

This Opinion is not a
Precedent of the TTAB

Mailed: October 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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John Edward Guzman
d/b/a Club Ed Surf School and Camp

v.

The New Santa Cruz Surf School, LLC

—
Opposition No. 91220843
—

Barbara Burns, Praxis Legal Solutions LLC, for John Edward Guzman d/b/a Club Ed Surf School and Camp.

Patrick T. Reilly, Esq., for The New Santa Cruz Surf School, LLC.

—
Before Zervas, Cataldo and Ritchie,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

The New Santa Cruz Surf School, LLC (“Applicant”), seeks to register SANTA CRUZ SURF SCHOOL in standard characters on the Principal Register under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for the following International Class 41 services:

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.¹

The term SURF SCHOOL has been disclaimed.

John Edward Guzman d/b/a Club Ed Surf School and Camp (“Opposer”) asserts in his amended notice of opposition (filed on September 11, 2015) that he is a competitor of Applicant and has been providing instruction in surfing, boogie boarding and standup paddle boarding, as well as the rental of surfboards, boogie boards, stand-up paddle boards and paddles and wetsuits, for more than 20 years.² Opposer alleges in its amended complaint that SANTA CRUZ SURF SCHOOL is geographically descriptive pursuant to Section 2(e)(2) of the Trademark Act, 15, U.S.C. § 1052(e)(2), and that Applicant’s claim of acquired distinctiveness under Section 2(f) based on the substantially exclusive and continuous use of its mark for at least five years prior to its written statement is “erroneous” due to other uses of SANTA CRUZ, *e.g.*, “Santa Cruz Bicycles, Santa Cruz Skateboards, Santa Cruz Boardroom, Santa Cruz Millwork and Santa Cruz Electronics.”³

With regard to an answer to the amended notice of opposition, the record reflects that the Board extended Applicant’s time to respond to Opposer’s motion to amend the notice of opposition on January 20, 2016, and Applicant filed a “Notice of Non-

¹ Application Serial No. 86266634, filed April 29, 2014 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use anywhere on October 15, 1998, and first use in commerce on October 30, 1998. The English translation of “Santa Cruz” in the mark is “Holy Cross.”

² Amended notice of opposition at ¶2, 9 TTABVUE 12.

³ 9 TTABVUE 11-15.

Opposition to Opposer’s Motion for Leave to File an Amended Opposition” on February 5, 2016. After the Board granted the motion to amend the notice of opposition and allowed Applicant time to file an answer, Applicant filed its “Answer to Opposer’s Amended Notice of Opposition” on February 26, 2016, which primarily addresses Opposer’s *motion* to amend the notice of opposition rather than the contents of the amended notice of opposition, and which does not comply with Trademark Rule 2.106(b)(2), 37 C.F.R. § 106(b)(2) (“An answer shall state in short and plain terms the applicant’s defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies.”).

Opposer states in its trial brief that Applicant’s answer to the amended notice of opposition is “unacceptable as to form and does not establish denials and defenses for use at trial”; “Applicant should not be allowed to offer any unpleaded denials and unpleaded defenses because of its failure to properly answer”;⁴ and “Applicant has not set forth any specific denials, save a generous construction of the mark as not primarily geographically descriptive.”⁵

Opposer, however, stated in its March 15, 2016 submission that “Applicant filed its Answer to Opposer’s Amended Notice of Opposition” on February 26, 2016, and later in the same submission refers to Applicant’s filing as “its Answer.”⁶ Additionally, Opposer never sought default judgement for Applicant’s failure to file a

⁴ Opposer’s brief at 8-9, 27 TTABVUE 9-10.

