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

Proceeding	91208511
Party	Plaintiff Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne
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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

In re the application of:

Sundek, LLC  
Serial No. 85569536  
Mark: SUNDEK  
Filed: March 14, 2012

BATA BRANDS S.A.R.L. LUXEMBOURG,	)	
SUCCURSALE DE LAUSANNE,	)	
	)	
Opposer,	)	
	)	Opposition No. 91208511
v.	)	
	)	
SUNDEK LLC,	)	
	)	
Applicant.	)	

**OPPOSER’S MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM AND SUPPORTING BRIEF**

Opposer, Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne (Bata), by and through undersigned counsel, respectfully moves the Board under Fed. R. Civ. P. 12(b)(6) and 37 C.F.R. § 2.112 to dismiss the Petition for Cancellation filed by Sundek LLC (Sundek) for failure to state a claim upon which relief can be granted due to Sundek’s failure to allege a *prima facie* case of false association under § 2(a) of the Trademark Act (15 U.S.C. § 1052(a)). In support of the Motion, Bata states the following:

**I. STATEMENT OF FACTS**

The following facts are relied upon by Bata for purposes of this Motion only and

are not conceded for any other purpose:

1. Bata owns Registration No. 975546 SANDAK used in connection with footwear in International Class 25. This registration was issued December 25, 1973. Bata or its predecessors first used this mark in September 1961 and first used this mark in commerce in the United States in June 1970.

2. In October 1979, Bata filed a Combined Declaration of Use and Affidavit of Incontestability. The Patent and Trademark Office received the Combined Declaration on October 22, 1979, and accepted it on January 20, 1980.

3. Sundek filed the opposed trademark application for SUNDEK in standard characters on March 14, 2012, based on actual use the mark on “[c]lothing, namely, swimsuits, boardshorts, sweatshirts, knit shirts, t-shirts, tank tops, jackets, coats, dresses, dress shirt, pants, capri pants, and shorts; footwear; headwear ” in International Class 25. The application was accorded Serial No. 85569536 and published for opposition in the Official Gazette on August 21, 2012. It alleged in that application that it first used the mark in commerce in the United States on January 10, 1969, for goods in International Class 25.

4. Bata timely filed a Request for a 90-day Extension of Time to oppose Serial No. 85569536 on September 1, 2012. The Trademark Trial and Appeal Board granted this request. Bata’s opposition was timely filed by the close of the 90-day opposition period on December 19, 2012.

5. On January 28, 2013, Sundek filed its Answer and included a Counterclaim for Cancellation alleging that Bata’s mark creates a false association under § 2(a) with Sundek’s mark.

## **II. ARGUMENT**

The Counterclaim for Cancellation fails to allege facts which demonstrate the alleged ground of false association. The alleged claim is statutorily barred claim of likelihood of confusion under § 2(d) of the Act (15 U.S.C. § 1052(d)) masquerading as a false-association claim. Accordingly, the Counterclaim should be dismissed with prejudice.

A person seeking to cancel a registered trademark must state the grounds for cancellation under § 14 of the Act. 15 U.S.C. § 1064. It must include a plain, concise statement of the cancellation's grounds. 37 C.F.R. § 2.112. The pleadings need to contain enough detail to give the defendant fair notice of the basis of each claim. TMBP § 309.03(a)(2). They must also plead a valid ground for cancelling a registration. See TMBP § 503.02.

In this case there is no valid ground for Sundek's requested relief. Even if Sundek's alleged facts were true, they do not support a claim of false association. Sundek's counterclaim is a statutorily barred claim of likelihood of confusion under § 2(d) disguised as a claim of false association under § 2(a).

A petition (or counterclaim) for cancellation based on any ground may be filed within five years of the registration date under § 14(1) (15 U.S.C. § 1064(1)). If the petition is filed after that date, the ground for cancellation must be one of those specifically listed in § 14(3) (15 U.S.C. § 1064(3)). Moreover, Bata's mark is incontestable under Section 15 of the Act (15 U.S.C. § 1065), which again limits the ground for cancellation to one of those specifically listed in § 14(3).

