ESTTA Tracking number: **ESTTA254338**
Filing date: **12/10/2008**

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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Attachments	THINKCP Motion to Dismiss Reply (Dec 2008).pdf (8 pages)(237731 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. Opposer, vs. H. Co. Computer Products Applicant.	)	Opposition No. 91176065
H. Co. Computer Products Counterclaimant, vs. Lenovo (Singapore) PTE Ltd. Respondent.	)	

REPLY BRIEF IN SUPPORT OF LENOVO'S
MOTION TO DISMISS AMENDED COUNTERCLAIM

Introduction

The *Motion to Dismiss Amended Counterclaim* filed by Lenovo (Singapore) Pte. Ltd. was based on three grounds -- a failure to identify the class and marks sought to be cancelled, a failure to plead standing, and a failure to plead priority. In its *Opposition to Motion to Dismiss Counterclaim*, Counterclaimant H. Co. Computer Products ("H. Co") admits its' amended counterclaim fails to identify the marks and classes it seeks to cancel, fails to state why it has a reasonable basis for its claim of likelihood of confusion

given the number of co-existing multiple word marks which include the word THINK[1] and fails to adequately address the issue of priority for each of the twenty-nine asserted common law marks against the Lenovo registrations sought to be cancelled. Lenovo's *Motion to Dismiss Amended Counterclaim* should be granted.

The Failure to Identify the Marks Sought to be Cancelled

As noted in Lenovo's *Motion to Dismiss Amended Counterclaim*, the amended counterclaim identifies **seven marks** of Lenovo which H. Co. "petitions to cancel" which are registered in **ten classes** and H. Co. has only paid the fee associated with canceling **seven classes**. As such, H. Co.'s amended counterclaim is deficient as it is unclear which of Lenovo's marks (and in what classes) H. Co. is seeking to cancel. H. Co. admits its amended counterclaim is unclear by referring the Board to a "cover sheet" -- which is not part of the pleading -- when it states "the classes and registrations at issue here are further identified in the cover sheet filed with HCCP's original June 7, 2007, pleading." (*Opposition to Motion to Dismiss Counterclaim* at 8). Given the admitted deficiency of the amended counterclaim by H. Co., the Board should dismiss the amended counterclaim without giving H. Co. a further opportunity to amend.

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1 The mark which H. Co. seeks to register is THINKCP, a single word THINK formative mark. All of the Lenovo marks which H. Co. appears to be seeking to cancel are also single word THINK formative marks. However, all of the common law marks identified in the amended counterclaim are multiple word marks which merely contain the term THINK, e.g., THINK NETWORKING PRODUCTS.

The Failure to Plead Standing

In its amended counterclaim, H. Co. first identifies twenty-nine common law marks on which it purports to rely as a basis for canceling Lenovo's marks. Each of these twenty-nine common law marks contain multiple words and merely contain the word THINK, e.g., THINK NETWORKING PRODUCTS, THINK STORAGE SOLUTIONS, THINK VIPOR RAID, THINK SECURITY SOLUTIONS, THINK ON-SITE SUPPORT, etc. These marks differ from the mark at issue in this opposition proceeding, i.e., THINKCP, which is a single word THINK formative mark. There are any number of a great many multiple word marks which contain the term THINK, both registered and common law, already in the marketplace. There are, however, an extremely limited number of single word THINK formative marks.

Given the requirements for standing, "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)), H. Co. must allege sufficient facts to permit the Board to determine the "reasonableness" of H. Co.'s position given the number of co-existing multiple word marks which contain the term THINK. As noted in Lenovo's *Motion to Dismiss Amended Counterclaim*, a search of the USPTO website for multiple word marks in Class 9 containing the word THINK identified **361 multiple word marks**. (Page 4) H. Co., however, has alleged no facts whatsoever in support of its alleged "reasonable basis". Given the failure of H. Co.'s amended counterclaim to permit an evaluation of the "reasonableness" of its claim of likelihood of confusion given the number of multiple word marks which contain the term THINK, the amended counterclaim should be dismissed.