⁵ *Id.*

⁶ “Opposer’s Notice of Non-Opposition to Applicant’s Request to Re-Open Discovery,” 21 TTABVUE 2.

proper answer to the amended pleading but rather waited over eight months, until the filing its trial brief on October 11, 2016, to object to Applicant's failure to answer the amended notice of opposition. Thus, despite Opposer's arguments and Fed. R. Civ. P. 8(b)(6)⁷ which permits the Board to deem admitted any portion of an allegation that has not been denied, we construe Applicant's "Answer to Opposer's Amended Notice of Opposition," as denying the salient allegations of the amended notice of opposition. We hold Applicant to its admissions made in its answer to the original notice of opposition, however, including its admission (discussed below) that "Club Ed Surf School and Camp is now and has been in operation in Santa Cruz since 1990."⁸

Both Applicant and Opposer agree that this opposition involves the following issues:⁹

1. Whether SANTA CRUZ SURF SCHOOL has acquired distinctiveness through use in interstate and foreign commerce;
2. Whether SANTA CRUZ SURF SCHOOL primarily identifies the services Applicant provides rather than the city of Santa Cruz, California; and
3. Whether the term "Santa Cruz" is incapable of serving as a mark because it is generic.

Genericness, identified as No. 3 above, was not pleaded by Opposer. We consider genericness to have been tried by the consent of the parties pursuant to Fed. R. Civ. P. 15(b) (issues not raised by the pleadings are tried by the express or implied consent

⁷ Fed. R. Civ. P. 8(b)(6) is made applicable to Board proceedings pursuant to Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a).

⁸ Applicant's answer ¶ 2, 4 TTABVUE 1.

⁹ Applicant's brief at 5, 28 TTABVUE 6; reply at 6, 30 TTABVUE 7.

of the parties, and shall be treated in all respects as if they had been raised in the pleadings). *See also*, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 507.03(b) (June 2017).

In addition, we address the following issues:

- (i) whether Applicant’s statement of five-years use submitted during the prosecution of its application establishes that its mark has acquired distinctiveness; and
- (ii) if Applicant’s statement of five years use does not establish acquired distinctiveness, whether Applicant has established through its evidence submitted in this proceeding that its mark has acquired distinctiveness.

Opposer also asserts that this proceeding involves a claim of geographic descriptiveness. Applicant, however, seeks registration of SANTA CRUZ SURF SCHOOL pursuant to Section 2(f) of the Trademark Act, and hence has admitted that the designation is not inherently distinctive based on the primarily geographically descriptive nature of the mark. *Kasco Corp. v. Southern Saw Serv., Inc.*, 27 USPQ2d 1501, 1506 n.7 (TTAB 1993) (applicant conceded that its alleged mark was not inherently distinctive when it did not reserve its rights when amending its application to claim acquisition of distinctiveness under Section 2(f)). *See also*, *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”). Geographic descriptiveness is therefore *not* an issue before us.

The Record

In addition to the pleadings and Applicant's opposed application, which is automatically of record pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the evidence of record consists of the following:

- Opposer's first notice of reliance upon:
 - (i) Opposer's first set of interrogatories and Applicant's responses thereto;¹⁰
 - (ii) Opposer's first requests for admissions and Applicant's responses thereto,¹¹ including its admission to Request for Admissions No. 1 providing that "documents submitted in response to the Requests for Production of Documents ... are genuine"; and
 - (iii) Opposer's first request for production of documents and Applicant's responses thereto where documents were produced in support of Applicant's non-admissions to Opposer's first requests for admissions, as well as various documents produced by Applicant relating to Applicant's response to Opposer's Request for Admissions No 1.¹²
- May 2, 2016 testimony deposition with exhibits of Mr. Dylan Greiner, owner of Applicant's predecessor-in-interest Santa Cruz Surf School, Inc., submitted by Applicant.
- June 28, 2016 testimony deposition with exhibits of Mr. David K. Meyberg, the sole member of Applicant, submitted by Applicant.
- Opposer's rebuttal notice of reliance, submitting an Office Action issued in connection with the opposed application.

¹⁰ 19 TTABVUE.

¹¹ *Id.*

¹² 19 TTABVUE.

