

ESTTA Tracking number: **ESTTA1198454**

Filing date: **03/23/2022**

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

Proceeding no.	91273401
Party	Plaintiff Continental D.I.A. Diamond Products, Inc.
Correspondence address	JOSEPH V. MAUCH SHARTSIS FRIESE LLP ONE MARITIME PLAZA, 18TH FLOOR SAN FRANCISCO, CA 94111 UNITED STATES Primary email: trademarks@sflaw.com Secondary email(s): crubke@sflaw.com, jmauch@sflaw.com, calendar@sflaw.com 415-421-6500
Submission	Motion to Join/Substitute Party
Filer's name	Joseph V. Mauch
Filer's email	jmauch@sflaw.com, crubke@sflaw.com, calendar@sflaw.com
Signature	/Joseph V. Mauch/
Date	03/23/2022
Attachments	Motion to Substitute Party.pdf(1863268 bytes)

Continental D.I.A. Diamond Products, Inc.,	Opposition No. 91273401
Opposer,	Mark: TERMINATORBLUE
v.	Serial No.: 79297637
Wiha Werkzeuge GmbH,	Filing Date: October 8, 2020
Applicant.	Published in the Official Gazette of August 10, 2021

Pursuant to Federal Rule of Civil Procedure 25(c), Continental D.I.A. Diamond Products, Inc. hereby moves to substitute in Continental D.I.A. Diamond Products, LLC as the Opposer in this proceeding. Opposer Continental D.I.A. Diamond Products, Inc. filed this Opposition proceeding on December 8, 2021. On December 13, 2021, Continental D.I.A. Diamond Products, Inc. was converted into Continental D.I.A. Diamond Products, LLC, a Delaware limited liability company. Attached hereto as Exhibit A is a true and correct copy of the entity conversion documents. On March 16, 2022, the United States Patent and Trademark Office issued a Notice of Recordation of the Assignment, a copy of which is attached hereto as Exhibit B. Continental D.I.A. Diamond Products, LLC is the current owner of the marks that form the basis of this Opposition. For these reasons, Continental D.I.A. Diamond Products, Inc. requests that it be replaced with Continental D.I.A. Diamond Products, LLC as the Opposing party in this proceeding.

Respectfully submitted,

Joseph V. Mauch
Cristina N. Rubke
SHARTSIS FRIESE LLP

One Maritime Plaza, 18th Floor
San Francisco, CA 94111
Telephone: 415.421.6500
Facsimile: 415.421.2922
Attorneys for Applicant
Continental D.I.A. Diamond Products, LLC

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing MOTION TO SUBSTITUTE PARTY was served via Email, upon the following, on March 23, 2022.

GEOFFREY D. AURINI
HARNESS, DICKY & PIERCE, P.L.C.
5445 CORPORATE DRIVE, SUITE 200
TROY, MI 48098
UNITED STATES
mailroom@hdp.com, gaurini@hdp.com, troymailroom@hdp.com, palanglois@hdp.com
Phone: 248-641-1600

/s/ Joseph V. Mauch _____
Joseph V. Mauch
Cristina N. Rubke
SHARTSIS FRIESE LLP
One Maritime Plaza, 18th Floor
San Francisco, CA 94111
Telephone: 415.421.6500
Facsimile: 415.421.2922
Attorneys for Applicant
Continental D.I.A. Diamond Products, LLC

EXHIBIT A



**State of California
Secretary of State**

**Limited Liability Company
Articles of Organization - Conversion**

LLC-1A

File #

202134210296

FILED
Secretary of State *Emr*
State of California
DEC 06 2021 *NSS*

01681597

IMPORTANT — Read all instructions before completing this form.

This Space For Filing Use Only

Converted Entity Information

1. Name of Limited Liability Company (The name must include the words Limited Liability Company or the abbreviations LLC or L.L.C. The words Limited and Company may be abbreviated to Ltd. and Co., respectively.)

Continental D.I.A. Diamond Products, LLC

2. The purpose of the limited liability company is to engage in any lawful act or activity for which a limited liability company may be organized under the California Revised Uniform Limited Liability Company Act.

3. The limited liability company will be managed by (check only one):

☐

One Manager

☐

More Than One Manager

☒

All Limited Liability Company Member(s)

4. Initial Street Address of Limited Liability Company's Designated Office in CA

1300 Industrial Road, Ste. 18

City

San Carlos

State

CA

Zip Code

94070

5. Initial Mailing Address of Limited Liability Company, if different from Item 4

City

State

Zip Code

6. Initial Agent for Service of Process: Item 6a: List the name of an individual or a corporation registered in CA under California Corporations Code section 1505 that agrees to be your agent for service of process. You may not list the converted entity as the agent. Item 6b: If the agent is an individual, list the agent's CA business or residential street address. Item 6c: If the agent is an individual and the converting entity is a CA corporation, limited partnership or general partnership, list the agent's mailing address. Do not list an address if the agent is a CA registered corporate agent as the address for service of process is already on file.

