

ESTTA Tracking number: **ESTTA541646**

Filing date: **06/04/2013**

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

Proceeding	92057110
Party	Defendant Daphne Hereford
Correspondence Address	DAPHNE HEREFORD POST OFFICE BOX 27 CROKETT, TX 75835 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	William Propp, Esq.
Filer's e-mail	propplegal@gmail.com, rintintin@rintintin.com
Signature	/William Propp, Esq./
Date	06/04/2013
Attachments	92057110 Respondents Motion to Dismiss.pdf(890266 bytes )

William Propp, Esq. (State Bar No. 123,853)  
8149 Santa Monica Boulevard, #245  
West Hollywood, California 90046  
Telephone: (310) 820-9869  
Facsimile: (310) 820-9882  
Email: propplegal@gmail.com  
Attorney for Respondent,  
Daphne Hereford

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

Jeff Miller, Max Kleven, and	)	
Rin, Inc.,	)	Cancellation No. 92057110
Petitioners	)	Marks: RIN TIN TIN and
	)	RIN TIN TIN CANINE
	)	AMBASSADOR CLUB
v.	)	
	)	
Daphne Hereford and Rin Tin Tin, Inc.	)	
Respondents	)	RESPONDENT'S MOTION
	)	TO DISMISS PETITION
	)	FOR CANCELLATION
	)	
	)	
	)	

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RE: The following federal trademark registrations

Registration No: 3111161

Mark: RIN TIN TIN

Registration Date: July 4, 2006

Registration No: 2969852

Mark: RIN TIN TIN

Registration Date: July 19, 2005

Registration No: 3582436

Mark: RIN TIN TIN

Registration Date: March 3, 2009

Registration No: 2538312

Mark: RIN TIN TIN

Registration Date: February 12, 2002

Registration No: 2384745

Mark: RIN TIN TIN CANINE AMBASSADOR CLUB

Registration Date: September 12, 2000

///

///

Registration No: 1763135

Mark: RIN TIN TIN

Registration Date: April 6, 1993

Respondents Daphne Hereford, an individual with a place of business at P.O. Box 27, Crockett, Texas 75835, and Rin Tin Tin, Inc., a Texas Corporation with a place of business at P.O. Box 27, Crockett, Texas 75835, by and through her undersigned attorney, hereby Answer to the Petition for Cancellation and admit, deny and allege as follows:

MOTION TO DISMISS

The Trademarks are incontestable.

1. The federal trademarks registration No: 3111161, No: 2969852, No: 2538312, and No. 1763135 for the mark RIN TIN TIN and No: 2384745 for the mark RIN TIN TIN CANINE AMBASSADOR CLUB are incontestable. The necessary paperwork under Section 8 and 15 (filed between 5<sup>th</sup> and 6<sup>th</sup> year if issuance of mark) has been filed. Petitioners cannot challenge the validity of these trademarks, cannot claim these trademarks were improperly registered and/or cannot challenge the Respondents' ownership of these trademarks.

Petitioners have no standing.

2. The Petitioners have no standing to file this Petition for Cancellation. In a pending trademark cancellation of another of Respondents' RIN TIN TIN trademarks (Cancellation Proceeding No. 92056642), Jeff Miller alone has claimed to own Petitioners'

alleged rights in RIN TIN TIN. In a pending district court suit for the cancellation of these trademarks and other trademarks of Respondents' RIN TIN TIN trademarks ( CV-13-02783-ABC in the Central District of California), Max Kleven and Rin, Inc. alone have claimed to own Petitioners' alleged rights in RIN TIN TIN. In this trademark cancellation, Petitioners Jeff Miller, Max Kleven and Rin, Inc. have alleged ownership of rights in RIN TIN TIN. Petitioner's counsel in all three of these proceedings is the same attorney, which does not explain this inconsistent and contradictory pleading as to who has standing to file this Petition for Cancellation.

3. In the previous trademark cancellation of another of Respondents' RIN TIN TIN trademarks, Cancellation Proceeding 92056642, in Paper No. 11, Petitioners Motion to Dismiss Counterclaim, the pleading states "this allegation is based on facts that are very much in dispute, this issue is not ripe for adjudication at this time" pages 10 to 11. Petitioners have to have standing to file a cancellation. Petitioners and their attorney must know and show who owns their alleged rights in RIN TIN TIN.

