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

Proceeding	92058956
Party	Defendant 578539 B.C. Ltd.
Correspondence Address	PAUL W REIDL LAW OFFICE OF PAUL W REIDL 241 EAGLE TRACE DRIVE, SECOND FLOOR HALF MOON BAY, CA 94019 UNITED STATES paul@reidllaw.com
Submission	Motion to Dismiss - Rule 12(b)
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Date	05/09/2016
Attachments	Motion to Dismiss.pdf(60070 bytes)

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

3 Registration No. 4,156,487

4 Mark: MAICO and Design

5	_____)	
6	SOCAL MAICO,)	Cancellation No. 92058956
)	
7	Petitioner,)	RESPONDENT’S
)	MOTION TO DISMISS
8	v.)	
)	
9	578539 B.C Ltd.,)	
)	
10	Respondent.)	
	_____)	

11 Respondent hereby moves to dismiss the Amended Petition under Rule 12 (b)(6) for failure
12 to state a claim on which relief can be granted.

13 **PROCEDURAL BACKGROUND**

14 Petitioner is a competitor of Respondent’s. In its original Petition, Petitioner raised false
15 association, genericness, deceptiveness and fraud claims. (Docket No. 1). Specifically, it alleged
16 that the original German owner of the mark was defunct, that the mark had been “abandoned,” and
17 that Respondent was falsely suggesting a connection with the original owner.

18 In a related case, another competitor of Respondent’s, Mr. Eric Cook also petitioned to
19 cancel the registration. He made similar claims. The Board dismissed Mr. Cook’s petition with
20 prejudice because Mr. Cook failed to plead a claim that the Board could adjudicate. *Eric Cook v.*
21 *578539 B.C Ltd.*, No. 92058956 (Order of December 2, 2015)(Docket No. 16)(not precedential).
22 Specifically, the Board held that:
23
24

1 [T]here is no allegation that Petitioner is the owner of the mark
2 MAICO or its derivatives. Further, even if Petitioner is trying to
3 allege that he is the exclusive U.S. distributor of MAICO
4 goods under the mark MAICO ONLY, and he has not so alleged,
5 “it is settled law that between a foreign manufacturer and its
6 exclusive United States distributor, the foreign manufacturer is
7 presumed to be the owner of the mark unless an agreement between
8 them provides otherwise.” Here, Petitioner has not alleged that
9 there is an agreement between the German manufacturer/distributor
10 of MAICO motorcycles and parts that designates Petitioner as the
11 owner of the U.S. MAICO trademark

12 (See Id. at 5-6)(citations omitted.)

13 Petitioner and Mr. Cook are represented by the same attorney

14 In its Order of March 30, 2016, the Board granted Respondent’s Motion for Judgment on
15 the Pleadings (Docket No. 24). It allowed Petitioner to file an amended Petition on two possible
16 claims – likelihood of confusion and lack of ownership at the time the application was filed. (Order
17 at 11). The Board cautioned counsel regarding his obligations under Rule 11.

18 **THE CLAIMS SHOULD BE DISMISSED WITH PREJUDICE**

19 **A. LIKELIHOOD OF CONFUSION**

20 It is hornbook law that a proper likelihood of confusion claim under Section 2 (d) of the
21 Lanham requires the Petitioner to assert a proprietary interest in the trademark. See 15 U.S.C. §
22 1052 (d); *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156,1162 (Fed. Cir. 2002);
23 *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317 (CCPA 1981). Petitioner never so pleads.
24 Instead he pleads that Mr. Cook acquired the rights to the trademark from the United States
distributor for the German company (Petition Paragraphs 8 – 15),¹ and that consumers will
mistakenly believe that Respondent owns the MAICO trademark and that it is authorized by the

¹ One wonders how counsel could have pleaded this allegation consistent with Rule 11 when he did not make the allegation on behalf of his client, Mr. Cook, and the Board specifically adopted the absence of rights as a fact in its decision on the Cook Petition.

1 defunct German company. (Id. Paragraph 32). At bottom, this is simply a variation on the “false
2 association” theory that the Board has already dismissed. It is the same theory (less Mr. Cook’s
3 claimed ownership of the mark) that the Board dismissed in the Cook case. *Eric Cook v. 578539*
4 *B.C Ltd.*, No. 92058956 (Order of December 2, 2015, at pp. 3-6)(Docket No. 16)(not precedential).
5 The Board should dismiss the claim with prejudice because Petitioner has not pleaded a proprietary
6 interest in the mark, it has not pleaded any confusion with the owner of the alleged proprietary
7 interest (Mr. Cook), and it has not pleaded any basis for stepping into Mr. Cook’s shoes and
8 vindicating his rights. The only confusion alleged is with the defunct German company which is
9 a non-sequitur in light of the allegation that Mr. Cook acquired that company’s rights. In any
10 event, as the Board has held in both this case and the Cook case, alleged confusion with the defunct
11 German company simply is not actionable.

