

ESTTA Tracking number: **ESTTA561560**

Filing date: **09/26/2013**

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.
Correspondence Address	BARTH X DEROSA DICKINSON WRIGHT PLLC 1875 EYE STREET NW , SUITE 1200 WASHINGTON, DC 20006 UNITED STATES BdeRosa@dickinson-wright.com, cholder@dickinsonwright.com, trademark@dickinsonwright.com, malcantara@dickinsonwright.com
Submission	Reply in Support of Motion
Filer's Name	Barth X. deRosa
Filer's e-mail	BdeRosa@dickinson-wright.com, cholder@dickinsonwright.com, trademark@dickinsonwright.com, malcantara@dickinsonwright.com
Signature	/Barth X. deRosa/
Date	09/26/2013
Attachments	229-182 OPPOSER_S_REPLY_BRIEF_IN_SUPPORT_OF_MOTION_TO_DISMISS_APPLICANT_S_COUNTERCLAIM.pdf(158727 bytes )

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

_____	)	
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 GIOCATTOLI S.R.L.,	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER'S REPLY BRIEF IN SUPPORT OF  
MOTION TO DISMISS APPLICANT'S COUNTERCLAIM**

Opposer, Michael Brandt Family Trust, through its attorneys, submits this Reply Brief in support of its Motion to Dismiss Applicant's Counterclaim for lack of standing. Applicant's Memorandum in Opposition was filed on September 6, 2013.

**I. Applicant's Admission that its Application is Void is Nothing but Material**

Applicant's entire position is based on a false assumption. As stated on page 2 of its brief, Applicant incorrectly presumes that it is "immaterial" that Applicant has admitted its application should be declared void. The same theme continues throughout its brief. As stated again on page 4, "The fact that Applicant's application may be void is technically immaterial to both Opposer's standing to continue to assert confusion and Applicant's standing to continue to serve a counterclaim against Opposer's registration."

Perhaps Applicant does not fully comprehend the effect of its legal admissions, but those admissions eviscerate the statutory basis upon which Applicant sought registration. Applicant's admission that it has never had a bona fide intent to use the mark for the goods and services stated in its application is tantamount to an abandonment of its application. Simply put, Opposer no longer has a valid application which to oppose. As discussed in Opposer's Motion for Judgment on the Pleadings, Applicant's motion eradicates the basis upon which a valid application can be prosecuted and maintained. Rather than being immaterial, Applicant's legal admissions are very material and mandate that the opposition be sustained in Opposer's favor.

## **II. Applicant Eradicated its Standing and Injury Through Its Own Actions**

While not explicitly clear in its brief, Applicant seems to be suggesting that Opposer's Registration No. 1,749,733 continues to cast a cloud on Applicant's right and title to its "mark," not unlike the Applicant in *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons, Inc.*, 14 USPQ 2d 1879 (TTAB 1990). At issue in *Syntex* was "whether Applicant's demonstrated personal interest can be eradicated by **Opposer's own actions** in failing to prosecute its case, resulting in dismissal of Opposer's actions against Applicant." The Board held that Applicant's interest in standing was not and could not be eradicated by **Opposer's own actions**. Again, the emphasis was on Opposer's actions. In so ruling, the Board clearly noted that the situation would be quite different if the party asserting standing and damage took some action during the proceeding to deprive itself of standing, as here. As stated:

"We think that this case differs from the examples described in the dissenting opinion, in that in those scenarios standing was either created by the outside agency or taken away by an outside agency, i.e., a court or the Examining Attorney, **or the party asserting standing took some action during the course of a proceeding to deprive itself of standing**. Here, the defendant (Opposer) by its

own action seeks to take standing away from the Plaintiff (Applicant).”

In the case at hand, it is Applicant who has clearly taken steps by its own legal admissions to eradicate its standing to pursue the counterclaim. Applicant no longer has an interest, title or even any type of right to the mark. It admits it has no bona fide intent to use the mark as a trademark or service mark. There is no allegation of use of the mark in commerce nor is there any allegation that Opposer at any time has threatened Applicant. Applicant, by its own admission, has nothing. Thus, to maintain a counterclaim, at a minimum, one must have rights to a mark upon which its alleged damage may be based. Otherwise, anyone can, perhaps, say that they have an intent to use a particular mark and file a petition for cancellation or opposition without even declaring a bona fide intent to use the mark. Without any such rights, Applicant, by its own actions, has become no more than a mere intermeddler. As noted by the dissenting opinion in *Syntex*, for all we know, Applicant’s counterclaim is based on no more than a perceived vindictiveness since Opposer has clearly flushed and ferreted out the true nature of Applicant’s intentions.

Applicant’s reliance upon the Supreme Court’s decision in *Already, LLC, d/b/a Yums v. Nike, Inc.*, 133 S. Ct. 721, 727, 105 U.S.P.Q.2d 1169 (2013) is misplaced. To the extent an actual case and controversy under Article III of the Constitution applies to Board proceedings, the decision actually supports Opposer. On the one hand, it is distinguishable in so far as it focuses, as in *Syntex*, on the plaintiff’s actions in mooted the controversy, but on the other, supports Opposer’s position to the extent it (1) reasserts the key premise that an “actual controversy” must exist not only at the time the complaint is filed, but through all “stages of the litigation” and (2) the parties must, at all times, have a “legally cognizable interest in the outcome.” However, that

‘legally cognizable interest’ cannot be based on some “boundless” theory of standing as espoused by Applicant. As stated:

Already falls back on a sweeping argument: In the context of registered trademarks, ‘no covenant, no matter how broad, can eradicate the effects’ of a registered but invalid trademark.

\* \* \*

Under this approach, Nike need not even have threatened to sue first. Already, even with no plans to make anything resembling the Air Force I, could sue to invalidate the trademark simply because Already and Nike both compete in the athletic footwear market. Taken to its logical conclusion, the theory seems to be that a market participant is injured for Article III purposes whenever a competitor benefits from something allegedly unlawful – whether a trademark, the awarding of a contract....or so on. We have never accepted such a boundless theory of standing.” Id. at 133 S.Ct. 731.

### **III. Conclusion**

In conclusion, Applicant through its own actions has deprived itself of standing to maintain the petition to cancel. At a minimum, a petitioner or counter-claimant should have an interest in a mark either with allegations of actual use in commerce, or at least a bona fide intent declared under the penalties of perjury. Without more, the counter-claimant has no legally cognizable interest and the cancellation should be dismissed.

In view thereof, further action is respectfully solicited.

Respectfully submitted,

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

Dated: September 26, 2013

/s/ Barth X. deRosa  
Barth X. deRosa  
DICKINSON WRIGHT PLLC  
1875 Eye Street, N.W.  
Suite 1200  
Washington, D.C. 20006  
Phone (202) 457-0160  
Fax (202) 659-1559  
Counsel for Opposer

DC 229-182 231733v2

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION TO DISMISS APPLICANT'S COUNTERCLAIM has been served upon Applicant on this 26<sup>th</sup> day of September 2013, via e-mail and first class mail, postage prepaid, as identified below:

Jeffrey M. Goehring  
Young & Thompson  
209 Madison Street  
Suite 500  
Alexandria, VA 22314-1764

and

[jgoehring@young-thompson.com](mailto:jgoehring@young-thompson.com)

\_\_\_\_\_  
/s/ Barth X. deRosa

Barth X. DeRosa