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Filing date: **07/05/2005**

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

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| Proceeding | 92044540 |
| Party | Defendant Visa International Service Association Visa International Service Association 900 Metro Center Boulevard Foster City, CA 94404 |
| Correspondence Address | Visa International Service Association 900 Metro Center Boulevard Foster City, CA 94404 |
| Submission | Motion to Dismiss - Rule 12(b) |
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| Date | 07/05/2005 |
| Attachments | mot-to-dismiss-filing.pdf (5 pages) |

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

In the Matter of Trademark Registration No. 2,350,558
Trademark: SIGNATURE

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| CKC HOLDINGS, INC., Petitioner, v. VISA INTERNATIONAL SERVICE ASSOCIATION, Registrant. | MOTION TO DISMISS Cancellation No. 92044540 |
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Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO DISMISS

The Registrant, Visa International Service Association, the owner of Registration No. 2,350,558 (VISA SIGNATURE), hereby moves this Board for an order dismissing the Petition for Cancellation filed by Petitioner CKC Holdings, Inc. on the ground that CKC Holdings¹ waived its right to challenge the registration at issue by failing to timely

¹ By its petition, CKC Holdings is also known as CKC Communications, LLC). *See* Petition for Cancellation (introductory paragraph).

file a compulsory counterclaim attacking the same registration in Opposition No. 91,164,506—in which this same registration was asserted against CKC Holdings.

This Motion is based on the following Memorandum of Points and Authorities in support hereof, the complete files and records of Opposition No. 91,164,506, and the complete files and records of this cancellation action.

MEMORANDUM OF POINTS AND AUTHORITIES

Under Trademark Rule 2.114(b)(2)(i), in an opposition where a registration is pleaded as a basis for the opposition, the opposition defendant's attack of the validity of that registration is a *compulsory* counterclaim that must be filed with or as part of the answer to the opposition.² Failure to file the compulsory counterclaim waives the right to challenge that registration³; and it is the basis for dismissing this petition for cancellation.

CKC Holdings and Visa International are also before the Board in an opposition proceeding, Opposition No. 91,164,506, in which Visa International has opposed Petitioner's Application Serial No. 78/278,841 for the mark SIGNATURE and Design. In that opposition proceeding, CKC Holdings submitted its Answer on or about April 22, 2005.⁴ Petitioner did not file a counterclaim with or as part of its Answer.⁵

² Trademark Rule 2.114(b)(2)(i) (“If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim *shall* be pleaded with or as part of the answer.” (emphasis supplied)); *see also* TBMP § 313.04.

³ *See* TBMP § 313.04.

⁴ *See* Answer in Opposition No. 91,164,506.

⁵ *See* Opposition No. 91,164,506 (filings on record reflect no counterclaim).

CKC Holdings knew of its purported grounds for attacking the validity of Registration No. 2,350,558 (VISA SIGNATURE) at the time it filed its Answer in Opposition No. 91,164,506. As set forth in its Petition for Cancellation, the grounds for CKC Holdings' Petition for Cancellation are CKC Holdings' concern that its mark, SIGNATURE, may be damaged by the likelihood of confusion supposedly caused by the continued registration of Registration No. 2,350,558 (VISA SIGNATURE), given that CKC Holdings claims an earlier first-use date and priority for its mark.

CKC Holdings filed its Answer in Opposition No. 91,164,506 on or about April 22, 2005. CKC Holdings must necessarily have already known of its first-use date since that date—allegedly “well prior to September 26, 1997”⁶—was well before the date of its Answer. And CKC Holdings certainly knew of Registration No. 2,350,558 (VISA SIGNATURE) at the time it filed its answer, since that mark was asserted against it in the Opposition. Accordingly, CKC Holdings knew of all of the grounds for its attack on the validity of Registration No. 2,350,558 (VISA SIGNATURE) in its current Petition for Cancellation at the time of its Answer in Opposition No. 91,164,506.

Therefore, CKC Holdings' attack on the validity of Registration No. 2,350,558 (VISA SIGNATURE) was a compulsory counterclaim in Opposition No. 91,164,506. By failing to file the compulsory counterclaim, CKC Holdings has waived all rights to challenge Registration No. 2,350,558 (VISA SIGNATURE).

⁶ See Petition for Cancellation ¶ 9.

Accordingly, Petitioner's Petition for Cancellation should be dismissed on the grounds that the substance of its Petition for Cancellation was a compulsory counterclaim in Opposition No. 91164506 and has not been timely asserted; and Visa International respectfully asks the Board to dismiss this cancellation proceeding.

Respectfully submitted,

Visa International Service Association

Dated: July 5, 2005

By: /GarnerKWeng/
Garner K. Weng
Attorney for Registrant
Visa International Service Association

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PROOF OF SERVICE

I, Pam Rolph, declare that I am a resident of the State of California. I am over the age of 18 years and not a party to the action entitled

CKC HOLDINGS, INC., Petitioner,
v.
VISA INTERNATIONAL SERVICE ASSOCIATION, Registrant

Cancellation No. 92044540;

that my business address is 333 Market Street, 21st Floor, San Francisco, California 94105-2173. On July 5, 2005, I served a true and accurate copy of the document(s) entitled:

MOTION TO DISMISS

on the party(ies) in this action by placing said copy(ies) in a sealed envelope, each addressed to the last address(es) given by the party(ies) as follows:

Michael M. Amir, Esq. Attorney for CKC HOLDINGS, INC.,
Doll & Amir LLP Petitioner
1888 Century Park East, Suite 1106
Los Angeles, CA 90067

(By First Class Mail pursuant to Code of Civil Procedure section 1013.) I am readily familiar with Hanson Bridgett Marcus Vlahos & Rudy, LLP's practices for collecting and processing documents for mailing with United States Postal Service. Following these ordinary business practices, I placed the above referenced sealed envelope(s) for collection and mailing with the United States Postal Service on the date listed herein at 333 Market Street, 21st Floor, San Francisco, California 94105-2173. The above referenced sealed envelope(s) will be deposited with the United States Postal Service on the date listed herein in the ordinary course of business.

(By Express Mail pursuant to Code of Civil Procedure section 1013.) I deposited each sealed envelope, with the postage prepaid, to be delivered via _____ to the party(ies) so designated on the service list.

(By Telecopy Fax pursuant to Code of Civil Procedure section 1013.) I am readily familiar with Hanson Bridgett Marcus Vlahos & Rudy, LLP's practice for processing of documents via Telefax. Following these ordinary business practices, I directed that the above referenced documents(s) be placed in the Telefax machine, with all costs of Telefaxing prepaid, directed to each of the party(ies) listed on the attached service list using the last Telefax numbers(s) given by the party(ies), and processed through the Telefax equipment, until a report is provided by that equipment indicating that the Telefax operation was successful. A copy of the Telefax report indicating successful transmission is attached hereto.

I declare that I am employed in the office of a member of the Bar of the State of California at whose direction the service was made.

/PamRolph/
Pam Rolph