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

Proceeding	91224272
Party	Defendant Pac-West Distributing NV LLC
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Submission	Motion to Dismiss - Rule 12(b)
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AFAB INDUSTRIAL SERVICES, INC.,)	
)	Opposition No. 91224272
)	
Opposer,)	Serial No. 86/599421
)	Marl: SUPER RUSH
vs.)	
)	
PAC-WEST DISTRIBUTING NV LLC)	
)	
)	
Applicant.)	
)	
)	
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APPLICANT’S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM

I. INTRODUCTION

Applicant, Pac-West Distributing NV LLC (“PWD”) respectfully requests dismissal with prejudice of the Notice of Opposition (“Opposition”) filed by Opposer AFAB industrial Services, Inc. (“AFAB”) because the Opposition fails to state a claim for relief under Rule 12(b)(6) of the Federal Rule of Civil Procedure. AFAB fails to allege facts sufficient to support a plausible claim that PWD’s use of the PWD Mark is unlawful. As set out in detail below, even if PWD’s all purpose cleaners and cleaning preparations contain isobutyl nitrites and/or alkyl nitrites such products have not been banned by the Federal government.

II. BACKGROUND

AFAB opposes the mark SUPER RUSH, Serial No. 86/599421 for the goods, “All-purpose cleaners; Cleaning preparations” in International Class 003 (“PWD Mark”). As grounds for the opposition, AFAB alleges that PWD’s use of the PWD Mark does not constitute lawful use of a trademark in commerce. AFAB argues that PWD’s use of the PWD Mark on all purpose cleaners and cleaning preparations is unlawful pursuant to 15 U.S.C. §§ 2057a and 2057b and

therefore PWD has not made any lawful use of the PWD Mark in commerce (Count I) and its statement that it had made lawful use to the trademark office was fraudulent (Count II).

Preliminarily, it should be noted that AFAB's Opposition is wrought with inaccuracies, including several false statements which appear to have been knowingly made in an attempt to intentionally mislead the TTAB. In particular, the Opposition contains photographs of certain product packaging in the Opposition AFAB knows are not PWD products, but rather unlicensed, infringing products.

Regardless, such inaccuracies are not material for purposes of this Motion to Dismiss as it is not necessary for TTAB to go beyond a review of PWD's application and the Opposition itself to determine this motion.

III. ARGUMENT

In order to avoid being dismissed, AFAB's Opposition must "state a claim to relief that is plausible on its face." See TBMP § 503.03 (citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007) and *Ashcroft v. Iqbal*, 129 S. Ct. 1937 (2009)). This plausibility standard applies in "all civil actions," including proceedings before the TTAB. See TBMP § 503.03 (citing *Iqbal*, 129 S. Ct. at 1953); see also *Zoba Int'l Corp. v. DVD Format / LOGO Licensing Corp.*, Cancellation No. 92051821, 2011 TTAB LEXIS 64 (T.T.A.B. Mar. 10, 2011) (granting motion to dismiss a fraud claim under the *Twombly* and *Iqbal* plausibility standard). A Rule 12(b)(6) motion allows the Board "to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993); see also *Kelly Services, Inc. v. Greene's Temporaries, Inc.*, 25 U.S.P.Q.2d 1460 (T.T.A.B. 1992) (dismissing a cancellation action under Rule 12(b)(6) when facts did not support a statutory grounds for cancellation).

In the Opposition AFAB has alleged that PWD's use of the PWD Mark on all purpose cleaners and cleaning preparations purportedly containing isobutyl nitrites and/or alkyl nitrites is unlawful pursuant to 15 U.S.C. §§ 2057a and 2057b. Those statutes state in full,

15 U.S.C. §§ 2057a

(a) In general

Except as provided in subsection (b) of this section, butyl nitrite shall be considered a banned hazardous product under section 2057 of this title.

(b) Lawful purposes

For the purposes of section 2057 of this title, it shall not be unlawful for any person to manufacture for sale, offer for sale, distribute in commerce, or import into the United States butyl nitrite for any commercial purpose or any other purpose approved under the Federal Food, Drug, and Cosmetic Act [21 U.S.C. 301 et seq.].

(c) Definitions. For purposes of this section:

(1) The term "butyl nitrite" includes n-butyl nitrite, isobutyl nitrite, secondary butyl nitrite, tertiary butyl nitrite, and mixtures containing these chemicals.

(2) The term "commercial purpose" means any commercial purpose other than for the production of consumer products containing butyl nitrite that may be used for inhaling or otherwise introducing butyl nitrite into the human body for euphoric or physical effects.

(d) Effective date

This section shall take effect 90 days after November 18, 1988.

15 U.S.C. §§ 2057b

(a) In general

Except as provided in subsection (b) of this section, volatile alkyl nitrite shall be considered a banned hazardous product under section 2057 of this title.

(b) Lawful purposes

For the purposes of section 2057 of this title, it shall not be unlawful for any person to manufacture for sale, offer for sale, distribute in commerce, or import into the United States volatile alkyl nitrites for any commercial purpose or any other purpose approved under the Federal Food, Drug, and Cosmetic Act [21 U.S.C. 301 et seq.].

(c) “Commercial purpose” defined

For purposes of this section, the term “commercial purpose” means any commercial purpose other than for the production of consumer products containing volatile alkyl nitrites that may be used for inhaling or otherwise introducing volatile alkyl nitrites into the human body for euphoric or physical effects.

(d) Effective date

This section shall take effect 90 days after November 29, 1990.

15 U.S.C. §§ 2057a and 2057b (emphasis added).

PWD has filed the PWD Mark for the goods, “all-purpose cleaners; cleaning preparations.” These products are not ones “that may be used for inhaling or otherwise introducing [butyl nitrite / volatile alkyl nitrites] into the human body for euphoric or physical effects.”

In order to meet its burden of proof that a use is unlawful, the party asserting unlawfulness must establish that:

the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been *per se* violation of a statute regulating the sale of a party’s goods

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, at 1273-1274 (TTAB 1992). Here there is no allegation that compliance has been previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved. Thus AFAB must demonstrate a *per se* violation of a statute regulating the goods set out in PWD’s trademark application.

The reason a *per se* violation is required was expressed in the case *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, where the TTAB recognized,

due to a proliferation of federal regulatory acts in recent years, there is now an almost endless number of such acts which the Board might in the future be

compelled to interpret in order to determine whether a particular use in commerce is lawful. Inasmuch as we have little or no familiarity with most of these acts, there is a serious question as to the advisability of our attempting to adjudicate whether a party's use in commerce is in compliance with the particular regulatory act or acts which may be applicable thereto.

209 USPQ 958, 964 (TTAB 1981).

Here, PWD has filed the PWD Mark for “all-purpose cleaners; cleaning preparations.”

These products are not a *per se* violation of the identified statutes and AFAB’s Opposition should therefore be dismissed.

IV. CONCLUSION

For the foregoing reasons, Registrant respectfully requests the Board to exercise its authority under Rule 12(b)(6) and dismiss the cancellation proceeding against PWD for failure to state a claim.

Respectfully submitted,

Dated: November 16, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM** has been served on the attorney of record for Petitioner on November 16, 2015 by U.S. First Class Mail, postage prepaid, with a courtesy copy provided by email to:

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