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

Proceeding	91224626
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 79/154,399
For the Mark: GATTO ASTUCCI 1937 and Design
Published in the Official Gazette on June 30, 2015

ASTUCCI U.S. LTD.,

Opposer/Counterclaim Defendant,

V.

Opp.No. 91224626

GATTO ASTUCCI S.P.A.,

Applicant/Counterclaim Plaintiff.

**GATTO ASTUCCI S.P.A.'s BRIEF IN RESPONSE TO ASTUCCI U.S. LTD'S MOTION TO
DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM**

INTRODUCTION

Applicant/Counterclaim Plaintiff Gatto Astucci S.p.A. (hereinafter "Applicant GATTO ASTUCCI") is filing this Reply Brief in response to the Motion to Dismiss the Counterclaim filed by Opposer/Counterclaim Defendant Astucci US LTD. (hereinafter "Opposer") Applicant GATTO ASTUCCI 'S counterclaim at issue seeks a ruling that Opposer's US Trademark registration 2,627,183 is invalid

because the ASTUCCI mark is generic ; ASTUCCI means “cases” in English and the goods are cases, including eyeglass cases. Opposer has no grounds to support dismissal of Applicant’s counterclaim based upon Opposer’s allegation that the counterclaim (i) is time-barred under Section 14 of the Lanham Act, or (ii) is barred under laches and acquiescence.

SUMMARY OF ARGUMENT

Opposer’s US Trademark Registration 2,627,183 should be canceled not because the ASTUCCI mark merely describes “cases” including eyeglass cases, but because the ASTUCCI mark is the common descriptive or generic term for “cases” including eyeglass cases. Sections 14 and 15 of the Lanham Act do not give the holder of a US Trademark Registration directed to a generic mark, an incontestable right to the generic mark, even if more than five years have passed from the date of registration. Laches and Acquiescence are not available defenses to a registrant of a generic mark as a basis to dismiss a cancellation proceeding. Precedential and relevant case law from the Federal Circuit and the TTAB establish that generic marks are not registerable, regardless of when they are or become generic, or when a cancellation proceeding is commenced. The cases cited by Opposer are distinguishable because those cases relate to attempts to cancel marks that were merely descriptive, not which were the common descriptive or *generic* terms for the goods or services identified in the registration.

A. US TRADEMARK REGISTRATION 2,627,183 SHOULD BE CANCELED BECAUSE THE TERM “ASTUCCI” IS THE COMMON DESCRIPTIVE OR GENERIC TERM FOR “CASES” INCLUDING EYEGLOSS CASES

Applicant GATTO ASTUCCI’s legal basis for petitioning to cancel US Trademark Registration 2,627,183 is not based upon the argument that the mark ASTUCCI merely describes eyeglass cases and the other goods identified in the registration. Applicant’s basis is that the term ASTUCCI is *generic* for cases, including eyeglass cases since the “astucci” in Italian means “cases.” By

obtaining a registration for the mark ASTUCCI for eyeglass cases and the other goods identified in the registration, Astucci U.S. LTD has obtained a registration for the "CASES" brand of eyeglass cases. The word "cases" does more than merely describe eyeglass cases. The word "cases" identifies the eyeglass cases and is in fact generic with respect to eyeglass cases, since eyeglass cases are cases. Thus, ASTUCCI is incapable of functioning as a trademark for eyeglass cases and should never have been registered to cover eyeglass cases or any of the other kinds of cases identified in US Trademark Registration 2,627,183.

B. SECTIONS 14 AND 15 OF THE LANHAM ACT DO NOT GIVE THE HOLDER OF A US TRADEMARK REGISTRATION DIRECTED TO A GENERIC MARK, AN INCONTESTABLE RIGHT TO THE GENERIC MARK, EVEN AFTER MORE THAN FIVE YEARS HAS PASSED FROM THE DATE OF REGISTRATION

Opposer argues that Applicant GATTO ASTUCCI is time-barred from bringing a cancellation petition against US Trademark Registration 2,627,183, even if it is agreed that ASTUCCI is a generic mark for eyeglass cases. Opposer argues that in order for the Applicant to maintain a cancellation on genericness grounds, Applicant was required to plead that the mark has "become the generic name for the goods" and that a cancellation proceeding is not available where the term has always been generic. Opposer concludes that Section 14 of the Lanham Act gives the Applicant no legal basis to challenge the validity of US Trademark Registration 2,627,183 because the mark ASTUCCI did not become a generic term, subsequent to the mark's registration.

