

ESTTA Tracking number: **ESTTA1200848**

Filing date: **04/05/2022**

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

Proceeding no.	91266658
Party	Defendant Hills Point Industries, LLC
Correspondence address	DAVID JACOBSON GORDON & JACOBSON PC 60 LONG RIDGE ROAD, STE 407 STAMFORD, CT 06905 UNITED STATES Primary email: davidj@gjip.com Secondary email(s): pto@gordonjacobson.com 203-323-1800
Submission	Other Motions/Submissions
Filer's name	David Jacobson
Filer's email	davidj@gjip.com, pto@gordonjacobson.com
Signature	/David Jacobson/
Date	04/05/2022
Attachments	MotiontoAmendSect15-91266658-f.pdf(1337445 bytes)

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

Chubby Gorilla, Inc.,)	Consolidated Opposition Nos.
Petitioner,)	91253105 (parent) and 91266658
)	
)	
v.)	
)	
Hills Point Industries, LLC,)	
Respondent.)	
)	
)	

HILLS POINT INDUSTRIES, LLC’S
MOTION TO AMEND REGISTRATION NO. 5060102

Respondent Hills Point Industries, LLC (“Respondent”), hereby moves the Board to amend Registration No. 5060102 (“the ‘102 Registration”) to withdraw a Section 15 Affidavit filed in that registration on October 11, 2021.¹

On December 18, 2020, Petitioner Chubby Gorilla, Inc. (“Petitioner”) filed a Notice of Opposition against two applications owned by Respondent: US Serial No. 88/815,304 and 88/701,306, which was instituted as proceeding 91266658. This was just one more of a series of offensive oppositions filed by Petitioner against Respondent’s marks: Opposition 91253105 (parent) which Petitioner filed against Respondent’s 88/184698; Opposition 91253653 which Petitioner filed against Respondent’s 88/406,724, 88/406,769, and 88/449,165; Opposition 91254743 which Petitioner filed against Respondent’s 88/344,163 and, 88/701,306; Opposition

¹ Pursuant to TMEP Sections 1605.03 and 1707, Hills Point Industries, LLC may, as the trademark owner, petition the Director of the Trademark Office under 37 C.F.R. Section 2.146(a) requesting that its Section 15 affidavit be withdrawn, but that since this matter is now in front of the TTAB in an *inter partes* proceeding, Hills Point Industries, LLC is requesting this relief via motion to the TTAB out of an abundance of caution.

91273419 which Petitioner filed against Respondent's 88/723,372; and Opposition 91274777 which Petitioner filed against Respondent's 90/372,983.

After a consented period of suspension for settlement negotiations in the current 91266658 proceeding, on April 14, 2021, Respondent timely filed an Answer and Counterclaim to the Notice of Opposition in the 91266658 proceeding. In its Answer and Counterclaim, Respondent cited the '102 Registration against Petitioner's marks. Such action placed the '102 Registration into a legal proceeding before the Trademark Trial and Appeal Board.

The window for filing Section 8 and 15 Affidavits for the '102 Registration opened on October 11, 2021.

On October 14, 2021, Respondent filed Section 8 and 15 Affidavits for the '102 Registration at the United States Trademark Office, and with respect to the Section 15 Affidavit declared that "[t]here is no proceeding involving said rights pending and not finally disposed of either in the United States Patent and Trademark Office or in a court of law." It was later determined this declaration was in error. (See attached Declaration of David S. Jacobson in Support of Hills Point Industries, LLC's Motion to Correct Registration No. 5060102, hereafter "Jacobson Declaration".)

On January 31, 2022, the Section 15 Affidavit for the '102 Registration was accepted by the Trademark Office, and a Notice of Acceptance of the Section 8 and 15 Affidavits for the '102 Registration was communicated from the Trademark Office.

Hills Point Industries has over 50 active United States applications and registrations for GORILLA GRIP, the mark that is the subject of the current opposition. See Jacobson Declaration.