- a. Name of Agent For Service of Process

Vincent Salemi

- b. If an individual, Street Address of Agent for Service of Process - Do not list a P.O. Box

1300 Industrial Road, Ste. 18

City

San Carlos

State

CA

Zip Code

94070

- c. If an individual, Mailing Address of Agent for Service of Process

1300 Industrial Road, Ste. 18

City

San Carlos

State

CA

Zip Code

94070

Converting Entity Information

7. Name of Converting Entity

Continental D.I.A. Diamond Products, Inc.

8. Form of Entity

corporation

9. Jurisdiction

California

10. CA Secretary of State Entity Number, if any

2008043

11. The principal terms of the plan of conversion were approved by a vote of the number of interests or shares of each class that equaled or exceeded the vote required. If a vote was required, the following was required for each class:

The class and number of outstanding interests entitled to vote
Common Stock - 1,000 shares outstanding

AND

The percentage vote required of each class.
Greater than 50%

Additional Information

12. Additional information set forth on the attached pages, if any, is incorporated herein by this reference and made part of this certificate.

13. I certify under penalty of perjury that the contents of this document are true. I declare I am the person who executed this instrument, which execution is my act and deed.

Vincent Salemi

Signature of Authorized Person

Maria Salemi

Signature of Authorized Person

Vincent Salemi, Chief Executive Officer

Type or Print Name and Title of Authorized Person

Maria Salemi, Chief Financial Officer

Type or Print Name and Title of Authorized Person



Secretary of State

LLC-5

Application to Register a Foreign Limited Liability Company (LLC)

FILED

Secretary of State
State of California

202136110570

Filing Number

12/22/2021

Filing Date

This Space For Office Use Only

IMPORTANT — Read Instructions before completing this form.

Must be submitted with a current Certificate of Good Standing issued by the government agency where the LLC was formed. See Instructions.

Filing Fee – \$70.00

Copy Fees – First page \$1.00; each attachment page \$0.50;
Certification Fee – \$5.00

Note: Registered LLCs in California may have to pay minimum \$800 tax to the California Franchise Tax Board each year. For more information, go to <https://www.ftb.ca.gov>.

1a. LLC Name (Enter the exact name of the LLC as listed on your attached Certificate of Good Standing.)

Continental D.I.A. Diamond Products, LLC

1b. California Alternate Name, If Required (See Instructions – Only enter an alternate name if the LLC name in 1a not available in California.)

2. LLC History (See Instructions – Ensure that the formation date and jurisdiction match the attached Certificate of Good Standing.)

a. Date LLC was formed in home jurisdiction (MM/DD/YYYY)

12 / 13 / 2021

b. Jurisdiction (State, foreign country or place where this LLC is formed.)

Delaware

c. Authority Statement (Do not alter Authority Statement)

This LLC currently has powers and privileges to conduct business in the state, foreign country or place entered in Item 2b.

3. Business Addresses (Enter the **complete** business addresses. Items 3a and 3b cannot be a P.O. Box or "in care of" an individual or entity.)

a. Street Address of Principal Executive Office - Do not enter a P.O. Box	City (no abbreviations)	State	Zip Code
1300 Industrial Road, Ste. 18	San Carlos	CA	94070
b. Street Address of Principal Office in California, if any - Do not enter a P.O. Box	City (no abbreviations)	State	Zip Code
1300 Industrial Road, Ste. 18	San Carlos	CA	94070
c. Mailing Address of Principal Executive Office, if different than item 3a	City (no abbreviations)	State	Zip Code

4. Service of Process (Must provide either Individual **OR** Corporation.)

INDIVIDUAL – Complete Items 4a and 4b only. Must include agent's full name and California street address.

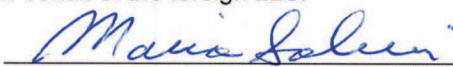
a. California Agent's First Name (if agent is not a corporation)	Middle Name	Last Name	Suffix
Vincent		Salemi	
b. Street Address (if agent is not a corporation) - Do not enter a P.O. Box	City (no abbreviations)	State	Zip Code
1300 Industrial Road, Ste. 18	San Carlos	CA	94070

CORPORATION – Complete Item 4c only. Only include the name of the registered agent Corporation.

c. California Registered Corporate Agent's Name (if agent is a corporation) – Do not complete Item 4a or 4b

5. Read and Sign Below (See Instructions. Title not required.)

By signing, I affirm under penalty of perjury that the information herein is true and correct and that I am authorized to sign on behalf of the foreign LLC.