The 2006 Settlement Agreement between Petitioners and Respondents settled this issue and prohibits Petitioners from bringing this cancellation.

4. Respondents and Max Kleven signed a settlement agreement dated effective May 1, 2006 ("Settlement Agreement"). A copy of that Settlement Agreement ("Exhibit A") is attached to this Answer.

5. To the best of Respondent's knowledge and belief, Jeff Miller and/or Rin, Inc. has been assigned or succeeded some or all of Max Kleven's alleged interest in RIN TIN TIN.

6. The Settlement Agreement in Clause 2.9 states “Kleven and Hereford hereby covenant not to sue one another hereafter for any reason other than a breach of this Agreement, which is intended as a full and complete final settlement of any and all disputes asserted or not, known or unknown, now existing or hereunder arising.”

7. The Settlement Agreement in Clause 1.4 states the agreement covers “any other Cancellation or Opposition Proceedings filed on behalf of Kleven against Hereford.”

8. The Settlement Agreement in Clause 1.1 binds Max Kleven and “each of its or their representatives, executors, administrators, attorneys, agents, successors and assignees.”

9. The Petitioners and Respondents have a valid, enforceable 2006 Settlement Agreement which expressly prohibits Petitioners from challenging or attempting to cancel the Respondents’ trademarks. The 2006 Settlement Agreement expressly settles any and all disputes between Petitioners and Respondents then existing or arising in the future.

10. The Petitioners in the present Cancellation Proceeding are estopped and barred from bringing this present Cancellation Proceeding by the Settlement Agreement.

The Petition for Cancellation fails to state a claim, and is barred by laches, waiver, acquiescence, and estoppel.

11. The Petition for Cancellation fails to state a claim upon which relief may be granted.

12. The claims set forth in the Petition for Cancellation are barred in whole or in part by the doctrine of laches.

13. The claims set forth in the Petition for Cancellation are barred in whole or in part by the doctrines of waiver, acquiescence, and estoppel.

PRAYER FOR RELIEF

14. WHEREFORE, Respondents request that this cancellation be dismissed with prejudice and the United States Trademark Registration No. 3111161, No: 2969852, No. 3582436, No: 2538312, and No. 1763135 for the mark RIN TIN TIN and No: 2384745 for the mark RIN TIN TIN CANINE AMBASSADOR CLUB remain as valid trademark registrations owned by Respondents.

Respectfully Submitted

Dated June 4, 2013

By William Propp

William Propp, Esq.

8149 Santa Monica Blvd., #245

West Hollywood, CA 90046

**CERTIFICATE OF MAILING**

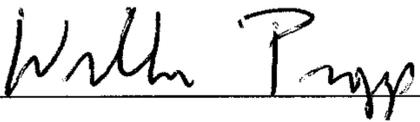
I hereby certify that a true and correct copy of the attached MOTION TO DISMISS THE PETITION FOR CANCELLATION, along with Exhibit A, was served on Petitioner's attorney of record by U.S. First Class Mail, postage prepaid, on June 4, 2013, addressed to:

Kevin M. Welch, Esq.

The Law Office of Kevin M. Welch

P.O. Box 494

Hermosa Beach, CA 90254



A handwritten signature in cursive script, reading "William Propp", is written over a horizontal line.

William Propp

Cancellation No. 92057110

Marks: RIN TIN TIN and RIN TIN TIN CANINE AMBASSADOR CLUB

RESPONDENT'S MOTION TO DISMISS PETITION FOR CANCELLATION

EXHIBIT A

2006 Settlement Agreement between Petitioner Max Kleven and Respondent Daphne Hereford

**SETTLEMENT AGREEMENT**

Date Effective: May 1, 2006

**PART ONE - DEFINITIONS**

1.1. The term "Kleven", when used in this agreement, means each and every one of the following, both singly and cumulatively: Max Kleven, Herbert B. Leonard, Kleven Productions, Inc., a California corporation and each of its or their representatives, executors, administrators, attorneys, agents, successors and assignees.

1.2 The term "Hereford", when used in this agreement, means each and every one of the following, both singly and cumulatively: Miss Daphne Hereford, Rin Tin Tin, Inc., a Texas corporation, and each of its or their servants, employees, officers, directors, shareholders, insurers, subsidiaries, attorneys, agents, parent companies, predecessors, and successors.

