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

Proceeding	91204603
Party	Plaintiff Bombardier Recreational Products Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bombardier Recreational Products Inc.,)	
)	
Opposer,)	
)	Opposition No. 91204603
v.)	
)	Ser. No. 79097186
Mirza Juddani,)	
)	
Applicant.)	

**OPPOSER’S MOTION TO DISMISS COUNTERCLAIM
UNDER FRCP 12(b)(6)**

Opposer, Bombardier Recreational Products Inc., by and through its attorneys of record, pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP Rule 503, moves to dismiss the Counterclaim filed by Applicant, Mirza Juddani, in this action for failure to state a claim.

I. INTRODUCTION

On April 3, 2012, Opposer filed a Notice of Opposition against the registration of Application Ser. No. 79097186.

On June 13, 2012, Applicant filed an Answer and a Counterclaim seeking the cancellation of Reg. No. 3673043 (“the ‘043 Registration”).

As the basis for its counterclaim, Applicant alleges that the ‘043 Registration “improperly exceeds the scope of [Opposer’s] Canadian Registration [TMA 176,452] to the extent that it includes ‘tour guide services and travel agency services, namely, making reservations and

bookings for transportation; tour guide services' in Class 39. [Opposer's] Canadian Registration [TMA 176,452] does not include tour guide services or travel agency services". Applicant's Answer to Notice of Opposition with Counterclaim for Partial Cancellation of Reg. No. 3,673,043, ¶ 49.

II. ARGUMENTS

To withstand a motion to dismiss, the complainant must demonstrate (1) its standing to challenge the continued presence on the register of the subject registration, and (2) a valid ground why the registrant is not entitled under law to maintain the registration. *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995). A valid ground for denying registration that must be alleged, and ultimately proved, must be a statutory ground which negates the right to the subject registration. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ 185, 190 (CCPA 1982). Dismissal under Fed. R. Civ. P. 12(b)(6) is appropriate only if "it appears to a certainty that [applicant] is entitled to no relief under any state of facts which could be proved in support of the claim." *Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 189 USPQ 420, 422 (CCPA 1976) (emphasis in original).

Applicant seeks to assert a counterclaim for the cancellation of the '043 Registration based on the allegation that the underlying application was incomplete because the Section 44(e) basis was insufficient for some of the services in International Class 39.

The determination of Opposer's compliance with the requirements of Section 44(e) was an *ex parte* examination issue addressed during prosecution of the underlying application. This issue, as with similar *ex parte* examination matters, does not form a basis for cancellation. *Cf. Saint-Gobain Abrasives Inc. v. Unova Indus. Automation Syst. Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (fairness dictates that the *ex parte* question of the sufficiency of the description of

the mark not be a ground for opposition or cancellation); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000) (failure to enforce requirement of filing of foreign registration is examination error and not a ground for counterclaim for cancellation); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation); *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the adequacy of specimens is solely a matter of ex parte examination); *Flash & Partners S.P.A. v. I.E. Manufacturing LLC*, 95 USPQ2d 1813 (TTAB 2010) (the sufficiency of the intent-to-use basis at time of filing does not form statutory ground for cancellation).

In essence, Applicant argues in its Counterclaim that the Section 44(e) basis should not have been accepted by the examining attorney assigned to examine the underlying application for the '043 Registration because the home country registration does not include the same description of services as is set forth in the underlying application.

TMEP Section 1004 informs examining attorneys that:

A §44(e) application must meet the following requirements:

(1) The applicant must be the owner of a valid registration in the applicant's country of origin. 15 U.S.C. §§1126(c) and (e). See TMEP §§1002.01 and 1002.04 regarding country of origin.

(2) The applicant's country of origin must be a party to a treaty or agreement with the United States that provides for registration based on ownership of a foreign registration, or must extend reciprocal registration rights to nationals of the United States. 15 U.S.C. §1126(b). See TMEP §§1002.03, 1002.04 and 1002.05.