Opposer's Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show “both a ‘real interest’ in the proceedings as well as a ‘reasonable basis’ for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer has not offered any evidence or comment in its briefs regarding its standing.

As noted above, however, Applicant, admitted in its answer to the original notice of opposition that “Club Ed Surf School and Camp is now and has been, in operation in Santa Cruz since 1990.”¹³ Applicant has not sought to withdraw this admission, and, as also noted above, did not admit or deny any of the specific allegations of the amended notice of opposition in his “Answer to Opposer’s Amended Notice of Opposition.” Additionally, Opposer’s Request for Admission No. 25 states, “Admit that Applicant sent a cease and desist letter, dated February 5, 2015, to Opposer, claiming registration of the mark SANTA CRUZ SURF SCHOOL in the United States

¹³ Answer to notice of opposition, ¶ 3, 4 TTABVUE 2.

Patent and Trademark Office.”¹⁴ Although Applicant stated it does not admit the request for admission, it added:

[Applicant] recognizes its unfortunately inaccurate phrasing in the referenced Cease and Desist Letter of having “registered the trademark” and to a “Register No.”. [sic] Applicant notes, however, that the U.S. Trademark Application No. 86/266,634 was provided in the referenced letter, and that the letter’s recipient were [sic] thereby on notice that the references therein were directed to an Application for Registration and not to a completed registration.

Because of Applicant’s statements concerning a cease and desist letter regarding the SANTA CRUZ SURF SCHOOL designation to Opposer, and because Applicant has not contested Opposer’s standing in its brief, we find that Opposer has both a real interest in the proceeding as well as a reasonable basis for its belief of damage and that Opposer has standing to maintain this opposition. *See Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062.

Burdens of Proof

Opposer bears the burden of proving genericness as plaintiff in its opposition. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 & n.2 (Fed. Cir. 2015).

Opposer also has the initial burden of showing that Applicant’s mark has not acquired distinctiveness. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) (a party challenging the sufficiency of an applicant’s § 2(f) showing “must have at least the initial burden of challenging or

¹⁴ 19 TTABVUE 45.

rebutting the applicant's evidence of acquired distinctiveness made of record during prosecution which led to publication of the proposed mark"). When an opposer has met its initial burden challenging the sufficiency of applicant's proof of acquired distinctiveness, an applicant may then present additional evidence and argument to rebut opposer's showing and to establish that its mark has acquired distinctiveness. *Id.* at 1005. In this regard, the ultimate burden of persuasion on the issue of acquired distinctiveness is on Applicant. *Id.* at 1006.

Genericness

We now consider Opposer's challenge to registration of Applicant's designation on the ground that it is unregistrable on the basis of genericness. As the Court of Appeals for the Federal Circuit explained in *Princeton Vanguard*:

A generic term "is the common descriptive name of a class of goods or services." *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 [228 USPQ 528, 530] (Fed. Cir. 1986). Because generic terms "are by definition incapable of indicating a particular source of the goods or services," they cannot be registered as trademarks. *Dial-A-Mattress [Operating Corp.]*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001). "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *Marvin Ginn*, 782 F.2d at 989-90.

We have said that determining a mark's genericness requires "a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *Id.* at 990. Evidence of the public's understanding of the mark may be obtained from "any competent source, such as consumer surveys, dictionaries, newspapers and other publications." *In re Northland*

Aluminum Prods., Inc., 777 F.2d 1556, 1559 [227 USPQ 961] (Fed. Cir. 1985).

Princeton Vanguard, 114 USPQ2d at 1830.