Contrary to Opposer's assertion, there is no language in Section 14 of the Lanham Act that time-bars Applicant/Cancellation Petitioner's relying on paragraph (3) of that section of the statute to attack the validity of a registration on the grounds that the mark is and has always been the generic name for the goods or services. Because the ASTUCCI registration is directed to a mark that was a generic mark at the time of registration, the registration should never have issued. Whether the mark was generic at the time of registration or has become generic during the years following registration, the principle is still the same:

registrations directed to generic marks are invalid per se and are subject to cancellation at any time.

Section 15, paragraph 4 of the Lanham Act reads as follows:

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.
[emphasis added]

This section of the statute clearly indicates that maintaining registration of generic marks is not permitted even after five years following registration of the generic mark, at which time incontestability would otherwise begin for trademark registrations directed to valid trademarks. Opposer argues that the purpose behind Section 14 of the Lanham Act is to ensure that an interested third party does not “sit on its hands” in enforcing any purported right and that cancellation of a registered mark is permitted only where circumstances have changed since the original registration date. Astucci US Limited further argues that such is the reason why Section 14 of the statute uses the phrase “becomes generic” as opposed to “is generic” and that Applicant should have made the same genericness argument during the first five years of the registration of ASTUCCI instead of waiting for over thirteen years before challenging the validity of US Trademark Registration 2,627,183.

Opposer is simply wrong. Section 14, paragraph 3 of the Lanham Act permits challenge of a registration on the grounds that the mark is or becomes generic at any time and Section 15, paragraph 4 clearly states that no incontestable status is accorded a registration directed to a generic mark. There is no mention of a time bar to cancellation of a registered generic trademark depending upon when the mark became generic. In addition, Opposer has not cited any decisional law or other authority to support its assertions that Section 14, paragraph 3 of the Lanham Act only permits a cancellation proceeding against a registration directed to a mark that has *become* generic with respect to the identified goods and services in the registration, following registration, and not at

any time against a registration that was directed to a generic mark from the beginning.

C. LACHES AND ACQUIESCENCE ARE NOT AVAILABLE TO THE HOLDER OF A REGISTRATION DIRECTED TO A GENERIC MARK AS A BASIS TO DISMISS A CANCELLATION PROCEEDING BROUGHT AGAINST THE REGISTRATION ON GENERICNESS GROUNDS

If relevant, Applicant had no knowledge of the existence of US Trademark Registration 2,627,183 until the fall of 2015 after learning that Opposer had filed a request for an extension of the term to file an opposition against US Trademark Application Serial No. 79/154,399. Thus, even if the relevant period begins at the time that Applicant GATTO ASTUCCI had knowledge of Opposer's registration, laches and acquiescence would not apply. The equitable defenses of laches and acquiescence are not available to the registrant in a proceeding where the cancellation petitioner is claiming that the mark is generic and thus cannot function as a trademark under the Lanham Act, and there is no time bar to bringing a cancellation proceeding against a registration directed to a generic mark. It is in the public interest to have registrations that are void ab initio stricken from the register and the right to such action cannot be waived or limited by the action of any single person. The public is entitled to use generic terms, regardless of when the term is determined to be generic. Opposer has not cited any authority to the contrary.