1.3 The term "Lawsuits", when used in this release, means the case Hereford v. Kleven, Case No. 9:06-CV-12, transferred from Texas to California, and Kleven v. Hereford, USDC Central District of California, Case No. CV06-785.

1.4 The term "Cancellation Proceeding" shall mean the Cancellation Proceeding initiated on behalf of Kleven in the USPTO regarding trademark registration number 2,969,852 and any other Cancellation or Opposition Proceedings filed on behalf of Kleven against Hereford, as defined above.

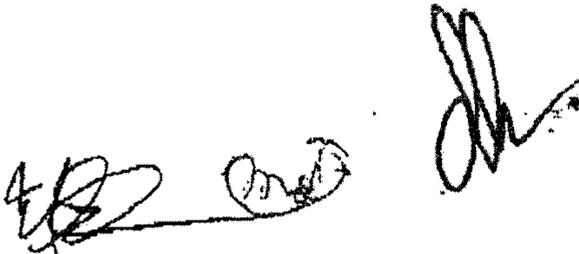
**PART TWO - THE AGREEMENT**

2.1 Within three (3) court days of the signing of this Agreement and the completion of the licenses and assignment delineated in this Agreement the Parties shall dismiss their respective lawsuits with prejudice and Kleven shall withdraw their pending Cancellation and Opposition Proceeding(s) with prejudice.

2.2.1 Within three (3) court days of the signing of this agreement, Hereford shall assign to Kleven all rights to the mark 2,969,852 in IC 041 for Rin Tin Tin for use in motion pictures, television programs or series, or any newly derived processes that provide a dynamic visual image, as well as the exclusive right to the mark Rin Tin Tin for any products or services that derive from said motion pictures, television programs or series, or any newly derived processes. Hereford shall cooperate in the processing of the assignment to the degree necessary.

2.2.2 Notwithstanding the foregoing, as to licenses for use in motion pictures, television programs or series, or any newly derived processes that provide a dynamic visual image made by Hereford prior to April 24, 2006, all of which have been disclosed by Hereford and which are delineated in Appendix "1" hereto, those licenses remain valid and enforceable by Hereford, and all payments due thereunder shall be entirely Hereford's own property.

2.2.3 Hereford may exercise any other intellectual property rights owned by Hereford as to the use of the mark Rin Tin Tin against anyone, other than those relating to motion pictures, television, or other video products, or other products related thereto, produced by Kleven or its successors, assigns and licensees. Kleven agrees to cooperate with Hereford in that regard to the extent reasonable. Further, should Hereford successfully obtain royalties from any entity, or if Hereford has already established royalty payment from any entity, Hereford shall retain all of such payments or royalties. In the event that both Hereford and Kleven desire to preclude the production or distribution of any motion picture or television series, by way of examples James Tierney's Story of Rin Tin Tin, they may cooperate but each party shall bear its own costs and attorneys' fees.



2.2.4 With regard to any products or services, that derive from said motion pictures, television programs or series, or any newly derived processes, thus including, for example, stuffed animals, books, costumes, video and computer games, song books and all other manner of toys for the relevant age group, Hereford shall be entitled to ten percent (10%) of the net proceeds received by Kleven as royalties. Net profit shall be defined in accordance with Generally Accepted Accounting Procedures ("GAAP").

2.3 Other than as included in Appendix "I" herein, Hereford and Kleven warrant that they have not entered into any agreements or commitments that would reduce or preclude them from fully complying with all of the terms and conditions of this Agreement to the full extent thereof.

2.4 This release contains all the promises which have been made in connection with this settlement. There are no hidden terms, and everything that is important to this release is specified in writing herein. The matters set forth herein shall be binding upon and inure to the benefit of the executors, administrators, personal representatives, heirs, successors and assigns of each party.

2.5 Each party hereto shall bear all its own attorneys' fees and costs related to the Lawsuits, the Cancellation and Opposition Proceeding(s) and/or the prosecution and defense thereof.

2.6 The undersigned acknowledge that they have been represented by legal counsel, that they have consulted with their attorney about this agreement and release, and have freely assented to this settlement, which has not involved coercion, undue influence or economic pressure.

