

ESTTA Tracking number: **ESTTA555629**

Filing date: **08/22/2013**

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

Proceeding	91201703
Party	Plaintiff Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	08/22/2013
Attachments	229-182 Motion to Dismiss.PDF(510465 bytes )

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_____	)	
MICHAEL BRANDT FAMILY TRUST	)	
d/b/a ECO-SAFE OF DALLAS,	)	
	)	Opposition No. 91201703
Opposer,	)	
	)	Application Ser. No. 77/960,950
v.	)	
	)	
ISTITUTO ITALIANO SICUREZZA	)	
DEI GIOCATTOLE S.R.L.,	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER’S MOTION TO DISMISS COUNTERCLAIM FOR CANCELLATION OF  
REGISTRATION NO. 1,749,733**

Opposer, Michael Brandt Family Trust, through its attorneys, hereby moves to dismiss under Rule 12(b)(6) of the Federal Rules of Federal Procedure, the counterclaim made by Applicant on July 1, 2013 for cancellation of Opposer’s Registration No. 1,749,733. Opposer makes this Motion to Dismiss concurrently with its Motion for Judgment on the Pleadings. In view of Applicant’s undisputed admissions that its application should be deemed void because it had no *bona fide* intent to use the “ECO-SAFE and Design” mark for the goods and services specified in its Application and its admission that it intended to circumvent the anti-use by owner rule for certification marks, Applicant no longer has standing to seek a counterclaim.

In the event this Motion to Dismiss the counterclaim is denied, then Opposer respectfully requests sufficient time in which to answer or otherwise plead.

## MEMORANDUM

### A. The Facts

Opposer owns Registration No. 1,749,733 covering the mark ECO-SAFE as used for t-shirts and hats in Class 25 and for cloth patches for shirts in Class 26. The mark has been used for such items since 1972.

In response to Opposer's Second Amended Notice of Opposition, Applicant has filed a counterclaim to cancel this pleaded registration allegedly based on Opposer's fraud and non-use of the mark for these items during the filing of its various declarations of use under Section 8.

### B. The Law

While Opposer appreciates that an applicant does not need to allege its standing to challenge an opposer's pleaded registration because its standing is deemed "inherent," a good faith exception is warranted in this instance. The exception is warranted because Applicant now admits its application should be declared void. [See Opposer's Motion for Judgment on the Pleadings]. Accordingly, when the Applicant, as here, declares that its application should be declared void because it does not have the *bona fide* intent to use the mark in commerce and there is no corresponding allegation of use, then Applicant becomes no more than a mere "intermeddler" – there is no damage or likelihood of damage. As stated by Professor McCarthy in McCarthy on Trademarks and Unfair Competition, Section 20:46 (6/2013 at 20 – 126-127):

The requirement for standing is fairly easy to satisfy in the vast majority of cases: 'The same general statement is applicable to cancellation proceedings. The purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler.'

The purpose of the standing requirement in opposition and cancellation proceedings is to prevent a 'mere intermeddler' from initiating such a proceeding. This means that to establish standing to petition to cancel, the petitioner need only

be something more than a gratuitous interloper or a vicarious enforcer of someone else's rights

\* \* \*

Once standing is established, petitioner is entitled to rely on the merits on any statutory ground which negates [respondent – registrant's] right to the subject registration and may invoke the public interest in support of its claim.

Rhetorically, with an admittedly void application, no actual use of the mark or even an intent to use the mark in commerce, how then is Applicant, a foreign entity, damaged by Opposer's registration? In short, it is not.

In *International Telephone and Telegraph Corporation v. International Mobile Machines Corporation*, 218 USPQ 1024 (TTAB 1983), the Board held that some possible damage in the future is insufficient to create standing. In a similar vein, some speculative allegation that Applicant is "damaged" or might be damaged in the future is insufficient to retain standing to cancel Opposer's registration when in fact Applicant has no rights to the mark – i.e., no allegations of use of the mark in commerce, or even a *bona fide* intent to use the mark.

### Conclusion

In view thereof, Applicant no longer has standing by reason of its admission that its application should be declared void. Its counterclaim should therefore be dismissed for failure to state a claim upon which relief can be granted.

In view thereof, further action is solicited.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST  
d/b/a ECO-SAFE OF DALLAS

Dated: August 22, 2013

/s/ Barth X. deRosa

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