

ESTTA Tracking number: **ESTTA536408**

Filing date: **05/06/2013**

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
Correspondence Address	ROBERT S PIERCE JACOBSON HOLMAN PLLC 400 SEVENTH STREET NW WASHINGTON, DC 20004 UNITED STATES trademark@jhip.com,rpierce@jhip.com,jholman@jhip.com
Submission	Other Motions/Papers
Filer's Name	Robert S. Pierce
Filer's e-mail	trademark@jhip.com,rpierce@jhip.com,jholman@jhip.com
Signature	/Robert S. Pierce/
Date	05/06/2013
Attachments	I06644 amended counterclaim reply brief.pdf (5 pages)(33249 bytes)

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 REPLY BRIEF TO DISMISS AMENDED 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 asks the Board’s leave to file this reply brief and moves the Board under Fed. R. Civ. P. 12(b)(6) and 37 C.F.R. § 2.112 to dismiss the Amended Counterclaim 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

Bata restates and incorporates by reference the facts asserted in its Motion to

Dismiss Counterclaim filed on March 28, 2013. Those facts and following facts are relied upon by Bata for purposes of this Motion only and are not conceded for any other purpose:

1. In response to Bata's Motion to Dismiss Counterclaim, Sundek filed Applicant's First Amended Answer to Notice of Opposition and Counterclaim on April 15, 2013, and served Bata by first class mail. The amended counterclaim continued alleging that Bata's mark creates a false association under § 2(a) with Sundek's mark.

II. ARGUMENT

Despite the effort to amend the Counterclaim for Cancellation to include additional facts allegedly relating to Sundek's institutional fame, it still fails to allege facts which demonstrate the alleged ground of false association. In fact, this effort to amend implicitly concedes that Sundek's 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 for the reasons set forth in the March 28th motion and supplemented here.

As originally argued, Sundek's counterclaim can only stand if it has proper grounds to plead a false-association claim under § 2(a). A counterclaim of likelihood of confusion with a prior mark under § 2(d) must be dismissed because Bata's mark is incontestable under § 15 of the Act (15 U.S.C. § 1065) and it is filed too late under Section 14(1) (15 U.S.C. § 1064(1)). Even with additionally pleaded facts, Sundek has failed to properly plead a false-association claim under § 2(a) because any additional facts relate to the mark's alleged fame and not to Sundek as an institution.

Under § 2(a), false association occurs when a mark falsely suggests a

connection with persons, living or dead; institutions; beliefs; or national symbols. 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).

Sundek mistakenly alleges in the amended counterclaim that the marks differ only by one letter. Amended Counterclaim Para. 22. Bata's mark is SANDAK, which differs by two letters from SUNDEK. Therefore, the amended counterclaim relies on a mistake to support an allegation that the marks are close approximations as required to show a false association.

It still fails to allege facts that SUNDEK is an unmistakable and unique identifier of an institution. Anyway, this is a difficult task because "sun" and "sundeck" are naturally associated with the swimwear and beach clothing that Sundek sells.

Moreover, any identity that Sundek has an institution is derived from the use of its SUNDEK mark. The alleged facts relating to fame are found in Paragraphs 1, 4-6, 10, and 12, and they describe the mark's fame. They do not relate to Sundek as institution. Instead Sundek alleges that the fame should be transferred because its corporate name is shared with the mark. *See Amended Counterclaim Paragraphs 11*

and 13. This maneuver should be view with a degree of scepticism because it would allow parties that used their names as trademarks to easily avoid the time limit for filing a § 2(d) claim. This scepticism is reflected by the fact that establishing a mark's fame alone does not prove that its owner is famous as an institution. *See The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 U.S.P.Q.2d 1466,1471 (T.T.A.B. 1990).

Moreover, Sundek does not allege that SUNDEK points uniquely and unmistakably to that institution before Bata's predecessor began using its SANDAK mark in commerce in 1970. While Sundek relates the history of its mark's use, it resorts tellingly to the language of § 2(d) and asserts that it began using its SUNDEK mark in commerce before Bata's predecessor began using its mark. It does not allege with any specificity that SUNDEK uniquely and unmistakably pointed to Sundek as an institution before Bata's predecessor used the SANDAK mark.

Sundek still 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 Amended 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 amended 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 Amended Counterclaim for Cancellation.

Respectfully submitted,

Bata Brands S.a.r.l. Luxembourg, Succursale
De Lausanne

By: /Robert S. Pierce/
John C. Holman
Robert S. Pierce
Attorneys for the Opposer
JACOBSON HOLMAN PLLC
400 Seventh Street, Northwest
Washington, District of Columbia 20004
(202) 638-6666

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing ***Opposer's Reply Brief to Dismiss Amended Counterclaim for Failure to State a Claim and Supporting Brief*** was served on this 6th day of May 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/
Robert S. Pierce