

ESTTA Tracking number: **ESTTA225353**

Filing date: **07/21/2008**

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

Proceeding	92049339
Party	Plaintiff Bitsteam Inc.
Correspondence Address	Thomas M. Saunders Seyfarth Shaw LLP World Trade Center East, Two Seaport Lane, Suite 300 Boston, MA 02210-2028 UNITED STATES bosippto@seyfarth.com
Submission	Opposition/Response to Motion
Filer's Name	Thomas M. Saunders
Filer's e-mail	bosippto@seyfarth.com
Signature	/s/TMS/
Date	07/21/2008
Attachments	motion.PDF (6 pages)(135966 bytes)

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

BITSTREAM, INC.,

Petitioner,

v.

CHARLES ANTHONY BOOKMAN,

Registrant.

Cancellation No. 92049339

Registration No. 2715836

**PETITIONER'S OPPOSITION TO
REGISTRANT'S MOTION TO DISMISS
PETITIONER'S PETITION FOR CANCELLATION
FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED**

INTRODUCTION

The Rule 12(b)(6) motion of registrant Charles Anthony Bookman ("Registrant") to dismiss the Petition for Cancellation filed by Petitioner Bitstream, Inc. ("Petitioner") is frivolous. As shown below, Petitioner has pled the two elements required to seek cancellation of Registrant's mark: standing and a reasonable belief that Petitioner will be damaged by the continued existence of the registration. Petitioner has pled both fraud in the procurement of the registration and abandonment. The basis of the Registrant's Motion to Dismiss appears to be that (1) based on prior litigation, Petitioner is precluded from asserting that there is a likelihood of confusion between the Registrant's and Petitioner's THUNDERHAWK marks, (2) Petitioner has failed to allege valid grounds for Cancellation; and (3) this action is premature in that the Examining Attorney *may not* refuse Petitioner's Application in view of Registrant's Mark. As shown below, the pleadings are sufficient to maintain the proceeding and the allegations of Registrant's Motion are insufficient to result in dismissal.

SUMMARY OF PERTINENT ALLEGATIONS

Petitioner's Petition for Cancellation (the "Petition") pleads facts regarding the Registrant's THUNDERHAWK mark (the "Registered Mark") Registration No. 2,715,836 (the "Registration"), the subject of this cancellation, and Petitioner's Application Serial No. 77/472, 223 for THUNDERHAWK (the "Application") Petition ¶¶ 5, 7. The Petition alleges that the Registered Mark is not now in use and, furthermore, either was never in use or has been abandoned. Petition ¶¶ 8, 12. The Petition further alleges that Registrant's declaration of use in connection with the prosecution of Application Serial No. 78/133,290 was false and made knowingly. Petition ¶¶ 9, 11. The Petition alleges that these false statements constituted fraud upon the Trademark Office. Petition ¶ 10. Finally, the Petition alleges that Petitioner will be damaged thereby. Petition ¶ 13.

ARGUMENT

The standard for determining a motion under Rule 12(b)(6) is well known to the Board and will not be discussed at length. It is sufficient to reiterate that the Petition must be construed in the light most favorable to Petitioner, that all well-pled allegations must be accepted as true, that it is the duty of the Board to examine the Petition in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether the Petition contains any allegations, which, if proved, would entitle Petitioner to the relief sought, and that the Petition may be dismissed only if it appears certain that Petitioner is entitled to no relief under any set of facts that could be proven in support of its claim. TBMP § 503.02. Petitioner's Petition easily passes muster under these standards.

A party seeking cancellation must plead: (1) that it has standing; and (2) that there are valid grounds for canceling the registration. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943,

944 (Fed. Cir. 2000); *Omicron Capital, L.L.C. v. Omicron Capital, L.L.C.*, 433 F. Supp. 2d 382 (S.D.N.Y. 2006). The allegations contained in the Petition clearly meet these requirements.

I.

PETITIONER HAS ADEQUATELY PLED STANDING BY PLEADING BELIEF OF DAMAGE DUE TO CONTINUED REGISTRATION OF THE REGISTERED MARK

As noted, the Petition alleges that Petitioner will be damaged by the continued registration of Registrant's mark. Petition ¶ 13. Registrant's Motion merely alleges that (1) Petitioner is precluded from asserting that there is a likelihood of confusion between the Registered Mark and the mark that is the subject of Petitioner's Application Serial No. 77/472, 223; and (2) the Examining Attorney *may not* refuse Petitioner's Application (Mot. at 2). One or the other of these assertions presumably addresses standing. The allegations in the Petition clearly support a finding that the Petitioner has standing to seek cancellation of the Registered mark, and are not negated by either assertion in Registrant's Motion.

