

ESTTA Tracking number: **ESTTA1061313**

Filing date: **06/11/2020**

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

Proceeding	91255775
Party	Defendant Surterra Holdings, Inc.
Correspondence Address	JOHN C. MCELWAINE NELSON MULLINS RILEY & SCARBOROUGH LLP IP DEPARTMENT 301 SOUTH COLLEGE STREET CHARLOTTE, NC 28202 UNITED STATES ip@nelsonmullins.com no phone number provided
Submission	Answer
Filer's Name	Christopher D. Casavale
Filer's email	ip@nelsonmullins.com, john.mcelwaine@nelsonmullins.com, chris.casavale@nelsonmullins.com
Signature	/Christopher D. Casavale/
Date	06/11/2020
Attachments	Answer to Notice of Opposition No. 91255775.pdf(40511 bytes)

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

Suterra LLC,)	Opposition No. 91255775
)	
Opposer,)	Mark: SURTERRA WELLNESS
)	
vs.)	Serial No. 87848359
)	
Surterra Holdings, Inc.,)	Published: November 19, 2019
)	
Applicant.)	
)	

APPLICANT’S ANSWER
TO NOTICE OF OPPOSITION

Surterra Holdings, Inc. (“Surterra”) denies every allegation in Suterra LLC’s (“Opposer”) Notice of Opposition not specifically admitted herein and further responds as follows:

1. Responding to paragraph 1 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 and, therefore, the allegations in paragraph 1 of the Notice of Opposition are denied.

2. Responding to paragraph 2 of the Notice of Opposition, Surterra admits only that Application Serial No. 87848359 was filed based on use of the SURTERRA WELLNESS mark in commerce and claims dates of first use of at least as early as January 29, 2018 and December 8, 2016 for the Classes 35 and 44 services, respectively. Surterra is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 2 and, therefore, these allegations are denied.

3. Responding to paragraph 3 of the Notice of Opposition, Surterra admits only that Opposer has registered the SUTERRA trademark under U.S. Reg. No. 2796835 and that this registration speaks for itself. Surterra is without knowledge or information sufficient to form a

belief as to the truth of the remaining allegations in paragraph 3 and, therefore, these allegations are denied.

4. Responding to paragraph 4 of the Notice of Opposition, Surterra admits only that Opposer alleges to have obtained an undisclosed registration. Any remaining allegations in paragraph 4 are denied.

5. Responding to paragraph 5 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the allegations in paragraph 5 and, therefore, the allegations in paragraph 5 are denied.

6. Responding to paragraph 6 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the allegations in paragraph 6 and, therefore, the allegations in paragraph 6 are denied.

7. Responding to paragraph 7 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the allegations in paragraph 7 and, therefore, the allegations in paragraph 7 are denied.

8. Responding to paragraph 8 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the allegations in paragraph 8 and, therefore, the allegations in paragraph 8 are denied.

9. Responding to paragraph 9 of the Notice of Opposition, Surterra admits only that it did not seek Opposer's permission to file application Serial No. 87848363 because there was no reason to have done so. Any remaining allegations of paragraph 9 are denied.

10. Responding to paragraph 10 of the Notice of Opposition, Surterra is without knowledge or information sufficient to form a belief as to the allegations in paragraph 10 and, therefore, the allegations in paragraph 10 are denied

11. Responding to paragraph 11 of the Notice of Opposition, Surterra admits only that the time lines outlined therein are accurate. Surterra granted an extension of 60-days on the promise that Opposer would complete its investigation and present an amicable resolution. No settlement was achieved and instead this Notice of Opposition was filed. Any remaining allegations of paragraph 11 are denied.

12. In response to paragraph 12 of the Notice of Opposition, Surterra repeats and incorporates its answers to paragraphs 1 through 11 herein.

13. Surterra denies paragraph 13 of the Notice of Opposition.

14. Surterra denies paragraph 14 of the Notice of Opposition.

15. Surterra denies paragraph 15 of the Notice of Opposition.

16. Surterra denies paragraph 16 of the Notice of Opposition.

17. Surterra asserts that no response is required to paragraphs 17 and 18 of the Notice of Opposition. To the extent any response is required, the allegations of paragraphs 17 and 18 are denied.

AS A FIRST AFFIRMATIVE DEFENSE

18. Opposer's claims are precluded by its unclean hands because Opposer is engaging in trademark misuse, by attempting to improperly extend the scope of its trademark rights against Surterra's application Serial No. 87848359. Opposer's impermissible assertion of its registered trademark against Surterra for such vastly different goods, sold to different consumers, through unrelated channels of trade is in bad faith.

WHEREFORE, having fully answered the Notice of Opposition, Applicant prays that the Opposition and for such other and further relief as the Trademark Trial and Appeal Board may deem just and proper.

Please recognize John C. McElwaine, Charles G. Zug, and Chris D. Casavale duly authorized to represent the Applicant in this matter, as the attorneys for the Applicant.

NELSON MULLINS RILEY & SCARBOROUGH LLP

By: _____



John C. McElwaine
Chris D. Casavale
151 Meeting Street / Sixth Floor
Post Office Box 1806 (29402-1806)
Charleston, SC 29401-2239
Phone: (843) 853-5200
E-Mail: john.mcelwaine@nelsonmullins.com
E-Mail: ip@nelsonmullins.com

Charles G. Zug
1320 Main Street, 17th Floor
Columbia, SC 29201
E-Mail: geordie.zug@nelsonmullins.com

Counsel for Surterra Holdings, Inc.

Charleston, South Carolina

June 5, 2020

CERTIFICATE OF SERVICE

I, the undersigned of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant, Surterra Holdings, Inc., do hereby certify that I have served all counsel in this action with a true and complete copy of the foregoing pleading(s) herein below specified by emailing, pursuant to 37 C.F.R. § 2.119, a copy of the same to the email address set forth below:


Pleadings:

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Counsel Served:

Darya P. Laufer
Danielle M. Criona
Roll Law Group, PC
11444 West Olympic Blvd., 7th Floor
Los Angeles, California 90064
Email: darya.laufer@roll.com; ipdocketing@roll.com

Dated: June 11, 2020



John C. McElwaine