Opposer's only support for his contention that Applicant's designation is generic is Applicant's statement in its "Answer to Opposer's Amended Notice of Opposition" providing that "the term 'Santa Cruz' as it currently exists has become a generic term evoking a spirit of excitement embodied in the realm of extreme sports, and particularly in the realm of board sports."¹⁵ Applicant explained in its brief that it did not make the statement in the trademark sense, but rather in the sense that "it identifies a spirit, not a good or service. There is no genus of 'Santa Cruz' for which Applicant's product is a species. Nothing stops other surf schools from competing with it."¹⁶

Opposer bears the burden of proving genericness as plaintiff in its opposition. *Id.* In view of the lack of evidence concerning the inquiry set forth in *Marvin Ginn*, 228 USPQ at 530, and Applicant's explanation for its statement in its "Answer to Opposer's Amended Notice of Opposition," we find that Opposer has not met its burden of proof on the ground of genericness and dismiss the opposition on the ground of genericness.¹⁷

¹⁵ 20 TTABVUE 3.

¹⁶ Applicant's brief at 12, 28 TTABVUE 13.

¹⁷ Opposer included a throwaway motion for judgment on the pleadings at pp. 8-9 of its main brief on the basis that Applicant's designation is incapable of registration under Section 2(f) because it is a generic term. 27 TTABVUE 9-10. Opposer's motion is denied as moot, and as untimely. *See* TBMP § 504.01 ("in order to avoid a disruption or delay in the trial phase of a Board proceeding, a motion for judgment on the pleadings must be filed prior to the deadline for pretrial disclosures for the first testimony period, as originally set or as reset.").

Secondary Meaning

We now consider whether Applicant's applied-for mark has acquired secondary meaning. Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as prima facie evidence that the mark has acquired distinctiveness as used in commerce with the applicant's goods or services. Trademark Rule 2.41(a)(3), 37 C.F.R. § 2.41(a)(3), states that an applicant may submit, in support of registration under Section 2(f), "appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith ... and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness."

"To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005).

Applicant submitted the declaration dated November 5, 2014 of its principal, David Meyberg, with its November 25, 2014 response to the Examining Attorney's first Office Action, attesting that "the mark has become distinctive of the services through Applicant's substantially exclusive and continuous use in commerce for at

least ... five years ...”¹⁸ The Examining Attorney accepted the declaration as evidence of acquired distinctiveness of Applicant’s mark. At trial, Applicant offered additional evidence.

Whether the statement of five years’ use is sufficient in and of itself to establish acquired distinctiveness depends on the degree to which the mark is descriptive. If the mark is highly descriptive of the goods or services named in the application, the statement of five years’ use alone will be deemed insufficient to establish acquired distinctiveness. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (Board was within its discretion not to accept applicant’s allegation of five years’ use given the highly descriptive nature of the mark); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1766 (TTAB 2013) (“Given the highly descriptive nature of registrant’s mark [ANNAPOLIS TOURS], continuous use alone since 1992 would not be sufficient to establish acquired distinctiveness.”). *See also*, TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1212.05(a) (April 2017).

Opposer has not offered evidence to demonstrate the level of descriptiveness of Applicant’s designation but relies on Applicant’s statement in its “Answer to Opposer’s Amended Notice of Opposition” to establish weakness as a source indicator. Because of the lack of evidence regarding any significant weakness of Applicant’s mark as a source indicator, we find that the designation has an ordinary level of descriptiveness and that a declaration attesting to substantially exclusive and

¹⁸ Nov. 25, 2014 response, TSDR 2; Meyberg Depo. Exh. A, 24 TTABVUE 72.

continuous use of a designation as a mark in commerce for the five years before the date on which the claim of distinctiveness is made *may* establish acquired distinctiveness of Applicant's designation. Applicant's disclaimer of the SURF SCHOOL, however, constitutes a tacit admission that SURF SCHOOL is generic for the identified services. *See Alcatraz Media*, 107 USPQ2d at 1762 (citing *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986)).

Opposer challenges the accuracy of Mr. Meyberg's statements in his declaration. According to Opposer, while the declaration states that "[t]he mark has become distinctive of the services through Applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement," the mark has not been in "substantially exclusive use" or "continuous use" during the five-year period. We consider whether SANTA CRUZ SURF SCHOOL has been in "substantially exclusive use" or "continuous use" during the five-year period in the following paragraphs.

