

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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August 15, 2022

Opposition No. 91253105 (parent)  
Opposition No. 91253653  
Opposition No. 91254743  
Opposition No. 91266658  
Opposition No. 91273419  
Opposition No. 91274777  
Opposition No. 91275687

*Chubby Gorilla, Inc.*

*v.*

*Hills Point Industries, LLC*

**M. Catherine Faint,  
Interlocutory Attorney:**

This case now comes before the Board for consideration of the following motions filed by Chubby Gorilla, Inc. (Opposer) and Hills Points Industries, LLC (Applicant):

1. Opposer's motion, filed January 20, 2022 to further consolidate these proceedings;
2. Opposer's motion, filed March 29, 2022, to suspend for civil action;
3. Applicant's motion, filed April 5, 2022, for leave to amend its Section 15 filing;  
and
4. Opposer's fully-briefed motion, filed April 22, 2022, to strike the motion for leave to amend.

While both parties have filed motions during the suspension of these proceedings for consideration of the motion to further consolidate, the Board exercises its discretion to consider the pending motions and has determined the following.

## **I. Background**

This consolidated case currently involves the following proceedings:

Opposition No. 91253105 was filed December 23, 2019, and the answer was filed March 30, 2020;

Opposition Nos. 91253653 and 91254743 were filed January 16, 2020 and March 18, 2020 with the answers to each filed on April 27, 2020;

Opposition No. 91266658 was filed on December 18, 2020; the answer and counterclaims as to all five of Opposer's pleaded registrations were filed April 14, 2021 wherein Applicant claimed ownership of Registration No. 5060102 (the '102 Registration). With its answer to the counterclaim, Opposer filed a cross-counterclaim to cancel Applicant's '102 Registration. Applicant's answer to the cross-counterclaim was filed October 26, 2021;

Opposition No. 91273419 was filed December 13, 2021 with an answer filed January 20, 2022;

Opposition No. 91274777 was filed March 1, 2022 with an answer filed April 7, 2022 and suspended pending disposition of the civil action between the parties; and

Opposition No. 91275687 was filed April 19, 2022, however, it was suspended pending disposition of the civil action between the parties prior to the filing of an answer in the Board proceeding.

## **II. Further Consolidation**

Opposer's motion to consolidate, filed March 29, 2022, seeks to add Opposition No. 91273419 to these proceedings.<sup>1</sup> The motion is granted as **conceded**. Trademark Rule 2.127(a). The Board sua sponte further consolidates subsequently filed

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<sup>1</sup> 29 TTABVUE.

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Opposition Nos. 91274777 and 91275687 with this proceeding. *See Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007) (consolidation ordered sua sponte).

The Board file will be maintained in Opposition No. 91253105 as the “parent” case. As a general rule, from this point on the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order. Because the involved proceedings, however, are consolidated prior to joinder of the issues in one of the proceedings, Applicant must file a **separate answer for each opposition in the proceeding to which it pertains**, before commencing the practice of filing a single copy of any paper in the parent case. The Board notes that no answer has been filed in Opposition No. 91275687, but that case is currently suspended pending disposition of the civil action between the parties. **A date for answer will be set upon resumption, if appropriate.**

### **III. Motion to Amend Applicant’s Section 15 Filing/Motion to Strike**

Applicant’s ‘102 Registration was the subject of a cross-counterclaim filed on June 9, 2021 in Opposition No. 91266658. On October 14, 2021, Applicant filed a combined declaration of use<sup>2</sup> and inconstestability for the ‘102 Registration under Trademark

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<sup>2</sup> Under Trademark Act §8(a), 15 U.S.C. § 1058(a), the owner of a registration must periodically file an affidavit or declaration for registrations issued on the Principal Register attesting that the registered mark is in use in commerce with the goods cited in the registration, or state on which goods the mark is no longer used, or make a showing that any nonuse is without intent to abandon the registered mark, include a specimen of use, and pay a fee.

Act Sections 8 and 15, 15 U.S.C. §§ 1058 and 1065. *See* Trademark Rule 2.168(a), 37 C.F.R. § 2.168(a). On January 31, 2022, the Section 8 declaration was accepted and the Section 15 declaration was acknowledged by the Post Registration division of the USPTO.<sup>3</sup>

On January 20, 2022, Opposer filed a motion to further consolidate and to suspend this proceeding pending determination of the motion to consolidate.<sup>4</sup> On February 1, 2022, the Board ordered suspension for consideration of the motion to consolidate.<sup>5</sup> On March 29, 2022, Opposer filed a motion to suspend for civil action.<sup>6</sup> On April 5, 2022, Applicant filed its motion to amend its registration,<sup>7</sup> and on April 22, 2022, Opposer filed a motion to strike the motion to amend.<sup>8</sup>

By its motion to amend, Applicant seeks to “amend” its registration by withdrawing its Section 15 declaration. Opposer seeks to strike the motion to amend, arguing that, as it was filed during suspension of this proceeding for determination

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<sup>3</sup> Trademark Status and Document Retrieval (“TSDR”) system, Registration No. 5060102, TSDR entry of January 31, 2022, “Notice of Acceptance Acknowledgment.” The distinction of “accepted” versus “acknowledged can be found by comparing TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §§ 1604.15 and 1605 (2022).

