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

Proceeding	91214938
Party	Defendant KSB Aktiengesellschaft
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

BALDOR ELECTRIC COMPANY,)	
)	
Opposer,)	
)	
v.)	Opp. No.: 91214938
)	App. No.: 79/112,458
KSB AKTIENGESELLSCHAFT,)	Pot. Mark: REEL SUPREME
)	
Applicant.)	
)	

**APPLICANT’S MOTION TO DISMISS COUNT II OF
OPPOSER’S FIRST AMENDED NOTICE OF OPPOSITION WITH PREJUDICE**

KSB Aktiengesellschaft (“KSB” or “Applicant”) by and through its undersigned counsel, hereby submits this Motion to Dismiss Count II of Opposer Baldor Electric Company’s (“Baldor” or “Opposer”) First Amended Notice of Opposition pursuant to Federal R. Civ. P. 12(b)(6) with prejudice.¹

Opposer filed a Notice of Opposition on February 17, 2014. On March 31, 2014, Applicant timely filed a Motion to Dismiss Count II of the Notice of Opposition, and Opposer subsequently filed on April 21, 2014 an Opposition to Applicant’s Motion to Dismiss together with an Amended Notice of Opposition.

As will be shown, Count II of Opposer’s Amended Notice of Opposition, which alleges that KSB did not have a *bona fide* intention to use the mark at issue in commerce, should be dismissed because Opposer provides no information or explanation (and thus no notice to

¹ Applicant notes that it is aware that the Board issued a Notice of Suspension on May 2, 2014. However, to provide a complete record for the Board, Applicant submits the instant motion with respect to Opposer’s Amended Answer and Opposition.

Applicant) regarding why or how KSB purportedly lacked a *bona fide* intent to use its mark in commerce with the goods listed in the application and does nothing more than set forth the basic allegation without explanation.

I. Opposer's Allegations

Count II of Opposer's original Notice of Opposition asserted a lack of *bona fide* intent to use the mark in commerce. *See* D.I. 1. The entirety of Opposer's allegation regarding the alleged lack of *bona fide* intent to use the mark in commerce consisted of the following:

8. Baldor incorporates the above allegations by reference.

9. On information and belief, KSB lacked a bona fide intention to use KSB's Mark in commerce in connection with KSB's Goods at the time KSB filed its request for extension of protection of its international registration to the United States.

10. Accordingly, U.S. Ser. No. 79/112,458 is void under Section 66 of the Lanham Act, 15 U.S.C. §1141f.

Id. at paras. 8-10. In response to Applicant's motion to dismiss, Opposer amended the allegations in its Amended Notice of Opposition to add the following italicized wording:

8. Baldor incorporates the above allegations by reference.²

9. On information and belief, KSB lacked a bona fide intention to use KSB's Mark in *United States* commerce in connection with *all of* KSB's Goods at the time KSB filed its request for extension of protection of its international registration to the United States.

10. *On information and belief, KSB has not made use of KSB's Mark in United States commerce in connection with any of KSB's Goods. On information and belief, its websites do not reflect planned distribution in the United States of KSB's Goods under KSB's Mark. On information and belief, KSB is merely attempting to reserve a right in KSB's Mark.*

² None of the above referenced paragraphs contain any allegations or claims relevant to KSB's *bona fide* intention to use a mark.

11. Accordingly, U.S. Ser. No. 79/112,458 is void, *in whole or in part*, under Section 66 of the Lanham Act, 15 U.S.C. §1141f.

D.I. 5 at paras. 8-11 (emphasis added). The minimal wording added by Opposer still does not provide any information to support its allegation nor does it provide any hint as to the basis for its alleged “information and belief.” For the reasons set forth below, Baldor’s amended allegations fail to satisfy its pleading requirements and should be dismissed with prejudice.

II. Argument

Factual allegations contained in a complaint must be sufficient to “state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A complaint which offers merely “labels and conclusions” or a “formulaic recitation of the elements” without “further factual enhancement” cannot survive a motion to dismiss. *Ashcraft v. Iqbal*, 129 S.Ct. 1937, 1949 (2009).

