Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA426766**

Filing date: **08/24/2011**

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

Proceeding	92054263
Party	Defendant Current Solutions, LLC DBA Koalaty Products, Inc.
Correspondence Address	CURRENT SOLUTIONS LLC DBA KOALATY PRODUCTS INC 3814 WOODBURY DR AUSTIN, TX 78704 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	J. Matthew Pritchard
Filer's e-mail	ttab@webblaw.com
Signature	/jmp/
Date	08/24/2011
Attachments	Motion For A More Definite Statement And Motion To Strike.pdf (8 pages)(287975 bytes)

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

TENSPRODUCTS, INC.,	)	
	)	
Petitioner	)	Cancellation No. 92054263
	)	
v.	)	
	)	
CURRENT SOLUTIONS, LLC	)	
DBA KOALATY PRODUCTS, INC.,	)	
	)	
Registrant	)	

MOTION FOR A MORE DEFINITE STATEMENT AND
TO STRIKE PETITIONER'S ALLEGATIONS OF
MISAPPROPRIATION AND ILLEGALITY

Pursuant to Rule 12(e) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.) and Section 505 of the *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP"), and in lieu of an Answer, Registrant Current Solutions, LLC DBA Koalaty Products, Inc., ("Current Solutions" or "Registrant"), by and through its undersigned counsel, moves the Trademark Trial and Appeal Board ("Board") for an Order directing Petitioner TENSproducts, Inc.'s ("TPI" or "Petitioner") to provide a more definite statement of its Petition to Cancel U.S. Trademark Registration No. 3,982,139 ("Petition"). In addition, Registrant respectfully requests that Petitioner's allegations that Registrant misappropriated its INTENSITY mark and is selling class II medical devices illegally be stricken from the record pursuant to Fed.R.Civ.P. 12(f) and Section 506 of the TBMP.

In its Petition to Cancel, Petitioner fails to allege facts sufficient to demonstrate a statutory basis for cancelling Registrant's mark. Although Petitioner has alleged common law rights arising out of an ornamental use of the phrase "Put the InTENSity back in your life" on a

t-shirt, those allegations lack a factual basis sufficient to constitute actual use in the nature of a mark and misapprehend the legal implications of trademark use. Moreover, even if Petitioner's allegations had some basis in fact (which they do not), they fail to set forth a statutory basis for relief. It is likewise impossible to discern from the petition the statutory basis Petitioner is alleging as grounds for cancellation. Registrant cannot in good faith frame a responsive pleading to the Petition and therefore seeks a more definite statement of the Petition to Cancel. Finally, Petitioner's unfounded speculation regarding Registrant's misappropriation of the mark and allegedly illegal sale of class II medical devices should be stricken from the record.

I. Petitioner has Failed to Set Forth Facts Sufficient to Establish Trademark Use.

Although evidence of a Petitioner's pending trademark application combined with a reasonable belief that Petitioner would be harmed by the registration of Applicant's mark is sufficient to establish standing in a trademark opposition [or cancellation] (*see, e.g., Life Zone Inc. v. Middleman Group Inc.,* 87 U.S.P.Q.2d 1953, 1959 (TTAB 2008)), Petitioner cites to no such pending trademark application. Instead, Petitioner relies entirely on common law trademark rights arising out of an ornamental use of the phrase "Put the InTENSity back in your life" on promotional t-shirts. Dkt. 1 at ¶3-4. As a matter of law, this alleged use is insufficient to establish common law rights (or the geographic scope of such rights) in connection with the shirts themselves, much less in connection with goods that are related to, or likely to be confused with, those identified in the INTENSITY registration, namely, "a line of transcutaneous electrical nerve stimulation units" in International Class 10.

In order to establish common law rights in a particular mark, it is necessary to demonstrate the ownership and validity of the mark, the source-indicating function of the mark

based on actual use, and the geographic scope of the mark. *See generally* 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §1:2 (West, 4th Ed. 2009). In order to survive a motion to dismiss, a petition to cancel must allege facts "showing proprietary rights in its pleaded mark prior to defendant's rights in the challenged mark." *See, e.g.,* TBMP §309.03(c)(A); *see also T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (holding that plaintiff bears the burden of establishing that the activities claimed to constitute analogous use have had "substantial impact" on the purchasing public). Use in the nature of a mark occurs only when a designation is "displayed or otherwise made known to prospective customers in the ordinary course of business in a manner that associates the designation with the goods, services or business of the user." *Restatement (Third) of Unfair Competition* §18, cmt. d (1995).

In this case, there is no set of facts alleged that would establish that Petitioner's promotional t-shirts incorporating the phrase "Put the InTENSity back in your life" constituted trademark use or created an association between the phrase and the goods that Petitioner purports to sell, or Petitioner's business more generally. It is all but impossible to discern how Petitioner could conceivably establish use-based common law rights on the facts alleged in the Petition. At a minimum, the Board should instruct Petitioner to allege with specificity the precise mark in which common law rights are being asserted, the actual use in the nature of a mark giving rise to those rights, and the geographic scope of that use.

