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

Proceeding	92051579
Party	Plaintiff Humanscale 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)	
vs.)	In the Matter of Trademark
)	Registration No.: 1,632,391
)	
COMMERCIAL FURNITURE GROUP,)	
INC.)	For the Mark: DIFFRIENT
)	
Respondent)	Date of Registration: January 22,
)	1991

**MEMORANDUM IN OPPOSITION
TO RESPONDENT’S MOTION TO DISMISS**

Commercial Furniture Group, Inc.’s (“CFGroup”) motion to dismiss lacks merit and should be denied. Humanscale Corporation (“Humanscale”) has been refused registration of its DIFFRIENT WORLD mark because of Registration No. 1,632,391—a registration obtained by CFGroup without Niels Diffrient’s written consent to register as required by Section 2(c) of the Trademark Act, 15 U.S.C. 1052(c). In contrast, Humanscale has obtained Mr. Diffrient’s written consent to register its DIFFRIENT WORLD mark. Because Humanscale has a proprietary right in the “Diffrient” name, Humanscale is a proper party to enforce the prohibition of registration found in Section 2(c) of the Trademark Act.

1. Factual Background

As set forth in the original Petition for Cancellation, Humanscale applied for the registration of the mark DIFFRIENT WORLD on an intent-to-use basis in International

Class 20 to identify its goods, which include furniture, namely seating, chairs, and stools. The mark consists of the surname of Niels Diffrient, the designer of the DIFFRIENT WORLD product line. In accordance with 15 U.S.C. 1052, Niels Diffrient signed a written consent for Humanscale to register the DIFFRIENT WORLD mark (See Exhibit 1).

On June 2, 2009, Humanscale received an office action in Application No. 77/686364, refusing registration of the DIFFRIENT WORLD mark under Section 2(d) based upon CFGroup's Registration No. 1,632,391 (See Exhibit 2). As a result, Humanscale instituted this cancellation proceeding against Registration No. 1,632,391 on the ground that CFGroup's registration was obtained without Niels Diffrient's written consent to registration as required by 15 U.S.C. 1052(c).

CFGroup seeks to dismiss the cancellation proceeding, arguing that Humanscale, as a non-exclusive licensee, is not in privity with Niels Diffrient and therefore has no standing to vindicate his rights. This argument lacks merit.

2. Humanscale Has Standing to Institute This Action.

A party may establish its standing to petition to cancel by showing that it has a "real interest" in the case; that is, a personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage. See TBMP § 303.03, citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Trademark Trial and Appeal Board Manual of Procedure § 309.03(b) makes it clear that a real interest in the proceeding and a reasonable belief of damage may be found where the plaintiff pleads (and later proves) that he has been refused registration of its mark because of defendant's registration. Because Humanscale's Trademark Application No. 77/686364 has been

denied registration in light of CFGroup's Registration No. 1,632,391, Humanscale has standing to seek cancellation of CFGroup's mark.

CFGroup erroneously characterizes Humanscale's relationship with Niels Diffrient as that of a non-exclusive licensee. It is inconsistent with trademark law for Mr. Diffrient's written consent to be characterized as non-exclusive. The written consent to register the "Diffrient World" mark is inherently an exclusive license with respect to the identified class of goods.

3. Humanscale Has a Proprietary Right in the "Diffrient" Name and Therefore is a Proper Party to Enforce 15 U.S.C. 1052(c) and Cancel CFGroup's Registration.

In *Giuliano Ceccato v. Manifattura Lane Gaetano Marzotto & Figli, S.P.A.*, 32 U.S.P.Q.2d 1192 (Trademark Tr. & App. Bd. 1994), the Board held that a third party's enforcement of the prohibition of registration found in Section 2(c) of the Trademark Act is not an issue of standing. Rather, "an element of the Section 2(c) ground is that the party asserting that ground must have a cognizable or proprietary right in the name." *Id.*

Humanscale clearly has a proprietary right in the "Diffrient" name. Niels Diffrient expressly authorized Humanscale to register its DIFFRIENT WORLD mark. This written authorization establishes Humanscale's proprietary right in both the mark and the "Diffrient" name with respect to the identified class of goods.

4. The Cases Relied Upon by CFGroup are Inapposite to this Proceeding.

In the cases cited by CFGroup in its motion, the third party plaintiffs did not themselves have written authorization to register the marks at issue. Rather, these third party plaintiffs were attempting to use Section 2(c) as a defense to infringement allegations made by the registrant.

For instance, In *Gilbert/Robinson Inc. v. Carrie Beverage-Missouri Inc.*, 989 F.2d 985, 26 USPQ2d 1378, 1381 (8th Cir.1993), the owner of a registration for HOULIHAN'S OLD PLACE sued for trademark infringement. The alleged infringer asserted in a counterclaim that, during the prosecution of its trademark application, the owner misrepresented that the mark was a fictitious name despite the fact that the owner based the mark on the name of the site's previous tenant, Tom Houlihan. The Court found that the alleged infringer failed to prove a cognizable Lanham Act injury because it was not in privity with Tom Houlihan and had no standing to vindicate his rights.

Similarly, in *Giuliano Ceccato v. Manifattura Lane Gaetano Marzotto & Figli*, *supra*, a trademark applicant applying for the mark DUCA D'AREZZO filed a counterclaim to cancel an opposer's registration under Section 2(c) for the mark DUCA D'AOSTA. But, the applicant did not assert any relationship with the individual that it contended was the Duca D'Aosta. The TTAB explained that a reason for requiring the party asserting Section 2(c) to have a cognizable or proprietary right in the name is to prevent a petitioner from scouring telephone directories in order to find a listing for someone whose name is used in the registrant's mark. Thus, the TTAB dismissed the applicant's counterclaim.

Contrary to the foregoing cases, Humanscale has a proprietary interest in the name at issue. Humanscale did not scour telephone directories in order to find a listing for someone whose name is used in the registrant's mark. Rather, Humanscale has a contractual relationship with Mr. Diffrient that authorizes Humanscale not only to use Mr. Diffrient's name as a trademark, but also to register his name as a trademark.

Accordingly, Humanscale is a proper party to enforce the proscription of registration found in Section 2(c) of the Trademark Act.

Conclusion

For the reasons set forth above, CFGroup's motion to dismiss should be denied.

Date: January 19, 2010

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Certificate of Service

The undersigned certifies that a copy of the foregoing "Memorandum in Opposition to Respondent's Motion to Dismiss" was submitted to the Trademark Trial and Appeal Board electronically on January 19, 2010, and was electronically mailed to the following counsel of record on January 19, 2010:

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