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

|                        |  |
|------------------------|--|
| Proceeding             | 91197573   |
| Party                  | Defendant<br>Sipi Metals Corp.   |
| Correspondence Address | ROBERT S. BEISER<br>VEDDER PRICE P.C.<br>222 N LASALLE ST STE 2400<br>CHICAGO, IL 60601-1104<br>UNITED STATES<br>rbeiser@vedderprice.com |
| Submission             | Motion to Dismiss - Rule 12(b)   |
| Filer's Name           | Robert S. Beiser   |
| Filer's e-mail         | rbeiser@vedderprice.com, avilleneuve@vedderprice.com,<br>esosnicki@vedderprice.com   |
| Signature              | /Robert S. Beiser/   |
| Date                   | 10/14/2011   |
| Attachments            | 36429-03-0005_motion_to_dismiss.pdf ( 9 pages )(427811 bytes )   |

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

CHASE BRASS, LLC, a Delaware Limited  
Liability Company,

Opposer,

v.

SIPI METALS CORP., an Illinois Corporation,

Applicant.

Marks: ECO BRONZE / ECO-BRONZE /  
ECOBRONZE

Opposing Marks: ECO BRASS / ECOBRASS

Opposition No. 91/197,571

Opposition No. 91/197,573

Opposition No. 91/197,574

**MOTION TO DISMISS FIRST AMENDED NOTICE OF CONSOLIDATED  
OPPOSITION**

Sipi Metals, Corp. (“Sipi Metals”), Applicant in Opposition No. 91/197,571, Applicant in Opposition No. 91/197,573, and Applicant in Opposition No. 91/197,574 (the “Oppositions”), by and through its attorneys, hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order to dismiss the only remaining ground under 15 U.S.C. § 1052(d) pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (Red.R.Civ.P.). The filing of this motion tolls the time for filing an answer. TBMP § 503.01. Applicant, Sipi Metals, moves the Board to grant an Order dismissing the Oppositions for failure to state a claim upon which relief can be granted, and for failure to include indispensable parties as part of this Opposition.

**TIMELINE**

On June 8, 2010, Applicant’s marks were allowed by the Trademark Office.

On July 27, 2010, Applicant’s marks were published for opposition by the Trademark Office.

On August 26, 2010, three different parties filed a request for an extension of time to oppose pursuant to 37 C.F.R. § 2.102, namely Sambo Copper Alloy Co., Ltd (30 day request), Mitsubishi Shindoh Co., Ltd. (30 day request), and Chase Brass, LLC (90 day request). All three requests were granted by this Board.<sup>1</sup> (See Exhibit A).

On November 24, 2010, of these three parties, only one of the three parties filed the Oppositions, namely Chase Brass, LLC as a licensee of Sambo Copper Alloy Co. (See Notice of Opposition as Exhibit B). These notice for the Oppositions asserted claims under Sections 2(a), 43(c), and 2(d).

On January 3, 2011, Applicant request consolidation of all three oppositions, and moved to dismiss the claims under Sections 2(a), and 43(c).

On June 28, 2011, the Board dismissed the claims under Sections 2(a), and 43(c) and asked Opposer to file an amended pleading.

On July 18, 2011, Opposer filed the First Amended Notice of Consolidated Opposition. This short pleading asserts only Section 2(d) as a ground for opposition. Opposer describes clearly a situation where confusion, if at all, will be between Applicant and Sambo, a party absent from this Opposition:

*9. The grant of a registration to Applicant for its ECOBRONZE mark as sought in the '606 Application, for ECO BRONZE as sought in the '618 Application, and for ECO-BRONZE as sought in the '614 Application should be denied on the grounds that Applicant's ECOBRONZE, ECO BRONZE and ECO-BRONZE are in close approximation of Sambo's ECO BRASS mark or name of Sambo products. Sambo has no connection with Applicant and/or the activities performed by Applicant, or Applicant's goods marketed, under the ECOBRONZE, ECO BRONZE, and/or ECO-BRONZE marks. When used in connection*

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<sup>1</sup> On September 27, 2010 both Mitsubishi Shindoh Co., Ltd. and Sambo Copper Alloy Co., Ltd. filed and were granted a 60 day extension of time to oppose giving all three potential oppose until 11/24/2010 to file a Notice of Opposition.

