

ESTTA Tracking number: **ESTTA732319**

Filing date: **03/09/2016**

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

Proceeding	92060209
Party	Plaintiff Rakuten, Inc.
Correspondence Address	GINA L DURHAM 555 MISSION STREET, SUITE 2400 SAN FRANCISCO, CA 94105-2933 UNITED STATES gina.durham@dlapiper.com
Submission	Other Motions/Papers
Filer's Name	Kerry A. O'Neill
Filer's e-mail	kerry.oneill@dlapiper.com
Signature	/Kerry A. O'Neill/
Date	03/09/2016
Attachments	Motion to Dismiss Cancellation.pdf(591565 bytes)

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

RAKUTEN, INC.,)	
)	Cancellation No.: 92/060,209
Petitioner,)	
)	Mark: SUPERPOINTS
)	Registration No.: 3,936,303
v.)	
)	
SUPERPOINTS LLC,)	
)	
Respondent.)	

MOTION TO DISMISS CANCELLATION AS MOOT

In the matter of Cancellation No. 92/060,209 regarding Registration No. 3,936,303, Petitioner Rakuten, Inc. (“Petitioner”), by and through its attorneys, hereby moves to dismiss this Cancellation with prejudice on the following grounds:

1. Respondent Superpoints LLC executed an assignment of Registration No. 3,936,303 to Petitioner on December 14, 2015.
2. The assignment was recorded on February 1, 2016 at Reel Frame No. 5721/298.
3. In view of the assignment to Petitioner of the registration involved herein, the Cancellation should be dismissed as moot.

A copy of the assignment is enclosed for the Board’s records.

WHEREFORE, Petitioner prays that the Board dismiss this Cancellation with prejudice.

Respectfully submitted,

RAKUTEN, INC.

Dated: March 9, 2016

By: /s/ Gina L. Durham
DLA PIPER LLP (US)

Gina L. Durham
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Attorneys for Petitioner

EXHIBIT A

Assignment

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM371471

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Superpoints, LLC		12/14/2015	LIMITED LIABILITY COMPANY: TEXAS
RECEIVING PARTY DATA			
Name:	Rakuten, Inc.		
Street Address:	1-14-1 Tamagawa, Setagaya-ku		
Internal Address:	Rakuten Crimson House		
City:	Tokyo		
State/Country:	JAPAN		
Postal Code:	1-14-1		
Entity Type:	CORPORATION: JAPAN		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	3936303	SUPERPOINTS	
CORRESPONDENCE DATA			
Fax Number:	4156597333		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	415-836-2506		
Email:	TMDocket@dlapiper.com		
Correspondent Name:	DLA Piper LLP (US)		
Address Line 1:	555 Mission Street, Suite 2400		
Address Line 2:	Attn: Gina Durham, Esq.		
Address Line 4:	San Francisco, CALIFORNIA 94105-2933		
ATTORNEY DOCKET NUMBER:	388140000011		
NAME OF SUBMITTER:	Gina Durham		
SIGNATURE:	/Gina Durham/		
DATE SIGNED:	02/01/2016		
Total Attachments: 8			
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TRADEMARK ASSIGNMENT

This Trademark Assignment (the "*Trademark Assignment*") is entered into and is effective as of December 14, 2015 (the "*Effective Date*"), by and between Superpoints, LLC, a Texas limited liability company having a place of business at 145 Corta Madera Town Cntr #445, Corta Madera CA 94925 (the "*Assignor*"), and Rakuten, Inc., a Japanese corporation having a place of business at Rakuten Crimson House, 1-14-1 Tamagawa, Setagaya-ku, Tokyo JAPAN (the "*Assignee*").

The Assignor hereby transfers and assigns to Assignee, effective as of the Effective Date, all worldwide right, title, and interest in and to the trademarks, trade names, service marks, applications and registrations described in Schedule A, which is attached hereto and is incorporated by reference herein, and the goodwill of the business associated therewith (collectively, the "*Marks*").

For good and valuable consideration by Assignee, the receipt and sufficiency of which are hereby acknowledged, the Assignor does hereby assign unto the Assignee, as of the Effective Date, all of its right, title, and interest in and to the Marks, free and clear of all liens and encumbrances, including any and all common law rights thereof and applications and registrations therefor, together with the goodwill of the business associated with and symbolized by such Marks, the applications and registrations therefor, and any rights of the Assignor to sue any third parties for any past infringement of or to the Marks, for the use and behalf of Assignee and its successors, assigns or other legal representative and to prosecute such applications and registrations in the United States Patent and Trademark Office or in any foreign jurisdiction.

