

ESTTA Tracking number: **ESTTA722475**

Filing date: **01/25/2016**

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

Proceeding	91220843
Party	Plaintiff John Edward Guzman DBA Club Ed Surf School and Camp
Correspondence Address	BARBARA BURNS PRAXIS LEGAL SOLUTIONS LLC 4 OCEAN AVE APT 13 OCEAN GROVE, NJ 07756-1693 UNITED STATES bburns@praxislegalsolutions.com
Submission	Response to Board Order/Inquiry
Filer's Name	Barbara Burns
Filer's e-mail	bburns@praxislegalsolutions.com
Signature	/Barbara Burns/
Date	01/25/2016
Attachments	amended_certificate_01252016.pdf(659179 bytes ) motion_to_amend_09112015rev_.pdf(89060 bytes ) certified_receipts_09142015.pdf(518650 bytes )

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

JOHN EDWARD GUZMAN )  
d/b/a Club Ed Surf School and Camp )  
 ) Opposition No. 91220843  
Opposer, )  
 ) Serial No. 86266634  
v. )  
 )  
THE NEW SANTA CRUZ SURF SCHOOL, LLC )  
 )  
Applicant )  
 )  
 )  
 )  
\_\_\_\_\_ )

AMENDED CERTIFICATE OF SERVICE OF MOTION FOR LEAVE TO  
AMEND NOTICE OF OPPOSITION  
(9 TTABVUE)

In response to the Board order issued on January 20, 2016 (15 TTABVUE), Opposer submits proof of service of the subject document, Motion to Amend the Notice of Opposition and Amended Notice of Opposition (9 TTABVUE), to Applicant at 132 Alta Avenue, Santa Cruz, California 95060, and at 214 Lighthouse Avenue, Santa Cruz, California 95060, together with an AMENDED CERTIFICATE OF SERVICE. The certified receipts for both mailings are signed by the applicant, David K. Meyberg and are attached as Exhibit A.


AMENDED CERTIFICATE OF SERVICE

A copy of the foregoing Motion to Amend the Notice of Opposition and Amended Notice of Opposition has been filed electronically through

ESTTA and served by USPS, first class certified postage prepaid, return receipt requested, on September 11, 2015, to the Applicant:

David Meyberg, Esq.  
32 Alta Avenue  
Santa Cruz, California 95060

By: Barbara Burns


  
Attorney for John Edward Guzman  
Opposer

Date: January 25, 2016

CERTIFICATION OF SERVICE

The undersigned certifies that a copy of this Amended Certificate of Service has been filed electronically through ESTTA, and served by USPS, first class postage prepaid, return receipt requested, on January 25, 2016, to the attorney for Applicant:

Patrick T. Reilly  
101 Cooper Street  
Santa Cruz, California 95060

  
Barbara Burns  
Attorney for Opposer  
4 Ocean Avenue  
No. 13  
Ocean Grove, New Jersey 07756  
(732) 988-5362  
bburns@praxislegalsolutions.com

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

John Edward Guzman	)	
	)	
Opposer,	)	Opposition No.: 91220843
	)	
v.	)	Serial No.: 86266634
	)	
The New Santa Cruz Surf School, LLC	)	Mark: Santa Cruz Surf School
	)	
Applicant	)	
	)	
_____	)	

MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION

Pursuant to Rule 15(a) of the Federal Rules of Civil Procedure and 37 CFR § 2.107, Opposer John Edward Guzman, d/b/a Club Ed Surf School and Camp, through its counsel, moves for leave to amend the Notice of Opposition filed in this matter. As grounds therefor, Opposer provides as follows:

