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

Proceeding	91223528
Party	Plaintiff Clariant Corporation
Correspondence Address	SEAN M SULLIVAN LEE SULLIVAN SHEA & SMITH LLP 224 N DESPLAINES ST, STE 250 CHICAGO, IL 60661 UNITED STATES sullivan@ls3ip.com, smith@ls3ip.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Sean M. Sullivan
Filer's e-mail	sullivan@ls3ip.com
Signature	/Sean M. Sullivan/
Date	01/06/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLARIANT CORPORATION Opposer, v. MULTISORB TECHNOLOGIES, INC. Applicant.	)	Opposition No. 91223528 Application Serial No. 86/569,259

CLARIANT'S REPLY IN SUPPORT OF ITS MOTION
TO DISMISS MULTISORB'S COUNTERCLAIM

Rather than provide Clariant adequate notice in its pleading, Multisorb argues that it is only required to parrot back the very legal definition of abandonment – "discontinuing use of the mark for each of the goods listed therein, with an intention not to resume use" – to satisfy its pleading requirements. Multisorb is wrong. "[A] formulaic recitation of the elements of a cause of action" does *not* satisfy the pleading standard of Rule 8(a). *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)).

After reading Multisorb's opposition brief, Clariant is still left without "fair notice of what the . . . [abandonment] claim is and the grounds upon which it rests." *See Twombly*, 550 U.S. at 555 (quoting *Conley v. Gibson*, 355 U.S. 41, 47 (1957)). Although Multisorb argues in the opening paragraph of its brief that it "knows that Clariant discontinued use" and "believes that Clariant had an intent not to resume," Multisorb never explains how it "knows" or why it "believes" that Clariant has discontinued the use of its DESI PAK mark without an intent to resume use. *See* Applicant's Response to Opposer's Motion to Dismiss Multisorb's

Counterclaim (Doc. No. 10) ("Multisorb Opposition Brief"). Rather, Multisorb merely states that "Clariant, not Multisorb knows the details." But, Multisorb must do more than simply assert a conclusion that it hopes to find support for at some point in the future. In fact, Multisorb must have a Rule 11 basis for pleading its abandonment claim. *See* Fed. R. Civ. P. 11(b). It does not.

Acknowledging that it has no evidence of Clariant's alleged abandonment, Multisorb tries to manufacture such details by arguing that "it appears from the evidence relied upon by Clariant that from 2005 until at least 2013, the mark was never used by Clariant, and was instead used by a company called Sud-Chemie." Multisorb Opposition Brief at p. 9; *see also id*. at p. 5 ("Further, the images provided show the DESI PAK products being advertised by a company called Sud-Chemie, not Clariant."). This is an intentionally misleading statement. As indicated on the publicly available Trademark Status & Document Retrieval ("TSDR") database, Clariant completed its acquisition of Süd-Chemie and was assigned the DESI PAK trademark registration in 2012. *See* TSDR Assignments Documents for U.S. Trademark Registration No. 1369682 (DESI PAK). Thus, Süd-Chemie's use of the DESI PAK mark from "2005 until at least 2013" is, by acquisition and legal assignment, Clariant's use of the mark during such time frame. The fact that Clariant's predecessor-in-interest, Süd-Chemie, used the mark before Clariant acquired Süd-Chemie is not a "plausible" ground for abandonment. *See Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 U.S.P.Q.2d 1315 (Fed. Cir. 2010) (finding no abandonment of the CRASH DUMMIES mark where opposer's predecessor-in-interest used the mark from 1991-1997 before legally assigning it to opposer). And the Board must dismiss a claim that is not "plausible on its face." TBMP § 503.02 (2015) (citing *Twombly*, 550 U.S. at 570); *see also Iqbal*, 556 U.S. at 678.

Further, Multisorb was and is well aware of the legal relationship between Süd-Chemie

and Clariant, and Multisorb's characterization of the two as unrelated companies is disingenuous at best. Not only does the public file history for the DESI PAK registration include the assignment of the mark from Süd-Chemie to Clariant, but Multisorb's own exhibits to its opposition brief clearly illuminate the relationship between the two companies. For example, in Multisorb's Exhibit B, Clariant's counsel informed Multisorb's counsel in a letter dated October 1, 2015, that Süd-Chemie was Clariant's predecessor: "Since 2005, Clariant has also continued to use the DESI PAK mark as evidenced by, for example, the attached webpages from ***Clariant's (and its predecessor Süd-Chemie's)*** website." Multisorb Opposition Brief at Exhibit B, p. 1 (emphasis added). In addition, at least one of the "attached webpages" of Exhibit B clearly indicates that Süd-Chemie was a part of Clariant:

Id. at p. 17 (logo from webpage).

