

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

78750911

In the matter of trademark Registration No.: **3,157,991**

For the mark: **FAMILY WATCHDOG**

Registration Date: **October 17, 2006**

**TTAB**

<b>Lester H. Schweiss (a/k/a Chip Schweiss)</b>	)	Cancellation No.: 92,048,699
	)	
Petitioner,	)	
	)	Registration No. 3,157,991
v.	)	Date of issue: Oct 17, 2006
	)	
<b>Family Watchdog LLC</b>	)	
	)	
Registrant	)	

**MOTION TO DISMISS PETITION TO CANCEL**

Pursuant to 37 C.F.R § 2.116(a) and Rule 12(b)(6) F.R.Civ.P., Registrant moves to dismiss the above captioned proceeding for failure to state a claim upon which relief may be granted.

Substantively, in its Petition to Cancel Petitioner avers:

- a. Petitioner is a Citizen of the United States located and doing business in the state of Missouri (opening unnumbered paragraph).
- b. Registrant is the owner of the mark **FAMILY WATCHDOG** for “security services, namely, a sexual offender, crime, and criminal registry, search, and notification service” (paragraph 1).
- c. Registrant’s registration was issued on the Principal Register on October 17, 2006 (paragraph 2).



**02-19-2008**

- d. Registrant filed its Trademark Application on November 9, 2005 (paragraph 3).
- e. Petitioner used FAMILY WATCHDOG and FAMILYWATCHDOG.COM prior to both Registrant's application filing date and first use date listed in the registration.
- f. Petitioner is damaged because Registrant protected its valuable trademark pursuant to 15 U.S.C §1125(d).
- g. Registrant committed fraud in the completion of its trademark application.

Petitioner alleges its priority of use is based upon the following:

- a. On an unspecified date in 2004 or 2005 Petitioner chose the name FAMILY WATCHDOG for use in connection with the offering of products and services related to home computers, inter alia (paragraph 5).
- b. On January 7, 2005 Petitioner registered the domain names [www.familywatchdog.com](http://www.familywatchdog.com), [www.familywatchdog.net](http://www.familywatchdog.net), and [www.familywatchdog.org](http://www.familywatchdog.org) (paragraph 6).
- c. On an unspecified date in February 2005 Petitioner printed marketing and informational materials and handed them out to the general public at a business expo in the St. Louis, Missouri metropolitan area (paragraph 7).
- d. On an unspecified date in February 2005 Petitioner's web site went live (paragraph 8).

The pleading requirements for a valid Petition to Cancel require a "short and plain statement" showing standing and the grounds upon which petitioner relies. A petitioner's right or standing to bring a cancellation proceeding flows from the requirements of

Section 14 (15 U.S.C §1064) that a petitioner believes that it would be damaged by the continued registration of the mark. The valid ground that must be alleged and ultimately proven by a petitioner must be a statutory ground which negates the registrant's right to the registration of the mark. Standing and grounds are separate elements, and the petition must provide enough detail to provide the registrant fair notice of each. Young v. AGB Corp., 47 U.S.P.Q.2d 1752 (Fed Cir., 1998), citing Lipton Industries, Inc. v. Ralston Purina Co., 213 U.S.P.Q. 185 (CCPA 1982).

A petitioner seeking to cancel a registration under Section 2(d) [15 U.S.C. § 1052(b)] must prove it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion of source, whether by ownership of registration, prior use of a technical trademark, prior use in advertising, prior use of a trade name, or whatever type of use may have developed a trade identity. Otto Roth & Co., Inc. v. Universal Foods Corp., 209 U.S.P.Q. 40 (CCPA 1981); Miller Brewing Co. v. Anheuser-Busch Inc., 27 U.S.P.Q. 2d 1741 (TTAB 1993).

Petitioner alleges it chose a name some time in 2004 or early 2005. Petitioner's allegation does not indicate how it intended to use this name. Petitioner does not allege it informed anyone of its decision or sought or took any steps to protect its chosen name, such as by filing to organize, registering an intent to use application under state or federal statute, or by any other method requesting any protection for its allegedly chosen name. Keeping this information secret did not create an effective first use of a mark. Lucent Information Management v. Lucent Technologies, 186 F.3d 311, 51 USPQ2d 1545 (3d Cir. 1999).

Petitioner alleges it registered the domain names www.familywatchdog.com, www.familywatchdog.net, www.familywatchdog.org on January 7, 2005. Registering a domain name generates no commercial use or trademark protection. Panavision International, L.P. v. Toeppen, 945 F. Supp. 1296, 1303 (C.D. Cal. 1996) citing Academy of Motion Picture Arts & Sciences v. Network Solutions, Inc., 989 F. Supp. 1276, 1997 U.S. Dist. LEXIS 20806, 1997 WL 810472 (C.D. Cal. 1997) and Lockheed Martin Corp. v. Network Solutions, Inc., 985 F. Supp. 949 (C.D. Cal. 1997).

