

ESTTA Tracking number: **ESTTA1054753**

Filing date: **05/12/2020**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SUTERRA LLC
Granted to Date of previous extension	05/17/2020
Address	11444 WEST OLYMPIC BLVD. LOS ANGELES, CA 90064 UNITED STATES

Attorney information	DANIELLE M. CRIONA, ESQ. ROLL LAW GROUP PC 11444 WEST OLYMPIC BLVD., 7TH FLOOR LOS ANGELES, CA 90064 UNITED STATES danielle.criona@roll.com, ipdocketing@roll.com 3109668771
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Applicant Information

Application No	87848359	Publication date	11/19/2019
Opposition Filing Date	05/12/2020	Opposition Period Ends	05/17/2020
Applicant	Surterra Holdings, Inc. WeWork c/o Surterra 1175 West Peachtree Street, NE Atlanta, GA 30361 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. First Use: 2018/01/29 First Use In Commerce: 2018/01/29 All goods and services in the class are opposed, namely: Providing an online directory featuring information on physicians and health care providers
Class 044. First Use: 2016/12/08 First Use In Commerce: 2016/12/08 All goods and services in the class are opposed, namely: Providing a website featuring health information in the field of medical marijuana and cannabis; Providing a website featuring health information concerning cannabidiol (CBD) and tetrahydrocannabinol(THC); Wellness and health-related consulting services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2796835	Application Date	05/29/2002
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	SUTERRA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 PESTICIDES AND INSECTICIDES IN THE NATURE OF INSECT PHEROMONES FOR AGRICULTURAL, HORTICULTURAL AND DOMESTIC USE WITH INSECT TRAPS AND LURES</p> <p>Class 021. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 INSECT TRAPS AND LURES FOR USE IN PEST CONTROL</p>		

Attachments	76413173#TMSN.png(bytes) SURTERRA WELLNESS 87848359 CI 35 44 208825 OPPN.pdf(101359 bytes)
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Signature	/Danielle M. Criona/
Name	DANIELLE M. CRIONA, ESQ.
Date	05/12/2020

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

SUTERRA LLC,)	Opposition No.: _____
)	
Opposer,)	NOTICE OF OPPOSITION
)	
v.)	Mark: SURTERRA WELLNESS
)	
SURTERRA HOLDINGS, INC.,)	Application Ser. No.: 87848359
)	
Applicant.)	Published in the <i>Official Gazette</i> on
)	November 19, 2019
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Suterra LLC, a Delaware limited liability company, located and doing business at 11444 W. Olympic Blvd., Los Angeles, CA 90064 (“Opposer”), believes it will be damaged by registration of the SURTERRA WELLNESS mark set forth in application serial number 87848359 (“Application” or the “SURTERRA Mark”) in Class 35 for “*Providing an online directory featuring information on physicians and health care providers,*” and in Class 44 for “*Providing a website featuring health information in the field of medical marijuana and cannabis; Providing a website featuring health information concerning cannabidiol (CBD) and tetrahydrocannabinol (THC); Wellness and health-related consulting services*” (“Applicant’s Services”), filed by Surterra Holdings, Inc. a Delaware corporation (“Applicant”), with an address of WeWork c/o Surterra, 1175 West Peachtree Street, NE, Atlanta, Georgia 30361 and hereby opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer is one of the largest biorational pest control providers in the world and is dedicated to researching, developing, and commercializing environmentally sound products using naturally occurring compounds and biochemicals, such as pheromones.
2. Since long prior to the January 29, 2018 and December 8, 2016 first use in

commerce dates listed in the Application for the Classes 35 and 44 services, respectively, Opposer has produced, marketed and sold pest control products in interstate commerce in connection with its distinctive SUTERRA® mark.

3. Opposer is the owner of trademark registration number 2796835 issued by the United States Patent and Trademark Office for SUTERRA® in International Class 5 for “*Pesticides and insecticides in the nature of insect pheromones for agricultural, horticultural and domestic use with insect traps and lures*” and in International Class 21 for “*Insect traps and lures for use in pest control*” with a first use date of October, 2001 (the “SUTERRA® Mark”).

4. This registration is valid and subsisting and Opposer hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will rely thereon as evidence in this proceeding, and a status copy showing present title to this registration will be introduced into evidence on its behalf during Opposer’s testimony period.

5. Opposer has sold a significant amount of goods in connection with the SUTERRA® Mark.

6. Opposer and any predecessors have expended substantial sums advertising and promoting its products sold in connection with the SUTERRA® Mark throughout the United States.

7. By virtue of the popularity and industry recognition of Opposer’s goods offered in connection with the SUTERRA® Mark, Opposer has built and owns extremely valuable goodwill symbolized by, and associated with, the SUTERRA® Mark.

8. The SUTERRA® Mark is inherently distinctive as used in connection with Opposer’s products or, in the alternative, has acquired distinctiveness due to its secondary meaning.

9. The Application for and use of the SURTERRA Mark is without Opposer's consent or permission.

10. Opposer has rights in and to the SUTERRA® Mark long prior to Applicant's January 29, 2018 and December 8, 2016 first use in commerce dates listed in the Application for its services in Classes 35 and 44, respectively.

11. Opposer timely filed Requests for Extension of Time to Oppose the Application with the Trademark Trial and Appeal Board on December 9, 2019, January 13, 2020 and March 16, 2020. Opposer's requests were granted. An opposition to the Application must be filed by May 17, 2020. Therefore, this Notice of Opposition is being timely filed.

COUNT I – LIKELIHOOD OF CONFUSION

12. Opposer incorporates the allegations of Paragraphs 1 through 11 herein.

13. Applicant's use of the SURTERRA Mark for Applicant's Services is likely to cause confusion, mistake, or deception in that consumers are likely to believe that Applicant's Services are sponsored, authorized or licensed by, or in some other way legitimately connected with Opposer or that Applicant's services are Opposer's services or are for Opposer's products.

14. The purchasing public is likely to be led to believe that Applicant's Services bearing the SURTERRA Mark emanate from or are approved, licensed, sponsored by, or in some other way legitimately connected with or affiliated with Opposer, or that Applicant and its business are owned by or are affiliated with Opposer and its SUTERRA® branded products.

15. If Applicant is permitted to use the SURTERRA Mark on Applicant's Services, confusion resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the use of the SURTERRA Mark on Applicant's Services and the SUTERRA® Mark on Opposer's goods. Consumers familiar with the SUTERRA® Mark

would be likely to believe Applicant's Services are provided by Opposer or provided with Opposer's authorization or approval. Furthermore, any defect, objection or fault found with Applicant's Services sold under the SURTERRA Mark would necessarily injure Opposer's reputation and the goodwill Opposer has established in the SUTERRA® Mark.

16. WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 87848359 be denied registration and that such other and further relief as is deemed just and proper be granted.

17. The Patent and Trademark Office and Trademark Trial and Appeal Board are hereby authorized to collect the \$400 per class fee necessitated by this Notice of Opposition from Deposit Account No. 502934.

18. Please address all correspondence to Danielle M. Criona, Special Counsel, Intellectual Property, at Roll Law Group P.C., 11444 West Olympic Boulevard, Los Angeles, CA 90064.

Respectfully submitted,

Date: May 12, 2020

SUTERRA LLC

By: /s/ Danielle M. Criona /s/
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