In contradiction to its statements here, Multisorb itself has previously represented to this Board that Süd-Chemie is Clariant's predecessor. Specifically, in at least one of Multisorb's submissions filed in its opposition against Clariant over the OXY-GUARD mark, Multisorb's counsel – the same counsel representing Multisorb in this opposition – informed this Board that "[i]n 2011 Applicant [Clariant] acquired the company Sud-Chemie." Opposition No. 91212441, Multisorb's Motion for Summary Judgment and Memorandum in Support (Doc. No. 18), p. 3. In that same submission, Multisorb's counsel characterized "Sud-Chemie" as "Applicant's [(Clariant's)] predecessor in interest." *Id*. at p. 8. Multisorb's ignorance about the relationship between Süd-Chemie and Clariant in its opposition brief here highlights the lack of merit to

Multisorb's position.

The Board should also reject Multisorb's attempt to avoid its obligation to adequately plead and prove abandonment by shifting that burden onto Clariant. Instead of providing the factual basis for its allegation that Clariant abandoned its DESI PAK mark, Multisorb merely criticizes the publicly available evidence that Clariant cited in support of its continuous use of the mark. Even if Clariant's evidence was worthy of such criticism (it is not), mere criticism of Clariant's evidence of use does not satisfy or discharge Multisorb's burden to properly plead and prove discontinued use without an intent to resume.[1]

In another effort to avoid its burden to adequately plead abandonment, Multisorb asks the board to ignore Clariant's motion to dismiss entirely and dismiss it as "premature" because Clariant allegedly relied on evidence that is "outside the pleadings." Multisorb Opposition Brief, pp. 7-9. The so-called "premature" evidence consists of Clariant's Section 8 Declarations of Use from the TSDR database as well as Clariant's publicly available company website. *Id*. at pp. 1-2. Clariant's citation of this evidence of use in the public record, however, does not excuse Multisorb's failure to properly plead abandonment and does not render Clariant's motion to dismiss "premature."

For the foregoing reasons, as well as the reasons set forth in Clariant's opening brief, Opposer Clariant Corporation requests that the present motion be granted and that Applicant Multisorb Technologies, Inc.'s Abandonment Counterclaim be dismissed.[2]

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[1] In addition, contrary to Multisorb's suggestion, Clariant has additional sales information regarding its continued use of the DESI PAK mark. As Clariant has already explained to Multisorb, however, such information is confidential and Clariant is reluctant to provide it to a direct competitor like Multisorb absent the entry of a suitable protective order. *See* Multisorb Opposition Brief at Exhibit A, pp. 2-3.

[2] In the opening paragraph of its opposition brief, Multisorb requests that the Board "deny

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Respectfully submitted,

/Sean M. Sullivan Reg. No. 40,191/
Sean M. Sullivan

Sean M. Sullivan (USPTO Reg. No. 40,191)
John Dan Smith III (USPTO Reg. No. 66,743)
Lee Sullivan Shea & Smith LLP
224 N Desplaines St, Suite 250
Chicago, Illinois 60661
Tel: (312) 754-9602
sullivan@ls3ip.com
smith@ls3ip.com

Attorneys for Opposer Clariant Corporation

Opposer's Motion to Dismiss based on the properly pled counterclaims, or, in the alternative, grant Multisorb leave to amend its pleading." Multisorb Opposition Brief at p. 2. However, in the conclusion of its brief, Multisorb slips in a request that the Board "enter summary judgment for Multisorb on the counterclaim." *Id*. at p. 9. Summary judgment in Multisorb's favor is not only substantively inappropriate, but also procedurally inappropriate at this stage. *See* TBMP 528.04 ("A party may not file a motion for summary judgment until it has made its initial disclosures and such disclosures are not made until after the pleadings have closed . . . . As a result, the Board generally will not construe either a motion to dismiss or a motion for judgment on the pleadings, filed prior to initial disclosures, as a motion for summary judgment.").

CERTIFICATE OF SERVICE

I hereby certify that on January 6, 2016, a true and complete copy of the foregoing CLARIANT'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS MULTISORB'S COUNTERCLAIM was served on Applicant's Attorney of Record for Application Serial No. 86/569,259 by sending via email a copy to:

Rhett V. Barney
Lee & Hayes, PLLC
601 West Riverside, Suite 1400
Spokane, WA 99201
Tel: (509) 944-4642
rhettb@leehayes.com

Date: January 6, 2016

/Sean M. Sullivan Reg. No. 40,191/
Sean M. Sullivan

Sean M. Sullivan (USPTO Reg. No. 40,191)
John Dan Smith III (USPTO Reg. No. 66,743)
Lee Sullivan Shea & Smith LLP
224 N Desplaines St, Suite 250
Chicago, Illinois 60661
Tel: (312) 754-9602
sullivan@ls3ip.com
smith@ls3ip.com

Attorneys for Opposer Clariant Corporation