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

Proceeding	91221951
Party	Plaintiff Geoffrey, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GEOFFREY, LLC,	:	
	:	
	:	
Opposer/ Counterclaim Defendant,	:	
	:	Serial No. 86/222,809
v.	:	
	:	Opposition No. 91/221,951
HAIR ARE US, INC.,	:	
	:	
	:	
Applicant/ Counterclaim Plaintiff.	:	
	:	

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

**OPPOSER/COUNTERCLAIM DEFENDANT'S MOTION TO DISMISS
AMENDED COUNTERCLAIM PURSUANT TO FED. R. CIV. P. 12(b)(6)**

Pursuant to Rule 12(b)(6), Opposer/Counterclaim Defendant Geoffrey, LLC ("Opposer"), by and through its attorneys, Blank Rome LLP, hereby submits this motion to dismiss Applicant Hair Are Us, Inc.'s ("Applicant") amended counterclaim to cancel Opposer's U.S. Registration No. 3,859,458 for failure to state a claim upon which relief can be granted. First, Applicant's amended counterclaim is entirely lacking in facial plausibility, as no set of facts exist that would reasonably permit the conclusion that the  mark is generic. Furthermore, cancellation of Registration No. 3,859,458 would be futile, as

it is merely one of more than 30 "R US"-formative registrations on which the opposition is based. Accordingly, for the reasons set forth herein, Opposer prays that the Trademark Trial and Appeal Board grant the subject motion and dismiss with prejudice Applicant's amended counterclaim for cancellation of Registration No. 3,859,458.

BACKGROUND

On May 13, 2015, Opposer instituted this opposition against U.S. Trademark Application Serial No. 86/222,809 for the mark



, filed by Hair Are Us, Inc., on the basis of priority and likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Opposer based its opposition upon more than 30 U.S. trademark and service mark registrations for marks comprised of, in whole or in part, "R US," as well as common law rights in such "R US"-formative marks.

In Applicant's answer, filed June 23, 2015, Applicant asserted genericness of Opposer's mark. In the discovery conference memorandum of August 8, 2015, the Board struck Applicant's genericness defense as improper and granted Applicant an opportunity to file an amended answer and

counterclaim "specifying which of Opposer's pleaded registrations are the subject of the counterclaim."

On August 28, 2015, Applicant filed an amended answer and a counterclaim seeking to cancel only one of Opposer's numerous pleaded registrations, specifically Registration No. 3,859,458 for the mark , based solely on alleged genericness of the "RUS" portion of such mark. On October 2, 2015, Opposer moved to dismiss Applicant's counterclaim pursuant to Rule 12(b)(6), which the Board granted on January 11, 2016. The Board once again allowed Applicant an additional period of time to file a second amended answer and amended counterclaim.

On January 29, 2016, Applicant filed its amended counterclaim, alleging that the mark , as a whole, inclusive of stylized and design elements, is "generic for a toy store" (¶ 63), and on that basis again seeks relief in the form of cancellation of Opposer's Registration No. 3,859,458. Opposer now seeks to dismiss the amended counterclaim.

RULE 12(b)(6) STANDARD

In order to survive a motion to dismiss, Applicant must allege sufficient facts that, if proved, would allow the Board to conclude that: (1) Applicant has standing;¹ and (2) a valid statutory ground exists for cancelling the registration. Doyle

¹ Applicant's standing is not disputed in this motion.

v. Al Johnson's Swedish Restaurant & Butik Ink., 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012); see also T.B.M.P. § 503.02 (June 2015). Specifically, a counterclaim "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007)). As the Board explained in granting Opposer's prior motion to dismiss:

In the context of Board *inter partes* proceedings, a claim is plausible on its face when the plaintiff pleads factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that, the petitioner has standing and that a valid ground for cancellation exists. Cf. Bell Atlantic Corp., 550 U.S. at 556. In particular, a plaintiff need only allege enough factual matter to suggest its claim is plausible and "raise a right to relief above the speculative level." Id. at 555-56.

