

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 11, 2015

Opposition No. 91220843

*John Edward Guzman DBA Club Ed Surf
School and Camp*

v.

The New Santa Cruz Surf School, LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

On May 8, 2015, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were Barbara Burns, attorney for Opposer, David Meyberg, sole Member of Applicant, a limited liability company of California, acting pro se, and Elizabeth Dunn, attorney for the Board.¹ The Board informed the parties that phone conferences may not be recorded, but an order summarizing the discussion would issue. Opposer requested Board participation to facilitate the discussion of disclosure and discovery.

STIPULATION

The parties have agreed to accept service by email.

RELATED PROCEEDINGS

¹ TTAB Attorney Michael Webster also attended the conference.

As set forth in the institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding, or a civil action, which involve related marks or issues of law or fact which overlap with this case. The parties confirmed no related proceeding is pending.

The Board notes that there was a brief discussion about the civil action in California state court between Applicant and the City of Santa Cruz, involving permitting issues. Because neither Applicant's mark nor Applicant's ability to offer the services listed in the opposed application will be affected by the civil action, there is no potential impact on this proceeding.

SETTLEMENT

Unlike the federal courts, the Board does not take an active role in promoting settlement. As discussed, because its jurisdiction is limited to registrability determinations, the Board's role in settlement is limited. The Board has no authority to enforce settlement provisions regarding the use of marks.

The Board is liberal in granting stipulations to suspend proceedings to allow settlement discussions, and is available to discuss whether prospective amendments to the opposed application or subject registration would be acceptable. Stipulations to suspend the proceeding should be filed promptly because, absent suspension, the Board expects the parties to adhere to the disclosure, discovery, and trial deadlines already set by the Board. *See Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (“[I]t is well established that the mere existence of settlement negotiations alone does not justify a party's inaction or delay.”).

PLEADED CLAIMS AND DEFENSES

The opposed application Serial No. 86266634 to register the mark SANTA CRUZ SURF SCHOOL for “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” alleges use in commerce since October 30, 1998, and was approved for publication based on a claim of acquired distinctiveness under Trademark Act Sec. 2(f), and a disclaimer of SURF SCHOOL.

Opposer pleads that its Santa Cruz surf school has been in operation since 1990 under the name “Club Ed Surf School”. Opposer also pleads that the Santa Cruz surf school known as “Surf School Santa Cruz” has been in operation since 2010; that the Santa Cruz surf school known as “The Richard Schmidt Surf School” has been in operation since 1978; that Applicant has not used the mark in commerce for the five years prior to the November 25, 2014 filing date of its declaration of acquired distinctiveness; that the opposed mark has not acquired distinctiveness based on Applicant’s substantially exclusive and continuous use of the mark SANTA CRUZ SURF SCHOOL, and thus registration of Applicant mark’s mark should be denied.

Inasmuch as Opposer pleads that it is a competitor to Applicant, the notice of opposition includes a sufficient pleading of Opposer’s standing. *See Eastman Kodak Co. v. Bell & Howell Document Management Products Co.*, 23 USPQ2d 1878, 1879

(TTAB 1992), *aff'd* 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993) (party challenging mark on descriptiveness grounds may establish standing by pleading and proving it is engaged in manufacture or sale of related products). The notice of opposition also pleads the legally sufficient claim that the subject mark lacks the necessary acquired distinctiveness. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”). While it would have been better to plead also that, absent acquired distinctiveness, the mark SANTA CRUZ SURF SCHOOL is unregistrable as primarily geographically descriptive, this is not a fatal defect because seeking registration under Trademark Act Sec. 2(f) is an admission that the mark is not inherently distinctive. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (“Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact”); *The 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”).

Applicant filed an answer which denies the salient allegations of the notice of opposition and asserts various affirmative defenses.²

ACR (ACCELERATED CASE RESOLUTION) PROCEDURES

Inasmuch as only the issue of acquired distinctiveness is at issue, the Board recommends adoption of ACR (accelerated case resolution) procedures. The Board informed the parties of basic information regarding the use of ACR procedures to expedite this proceeding, and the availability of ACR options set forth on the TTAB's webpage at www.uspto.gov. *Ballet Tech Foundation Inc. v. Joyce Theater Foundation Inc.*, 89 USPQ2d 1262, 1266 fn9 (TTAB 2008) (“ACR is a procedure akin to summary judgment in which parties can receive a determination of the claims and defenses in their case promptly, but without the uncertainty and delay typically presented by standard summary judgment practice. In order to take advantage of ACR, the parties must stipulate that, in lieu of trial, the Board can resolve any material issues of fact ... After the briefs are filed, the Board will issue a decision within fifty days, which will be judicially reviewable as set out in 37 CFR §2.145.”). The parties may call Board Attorney Elizabeth Dunn to arrange a conference on how to adapt existing, or come up with new, provisions addressing the needs of this proceeding. In addition, the Board will entertain any stipulations designed to save the parties time and money, such as stipulating to facts, agreeing to a shortened schedule of disclosure, discovery, and trial, and stipulating as to the admissibility of evidence.

² Inasmuch as the sufficiency of the notice of opposition was discussed during the conference, no consideration will be given to the affirmative defense (No. 1) that the notice of opposition fails to state a claim for relief.

ARRANGEMENTS FOR DISCLOSURE, DISCOVERY AND TRIAL

The scope of the pleadings determines the scope of discovery. See Fed. R. Civ. P. 26(b)(1) (“Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense...”). The parties are expected to promptly respond to discovery requests, and to consult Chapter 400 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2014) before refusing to provide any requested information. Unless the parties stipulate to an alternate procedure, testimony is submitted through depositions. Stipulations as to how testimony may be obtained should be filed with the Board. As indicated above, the parties remain free to stipulate to an abbreviated schedule or alternate forms of evidence. Absent such stipulation, the Board’s current schedule and rules define applicable deadlines and evidentiary requirements.

STIPULATED PROTECTIVE ORDER

The stipulated protective agreement filed on May 7, 2015 is noted and its use in this proceeding is approved. See Trademark Rule 2.116(g). The parties are referred, as appropriate, to TBMP §§ 412.04 (Filing Confidential Materials With Board), and 412.05 (Handling of Confidential Materials by the Board). The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing Trademark Rules 2.27(d) and (e), which provide that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

SCHEDULE REMAINS AS SET

Absent an agreement by the parties to change the schedule, the schedule set forth in the Board's February 27, 2015 institution and trial order remains in effect.