Exclusive use

Opposer relies on Applicant's failure to properly answer its allegation in its amended pleading regarding the use of SANTA CRUZ marks by third-parties as an admission of the existence of such marks. As discussed above, we do not consider Applicant's failure to file a proper answer as an admission of Opposer's allegations regarding non-exclusive use. At best, Opposer may rely on "Santa Cruz Bicycles," referenced in Applicant's admission to Opposer's Request for Admission No. 12.¹⁹

¹⁹ Opposer also references Applicant's response to Request for Admissions Nos. 26 and 27 (concerning cease and desist letters) at p. 14 of its brief, 27 TTABVUE 15, but the response

Even if the rental or sale of bicycles is related to the services identified in the opposed trademark application, however, “Santa Cruz Bicycles” constitutes only one use, and there is no information as to how extensive such use is. In addition, Mr. Greiner testified that nobody else was operating under the name SANTA CRUZ SURF SCHOOL at any time after he acquired the Santa Cruz Surf School and SANTA CRUZ SURF SCHOOL mark from Anne Bailey in late 2000 or 2001.²⁰ (Apparently, Ms. Bailey owned the school since 1997.²¹) Opposer has hence not established that Applicant’s use was not substantially exclusive during the five-year period prior to November 5, 2014, the date of Mr. Meyberg’s declaration. *See Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1404 (TTAB 2016) (finding that, because of widespread third-party uses of the surname Ayoub in connection with rug, carpet and flooring businesses, applicant’s use of the applied-for mark, AYOUB, was not “substantially exclusive” and thus the mark had not acquired distinctiveness in connection with applicant’s identified carpet and rug services); *Nextel Commc’ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009) (finding opposer’s extensive contemporaneous use of the mark in connection with services closely related to applicant’s goods rose to the level necessary to rebut applicant’s contention of substantially exclusive use); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1682-83 (TTAB 2007) (finding substantial use of mark by opposer’s parent company and

to each request is “Not Admitted” and we cannot determine the mark and underlying services which are the subject of the requested admissions.

²⁰ Greiner Depo. at 4 and 18, 23 TTABVUE 5 and 19.

²¹ Applicant’s Resp. to Interrog. Nos. 4 and 8, 19 TTABVUE 15 and 16.

additional use of mark by numerous third parties “seriously undercuts if not nullifies applicant’s claim of acquired distinctiveness.”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1357-58 (TTAB 1989) (“[T]he existence of numerous third party users of a mark, even if junior, might well have a material impact on the Examiner’s decision to accept a party’s claim of distinctiveness.”).

Continuous use

We consider next whether the use of SANTA CRUZ SURF SCHOOL by Applicant and its immediate predecessor-in-interest was continuous during the five-year period from November 5, 2009 to November 5, 2014, prior to the November 5, 2014 date of Mr. Meyberg’s declaration, and set forth the salient facts and testimony as presented to us in the record.

Dylan Greiner owned and operated Santa Cruz Surf School, Inc. in Santa Cruz, California from 2009 to approximately August 16, 2013, when he was arrested and imprisoned.²²

The record is slim, but does reflect that Mr. Greiner provided surfing lessons between 2006 to 2010 to Mendocino Community School and Mendocino High School in California;²³ between 2000 and 2012 at Asilomar Beach, California;²⁴ and in December of 2011 in New Smyrna Beach Florida.²⁵ In addition, Mr. Greiner testified

²² 24 TTABVUE 8 and 11; 23 TTABVUE 5; Applicant’s brief at 6, 29 TTABVUE 7; Answer to notice of opposition ¶ 2, 4 TTABVUE 1.

²³ Greiner Depo. at 39-40, 23 TTABVUE 40-41.

²⁴ Greiner Depo. at 41, 23 TTABVUE 42.