The initial Notice of Opposition, filed February 19, 2015, alleges that Applicant's mark has not acquired distinctiveness based on Applicant's substantially exclusive and continuous use of the mark SANTA CRUZ SURF SCHOOL. Opposer's proposed amendment would expand the grounds for denial of registration of the mark in that, absent acquired distinctiveness, Applicant's mark cannot be registered because it is geographically descriptive. In addition, Applicant's services, as described in its application, "Educational services, namely, conducting

surfing lessons in the field of ocean recreation; Providing a web site featuring information needed for the sport of surfing, namely wave conditions, wave locations and duration of surfing session; Providing a website featuring information relating to the sport of surfing; rental of surf boards”, are used entirely within the state of California, and, therefore, Applicant’s mark is not used “in commerce” as defined in the Lanham Act, 15 U.S. Code §1127.<sup>1</sup> Opposer’s proposed amendment is supported by the facts set forth in Applicant’s Trademark/Service Mark Application, and Opposer does not seek to add additional facts. The Board should permit Opposer to file his amended notice because there has not been undue delay, Applicant would not be prejudiced, and the amendment would not be futile.<sup>2</sup> Under TBMP 507.01, a party may amend its pleading and the court will freely give leave where justice so requires. Opposer seeks to amend its pleading in this case to conform to the facts, and to clarify the issue discussed in the Board-assisted discovery conference.

## ARGUMENT

37 CFR § 2.107 provides pleadings in an opposition may be amended in the same manner and to the same extent as in a civil action

---

<sup>1</sup> A copy of the amended Notice of Opposition Opposer seeks to file is attached hereto.

<sup>2</sup> Applicant cannot demonstrate bad faith or dilatory motive on the part of Opposer. Applicant sees to more thoroughly frame the issues raised by the claim of acquired distinctiveness on which Applicant relies as the basis for registration of its mark. Opposer had not previously requested an amendment to its pleadings, and therefore, there is no basis to conclude that Opposer has repeatedly failed to cure deficiencies by previous amendments.

in a United States district court. Rule 15(a) governing amendments provides that leave to amend shall be freely given when justice requires. “Leave to amend a complaint should be freely given in the absence of undue delay, bad faith, undue prejudice to the opposing party, repeated failure to cure deficiencies, or futility.” *Richardson v. United States*, 193 F.3d 545, 548-549 (D.C. Cir. 1999). The United States Supreme Court has said that “this mandate is to be heeded”. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Davis v. Liberty Mut. Ins Co.*, 871 F.2d 1134, 1136 (D.C. Cir. 1989). Therefore, the burden is on the opposing party to show that there is reason to deny leave. *In re Vitamins Antitrust Litigation*, 217 F.R.D 30, 32 (D.D.C. 2003). The Supreme Court explained that, “if the underlying facts or circumstances relied upon by a plaintiff may be a proper source of relief, he ought to be afforded an opportunity to test his claim on the merits.” *Foman*, 371 U.S. at 182.

The law is well-settled that leave to amend a pleading should be denied only where there is undue delay, bad faith or dilatory motive, repeated failure to cure deficiencies by previous amendments, undue prejudice or futility of amendment. *Firestone v. Firestone*, 76 F.3d 1205, 1208 (D.C. Cir. 1996). The grant or denial of leave to amend is committed to the sound discretion of the court. *Anderson v. USAA Cas. Ins. Co.*, 218 F.R.D. 307, 310 (D.D.C. 2003).

I. Opposer is entitled to amend its notice because there has not been undue delay.

Opposer has not unduly delayed in bringing this motion for leave to amend. The United States Court of Appeals for the District of Columbia has held that, “[w]here an amendment would do no more than clarify legal theories or make technical corrections, delay, without a showing of prejudice, is not a sufficient ground for denying the motion.” *Harrison v. Rubin*, 174 F.3d 249, 253 (D.C. Cir. 1999); see also *Atchison v. District of Columbia*, 73 F.3d 418, 426 (D.C. Cir. 1996) (holding that in order to determine the severity of the delay, the court considers any resulting prejudice the delay may cause); *Estate of Gaither v. District of Columbia*, 272 F.R.D. 248, 252 (D.D.C. 2011) (“[T]he mere passage of time does not preclude amendment—the delay must result in some prejudice to the judicial system or the opposing party.”) Opposer’s proposed amendment would serve only to identify an additional factor on which Applicant’s claim of acquired distinctiveness must fail without expanding or altering the scope of this matter.

