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

Proceeding	91175892
Party	Defendant Daniel, Mark T
Correspondence Address	DANIEL, MARK T 2316 YORK RD SW ROANOKE, VA 24015-3906 UNITED STATES mtdesq@hotmail.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Mark Tyson Daniel
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Signature	/Mark Tyson Daniel/
Date	08/15/2007
Attachments	Microsoft_Opposition_91175892_--_Motion_to_Dismiss_8.15.07[1].pdf (12 pages)(33892 bytes)

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

MICROSOFT CORPORATION,	:	
Opposer,	:	Opposition No. 91175892 Opposition No. 91175893
v.	:	
DANIEL, MARK T.,	:	
Applicant.	:	

ORDER

AND NOW, this _____ day of _____ 2007, upon consideration of Applicant Mark Tyson Daniel's Motion to Dismiss Opposer Microsoft Corporation's Amended Notice of Opposition, or, Alternatively, to Strike Improper Allegations, and any Response thereto,

IT IS HEREBY ORDERED that Applicant's Motion to Dismiss is GRANTED and the Amended Notice of Opposition is DISMISSED with prejudice.

BY THE TRADEMARK TRIAL
AND APPEAL BOARD:

_____

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

MICROSOFT CORPORATION,	:	
Opposer,	:	Opposition No. 91175892 Opposition No. 91175893
v.	:	
DANIEL, MARK T.,	:	
Applicant.	:	

ORDER

AND NOW, this _____ day of _____ 2007, upon consideration of Applicant Mark Tyson Daniel's Motion to Dismiss Opposer Microsoft Corporation's Amended Notice of Opposition, or, Alternatively, to Strike Improper Allegations, and any Response thereto,

IT IS HEREBY ORDERED that Applicant's Motion to Strike Improper Allegations is GRANTED. IT IS FURTHERED ORDERED that Opposer Microsoft Corporation has twenty (20) days to amend its Amended Notice of Opposition to conform to this Order.

BY THE TRADEMARK TRIAL
AND APPEAL BOARD:

_____

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

MICROSOFT CORPORATION,	:	
Opposer,	:	Opposition No. 91175892 Opposition No. 91175893
v.	:	
DANIEL, MARK T.,	:	
Applicant.	:	

APPLICANT MARK TYSON DANIEL'S MOTION TO DISMISS OPPOSER MICROSOFT CORPORATION'S AMENDED NOTICE OF OPPOSITION, OR, ALTERNATIVELY, TO STRIKE IMPROPER ALLEGATIONS

Pursuant to Trademark Rule of Practice 2.116 and Fed. R. Civ. Pro. 12(b)(6) and 12(f) Applicant Mark Tyson Daniel ("Applicant") hereby moves the Trademark Trial and Appeal Board ("the Board") to dismiss the opposition proceedings referenced above filed by Opposer Microsoft Corporation ("Microsoft"), or, alternatively, to strike the improper allegations of bad faith contained therein. The specific grounds for this motion are set forth in the attached memorandum of law, which is fully incorporated by reference herein.

Wherefore, Applicant respectfully requests that the Board grant this motion and dismiss the opposition, or, alternatively, strike the improper allegations of bad faith.

Respectfully submitted,

By: /s/ Mark Tyson Daniel
Mark Tyson Daniel
2316 York Road SW
Roanoke, VA 24015-3906
Applicant, *pro se*

Date: August 15, 2007

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

MICROSOFT CORPORATION,	:	
Opposer,	:	Opposition No. 91175892 Opposition No. 91175893
v.	:	
DANIEL, MARK T.,	:	
Applicant.	:	

MEMORANDUM IN SUPPORT OF APPLICANT MARK TYSON DANIEL'S MOTION TO DISMISS OPPOSER MICROSOFT CORPORATION'S AMENDED NOTICE OF OPPOSITION, OR, ALTERNATIVELY, TO STRIKE IMPROPER ALLEGATIONS

FACTUAL BACKGROUND

These consolidated Oppositions were initially filed by Microsoft on February 27, 2007. Microsoft asserts priority under the Paris Convention for the Protection of Industrial Property based on respective marks registered in Germany in July 2006.