In order to state a claim based upon a lack of a *bona fide* intent to use a mark, the Opposer “has to notify the applicant of the general ‘circumstances, occurrences, and events’ causing the flaw in the application.” *Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 86 U.S.P.Q.2d 1527, 1537 (D.C. Cir. 2008) (citing *Twombly*, 127 S. Ct. at 1965 n.3.) “Although the complaint need not go into detail, it must at least notify the applicant of how the general circumstances fail to show intent.” *Id*; see also *Sandro Andy, S.A. v. Light, Inc.*, 2012 WL 6709268 at *5 (S.D.N.Y. December 27, 2012) (“A petition to cancel an extension of an International Registration based on an alleged lack of a bona fide intent to use the mark in commerce for some or all of the listed goods is a valid claim where it is supported by adequately alleged facts.”).

There is no substantive difference between Opposer’s initial allegations and those contained in its Amended Notice of Opposition. As before, Opposer’s conclusory statement

regarding Count II provides no information or explanation (and thus no notice to Applicant) regarding why or how KSB purportedly lacked a *bona fide* intent to use its mark in commerce with the goods listed in the application at the time KSB filed its request for extension of protection to the United States. As before, Opposer's allegations fall short of the limited information that Courts have considered sufficient in other cases regarding an allegation of a lack of bona fide intent to use a mark.

For example, in *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 U.S.P.Q.2d 1111, 1115-16, 2010 WL 956670, (T.T.A.B. 2010), the Opposer had alleged that “[o]n information and belief, Applicant has never been in the automotive manufacturing industry, nor does it intend to be in the automotive manufacturing industry in the future” and that “... Applicant did not have a bona fide intent to use the mark at the time the application was filed.”). In considering a motion to dismiss, the Board stated “we find opposer’s allegations that applicant has not been engaged in the manufacture or sale of automobiles under the claimed mark or otherwise, and, therefore, applicant lacks a bona fide intent to use the mark in commerce, to state a sufficient claim.” *Id.* Similarly, in *Aktieselskabet AF 21.*, the Court found an Opposer’s allegations sufficient where the Opposer had included numerous allegations, including that Applicant “has never used the [] mark anywhere in the world” and Opposer’s “investigation reveal[ed] that it does not intend” to use the mark in the United States. *Aktieselskabet AF 21. November 2001* at 86 U.S.P.Q.2d 1538.

Baldor’s allegations in the instant case are limited to an unexplained “information and belief,” and fall short of the limited allegations set out in *Fiat Group* or *Aktieselskabet AF 21.*³

Opposer’s new statement is the following:

³ For example, given Applicant’s presence in the market related to the goods listed in its application, it would seem Opposer could not make an allegation of the type set out in *Fiat*. (Continued...)

“On information and belief, KSB has not made use of KSB’s Mark in United States commerce in connection with any of KSB’s Goods. On information and belief, its websites do not reflect planned distribution in the United States of KSB’s Goods under KSB’s Mark. On information and belief, KSB is merely attempting to reserve a right in KSB’s Mark.

D.I. 5 at para. 10.

Each of Opposer’s new statements are unavailing, and appear to be no more than attempts to write around the foregoing cases that were also cited by Applicant in its initial motion to dismiss. For example, given Applicant’s presence in the market related to the goods listed in its application, Opposer did not make an allegation of the type set out in *Fiat*. Likewise, a review of Applicant’s website shows use of KSB’s Mark on its website, in product brochures, and elsewhere, contrary to the assertions contained in *Aktieselskabet AF 21*. Opposer in this case was left to make effectively irrelevant new allegations that neither satisfy its pleading requirement nor provide sufficient notice to Applicant. The fact that Opposer’s Amended Notice of Opposition retreated from its earlier allegations and now only claims that the application is void “in whole or in part” only further evidences the vague and unsupported nature of its allegations. Such “labels and conclusions” amount to nothing more than the “formulaic recitation of the elements” without “further factual enhancement” that the Supreme Court has rejected. *Ashcraft*, 129 S.Ct. at 1949.

III. Conclusion

Opposer’s First Amended Notice of Opposition fails to meet the applicable notice pleading requirements with respect to its assertion that KSB purportedly lacked a *bona fide* intent to use its mark at the time it sought an extension of protection into the United States. Applicant

Likewise, a simple review of Applicant’s website shows use of KSB’s mark on its website, in product brochures, and elsewhere, contrary to the assertions contained in *Aktieselskabet AF 21*.

respectfully requests that the Board grant Applicant's motion to dismiss Count II of Opposer's First Amended Notice of Opposition with prejudice.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S MOTION TO DISMISS COUNT II OF OPPOSER'S FIRST AMENDED NOTICE OF OPPOSITION was served on counsel for Opposer this 12th day of May, 2014, by sending same via First Class Mail, postage prepaid, to:

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