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

Proceeding	92051579
Party	Defendant Commercial Furniture Group, Inc. (by merger with Howe Furniture Corporation)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HUMANSCALE CORPORATION	)	Cancellation No. 92051579
	)	
Petitioner,	)	Trademark: DIFFRIENT
	)	
v.	)	Reg. No.: 1,632,391
	)	
HOWE FURNITURE CORPORATION	)	
	)	
Respondent.	)	

**COMBINED MOTION TO DISMISS AND MEMORANDUM IN SUPPORT THEREOF**

COMES NOW Respondent Commercial Furniture Group, Inc. (the successor in interest to Howe Furniture Corporation’s ownership of and rights in the subject registration) (“Commercial Furniture”), by and through the undersigned counsel, and, pursuant to Rule 12(b) of the Federal Rules of Civil Procedure and TBMP § 503, hereby respectfully moves to dismiss the Petition for Cancellation of Trademark Registration No. 1,632,391 on the basis that Petitioner Humanscale Corporation (“Humanscale”) has failed to plead facts establishing that it has standing to assert the purported basis for the cancellation.

**INTRODUCTION**

Commercial Furniture’s predecessor registered its trademark DIFFRIENT (the “Mark”) on January 22, 1991. Until now, no one has objected to Commercial Furniture and its predecessor’s adoption, use and/or registration of the Mark, including specifically ergonomic furniture designer Niels Diffrient. In fact, Humanscale does not dispute that twenty-three (23) years ago Mr. Diffrient authorized Commercial Furniture’s adoption and use of its Mark as part of a business relationship that continues to this day. (See Petition for Cancellation, ¶ 3.)

Now, eighteen (18) years after the registration issued, Humanscale seeks to cancel it on the sole basis that the registration consists of Mr. Diffrient's surname in violation of 15 U.S.C. § 1052(c). Even assuming as true Humanscale's claim that Mr. Diffrient did not authorize registration of the Mark – a claim which is disputed – fatally, Humanscale does not and cannot allege that it “stands in the shoes” of Mr. Diffrient in asserting what would be a *personal right* of Mr. Diffrient. Specifically, Humanscale does not and cannot allege that it is authorized to pursue the cancellation on Mr. Diffrient's behalf, that it is in privity with Mr. Diffrient, or that Mr. Diffrient himself objects to the registration that he has been aware of, consented to and/or acquiesced in for more than eighteen (18) years. Since the statute cited as the basis for cancellation is intended to protect a person's right to privacy and right to publicity, only that individual has standing to pursue a cancellation on such basis. As Humanscale cannot rely on Mr. Diffrient's alleged rights, claims that it is but a mere licensee of Mr. Diffrient, and relies on no other basis for seeking cancellation, the Petition must be dismissed.

## **ARGUMENT**

### **A. Standard of Review for Motions to Dismiss.**

“A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint.” TBMP §503.02; Intellimedia Sports, Inc. v. Intellimedia Corporation, 43 U.S.P.Q.2d 1203 (TTAB 1997). “For purposes of such a motion, all well pleaded factual allegations of the complaint are accepted as true and the complaint is viewed in the light most favorable to the non-moving party.” Id. “Accordingly, a motion to dismiss will not be granted unless it appears to a certainty that the plaintiff has failed to allege any facts which would support a cause of action under the statute.” Id.

**B. Humanscale Does Not Have Standing to Assert the Personal Right of Mr. Diffrient.**

Pursuant to 15 U.S.C. § 1052(c), “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.”

