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

Proceeding	91216552
Party	Defendant Technicolor
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Submission	Reply in Support of Motion
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Date	07/28/2014
Attachments	FRAMELOGIC reply.pdf(97587 bytes)

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

FRAME LOGIC DIGITAL LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91216552
)	Application Serial No. 85682937
TECHNICOLOR,)	Mark: FRAMELOGIC
)	
Applicant.)	
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)	
	/	

**APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO DISMISS FOR FAILURE
TO STATE A CLAIM PURSUANT TO FED. R. CIV. P. 12(B)(6) AND TBMP §503**

Pursuant to Opposer’s opposition to *Applicant’s Partial Motion to Dismiss For Failure to State A Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TMEP §503*, Applicant, Technicolor, makes the following additional point in support of its motion.

In Opposer’s opposition to the motion to dismiss, it stated “Opposer counters by stating that the mark was distinctive and famous at least as early as the date the Opposition was filed.” Even assuming, *arguendo*, that this “can be implied from the Notice itself” as Opposer states, the dilution claim is still defective. Opposer also stated in its opposition that “Applicant filed its Notice of Opposition against an Intent to Use application. Therefore, no amendment containing the date when Opposer’s mark became famous is necessary.”

In *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164 (TTAB 2001), the Board held:

We hold that in the case of an intent-to-use application, an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding. The FTDA provides for injunctions against “another person’s commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous ... The constructive use provisions of the Trademark Act establish that: Contingent on the registration of a mark on the principal register provided by this Act, the filing of the application to register shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect ... against any other person except for a person ... who, prior to such filing (1) has used the mark. To harmonize the constructive use provisions with the Board’s authority to resolve dilution issues, it would

appear that an owner of an allegedly famous mark would have to show fame prior to the constructive use date; otherwise the intent-to-use provisions would lose much of their value.

Id. at 1174-5 (citations omitted).

Applicant's constructive use date is February 13, 2012, the priority filing date of the opposed application. The opposition was filed on May 27, 2014. Therefore, the dilution claim would still be defective even if it were implied in the Notice of Opposition that Opposer's mark became famous at least as early as the date the Opposition was filed. And, it is clear from this case that a properly plead dilution claim, even against an intent to use application, must specify the date the Opposer's mark became famous.

For the foregoing reasons, Applicants request that the Board grant Applicant's motion, and dismiss the dilution claim with prejudice.

Respectfully submitted,

Date July 28, 2014

s/Michelle L. Visser
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CERTIFICATE OF SERVICE

This will certify that a copy of the foregoing *Applicant's Reply in Support of its Motion to Dismiss for Failure to State a Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503* has been served upon the following via first class mail, postage prepaid, on the date below:

Stewart J. Bellus
COLLARD & ROE, P.C.
1077 Northern Blvd.
Roslyn, NY 11576

Date: July 28, 2014

s/Michelle L. Visser
Michelle L. Visser