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

Proceeding	92053622
Party	Defendant Siggy Music, Inc.
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Attachments	Registrant's Opp to Motion to Dismiss Counterclaim 071811.pdf (6 pages) (496246 bytes)

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

In the Matter of Registration No. 3,059,241

Mark: J5

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UMG RECORDINGS, INC.,	:	
	:	
Petitioner,	:	
	:	
-against-	:	Cancellation No. 92053622
	:	
SIGGY MUSIC, INC.,	:	
	:	
Registrant.	:	
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**REGISTRANT’S OPPOSITION TO PETITIONER’S MOTION TO DISMISS
REGISTRANT’S COUNTERCLAIM FOR FRAUD**

Registrant, Siggly Music, Inc. (“Registrant”), by its attorneys, Grimes & Battersby, LLC, hereby opposes the Motion to Dismiss Registrant’s Counterclaim for Fraud (the “Motion”) filed by Petitioner, UMG Recordings, Inc. (“Petitioner”).

INTRODUCTION

As shown below, Petitioner’s Motion should be denied on the merits. In addition, the Motion should be denied as moot, in light of the fact that Registrant has concurrently filed an amended pleading, namely, Registrant’s Amended Answer, Affirmative Defenses, and Counterclaim, in accordance with Trademark Rule of Practice 2.115, Fed. R. Civ. P. 15(a)(1)(B) and Trademark Trial and Appeal Board Manual of Procedure § 507.

ARGUMENT

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Young v. AGB Corp.*, 152 F.3d 1377 (Fed. Cir. 1998). The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief sought. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP §503.02. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157 (Fed. Cir. 1993).

I. PETITIONER'S MOTION TO DISMISS SHOULD BE DENIED ON THE MERITS

Petitioner argues that Registrant's counterclaim to cancel Petitioner's Registration No. 2,881,064 ("Petitioner's Registration") on the ground that the registration was fraudulently obtained fails to state a claim upon which relief can be granted. Contrary to Petitioner's assertions, Registrant has sufficiently pleaded two independent bases for cancelling Petitioner's Registration.

A. Registrant Sufficiently Pleaded Allegations That Petitioner Fraudulently Stated Its Date of First Use

For its first basis, Registrant alleges that Petitioner made a fraudulent misrepresentation when it failed to state that any use of the trademark prior to at least as late as December 1998 was not made by Petitioner. (Counterclaim ¶¶ 46-49.) In its Motion, Petitioner focuses solely on the allegations contained in Paragraphs 47(a)-(d) regarding the actual date of first use of the mark and ignores the allegation contained in Paragraph 47(e) which states, as follows: “To the extent that Petitioner seeks to claim that it is the successor in interest to the Motown record label (and thus entitled to rely upon the earlier activities of Motown), Petitioner failed to so state in its declaration, as required under 37 C.F.R. §2.38(a)...” (Counterclaim ¶ 47(e).)

Although Registrant does indeed state that the allegations contained in Paragraphs 47(a)-(d) are made on “information and belief”, the allegation contained in Paragraph 47(e) is clearly supported by Petitioner’s own representation contained in its application for registration, which application was automatically made of record when Petitioner filed its Petition to Cancel, and is further supported by the allegation contained in Paragraph 46 which sets forth the misrepresentation in its entirety. (Counterclaim ¶¶ 46 and 47.)

B. Registrant Sufficiently Pleaded Allegations That Petitioner Fraudulently Claimed Ownership of Reg. No. 965,809

For its second basis, Registrant alleges that Petitioner fraudulently misrepresented that it owned Reg. No. 965,809, when in fact the publicly-available USPTO records show otherwise. (Counterclaim ¶¶ 50-53.) Contrary to UMG’s assertions, the publicly-available USPTO records actually support Registrant’s allegations. The Trademark Applications and Registration Retrieval (“TARR”) database for Reg. No. 965,809 identifies the current owner of record as Motown Record Company, L.P. (a Delaware limited partnership), not Petitioner. Moreover, the

Trademark Assignment Abstract of Title database shows the recordation of an assignment of the entire interest and goodwill in the mark from Motown Record Company, L.P. (a Delaware limited partnership) to MRAC, L.P. (a California limited partnership), such assignment having been executed on September 2, 1993. It then shows the recordation of a subsequent assignment of the entire interest and goodwill in the mark from Motown Record Company, L.P. (a limited partnership/no state designated) to UMG Recordings, Inc. (a Delaware corporation), such assignment having been executed on May 14, 2003. This latter assignment was improper, given that Motown Record Company, L.P. did not own any interest in the mark after September 2, 1993. Accordingly, Petitioner did not acquire any rights in Reg. No. 965,809 in 2003 and was not the rightful owner of Reg. No. 965,809 in 2004 when it made that representation.

In support of its Motion, Petitioner provided a copy of the actual assignment document for this latter assignment. The document states that the assignment was made by Motown Record Company, L.P. (a California limited partnership). However, according to the publicly-available USPTO records, the only Motown Record Company, L.P. that ever owned rights in the mark was a Delaware limited partnership, thus casting a further shadow on the chain of title.

Finally, while Registrant states that these allegations are made “upon information and belief,” they are actually supported by the USPTO’s own records.

II. PETITIONER’S MOTION TO DISMISS SHOULD BE DENIED AS MOOT

In addition to failing on the merits, Petitioner’s Motion should be denied as moot. Concurrent with the filing of this opposition, Registrant has filed an amended pleading, namely Registrant’s Amended Answer to Petition to Cancel, Affirmative Defenses, and Counterclaim. In its amended pleading, Registrant has even more explicitly stated the facts upon which Registrant’s belief is founded and has attached the relevant supporting documents as exhibits

thereto. This amended pleading corrects any potential defects noted by Petitioner in its Motion and once again states a claim upon which relief may be granted. Accordingly, Petitioner's Motion is moot. *See* TBMP 503.03.

CONCLUSION

For the reasons set forth herein, Registrant respectfully requests that the Board deny Petitioner's Motion in its entirety with prejudice. Registrant further requests that this proceeding be resumed without further delay.

Dated: Norwalk, Connecticut
July 18, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of July, 2011, I caused a true and correct copy of the foregoing Registrant's Opposition to Petitioner's Motion to Dismiss Registrant's Counterclaim for Fraud to be sent by U.S. Mail, First Class, postage prepaid, in an envelope addressed to Petitioner's attorney of record as follows:

David Donahue, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, NY 10017
(attorney of record for Petitioner)

and further certify that the foregoing Registrant's Opposition to Petitioner's Motion to Dismiss Registrant's Counterclaim for Fraud was filed on the same date via the Board's electronic filing system.

/Susan M. Schlesinger/
Susan M. Schlesinger