A claim of likelihood of confusion under § 2(d) is not one of the permissible grounds for cancellation listed in § 14(3). Meanwhile, Bata's mark was registered in 1973, more than five years ago. So a claim of likelihood of confusion is barred by statute because it would be filed more than five years after the registration of Bata's mark. *See The Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 U.S.P.Q. 505, 508 (C.A.F.C. 1983)

To avoid this result, Sundek has recast its likelihood-of-confusion claim as a claim of false association under § 2(a). Claims under § 2(a) are permitted after five years of the registration date under § 14(3). So §§ 14 and 15 would not prohibit this claim. However, this type of recasting is not permitted because it would nullify the § 14's prohibition of filing a § 2(d) claim after the fifth anniversary of the registration date. *See Id.* So if the counterclaim does not allege facts to support the false-association claim, it must be dismissed as barred under § 14.

Under § 2(a), false association occurs when a mark falsely suggests a connection with persons, living or dead; institutions; beliefs; or national symbols. The apparent purpose of this statute is to protect the rights of privacy and publicity and to control one's identity. *Id.* at 509. Therefore, a party acquires a protectible interest in a name under §2(a) where the name is unmistakably associated with, and points uniquely to, that party's personality or "persona"; this interest does not depend upon adoption and use as a technical trademark or trade name. *Id.* at 508-9.

To establish that a mark falsely suggests a connection with an institution, it must be shown that: (1) the contested mark is identical to or a close approximation of the

name or identity previously used by another institution; (2) the contested mark would be recognized as the name of the institute because it points uniquely and unmistakably to that institution; (3) the institution named by the contested mark is not connected with the activities performed by the owner of the mark; and (4) the fame or reputation of the institution is such that, when the contested mark is used with its owner's goods, a connection with the person or institution would be presumed. *See Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 U.S.P.Q. 752, 754 (T.T.A.B. 1985).

First, Sundek has failed to allege sufficient facts that SUNDEK is a name that points uniquely and unmistakably to an institution. Sundek has alleged facts to support its contention that it owns SUNDEK as a trademark. For example Sundek refers to its prior ownership of the SUNDEK brand. *See* Counterclaim Paragraphs 2-6. It has also alleged that it has continuously used the SUNDEK mark in commerce before Bata. *See Id.* at Paragraph 11. Similarly Sundek's prayer for relief explicitly refers to its prior use of the SUNDEK mark. *See Id.* at Paragraph 16. Finally, it refers its accrued goodwill in the SUNDEK mark. *See Id.* at Paragraph 6. These are allegations that Sundek owns a senior mark and not that it owns a name that uniquely and unmistakably refers to Sundek as an institution.

Moreover, it seems unlikely that Sundek could allege that SUNDEK is an unmistakable and unique identifier. SUN is a naturally associated with the swimwear and beach clothing that Sundek sells.

Second, Sundek has failed to allege that it possesses sufficient institutional fame and reputation to justify a connection between it and Bata's SANDAK mark. Its

allegations concerning fame refer to the mark's fame and to an "iconic" product. See *Id.* at Paragraphs 4-5. In neither case does Sundek refer to its fame as an institution.

Because Sundek's allegations concern its mark and fail to set forth any facts relating to a false association to it as an institution, it has not alleged a proper claim of false association under § 2(a). It is, instead, a claim of likelihood of confusion under § 2(d), which is statutorily barred under §§ 14 and 15. Therefore, the Counterclaim should be dismissed for the failure to state a claim for relief under Fed. R. Civ. P. 12(b)(6).

### **III. SUSPENSION**

Bata's motion is potentially dispositive of this counterclaim, and under 37 C.F.R. § 2.127(d), it respectfully requests the Board to suspend the proceedings with respect to matters not germane to this motion. The filing of this motion also tolls Bata's time for filing an answer. TMBP § 503.01.

### **IV. CONCLUSION**

Therefore, Bata respectfully requests the Board to grant the Motion to Dismiss for Failure to State a Claim and dismiss Sundek's Counterclaim for Cancellation.

Respectfully submitted,

Bata Brands S.a.r.l. Luxembourg, Succursale  
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing ***Notice of Undeliverable Service Copy*** was served on this 28<sup>th</sup> day of March 2013, by first class mail, postage prepaid, to Mr. Brian Downey, Barnes & Thornburg LLP, 41 South High Street, Suite 3300, Columbus, Ohio 43215-6104, Applicant's Attorney of Record

/Robert S. Pierce/  
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