²⁵ Greiner Depo. at 10 and 26-27, 23 TTABVUE 11 and 27-28. Applicant’s Resp. to Interrog. Nos. 14 and 15, 19 TTABVUE 17-18.

he owned an active website promoting his services during the time he provided surfing lessons,²⁶ but did not provide any information about the number of visitors to the website.

Mr. Meyberg, Applicant's sole member who is also an attorney licensed to practice law in California, provided legal services to Mr. Greiner and Santa Cruz Surf School, Inc. as early as 2005. Mr. Meyberg testified he was in monthly or quarterly contact with Mr. Greiner; he periodically provided surfing lessons; he would "regularly go to his shop to meet with [Mr. Greiner] and discuss business matters"; and Mr. Greiner "was in business non-stop every month from when I first became involved with helping the surf school all the way ... until he was basically incarcerated ... and actually even after that."²⁷ Mr. Meyberg added, however, that after Mr. Greiner's arrest, "classes went on, I think ... for a few days as the publicity and the, you know, the incident became more known through press and news coverage[,] the customers basically dwindled to ... a stop."²⁸

Applicant acquired the surf school and designation SANTA CRUZ SURF SCHOOL from Santa Cruz Surf School, Inc. pursuant to a Business Sale Agreement, dated December 17, 2013.²⁹ The Business Sale Agreement provides insight into the condition of the business purchased by Mr. Meyberg. It states:

The business has not been operating for several months.
The business currently does not have a physical business
location due to cancellation of the commercial lease. The

²⁶ Greiner Depo. at 7-8, 15, 22 and 41; 24 TTABVUE 8-9, 16, 23 and 42.

²⁷ Meyberg Depo. at 7-9, 11 TTABVUE 10-12.

²⁸ Meyberg Depo. at 11, 23 TTABVUE 14.

²⁹ 24 TTABVUE at 13; *see also* Exh. B to Meyberg's Depo., 24 TTABVUE 74-75.

insurance policy which is required to operate the business was cancelled. The website is not operating and has an outstanding bill. Numerous independent contract[or]s who taught lessons were never paid their last pay check. The business operating permit will expire at the end of December 2013 and the City of Santa Cruz's Parks and Recreation Department's Heads have expressed their intent to not renew the operating permit. The vehicle trailer is not registered. The business' reputation and good will has been substantially diminished.³⁰

³⁰ Greiner Depo. Exh. B, 23 TTABVUE 61-62; Meyberg Depo. Exh. B, 24 TTABVUE 74-75. These statements are not hearsay pursuant to Fed. R. Evid. § 803(15), which identifies the following exception to the rule against hearsay:

(15) Statements in Documents That Affect an Interest in Property. A statement contained in a document that purports to establish or affect an interest in property if the matter stated was relevant to the document's purpose — unless later dealings with the property are inconsistent with the truth of the statement or the purport of the document.

Thus, “[u]nder the plain meaning of Rule 803(15), hearsay statements are admissible if they are contained within a document that affects an interest in property, if the statements are relevant to the purport of the document, and if dealings with the property since the document was made have not been inconsistent with the truth of the statements.” *U.S. v. Boulware*, 384 F.3d 794, 807 (9th Cir. 2004), citing *Silverstein v. Chase*, 260 F.3d 142, 149 (2d Cir.2001). Mr. Greiner and Mr. Meyberg respectively authenticated the document, *i.e.*, the sales agreement. Greiner Depo. at 6, 23 TTABVUE 7; Meyberg Depo. at 10, 24 TTABVUE 11. The sales agreement affects an interest in property, *i.e.*, the sale of the business, and specifically mentions a “trademark/tradename” as part of the “business enterprise” and is relevant to the document's purpose, *i.e.*, the transfer of the property to Applicant. Later dealings with the trademark and the business are not inconsistent with the sales agreement.

