

ESTTA Tracking number: **ESTTA1014970**

Filing date: **11/12/2019**

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

Proceeding	92063808
Party	Plaintiff Double Coin Holdings, Ltd.
Correspondence Address	JOSEPH E MUETH JOSEPH E MUETH LAW CORPORATION 225 S LAKE AVE, STE 300 PASADENA, CA 91101 UNITED STATES jmueth@josephemueth.com 626-584-0396
Submission	Opposition/Response to Motion
Filer's Name	Joseph E. Mueth
Filer's email	jmueth@josephemueth.com
Signature	/josephemueth/
Date	11/12/2019
Attachments	351-125oppmotforrecon111219.pdf(109097 bytes)

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

DOUBLE COIN HOLDINGS, LTD,)	Cancellation No. 92063808
)	
Petitioner,)	
)	
v.)	
)	
TRU DEVELOPMENT,)	
)	
Registrant.)	

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION
FOR RECONSIDERATION AND RELIEF FROM JUDGEMENT**

Petitioner Double Coin Holdings, Ltd. (hereinafter “Petitioner”), by counsel, hereby opposes the Tru Development (hereinafter “Registrant”) Motion for Reconsideration and Relief from Judgment (75 TTABVUE) (hereinafter the “Motion for Reconsideration”).

I. Registrant’s Motion for Reconsideration Is Without Merit Under FRCP 60(b) and TBMP §544 .

Registrant’s Motion for Reconsideration is without merit under FRCP 60(b) because none of its requirements are met by Registrant’s Motion. TBMP §544 makes clear that motions for relief from final judgments are granted only under extraordinary circumstances and the moving party bears the burden of persuasion. Relief from a final

judgment is an extraordinary remedy to be granted only in exceptional circumstances or when other equitable considerations exist, *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991). Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in FRCP 60(b).

Registrant's Motion for Reconsideration fails to set forth any such reason.

II. Registrant's Motion for Reconsideration Should Not Have Been Filed.

Under FRCP 60(b), a motion for reconsideration is not granted on the basis of self-serving claims of unfairness or legal error by the Board, Motion for Reconsideration, p. 2 at Section II (75 TTABVUE).

A. Defense of Alleged Material Alteration Was Waived.

The Board in its Decision states that the only cognizable defenses Registrant asserts are laches, estoppel, waiver, unclean hands and acquiescence, Decision p. 3, first full paragraph (74 TTABVUE). Of these, the only one pursued by Registrant in its Trial Brief (65 TTABVUE) is laches and, hence, all other defenses are waived.

Registrant in its Motion for Reconsideration does not dispute the Board's holding that Registrant's only properly pleaded defense is laches and the defense of alleged material alteration was waived.

///

///

///

Registrant did not allege the defense of alleged material alteration by pleading or timely motion, and Registrant's Motion for Reconsideration flies into the face of well-established law respecting waiver. *See, Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014).

B. Registrant Was Aware of WARRIOR Letter Style Modernization Long Prior to Trial.

Ignoring waiver, Registrant alleges that Petitioner was "aware of their plans to use a drastically different mark on their tire but Registrant had no knowledge until Petitioner's trial evidence was submitted...", Motion for Reconsideration, p. 3, first paragraph (75 TTABVUE). This is Registrant's hyperbolic way of saying Registrant had no notice of the modernization of the WARRIOR letter style prior to trial.¹

This allegation is demonstrably false as evidenced by Registrant's own discovery responses produced to Petitioner November 14, 2016 among which were the results of an October 27, 2016 Google image search for "Road Warrior tires" conducted by Registrant. This Google image search clearly includes an image of Petitioner's WARRIOR tires with sidewalls bearing the modernized letter style for WARRIOR, Petitioner's Notice of Reliance, Ex. L, RW000017, bottom row, left-most image (41 TTABVUE).² Registrant's Motion for Reconsideration is notably silent regarding Petitioner's Notice of Reliance Ex. L.

¹ Trial began April 8, 2017, Order Setting Trial Dates (2 TTABVUE), and closed December 15, 2018, Stipulation for Extension (51 TTABVUE) and Grant of Extension (52 TTABVUE).

² Petitioner cited to and relied upon its Notice of Reliance Ex. L in its Opening Brief, Pet. Tr. Br., Sec. 7 pp. 23-24 (63 TTABVUE).

C. Registrant Did Not Timely Raise Its Claim of Alleged Material Alteration.

Registrant did not raise the allegation of alleged material alteration by change of letter style in its August 9, 2017 Amended Answer (22 TTABVUE) which was well after Registrant's October 27, 2016 Google image search evidencing Registrant's awareness of Petitioner's use of the modernized WARRIOR letter style on Petitioner's tires, Petitioner's Notice of Reliance, Ex. L (41 TTABVUE). Registrant belatedly raised the issue of alleged material alteration for the first time in its Trial Brief, Tru Tr. Br. pp.9-11 (65 TTABVUE). Registrant may not rely upon unpled defenses, *H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008), *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacan Inc.*, 98 USPQ2d 1921, 1926 (TTAB 2011).