Only the party whose name is reflected in a trademark registration (or a party in “privity” with such individual) has standing to challenge the registration pursuant to 15 U.S.C. § 1052(c). A party in a TTAB proceeding “does not have standing to assert damage to itself because of third party rights.” Jones & Laughlin Steel Corporation v. Jones Engineering Co., 292 F.2d 294, 296 (CCPA 1961). “[A] third party has been held to have no standing to invoke the provisions of [§ 1052 (c)], which are designed only to protect the person whose name is in the mark.” McCarthy on Trademarks and Unfair Competition § 13:37 at p. 71 (4<sup>th</sup> ed.) (citing Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc., 26 U.S.P.Q.2d 1378, 1381 (8<sup>th</sup> Cir. 1993)); see also Giuliano Cecceto v. Manifattura Lane Gaetano Marzotto & Figli, 32 U.S.P.Q.2d 1192 (a petitioner who is not in privity with the person whose name is associated with the registered mark “has no standing to vindicate his rights.”). “Section 1052(c) exists to protect the privacy and property interest of the person whom the public will associate with the mark.” Gilbert/Robinson, Inc. at 1381 (finding that, since the petitioner was not in privity with the person whose name consisted of the contested mark, the petitioner had no standing to contest the registration for failure to obtain that person’s consent).

Privity is defined as circumstances in which two parties hold successive interests in the same property or where there is a relationship of “related companies.” TBMP §206.02; International Nutrition Co. v. Horphag Research Ltd., 220 F.3d 1325, 55 U.S.P.Q.2d 1492, 1495 (Fed. Cir. 2000);

Tokaido v. Honda Associates Inc., 179 U.S.P.Q. 861, 862 (TTAB 1973) (no privity when the relationship of the two parties was based on a nonexclusive trademark license).

Here, Humanscale concedes that it is not seeking the cancellation based on its own rights; instead, it erroneously suggests that it is authorized to enforce Mr. Diffrient's personal rights because of an agreement through which Mr. Diffrient consented to Humanscale's registration of his name and granted Humanscale a non-exclusive license with respect to Mr. Diffrient's name as a trademark for particular products. (See Petition for Cancellation, ¶ 1.)

The consent simply states, "I, Neils Diffrient, hereby consent to the use and registration by Humanscale Corporation of the name 'Diffrient World' as a trademark for the following goods: furniture, namely, seating, chairs, and stools."<sup>1</sup> The consent is clearly only a non-exclusive, revocable license to use and register the mark DIFFRIENT WORLD. Conspicuously omitted is any allegation that Mr. Diffrient has authorized Humanscale to enforce his personal right or to challenge this registration.<sup>2</sup> Moreover, there is no suggestion or factual allegation that Humanscale is in privity with Mr. Diffrient. Instead, Humanscale only claims a non-exclusive license of certain trademark rights. Furthermore, it is impossible for Humanscale to overcome this fatal defect through amendment of its petition.

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<sup>1</sup> The Petition for Cancellation, ¶ 1, attempts to "make of record" in this proceeding the purported consent filed by Humanscale in Application Serial No. 77/686,364; however, Humanscale did not make this purported consent an exhibit to its Petition for Cancellation.

<sup>2</sup> Mr. Diffrient's absence as a party in this proceeding suggests that he does not object to the registration. In fact, Commercial Furniture believes that if Mr. Diffrient were aware of or understood the impact of Humanscale's actions, if successful, he would object, and, in any event, Commercial Furniture has substantial defenses to any claim of lack of consent, which defenses are beyond the scope of this Motion, but are in no way waived and are hereby expressly reserved.

Humanscale has clearly failed to plead, and given the personal nature of the right claimed cannot plead, facts that if true would establish its standing to seek cancellation of the registration pursuant to 15 U.S.C. § 1052(c). Therefore, this proceeding must be dismissed with prejudice.

### **CONCLUSION**

WHEREFORE, Respondent prays that the Board (i) enter an order dismissing this proceeding with prejudice and (ii) grant such other and further relief as it deems just and proper.

Dated: December 30, 2009

Respectfully submitted,

/s/ Jason L. Ross

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### **CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the above and foregoing Combined Motion to Dismiss and Memorandum in Support was submitted to the Trademark Trial and Appeal Board electronically via the Internet on December 30, 2009, and was mailed via the United States Postal Service, with postage prepaid, on December 30, 2009, to the following:

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