(3) The applicant must submit a true copy, a photocopy, a certification, or a certified copy of the registration in the applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01.

(4) The applicant must verify that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. §1126(e). If the verified statement is not filed with the initial application, the verified statement must also allege that the applicant has had a bona fide intention to use the mark in commerce since the application filing date. 37 C.F.R. §2.34(a)(3)(i).

(5) The scope of the goods covered by the §44(e) basis cannot exceed the scope of the goods or services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §1402.01(b).

In *Phonak Holding*, the applicant (in an opposition proceeding) filed a counterclaim alleging that the opposer's pleaded registration issued without a valid basis and therefore was void because the opposer never filed a home country registration as Section 44 requires, i.e., the opposer failed to comply with Paragraph (3) above. As the Board explained, "[f]ailing to enforce that requirement is an examination error". *Id.*, 56 USPQ2d at 1059. Therefore, the Board held that the pleading failed to state a proper ground for cancellation.

In this case, assuming *arguendo* that the basis¹ for the counterclaim is that the examining attorney failed to consider or enforce the requirement that the scope of the goods and services covered by the Section 44(e) basis not exceed the scope of the goods and services in the home country registration (and there is no allegation or suggestion that this in fact occurred), this was an examination error and cannot serve as a proper grounds for cancellation.

In *Phonak Holding*, the Board analogized the situation presented in that case to the situation in *Century 21 Real Estate* where an applicant sought to cancel a pleaded registration on the grounds that the specimens of use submitted during examination were inadequate. In *Century 21 Real Estate*, the Board re-affirmed its prior decision that the sufficiency of the specimens submitted with an application is a technical question which is within the province of

¹ The Counterclaim does not contain any allegations as to how or why the alleged error occurred during examination.

the examining attorney to determine and that the applicant should not be penalized by the examining attorney's error in judgment. *Id.* 10 USPQ2d at 2035.

Examining attorneys must determine whether the scope of the specification of goods and services in an application is within the scope of the goods and services in the foreign registration. There is no requirement that the language be identical – only that the U.S. application not exceed the scope. As a result, there is some inherent subjectivity in this determination. Therefore, in this case, assuming *arguendo* that the basis for the counterclaim is that the examining attorney erred in the determination of whether the underlying application for the '043 Registration exceeded the scope of the Canadian Registration, this determination was a technical question which was within the province of the examining attorney to determine. The Canadian Registration does include language which Applicant believes encompasses the Class 39 services in the '043 Registration. However, the correctness of this *ex parte* determination is not a proper grounds for cancellation.

As the Board explained in *Flash & Partners*, “[w]e recognize that prosecution of a trademark application involves numerous regulatory requirements, and that whether an applicant has satisfied them often entails some degree of subjective judgment on the part of the examining attorney. Considerations of due process, as well as fairness to parties against whom allegations of examination error are asserted, dictate that such matters be solely a matter for *ex parte* determination, and not grounds for opposition or cancellation.” *Id.*, 95 USPQ2d at 1817 (citing *Saint-Gobain Abrasives*, 66 USPQ2d at 1359 (TTAB 2003) (“It would be manifestly unfair to penalize defendant for noncompliance with a requirement that was never made by the Examining Attorney.”, citing *Marshall Field*, 11 USPQ2d at 1358 (TTAB 1989)).

III. CONCLUSION

For the reasons set forth above, Opposer respectfully requests that the Board dismiss the Counterclaim.

Respectfully submitted,

BOMBARDIER RECREATIONAL PRODUCTS INC.

Date: July 3, 2012

By:


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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing “OPPOSER’S MOTION TO DISMISS COUNTERCLAIM UNDER FRCP 12(b)(6)” has been served on Applicant’s Attorney of record, Paul I. Perlman of HODGSON RUSS LLP, with an address of 140 Pearl St., Suite 100, The Guaranty Building, Buffalo, NY 14202, via first class mail, today **July 3, 2012**.

By:



Laura K Greer