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

Proceeding	91176065
Party	Plaintiff Lenovo (Singapore) Pte. Ltd
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Submission	Motion to Dismiss - Rule 12(b)
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Date	11/06/2008
Attachments	THINKCP Motion to Dismiss.pdf ( 8 pages )(227121 bytes )

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

In the matter of trademark application Serial No. 78/636,480  
For the mark THINKCP  
Published in the Official Gazette on November 7, 2006

Lenovo (Singapore) PTE Ltd.	)	
	)	Opposition No. 91176065
Opposer,	)	
	)	
vs.	)	
	)	
H. Co. Computer Products	)	
	)	
Applicant.	)	
<hr/>		
H. Co. Computer Products	)	
	)	
Counterclaimant,	)	
	)	
vs.	)	
	)	
Lenovo (Singapore) PTE Ltd.	)	
	)	
Respondent.	)	
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**MOTION TO DISMISS AMENDED COUNTERCLAIM**

**Introduction**

Respondent Lenovo (Singapore) Pte. Ltd. hereby moves to dismiss the single counterclaim by H. Co. Computer Products (“H. Co.”) to cancel seven of Lenovo’s registered marks. The basis of this motion is threefold -- it is unclear what Lenovo registrations H. Co. is seeking to cancel given that H. Co. has paid to cancel seven classes, but yet identified a set of seven Lenovo marks containing ten classes, H. Co. does not have standing to bring the cancellation proceeding as H. Co. has not pled a reasonable

basis for its asserted likelihood of confusion and H. Co has not properly pled priority. The counterclaim should be dismissed, rather than H. Co. being given an opportunity to amend, as H. Co. was previously permitted to amend its counterclaim in response to Lenovo's Motion for a More Definite Statement.

**Failure to Identify the Class and Marks Sought to be Cancelled**

The counterclaim identifies seven of Lenovo's marks that H. Co. "petitions to cancel". (Introduction to Amended Counterclaim) These registration are Reg. No. 2,633,094 for THINKSCRIBE in Class 9, Reg. No. 2,550,628 for THINKLIGHT in Class 9, Reg. No. 2,995,709 for THINKCENTRE in Classes 9 and 16, Reg. No. 2,934,258, for THINKCENTRE in Class 9, Reg. No. 3,009,301 for THINKVANTAGE in Classes 9 and 16, Reg. No. 2,678,462 for THINKSTATION for Class 9, and Reg. No. 2,931,692 for THINKVISION in Classes 9 and 16. H. Co.'s counterclaim thus seeks to cancel seven marks in ten classes. H. Co., however, has only paid the fee for canceling seven classes.

It continues to be unclear which registrations (and in which classes) H. Co. seeks to cancel. All that is known is H. Co. has paid for cancelling seven of ten classes in the identified registrations. From these ten classes, there are a number of possible combinations of registration which would yield the seven classes paid for. H. Co. should not now be given a second opportunity to clarify which classes of which registrations it is seeking to cancel. The counterclaim should be dismissed and H. Co. should not be given a second opportunity to file an amended Answer and Counterclaim.

Dismissing the counterclaim is particularly appropriate where, as here, the party has previously had an opportunity to correct its pleading. As noted in the Trademark Trial and Appeal Board Manual of Procedure, “where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity for amendment.” TBMP, Section 503.03. Cases in which the Board has refused to permit an opportunity to amend include those situations -- such as the present case -- in which the party has previously had an opportunity to correct the defect. See *McConnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985) (plaintiff had already been allowed two opportunities to correct its pleading). H. Co. should not now be given a further opportunity to correct its pleading.

### **Failure to Plead Standing**

It is well settled that “[a]t the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis for its belief of damage’”. TBMP § 309.03(b). Ho. Co.’s Amended Counterclaim fails to allege **any** facts to support its assertion of a likelihood of confusion, let alone facts which permit a determination of whether that belief is reasonable.

The sole allegation regarding likelihood of confusion is that statement in Paragraph 12 of the Amended Counterclaim that “Lenovo’s marks so resemble HCCP’s Marks as to be likely to cause confusion, or to cause mistake, or to deceive when used in connection with Lenovo’s goods.” HCCP’s marks are identified in Paragraph 8 of the Amended Counterclaims as follows (a total of twenty nine common law word marks):

THINK COMPUTER SYSTEM or SYSTEMS  
THINKPOWER SYSTEM or SYSTEMS  
THINK MEMORY PRODUCTS  
THINK MEMORY  
THINK NETWORKING PRODUCTS  
THINK STORAGE SOLUTIONS  
THINK STORAGE SYSTEMS  
THINK VIPOR RAID  
THINK VIPOR STORAGE  
THINK SAN SOLUTIONS  
THINK NAS SOLUTIONS  
THINK SECURITY SOLUTIONS  
THINK SECURITY SYSTEMS  
THINK U-KEY-COM  
THINK FLASH DRIVES  
THINK FLASH MEMORY  
THINKTANK IQ  
THINKTANK I-SERIES  
THINKTANK Q-SERIES  
THINK FIRE-N-ICE  
THINK PERFECTPIX  
THINK MP3 PLAYERS  
THINK HEADTRIP  
THINK ROADTRIP  
THINK IC & COMPONENTS  
THINKCP FLAT PANEL DISPLAYS & MONITORS  
THINK ON-SITE WARRANTIES  
THINK ON-SITE SERVICE  
THINK ON-SITE SUPPORT