II. Petitioner Has Failed to Allege A Statutory Basis for Its Petition

It is equally unclear from the Petition how Petitioner is and would continue to be damaged by the registration of the INTENSITY mark. Specifically, Petitioner has alleged that Registrant's sale of electrotherapy units under the mark is illegal, and that it does not wish to be associated with the sale of these units or the Registrant. Dkt. 1 at ¶6. Petitioner's unfounded allegations of illegality do not appear to relate to a specific fraud claim or other valid grounds for cancellation, and are addressed more fully in Section III below. Petitioner's remaining allegation that it does not wish to be associated with the sale of Registrant's products or the Registrant does not provide Registrant with sufficient notice of what legal theories are being pled or what statutory basis is being asserted as grounds for cancellation. The petition also fails to allege facts establishing how an association between Petitioner and Registrant would be created in the minds of consumers by Registrant's continued use of its INTENSITY mark. Even under the liberal pleading standard of Fed.R.Civ.P. 8(f), the Petition is so vague and undefined that Registrant cannot reasonably formulate a responsive answer. Accordingly, the Board should require Petitioner to specify a statutory basis for the Petition and set forth factual allegations that, if proved, would establish the required elements of any claim(s) asserted as grounds for cancellation.

III. Petitioner's Allegations of Misappropriation and Illegality Should be Stricken

The Petition further alleges, albeit vaguely, that Registrant somehow misappropriated the INTENSITY mark from Petitioner (Dkt. 1 at ¶¶3-5) and that Registrant's sale of electrotherapy

units under the mark is illegal. *Id.* at ¶6. First, as outlined above, Petitioner has not alleged a set of facts that, if proved, would confer any use-based trademark rights in any mark, and only a mark in which rights have been established can be misappropriated. Even assuming *arguendo* that the idea to incorporate the TENS acronym into the word inTENSity originated with the petitioner, that idea confers no common law rights in the mark absent actual use. Beyond Petitioner's ornamental use of the phrase "Put the InTENSity back in your life" on t-shirts, there is simply no factual basis for any allegation of misappropriation, and paragraphs 3 through 5 of the Petition should therefore be stricken.

Petitioner's unfounded allegations of illegality should also be stricken because Petitioner has not and cannot adduce evidence that a court or government agency has ever determined Registrant's use of its INTENSITY mark to be unlawful. It is well recognized that "the Board will find use of a mark in commerce unlawful only when a court or government agency, having competent jurisdiction under the statute in question, has previously made a finding of non-compliance or where there has been a *per se* violation of the statute at issue." *Facial Aesthetic Center of Excellence Group, Inc. v. Stewart Wang, M.D., Inc.*, 2006 WL 3296210 at *3 (TTAB October 27, 2006); *see also Santinine v. P.A.B. Produits,* 209 USPQ 958, 965 (TTAB 1981)(holding that "it is incumbent upon any petitioner or opposer … to establish the grounds upon which its cause of action is predicated by clear and convincing evidence, and nowhere is this more true than in a case where a plaintiff urges us to cancel, or to refuse to issue, a registration based upon the defendant's alleged failure to comply with the requirements of a statute which is outside of our area of expertise."). The Board is an administrative tribunal that is empowered to determine only the right to register; it may not determine the right to use, or broader questions of infringement or unfair competition. *See* TBMP §102.01; §309.03 (a)(1); *see*

also McDermott v. San Francisco Women's Motorcycle Contingent, 81 USPQ2d 1212 (TTAB 2006)(holding that speculative allegations of illegality are insufficient to establish standing and dismissing opposition for failing to plead a reasonable basis for belief that damage would result from registration of DYKES ON BIKES); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571-1572 (TTAB 1988) (immaterial allegation stricken from petition for cancellation). Allowing Petitioner's borderline libelous allegations to remain in the record would unduly prejudice Registrant and force it to incur unnecessary costs responding to and refuting allegations which have no bearing on the registrability of its INTENSITY mark. If Petitioner wishes to pursue its claims of illegality (and has any evidence of illegal activity beyond mere speculation) there are undoubtedly appropriate regulatory and legal mechanisms for doing so. However, a cancellation proceeding before the Board is an inappropriate forum in which to pursue such claims. Absent specific allegations setting forth i) what statute or regulation Registrant's sale of electrotherapy units violates and ii) the court or agency of competent jurisdiction which determined said sale to be unlawful, the following sentence from Paragraph 6a should be stricken from the record with prejudice: "These units are a class II medical device sold illegally without prescription on many websites."

IV. Conclusion

In view of the dispositive character of this motion, Applicant respectfully requests that the Board suspend proceedings in this opposition pending the Board's decision on the motion.

Respectfully submitted,

Dated: August 24, 2011

By _____

William H. Logsdon, Registration No. 22,132
J. Matthew Pritchard, Registration No. 46,228
Steven M. Johnston, Registration No. 61,268

THE WEBB LAW FIRM
One Gateway Center
420 Fort Duquesne Boulevard, Suite 1200
Pittsburgh, PA 15222
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
E-mail: webblaw@webblaw.com

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **MOTION FOR A MORE DEFINITE STATEMENT AND TO STRIKE PETITIONER'S ALLEGATIONS OF MISAPPROPRIATION AND ILLEGALITY** was served via first class mail on this 24th day of August 2011 upon the following:

Linda Ziegler
TENSproducts, Inc.
253 County Road 41
Granby, CO 80446

Attorney for Applicant