On May 8, 2007, during the pendency of Applicant's Motion to Suspend Proceedings, the Board Ordered Microsoft to amend its Opposition because Microsoft's "notices of opposition fail[ed] to present a claim of priority based on 'use analogous to trademark use.'" Specifically, the Board explained that "Opposer has not adequately stated the 'use analogous to trademark use' grounds to support a claim of priority on this basis," noting that "Opposer states that it first used its mark 'on or in July 2006' (paragraph 6). Inasmuch as applicant filed the earliest of its applications on July 16, 2006, opposer must plead use prior thereto or it would not have any use onto which it could tack its later use." (emphasis added). On May 11, 2007, Microsoft filed its Amended Notice of Opposition.

ARGUMENT

1. Microsoft Fails to Allege Use in Conformity with the Board's May 8, 2007 Order

In its May 8, 2007 Office Action, the Board found that Microsoft's Opposition filed on February 27, "fail[ed] to present a claim of priority," noting that paragraph six (6) of Microsoft's original Opposition alleged priority based on the concept of "use analogous to trademark use" and finding that Microsoft's allegation that it first used its mark "on or in July 2006" was deficient, ordering Microsoft to amend its Opposition to "cure the deficiencies in the complaints."

As discussed above, the Board explained that "[Microsoft] has not adequately stated the 'use analogous to trademark use' grounds to support a claim of priority on this basis," noting that "[Microsoft] states that it first used its mark 'on or in July 2006' (paragraph 6). Inasmuch as applicant filed the earliest of its applications on July 16, 2006, opposer must plead use prior thereto or it would not have any use onto which it could tack its later use." (emphasis added).

A review of Microsoft's Amended Oppositions shows that Microsoft has not pled use prior to July 2006, thus, failing to cure the deficiencies identified by the Board. In the amended paragraph six (6), Microsoft adds the following propositions in its attempt to cure the noted deficiencies, none of which plead use prior to July 2006:

- the allegation that Microsoft's mark "became known to Applicant, users and the industry at least as early as July 11, 2006."

- "Opposer made use of its ZUNE mark in preparation for analogous to formal trademark use at least as early as July 11, 2006."

- "Opposer's adoption and use of ZUNE has had a substantial impact on the purchasing public, resulting in an identification in the mind of the consuming public between the ZUNE mark and Opposer's ZUNE goods and services since at least July 11, 2006."

• "For example, throughout the month of July 2006, prior to the filing date of Applicant's intent-to-use application, Opposer's adoption and use of ZUNE resulted in a significant amount of third-party discussion and reporting on Internet blogs, discussion forums and on-line new (sic) magazines mentioning, referring to and discussing Opposer's new ZUNE digital music/MP3 player and Opposer's planned use of ZUNE for a family of products and services including, *inter alia*, an on-line music service and an X-box-like portable video game machine." (emphasis added).

In *Buti v. Perosa*, 139 F.3d 98, 105 (2d Cir. 1998) the Second Circuit adopted the "TTAB's longstanding view" that "the mere advertising or promotion of a mark in the United States is insufficient to constitute 'use' of the mark 'in commerce,' within the meaning of the Lanham Act, where that advertising or promotion is unaccompanied by any actual rendering *in the United States or in 'commerce*['].... *Id.* at 105 (citing *Mother's Restaurants Inc. v. Mother's Other Kitchen, Inc.*, 218 U.S.P.Q. 1046, 1983 WL 51992 (TTAB 1983) (emphasis and alterations in the original).

In this case, Microsoft has not alleged any use in the United States that would satisfy the Board's May 8, 2007 Order. The language added to paragraph six (6) amounts to nothing more than advertising, not actual use in commerce. Microsoft's attempt to shift the focus onto Applicant's knowledge of their mark is irrelevant and transparent.

More importantly, however, is a review of what words Microsoft chose to remove from paragraph six (6) of its Amended Opposition that reveals Microsoft's intentions concerning how it decided to cure the deficiencies relating to the timing of Microsoft's first use of its mark.

Specifically, in the Amended Opposition, regarding the time frame of use in July 2006, Microsoft simply replaces the sentence:

> "Opposer officially announced the adoption of its ZUNE mark to the public on or in July 2006, and commencing as early as November 14, 2006, Opposer has continuously used the ZUNE mark in commerce in the United States as a trademark on its digital media player...." (February 27) (emphasis added)

with

> "Opposer officially announced the adoption of its ZUNE mark to the public in July 2006, and since that time Opposer has continuously used the ZUNE mark in commerce to promote its digital media player…." (May 11).

