

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

By: Anne C. Martin
Name: Anne C. Martin
Date: February 20, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Jack Richeson & Co., Inc.,)
)
Petitioner,)
)
v.)
)
Select Export Corp. dba Trident,)
)
Registrant.)
)
Attorney Ref. No. 002763-060801)

76078278
Cancellation No. 92048118
Reg. No. 2,619,642

**PETITIONER'S REPLY TO REGISTRANT'S RESPONSE TO ITS
MOTION FOR SUMMARY JUDGMENT AND FOR
SUSPENSION OF PROCEEDINGS**

In its Response, Select Export Corp. dba Trident (hereinafter "Registrant"), asks the Board to grant it summary judgment against, or deny the requested summary judgment to, Jack Richeson & Co., Inc. (hereinafter "Petitioner") based upon three grounds, none of which are sufficiently supported by the facts and the law.¹

First, Registrant argues Petitioner is without standing in relation to the mark at issue because the assignment upon which it bases standing is in gross and void. This is despite the fact the Board has already recognized Petitioner as having standing in its earlier ruling on Registrant's motion for summary judgment, dated November 4, 2008. In that decision,

¹ Several times in its filing, instead of asking the Court to deny Petitioner's motion, Registrant asks for summary judgment on its behalf. Respectfully, that is an inappropriate request as Registrant has not filed a motion for summary judgment pursuant to Trademark Rule 2.127 and Rule 56 of the Federal Rules of Civil Procedure.

the Board referred to Trident Industria De Precisao Ltda. ("Trident S/A") throughout as Petitioner's predecessor-in-interest. (See pages 5, 8, 10). Moreover, if Registrant had a legitimate concern regarding the validity of Petitioner's assignment with Trident S/A, it should have been raised in its summary judgment motion when claim preclusion based upon Trident S/A's prior actions was at issue. Registrant does not have an adequate basis to challenge Petitioner's standing as an assignee, and Petitioner is a true predecessor-in-interest to Registrant in relation to the TRIDENT Design & mark registration.

Registrant also asserts, in its response, that it was not a distributor for Trident S/A based solely upon a May 1991 letter signed by an individual named Julio Cesar Aguirre and the testimony of its principals. (See Response, Castandeda Decl., Exh. C). As evidenced by the declaration of Domingos Zanocco, filed in conjunction with this reply, the May 1991 document, if authentic, was not authorized by Trident S/A, was not among Trident S/A's business records, and is not true. (See Zanocco Decl. ¶¶ 4-5). Moreover, the serious credibility problems created by Registrant's principals' allegations and sworn testimony in this case make their word insufficient to create a legitimate factual dispute. Registrant cannot rely upon the May 1991 letter, or its own untrustworthy testimony, to support its position it was not a distributor for Trident S/A but rather is the owner of the TRIDENT Design & mark registration.

Finally, Registrant argues that it actually owns the TRIDENT Design & mark registration despite the fact the only believable evidence regarding its origin and use is otherwise. Registrant has shown a complete lack of candor and outright dishonesty regarding the creation of the TRIDENT Design & mark. It has claimed that Registrant began using the TRIDENT Design & mark in 1988, which was created by its owner. (See,

Response to Registrant's Summary Judgment Motion, Martin Affid. ¶2, Exh. A). This is despite Trident S/A's documented use of the mark, which it created, back to 1977 in its catalogues, and its 1972 trademark of the mark in Brazil. (See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶¶ 2-3, Exh. A, B). Finally, on this subject, Registrant cannot expect the Board to adopt its explanation for a generic invoice when the explanation is contrary to the evidence of earlier use and ownership by Trident S/A, Petitioner's predecessor-in-interest.

1. The Assignment.

Trident S/A assigned Petitioner its rights in the TRIDENT & Design mark in the United States, which assignment was attached to Petitioner's motion. (See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶ 23, Exh. M.; Richeson Affid. ¶ 7). The assignment resulted from a business relationship that originated in 1999 and continues to date. (See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶¶ 12-15; Richeson Affid. ¶¶ 4-5).

