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

Proceeding	91161458
Party	Defendant Celestial Pictures Limited Celestial Pictures Limited Shaw Administration Building Lot 220, Clear Water Bay Road HKX Kowloon,
Correspondence Address	JOSEPH R. DREITLER JONES DAY REAVIS & POGUE 41 SOUTH HIGH STREET 1800 HUNTINGTON CENTER COLUMBUS, OH 43215
Submission	Motion to Dismiss - Rule 12(b)
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Date	09/03/2004
Attachments	Applicants Motion to Dismiss Opposition No 91161458.pdf (5 pages)

herein seeks registration of the mark  for use in connection with a variety of services in International Class 41. Applicant filed for registration under the Intent to Use provisions of the Trademark Act, and does not, presently, claim use of the mark in commerce in the U.S.

In its Notice of Opposition, Opposer makes the following assertions:

- (a) it "is the owner of all right, title and interest in and to Star Button Device trademark";
- (b) that "Opposer has used the Star Button Device in connection with telecommunication services";
- (c) that "Opposer's services identified and distinguished under the Star Button Device are rendered throughout the world, including Australia, Denmark, Hong Kong, Ireland, Israel, Italy, Sweden, Thailand, Austria and the United Kingdom";
- (d) that "Applicant's Mark is substantially similar to Opposer's mark"; and
- (e) that registration be refused under Section 2(d).

What is conspicuously missing from the Notice of Opposition filed by Opposer are any facts or even allegations which show "damage" under the Trademark Act sufficient to sustain the Opposition under Section 2(d). More specifically, Opposer has:

1. failed to claim ownership of a trademark registration of its alleged Star Button Device in the United States;
2. failed to allege that it uses its Star Button Device in the United States; and

3. failed to claim that it has priority of use of its Star Button Device over Applicant in the United States.

By failing to claim ownership rights in a similar trademark in the United States, or even prior use of a Star Button Device in the United States, Opposer can not prevail herein under Section 2(d).

Applicant acknowledges that pleadings must be construed liberally by the Board in the light most favorable to Opposer. *See Fed. R. Civ. P. 8(f)*. However, Opposer must plead and prove that it has a proprietary interest in its claimed Star Button Device trademark in the United States and that this interest was obtained prior to the filing date of Applicant's Intent to Use application. *See Trademark Act § 2(d) and Zirco Corp. v. American Telephone and Telegraph Co.*, 21 U.S.P.Q.2d 1542 (TTAB 1991).

Opposer has only argued that there is a likelihood of confusion. Opposer does not claim any proprietary interest in its alleged Star Button Device in the United States, and it does not claim prior rights to its Star Button Device in the United States. Opposer has not specifically identified or claimed that consumers in the United States have purchased (much less that the alleged logo serves to identify) any products or services using the Star Button Device. In the Notice of Opposition, Opposer merely claims it has rendered services in a limited number of countries, all of which are outside of North and South America. As a result, Applicant requests that the Notice of Opposition be dismissed on the grounds that even if all facts alleged by Opposer in its Notice of Opposition were proved, that such facts and legal claims do not constitute damage required under the Trademark Act which would allow Opposer to prevail. *See Delta Tire Corp. v. Sports Car Club of America, Inc.*, 186 U.S.P.Q. 431 (TTAB 1975).

For all of the reasons above, Applicant respectfully requests that the Board dismiss the above Opposition.

Dated: September 3, 2004

Respectfully submitted,

/Joseph R. Dreitler/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Applicant's Motion to Dismiss was served, by regular U.S. Mail, postage prepaid on Julie B. Seyler, Esq., c/o Abelman Frayne & Schwab, 150 East 42nd Street, New York, New York 10017, attorney for Opposer, this 3rd day of September, 2004.

/Nancy A. Fickle/
Nancy A. Fickle

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