

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



GLENN DANZIG,)
)
)
 Petitioner,)
)
 v.)
)
 CYCLOPIAN MUSIC, INC.,)
)
)
 Registrant.)

02-09-2006

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Cancellation No. 92045173 76.138, 226
Reg. Nos. 2793533, 2634215,
2735848

REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO MOTION TO DISMISS

Registrant Cyclopien Music, Inc. ("Registrant") submits this Reply to
Petitioner Glenn Danzig's ("Petitioner") Opposition to Registrant's Motion to Dismiss
("Opposition").

As explained in Registrant's Motion to Dismiss, the Petition for
Cancellation must be dismissed pursuant to Fed.R.Civ.P. 12(b)(6) because Petitioner's
claims for fraud and lack of exclusive ownership are fatally defective as a matter of law.
Nothing contained in Petitioner's Opposition compels a different conclusion.

Most significantly, Petitioner's Opposition effectively admits that he is not
using, and never has used, the MISFITS marks in commerce in connection with the
goods and services covered by the registrations at issue. Indeed, Petitioner remarkably
claims that such use is unnecessary and irrelevant in light of the 1994 Settlement

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Agreement. Yet even assuming *arguendo* the Settlement Agreement granted to Petitioner the rights he claims, it is well established that trademark rights “can only be perfected by use.” See *Oklahoma Beverage Co. v. Dr. Pepper Love Bottling Co.*, 565 F.2d 629, 631 (10th Cir. 1977). Accordingly, the Settlement Agreement alone without bona fide use of the marks in commerce could not and does not give Petitioner rights in the MISFITS marks.

With regard to such actual use, Petitioner’s Opposition asserts—albeit defectively without proper pleading in his Petition for Cancellation—specific use of the marks only on “t-shirts” and “apparel”—goods which are not covered by the registrations at issue.¹ The pleadings are devoid of any allegation that Petitioner has any claim of rights to the marks in connection with the goods and services covered by the registrations at issue. Thus contrary to the core principal of trademark law that “[t]rademark ownership inures to the legal entity who is in fact using the mark as a symbol of origin for the identified goods and services,” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 16:35 (4th ed. 2005), Petitioner claims “co-ownership of the MISFITS marks” in the admitted absence of such use. Such a position is untenable, indeed bordering on frivolous. In the absence of a cognizable basis for Petitioner to contest Registrant’s registrations, the Petition for Cancellation must be dismissed as a matter of law.

Petitioner’s Opposition also belatedly attempts to cure his fundamentally deficient allegations of fraud by purporting to now set forth the alleged time, place and

¹ In addition, Petitioner’s Opposition vaguely and generally alleges use on “other merchandise, which [is] included in the goods and services recited in the registrations.” Such a nebulous allegation is plainly inadequate to establish any relevant use of the marks.

content of the false representation, the alleged fact misrepresented, and what was allegedly obtained as a consequence. Procedurally, even if this new and additional information were sufficient to satisfy Petitioner's pleading requirements—which it is not—such information must be alleged in the Petition for Cancellation to satisfy the pleading requirements of Federal Rule of Civil Procedure 9(b). See e.g., *Car Carriers, Inc. v. Ford Motor Co.*, 745 F.2d 1101, 1107 (7th Cir. 1984) (“[I]t is axiomatic that the complaint may not be amended by the briefs in opposition to a motion to dismiss. . . . Thus, it may have been questionable for the district court to have relied on the plaintiffs’ briefs to embellish the conclusory allegations in the complaint.”); *Colonial Ltd. P’ship Litig. v. Colonial Equities Corp.*, 854 F. Supp. 64, 79 (D. Conn. 1994) (“Allegations made outside of the complaint are not properly before the court on a motion to dismiss.”) Contrary to Petitioner’s unfounded assertion, the requisite elements of fraud plainly are not “included in the Petition.” Indeed, had they properly been pled, Petitioner simply would have cited to such allegations as opposed to supplementing and amplifying his fraud claim through one and one-half additional pages of briefing.

Substantively, moreover, the additional information asserted for the first time in Petitioner’s Opposition still does not come close to curing Petitioner’s defective fraud claim. In particular, there is no specific allegation, or any specific facts from which it could be inferred, that Registrant knew its declaration to be untrue. See *Metro Traffic Control v. Shadow Network Inc.*, 41 U.S.P.Q.2d 1369, 1373 (Fed. Cir. 1997); *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 212 U.S.P.Q. 801, 803 (C.C.P.A. 1981). Petitioner similarly has made no attempt to satisfy the specific pleading standards set forth in *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 1999), for

claims—as asserted by Petitioner here—that Registrant fraudulently signed the declaration because there was another legitimate use of the mark at the time the declaration was signed. See Motion to Dismiss at 5-6.

For the foregoing reasons and for the reasons stated in Registrant's Motion to Dismiss, the Petition to Cancel should be dismissed in its entirety with prejudice for failure to state a claim upon which relief can be granted.

February 7, 2006

Respectfully submitted,



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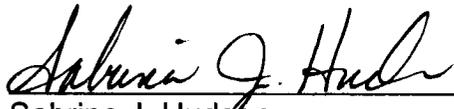
Attorneys for Registrant

Cyclopiian Music, Inc.

Certificate of Service

I certify that a copy of the foregoing Registrant's Reply to Petitioner's Opposition to Motion to Dismiss was served by U.S. first-class mail on February 7, 2006, on the following counsel of record for Petitioner Glenn Danzig:

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