Petitioner has not denied – and indeed submitted evidence from Mr. Segato with Trident S/A – that Trident S/A is a member of National Art Materials Trade Association (“NAMTA”), the leading U.S. based industry organization for art equipment manufacturers and sellers. (See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶ 6). This fact does not, however, support Registrant's position that the assignment is invalid.

It is a well established principle, both at common law and under Section 10 of the Trademark Act, 15 U.S.C. §1060, that a trademark cannot be sold or assigned apart from the good will it symbolizes. *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 107 F.2d 699, 43 USPQ 262 (10th Cir. 1939); *Warner-Lambert Pharmaceutical Co. v. General Foods Corp.*, 164

USPQ 532 (TTAB 1970). The sale of a trademark apart from its good will is an “assignment in gross” and such an assignment confers no rights on the assignee. *See McCarthy on Trademarks and Unfair Competition* (4th ed. 1997), Sections 18.2, 18.3. In this case, Registrant complains, essentially, that the assignment from Trident S/A to Petitioner did not involve the transfer of any assets and that as a consequence the assignment constitutes a “naked” transfer of the trademark to Petitioner, which is invalid as an assignment in gross. Registrant, however, is incorrect.

It is not necessary to the continuing validity of the mark that tangible assets of the assignor pass to the assignee. The court stated the following in *VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649 (Fed. Cir. 1982), *cert. denied*, 464 U.S. 826, 78 L. Ed. 2d 104, 104 S. Ct. 98, 220 USPQ 385 (1983):

The key objective of the law of trademarks is protection of the consumer against being misled or confused as to the source of the goods or services he acquired. The rule against assignment of a mark in gross thus reflects the need, if consumers are not to be misled from established associations with the mark that it continues to be associated with the same or similar products after the assignment. (Citation omitted.)

See also, The Money Store v. Harriscorp Finance, Inc., 689 F.2d 666, 216 USPQ 11 (7th Cir. 1982), and cases cited therein. In this case, the assigned mark is used in connection with essentially the same goods. While the goods are not identical (i.e. Petitioner does not sell all of the goods that Trident S/A sells), the transfer of good will does not require that the goods of assignor and assignee be identical. It is only necessary that they be sufficiently similar to prevent consumers of the goods under the mark from being “misled from established associations with the mark.” *VISA U.S.A., Inc., supra*. Petitioner, Registrant and Trident S/A are all past or present members of NAMTA. Membership in NAMTA is limited to those who provide business services to the art materials or creative industry. (See attached excerpt from

NAMTA website). Clearly, the assignment from Trident S/A to Petitioner is not an assignment in gross. Rather, the record does not establish that it is other than a valid assignment of the trademark and the good will associated therewith.

Registrant asserts that Trident S/A's continued use of TRIDENT & Design in the United States somehow prevents the transfer of "good will" to Petitioner and, as a consequence, renders the assignment to Petitioner of TRIDENT & Design in the United States void. Registrant does not specify the goods that Trident S/A is selling in the United States that bear TRIDENT & Design; however, whatever they are they fall outside the scope of the assignment from Trident S/A to Petitioner.

2. Registrant's Credibility Problems.

Registrant has contradicted itself and made incredible assertions to this Board that precludes it from successfully being able to rely upon its principals' testimony to create material facts of dispute. The self-serving declarations submitted – attempting to provide validity and back up to documents whose origin and meaning are far from clear – cannot in and of themselves be used to preclude summary judgment.

The most glaring example of this lack of candor, and outright dishonesty, with the Board regards the testimony about the origin and creation of the TRIDENT & Design mark. Registrant claims, through its admission responses, that its owner "conceived" of the mark "through his own individual brainstorming thoughts. . .from his personal knowledge of the mythic legends Poseidon and Neptune." (See, Response to Registrant's Summary Judgment Motion, Martin Affid. ¶ 2, Exh. A). This is despite the fact the earliest the parties recall a business relationship was in the 1980's, and Trident S/A had been using the TRIDENT & Design mark since at least 1972, when it first trademarked it in Brazil, and used it on catalogues starting at least in 1977.

