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

Proceeding	91212231
Party	Plaintiff Dragon Bleu (SARL)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DRAGON BLEU (SARL),

Opposer and Counterclaim  
Respondent,

v.

VENM, LLC,

Applicant and Counterclaim  
Petitioner.

Opposition No. 91212231

Application Serial No. 85/848,528

**OPPOSER’S MOTION PURSUANT TO FED. R. CIV. P. 12(b)(6)  
TO DISMISS APPLICANT’S COUNTERCLAIMS**

Dragon Bleu (SARL), Opposer and Counterclaim Respondent (“Opposer”), through its undersigned attorneys, Saunders & Silverstein LLP, hereby moves pursuant to Federal Rule of Civil Procedure, Rule 12(b)(6), to dismiss the Cancellation Counterclaims brought by Applicant and Counterclaim Petitioner, Venm LLC (“Applicant”), for failure to state claims upon which relief can be granted. As grounds for this Motion, Opposer states as follows:

1. Applicant’s first Counterclaim, entitled “Lack of Distinctiveness,” is not a statutory ground for cancellation and Applicant has failed to allege facts to support any valid ground for cancellation.
2. Applicant’s second Counterclaim, “Lack of Use and/or Abandonment,” fails to allege the elements of abandonment sufficient to warrant cancellation of a registered trademark.

3. Because Applicant's first ground is completely without merit, and its second ground lacks sufficient allegations, Applicant failed to state claims upon which the relief sought may be granted.
4. As further grounds, Opposer relies upon its Memorandum of Law, incorporated herein.

## **Memorandum of Law**

### **I. Introduction**

In a cancellation proceeding, the Federal Rules of Civil Procedure apply. *See* 37 C.F.R. § 2.116(a). A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of the claim stated in the complaint. *Ileto v. Glock Inc.*, 349 F.3d 1191, 1199–1200 (9th Cir.2003); *see also* Fed.R.Civ.P. 12(b)(6). “Dismissal can be based on the lack of a cognizable legal theory or the absence of sufficient facts alleged under a cognizable legal theory.” *Hana Financial, Inc. v. Hana Bank*, 500 F. Supp. 2d 1228, 1232 (C.D. Cal. 2007) (*quoting Balistreri v. Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir.1988)).

Furthermore, the Board must dismiss a petition to cancel under Rule 12(b)(6) if it fails to state a claim that is “plausible on its face.” T.B.M.P. § 503.02 citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *see also Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). The primary function of Fed. R. Civ. P. 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premise and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys.*, 26 U.S.P.Q.2d at 1041. When considering a motion to dismiss, the Board must accept the factual allegations pleaded in the complaint as true, but “conclusory allegations of law

and unwarranted inferences of fact do not suffice to support a claim. *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998).

Applicant has asserted two grounds for its counterclaims seeking to cancel Opposer's federally registered trademarks. The first counterclaim, "Lack of Distinctiveness," seeks to cancel all of Opposer's **VENUM & Design** registrations that serve as a basis for this Opposition. The second ground for cancellation, "Lack of Use and/or Abandonment," seeks to cancel Opposer's registration subject of Registration Number 3,896,673. Both grounds are "fatally flawed" and "destined to fail" for the reasons addressed below. Accordingly, Opposer requests dismissal.

## **II. Applicant's First Counterclaim Should Be Dismissed Because It Does Not State a Statutory Ground For Cancellation**

It is axiomatic that a Petition for Cancellation contain a valid ground for cancellation. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). In pleading the grounds for opposition or cancellation, citation to a section of the statute, although encouraged and often helpful in clarifying the nature of a set of allegations in a pleading, may not be sufficient to plead a claim under that section or place a defendant on proper notice of the extent of the claim. T.B.M.P. § 309.03(c). Section 309 of the T.B.M.P. sets forth a listing of grounds for cancellation including, Section 2(d) – likelihood of confusion, Section 2(e) – mere descriptiveness, Section 2(a) – geographic deceptiveness, *etc.*

Applicant's first counterclaim, "lack of distinctiveness" is not a statutory ground for cancellation, nor do the facts asserted support any other valid ground. Applicant

references third-party marks consisting of the term VENUM to establish, ostensibly, that Opposer's trademark is weak or confusingly similar to those marks. Not only is this not a valid ground for cancellation, but also the third-party marks referenced are used in connection with unrelated goods and services. Thus, the facts alleged to support the "lack of distinctiveness" claim are not relevant to any ground for cancellation. Specifically, Applicant alleges:

¶ 44. All of the asserted registrations are directed to the mark "VENUM." As asserted herein, the mark "VENUM" is not distinctive as numerous others make use of confusingly similar marks (at least as Opposer has asserted its marks.) For example, the mark "VENUM" is used by Optec USA on spinal braces for medical use. *See* Ser. No. 85535609, Reg. No. 4314403. Similarly, the mark "VENUM" is used by Jamie Burgos to denote dance performances. *See* Ser. No. 78927571, Reg. No. 3295728. In addition, there are numerous uses of the similar term "VENUM," such as by UnderArmour (*sic*) on shoes, by Venom-wear on clothing, and again on clothing by a clothing store in Memphis, Tennessee. *See* Exh. B, collecting registered and unregistered uses of VENOM.