The mistaken declaration in the Section 15 Affidavit for the '102 Registration was not willful but was due to an unintentional error by the Attorney for Respondent. See Jacobson Declaration.

The motion to correct the error is being filed promptly upon Respondent being made aware of the error.

Amendment of the '102 Registration to correct this error does not prejudice the Petitioner or other third parties and operates to correct the status of the registration.

WHEREFORE, Respondent respectfully request the Board grant this motion to amend the registration to correct the error as set forth above.

April 5, 2022

ATTORNEYS FOR RESPONDENT
HILLS POINT INDUSTRIES, LLC

By: /David S Jacobson/
David S. Jacobson
Member, CT, NY & NJ Bars
Gordon & Jacobson, P.C.
60 Long Ridge Road, Ste 401
Stamford, CT 06902
(203) 323-1800

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing HILLS POINT INDUSTRIES' MOTION TO CORRECT REGISTRATION NO. 5060102 upon Petitioner's counsel on via electronic mail addressed as follows:

Stacey.Halpern@knobbe.com

April 5, 2022

ATTORNEYS FOR RESPONDENT
HILLS POINT INDUSTRIES, LLC

By: /David S Jacobson/
David S. Jacobson
Member, CT, NY & NJ Bars
Attorney for Respondent

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

Chubby Gorilla, Inc.,)	Consolidated Opposition Nos.
Petitioner,)	91253105; 91253653; 91254743; and
)	91266658
)	
v.)	
)	
Hills Point Industries, LLC,)	
Respondent.)	
)	
)	

**DECLARATION OF DAVID S. JACOBSON IN SUPPORT OF HILLS POINT
INDUSTRIES, LLC’S MOTION TO CORRECT REGISTRATION NO. 5060102**

I, David S. Jacobson, hereby declare under oath the following:

1. I am a partner with Gordon & Jacobson, PC, the attorneys of record for Respondent Hills Point Industries, LLC in the above-referenced Consolidated Opposition Proceeding. I have personal knowledge of the facts set forth below.

2. Gordon & Jacobson, PC uses the FlexTrac IP/Case Tracking System Docketing System (“Flextrac”) to manage the trademark portfolios of its clients.

3. Flextrac does not have a docket or status entry to indicate that a registration is permanently or temporarily disqualified from filing a Section 15 Affidavit because of a legal proceeding. For such cases, Gordon & Jacobson, PC relies on the records of TSDR.

4. Gordon & Jacobson, PC uses Flextrac to manage Registration No. 5060102 (“the ‘102 Registration”) for the mark GORILLA GRIP.

5. Flextrac does not have a docket or status entry to indicate that the '102 Registration is permanently or temporarily disqualified from filing a Section 15 Affidavit because of a legal proceeding. Gordon & Jacobson, PC relied on the records of TSDR.

6. I am responsible for a large number of trademark applications and registrations, including over 50 pending applications and issued registrations for the mark GORILLA GRIP in the United States to owner Hills Point Industries, LLC. Exhibit A.

7. I review each and every Section 8 and 15 filing before it is submitted to the Trademark Office.

8. On October 14, 2021, I filed a Section 15 Affidavit in the '102 Registration that mistakenly declared that "There is no proceeding involving said rights pending and not finally disposed of either in the United States Patent" with respect to the '102 Registration. In making this declaration, I believed that "There is no proceeding involving said rights pending and not finally disposed of either in the United States Patent" with respect to the '102 Registration because I relied on the TSDR status page for the '102 Registration, which indicates that the '102 Registration is not involved in a legal proceeding. A true and correct printout of the TSDR status page for the '102 Registration dated March 29, 2022 is attached as Exhibit B. In addition, a TTABVUE page dated March 30, 2022, indicates that the '102 Registration is not subject to any proceeding in the TTAB. Exhibit C. I made the mistaken statement unintentionally and did not make any willfully false statement in association with the filing of the Section 15 Affidavit in association with the '102 Registration.