"Determining whether a complaint states a plausible claim for relief will . . . be a context-specific task that requires the reviewing court to draw on its judicial experience and common sense." Iqbal, 556 U.S. at 679.

ARGUMENT

Opposer respectfully submits that, when tested against the established standards of Rule 12(b)(6), Applicant's amended counterclaim fails as a matter of law. First, Applicant's genericness counterclaim is entirely lacking in facial plausibility, as no set of facts exist that would reasonably

permit the conclusion that the highly distinctive  mark is generic. Second, even if Applicant's amended counterclaim were successful, cancellation of Registration No. 3,859,458 would be futile because Opposer owns more than thirty additional "R US"-formative registrations, all of which were cited by Opposer as bases for the subject opposition. Opposer thus respectfully requests that the Board grant the subject motion and dismiss Applicant's amended counterclaim with prejudice.

I. Applicant's Genericness Counterclaim Lacks Legal or Factual Foundation and Cannot Withstand Judicial Scrutiny

Opposer's  mark is, as a matter of law, decidedly not generic. A generic term "is the common descriptive name of a class of goods or services." H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986); see also T.M.E.P. § 1209.01(c) (Oct. 2015) ("Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services."). As the Federal Circuit explained:

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant

public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corp., 228 U.S.P.Q. at 530 (citations omitted).

Applicant's amended counterclaim fails as a matter of law because it is lacking in facial plausibility and legal merit, cannot be supported by fact, and is devoid of common sense. Indeed, no set of facts exist that would reasonably permit the conclusion that the  mark is generic. In its counterclaim, Applicant asserts that "Opposer's mark is generic because it identifies the genus of its services as a toy store and the relevant public understands that the designation 'TOYSRUS' primarily refers to that genus of services as a retail store selling toys, or simply put, a toy store." Amended Answer and Counterclaim ¶ 39 (Jan. 29, 2016). This is nonsense. To be deemed generic, the relevant term must explicitly identify retail store services, i.e., "TOY STORE." As common sense dictates, and as Applicant well recognizes, the generic name for "toy store" is "toy store." See, e.g., id. (conceding that the "genus of services as a retail store selling toys" is, "simply put, a toy store"); see also id. ¶ 38 (indicating that "in commercial context, as understood by the relevant public, . . . 'retail store/online retail store services, all featuring toys and other playthings'" is, "simply put, 'Toy Store'"); ¶ 40 ("Opposer identifies the Genus of its services as a toy store in

the mark's registration as follows: 'retail store and on-line retail store services all featuring toys, games, playthings, natural wooden toys . . .'" (emphasis added); ¶ 55 (recognizing that "'a store selling toys'" is, "simply put, a toy store"); ¶ 56 ("[A] retail store that specializes in selling toys [is] simply put, a toy store.").

Applicant does not assert that a retail store featuring toys is, "simply put, a TOYSRUS." Indeed, such an assertion would be farcical. "TOYSRUS" does not mean "toy store," it does not "say" anything about retail store services, nor does it explicitly or even implicitly identify the nature of such services. That Applicant has devoted over 18 pages to its genericness counterclaim merely serves to reinforce the absurdity of its position.

In addition, as the Board already ruled, for a mark to be subject to cancellation on grounds of genericness, the mark as a whole must be entirely lacking in distinctiveness, including the mark's stylization and design elements. In a futile attempt to avoid the Board's holding, Applicant argues that "[t]he star symbol in the transposed R coupled with the basic coloring of words of the Opposer's mark does not create a separate distinct commercial impression over and above that made by the generic terms TOYSRUS - its ordinary stylization and design elements carry." Amended Answer and Counterclaim ¶ 62. Even if the

literal portion of the mark "TOYSRUS" were generic (which it clearly is not), the unique stylization and design elements in Opposer's  mark - featuring: (a) distinctive bubble lettering; (b) unique coloration; (c) Opposer's famous reverse letter "R"; and (d) its proprietary star/R mashup - render Applicant's contention facially implausible and entirely unreasonable.

