

ESTTA Tracking number: **ESTTA410261**

Filing date: **05/20/2011**

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

Proceeding	92051522
Party	Defendant PURE FISHING, INC.
Correspondence Address	LANCE G JOHNSON ROYLANCE ABRAMS BERDO & GOODMAN LLP 1300 19TH STREET NW , SUITE 600 WASHINGTON, DC 20036 UNITED STATES ccook@roylance.com; PFdocketing@roylance.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Casimir Cook
Filer's e-mail	CWCdocketing@roylance.com
Signature	/Casimir Cook/
Date	05/20/2011
Attachments	Exhibit B.pdf (15 pages)(141375 bytes)

Exhibit B

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA
COLUMBIA DIVISION**

PURE FISHING, INC.,)	C.A. NO. 3:10-CV-03117-JFA
)	
PLAINTIFF,)	
)	ANSWER AND COUNTERCLAIM
vs.)	
)	(JURY TRIAL DEMANDED)
REDWING TACKLE, LTD.,)	
)	
DEFENDANT.)	
_____)	

Defendant, Redwing Tackle, Ltd. (Redwing Tackle), by counsel, hereby Answers the Complaint filed against it by Pure Fishing, Inc. (Pure Fishing) as follows.

I. PARTIES AND JURISDICTION

1. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 1 of the Complaint and therefore denies the same.

2. Redwing Tackle admits that it is a Canadian corporation but denies that its principal place of business is presently at 86 Ainsdale Road, Toronto, Ontario, M1R3Z2 as recited in paragraph 2 of the Complaint.

3. Redwing Tackle admits that the Complaint alleges the claims recited in paragraph 3 of the Complaint.

4. Redwing Tackle admits the allegations of paragraph 4 of the Complaint.

5. Redwing Tackle admits the allegations of paragraph 5 of the Complaint.

6. Redwing Tackle admits the allegations of paragraph 6 of the Complaint.

II. VENUE

7. Redwing Tackle admits the allegations of paragraph 7 of the Complaint.

8. Redwing Tackle admits the allegations of paragraph 8 of the Complaint that certain events giving rise to the cause of action alleged therein but denies that the acts complained of continued to occur in the District of South Carolina.

III. FACTS

9. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 9 of the Complaint and therefore denies the same.

10. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 10 of the Complaint and therefore denies the same.

11. Redwing Tackle admits the allegations of paragraph 11 of the Complaint except that it denies that the description of the goods registered under No. 2,903,536 is accurate.

12. Redwing Tackle admits that the recited registrations are all registered, for among other things, fishing line and that print-outs of the PTO database are attached to the Complaint as Exhibit A.

13. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 13 of the Complaint and therefore denies the same.

14. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 14 of the Complaint and therefore denies the same.

15. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 15 of the Complaint and therefore denies the same.

16. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 16 of the Complaint and therefore denies the same.

17. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 17 of the Complaint and therefore denies the same.

18. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 18 of the Complaint and therefore denies the same.

19. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 19 of the Complaint and therefore denies the same.

20. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 20 of the Complaint and therefore denies the same.

21. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 21 of the Complaint and therefore denies the same.

22. Redwing Tackle admits that a Declaration under Section 15 has been filed in connection with the recited registration but has insufficient knowledge to admit or deny the sufficiency of said Declaration and therefore denies the remaining allegations of Paragraph 22 of the Complaint.

23. Redwing Tackle admits that a Declaration under Section 15 has been filed in connection with the recited registration but has insufficient knowledge to admit or deny the sufficiency of said Declaration and therefore denies the remaining allegations of Paragraph 23 of the Complaint.

24. Redwing Tackle admits that a Declaration under Section 15 has been filed in connection with the recited registration but has insufficient knowledge to admit or deny the sufficiency of said Declaration and therefore denies the remaining allegations of Paragraph 24 of the Complaint.

25. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 25 of the Complaint and therefore denies the same.

26. Redwing Tackle has insufficient knowledge to admit or deny the allegations of Paragraph 26 of the Complaint and therefore denies the same.

27. Redwing Tackle admits the allegations of paragraph 27 of the Complaint.

28. Redwing Tackle denies the allegations of paragraph 28 of the Complaint.

29. Redwing Tackle denies that there is any advertising overlap between its marketing and that of Pure Fishing. Redwing Tackle has insufficient knowledge to admit or deny the allegations as to the parties' channels of trade and therefore denies the same. Redwing Tackle admits that it markets its SPIDER THREAD products to the same class of consumer as Pure Fishing.

30. Redwing Tackle denies the allegations of paragraph 30 of the Complaint as having any relevance whatsoever to the United States marketplace.