9. On March 24, 2022, I learned that the Section 15 Affidavit filed in association with the '102 Registration was made in error because the '102 Registration was in fact disqualified from filing a Section 15 Affidavit because of a legal proceeding in the Consolidated Opposition Nos. Consolidated Opposition Nos. 91253105 (parent); 91253653; 91254743; and 91266658. I learned

of this error on March 24, 2022, when reviewing an allegation of fraud that was made in a civil litigation related to the '102 Registration.

10. This declaration is in support of a Motion to Amend the '102 Registration to withdraw the Section 15 Affidavit filed on October 14, 2021, and thus correct for the mistaken declaration that was unintentionally made in the Section 15 Affidavit filed on October 14, 2021.

I declare under penalty of perjury that all statements made herein of my own knowledge are true and correct and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

April 5, 2022

By: /David S Jacobson/
David S. Jacobson
Member, CT, NY & NJ Bars
Gordon & Jacobson, P.C.
60 Long Ridge Road, Ste 401
Stamford, CT 06902
(203) 323-1800

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing DECLARATION OF DAVID S. JACOBSON IN SUPPORT OF HILLS POINT INDUSTRIES, LLC'S MOTION TO CORRECT REGISTRATION NO. 5060102 upon Opposer's counsel on via electronic mail addressed as follows:

Stacey.Halpern@knobbe.com

April 5, 2022

ATTORNEYS FOR APPLICANT
HILLS POINT INDUSTRIES, LLC

By: /David S Jacobson/
David S. Jacobson
Member, CT, NY & NJ Bars
Attorney for Applicant

EXHIBIT A



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Mar 29 03:32:22 EDT 2022

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Refine Search GORILLA-GRIP[FM] AND "Hills Point Industr Submit

Current Search: S11: GORILLA-GRIP[FM] AND "Hills Point Industries"[ON] AND LIVE[LD] docs: 52 occ: 175

Export displayed results (1 ~ 52) .CSV

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead	Class(es)
1	97148365		GORILLA GRIP	TSDR	LIVE	
2	90976753		GORILLA GRIP	TSDR	LIVE	
3	90452289		GORILLA GRIP	TSDR	LIVE	
4	90976545		GORILLA GRIP	TSDR	LIVE	
5	90004345		GORILLA GRIP	TSDR	LIVE	
6	90372983		GORILLA GRIP	TSDR	LIVE	
7	90463752		GORILLA GRIP	TSDR	LIVE	
8	90720382		GORILLA GRIP	TSDR	LIVE	
9	90004417		GORILLA GRIP	TSDR	LIVE	
10	90253785		GORILLA GRIP	TSDR	LIVE	
11	90253946		GORILLA GRIP	TSDR	LIVE	
12	88983754		GORILLA GRIP	TSDR	LIVE	
13	88979103		GORILLA GRIP	TSDR	LIVE	
14	88983485		GORILLA GRIP	TSDR	LIVE	
15	88983484		GORILLA GRIP	TSDR	LIVE	
16	88815304		GORILLA GRIP	TSDR	LIVE	
17	88701306		GORILLA GRIP	TSDR	LIVE	
18	88982471	6512476	GORILLA GRIP	TSDR	LIVE	
19	88981905	6429741	GORILLA GRIP	TSDR	LIVE	
20	88981904	6450110	GORILLA GRIP	TSDR	LIVE	
21	88981887	6450109	GORILLA GRIP	TSDR	LIVE	
22	88981687	6405022	GORILLA GRIP	TSDR	LIVE	
23	88980131	6297060	GORILLA GRIP	TSDR	LIVE	
24	88979993	6284921	GORILLA GRIP	TSDR	LIVE	
25	88979105		GORILLA GRIP	TSDR	LIVE	
26	88979104		GORILLA GRIP	TSDR	LIVE	
27	88978978	6197179	GORILLA GRIP	TSDR	LIVE	
28	88976125	5934293	GORILLA GRIP	TSDR	LIVE	
29	88815374		GORILLA GRIP	TSDR	LIVE	
30	88612360		GORILLA GRIP	TSDR	LIVE	

