitioner apparently desires to argue descriptiveness in the Civil Action, despite its failure to plead any related counterclaim or affirmative defense, and despite its assertions in its opposition brief, else Petitioner would have agreed to waive any right to argue

descriptiveness during the Civil Action. Petitioner's refusal resolves any question as to whether the Civil Action and this proceeding involve common issues. They do.

This proceeding should be stayed pursuant to 37 C.F.R. § 2.117(a) pending final resolution of the Civil Action.

Dated: May 31, 2016

Respectfully submitted,

/Mark C. Johnson/

Mark C. Johnson
Nicholas J. Gingo
RENNER OTTO
1621 Euclid Avenue, Floor 19
Cleveland, Ohio 44115
216-621-1113 (telephone)
216-621-6165 (facsimile)

Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served on the following attorney of record for Petitioner by depositing same in the United States mail, postage prepaid, this 31st day of May, 2016:

Richard M. Klein
FAY SHARPE LLP
1228 Euclid Avenue, Fifth Floor
Cleveland, Ohio 44115

Dated: May 31, 2016

/Mark C. Johnson/
Attorney for Respondent

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 31st day of May, 2016.

Dated: May 31, 2016

/Mark C. Johnson/
Attorney for Respondent

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

SERIOUS, INC. Petitioner v. BUSS GENERAL PARTNER CO. LTD. Respondent.	Cancellation No. 92/063,367 Registration No. 4,017,207 Mark: BASEBOARDERS

DECLARATION OF MARK C. JOHNSON IN SUPPORT OF MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(A)

I, Mark C. Johnson, declare as follows:

1. I represent Respondent, Buss General Partner Co. Ltd. in the above-titled proceeding.

2. Attached hereto as Ex. 1 is a true and accurate copy of a May 23, 2016 email I sent to Petitioner's counsel, Richard Klein and George Huang, who represent Petitioner in this proceeding and in *Buss General Partner Co. Ltd. v. Serious, Inc., et al*, Case No. 15-cv-01256 in the United States District Court for the Northern District of Ohio ("Civil Action").

3. Respondent's counsel has not replied to the email attached hereto as Ex. 1.

4. Attached hereto as Ex. 2 is a true and accurate copy of an April 29, 2016 email from Mr. Huang replying to Respondent's inquiry regarding whether Petitioner would oppose Respondent's motion to stay.

I declare under penalty of perjury that the foregoing is true to the best of my knowledge and belief.

Date: May 31, 2016

/Mark C. Johnson/
Mark C. Johnson

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served on the following attorney of record for Petitioner by depositing same in the United States mail, postage prepaid, this 31st day of May, 2016:

Richard M. Klein
FAY SHARPE LLP
1228 Euclid Avenue, Fifth Floor
Cleveland, Ohio 44115

Dated: May 31, 2016

/Mark C. Johnson/
Attorney for Respondent

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this 31st day of May, 2016.

Dated: May 31, 2016

/Mark C. Johnson/
Attorney for Respondent

Mark Johnson

From: Mark Johnson
Sent: Monday, May 23, 2016 11:17 AM
To: 'rklein@faysharpe.com'; 'ghuang@faysharpe.com'; 'tbarni@dhplaw.com'
Subject: Buss General v. Serious - Litigation and Cancellation Proceedings

Dear Rick and George,

As you are aware, Tom Barni represents Buss General in the district court litigation with Serious (NDOH 1:15-cv-01256-DCN) ("the District Court Proceeding") and I represent Buss General in the TTAB cancellation proceeding (92/063,367) ("the Cancellation Proceeding"). Tom and I have discussed with Buss General and we are in agreement regarding the proposal below.

In Serious' opposition to Buss General's motion to stay the Cancellation Proceeding, Serious argues:

> Petitioner's Answer and Counterclaims also included eight affirmative defenses, ***none of which raised the issue of the non-registrability or unenforceability of Respondent's mark for mere descriptiveness***. (p. 2, emphasis added)
>
> In summary, ***resolution of the civil action between Petitioner and Respondent can be predicated upon a finding that Petitioner has not infringed Respondent's mark because Petitioner has not made any confusingly similar use of the mark (i.e., without any determination of the descriptiveness of the subject mark***). Petitioner has not asked the Court to cancel Respondent's mark. In other words, resolution of the civil action will not resolve ***the issue that Respondent's mark is merely descriptive under 15 U.S.C. § 1052(e)(1), which issue was presented to the Board in the Petition to Cancel but is not at issue in the pending civil action***. (p. 3, emphasis added)

Buss General is willing to take Serious at its word. Accordingly, Buss General offers to withdraw its motion to stay the Cancellation Proceeding if Serious agrees to the following:

1. Serious waives any right to argue descriptiveness with regard to Buss General's claimed trademark rights during the District Court Proceeding (to the extent any such rights even exist in light of Serious' failure to state any defense or counterclaim involving descriptiveness); and

2. Serious will not seek to stay or otherwise delay the resolution of the District Court Proceeding pending the outcome of the Cancellation Proceeding.

This offer is good until 5:00 pm Eastern on Wednesday, May 25, 2016. If we do not receive a response prior to that deadline, Buss General will assume that Serious intends to argue descriptiveness as part of its defense in the District Court Proceeding, a fact that will be made clear to the TTAB in Buss General's reply brief.

Regards,
Mark

Mark Johnson | Partner
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EXHIBIT
1

Mark Johnson

From: George Huang <ghuang@faysharpe.com>
Sent: Friday, April 29, 2016 8:02 AM
To: Mark Johnson; Richard M. Klein
Cc: Shannon M. Bobka; Lynda S. Kalemba
Subject: RE: BASEBOARDERS; Cancellation No. 92/063,367 (FS Ref: FRAT 700005, 700011)

Good morning Mark,

Thank you for your email. Yes, Serious Inc. would object to a stay in the proceedings at the TTAB. Briefly, a determination by TTAB that the mark is not registrable would end the civil action.

Regards, George

Fay Sharpe LLP
Protecting Ideas Since 1884

George Huang ■ Partner
ghuang@faysharpe.com

Fay Sharpe LLP, Halle Building, 5th Floor ■ 1228 Euclid Avenue, Cleveland, OH 44115
Main: 216.363.9000 ■ Direct: 216.363.9177

From: Mark Johnson [mailto:mjohnson@rennerotto.com]
Sent: Thursday, April 28, 2016 5:17 PM
To: Richard M. Klein; George Huang
Subject: BASEBOARDERS; Cancellation No. 92/063,367

Dear Rick and George,

I hope all is well. Buss General has asked Renner Otto to assist with the cancellation proceeding referenced above. We intend to move the Board to stay proceedings pending resolution of the civil action. Please let me know if Serious, Inc. objects.

Regards,
Mark Johnson

Mark Johnson | Partner
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EXHIBIT
2