2.7 It is understood and agreed that this settlement is the compromise of disputed claims, and that the promises made are not to be construed as an admission of liability on the part of any of the Parties hereto and that the Parties deny liability therefore and intend merely to avoid litigation and to buy their peace.

2.8 If any portion of this release is invalid or prohibited, only that portion should be affected and the rest of the release shall be enforced as written here.

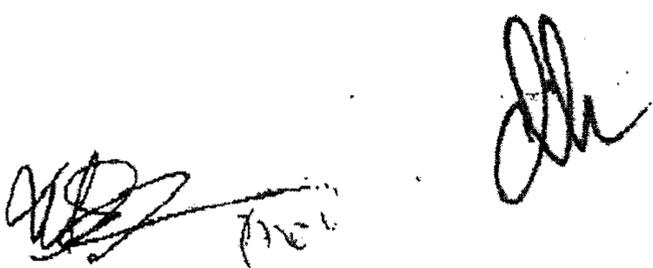
2.9 Kleven and Hereford hereby covenant not to sue one another hereafter for any reason other than a breach of this Agreement, which is intended as a full and complete final settlement of any and all disputes, asserted or not, known or unknown, now existing or hereafter arising.

2.10 This Agreement may be signed in counterparts and the counterparts together and exchanged by facsimile transmission and, if so signed, it shall have the same force and effect as if all of the undersigned had signed one copy. Signatures on documents transmitted by facsimile shall be deemed to be original signatures for all purposes.

2.11 The Parties agree that in the event of any litigation arising from this Agreement that the proper court, venue and jurisdiction shall be the United States District Court, Central District for California, in Los Angeles, California.

2.12 Max Kleven and Herbert B. Leonard each acknowledge that they have been informed that there may be conflicts between them with regard to this Agreement and the settlement of these matters and that they have been given sufficient opportunity to seek independent legal counsel to advise them regarding the settlement prior to their signing this Agreement. Kleven and Leonard further acknowledge that nothing in this Agreement grants or implies any rights or obligations with respect to one another.

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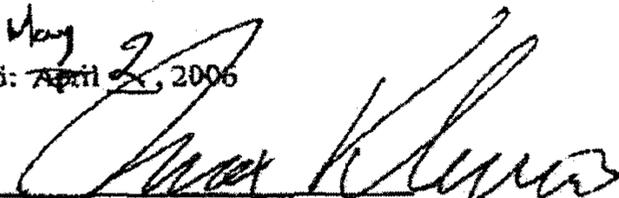
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**SIGNATURES**

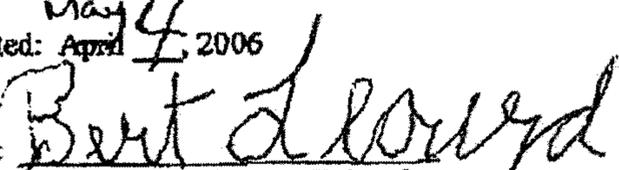
<sup>May</sup>  
Dated: ~~April~~ \_\_, 2006

By: \_\_\_\_\_  
Daphne Hereford, an individual and on behalf of Rin Tin Tin, Inc.

<sup>May</sup>  
Dated: ~~April~~ 2, 2006

By:   
Mik Kleven, an individual and on behalf of Kleven Productions, Inc.

<sup>May 4</sup>  
Dated: ~~April~~ 4, 2006

By:   
Bert Leonard, an individual



Appendix "1"

Todd Moore

Susan Orlean

Darryl Rehr

MPH Entertainment

Kendra Waters

LOGGED

Marc Stever Colen, sbn 108275  
Law Offices of Marc Steven Colen  
20300 Ventura Blvd., Ste. 120  
Woodland Hills, CA 91364  
(818) 716 2891

2006 MAY 11 PM 2:42  
CLERK OF DISTRICT COURT  
CENTRAL DISTRICT OF CALIF.  
LOS ANGELES

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

Max Kleven, et al.  Plaintiff(s).	CASE NUMBER CV06-785 CBM(JTLx)
v.  Daphne Hereford, et al.  Defendant(s).	NOTICE OF DISMISSAL PURSUANT RULE 41(a) or (c) F.R.Civ.P.