The only common element among these asserted common law word marks is THINK. A search of the USPTO website, however, for THINK marks in Class 9 identifies 361 such marks. Indeed, none of the marks, in their entirety, cited by H. Co. are similar to the marks H. Co. seeks to cancel. Rather, the marks cited and sought to be cancelled merely share a common element of THINK. In such a circumstance, a mere bald assertion of likelihood of confusion is not “reasonable”.<sup>1</sup> As H. Co. has not

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<sup>1</sup> In such a circumstance there may in fact be a likelihood of confusion. Merely stating the conclusion, however, is not sufficient for pleading purposes. Rather, the party asserting the likelihood of confusion must state the grounds for its “reasonable basis” for believing there is confusion.

provided any allegations for its belief of likelihood of confusion, the counterclaim should be dismissed.

Furthermore, the mere position of H. Co. as the defendant in the opposition proceeding does not automatically confer standing on H. Co. in the cancellation proceeding based upon a likelihood of confusion since the mark that is subject to the opposition is not used as a basis for the cancellation proceeding. See *General Mills, Inc. v. Natures Way Products*, 202 USPQ 840, 841 (TTAB 1979)

**Failure to Plead Priority**

Where, as here, the Counterclaimant is not asserting a registered mark as the basis for the likelihood of confusion claim, the H. Co. must also plead prior trademark or service use. See TBMP 309.03(c)(A). As H. Co. is relying on twenty nine asserted common law marks, H. Co. must plead that each of its relied upon common law marks has priority to each of the Lenovo registrations it seeks to cancel, whichever registrations those may be (see discussion supra).

The priority dates for the registrations that H. Co seeks to cancel are as follows:

<b>Registration No</b>	<b>Mark</b>	<b>Class</b>	<b>Filing Date</b>
2,678,462	THINKSTATION	009	03/18/1999
2,550,628	THINKLIGHT	009	09/13/1999
2,633,094	THINKSCRIBE	009	03/20/2001
2,995,709	THINKCENTRE	009, 016	08/26/2002
2,934,258	THINKCENTRE	009	08/26/2002
3,009,301	THINKVANTAGE	009, 016	08/26/2002
2,931,692	THINKVISION	009, 016	12/12/2002

The allegation of priority in the present counterclaim, however, is insufficient. Paragraph 10 of the Counterclaim states “[s]ince prior to the claimed priority date **in**

**some or all** of Lenovo's Registrations, HCCP has been using HCCP's Marks in connection with HCCP's Goods." Not only does the pleading fail to identify those particular H. Co. marks which have priority to each of Lenovo's seven registrations, the pleading attempts to group all of H. Co.'s marks together. In doing so, the pleading fails to allege that any of H. Co.'s marks has priority against all seven of Lenovo's registrations.

Since H. Co.'s counterclaim fails to allege that each of the twenty nine marks has priority over any one of -- let alone all of -- Lenovo's seven registered marks identified in the Amended Counterclaim, the counterclaim should be dismissed.

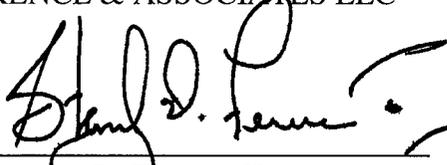
### **Conclusion**

Although a single pleading may be filed seeking to cancel more than one registration under the rules of practice, as was done here, doing so does not relieve a party from complying with the rules of pleading. In the present case, H. Co. needs to plead its "reasonable belief" for its claim of likelihood of confusion and must also allege that each of the twenty nine common law marks it is relying upon has priority over each of the seven Lenovo marks sought to be cancelled. H. Co. was previously given an opportunity to file an Amended Counterclaim in response to a Motion for a More Definite Statement filed by Lenovo. H. Co. should not now be given another bite at the proverbial apple. The appropriate remedy of this insufficient pleading is dismissal of the counterclaim for cancellation.

Respectfully Submitted,

FERENCE & ASSOCIATES LLC

Dated: November 6, 2008

By: 

Stanley D. Ference III  
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Attorneys for Opposer

**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that the foregoing MOTION TO DISMISS AMENDED  
COUNTERCLAIM is being electronically filed with:

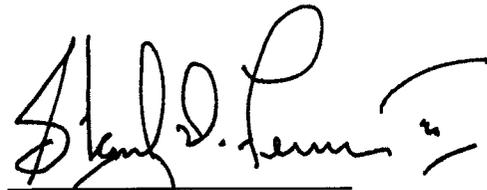
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

and that the forgoing MOTION TO DISMISS AMENDED COUNTERCLAIM is  
being served by first-class mail, postage pre-paid, to:

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this 6th day of November, 2008.



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