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

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
Correspondence Address	JOHN S EGBERT EGBERT LAW OFFICES PLLC 1314 TEXAS, 21ST FLOOR HOUSTON, TX 77002 UNITED STATES mail@egbertlawoffices.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	John S. Egbert
Filer's e-mail	mail@egbertlawoffices.com
Signature	/1433-55/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

**OPPOSER'S MOTION TO DISMISS APPLICANT'S COUNTERCLAIM FOR FAILURE
TO STATE A CLAIM AND MOTION TO STRIKE APPLICANT'S EXHIBITS**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Opposer INTS It Is Not The Same, GmbH ("Opposer"), through its undersigned attorneys, submits this Motion to Dismiss Applicant's Counterclaim filed by Applicant Disidual Clothing, LLC ("Applicant") for failure to state a claim upon which relief can be granted. Opposer also requests that the Board strike the exhibits attached to Applicant's Answer to the Notice of Opposition and Counterclaim against Opposer's pleaded registration.

In support of this Motion, Opposer states as follows:

I. **INTRODUCTION**

On October 2, 2013 Opposer filed its Notice of Opposition, asserting priority and likelihood of confusion. To support its claims, Opposer cited five federal trademark registrations and a common law mark, as Opposer's "DESIGUAL" Marks.

On December 20, 2013 Applicant concurrently filed its Motion to Strike Trademark Registration Nos. 4,113,640 and 4,269,396 from Opposer's October 2, 2013 Notice of Opposition

as well as Applicant's Answer to the Notice of Opposition with a Counterclaim against Trademark Registration No. 2,088,319.

On March 31, 2014 the Board issued an Order Denying the Applicant's Motion to Strike Trademark Registration Nos. 4,113,640 and 4,269,396 from Opposer's October 2, 2013 Notice of Opposition. In accordance with the Board's Order, Opposer's to Applicant's Counterclaim against Trademark Registration No. 2,088,319 is due April 20, 2014.

II. ARGUMENTS

A. Opposer Has Failed to State a Claim Upon Which Relief May Be Granted.

In order to state a claim upon which relief may be granted in an opposition proceeding, the Applicant's counterclaim must allege facts which, if proved, establish that (1) the Applicant has standing to challenge the registration which the complaint is directed, and (2) that there is a valid ground for canceling the subject registration. *See* TBMP § 503.02; *see also* Trademark Rule 2.112(a).

B. Applicant's Counterclaim Has Failed to State a Ground for Cancellation of Opposer's Trademark Registration No. 2,088,319.

In filing a counterclaim against Opposer's cited registration, Applicant must establish that there is a valid ground for canceling the subject registration. *See* TBMP § 503.02; *see also* Trademark Rule 2.112(a). In the present case, the twelve paragraphs dedicated to Applicant's counterclaim, which purport to explain the basis upon which Applicant's counterclaim is based, yield little insight as to why cancellation is being sought. Moreover, Applicant's postulation that the registration should be cancelled is wholly conclusory, because Applicant fails to adequately plead a proper legal basis upon which cancellation may be sought. Applicant's alleged counterclaim

vitiates the fair notice standard that is the proud hallmark of pleading requirements within American jurisprudence. As espoused by the Supreme Court of the United States, "all the Rules require is 'a short and plain statement of the claim' that will give the defendant fair notice of what the plaintiff's claim is and the grounds upon which it rests." *Conley v. Gibson*, 355 U.S. 41, 47 (1957) (footnote omitted) (quoting Fed. R. Civ. P. 8(a)(2)).

The only legal ground proffered by Applicant in support of its counterclaim is 15 U.S.C. § 1064(3), which allows for cancellation of a trademark registration in the following instances:

if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

See [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶ 12] (citing 15 U.S.C. § 1064(3)). Immediately after citing 15 U.S.C. § 1064(3), Applicant then concludes that "Reg. No. 2,088,319 has been abandoned and should be cancelled in full." *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶ 12]. Thus, it would appear that Applicant's counterclaim may be based on abandonment. However, Applicant has not pleaded, with legal sufficiency, a counterclaim based on abandonment of the cited registration.

Section 45 of the Lanham Act defines abandonment of a trademark. Specifically, a mark is deemed abandoned when either of the following occurs:

- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

15 U.S.C. § 1127. Yet, in the case at bar, Applicant has not pleaded that Opposer has discontinued its use of the mark with intent not to resume such use. *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶¶ 1-12]. Instead, Applicant's reasoning within the counterclaim appears to rely on specimens, which Applicant alleges were improperly submitted to the USPTO, as the foundation upon which this potential abandonment claim is based. *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶¶ 1-8, 12]. Opposer is unable to discern how allegations relating to improper specimens submitted to the USPTO might be related to a potential abandonment claim. Similarly, merely identifying that Opposer's website "reveals no trademark uses of the design mark on the goods identified in the registration" also does nothing to support the Applicant's legally deficient claim of abandonment. *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶ 9]. Applicant's counterclaim is legally insufficient to properly plead a cause of action against the Opposer's trademark registration.

In order to properly defend the trademark registration cited in Opposer's Notice of Opposition, which Applicant is attempting to cancel, Opposer is entitled to know the legal basis upon which Applicant is seeking to cancel the mark. It is imperative that the Applicant's counterclaim be properly plead, in order to provide the Opposer with fair notice of the Applicant's claim. Without fair notice, Opposer will be unable to adequately prepare to defend its trademark registration. Applicant's counterclaim is legally deficient, and should be dismissed for failure to state a cause of action.

C. Exhibits attached to Applicant's Notice of Opposition and Counterclaim.

Opposer notes that Applicant's Answer and Counterclaim included a number of attached Exhibits, consisting of pages from Opposer's website. *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, pg. 13-165]. With the exception of attaching trademark registrations showing current title and status, "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached." *See* TBMP § 317; *see also* 37 § C.F.R. 2.122(c). Extrinsic evidence that would fall outside the pleadings is not relevant to Applicant's Answer to the Notice of Opposition, and it is not relevant to Applicant's Counterclaim against Opposer's cited trademark registration, because such evidence does not affect whether Applicant has stated a claim upon which relief can be granted, when all of Applicant's well-pleaded allegations are accepted as true. *See* Fed. R. Civ. P. 12(b)(6). Therefore, the exhibits attached by Applicant are irrelevant and should be stricken from Applicant's Answer and Counterclaim.

III. CONCLUSION

For the foregoing reasons, it is evident that Applicant has not alleged facts that would, if proved, establish that it is entitled to the relief sought in any of its claims. *See* TMEP §503.02.¹ For this reason, Opposer respectfully requests that the Board grant Opposer's Motion to Dismiss Applicant's Counterclaim against Trademark Registration No. 2,088,319 for Failure to State a Claim.

¹In the unexpected event that the Board does not sustain the present motion with respect to Applicant's asserted claim, Opposer respectfully requests the Board grant Opposer leave to file a Response to the Applicant's Counterclaim against Opposer's cited Trademark Registration No. 2,088,319. *Cf.* TBMP § 503.03 ("If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading.").

Opposer also requests the Board strike the exhibits attached with Applicant's Notice of Opposition and Counterclaim, as the introduction of such extrinsic evidence is not proper.

Respectfully submitted,

April 21, 2014
Date

/1433-55/
John S. Egbert
Reg. No. 30,627
Kevin S. Wilson
Michael F. Swartz

Egbert Law Offices, PLLC
1314 Texas, 21st Floor
Houston, Texas 77002
(713)224-8080
(713)223-4873 (Fax)

ATTORNEYS FOR OPPOSER
INTS It Is Not The Same, GmbH