31. Redwing Tackle denies the allegations of paragraph 31 of the Complaint as having any relevance whatsoever to the trademark rights of Pure Fishing in the United States.

32. Redwing Tackle denies the allegations of paragraph 32 of the Complaint as having any relevance whatsoever to the United States marketplace.

33. Redwing Tackle denies the allegations of paragraph 33 of the Complaint as having any relevance whatsoever to the United States marketplace.

34. Redwing Tackle denies the allegations of paragraph 34 inasmuch as it presumes a factual refusal not set forth in the Complaint with respect to the United States but admits that it placed the referenced advertising in the November 2010 issue of *Coastal Angler* magazine.

FIRST CLAIM FOR RELIEF

35. Redwing Tackle repeats its responses to the allegations contained in Paragraphs 1-34 of the Complaint.

36. Redwing Tackle denies the allegations of paragraph 36 of the Complaint.

37. Redwing Tackle denies the allegations of paragraph 37 of the Complaint inasmuch as it has not sold, advertised, and transporting its fishing line in interstate commerce within the United States but admits that it has sold its fishing line in commerce between the United States and Canada.

38. Redwing Tackle denies the allegations of paragraph 38 of the Complaint.

39. Redwing Tackle denies the allegations of paragraph 39 of the Complaint.

40. Redwing Tackle denies the allegations of paragraph 40 of the Complaint.

41. Redwing Tackle denies the allegations of paragraph 41 of the Complaint.

SECOND CLAIM FOR RELIEF

42. Redwing Tackle repeats its responses to the allegations contained in Paragraphs 1-41 of the Complaint.

43. Redwing Tackle denies the allegations of paragraph 43 of the Complaint.

44. Redwing Tackle denies the allegations of paragraph 44 of the Complaint.

45. Redwing Tackle denies the allegations of paragraph 45 of the Complaint.

46. Redwing Tackle denies the allegations of paragraph 46 of the Complaint.

THIRD CLAIM FOR RELIEF

47. Redwing Tackle repeats its responses to the allegations contained in Paragraphs 1-46 of the Complaint.

48. Redwing Tackle admits that the allegations of the Complaint are sufficient to give rise to supplemental jurisdiction but denies that the allegations of the Complaint are true.

49. Redwing Tackle denies the allegations of paragraph 49 of the Complaint.

50. Redwing Tackle denies the allegations of paragraph 50 of the Complaint.

51. Redwing Tackle denies the allegations of paragraph 51 of the Complaint.

52. Redwing Tackle denies the allegations of paragraph 52 of the Complaint.

53. Redwing Tackle denies the allegations of paragraph 53 of the Complaint.

54. Redwing Tackle denies the allegations of paragraph 54 of the Complaint.

55. Redwing Tackle denies the allegations of paragraph 55 of the Complaint.

FOURTH CLAIM FOR RELIEF

56. Redwing Tackle repeats its responses to the allegations contained in Paragraphs 1-55 of the Complaint.

57. Redwing Tackle denies the allegations of paragraph 57 of the Complaint.

58. Redwing Tackle denies the allegations of paragraph 58 of the Complaint.

59. Redwing Tackle denies the allegations of paragraph 59 of the Complaint.

60. Redwing Tackle denies the allegations of paragraph 60 of the Complaint.

FIFTH CLAIM FOR RELIEF

61. Redwing Tackle repeats its responses to the allegations contained in Paragraphs 1-60 of the Complaint.

62. Redwing Tackle denies the allegations of paragraph 62 of the Complaint.

63. Redwing Tackle denies the allegations of paragraph 63 of the Complaint.

64. Redwing Tackle denies the allegations of paragraph 64 of the Complaint.

65. Redwing Tackle denies the allegations of paragraph 65 of the Complaint.

66. Redwing Tackle denies the allegations of paragraph 66 of the Complaint to the extent that Plaintiff seeks to complain of Redwing Tackle's activities outside of the United States.

67. Redwing Tackle denies the allegations of paragraph 67 of the Complaint.

68. Redwing Tackle denies the allegations of paragraph 68 of the Complaint.

69. Redwing Tackle denies the allegations of paragraph 69 of the Complaint.

70. Redwing Tackle denies the allegations of paragraph 70 of the Complaint.

PRAYER FOR RELIEF

WHEREFORE, Redwing Tackle prays that the Court deny Pure Fishing's prayer that its Verified Complaint be treated as an Affidavit as it is, in fact, not verified; furthermore, Redwing Tackle denies that Pure Fishing is entitled to any of the relief for which it has prayed.

