

ESTTA Tracking number: **ESTTA624415**

Filing date: **08/29/2014**

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

Proceeding	91215553
Party	Defendant Ebel International Limited
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Attachments	Reply to Response to MTD to upload (00173571xC536D).pdf(326440 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Actions Simplifee,)		
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Opposer,)	<u>OPPOSITION</u>	
)		
v.)	Serial No.	85840883
)	Mark:	SUMMUM L’BEL
Ebel International Limited)	Opposition No.:	91215553
Applicant)		

APPLICANT’S REPLY TO OPPOSER’S RESPONSE TO MOTION TO DISMISS

COMES NOW, Applicant, Ebel International Limited, by its undersigned counsel and respectfully states:

PRELIMINARY STATEMENT

On April 30, 2014, the Applicant filed a Motion to Dismiss the pending Opposition on the ground that Opposer had failed to state a claim under which relief might be granted. The parties unsuccessfully engaged in negotiations in an attempt to reach a settlement and the Opposer filed a Response to the Motion to Dismiss on August 19, 2014. Although Opposer’s Response does not address the arguments made in the Motion to Dismiss and Opposer seems to be suggesting that this Opposition not continue, Applicant wishes to reply to note its concerns about the actions requested by Opposer. Accordingly, Applicant replies to the Reponse to the Motion to Dismiss and requests that the Board grant the relief requested in the Motion to Dismiss, that is, dismiss the instant Opposition proceeding.

DISCUSSION

In its Response to the Motion to Dismiss, Opposer argues that the Opposition appears to be moot because one of the grounds in the Motion to Dismiss is that there is no likelihood of confusion. However, Opposer fails to address any of the substantive arguments made by Applicant. Furthermore, Opposer mischaracterizes the nature of Applicant’s response and ignores the implications of the standards for presenting a Motion to Dismiss.

In the Motion to Dismiss, Applicant presented its arguments in a manner fulfilling the guidelines for such motions, i.e., directed towards “a test solely of the legal sufficiency of a complaint.” TBMP § 503.02. As noted in the Motion to Dismiss, “[w]henver the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought.” Id. Accordingly, Applicant’s motion to dismiss is based on the allegations made by Opposer and is directed at demonstrating that even construed in the required manner, the alleged facts presented by Opposer fail to state a claim. Opposer’s assertion that Applicant made “admissions” in the Motion to Dismiss is not

supported by the context in which the supposed admissions were made. Moreover, as with judicial proceedings before a court, statements made in a motion to dismiss do not constitute a judicial admission that would bind a party for the rest of the litigation and Opposer does not cite to any legal authority in support of his mistaken allegation.

All of Applicant's statements in the Motion to Dismiss were directed at showing that the Opposition failed to provide sufficient statements, that if proven, would support a finding that a valid ground exists for denying the instant Application. *Id.* Looking at the statements highlighted by Opposer in its Response, it only contains arguments pointing out clear inaccuracies in the statements made in the Opposition or summarizing how the assertions of Opposer fail to establish the alleged likelihood of confusion. Indeed, within this highlighted language there is a clear indication of Applicant's intent in filing the Motion to Dismiss to show that "there could be no likelihood of confusion, *as per the Complaint's own allegations*". (emphasis added). With the emphasis in the proper location, the focus is on the proper issue: whether Opposer's allegations are sufficient to state a claim. Applicant has argued that these allegations are not, but in order to properly present a motion to dismiss, Applicant did not present arguments whether such allegations had been or could be proved. Accordingly Applicant did not, and does not *at this time*, take a position as to whether there is indeed a likelihood of confusion between Opposer's mark and Applicant's mark. Moreover, Opposer's response to the Motion to Dismiss is nothing but an admission that its Opposition would not survive immediate dismissal of this proceeding.

Turning to the specific action suggested by Opposer, Applicant believes that it would be useful to note that not only is there nothing in the record of the instant Opposition that supports allowing Opposer's application to register, the instant action is not a helpful nor the proper vehicle for that determination. First, Opposer's application is not at issue in this proceeding and there has been no opportunity to review its merits. Second, the opposition procedure is intended to remedy oversight or error, not to substitute for the examination process. *See In re Shell Oil*, 992 F.2d at 1209. In that sense, opposition proceedings "provide a backstop to purely ex parte examination of trademark applications. *See* 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20:2. In opposition proceedings, the ultimate issue is whether the applicant does have, in fact, the exclusive right to use the mark sufficient to qualify for federal registration. *See Wilson v. Delaunay*, 245 F. 2d 877, 114 U.S.P.Q. 339 (C.C.P.A. 1957). As the court noted in *American Novawood Corp. v. U.S. Plywood-Champion Papers, Inc.*, 426 F.2d 823, 165 U.S.P.Q. 613 (C.C.P.A. 1970), if an opposition proceeding is viewed as a balancing of competing interests, then the issue is whether an applicant has a right to register the mark superior to the opposer's asserted right to prevent registration. Accordingly, the merits of whether Opposer's application should be approved are outside the scope of this proceeding and nothing that has transpired in this case has any bearing on the examination process to be made of the other mark.

CONCLUSION

Opposer's Response to the Motion to Dismiss does not rebut any of Applicant's arguments. To the contrary, Opposer has consented to the dismissal of this case in its entirety. On the other hand, the request that another mark subject to the examination process outside of this proceeding be somehow granted is neither supported by the facts of this proceeding or applicable law. Therefore, Applicant respectfully requests that the Board (i) grant the Motion to Dismiss, to which Opposer has consented for this Board to do; (ii) decline to take the action requested by Opposer concerning the examination process

of its mark subject to another and different proceeding; and (iii) grant such other and further relief as the Board deems appropriate.

Respectfully Submitted,

EBEL INTERNATIONAL LIMITED

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[CERTIFICATES OF TRANSMISSION AND SERVICE ON FOLLOWING PAGES]

CERTIFICATE OF TRANSMISSION

I, Travis D. Wheatley, hereby certify that the foregoing *Applicant's Motion to Dismiss Opposition for Failure to State a Claim* is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on August 29, 2014.

By: /Travis D. Wheatley/
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CERTIFICATE OF SERVICE

I, Travis D. Wheatley, state that I served a true and complete copy of the foregoing *Applicant's Motion to Dismiss Opposition for Failure to State a Claim*, via USPS First Class mail, postage prepaid, and email (jhgeller@aol.com) upon Opposer's counsel of record at the following address:

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On this 29th day of August 2014.

s/Travis D. Wheatley /
Travis D. Wheatley