Registrant had every opportunity to raise the alleged material alteration issue well in advance of close of trial. Registrant did not do so and it is prejudicial to Petitioner to have this unpled and waived defense resurrected by Registrant's Motion. Registrant's Motion for Reconsideration must fail under TMBP §§311.02 and 314.

Registrant's claim that Petitioner thwarted Registrant from timely raising the defense of alleged material alteration, Motion for Reconsideration p. 4 (75 TTABVUE), is preposterous.

Registrant had good reason not to timely raise the defense of alleged material alteration. As is shown in the Board's Decision, the minor difference in the two letter styles is not material because it obviously does not change the commercial impression that WARRIOR creates, Decision pp. 41-42 (74 TTABVUE). The trivial difference in letter styles and the powerful customer impression of the "Warrior" term make it

blindingly obvious that Registrant's alleged material alteration claim is frivolous. The legal standard for tacking and non-abandonment is met, *see Jack Wolfskin Ausrüstung Fur Draussen GmbH Co. KgaA v. New Millennium Sports S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133-34 (Fed. Cir. 2015). There is no alleged material alteration.

D. Registrant's Motion Is Futile.

Petitioner began using the modernized WARRIOR letter style prior to January 1, 2015, Registrant's claimed date of first use, Decl. of Murphy ¶6 (36 TTABVUE). The allegation of material alteration is irrelevant since Petitioner's modernized trademark enjoys priority, *see West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994), *Kemi Organics, LLC v. Rakesh Gupta*, 126 USPQ2d 1601, 1605 (TTAB 2018), *Crash Dummy Movie LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 USPQ2d 1315 (Fed. Cir. 2010).

The record shows that Petitioner began using the modernized letter style as early as January 28, 2014, Decl. of Murphy at ¶6 and Exs. 2, 4-5 thereto (36 TTABVUE). Petitioner's January 28, 2014 promotional brochures for WARRIOR R29 and R30 tires clearly show the tires bearing the modernized WARRIOR letter style, Decl. of Murphy Ex. 4-5 (36 TTABVUE). Petitioner's sales records establish that WARRIOR has been used in commerce by Petitioner since May 29, 2014, Decl. Of Yang ¶18 and Ex. 6 thereto (11 TTABVUE). This evidence is uncontroverted. Petitioner's Petition for Cancellation put Registrant on notice that Petitioner planned to resume use of the WARRIOR trademark, Petition, ¶¶2-3 (1 TTABVUE).

III. MOTION TO DENY THE MOTION FOR RECONSIDERATION

For the foregoing reasons, Petitioner Double Coin moves to deny Registrant Tru Development's Motion for Reconsideration and Relief from Judgement (75 TTABVUE).

Registrant fails to carry its burden of persuasion as required by TBMP §544. Registrant waived the defense of alleged material alteration by failing to raise this defense until filing its Trial Brief, Reg. Main Tr. Br. Pp.9-11 (65 TTABVUE). Registrant conducted a Google image search on October 27, 2016, the results of which showed the modernized WARRIOR letter style. Registrant had ample opportunity to raise the alleged material alteration defense in advance of trial. The letter style is a minor feature of the WARRIOR trademark. There is no material alteration.

To grant any part of Registrant's Motion for Reconsideration would be unwarranted and unduly prejudicial against Petitioner as it would have the grave effect of unjustifiably and unfairly subjecting Petitioner to the expense and cost of Rehearing before the Trademark Trial and Appeal Board occasioned by avoidable behavior on the part of Registrant.

///

///

///

///

///

///

IV. CONCLUSION

For the foregoing reasons, Registrant's Motion for Reconsideration should be DENIED.

Respectfully submitted,

November 12, 2019

By: /josephemueth/
Joseph E. Mueth, Esq.
JOSEPH E. MUETH LAW CORPORATION
225 S. Lake Ave., Ste. 300
Pasadena, CA 91101
626-584-0396 (phone)
626-584-6862 (fax)
jmueth@josephemueth.com

Attorney for PETITIONER,
Double Coin Holdings, Ltd.

CERTIFICATE OF ELECTRONIC TRANSMISSION

The undersigned hereby certifies that this Petitioner's Opposition to Registrant's Motion for Reconsideration and Relief From Judgment is being electronically transmitted to the Patent and Trademark Office on November 12, 2019.

/sallyshore/

Sally Shore
Paralegal
Joseph E. Mueth Law Corporation
225 S. Lake Avenue, Suite 300
Pasadena, California 91101

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and complete copy of this Petitioner's Opposition for Reconsideration and Relief From Judgment to be served electronically upon the following this 12th day of November, 2019:

Attorneys for Registrant Tru Development
Rishi Nair, Esq.
Kevin J. Keener, Esq.
Keener & Associates, P.C.
161 N. Clark St. Ste. 4700
Chicago, IL 60601
312-375-1572
rishi.nair@keenerlegal.com
kevin.keener@keenerlegal.com

/sallyshore/

Sally Shore
Paralegal
Joseph E. Mueth Law Corporation
225 S. Lake Avenue, Suite 300
Pasadena, California 91101