AFFIRMATIVE DEFENSES

1. Redwing Tackle has been selling spawn sacks, as a form of securing fishing bait to be placed on fishing hooks, under its trademark SPIDER THREAD in the United States since 1983. Pure Fishing (and/or its predecessors in interest) have known of Redwing Tackle's use of its mark SPIDER THREAD at least since 2005, pursuant to Exhibit A attached (exhibits omitted). Therefore, Redwing Tackle alleges that Pure Fishing's claims as set forth in its Complaint are barred by **laches and/or acquiescence**.

2. After Pure Fishing sent another cease-and-desist letter to Redwing Tackle in April of 2009, and the Patent and Trademark Office cited various marks registered to Pure Fishing against Redwing Tackles application to register its mark, SPIDER THREAD, Redwing Tackle brought a cancellation proceeding against Pure Fishing's registration of its trademark registration SPIDER, No. 2,903,536, at the Trademark Trial and Appeal Board under No. 92051522 on the basis of non-use. Said allegations of non-use were denied by Pure Fishing, Pure Fishing maintaining that the mark was in use for all of the goods for which it was registered, and the matter was staunchly defended (from 2009 to the present). Redwing Tackle alleges that these representations to the Trademark Trial and Appeals Board were false and were made intentionally for the purpose of maintaining this registration for assertion against Redwing

Tackle. This registration is indeed recited in the Complaint as among the trademark rights Pure Fishing is asserting against Redwing Tackle. As evidence of the falsity of Pure Fishing's representations that the mark was in use for all goods recited in the registration, in October of 2010, Pure Fishing caused to be submitted to the United States Patent and Trademark Office a Declaration, under penalty of perjury pursuant to 18 U.S.C. § 2001, stating the mark was no longer in use for the majority of goods for which it was registered and requesting amendment of the registration. Under the Rules of the Trademark Trial and Appeals Board, registrations which are the subject of Board proceedings may not be amended without leave of the Board. Furthermore, said Declaration was signed by a person with questionable knowledge of use of the mark at issue and submitted with questionable specimens allegedly for the purpose of confirming use on the remaining goods for which maintenance of the registration was sought. Redwing Tackle asserts, based upon the documents withheld by Pure Fishing in the TTAB discovery process, that the statements in the Declaration were false and were made intentionally for the purpose of maintaining this registration for assertion against Redwing Tackle. Redwing Tackle's challenge to the legitimacy and adequacy of said Declaration remains pending before the Trademark Trial and Appeal Board in motions practice. Accordingly, Redwing Tackle alleges that the Complaint is barred by **fraud and unclean hands** on the part of Pure Fishing based on: (1) its false position in the cancellation proceeding that the mark was in use for all the goods recited in the registration, (2) its false Declaration before the PTO that the mark was in use for the remaining goods recited in the Declaration, and (3) false testimony before the TTAB in the Declaration that the mark was in use for the remaining goods recited in the Declaration, all of which was intentional and for the purpose of asserting Pure Fishing's claimed rights in the challenged registration against Redwing Tackle.

COUNTERCLAIM FOR CANCELLATION OF NO. 2,903,536

1. Redwing Tackle Ltd. (“Redwing Tackle”), a Canadian corporation, with its principal place of business at 55 Mills Road #8, Ajax, Ontario, L1S 2H2, by counsel, hereby petitions to cancel U.S. trademark registration number 2,903,536, for SPIDER in the name of Pure Fishing, Inc., 1900 18th Street, Spirit Lake, Iowa, 51360, according to the records of the United States Patent and Trademark Office.

2. Redwing Tackle is being damaged by the existence of registration number 2,903,536 because this registration has been cited by the U.S. PTO as the basis for refusing Redwing Tackle’s application to register its trademark, SPIDER THREAD, serial number 77/653,377.

3. Redwing Tackle is also being damaged because Pure Fishing, by counsel, has asserted a likelihood of confusion between Registrant’s mark and Redwing Tackle’s mark. See Exhibit B (exhibits omitted).

4. Redwing Tackle asserts that it has been continuously using its distinctive mark SPIDER THREAD in commerce within and with the United States since at least as early as 1983, ten years earlier than the first use in commerce in the United States claimed by Registrant for its mark. Due to the extended period of Redwing Tackle’s use of its mark, SPIDER THREAD has come to be associated exclusively with Redwing Tackle. Therefore, Redwing Tackle has priority of use over Registrant. As the junior user, it is the obligation of Registrant to give way to the rights of the prior user, Redwing Tackle, in the event of any likelihood of confusion. Registrant has admitted the existence of a likelihood of confusion between the parties’ marks in its demands upon Redwing Tackle.