See also, Notes of the Advisory Committee on the 1972 Proposed Rules stating:

Dispositive documents often contain recitals of fact. Thus a deed purporting to have been executed by an attorney in fact may recite the existence of the power of attorney, or a deed may recite that the grantors are all the heirs of the last record owner. Under the rule, these recitals are exempted from the hearsay rule. The circumstances under which dispositive documents are executed and the requirement that the recital be germane to the purpose of the document are believed to be adequate guarantees of trustworthiness, particularly in view of the nonapplicability of the rule if dealings with the property have been inconsistent with the document.

At a minimum, the Santa Cruz Surf School was not in operation from the time of Mr. Greiner's arrest until the purchase of the surf school by Applicant, a period of four months in the fall of 2013.³¹ There is no indication in the record that employees or contractors provided the services identified in the opposed trademark application while Mr. Greiner was in prison, before Applicant started using SANTA CRUZ SURF SCHOOL.

Only four checks made out to "Santa Cruz Surf School" are in the record; they are all dated between December 2015 and June 2016.³² There are numerous emails from customers in the record inquiring about surfing lessons; many of the emails do not indicate a year or are dated in June 2015 or later.³³

Opposer argues that Applicant did not receive a business license until May 31, 2015, and hence had lawful use "approximately 19 months after the time that Applicant stated that the business of the surf school had 'dwindled ... to a stop', but 21 months after the arrest of Dylan Greiner" ³⁴ We do not agree with Opposer's time calculations; the Meyberg declaration attesting to use is dated November 5, 2014, which is 14 months after Mr. Greiner's arrest on August 16, 2013, and Applicant's business license indicates that Applicant paid for the license on June 5, 2014.³⁵

³¹ Meyberg Depo. at 11-12, 24 TTABVUE 14-15. *See also*, Exh. B to Mr. Meyberg's Depo., 24 TTABVUE 74-75.

³² Meyberg Depo. Exh. E, 24 TTABVUE 86.

³³ Meyberg Depo. Exh. F, 24 TTABVUE 87-105.

³⁴ Opposer's brief at 25, 27 TTABVUE 26; Meyberg Depo. at 12, 24 TTABVUE 15.

³⁵ Meyberg Depo. Exh. H, 24 TTABVUE 113.

Opposer also points out that Mr. Meyberg's declaration states that SANTA CRUZ SURF SCHOOL has been used for five years prior to November 5, 2014, but his corporation acquired the surf school approximately one year earlier on December 17, 2013; and Applicant denied certain requests for admissions on the basis that Applicant "cannot speak to the knowledge or belief of its predecessors in interest."³⁶ Applicant is silent as to how it can attest to matters that occurred prior to December 17, 2013, during the prosecution of the application, but not during this proceeding. We are troubled by Applicant's inconsistency, but, in view of our ultimate resolution of this case, we have considered all of Applicant's statements and responses.

As noted, Mr. Greiner was arrested on August 16, 2013, and there is no documentary evidence in the record demonstrating that Applicant's predecessor and Applicant offered surfing lessons or the rental of surfboards for more than one year after Mr. Greiner's arrest. There is also an absence of documentary evidence regarding the provision of surfing lessons and the rental of surfboards by the "independent contracts [*sic*] who taught lessons" referenced in the Business Sale Agreement from essentially the date that Mr. Greiner was arrested and throughout 2014 (the business licenses in the record are not evidence of use of the mark in commerce)³⁷; and the "Business Sale Agreement" describes a defunct business. Based

³⁶ See, e.g., 19 TTABVUE 41, responding to Req. for Admissions No. 9.

³⁷ Mr. Meyberg's statement that "I would regularly see people wearing the hats, tank tops, shirts and sweat shirts [of Santa Cruz Surf School], you know, around Santa Cruz,"³⁷ is not helpful to Applicant because the time period Mr. Meyberg is referring to is unclear, and Applicant does not contend that the hats, tank tops, shirts and sweat shirts constitute promotion of the mark for the specific services identified in the application.

on this record, we find that SANTA CRUZ SURF SCHOOL was not used from approximately August 16, 2013 until after November 5, 2014 at least insofar as “educational services, namely, conducting surfing lessons in the field of ocean recreation” and “rental of surf boards.”