(See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶ 3, Exh. A, B).² Registrant had tried to pressure NAMTA to revoke Trident S/A's membership based upon alleged infringement in 2005, at which time NAMTA clearly informed Registrant it did not have a position on the issue of ownership, recognizing Trident S/A might be the senior user of the mark. (See, Response to Registrant's Summary Judgment Motion, Martin Affid. C).

Registrant claims the May 1991 letter that appears to be signed by Mr. Aguirre, purportedly of Trident S/A, is conclusive evidence it did not have a distributor relationship with Trident S/A rather than ownership of the TRIDENT & Design mark. The circumstances regarding the letter are explained by Registrant's principals themselves, the very ones who have made the ludicrous assertions regarding creation of the mark discussed above. Petitioner has submitted current, authoritative evidence from a Director of Trident S/A, providing clarity regarding Mr. Aguirre's former relationship with Trident S/A. Domingos Zanocco explains that Mr. Aguirre was an independent sales representative of Trident S/A, was never an employee of Trident S/A and had no authorization to sign legal documents on behalf of Trident S/A. Further, that even though the May 1991 letter is addressed to him (Mr. Zanocco), he has never seen it, does not believe it among Trident S/A's files, and reiterates that Mr. Aguirre would not have been authorized to sign that document on behalf of Trident S/A in May of 1991, or any other time. (See Zanocco Decl. ¶¶ 3-4).

The same credibility concerns regard the 1996 invoice Registrant claims was the sale of art work including the TRIDENT & Design mark to Trident S/A. If Trident S/A had been using the mark since at least 1972, had it trademarked in three countries, and was a member of NAMTA based upon its use of the mark with 1981, why would it need to purchase artwork

² It has since been trademarked in other South American countries, and is used by Trident S/A in other countries. (See, Response to Registrant's Summary Judgment Motion, Segato Affid. ¶ 4, Exh. C; Exh. 1).

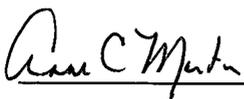
regarding it from Registrant in 1996? It defies logic such a transaction occurred at that time, or that Registrant can base its claims of ownership of the TRIDENT & Design mark upon such a generic invoice.

Registrant would no doubt argue it has created material disputes of fact that preclude summary judgment on the distributor issue. Petitioner implores the Board to carefully consider, however, the lack of candor or credibility Registrant has given the incredible assertions regarding the creation and ownership of the TRIDENT & Design mark. If it does, there is no reasonable conclusion but that Registrant's "evidence" regarding the distributorship relationship should be disregarded, and the overwhelming, credible evidence otherwise is that such was the relationship between the parties, and Registrant cannot claim otherwise.

3. Conclusion

Registrant has not effectively defeated Petitioner as to any of these issues, and in addition to this reply, Petitioner reiterates the points it raised in its motion and asks the Board to grant it summary judgment as a matter of law and cancel the Registrant's TRIDENT Design & Mark.

Jack Richeson & Co., Inc.

By:  _____

Name: Paul W. Kruse & Anne C. Martin

Title: Attorneys

Date: February 20, 2009

Submitted by:

Bone McAllester Norton, PLLC
511 Union Street
Suite 1600
Nashville, Tennessee 37219

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was served on Registrant's attorney, Cheryl Meide with an address at Meide Law Firm, P.A., Corners at Deerwood 7545 Centurion Parkway, Suite 201, Jacksonville, Florida 32256, via first class mail, postage prepaid, today February 20, 2009.

By:

Alan C. Martini

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Jack Richeson & Co., Inc.,)	
)	
Petitioner,)	
)	Cancellation No. 92048118
v.)	
)	Reg. No. 2,619,642
Select Export Corp. dba Trident,)	
)	
Registrant.)	
)	
Attorney Ref. No. 002763-060801)	

DECLARATION OF DOMINGOS ZANOCCO

Domingos Zanocco declares as follows:

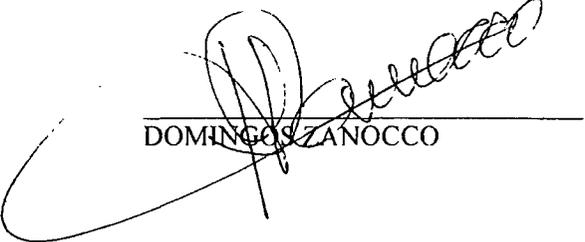
1. My name is Domingos Zanocco. I am a resident of the City of Jaú in Brazil. My native language is Portuguese. I am providing this declaration based upon my personal knowledge, and believe that I understand what I am signing, despite English being a second language to me.