12 **B. OWNERSHIP**

13 In its Order, the Board held as follows:

14 The petition to cancel vaguely alludes to Respondent not being entitled
15 to the goodwill associated with the original MAICO mark for motorcycle
16 parts. This is insufficient to allege that Respondent was not the owner of
17 the mark when the underlying application was filed. In its opposition to
18 the motion for judgment on the pleadings, Petitioner asserts that Respondent
19 falsely claimed to be the owner of the mark, but fails to allege whether
20 Respondent is not the owner based on the existence of a legal successor
to the original owner of the MAICO mark (who is entitled to any
continuing good will created by the original owner), or whether Respondent
is not the owner based on Petitioner or a third party having adopted the abandoned
MAICO mark prior to Respondent. Petitioner also fails to allege what relationship
Petitioner has with any legal successor or third party adopter which would allow
Petitioner to assert their rights in this proceeding

21 (Order at 9-10)(Docket No. 24). Petitioner has failed to plead what the Board has required it to
22 plead.
23
24

1 Petitioner pleads an alternative reality regarding Mr. Cook that is contrary to the Board's
2 findings in Mr. Cook's case. It claims that Mr. Cook acquired the trademark rights from the
3 German company through the latter's previous United States importer. (Petition paragraphs 8-24).
4 It argues in the alternative that no one owns the trademark because it is in the public domain. (Id.
5 Paragraphs 25-27).

6 The claim should be dismissed because there is no allegation that Petitioner has any legal
7 relationship with Mr. Cook that would allow him to assert Mr. Cook's rights. More importantly,
8 any attempt to now assert Mr. Cook's claim on his behalf is legally precluded. Mr. Cook raised
9 his claims and judgment was entered against him. He should not be given a second chance to have
10 his alleged rights vindicated through the pleading of a surrogate (using the same attorney as Mr.
11 Cook who has filed two conflicting sets of factual allegations on the two Petitions.) Stated
12 somewhat differently, the only way that Petitioner could possibly plead a valid claim is if it could
13 step into Mr. Cook's shoes and assert his alleged rights, but it is barred from doing so because Mr.
14 Cook already had the opportunity to litigate that claim and he lost.

15 As for the mark allegedly being in the public domain, this is an improper muddling of
16 copyright and trademark concepts. Once a trademark is abandoned, anyone is free to adopt it. *See*
17 *General Motors Corp. v. Aristide & Co., Antiquaires de Marques*, 87 U.S.P.Q.2d 1179 (TTAB
18 2008). Petitioner has pleaded the the trademark was abandoned by the German company and he
19 should not now be permitted to plead the opposite. *See Airs Aromatics v. Victoria's Secret Store*
20 *Brand Management, Inc.*, 744 F.3d 595, 600 (9th Cir. 2014) (repleaded Complaint cannot
21 contradict the original allegations); *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925,
22 1929 n.10 (TTAB 2014) (Board did not grant leave to replead fraud claim due to futility and lack
23 of plausibility based on recited facts); *Institut National des Appellations d'Origine v. Brown-*

1 *Forman Corp.*, 47 U.S.P.Q.2d 1875, 1896 (TTAB 1998)(amendment would be futile because
2 opposer cannot prevail on claim as a matter of law). While it is true that there may be many third
3 party uses of the word mark MAICO, that in no way limits the ability of Petitioner *to apply to*
4 *register a specific form of design such as that at issue in this case.*

5 At bottom, the claim is nothing more than Petitioner's continued attempt to act as a
6 "private attorney general" to protect the market from what is perceived to be an injustice. It asserts
7 no proprietary rights in the mark.

8 **CONCLUSION**

9 For all of these reasons the Amended Petition should be dismissed with prejudice.

10 Respectfully submitted,

11 **LAW OFFICE OF PAUL W. REIDL**

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13 By: _____

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15 Dated: May 9, 2016

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22 *Attorney for Respondent,*
23 *578538 B.C. Ltd.*

1 **PROOF OF SERVICE**

2 On May 9, 2016 I caused to be served the following document:

3 **MOTION TO DISMISS**

4 on Petitioner by placing a true copy thereof in the United States mail enclosed in an envelope,
5 postage prepaid, addressed as follows to their counsel of record at his present business address:

6 Ken Dallara
7 Law Office of Ken Dallara
8 2775 Tapo Street
9 Suite 202
10 Simi Valley, California 93063

11 Executed on May 9, 2016 at Half Moon Bay, California.

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