The distinctiveness of the  mark is amply demonstrated by the existence of more than 30 "R US"-formative registrations on the Principal Register owned by Opposer, many of which are incontestable. In addition to the Trademark Office's recognition that Opposer's "R US" marks, including the  mark, are valid and subsisting and therefore unequivocally not generic, several federal courts as well as panels of this Board have acknowledged the distinctiveness and fame of Opposer's "R US"-formative marks. See, e.g., Toys "R" Us Inc. v. Akkaoui, 40 U.S.P.Q.2d 1836, 1838 (N.D. Cal. 1996) (finding the "R Us" family of marks to be famous and to have "a strong degree of distinctiveness"); Toys "R" Us Inc. v. Abir, 45 U.S.P.Q.2d 1944, 1948 (S.D.N.Y. 1997) ("[I]t is plain that the ["R US"] marks are famous."); Geoffrey Inc. v. Stratton, 16 U.S.P.Q.2d 1691, 1696 (C.D. Cal. 1990), aff'd, 951 F.2d 259 (9th Cir. 1991) ("The "R US" designation is a fanciful mark

coined by plaintiff"); Toys "R" Us, Inc. v. Smokes R Us of Pa Corp., Case No. 11-cv-00820 (M.D. Pa. June 20, 2011) (finding R US Marks to be famous and inherently distinctive and a "global 'super brand'"); Geoffrey, Inc. v. Floors 'R' Us, Inc., Opp. No. 90,662, 1997 TTAB LEXIS 406 (T.T.A.B. Sept. 4, 1997) (finding that Opposer's "family of "R" US marks is strong and well-known"); Geoffrey, Inc. v. Donald Lee Freedman, 1996 TTAB LEXIS 55 (T.T.A.B. 1996) (recognizing the inherent distinctiveness of Opposer's R US Marks and sustaining opposition to the application for MEN ARE US). In the face of such overwhelming evidence, Applicant's suggestion that Opposer's  mark is generic and subject to cancellation beggars belief and fails to satisfy Rule 12(b)(6)'s plausibility standard. Iqbal, 555 U.S. at 678. Accordingly, Opposer respectfully requests that the Board grant the subject motion and dismiss Applicant's amended counterclaim with prejudice.

**II. Applicant's Genericness Counterclaim Is Futile:
Registration No. 3,859,458 Is but One of More Than 30
Registrations Pled in the Subject Opposition.**

In addition to lacking substance, Applicant's genericness counterclaim is futile. Registration No. 3,859,458, the sole registration against which Applicant's amended counterclaim is directed, is merely one of more than 30 "R US"-formative registrations upon which the subject opposition is based. Consequently, even if successful, Applicant's counterclaim would

be futile as it cannot possibly result in Applicant's requested relief of dismissal of the opposition. See, e.g., Dragon Bleu (SARL) v. VENM, LLC, 112 U.S.P.Q.2d 1925, 1929 n.10 (T.T.A.B. 2014) (dismissing claim with no leave to replead as would be futile); Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 U.S.P.Q. 151, 154 (T.T.A.B. 1983) (dismissing claim as futile where "leave to amend the pleading would serve no useful purpose").

Under the circumstances, the only explanation for filing this meritless counterclaim is Applicant's intent to cause further unnecessary delay in the subject opposition, harass Opposer, and waste the Board's and Opposer's resources. In view of the foregoing, Applicant respectfully requests that the Board grant the subject motion and dismiss Applicant's amended counterclaim with prejudice.

* * *

WHEREFORE, for the reasons set forth herein, Geoffrey, LLC, respectfully requests that the Board grant this motion and dismiss Applicant's counterclaim for cancellation of Registration No. 3,859,458 with prejudice.

Respectfully submitted,

GEOFFREY, LLC

Date: March 4, 2016

By:



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CERTIFICATE OF SERVICE

I, Bradford C. Craig, do hereby certify that I have on this 4th day of March 2016 served via electronic mail the foregoing OPPOSER/COUNTERCLAIM DEFENDANT'S MOTION TO DISMISS AMENDED COUNTERCLAIM PURSUANT TO FED. R. CIV. P. 12(b)(6) to the following:

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