2. Trident Indústria De Precisão Ltda. ("Trident S/A") is a Brazilian company with which I have been associated since October 1980. My title is Director and my responsibilities include the management of factory production. As such, I am a member of the executive management team for the company.

3. In May of 1991, Julio Cesar Aguirre was an independent sales representative of Trident S/A, as well as other companies in the art supplies industry. My recollection is that he also was a representative for Carbono Hellios, Acrilex as well as Tigre brush, a well known South American brush company. Mr. Aguirre was never an employee of Trident S/A and had no authorization to sign legal documents on behalf of Trident S/A. Upon information and belief, Mr. Aguirre is deceased.

4. I have reviewed the document dated May 1991 and attached to the declaration of Herbert Moebius Castaneda as part of the Respondent's Response to the Petitioner's Motion for Summary Judgment. I have never seen that document before and I do not believe it among Trident S/A's files. Mr. Aguirre would not have been authorized to sign that document on behalf of Trident S/A in May of 1991, or any other time. I disagree with the statement therein that the Respondent was not a distributor of Trident S/A.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.



DOMINGO ZANOCCO

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Membership Categories and Criteria

Join NAMTA

In order to join NAMTA, potential members must apply under one of the following membership categories. NAMTA membership categories are divided by primary purpose of business. Members may only be listed under one category, even though some may fall under many. Please read each category carefully to ensure you are joining under the proper designation. Refer questions on membership categories to membership@namta.org.

Associate: An individual, partnership, firm or corporation providing business services to the art materials or creative industry. Associate members may be eligible to exhibit at NAMTA's annual convention and trade show.

Branch: A subsidiary of a NAMTA member company. Branch members will receive a separate listing in the annual Who's Who Directory and online directory, receive all NAMTA mailings and are entitled to attend NAMTA functions as the board of directors may designate, including, but not limited to, the annual convention, affairs or meetings.

Distributor: An individual, partnership, firm or corporation that purchases from multiple suppliers and product categories; warehouses, promotes and ships product to retailers for resale; and does not sell to the general public. Distributors are eligible to exhibit at NAMTA's annual convention and trade show.

Importer: An individual, partnership, firm or corporation that imports artist products and materials from foreign countries and maintains a substantial merchandise inventory for the purpose of resale to distributors, jobbers and retailers. Importers are eligible to exhibit at NAMTA's annual convention and trade show.

Manufacturer: An individual, partnership, firm or corporation that manufactures or creates the art materials and/or products it sells or distributes through established channels. Manufacturers are eligible to exhibit at NAMTA's annual convention and

trade show.

Manufacturer's Representative: An independent contractor, individual or firm who sells the art materials and products of one or more manufacturers or distributors. Manufacturer's Representatives are eligible to work their client's booths at NAMTA's annual convention and trade show.

Publisher: An individual, partnership, firm or corporation that prints or publishes magazines, books or trade papers whose subject matter deals with art materials. Publishers are eligible to exhibit at NAMTA's annual convention and trade show.

Reciprocal: A collaborative industry association. NAMTA uses these partnerships for information sharing purposes. Reciprocal members may be eligible to exhibit at NAMTA's annual convention and trade show.

Retailer: An individual, partnership, firm or corporation maintaining a store or similar physical establishment, purchasing and maintaining an inventory of a substantial and diverse line of art materials for the purpose of resale to consumers and, where required by law, has secured an appropriate resale license or certificate. Retailers are eligible to attend, not exhibit, at NAMTA's annual convention and trade show.

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