PLEASE TAKE NOTICE: (Check one)

- This action is dismissed <sup>with prejudice</sup> by the Plaintiff(s) in its entirety.
- The Counterclaim brought by Claimant(s) \_\_\_\_\_ is dismissed by Claimant(s) in its entirety.
- The Cross-Claim brought by Claimant(s) \_\_\_\_\_ is dismissed by the Claimant(s) in its entirety.
- The Third-party Claim brought by Claimant(s) \_\_\_\_\_ is dismissed by the Claimant(s) in its entirety.
- ONLY Defendant(s) \_\_\_\_\_

is/are dismissed from (check one)  Complaint,  Counterclaim,  Cross-claim,  Third-Party Claim brought by \_\_\_\_\_

The dismissal is made pursuant to Rule 41(a) or (c) of the Federal Rules of Civil Procedure.

May 4, 2006

Date

Signature of Attorney/Party

NOTE: F.R.Civ.P. 41(a): This notice may be filed at any time before service by the adverse party of an answer or of a motion for summary judgment, whichever first occurs.

F.R.Civ.P. 41(c): Counterclaims, cross-claims & third-party claims may be dismissed before service of a responsive pleading or prior to the beginning of trial.

CV-9 (07/01)

NOTICE OF DISMISSAL PURSUANT TO F.R.Civ.P. 41(a) or (c)

**TRADEMARK ASSIGNMENT**

THIS TRADEMARK ASSIGNMENT (the "Assignment") is made and entered into effective as of the 1<sup>st</sup> day of May, 2006, by and between DAPHNE HEREFORD, on behalf of herself as an individual, and her company Rin Tin Tin, Inc., and all of its shareholders and directors (hereinafter referred to as "Assignor"), and MAX KLEVEN (hereinafter referred to as "Assignee");

WHEREAS, Assignor is the record owner of Registration No. 2,969,852 in multiple classes for RIN TIN TIN (the "Mark") as recorded in the U.S. Patent and Trademark Office; and

WHEREAS, the Mark is registered in International Classes 016 and 028 for Printed Goods (the "Printed Goods Classes") and in International Class 041 for Movie Services (the "Movie Services Class"); and

WHEREAS, Assignee and Assignor desire that Assignor retain ownership of the Mark as registered in the Printed Goods Classes, 016 and 028; and

WHEREAS, Assignee and Assignor desire to enter into this Assignment to effect the transfer to Assignee of the Mark only as registered in the Movie Services Class, 041.

NOW, THEREFORE, for and in consideration of the premises and the mutual promises hereinafter set forth and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor and Assignee hereby agree as follows:

1. Transfer and Assignment. Assignor hereby transfers and assigns to Assignee all of its right, title, and interest in and to the Mark only as registered in the Movie Services Class, 041.

2. Further Documentation and Actions. Assignor hereby agrees to execute and deliver to Assignee any further documents and instruments to vest in Assignee the right, title, and interest in and to the Mark in Movie Services Class 041, and to enable such right title and interest to be recorded in the United States Patent & Trademark Office.

"ASSIGNOR"  
DAPHNE HEREFORD

"ASSIGNEE"  
MAX KLEVEN

By: \_\_\_\_\_  
Name: Daphne Hereford  
Date: May \_\_, 2006

By: \_\_\_\_\_  
Name: Max Kleven  
Date: May \_\_, 2006

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PAGE 01

INCOLOURSER

**TRADEMARK ASSIGNMENT**

THIS TRADEMARK ASSIGNMENT (the "Assignment") is made and entered into effective as of the 1<sup>st</sup> day of May, 2006, by and between DAPHNE HERRSFORD, on behalf of herself as an individual, and her company Rin Tin Tin, Inc., and all of its shareholders and directors (hereinafter referred to as "Assignor"), and MAX KLEVEN (hereinafter referred to as "Assignee");

WHEREAS, Assignor is the record owner of Registration No. 2,969,832 in multiple classes for RIN TIN TIN (the "Mark") as recorded in the U.S. Patent and Trademark Office; and

WHEREAS, the Mark is registered in International Classes 016 and 028 for Printed Goods (the "Printed Goods Classes") and in International Class 041 for Movie Services (the "Movie Services Class"); and

WHEREAS, Assignor and Assignee desire that Assignor retain ownership of the Mark as registered in the Printed Goods Classes, 016 and 028; and

WHEREAS, Assignor and Assignee desire to enter into this Assignment to effect the transfer to Assignee of the Mark only as registered in the Movie Services Class, 041.

