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

Proceeding	91180462
Party	Plaintiff CALIFORNIA CLOSET COMPANY, INC.
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CALIFORNIA CLOSET COMPANY, INC.            )  
  )  
                  Opposer,                            )  
  )  
                  v.                                    ) Opposition No. 91180462  
  )  
CHARLES KENWORTHY                            )  
TERRI KENWORTHY                             )  
  )  
                  Applicants.                     )

**MOTION FOR (PARTIAL)DISMISSAL OF COUNTERCLAIM FOR CANCELLATION  
OF U.S. TRADEMARK REGISTRATION NOS. 1915339, 2853226 AND 3168301**

Opposer California Closet Company, Inc., hereby moves for partial dismissal of the counterclaim for cancellation of U.S. Trademark Registration Nos. 1915339, 2853226 and 3168301 (“counterclaim”). Specifically, Opposer moves to dismiss Applicants’ claims of fraud and unclean hands (counterclaim ¶13); further, with respect to Registration No. 1,915,339, Opposer moves to dismiss all remaining claims of the counterclaim except those alleging abandonment and that the registered mark is generic. In support of its Motion, Opposer submits the following.

**1. APPLICANTS HAVE FAILED TO PLEAD FRAUD WITH THE REQUIRED SPECIFICITY.**

F.R.Civ.P. 9(b) requires for any averment of fraud, that the circumstances alleged to constitute such fraud be stated with particularity. The counterclaim simply pleads, in ¶13: “Registrant’s continued registration of the Subject Marks should also be refused because registrant has committed fraud upon the Trademark Office and/or has unclean hands.” Clearly, this does not state, even generally, the circumstances alleged to constitute fraud, let alone with the particularity required under F.R.Civ.P. 9(b). Accordingly, the claim for fraud must be dismissed for failure to

state a claim. *See Food Specialty Co., Inc. v. Carnation Company*, 170 U.S.P.Q. 222, 223-24 (TTAB 1971).

**2. UNCLEAN HANDS IS NOT A COGNIZABLE GROUNDS FOR CANCELLATION.**

As set forth above, the counterclaim, ¶13, pleads that Registration Nos. 1915339, 2853226 and 3168301 should be cancelled “because registrant has . . . unclean hands.” Such an allegation of unclean hands is not a valid ground for cancellation of a registration which may be entertained by the Board. *See Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154 (TTAB 2003). Therefore the counterclaim on such ground must be dismissed for failure to state a claim. *Id.*

**3. THE CHARGES OF ABANDONMENT AND THAT THE REGISTERED MARK IS GENERIC ARE THE ONLY COGNIZABLE GROUNDS FOR CANCELLATION OF REGISTRATION NO. 1915339.**

Opposer’s Registration No. 1915339 issued August 29, 1995. As such – the registration is more than five years old – it may be cancelled only on the specific grounds enumerated in §14(3) and (5) of the Trademark Act. *See* 15 U.S.C. §1064(3) and (5). *See also Treadwell’s Drifters, Inc. v. Larry Marshak*, 18 USPQ2d 1318 (TTAB 1990). Applicants’ claims that the mark of Registration No. 1915339 are descriptive (counterclaim ¶18), and that the application which matured into Registration No. 1915339, in effect, is void *ab initio*, for the failure to make use or “*bona fide*” use of the subject mark as of the filing date of the application (counterclaim 9 and 11), are not among these enumerated grounds. *See Id.*(claim that application is void *ab initio* is not a ground for cancellation of a registration more than five years old); *Food Specialty Co., Inc. v. Carnation Company, supra* (descriptiveness not a ground for cancellation of registration over five years old). Therefore, except for their claims of abandonment and that the registered mark is generic, all of

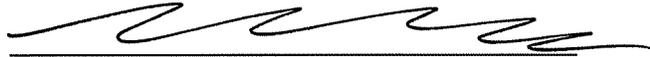
Applicants' counterclaim claims with respect to Registration No. 1915339 must be dismissed for failure to state a claim. *Id.*

**WHEREFORE**, for all of the foregoing reasons, Opposer California Closets, Inc., respectfully submits that its Motion for (partial) dismissal of the counterclaim herein should be granted.

Respectfully submitted,  
CALIFORNIA CLOSET COMPANY, INC.

Dated: February 21, 2008

By:



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Certificate of Service

I hereby certify that on the 21<sup>st</sup> day of February, 2008, the foregoing Motion for (Partial) Dismissal of Counterclaim for Cancellation of U.S. Registration Nos. 1915339, 2853226 and 3168301 was served on Applicants by mailing same, first class and postage prepaid, to the following:

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