As for the website services in Applicant’s identification, *i.e.*, “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,” Mr. Greiner testified that he operated a website which he used to “promote the services of teaching surfing in the ocean”;³⁸ and that the website was in existence from 2000 to 2012.³⁹ However, the Business Sale Agreement states that the website was not operating and had an outstanding bill.⁴⁰ We therefore find that Applicant’s designation was not in continuous use for five years preceding the date of Mr. Meyberg’s declaration.

In sum, we find that Mr. Meyberg’s declaration does not establish acquired distinctiveness of Applicant’s mark for any of Applicant’s identified services.

Additional evidence

We now consider whether the record adduced at trial suffices to demonstrate acquired distinctiveness, particularly through the trial testimony of Messrs. Greiner and Meyberg, and exhibits. Trademark Rule 2.41(a), 37 C.F.R. § 2.41(a), allows that:

In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant’s

³⁸ Greiner Depo. at 7, 23 TTABVUE 8.

³⁹ Greiner Depo. at 22 and 41, 23 TTABVUE 23 and 42.

⁴⁰ Greiner Depo. Exh. B, 23 TTABVUE 74-75.

goods or services, the applicant may, in support of registrability, submit ... verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

At best, Applicant's evidence reflects use of SANTA CRUZ SURF SCHOOL from approximately 1997⁴¹ until trial, with an interruption of more than one year from late 2013 through 2014. The passage of time alone, however, may be insufficient to establish secondary meaning. *See In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (deeming use of mark for sixteen years "a substantial period but not necessarily conclusive or persuasive on the Section 2(f) showing"). Additionally, the record reveals use of SANTA CRUZ SURF SCHOOL by Applicant for less than five years and limited advertising or promotional efforts by Applicant and its predecessors-in-interest⁴²; and is incomplete regarding (i) Applicant's and its

⁴¹ Applicant's Resp. to Interrog. Nos. 4 and 8, 19 TTABVUE 15 and 16.

⁴² Mr. Meyberg testified at p. 19, 24 TTABVUE 22:

[W]hat sort of marketing materials and goods that were marked with the mark Santa Cruz Surf School were you aware of? ...

A. In addition to, you know, the documents here, I would regularly see at the surf school and around town people wearing hats, shirts, sweat shirts, tank tops with the Santa Cruz Surf School logo and business name on it. ... There ... was a sign that was regularly posted in front of the surf school, and I believe that there was signage even on different vehicles when I was, you know, when I would visit the business office or business location in person. ... I would see stickers posted around everywhere with Santa Cruz Surf School. In fact, I still see them on the doors to markets and to other business establishments.

predecessors-in-interest's volume of sales under the mark,⁴³ and (ii) the internet traffic generated by the website operated by Applicant and its predecessors-in-interest. There is no evidence of copying, or media recognition of SANTA CRUZ SURF SCHOOL. *See Steelbuilding.com*, 75 USPQ2d at 1424. The impression created by the evidence in the record, including any evidence not specifically mentioned in this opinion, is that Applicant and its predecessors-in-interest have provided the services identified in the involved application to only a limited number of customers on an irregular basis. We therefore conclude that Applicant has not satisfied its burden of demonstrating that SANTA CRUZ SURF SCHOOL has acquired distinctiveness.

Decision: The opposition is sustained on the ground that SANTA CRUZ SURF SCHOOL is geographically descriptive and has not acquired distinctiveness. Registration to Applicant is refused.

⁴³ Mr. Meyberg testified that Applicant provides from five to twelve lessons per week. Meyberg Depo. at 64, 24 TTABVUE 67. He did not indicate when Applicant began providing this number of lessons.