5. As additional grounds for its Petition, upon information and belief, Redwing Tackle asserts that Registrant has discontinued its use in commerce of SPIDER for all of the goods

recited within the certificate of registration with the express or implied intent not to resume use. Therefore, Redwing Tackle believes that the registration should be cancelled on the grounds of abandonment.

WHEREFORE, Redwing Tackle prays that:

(a) Pure Fishing's Registration, number 2,903,536, for SPIDER be cancelled and requests the same pursuant to 15 U.S.C. § 1119;

(b) This Court find that Redwing Tackle's use of its mark SPIDER THREAD does not infringe any rights of Pure Fishing in its marks; and

(c) This Court find that Pure Fishing's conduct in pursuing this litigation against Redwing Tackle has been an exceptional case supporting an award of attorneys' fees against Pure Fishing, pursuant to 15 U.S.C. § 1117(a).

(d) This Court award such further relief as the Court deems just and proper.

/s/ D. Jay Davis, Jr.
D. Jay Davis, Jr. (Federal ID No. 6723)
Young Clement Rivers, L.L.P.
P.O. Box 993
Charleston, SC 29402
Direct Dial: 843-720-5406
Direct Fax: 843-579-1355
e-mail: jdavis@ycrlaw.com
Attorney for Redwing Tackle, Ltd.

May 16, 2011
Charleston, South Carolina



TTAB

55503

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

-----X
REDWING TACKLE, LTD. :
Petitioner, :
v. :
PURE FISHING, INC., :
Registrant. :
-----X

78/334,549

Cancellation No. 92051522



04-25-2011

U.S. Patent & Trademark Office Form 101, Rev. 01-07

UPDATED STATUS REPORT ON SERVICE OF COMPLAINT ON REDWING TACKLE

As requested by Interlocutory Attorney, Jennifer Krisp in her April 19, 2011 Order, Registrant reports that service on Redwing Tackle, Ltd. of the Summons and Complaint in Civil Action No. 3:10-cv-03117-JFA before the United States District Court for the District of South Carolina is ongoing. To date, despite four separate attempts by the constable in Ontario, Registrant has been unable to perfect service on Redwing Tackle, Ltd. at its address of record with the U.S. Patent and Trademark Office, 86 Ainsdale Road, Toronto, Ontario M1R3Z2, Canada. An Amended Summons was issued from the United States District Court for the District of South Carolina on April 7, 2011 (copy enclosed). The Amended Summons identifies the mailing address listed on Redwing Tackle, Ltd.'s website, 55 Mills Road, #8, Ajax, Ontario, Canada, L1S2H2 for service of process.

Pursuant to Fed. R. Civ. P. 4, service on a foreign corporation in a foreign country must be accomplished in any manner prescribed by Fed. R. Civ. P. 4(f), which identifies "any internationally agreed means of service that is reasonable calculated to give notice, such as those authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents. Fed. R. Civ. P. 4(f)(1) and Fed. R. Civ. P. 4(h)(2).

Registrant continues to make good faith efforts to perfect service. Registrant notes that the 120-day provision for service of a Summons and Complaint does not apply to service on a foreign corporation such

Civil Action No. 3:10-cv-03117-JFA

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 4 (l))

This summons for *(name of individual and title, if any)* _____
was received by me on *(date)* _____

I personally served the summons on the individual at *(place)* _____
_____ on *(date)* _____ ; or

I left the summons at the individual's residence or usual place of abode with *(name)* _____
_____, a person of suitable age and discretion who resides there,
on *(date)* _____, and mailed a copy to the individual's last known address; or

I served the summons on *(name of individual)* _____, who is
designated by law to accept service of process on behalf of *(name of organization)* _____
_____ on *(date)* _____ ; or

I returned the summons unexecuted because _____ ; or

Other *(specify)*:

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ _____ 0.00

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

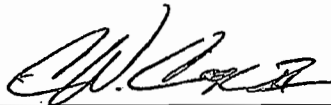
Print

Save As...

Reset

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that an electronic copy of the foregoing **UPDATED STATUS REPORT ON SERVICE OF COMPLAINT ON REDWING TACKLE** was filed at the U.S. Patent and Trademark Office through ESTTA this 25th day of April, 2011.



Casimir W. Cook II

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **UPDATED STATUS REPORT ON SERVICE OF COMPLAINT ON REDWING TACKLE** was served by first class mail, postage prepaid, this 25th day of April, 2011 on attorney for Petitioner at the following address:

Barbara L. Waite P.C.
1425 K Street Nw, Ste. 350
Washington, Dc 20005
United States



Casimir W. Cook II