What is alarming is the fact that Microsoft makes no attempt to offer any additional facts to support the significant alterations made to the allegations fundamental to Microsoft's claim for priority. *See* 71 CORPUS JURIS SECUDUM § 366 (June 2007) ("A party will not, however, be allowed the benefit of an amendatory pleading in positive antagonism to his or her original pleading without specifically showing some inadvertence in the original pleading and giving full and satisfactory reasons for same and for the change desired to be made."). Without any additional factual support or explanation, Microsoft shortened the timeline of first use of its mark from November 2006 to July 2006. This is questionable, at best, especially without further explanation.

What is conclusive is that a side-by-side comparison of Microsoft's Oppositions filed on February 27 and the Amended Opposition filed on May 11 shows that Microsoft still does not allege that it used its mark in commerce before July 2006. Thus, because Microsoft has failed to cure the deficiencies identified by the Board, Microsoft's Amended Opposition should be dismissed with prejudice.

2. Microsoft Lacks Standing Under the Paris Convention

Even if the Board concludes that Microsoft has properly alleged "use," which it has not, Microsoft lacks standing under the Paris Convention because when Microsoft filed its mark in the German Trademark Office, it did so as a United States entity, listing its country of origin as "Redmond, Wash., U.S." This means that Microsoft cannot seek priority in the United States under the Paris Convention because Microsoft is not a "foreign national" in the United States. *See In re Rath*, 402 F.3d 1207, 1213 (Fed. Cir. 2005) ("the Paris Convention 'establish[ed] a

minimum standard for all member countries as to what grounds for refusal of registration of any mark duly registered in the country of origin can be imposed by the other countries…." (citations omitted)).

The pertinent language in the Paris Convention is found in Article 6*quinquies*, which states that "Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union."[1]

The consequence of Microsoft's decision to list "Redmond, Wash." on its German application is clear. It establishes the U.S. as Microsoft's country of origin. Because the Paris Convention applies to foreign nationals who have registered their marks in their country of origin, and because Microsoft has not registered its mark in its country of origin: the U.S., Microsoft cannot seek the benefits of priority afforded to foreign nationals The conclusion strips Microsoft of the priority it seeks under the Paris Convention.

This argument is not a stretch or perversion of U.S. trademark law; rather, it would be a perversion of U.S. trademark law to permit Microsoft to bootstrap its U.S. application with its German registration, especially in this case where Microsoft's stated country of origin is the United States. Certainly Microsoft does not contend that it is a foreign national. *See United Rum Merchants Ltd. v. Distillers Corp.*, 9 U.S.P.Q.2d 1481, 1988 WL 252327 (TTAB Nov. 2, 1988) (discussing just such a perversion of Section 44(e) in the event a foreign applicant were

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[1] The Paris Convention is essentially a compact between the various member nations to accord in their own countries to citizens of the other member nations trademark and other rights comparable to those accorded their own citizens by their domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens. The [Paris] Convention is not premised upon the idea that the trademark laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation's law shall have only territorial application. Thus, the Paris Convention creates nothing that even remotely resembles a "world mark" or an "international registration." Rather, it recognizes the principle of the territoriality of trademarks: a mark exists only under the laws of each sovereign nation.
4 J. McCarthy, McCarthy on Trademarks & Unfair Competition §29:25 (4th ed. 2003).

permitted to bootstrap a registration in the United States for a mark otherwise not permitted filing in its country of origin).

In sum, for purposes of priority under the Paris Convention, Microsoft is not a foreign national because its country of origin is the U.S. To permit Microsoft this benefit would be to sanctify Microsoft's attempt to sidestep U.S. trademark law and gain a six-month priority look back period. Microsoft's furtive attempt to register its "intent to use" mark in Germany, only to later seek priority in the U.S. violates the spirit of the very laws that Microsoft seeks protection under. For these reasons, Microsoft's Opposition should be dismissed with prejudice.

3. Microsoft's Unsupported Allegations of Bad Faith Are Improper

Even if the Board determines that Microsoft may seek priority under the Paris Convention, Microsoft's Opposition should be dismissed because Microsoft fails to allege Applicant's alleged bad faith with requisite particularity or present any specific facts, rendering all allegations of any misconduct improper.