<sup>4</sup> 29 TTABVUE.

<sup>5</sup> 30 TTABVUE.

<sup>6</sup> 31 TTABVUE.

<sup>7</sup> 32 TTABVUE.

<sup>8</sup> 33 TTABVUE.

of a pending motion to consolidate, it is filed in violation of the Board's suspension order.<sup>9</sup>

Under Trademark Act § 15, 15 U.S.C. § 1065, a registration can achieve “incontestable” status after five years of continuous use, such that certain grounds cannot be alleged in a cancellation proceeding, upon the filing of a valid affidavit or declaration provided that:

- 1) there has not been a final decision adverse to the owner's claim of ownership of the mark for the goods and services, or the owner's right to register; and
- 2) there is no proceeding involving those rights pending in the USPTO, or in a court, which has not been finally disposed.

The filing of a Section 15 affidavit or declaration is optional. TMEP § 1605.

When the USPTO receives a Section 15 filing, it is “acknowledged” and entered into the record of the registration, but the Office does not examine the merits of the filing, nor does it make a determination that the registration is in fact incontestable. *Arman's Sys., Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 n.2. (TTAB 1982) (noting Post Registration division's function is ministerial one of receiving Section 8 and 15 affidavits or declarations and noting their receipt). However, where there is litigation involving the registration, a court has the power to examine the affidavit or declaration to determine whether the registration has attained the status of incontestability. *See e.g. Sizzler Family Steak Houses v. Western Sizzlin Steak House, Inc.*, 793 F.2d 1529, 1540–1541, 230 U.S.P.Q. 332 (11th Cir. 1986) (court determined section 15 affidavit filed during ongoing litigation had not established

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<sup>9</sup> *Id.* at 3.

incontestable status). A failure to correct a false Section 15 affidavit or declaration may also be the basis for a finding of fraud. *See e.g., Chutter, Inc. v. Great Mgmt Grp., LLC*, 2021 USPQ2d 1001, at \*13 (TTAB 2021) (finding continued failure to correct false § 15 affidavit constitutes “reckless disregard” which satisfies requisite intent for fraud claims).

As the USPTO does not review the validity of a claim of incontestability made in a Section 15 affidavit or declaration, if after its filing the owner determines that the affidavit or declaration contained an inaccuracy, the owner may not request that the affidavit or declaration be withdrawn and the fee refunded, nor is it an issue to be decided by the Board. *See, e.g., Palisades Pageants, Inc. v. Miss America Pageant*, 442 F.2d 1385, 169 USPQ 790, 792 (CCPA 1971) (whether Board abused discretion in denying motion to amend description of services was matter to be determined by Commissioner, not court since not part of central issue), *cert. denied*, 404 U.S. 938 (1971). In such situations, the owner may file a petition to the Director under Trademark Rule 2.146(a)(3), 37 C.F.R. §2.146(a)(3), requesting that the Section 15 affidavit or declaration be abandoned. *See* Trademark Rule 2.167(j), 37 C.F.R. §2.167(j); TMEP §§1702, 1704 and 1707.

The filing of a petition to the Director does not act as a stay in an inter partes proceeding, although the Board in its discretion may do so. *See In re Docrate Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm’r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay

time to file opposition or further extensions of time to oppose); and Trademark Rule 2.146(g), 37 C.F.R. § 2.146(g); *see also* TBMP § 905.

The Board finds in this instance that it will not “amend” or review Applicant’s Section 15 declaration.

In view of the foregoing, Applicant’s motion to amend the ‘102 Registration is **denied without prejudice**. Opposer’s motion to strike is **denied without prejudice** as moot.

#### **IV. Suspension for Civil Action**

The motion (filed March 29, 2022) to suspend this now consolidated proceeding pending final determination of Civil Action No. 8:22-cv-00446, styled as *Chubby Gorilla, Inc. v. Hills Point Industries, LLC*, filed in the United States District Court for the Central District of California is **granted**.<sup>10</sup> It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

Accordingly, proceedings are **suspended** pending final disposition of the civil action. Time to answer in any proceedings where answer has not yet been filed will be reset upon resumption, if appropriate.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for

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<sup>10</sup> Opposer provided a copy of the complaint. 31 TTABVUE 4-34.

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appropriate action.<sup>11</sup> Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action. During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. The Board in its discretion may consolidate any related Board cases.

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<sup>11</sup> A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).