D. PRECEDENTIAL CASE LAW FROM THE FEDERAL COURTS AND BOARD ESTABLISHES THAT GENERIC REGISTRATIONS CAN BE CHALLENGED AT ANY TIME

TMEP 1209.03(g) Foreign Equivalents and In re Zazzara, 156 USPQ 348 (TTAB 1967) establish that Opposer has no right to register the generic mark ASTUCCI notwithstanding that the generic mark is in the Italian instead of English language. In re Zazzara, the applicant tried to register, on the Supplemental

Register, the mark “Pizza Fritte” for comestible fried dough. The Board affirmed the examiner’s refusal to register the mark, even on the Supplemental Register, because the term was held to be not only *merely descriptive* of comestible fried dough, but was held to be so highly descriptive [generic] *that it was incapable of performing the function of a mark*. It is telling that the “Pizza Fritte” mark was refused registration on the Supplemental Register which underscores the distinction between marks that are *merely descriptive* of the goods and services identified in a registration, which may acquire distinctiveness and develop secondary meaning while registered on the Supplemental Register to eventually become eligible for registration on the Principal Register, and marks that are the *common descriptive or generic term* for the goods and services identified in an application, which may never become eligible for registration even on the Supplemental Register.

Applicant GATTO ASTUCCI’s basis for cancellation of US Trademark Registration 2,627,183 for the mark ASTUCCI is not that the mark merely describes the goods identified therein, in particular, eyeglass cases, but instead that the ASTUCCI mark is the common descriptive or generic term for the goods identified in the registration since “astucci” in Italian means “cases” in English. Unlike the situation in Park ‘N Fly (cited by Opposer) where the mark was found to be merely descriptive of airport parking services, the ASTUCCI mark means “cases” in Italian, and so “astucci” and “cases” are the same word in two different modern languages. By registering “ASTUCCI” for “cases”, Opposer has attempted to take away the generic term “cases” from the English language, which was always deemed to be in the public domain. See J. Kohnstam, Ltd. v. Louis Marx & Co., Inc., 126 USPQ 362,363 (CCPA 1960), where the opposer to the registration of the mark MATCHBOOK SERIES for miniature toys in a matchbox argued that:

“What opposer is seeking, is to thwart applicant’s attempt to take away a part of the English language which was always deemed to be in the public domain. All who want to sell miniature toys in a matchbox should be free to do so, and all who do so should have the right to say so. “

In the present matter, Applicant GATTO ASTUCCI or anyone else should have the right to refer to cases, including eyeglass cases as “cases” or as “astucci” in Italian.

The term ASTUCCI functions only as a generic term to mean “cases”, including eyeglass cases, rather than to identify and distinguish Opposer’s eyeglass cases and other cases from those of others. See In re G.D. Searle & Co., 149 USPQ 619, 624 (CCPA 1966). In that decision, the applicant G.D. Searle sought to obtain a registration for the mark “the pill” for oral contraceptive pills. The CCPA held that the mark “the pill” was not registerable as a trademark since it functions to identify the pill to the public rather than to identify and distinguish the applicant’s pill from those of others. According to the court, “Whether the objection to registration of “the pill” is phrased as “highly descriptive”, “inescapably descriptive”, or “common descriptive name” or “common name” or “generic name” on the facts of record, the basis for the objection is the same; the term “the pill” here functions to identify the product to the public rather than to identify and distinguish appellant’s goods from those of others and cannot be appropriated as a trademark.” Here is case law in which “generic” marks and “common descriptive” marks are treated as one and the same. According to the Searle decision on page 621, right-hand column, the version of Section 14 of the Lanham Act in force at the time of the decision in 1966 referred to marks that have become the “common descriptive name” of the goods or services identified in a registration as marks that are subject to cancellation for failure to be able to distinguish the goods or services identified therein from the goods and services of others. The Searle decision refers to Section 14 (c) of the Lanham Act which provides that a registered mark may be canceled “if the registered mark becomes the common descriptive name of an article or substance. “

Thus, marks such as “the pill” for oral contraceptive pills or “astucci” (cases) for eyeglass cases are not registerable per se because these marks simply identify the goods or services set forth in a registration and are not capable and never will be capable of distinguishing the underlying goods from those of others in the marketplace. Such marks are generic marks and should never be registered.