In its Amended Opposition, Microsoft alleges for the first time[2] that Applicant engaged in bad faith conduct, concluding that this alleged bad faith results in Applicant's registration as void *ab initio*. *See* Amend. Oppos. at ¶ 16. Despite the severity of these charges, equal to an assertion of fraud, see *Caesars World, Inc. v. Milanian*, 247 F.Supp.2d 1171, 1206-07 (D. Nev. 2003) (discussing bad faith in trademark infringement) Microsoft fails to allege any facts with particularity as required by Fed. R. Civ. Pro. 9(b), instead relying on merely assertions of "on information and belief." *See* Amend. Oppos. at ¶¶ 13-15.

[2] Microsoft first raised the issue of bad faith in its Response to Applicant's Motion to Suspend, in an improper attempt to disparage Applicant's credibility before the Board, asserting that Applicant filed his motion to suspend in order to avoid the legal consequences of filing his Answer," suggesting that Applicant has committed wrong doing for defending this matter *pro* se, when it is absolutely clear that Applicant has sought no special treatment, and asserting incorrectly that Applicant was in default. These improper statements reveal the depth of Microsoft's disregard for the rules of civil procedure, underscoring Microsoft's apparent belief that it is entitled to act on its own will with impunity. The improper remarks should not go unsanctioned.

At most, Microsoft alleges in paragraph six (6) of the Amended Opposition, the paragraph the Board ordered Microsoft to amend, that Applicant learned about Microsoft's mark after May 2006 when "[w]ord of [Microsoft's] … MP3 player began to leak to the public…." From this scintilla of facts, Microsoft concludes that Applicant acted in bad faith, a statement that is irrelevant at this stage in the proceedings and outrageous without any factual support.

Furthermore, case law does not support Microsoft's allegations. Mere knowledge of a foreign mark does not give rise to bad faith or preclude individuals from using the mark in the United States. *See Person's* Co. v. Christman, 900 F.2d 1565, 1570 (Fed. Cir. 1990) ("Knowledge of a foreign use does not preclude good faith adoption and use in the United States."); *accord Buti*, 139 F.3d at 106; Cullman § 19.24 and cases cited therein ("[E]van an intentional imitator may acquire domestic trademark rights if the mark he imitates is used in a foreign country.").

For these reasons, Microsoft's unsupported allegations of bad faith are improper. As a consequence of this conduct, Microsoft's Amended Opposition should be dismissed with prejudice.

4. Microsoft's Unsupported Allegations of Bad Faith Should Be Struck

Even if the Board denies Applicant's motion to dismiss the Amended Opposition because of the improper allegations, the Board should grant Applicant's motion to strike these improper and irrelevant allegations pursuant to Fed. R. Civ. Pro. 12(f).

What makes Microsoft's bad faith argument even more insidious and disingenuous is that Microsoft apparently sought registration in Germany, and not in the U.S., as an attempt to gain additional time to prepare its MP3 player for actual use in commerce because the player was not used in commerce until November 2006, which Microsoft now asserts and, indeed, affirms has

been used in commerce since July 2006, yet Microsoft presents no additional facts to explain the shift in timeline. First, this shows Microsoft's attempt to sidestep U.S. law. More importantly, however, it shows that Microsoft was not using in commerce its MP3 player before its launch in November 2006, and, thus, Microsoft does not enjoy priority of its ZUNE mark.

CONCLUSION

For the reasons set forth above, Applicant Mark Tyson Daniel respectfully requests that the Board grant his Motion to Dismiss Opposer Microsoft Corporation's Amended Notice of Opposition, or, Alternatively, to Strike Improper Allegations.

Respectfully submitted,

By: /s/ Mark Tyson Daniel

Mark Tyson Daniel
2316 York Road SW
Roanoke, VA 24015-3906
Applicant, *pro se*

Date: August 15, 2007

CERTIFICATE OF SERVICE

I, Mark Tyson Daniel, hereby certify that on this 15th day of August 2007, I caused a true and correct copy of Applicant Mark Tyson Daniel's Motion to Dismiss Opposer Microsoft Corporation's Amended Notice of Opposition, or, Alternatively, to Strike Improper Allegations to be served via first class U.S. Mail and via electronic mail on counsel for Opposer Microsoft Corporation at the address below:

William O. Ferron, Jr.
Seed IP Law Group
Suite 5400
701 Fifth Avenue
Seattle, WA 98104

/s/ Mark Tyson Daniel__
Mark Tyson Daniel