The standing rules are liberal requiring only that the Petitioner have a commercial interest. The relevant provision of the Lanham Act reads, in pertinent part, "[a] petition to cancel . . . may . . . be filed . . . by any person who *believes* that he is *or will be* damaged . . . by the registration. . . ." 15 USC § 1064 (emphasis added). The Federal Circuit has long held "[a]ll that the Lanham Act requires is that the cancellation petitioner plead . . . facts showing a 'real interest' in the proceedings." *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092 (Fed. Cir. 1984). In *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161 (Fed. Cir. 2002), the Court explained this liberal standard stating, "[i]n most settings a direct commercial interest satisfies the 'real interest' test."

Use of the mark in commerce constitutes a direct commercial interest. *Int'l Order of Job's Daughters*, 727 F.2d at 1092 (allegations regarding longtime production and sale of

merchandise deemed sufficient). Petitioner has alleged use of the mark in commerce.

Petition ¶ 3.

Neither the earlier court decision nor the fact that the Examiner has not yet cited the Registered Mark against the Petitioner's Application are relevant to the issue of standing. First, even where there is no likelihood of confusion in the infringement context, there may be a likelihood of confusion in a cancellation context. *See, e.g., Central Mfg. Co. v. Brett*, 78 U.S. P.Q. 2d 1662, 2005 WL 2445898 (N.D. Ill. 2005). This is so because the standard for likelihood of confusion in an infringement matter differs from the likelihood of confusion standard for cancellation. *Id.* In an infringement context, the adjudicating body is seeking to determine whether the marks, as encountered in the market, are likely to cause confusion among consumers. *Id.* In the cancellation context, the concern is whether one mark as used in connection with the goods or services recited in the registration, would be likely to cause confusion with the opposed mark. *Id.* Petitioner is not alleging a likelihood of confusion as grounds for cancellation. Petitioner is alleging that the Examiner may cite the Registered Mark against the Application and, therefore, Petitioner believes it may be damaged by the Registration. Furthermore, the existence of Registrant's fraudulent registration damages the Petitioner as Petitioner uses and seeks to further use the mark in commerce.

Petitioner has properly pled standing to seek cancellation of the Registered Mark. The Petition clearly asserts that the Petitioner has used its THUNDERHAWK mark in commerce since at least as early as 2002. Petition ¶ 3. This use clearly demonstrates that the Petitioner has reason to believe that it is or will be damaged by the continued Registration and, therefore, satisfies the liberal "real interest" standard for standing.

II.

PETITIONER HAS STATED SUFFICIENT GROUNDS FOR CANCELLATION BY ALLEGING: (1) THAT THE REGISTRATION WAS FRAUDULENTLY OBTAINED AND (2) THAT THE REGISTERED MARK HAS BEEN ABANDONED

The final allegation of Registrant's Motion is that Petitioner has not asserted valid grounds for cancellation. Motion at 2. Registrant seems to be arguing that there is no likelihood of confusion and, therefore, no basis for cancellation. Of course, the existence or non-existence of a likelihood of confusion is entirely irrelevant in the current proceeding where Petitioner has not asserted likelihood of confusion as a ground for cancellation. The grounds *actually* pled by Petitioner are that the Registration was fraudulently obtained and that the Registered Mark has been abandoned. Petition ¶ 8 - 12. Fraud and abandonment are legally sufficient grounds for cancellation. TBMP § 309.03(c)(6) at 300-44; 15 U.S.C.A. 1064(3). Registrant cites no authority to the contrary.

CONCLUSION

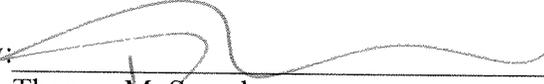
For all of the foregoing reasons, Registrant's motion to dismiss the instant Petition for Cancellation should be denied in its entirety. If the Petition for Cancellation is found to be deficient in any respect, which Petitioner denies, Petitioner requests leave to re-plead pursuant to Fed. R. Civ. P. 15(a) and the authorities set forth in TBMP § 503.03.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: July 21, 2008

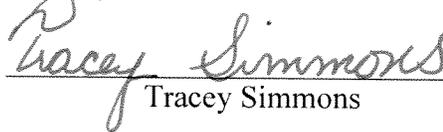
By:


Thomas M. Saunders
Deidré A. Francis
Attorneys for Petitioner
BITSTREAM, INC.

CERTIFICATE OF SERVICE

I hereby certify that on July 21, 2008, I served the foregoing Petitioner's Opposition to Motion to Dismiss Petition for Cancellation for Failure to State a Claim Upon Which Relief Can Be Granted on the Registrant by mailing a copy thereof by First Class Mail, postage prepaid, addressed to Registrant's correspondence address of record as follows:

Charles Anthony Bookman
1085 Commonwealth Avenue, # 273
Boston, MA 02215


Tracey Simmons