Applicant has the right to challenge the validity of US Trademark Registration 2,627,183 at any time on the grounds that the ASTUCCI mark is

generic, notwithstanding how much ASTUCCI U.S. LTD has spent over the years in advertising and promoting the ASTUCCI mark for eyeglass cases and other cases as well. See CES Publishing Corp. v. St. Regis Publications, Inc., 188 USPQ 2d 612 (2d Cir. 1975) on page 614, right-hand column at the bottom continuing onto the left-hand column of page 615, where the court relies on Section 14(c) [corresponding today to Section 14(3)] of the Lanham Act and Section 15(4) of the Lanham Act which states that “a registered mark may be canceled at any time if it becomes the common descriptive name of an article or substance,” and “No incontestable right shall be acquired in a mark which is the common descriptive name of an article or substance, patented or otherwise.”

In 1975 an earlier version of Section 15(4) of the Lanham Act was apparently in effect and the wording was as follows:

(4) no incontestable right shall be acquired in a mark which is the common descriptive name for the goods or services or a portion thereof, for which it is registered.

Thus, the courts have used the term “common descriptive” marks and “generic” marks in the same fashion, and as distinct from a mark that is “merely descriptive” and capable of developing secondary meaning and acquiring distinctiveness. Only marks that are “merely descriptive” as opposed to generic may acquire incontestable status.

In J. Kohnstam, Ltd. *supra*, the CCPA stated “...that under some circumstances, where there is only one source for a particular kind of merchandise over a period of time, the public might come to associate that source with the name by which the merchandise is called. But such a circumstance cannot take the *common descriptive name* of an article out of the public domain and give the temporarily exclusive user of it exclusive right to it, no matter how much money or effort it pours into promoting the sale of the merchandise. Registration of the mark in issue would deprive opposers of the right to call matchbox toys by their name. They have the same right to do so as

the appellant.” Thus, Opposer’s ninth and tenth assertions in the Notice of Opposition relating to its long use of the ASTUCCI mark in commerce to identify eyeglass cases and to its extensive use, advertising and promoting of the ASTUCCI mark for eyeglass cases, are irrelevant because the mark ASTUCCI means “cases” in Italian, and so ASTUCCI is a generic mark and US Trademark Registration 2,627,183 is invalid, regardless of the amount of use, advertising and promotion of the generic term.

To allow trademark protection for generic terms, i.e. names that describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of a mark a monopoly, since a competitor could not describe his goods as what they are. See CES Publication Corp. v. St. Regis Publications, Inc., 188 USPQ 612, especially page 615, left-hand column. Here the appellate court affirmed a lower court decision which invalidated a trademark registered on the Supplemental Register directed to the mark CONSUMER ELECTRONICS covering magazines. The lower court ruled that the registered mark was a generic mark and cited Section 14(c) and Section 15(4) of the Lanham Act as the bases for invalidating the registration. The appellate court also made it clear that even if the owner of the registration provided evidence that the mark CONSUMER ELECTRONICS developed secondary meaning in the marketplace that the registration was invalid since the mark CONSUMER ELECTRONICS was *not merely descriptive* of the magazines, but was the *common descriptive or generic term* for magazines directed to consumer electronics. Like the mark CONSUMER ELECTRONICS for magazines directed to consumer electronics which was found to be a generic mark, and thus invalid ab initio, the mark ASTUCCI for cases, including eyeglass cases, is also generic and invalid ab initio. Opposer’s request to dismiss Applicant’s counterclaim on the grounds of acquiescence or laches should be denied because laches and acquiescence are not available as defenses to a claim of genericness. See TBMP Section 311, 02(b) Affirmative Defenses, where it is specifically stated that for public policy reasons, the defenses of laches and acquiescence may not be available against claims such as genericness, descriptiveness, fraud, abandonment, and functionality. See also W.D. Byron & Sons, Inc. v. Stein Brothers Mfg. Co., 146 USPQ 313 (TTAB 1965) and Saint-Gobain

Abrasives, Inc. v. Unova Industrial Automation Systems, Inc., 66 USPQ 2d 1355 (TTAB 2003), cited within that section of the TBMP.

