

ESTTA Tracking number: **ESTTA726660**

Filing date: **02/12/2016**

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

Proceeding	91224626
Party	Plaintiff Astucci U.S. Ltd.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	02/12/2016
Attachments	astucci Motion to Dismiss PDF.pdf(21971 bytes)

**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.

GATTO ASTUCCI S.P.A.,

Applicant/Counterclaim-
Plaintiff

Opposition No.: 91224626

MOTION TO DISMISS COUNTERCLAIM

Pursuant to Fed. R. Civ. P. 12(b)(6), Opposer Astucci US Ltd. (hereinafter “Astucci” or “Opposer”) hereby brings this motion to dismiss the counterclaim for cancellation asserted by Applicant Gatto Astucci S.P.A. (“Applicant” or “Gatto”).

I. INTRODUCTION

Applicant has asserted a counterclaim for cancellation against Opposer’s pleaded registration No. 2,627,183 for the mark ASTUCCI (hereinafter the “‘183 Registration”) which was registered on October 1, 2002. A copy of the ‘813 Registration is attached as Exhibit 1 to the Notice of Opposition. The basis for Applicant’s cancellation counterclaim is that the term “Astucci” is allegedly either descriptive or generic of the goods identified in the ‘183 Registration. Applicant’s counterclaim should be dismissed because that claim is time-barred under 15 U.S.C. § 1064.

II. LAW

To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark.

Doyle v. Al Johnson's Swedish Restaurant & Butik Inc., 101 USPQ2d 1780 (TTAB 2012), citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); and TBMP Section 503.02 (3d ed. rev. 2012). Specifically, a complaint “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, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

III. ARGUMENT

A. Applicant's Claim That “Astucci” is Descriptive is Time-Barred

Even assuming for the purposes of this motion that Applicant's claim that the “Astucci” mark is either generic or descriptive is true (which Opposer vigorously disputes), Applicant's claim fails as a matter of law. First, Applicant's claim that Opposer's ASTUCCI mark is “merely descriptive” is time barred under the Lanham Act and thus should be dismissed. Under 15 U.S.C. § 1064, only specific grounds for cancellation may be asserted after five years from

the registration date. In other words, 15 U.S.C. § 1064 separates valid grounds for cancellation into those that must be raised within five years of a mark's registration, and those that can be raised at any time. 15 U.S.C. § 1064. It is indisputable that trademarks that are merely descriptive may only be cancelled if that claim is made within five years of registration. *See Neapco Inc. v. Dana Corp.*, 12 U.S.P.Q.2d 1746, 1989 WL 274388, at *1 n.1 (T.T.A.B. 1989) ([A] petition to cancel a registered mark on the basis that it was merely descriptive and lacked secondary meaning must be filed within five years from the date of the registration of the mark."). Given time, though, a mark may become "incontestable," and thereafter the mark's descriptiveness can no longer be challenged. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 196 (1985) ("The language of the Lanham Act . . . refutes any conclusion that an incontestable mark may be challenged as merely descriptive.")

Here, there can be no dispute that the '183 Registration registered on October 1, 2002. Likewise, there can be no dispute that Applicant waited over thirteen (13) years after the registration date of the '183 Registration to assert the instant counterclaim. Accordingly, the counterclaim that the ASTUCCI mark is descriptive is time-barred under 15 U.S.C. § 1064 and the counterclaim should be dismissed under Fed. R. Civ. P. 12(b)(6).

B. Applicant's Claim that the "Astucci" Mark is Generic is Also Time-Barred

Applicant's claim that Opposer's ASTUCCI mark is generic is also time-barred. 15 U.S.C. 1064(3) allows an interested party to file a cancellation action "at any time if the registered mark *becomes the generic name* for the goods or services, or a portion thereof, for which it is registered..." (emphasis added). Applicant argues that Opposer's ASTUCCI mark translates from English to Italian as "case" and is therefore generic of the goods identified in the registration. In order for Applicant to maintain a cancellation action on genericness grounds,

Applicant was required to plead that the mark has “become the generic name for the goods.” Applicant’s claim is based on the assertion that the mark has always been generic because it translates from Italian to English as “case.” Therefore, Applicant’s mark could not have “become generic” of the goods as the statute requires for maintaining this action.

The purpose behind 15 U.S.C. 1064 is to ensure that an interested third-party does not sit on its hands in enforcing any purported rights. However, 15 U.S.C. 1064 permits certain grounds for cancellation at any time where the circumstances have changed since the original registration date (such as abandonment). There is other reasonable explanation as to why the statute uses the phrase “becomes generic” as opposed to “is generic.” Here, Applicant could have made the same genericness argument it makes now within the first five years of registration but chose not to do so. Applicant should not be allowed to wait over thirteen years to assert its claim for cancellation that the ASTUCCI mark has always been generic.

Therefore, Applicant’s counterclaim that the ASTUCCI mark is generic should be dismissed.

IV. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that Applicant’s counterclaims be dismissed with prejudice.

Respectfully submitted,

Dated: February 12, 2016

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CERTIFICATE OF SERVICE

I hereby certify that, on February 12, 2016, the foregoing Motion to Dismiss Counterclaims was served on Applicant by causing a true and correct copy thereof to be deposited in the United States Mail, postage prepaid, addressed to the attorney of record for the Applicant as follows:

Jonathan Myers

Lucas & Mercanti, LLP

30 Broad Street, 21st Floor

New York, NY 10004

/David B. Sunshine/