Even if Applicant might claim that there was undue delay in Opposer’s effort to amend its notice, any alleged delay is minimal, as this matter is still in the discovery phase, where it is not unlikely that information may come to light that would serve as the basis of a motion for leave to amend either party’s pleadings in this opposition. Moreover, Applicant was already aware that its mark was susceptible to challenge

because it is geographically descriptive. Thus, there is no risk of unduly increasing discovery or delaying trial. *N. Am. Catholic Educ. Programming Found., Inc. v. Womble, Carlyle, Sandridge & Rice, PLLC*, 887 F. Supp. 2d 78,83 (D.D.C. 2012); *Heller v. District of Columbia*, No. 08-1289, 2013 U.S. Dist. LEXIS 38833, at \*8 (D.D.C. Mar. 20, 2013) (“A case’s position along the litigation path proves particularly important in that [hardship] inquiry; the further the case has progressed, the more likely the opposing party is to have relied on the unamended pleadings.”); *Harrison*, 174 F. 3d at 253. It is worth noting that courts have granted leave to amend even after plaintiffs had “five previous attempts to state [a] cognizable claim...because [the] Federal Rules suggest [that the] ‘artless drafting of a complaint should not allow for the artful dodging of a claim’”. *Driscoll v George Washington Univ.*, No. 12-0690, 2012 U.S. Dist. LEXIS 127870, at \*7 (D.D.C. Sept. 10, 2012) (alteration in original) (quoting *Poloron Prods., Inc. v. Lybrand Bros. & Montgomery*, 72 F.R.D. 556, 561 (S.D.N.Y. 1976)). There is thus no undue delay, and Opposer should be allowed to file its amended notice.

II. Opposer is entitled to amend its complaint because Applicant will not be prejudiced.

Applicant will not be prejudiced by Opposer’s amended notice. The “liberal concepts of notice pleading” is to make defendant aware of the facts.” *Harrison*, 174 F.3d at 253 (quoting *Hanson v. Hoffman*, 628 F. 2d 42, 53 (D.D. Cir. 1980)). Accordingly, an opposer is not bound by the

legal theories initially alleged unless an applicant is prejudiced on the merits. *Id.* The addition of a geographically descriptive claim, and a claim that the mark is not used “in commerce”, does not substantially change the theory of the Opposer’s notice; i.e., Applicant’s mark is not registrable because the averments set forth in the application are not accurate. *See Djourabchi v. Self*, 240 F.R.D. 5, 13 (D.D.C. 2006) (“Where ‘the amendment substantially changes the theory on which the case has been proceeding and is proposed late enough so that the opponent would be required to engage in significant new preparation the court may deem it prejudicial.’”) (quoting *Zenit Radio Corp v. Hazeltine Research Inc.*, 401 U.S. 321 (1971)); *Heller*, 2013 U.S. Dist. LEXIS 38833, at \*8. Neither are the additions of claims of geographic descriptiveness and no use “in commerce” issues “remote from the other issues in the case” because they Opposer’s notice is based on the inaccuracy of the statements in Applicant’s filing. *Djourabchi*, 240 F.R.D. at 13. Therefore, Applicant will not be “required to engage in significant new preparation” in responding to Opposer’s new claims. *Id.* Opposer seeks merely to refine its claim that Applicant’s mark cannot be registered because of the inaccuracy of the statements made in Applicant’s filing.

III. Opposer is entitled to amend its notice because the amendments will not be futile.

Opposer’s proposed amendments are not futile. “A district court may deny a motion to amend a complaint if the proposed claim

would not survive a motion to dismiss.” *Hettinga v. Ludwig*, 677 F. 3d 1085, 1099 (D.C. Cir.1996)). In order to survive a motion to dismiss, a complaint must have facial plausibility allowing the court to draw a reasonable inference that the defendant is liable for alleged misconduct. *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). The court must construe the complaint in favor of the plaintiff and grant plaintiff the benefit of all inferences derived from the facts. *Schuler v. United States*, 617 F. 2d 605, 608 (D.C. Cir. 1979).

Registration of Applicant’s mark was initially refused as geographically descriptive of the origin of Applicant’s services. Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2). A mark is primarily geographically descriptive when the following is demonstrated: (1) The primary significance of the mark is a generally known geographic place or location; (2) the services for which applicant seeks registration originate in the geographic place identified in the mark; and (3) purchasers would be likely to believe that the services originate in the geographic place identified in the mark. *In re Societe General des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987).