E. CASES CITED BY ASTUCCI US LTD. ARE DISTINGUISHABLE BECAUSE THOSE CASES RELATE TO ATTEMPTS TO CANCEL MARKS THAT MERELY DESCRIBE THE UNDERLYING GOODS AND SERVICES IDENTIFIED IN THE REGISTRATION, AND DO NOT RELATE TO MARKS THAT ARE THE COMMON DESCRIPTIVE OR GENERIC TERM FOR THE GOODS OR SERVICES IDENTIFIED IN THE REGISTRATION

The cases cited by Opposer are distinguishable and do not support its position in support of its argument that GATTO ASTUCCI's basis for cancellation of US Trademark Registration 2,627,183 is time-barred and may not be subject to cancellation . Opposer has cited Neapco Inc. v. Dana Corp., 12 USPQ 2d 1746 (TTAB 1989) and Park 'N Fly v. Dollar Park and Fly, Inc., 224 USPQ 327 (US Sup. Ct. 1985). The underlying facts in these decisions are totally different from the facts in the present case, and relate to marks that were merely descriptive of the goods and services, respectively, identified in the trademark owners' registrations.

In Neapco, the cancellation petitioner filed a motion for summary judgment that the registration in issue was invalid arguing that the registrant's mark 5-280X was per se merely descriptive of the registrant's goods because the mark was a parts number for those goods. Registrant argued that the mark served as both a parts number and as an indicator that the Registrant was the source or origin of the goods. The Board held that if the mark served as both a parts number and as an indicator of source or origin of the goods, that it could not be decided on summary judgment, without a trial, whether the mark was merely descriptive of the registrant's goods. Registrant further argued that the mark 5-280X had acquired distinctiveness and developed secondary meaning in the marketplace at the time that Registrant had filed its trademark application. The Board ruled that here was a further basis to deny cancellation petitioner's motion for summary judgment and that even if the registrant's mark was a parts number, that does

not mean that the mark was per se merely descriptive of the registrant's goods because it was possible that the registrant's mark could have acquired distinctiveness and develop secondary meaning in the marketplace, and so a trial would be needed to determine if the mark was merely descriptive.

Thus, the Neapco decision is irrelevant to the facts in the present case because the present case relates to a mark that more than merely describes Opposer's cases, including eyeglass cases; the mark ASTUCCI identifies the eyeglass cases and is the common descriptive or generic term for the eyeglass cases. Under decisional law as discussed at earlier points in this brief, "common descriptive" terms and "generic" terms may be one and the same.

The Park 'N Fly decision has no bearing on the present case. Applicant does not dispute that after a registration is more than five years old, it is too late for a cancellation petitioner to file a cancellation petition against the registration on the grounds that the mark merely describes the goods or services identified in the registration. The US Supreme Court held that the mark Park 'N Fly was merely descriptive of airport parking services, and further held that the mark was not a generic mark and since the mark was not a generic mark and since the registration for the mark was incontestable, the defendant could not attack the validity of the registration on the grounds that the mark was merely descriptive of airport parking services. Once again the facts in the present case are entirely distinguishable because the mark ASTUCCI in US Trademark Registration 2,627,183 does much more than merely describe cases, including eyeglass cases. ASTUCCI is the common descriptive or generic term for cases, including eyeglass cases, and Applicant is not time-barred from attacking the validity of this trademark registration on those grounds.

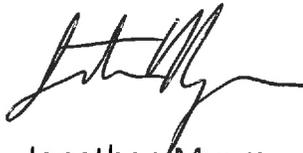
CONCLUSION

Applicant concludes that it has a sound legal basis for presenting the counterclaim.

Applicant respectfully requests that the Trademark Trial and Appeal Board deny Astucci U.S. LTD motion to dismiss the counterclaim.

Respectfully submitted,

Lucas & Mercanti, LLP,

A handwritten signature in black ink, appearing to read 'Jonathan Myers', written in a cursive style.

Jonathan Myers

Attorneys for Applicant/Counterclaim Plaintiff

Date: February 26, 2016

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing BRIEF IN RESPONSE TO ASTUCCI U.S. LTD'S MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM has been served on Defendant's attorney David B. Sunshine, Esq., by mailing said copy on this ^{26th} day of *February* 2016, via First Class Mail, postage prepaid to

David B. Sunshine, Esq.
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Feb 26, 2016

Date


Jonathan Myers