The Failure to Plead Priority

When relying on a common law mark in a cancellation proceeding, as H. Co. has done, H. Co. must also plead prior trademark or service use of each of the twenty-nine common law marks on which it is relying. In its *Opposition to Motion to Dismiss Counterclaim*, H. Co. does not dispute this, but instead asserts paragraphs 9 and 10 of the amended counterclaim sufficiently plead priority. Simply asserting that **all or some** of the common law marks (without identifying particular marks) "have been used in connection with HHCP's Goods" is not sufficient to plead trademark or service mark usage. See TMEP § 904.04 for a discussion of usage in connection with goods which does not qualify as trademark or service mark usage. As such, the amended counterclaim fails to properly plead priority and should be dismissed.

Furthermore, as set out in Lenovo's *Motion to Dismiss Amended Counterclaim*, the priority dates which H. Co. must overcome for each and every one of its asserted twenty-nine common law marks range from March 1999 to December 2002. In its *Opposition to Motion to Dismiss Counterclaim*, H. Co. asserts that it "has been using its marks on its goods since at least as early as 1996, which is three years prior to the earliest priority date for any of Lenovo's registrations." (*Opposition to Motion to Dismiss Counterclaim* at 5) To the extent this is a statement that is meant to apply to each and every one of H. Co.'s twenty-nine common law marks, it may very well be sanctionable.

By way of example, according to H. Co.'s website, THINK ROADTRIP (one of the twenty-nine common law marks relied upon by H. Co.) broadcasts the signal from an MP3 player to a car stereo. (http://www.thinkcp.com/products/thinkroadtrip.asp) A

market for accessories like this for mp3 players, however, did not develop until sometime after the Apple iPod was introduced in the Fall of 2001. (http://en.wikipedia.org/wiki/Ipod) Furthermore, the THINK ROADTRIP mp3 accessory did not appear on H. Co.'s website at least as late as December 2006. (http://web.archive.org/web/20061127122443/www.thinkcp.com/products/sitemap.asp) THINK ROADTRIP is but one quick example and it should be obvious H. Co. cannot show priority for each and every one (if any) of the twenty-nine common law marks on which it relies (and not the collective "HCCP's marks") under the penalty of sanctions provided by the rules.

Additionally, trademark cancellation proceedings incorporate the "fair notice" pleading concept of the Federal Rules of Civil Procedure such that a complaint (or petition to cancel) is required to include enough detail give a defendant "fair notice" of the claims raised therein. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USQP2d 1570 (TTAB 1988) ("Under the Federal Rules of Civil Procedure the function of pleadings is to give fair notice of the claim asserted -- preferably, as provided by Fed.R.Civ.P. 8(a)(2), in a form which contains 'a short and plain statement of the claim.'"). This concept of "fair notice" has been applied by the Board in dismissing a cancellation action to require that a plaintiff must allege ultimate facts pertaining the alleged abandonment when a party is seeking to cancel a registration based on abandonment in order to provide the defendant with fair notice of the plaintiff's theory of abandonment. *Otto International, Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007). Moreover, merely incanting the language of the Trademark Act does not provide fair notice of a claim. *Id.* ("to properly allege misrepresentation of a source, a party must do more than make a bald

allegation in the language of the statute, as this does not give fair notice of the basis for petitioner's claim").

The rationale of "fair notice" is equally applicable to the present case, where H. Co. is seeking to cancel Lenovo's marks based upon twenty-nine identified common law marks but has not asserted dates of first use for each of the common law marks, nor has H. Co. identified the specific goods or services with which each of the common law marks has allegedly been used. Without at least some bare bones assertion of use dates and goods or services for each one of the common law marks relied upon by H. Co., Lenovo does not have "fair notice of the basis for petitioner's claim" and the amended counterclaim should be dismissed.

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Conclusion

In its amended counterclaim, H. Co. has failed to identify the class and marks sought to be cancelled, failed to plead standing, and failed to plead priority with respect to each one of the twenty-nine common law marks replied upon. This is H. Co.'s **amended** counterclaim. 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: December 10, 2008

By: _____

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CERTIFICATE OF TRANSMISSION AND SERVICE

I certify that the foregoing REPLY BRIEF IN SUPPORT OF LENOVO'S 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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Attorneys for Counterclaimant

this 10th day of December, 2008.

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