31	88481754		GORILLA GRIP	TSDR	LIVE	
32	88449165		GORILLA GRIP	TSDR	LIVE	
33	88449118		GORILLA GRIP	TSDR	LIVE	
34	88406769		GORILLA GRIP	TSDR	LIVE	
35	88406724		GORILLA GRIP	TSDR	LIVE	
36	88344162		GORILLA GRIP	TSDR	LIVE	
37	88260658		GORILLA GRIP	TSDR	LIVE	
38	88184698		GORILLA GRIP	TSDR	LIVE	
39	88184642		GORILLA GRIP	TSDR	LIVE	
40	88124874		GORILLA GRIP	TSDR	LIVE	
41	87981098	5802001	GORILLA GRIP	TSDR	LIVE	
42	87980423	5771258	GORILLA GRIP	TSDR	LIVE	
43	87931145	5759149	GORILLA GRIP	TSDR	LIVE	
44	87872196	5759012	GORILLA GRIP	TSDR	LIVE	
45	87657288	5921506	GORILLA GRIP	TSDR	LIVE	
46	87425970	5347931	GORILLA GRIP	TSDR	LIVE	
47	87065629	5318020	GORILLA GRIP	TSDR	LIVE	
48	86979384	5003524	GORILLA GRIP	TSDR	LIVE	
49	86953031	5257234	GORILLA GRIP	TSDR	LIVE	
50	86946946	5077181	GORILLA GRIP	TSDR	LIVE	
51	86684091	4904649	GORILLA GRIP	TSDR	LIVE	
52	86453154	5060102	GORILLA GRIP	TSDR	LIVE	

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EXHIBIT B

The screenshot shows a web browser window with the URL <https://tsdr.uspto.gov/>. The page is the USPTO Trademark Status & Document Retrieval (TSDR) interface. At the top, there's a navigation bar with 'uspto UNITED STATES PATENT AND TRADEMARK OFFICE' and links for 'About Us', 'Careers', and 'Contact Us'. Below this, there are tabs for 'Patents', 'Trademarks', and 'Learning and Resources'. The main content area is titled 'USPTO > Trademark > TSDR > Trademark Search'. A pink box contains information about TSDR assistance and processing wait times. Below that is a search bar with 'SEARCH' and 'MULTI-SEARCH' options. The search criteria are set to 'US Serial, Registration, or Reference No' with the value '5060102'. The results show 'Status results found' and a detailed view for the trademark 'GORILLA GRIP'. The view includes fields for 'US Serial Number: 86453154', 'Application Filing Date: Nov. 13, 2014', 'US Registration Number: 5060102', and 'Registration Date: Oct. 11, 2016'. It also shows the 'TMS Common Status Descriptor' as 'LIVE/REGISTRATION/Issued and Active' with a registered trademark symbol icon. A red circle highlights the 'Proceedings - None recorded' section in the left-hand navigation menu.

Website: https://tsdr.uspto.gov/#caseNumber=5060102&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch

EXHIBIT C



United States Patent and Trademark Office

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TTABVUE. Trademark Trial and Appeal Board Inquiry System

v2.2.1

No documents match the query: Proceeding Status is: ALL and Application or Registration Number is: 5060102

View TTAB Proceeding File:

Note: extensions of time to oppose may be found under the application serial number

Proceeding Status: Pending Terminated All

Proceeding Number:

8-digit Board proceeding number, digits only

Application or Registration Number:

Find proceedings with the following criteria:

Enter applicable search terms below. Results will contain all specified terms. For example, if KALAKA is entered in the 'mark' field and 'Jones' is entered in the 'Party' field, the search results will include only proceedings in which the mark contains the word KALAKA and one of the parties contains the word 'Jones'.

All these words anywhere in a record:

Search proceeding number, application or registration number, parties, marks

Mark:

Party:

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