*with Applicant's "bronze and bronze alloy in bars, billets and sheets for use in manufacturing by machining, casting or forging", the public will presume that Applicant's ECOBRONZE, ECO BRONZE, and ECO-BRONZE goods are connected to Sambo and/or goods sold under the recognizable ECO BRASS mark. This is all to the damage and injury of the purchasing public and to the damage and injury of Sambo and Chase.*

### THE LAW

A court must dismiss claims from a notice of opposition for failure to state a claim if "plaintiff can prove no set of facts in support of his claim which would entitle him to relief." *Advanced Cardiovascular Sys. V. SciMed Life Sys.*, 988 F.2d 1157 (Fed. Cir. 1993). When ruling on a motion to dismiss, although the Board must accept the factual allegations pleaded in the complaint as true, *Abbott Labs. v. Brennan*, 952 F.2d 1346, 1354 (Fed. Cir. 1991), "[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim." *Bradley v. Chiron Corp.*, 136 F.3d 1317, 1322 (Fed. Cir. 1998).

Under Federal Rule of Civil Procedure 12(b)(6), a court should dismiss a complaint if it is clear that no relief could be granted under any set of facts that could be proven consistent with the allegations. *Swierkiewicz v. Sorema N.A.*, 534 U.S. 506 (2002). "Conclusory allegations or legal conclusions masquerading as factual conclusions will not suffice to prevent a motion to dismiss." *Smith v. Local 8191 B.T. Pension Plan*, 291 F.3d 236, 240 (2d Cir. 2002).

A notice of opposition must include (1) a short and plain statement of the reason(s) why oppose believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding), and (2) a short and plain statement of one or more ground for opposition. TBMP § 309.03(a)(2). In the July 1, 2011 opinion from this Board, this Board confirmed that a licensee has standing to maintain a proceeding as a party of interest.

In addition to standing, a plaintiff must also plead a statutory ground for opposition. TBMP § 309.03(c). In cases brought under 15 U.S.C. § 1052(d) the plaintiff must specifically plead any registrations on which it is relying. Id. Pursuant to 15 U.S.C. § 1052(d), plaintiff must assert.. that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception. Id. Opposer in the pleading argues that confusion is likely between Sambo's marks and Applicant's.

A trademark licensor must be joined as a necessary and indispensable party in a Lanham Act claim brought by a licensee due to the potential harm to the licensor's interest in being able to fully exploit its mark if the opposing party prevails, as well as the potential prejudice to the opposing party, who may suffer multiple or inconsistent obligations if the licensor subsequently sues on its own. *JTG of Nashville, Inc. v. Rhythm Brand, Inc.*, 693 F.Supp. 623, 626 (M.D. Tenn. 1998); *St. James v. New Prague Area Cmty. Ctr.*, No. 06-1472, 2006 WL 2069197 (D. Minn. Jul. 26, 2006); *Association of Co-op Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1143 (5<sup>th</sup> Cir. 1982); *Discount Muffler Shop, Inc. v. Meineke Realty Corp., Inc.*, 535 F.Supp. 439, 448 (N.D. Ohio 1982); *Lisseveld v. Marcus*, 173 F.R.D. 689, 693 (M.D. Fla. 1997); *Jaguar Cars Ltd. v. Manufactures des Montres Jaguar, S.A.*, 196 F.R.D. 306, 308 (E.D. Mich. 2000); *Lion Petroleum of Missouri, Inc. v. Millennium Super Stop, LLC*, 467 F.Supp.2d 953 (E.D. Mo. 2006); *May Apparel Group, Inc. v. Ava Import-Export, Inc.*, 902 F.Supp. 93, 96 (M.D.N.C. 1995); *Marrero Enters. Of Palm Beach, Inc. v. Estefan Enters., Inc.* No. 06-81036-CIV, 2007 WL 4218990 (S.D. Fla. Nov. 29, 2007).