NOW, THEREFORE, for and in consideration of the premises and the mutual promises hereinafter set forth and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor and Assignee hereby agree as follows:

1. **Transfer and Assignment.** Assignor hereby transfers and assigns to Assignee all of its right, title, and interest in and to the Mark only as registered in the Movie Services Class, 041.
2. **Further Documentation and Action.** Assignor hereby agrees to execute and deliver to Assignee any further documents and instruments to vest in Assignee the right, title, and interest in and to the Mark in Movie Services Class 041, and to enable each right title and interest to be recorded in the United States Patent & Trademark Office.

"ASSIGNOR"  
DAPHNE HERRSFORD

By:   
Name: Daphne Herrsford  
Date: May 2, 2006

"ASSIGNEE"  
MAX KLEVEN

By:   
Name: Max Kleven  
Date: May 2, 2006



[Assignments on the Web](#) > Trademark Query

## Trademark Assignment Abstract of Title

**Total Assignments: 1**

**Serial #:** 78259868

**Filing Dt:** 06/09/2003

**Reg #:** 2969852

**Reg. Dt:** 07/19/2005

**Registrant:** Hereford, Daphne

**Mark:** RIN TIN TIN

**Assignment: 1**

**Reel/Frame:** 3306/0964

**Received:** 05/11/2006

**Recorded:** 05/11/2006

**Pages:** 4

**Conveyance:** ASSIGNOR HEREBY TRANSFERS AND ASSIGNS TO ASSIGNEE ALL OF ITS RIGHT, TITLE, AND INTEREST IN AND TO THE MARK ONLY AS REGISTERED IN THE MOVIE SERVICES CLASS, 041.

**Assignor:** DAPHNE HEREFORD

**Exec Dt:** 05/01/2006

**Entity Type:** INDIVIDUAL

**Citizenship:** UNITED STATES

**Assignee:** MAX KLEVEN

33150 BARBER ROAD

SANTA CLARITA, CALIFORNIA 91390-3405

**Entity Type:** INDIVIDUAL

**Citizenship:** UNITED STATES

**Correspondent:** MARC E. HANKIN

11414 THURSTON CIRCLE

LOS ANGELES, CA 90049

Search Results as of: 05/15/2006 09:38 PM

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 571-272-3350

Marc Steven Colen  
Law Offices of Marc Steven Colen  
20300 Ventura Blvd., Suite 120  
Woodland Hills, CA 91364  
Attorney for Petitioner, Max Kleven

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

In the matter of trademark:  
Registration No. 2969852 [IC 016, 041, 028]

For the mark RIN TIN TIN

MAX KLEVEN,

Petitioner

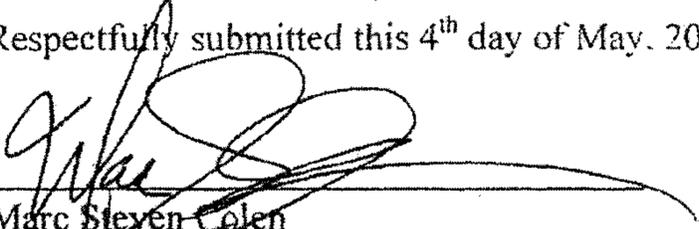
v.

DAPHNE HEREFORD, and her assignee,  
RIN TIN TIN INCORPORATED,  
Registrants

**WITHDRAWAL OF PETITION TO CANCEL**

Petitioner, Max Kleven, on the one hand, and Registrants Daphne Hereford and Rin Tin Tin, Inc. on the other have resolved their differences by way of, among other things, the assignment of all rights in IC 041 to Mr. Kleven. In view thereof, Mr. Kleven hereby withdraws his petition to cancel with prejudice.

Respectfully submitted this 4<sup>th</sup> day of May, 2006 by.

  
Marc Steven Colen

Law Offices of Marc Steven Colen  
20300 Ventura Blvd., Suite 120  
Woodland Hills, CA 91364  
Attorney for Petitioner, Max Kleven