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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
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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 REPLY TO APPLICANT'S RESPONSE TO 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 Reply in Support of Opposer's 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. This Reply is made after Applicant's recent Brief in Opposition to Opposer's Motion to Dismiss Applicant's Counterclaim for Failure to State a Claim and Motion to Strike Applicant's Exhibits. *See* [Applicant's Brief].

I. ARGUMENT

Applicant's counterclaim has failed to plead a proper claim of abandonment against Opposer's Trademark Registration No. 2,088,319. Prior to the filing of Applicant's Response, Opposer was unable to adequately identify the cause of action upon which Applicant sought to cancel the Registrant's mark. In the Applicant's Response to Opposer's Motion to Dismiss Applicant's Counterclaim, the Applicant has confirmed that its counterclaim is supposed to be based upon a

theory of abandonment. *See* [Applicant's Brief, pg. 1]. However, despite the Applicant's clarification that its counterclaim is actually based on abandonment, the simple fact remains that using the word abandonment once in the introductory paragraph of the counterclaim is not the same as properly pleading abandonment. Moreover, there are multiples types of abandonment and Opposer has no way to know which type of abandonment Applicant believes might be applicable to this proceeding.

Based on the Applicant's legally deficient counterclaim, Opposer has not been provided with notice as to what circumstances have given rise to Applicant's theory of abandonment. Section 45 of the Lanham Act defines abandonment of a trademark. Interestingly, the Applicant never cited this pertinent law regarding abandonment in its counterclaim, which is purportedly derived from a theory of abandonment. *See* [Opposer's Motion to Dismiss Counterclaim, pgs. 3-4] (providing the relevant statutory authority, 15 U.S.C. § 1127). The Applicant has merely asserted that "Reg. No. 2,088,319 has not been used as a trademark on the identified goods." *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶ 11]. Opposer is not required to use its mark directly on the goods identified in its registration. There are many different ways in which a trademark may be displayed. For example, a trademark is used on goods when "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale." *See* TMEP § 901.01.

Furthermore, the twelve paragraphs dedicated to Applicant's counterclaim yield little insight as to why cancellation is being sought. For example, the Applicant alleges that Opposer's website "reveals no trademark uses of the design mark on the goods identified in the registration." *See*

[Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶ 9]. Failure to find a trademark on a website does nothing to support any claim of abandonment, and it is not compelling evidence toward any of the five circumstances of abandonment, which include: (1) abandonment based on nonuse of the mark; (2) abandonment based on a material alteration of the mark with discontinued use of the mark in the original form; (3) abandonment based on naked licensing of the mark with a lack of quality control; (4) abandonment based on failure to police the mark; and (5) abandonment based on a naked assignment or assignment "in gross" of the mark, without any transfer of the goodwill associated with the mark. *See* Jeffery Handelman, *Guide to TTAB Practice* §§ 8.24-8.29 (2011).

The reality is that Applicant's paragraphs within its counterclaim focus almost exclusively on specimens submitted by Opposer to the USPTO, which Applicant alleges were improper. *See* [Applicant's Answer to Opposer's Notice of Opposition and Counterclaim, ¶¶ 1-8, 12]. Opposer is unable to discern how allegations relating to allegedly improper specimens submitted to the USPTO might be related to a potential abandonment claim. The specimens referenced by Applicant were all submitted to and accepted by the USPTO. The mark is clearly registered and remains on the Principal Register. Frankly, Opposer cannot understand what relationship specimens filed in connection with Section 8 Declarations have with an abandonment counterclaim. Applicant's Response to Opposer's Motion to Dismiss provides Opposer with no additional insight into this enigma.

Applicant's pleading fails to provide fair notice and is legally insufficient to allege a counterclaim of abandonment. Proper pleadings serve as the framework upon which a Trademark Opposition is built. Subsequently, it is imperative that the Applicant's counterclaim be properly

plead and provide the Opposer with fair notice of the Applicant's claim. Applicant's counterclaim should be dismissed for failure to properly plead a claim of abandonment.

II. 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. Merely using the word abandonment in a counterclaim along with numerous paragraphs unrelated to that legal theory is not the same as properly pleading a legal theory of abandonment in a counterclaim filed with the TTAB. Opposer is compelled to point this discrepancy out, in order to avoid implicitly acquiescing to an additional counterclaim in this proceeding. 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. With regard to the extrinsic evidence submitted by Applicant, Opposer also requests that the Board, at the very least, not consider Applicant's Exhibits in any determination as to whether a proper claim has been made in Applicant's counterclaim.

Respectfully submitted,

May 30, 2014
Date

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document is being sent by first class mail on May 30, 2014, to the attorney of record for Applicant at the following address:

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