## ARGUMENT

Three corporations were granted by this Board additional time to file opposition: (1) Sambo Copper Alloy Co., (“Sambo”), (2) Mitsubishi Shindoh Co., Ltd. (“Mitsubishi”), and (3) Chase Brass, LLC (“Chase”). On November 24, 2010, only one of the three corporations opposed, the U.S. licensee of Sambo, Chase. See Cover Page of First Amended Notice of Consolidated Opposition.

Mitsubishi did not exercise its right to file opposition, and is currently not before this Board. Sambo is also not before this Board. After careful review, the corporation Mitsubishi is absent from the First Amended Notice of Consolidated Opposition. Evidence from the United States Trademark Office TARR database shows that the trademarks ECO BRASS and ECOBRASS are currently owned by Mitsubishi, not Sambo. (See Exhibit B). Only rightful licensees can claim standing. *Syngenta Crop Protection Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537 (TTAB 2009).

As the owner of ECO BRASS and ECOBRASS, Mitsubishi has elected not to file for opposition and this missing party can no longer be joined in this opposition. 37 CFR § 2.102(b), *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm’r 1980).

Chase pleads it owns a license from Sambo, not Mitsubishi. See First Amended Notice of Consolidated Opposition, ¶ 4. Chase also argues that any possible confusion created in the marketplace will be between Applicant and Sambo, not Applicant and Mitsubishi. First Amended Notice of Consolidated Opposition ¶ 9. The pleading on its face is highly defective as it fails to incorporate the rightful owners of the marks. In the absence of proof on the issue of

standing and where likelihood of confusion is plead, the plaintiff's claim will be dismissed. *Demon Int'l LC v. Lynch*, 86 USPQ2d 1058, 1061 (TTAB 2008).

Even if ultimately Chase is found to have standing to maintain a claim under the Lanham Act, the failure of a licensee to join its licensor as an indispensable party to an action will result in the dismissal of the action. Chase argues at ¶9 that customers are likely to confuse Sambo and Applicant as a source of origin for goods, yet Sambo is not a party in this case. Chase as a licensee of Sambo will ask its licensor for documents that favor its case and will received them promptly. Applicant has no method to compel the discovery of any document owned by Sambo that are not in the possession of Chase. The Board cannot believe this is fair. For example, how can Applicant obtain evidence of actual confusions between ECO BRASS from the Opposer since the mark ECO BRASS was registered. Chase is not owner of record for the mark ECO BRASS and this Board has no power over either Sambo or Mitsubishi, both foreign corporations.

Certain trademark licensors, particularly foreign entities seek to avoid appearing in a U.S. legal proceeding, and desire to provide their licensees with the right to enforce their rights in the United States. See *Standing and Joinder Considerations in Trademark Litigation and Licenses*, by Kim J. Landsman, Daniel C. Glazer, and Irene C. Treloar, INTA Trademark Reporter, Vol. 99, No. 9 (Dec. 2009). Rule 19 of the Federal Rules of Civil Procedure requires this Board to determine whether Sambo or the owner Mitsubishi are absent party is "necessary" or even "indispensable" under Rule 19(a).

Rule 19(a) states: "A person who is subject to service of process and whose joinder will not deprive the court of subject-matter jurisdiction must be joined as a party in the action if (A) in that person's absence, the court cannot accord complete relief among existing parties, or (B) that person claims an interest relating to the action in the person's absence may (i) as a practical

matter impair or impede the person's ability to protect that interest; or (ii) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because of the interest."

Rule 19(b) states: "A Court will consider four factors in determining whether a party is indispensable: (1) the extent to which a judgment rendered in the person's absence might prejudice that person or the existing parties, (2) the extent to which any prejudice could be lessened or avoided by: (A) protective provisions in the judgment; (B) shaping the relief; or (C) other measures; (3) whether a judgment rendered in the person's absence would be adequate, and (4) whether the plaintiff would have an adequate remedy in the action where dismissed for non-joinder."