Petitioner's allegation that its web site "went live" in February 2005 does not establish use. Petitioner does not allege it offered any goods or services on its website, used its web site in intrastate or interstate commerce, or advertised or otherwise generated public awareness to sufficiently identify source in any segment of the consuming public. Lucent Information Management v. Lucent Technologies, 186 F.3d 311, 51 USPQ2d 1545 (3d Cir. 1999).

Petitioner's allegation that on an unspecified date in February 2005 it printed an undefined number of marketing and informational materials and handed them out to unidentified people at an unnamed business expo at an undisclosed location in the St. Louis, Missouri metropolitan area does not establish use of the mark. Petitioner's allegation fails to detail whether these were potential consumers, if the material generated any sales, or otherwise give any information to believe this was sufficiently public to identify source in an appropriate segment of the public mind. Lucent Information Management v. Lucent Technologies, 186 F.3d 311, 51 USPQ2d 1545 (3d Cir. 1999).

Nowhere does Petitioner allege actual intrastate or interstate offering of goods or services at any time. Petitioner does not allege any protectable rights to the term

FAMILY WATCHDOG based upon actual use. The right to a particular mark grows out of its use, not its mere adoption. *United Drug Co. v. Theodore Rectamus, Co.*, 248 U.S. 90, 97 (1918). Therefore, the pleading is fatally deficient on its face.

Petitioner's asserts its priority use date and trademark protection for the terms FAMILY WATCHDOG and FAMILYWATCHDOG.COM are based on two events; creating a web site and attending a single business expo some three years ago. Petitioner's allegations are insufficient to demonstrate that Petitioner is currently using or has ever used the terms FAMILY WATCHDOG or FAMILYWATCHDOG.COM in a manner sufficient to sustain its Petition to Cancel. Petitioner alleges nothing more than it registered some domain names and infers it might have intended to use the terms FAMILY WATCHDOG and FAMILYWATCHDOG.COM earlier than the date Registrant perfected its rights to the mark **FAMILY WATCHDOG**. Petitioner does not allege it ever carried through on its supposed intent. Trademark rights are not conveyed through mere intent to use a mark commercially; rather, the mark must be continuously used in order to maintain its trademark protection. *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 595 F.2d 1200 (9th Cir. 1999).

Absent any alleged use establishing trademark rights to the term FAMILY WATCHDOG, Petitioner's allegation that Petitioner is damaged because Registrant protected its valuable trademark pursuant to 15 U.S.C §1125(d) and Registrant committed fraud in the completion of its trademark application amount to nothing more than bald assertions.

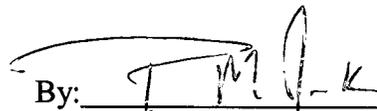
The Petition to Cancel fails to plead any statutory basis or any facts relevant to a statutory ground negating Registrant's continued right of ownership to Registration No.

3,157,991. Petitioner further has pleaded no facts to establish its standing. Therefore, the Petition to cancel should be dismissed for failure to state a claim upon which relief may be granted. *Young v. AGB Corp., supra.*

WHEREFORE, Registrant respectfully seeks an order from the Board dismissing this Petition to Cancel for failure to state a claim upon which relief may be granted.

Respectfully submitted,

Dated: February 15, 2008

By: 

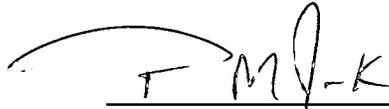
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Paul E. McJunkin, Chief Financial Officer  
Family Watchdog LLC  
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Suite 18-352  
Carmel, Indiana 46033  
Tel: (949) 209-8768

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **MOTION TO DISMISS PETITION TO CANCEL** has been served on February 15, 2008 by first class mail to:

Annette P. Heller and Morris E. Turek  
Heller and Associates  
14323 S. Outer Fourty Dr., Suite 512 S  
Town and Country, MO 63017

A handwritten signature in black ink, appearing to read 'P. McJunkin', with a horizontal line drawn underneath it.

Paul E. McJunkin, Chief Financial Officer  
Family Watchdog LLC  
1950 East Greyhound Pass  
Suite 18-352  
Carmel, Indiana 46033  
Tel: (949) 209-8768

February 15, 2008

Trademark Assistant Center  
Madison East Building  
Concourse Level, Room 37A  
600 Dulany Street  
Alexandria, VA 22314

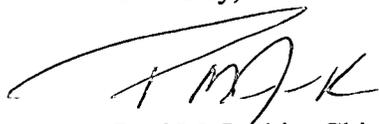
Re: Cancellation No.: 92,048,699  
Registration No. 3,157,991

Trademark Assistant Center:

Enclosed find an original and two copies of Motion to Dismiss Petition to Cancel. Please return one of the file-marked copies using the self-addressed stamped envelope.

Should you have any questions, please contact our office.

Sincerely,

A handwritten signature in black ink, appearing to read 'P. McJunkin', with a long, sweeping horizontal stroke above the name.

Paul McJunkin, Chief Financial Officer  
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