Signature

Maria Salemi

Type or Print Name

Delaware

The First State

Page 1

I, JEFFREY W. BULLOCK, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY "CONTINENTAL D.I.A. DIAMOND PRODUCTS, LLC" IS DULY FORMED UNDER THE LAWS OF THE STATE OF DELAWARE AND IS IN GOOD STANDING AND HAS A LEGAL EXISTENCE SO FAR AS THE RECORDS OF THIS OFFICE SHOW, AS OF THE FOURTEENTH DAY OF DECEMBER, A.D. 2021.

AND I DO HEREBY FURTHER CERTIFY THAT THE SAID "CONTINENTAL D.I.A. DIAMOND PRODUCTS, LLC" WAS FORMED ON THE THIRTEENTH DAY OF DECEMBER, A.D. 2021.

AND I DO HEREBY FURTHER CERTIFY THAT THE ANNUAL TAXES HAVE BEEN ASSESSED TO DATE.



6469358 8300

SR# 20214083068

You may verify this certificate online at corp.delaware.gov/authver.shtml

A handwritten signature in black ink, appearing to read "JBullock", is written over a horizontal line. Below the line, the text "Jeffrey W. Bullock, Secretary of State" is printed.

Authentication: 204969330

Date: 12-14-21

202136110570

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARCH 16, 2022

PTAS

CRISTINA N. RUBKE, SHARTSIS FRIESE LLP
ONE MARITIME PLAZA, 18TH FLOOR
SAN FRANCISCO, CA 94111

900677652

UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT RECORDATION BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE ASSIGNMENT RECORDATION BRANCH AT 571-272-3350. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, MAIL STOP: ASSIGNMENT RECORDATION BRANCH, P.O. BOX 1450, ALEXANDRIA, VA 22313.

RECORDATION DATE: 02/24/2022

REEL/FRAME: 7642/0590
NUMBER OF PAGES: 3

BRIEF: ENTITY CONVERSION

ASSIGNOR:

CONTINENTAL D.I.A. DIAMOND PRODUCTS,
INC.

DOC DATE: 12/13/2021
CITIZENSHIP: CALIFORNIA
ENTITY: CORPORATION

ASSIGNEE:

CONTINENTAL D.I.A. DIAMOND PRODUCTS,
LLC
1300 INDUSTRIAL ROAD, SUITE 18
SAN CARLOS, CALIFORNIA 94070

CITIZENSHIP: DELAWARE
ENTITY: LIMITED LIABILITY COMPANY

SERIAL NUMBER: 75648086

REGISTRATION NUMBER: 2497482

MARK: TERMINATOR

DRAWING TYPE: TYPESET WORD(S) /LETTER(S) /NUMBER(S)

FILING DATE: 02/25/1999

REGISTRATION DATE: 10/16/2001

SERIAL NUMBER: 77241273

REGISTRATION NUMBER: 3581253

MARK: TERMINATOR ZOOM

DRAWING TYPE: STANDARD CHARACTER MARK

FILING DATE: 07/27/2007

REGISTRATION DATE: 02/24/2009

SERIAL NUMBER: 77241277 FILING DATE: 07/27/2007
REGISTRATION NUMBER: 3500842 REGISTRATION DATE: 09/16/2008
MARK:
DRAWING TYPE: AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 77919140 FILING DATE: 01/25/2010
REGISTRATION NUMBER: 3856075 REGISTRATION DATE: 10/05/2010
MARK: KNOCKOUT
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 78516409 FILING DATE: 11/12/2004
REGISTRATION NUMBER: 3028708 REGISTRATION DATE: 12/13/2005
MARK: TERMINATOR XTREME
DRAWING TYPE: STANDARD CHARACTER MARK

SERIAL NUMBER: 86906134 FILING DATE: 02/12/2016
REGISTRATION NUMBER: 5045294 REGISTRATION DATE: 09/20/2016
MARK: TERMINATOR
DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 90753338 FILING DATE: 06/03/2021
REGISTRATION NUMBER: REGISTRATION DATE:
MARK: TERMINATOR THE CUTTING EDGE.
DRAWING TYPE: AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)
/NUMBER(S)

SERIAL NUMBER: 90801395 FILING DATE: 06/29/2021
REGISTRATION NUMBER: REGISTRATION DATE:
MARK: TERMINATOR ADP
DRAWING TYPE: STANDARD CHARACTER MARK

ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION