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

Proceeding	92058411
Party	Plaintiff Luxco, Inc.
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/s/ Andrew Gilfoil

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

LUXCO, INC.,)	
)	
Petitioner/Counter Registrant,)	
)	
v.)	Cancellation No. 92058411
)	
OPICI IP HOLDINGS, LLC)	
)	
Registrant/Counter Petitioner.)	

**LUXCO’S REPLY IN SUPPORT OF ITS MOTION TO DISMISS
REGISTRANT/COUNTERCLAIM PETITIONER’S
SECOND AND THIRD COUNTERCLAIMS**

Petitioner/Counter Registrant Luxco, Inc. (“Luxco”), by and through its undersigned attorneys and pursuant to 37 C.F.R. 2.127(a), submits the following Reply Brief in support of its Motion to Dismiss Registrant/Counter Petitioner Opici IP Holdings, LLC (“Opici”)’s Second and Third Counterclaims [Dkt. 6]:

INTRODUCTION

The Board should grant the present motion and dismiss Opici’s nominated “second counterclaim” and “third counterclaim” for failure to state a claim upon which relief may be granted. Under the well-settled standard governing motions to dismiss, Opici must plead a valid statutory ground for cancellation of the subject registrations. In other words, Opici must provide factual matter that supports a claim “plausible on its face.” Opici does not dispute that “failure to

police use” is not an independent “statutory ground” for cancellation of an existing trademark registration under the Lanham Act. Instead, Opici offers inapposite legal commentary and case law addressing “genericide”—a claim that Opici has not alleged here. Opici’s request that the Board treat its second and third counterclaims as a subset of its first counterclaim is without factual or legal support and contrary to the way Opici purposefully identified its three alleged “independent counterclaims” as separate and distinct here. As Opici has failed to identify any valid statutory ground supporting its second and third counterclaims, the present motion should be granted and the referenced counterclaims should be dismissed.

ARGUMENT AND AUTHORITIES

I. “FAILURE TO POLICE” IS NOT A BASIS FOR CANCELLATION UNDER THE LANHAM ACT

To survive a motion to dismiss, Opici must allege facts supporting a “statutory ground” that negates Luxco’s right to maintain the subject registrations. *Petroleos Mexicanos v. Intermix SA*, 97 U.S.P.Q.2d 1403, 1404 (TTAB 2010). Opici does not dispute this settled legal standard. (See Opposition Br. [Dkt. 8], at p. 1.) Indeed, Opici agrees that for incontestable registrations those “statutory grounds” are expressly limited to claims that the mark: (1) has become generic, (2) has been abandoned, (3) was procured by fraud, or (4) is being used to misrepresent the source of the goods or services in connection with which it is used. (See *Id.* at p. 2.)

In response, Opici fails to state where Congress identified “failure to police” in the Lanham Act as an independent basis for cancellation of a federal trademark registration. The reason for this omission is plain: “failure to police” is not an enumerated ground for cancellation.

Opici similarly fails to heed the Board’s admonition that a petitioner cannot simply “recast” its allegations in an effort to avoid Congress’ explicit exclusion of certain claims against incontestable registrations. See *Otto Int. Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1864

(TTAB 2007)(finding that doing so would render Congress' explicit exclusion of claims for registrations older than five years meaningless); *see also Caymus Vineyards v. Caymus Medical, Inc.*, 107 U.S.P.Q.2d 1519, 1524 (TTAB 2013)(dismissing counterclaim, finding that "not inherently distinctive" counterclaim was not among those grounds that an incontestable registration could be challenged under the Lanham Act). In short, Opici's second and third counterclaims should be dismissed because Opici has failed to state any valid statutory ground for cancelling Luxco's REBEL registrations independent of Opici's alleged "abandonment" theory. *Young v. AGB Corp*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1989); *Caymus Vineyards*, 107 U.S.P.Q.2d at 1525.

II. OPICI'S SECOND AND THIRD COUNTERCLAIMS ARE NOT PLAUSIBLE ON THEIR FACE

Settled Board precedent requires Opici to provide sufficient factual matter stating a claim that is "plausible on its face." *Caymus Vineyards*, 107 U.S.P.Q.2d at 1522 (quoting *Ashcroft v. Iqbal*, 556 U.S. 662 (2009)). In particular, to state a claim that is "plausible on its face" Opici's counterclaims must provide well-pleaded factual matter and more than threadbare recitals supported by conclusory statements. *Id.* The Board has similarly held that dismissal is appropriate where, as here, the counterclaims fail to assert factual matter raising a claim that is allowable against an incontestable registration. *Id.* at 1524-25.

Simply stated, Opici's ill-pleaded second and third counterclaims fail to assert claims that are "plausible" on their face or otherwise put Luxco on adequate notice of what Opici claims. Is Opici asserting three independent counterclaims or only one? In its pleading, Opici asserts three independent counterclaims, each set out separately and independently numbered as to be separate and distinct. (*See Counterclaims [Dkt. 4], at p. 4.*) Now, in its response to Luxco's Motion to Dismiss (which of course is not Opici's operative pleading), Opici appears to suggest that its

independent second and third counterclaims are really just sub-specie of its first counterclaim alleging “abandonment.” (See Opp. Br. [Dkt. 8], at p. 3.) Luxco should not be forced to guess at the basis for Opici’s claims.

Regardless of how Opici wishes to characterize its second and third counterclaims, they should be dismissed for failure to state a claim upon which relief can be granted. If Opici’s pleading only asserts a single counterclaim based on an “abandonment” theory—as Opici now seems to claim in its response—then Opici’s second and third counterclaims should be dismissed as superfluous. *Caymus Vineyards*, 107 U.S.P.Q.2d at 1525 n. 9 (dismissing independent counterclaim, finding that same was subsumed in separate fraud claim and thus resolution of same would render separate counterclaim “moot”). In short, regardless of how Opici wants to couch its allegations, its second and third counterclaims fail to satisfy the Board’s pleading requirements and should be dismissed. *Caymus Vineyards*, 107 U.S.P.Q.2d at 1522.

CONCLUSION

For the reasons set forth above and in Luxco’s principal motion and memorandum, the Board should dismiss Opici’s denominated second and third counterclaims.

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Respectfully Submitted,

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