Courts typically require a trademark licensor to be joined as a necessary and indispensable party in a Lanham Act claim brought by a licensee due to the potential harm to the licensor's interest in being able to fully exploit its mark if the opposing party prevails, as well as the potential prejudice to the opposing party, who may suffer multiple or inconsistent obligations if the licensor subsequently sues on its own. *JTG of Nashville, Inc. v. Rhythm Brand, Inc.*, 693 F.Supp. 623, 626 (M.D. Tenn. 1998); *St. James v. New Prague Area Cmty. Ctr.*, No. 06-1472, 2006 WL 2069197 (D. Minn. Jul. 26, 2006); *Association of Co-op Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1143 (5<sup>th</sup> Cir. 1982); *Discount Muffler Shop, Inc. v. Meineke Realty Corp., Inc.*, 535 F.Supp. 439, 448 (N.D. Ohio 1982); *Lisseveld v. Marcus*, 173 F.R.D. 689, 693 (M.D. Fla. 1997); *Jaguar Cars Ltd. v. Manufactures des Montres Jaguar, S.A.*, 196 F.R.D. 306, 308 (E.D. Mich. 2000); *Lion Petroleum of Missouri, Inc. v. Millennium Super Stop, LLC*, 467 F.Supp.2d 953 (E.D. Mo. 2006); *May Apparel Group, Inc. v. Ava Import-Export, Inc.*, 902

F.Supp. 93, 96 (M.D.N.C. 1995); *Marrero Enters. Of Palm Beach, Inc. v. Estefan Enters., Inc.*  
No. 06-81036-CIV, 2007 WL 4218990 (S.D. Fla. Nov. 29, 2007).

In this case, it is either Sambo or Mitsubishi who desires U.S. Trademark protection and has filed for a mark. Chase argues that customers will confuse Applicant and Sambo, yet Sambo has no ownership interest and no one is within reach to prepare a defense. If Chase is able to oppose without either Sambo or Mitsubishi, it will suffice for any trademark owner to use a small irrelevant licensee to oppose or cancel a mark. Since this licensee will have no information about the origin of the mark, the searches made at the time of filing, the filing intent, prosecution information, or even any evidence of how the mark has evolved in the marketplace over the years, Applicants will have no tools to defend themselves. More shocking will be the capacity of the licensee to ask for any needed documents to justify its Opposition or Cancellation, and the licensee will also have full power of discovery to compel Applicant to disclose any document in its possession, but without the reciprocal right of Applicant to compel discovery upon the owner of the mark asserted by Opposer.

Accordingly, Applicant respectfully requests that this Opposition be dismissed.

Respectfully submitted,

SIPI METALS CORP.



/Robert S. Beiser/

Robert S. Beiser

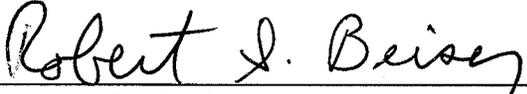
Dated: October 14, 2011

Robert S. Beiser  
Alain Villeneuve  
Vedder Price P.C.  
222 N. LaSalle St., Suite 2600  
Chicago Illinois 60601  
(312) 609 7848  
(312) 609 5005 (fax)  
avilleneuve@vedderprice.com

**CERTIFICATE OF SERVICE**

I hereby certify that on the 14th day of October 2011, I served a true and correct copy of the foregoing **Motion to Consolidate Opposition Proceedings** on the attorney for the Petitioner at the address indicated below by depositing said document in the United States mail, first class postage prepaid:

Bryan K. Wheelock  
Harness, Dickey & Pierce, PLC  
7700 Bonhomme Avenue Suite 400  
St. Louis, MO 63105  
(314) 726,7505  
bwheelock@hdp.com

  
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Attorney for Applicant