The words “Santa Cruz” refer to the City of Santa Cruz, in Santa Cruz County, California. Publicly available information on Google Maps and on randmcnally.com identifies Santa Cruz as a generally known place name.

Applicant indicates in its application that it is located in Santa Cruz, California. By its own admission, Applicant concedes that its services originate in the place identified in the mark.

Given that Applicant has disclaimed the exclusive use of the words “surf school” apart from the mark as shown, there can be no genuine issue that the geographical significance of “Santa Cruz” in Applicant’s mark is its primary significance, and given that Santa Cruz is neither obscure or remote, a public association of Applicant’s services with Santa Cruz can be presumed where Applicant’s services originate in Santa Cruz. TMEP § 1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California).

Applicant has attempted to overcome geographic descriptiveness of its mark by amending its application to seek registration under Trademark Act Section 2(f) on the basis of five years’ use in commerce. Accordingly, Applicant submitted a declaration stating that its mark had been in “substantially exclusive and continuous use in commerce” for at least five years immediately prior to the date of its declaration.

Even a brief and cursory exploration of the Internet shows that there are many businesses located in the City of Santa Cruz that incorporate the words “Santa Cruz” into the source identification of the goods or services they sell. Some examples are Santa Cruz Bicycles, Santa Cruz Skateboards, Santa Cruz Boardroom, Santa Cruz Millwork

and Santa Cruz Electronics. Accordingly, Applicant can hardly claim that its use of “Santa Cruz” is exclusive, nor that the use of Santa Cruz generally is not primarily for purposes of geographical descriptiveness.

IV. Conclusion.

For the foregoing reasons, Opposer requests that the Board grant it leave to file the attached amended Notice of Opposition.

Date: September 11, 2015

/ s / Barbara Burns  
Barbara Burns  
bburns@praxislegalsolutions.com

PRAXIS LEGAL SOLUTIONS LLC  
4 Ocean Avenue  
Box 13  
Ocean Grove, New Jersey 07756  
(732) 988-5362

CERTIFICATE OF SERVICE

A copy of the foregoing Motion for Leave to Amend Notice of Opposition has been filed electronically through ESTTA and served by USPS First Class Mail, postage prepaid on September 11, 2015 to the *pro se* Applicant:

David K. Meyberg, Esq.  
132 Alta Avenue  
Santa Cruz, California 95060

/ s / Barbara Burns  
Barbara Burns

**SENDER: COMPLETE THIS SECTION**

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

David Meyberg, Esq.  
 132 Alta Avenue  
 Santa Cruz, California 95060

2. Article Number  
(Transfer from service)

7013 2250 0001 5746 1174

PS Form 3811, July 2013

Domestic Return Receipt

**COMPLETE THIS SECTION ON DELIVERY**

A. Signature

X

D Meyberg

Agent

Addressee

B. Received by (Printed Name)

D Meyberg

C. Date of Delivery

9/14/15

D. Is delivery address different from item 1?  Yes

If YES, enter delivery address below:  No



3. Service Type

Certified Mail®

Priority Mail Express™

Registered

Return Receipt for Merchandise

Insured Mail

Collect on Delivery

4. Restricted Delivery? (Extra Fee)

Yes

**SENDER: COMPLETE THIS SECTION**

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

David Meyberg, Esq.  
 214 Lighthouse Avenue  
 Santa Cruz, California 95060

2. Article Number  
(Transfer from service label)

7013 2250 0001 5746 1181

PS Form 3811, July 2013

Domestic Return Receipt

**COMPLETE THIS SECTION ON DELIVERY**

A. Signature

X

D Meyberg

Agent

Addressee

B. Received by (Printed Name)

D Meyberg

C. Date of Delivery

9/14/15

D. Is delivery address different from item 1?  Yes

If YES, enter delivery address below:  No



3. Service Type

Certified Mail®

Priority Mail Express™

Registered

Return Receipt for Merchandise

Insured Mail

Collect on Delivery

4. Restricted Delivery? (Extra Fee)

Yes