¶ 55. During prosecution Opposer expressly stated that it would limit the mark to martial arts related goods. *See* Exh. A. at 3-6. Opposer made this statement to secure registration of its mark. Opposer now attempts to asset its mark to cover dance costumes, in direct contravention of the agreement it made to secure registration of its mark. Accordingly, Opposer has effectively "revoked" its agreement to limit its mark to martial arts related goods, which was the only reason that its mark was found distinctive. Opposer should not be allowed to argue that its mark is distinctive as it is restricted to martial arts goods and equipment and then use the same mark to oppose what it claims is a similar mark directed to dace costumes.

The facts above do not provide cogent support for any valid ground to cancel Opposer's federal registrations. Furthermore, even if Applicant has a valid ground in mind, the facts do not give Opposer the appropriate notice required for pleadings. Moreover, the pleading does not include any statutory citations that would assist Opposer in understanding the claim against it. Accordingly, the first counterclaim must be dismissed.

### **III. Applicant's Second Counterclaim Fails Because It Does Not Allege Elements Sufficient to Cancel a Registered Mark.**

To plead a prima facie case for trademark abandonment, a petitioner must allege either (i) that the mark has not been in use in commerce for three consecutive years, or (ii) use has been discontinued without the intent to resume use. 15 U.S.C. § 1127; *see On-Line Careline, Inc. v. Am. Online*, 56 U.S.P.Q.2d 1471 (Fed. Cir. 2000). Moreover, to provide fair notice to the registrant, a petitioner's pleading of abandonment must set forth the theory of abandonment the petitioner is relying on, *i.e.*, discontinued use without intent to resume use, or the statutory presumption of abandonment arising from three consecutive years of nonuse. *See Otto International Inc. v. Otto Kern GmbH* 83 USPQ2d 1861 (TTAB 2007).

In this case, Applicant's counterclaims fail to allege that Opposer ceased use without the intent to resume use. Additionally, the abandonment claim does not provide Opposer with appropriate notice of whether Applicant intends to rely on the presumption of abandonment after three consecutive years of nonuse, or whether Applicant intends to demonstrate abandonment by discontinued use without intent to resume. The factual allegations that Applicant asserts to support this counterclaim are the following:

¶ 51. During the prosecution of Registration No. 3896673, Opposer did not submit evidence of use during prosecution of the asserted registration.

¶ 52. On information and belief, Opposer does not use the mark "VENUM" on each and every product and/or services for which it registered the asserted mark. and (*sic*) accordingly Reg. No. 3896673 should be cancelled. For example, and without limitation, Applicant's investigation did not uncover use of the mark "VENUM" on bed linen, household linen, table linen, ribbons and braids, ornamental novelty pins and needles, artificial flowers, false beards, hairs or moustaches, lace trimmings, wigs, clothing hooks or clasps, and hair ornaments. Accordingly, this mark was either never used or is not abandoned, and Reg. No. 3896673 should be cancelled.

Paragraph 51 is a reference to the fact that Opposer's Reg. No. 3,896,673 was perfected under Section 44(e) of the Trademark Act. Demonstrating use is not a requirement for being granted registration under Section 44(e), and thus the fact alleged therein is not relevant to establishing a *prima facie* case of abandonment. That leaves Paragraph 52 that simply alleges Opposer "does not use" its trademark on each and every product and/or service for which it is registered. A blanket assertion that the mark is not in use falls considerably short of the pleading requirements for a cancellation based on abandonment. For that reason, the claim should be dismissed.

#### **IV. Conclusion**

**WHEREFORE**, Opposer requests that its motion be granted and that Applicant's counterclaims be dismissed.

Respectfully submitted,

DRAGON BLEU (SARL)

By its attorneys,



Dated: November 25, 2013

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CERTIFICATE OF SERVICE

I hereby certify that on November 25, 2013, this **Opposer's Motion Pursuant To Fed. R.Civ. P. 12(b)(6) To Dismiss Applicant's Counterclaims** were served on Applicant by delivering a true and correct copy thereof to Applicant's counsel by depositing same with the United States Postal Service, postage pre-paid, via first class mail, addressed to:

Konrad Sherinian  
THE LAW OFFICES OF KONRAD SHERINIAN, LLC  
1755 PARK ST STE 200  
NAPERVILLE, ILLINOIS 60563-8404  
UNITED STATES



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Aaron Silverstein

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via ESTTA on date shown below to the United States Patent and Trademark Office.



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Aaron Silverstein

Date: November 25, 2013