After the Effective Date, at the request of the Assignee, at Assignor's expense and without additional consideration to the Assignor, the Assignor will execute and deliver to the Assignee, from time to time such further instruments of conveyance, transfer, and assignment and other documents, and will take such other actions, as the Assignee may reasonably require to convey and deliver more effectively to the Assignee the Marks, to perfect the Assignee's title thereto, and otherwise to accomplish the orderly transfer to the Assignee of the Marks and to give full effect to this Trademark Assignment.

This Trademark Assignment is binding on the Assignor and its respective successors and assigns, and inures to the benefit of the Assignee and its successors and assigns.

This Trademark Assignment may be executed in any number of counterparts, each of which shall be deemed an original and all of which taken together shall be deemed to constitute one and the same instrument. An executed signature page of this Trademark Assignment delivered by facsimile or PDF transmission shall be as effective as an original executed signature page.

[Signatures on Following Page.]

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IN WITNESS WHEREOF, intending to be legally bound hereby, the parties hereto have duly executed this Trademark Assignment.

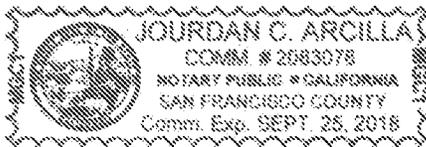
SUPERPOINTS, LLC

Dated: 12/14/15

By: [Signature]
Name: Ryan Fournace
Title: CEO

This 14th day of DEC. 2015, before me personally came the before-mentioned known as the individual who executed the foregoing Trademark Assignment, who acknowledged to me that he executed the same of his own free will for the purposes and consideration therein expressed, and in the capacity therein set forth.

Witness my hand and Notarial seal the day and year immediately above-written.



[Signature]
Notary Public
JOURDAN ARCILLA,
NOTARY PUBLIC

RAKUTEN, INC.

Dated: 10/12/2015

By: [Signature]
Name: Akio Sugihara
Title: Managing Executive Officer and Director

Schedule A

Trademarks/Service Marks

Jurisdiction	Trademark	Application No. / Registration No.	Filed / Issued
United States	SUPERPOINTS	U.S. Trademark Registration No. 3936303	September 3, 2009/March 29, 2011

DOMAIN AND SOCIAL MEDIA ASSIGNMENT

This Domain and Social Media Assignment (this "*Assignment*") is executed pursuant to that certain Confidential Settlement Agreement and Release dated as of December 14, 2015 (the "*Effective Date*") entered into by and between SUPERPOINTS, LLC, a limited liability company organized and existing under the laws of the State of Texas and RYAN KOONCE, an individual domiciled in California, (collectively, the "*Assignor*"), on the one hand, and RAKUTEN, INC., a corporation organized under the laws of Japan (the "*Assignee*"), RAKUTEN CARD CO. LTD, a corporation organized under the laws of Japan, and RAKUTEN CARD USA INC., a corporation organized and existing under the laws of the State of Delaware, on the other hand (the "*Settlement Agreement*"), and is effective as of the Effective Date.

RECITALS

A. Assignor is the owner of all right, title and interest in, to and under the domain name and registrations for www.superpoints.com and the other domain names related to Assignor's business listed in Schedule A, attached hereto and incorporated by reference (the "*Domain Names*"); and

B. Assignor is the owner of the social media handles at Twitter (the Twitter handle @SuperPoints) and the other social media handles related to Assignor's business listed in Schedule B, attached hereto and incorporated by reference (the "*Handles*"); and

C. Assignor has agreed to assign, transfer and convey to Assignee all its right, title and interest in, to and under the Domain Names and the Handles (collectively referred to herein as the "*Domain Assets*"), including all common law rights, and all the goodwill of the business associated therewith.

AGREEMENT

1. Assignment. For good and valuable consideration by Assignee, the receipt and sufficiency of which are hereby acknowledged, the Assignor does hereby assign unto the Assignee, as of the Effective Date, all of its right, title, and interest in and to the Domain Assets, free and clear of all liens and encumbrances, and all other rights, including common law rights, relating to the Domain Assets, each to be held and enjoyed by the Assignee for its own use and benefit and for the use and benefit of its successors, assigns and legal representatives as said rights would have been held and enjoyed by Assignor had this Assignment not been made.

2. Assignment Procedure for Domain Names and Handles.

2.1. *Procedure for Domain Names*. Within five (5) days of the Effective Date, Assignor shall promptly take steps required by the applicable domain name registrar ("*Registrar*") to effectuate and/or record the transfer of the Domain Names from Assignor to Assignee, or Assignee's designee, with such Registrar. Assignee shall provide to Assignor all registration and contact details pertaining to Assignee that are required by such Registrar.

2.2. Procedure for Handles. Assignee shall receive login credentials for the Twitter.com /@Superpoints account and for all other Handles by 5 pm PST on the Effective Date. Assignee shall receive only the Handles, and none of the content created by Assignor for and under these Handles. Assignor shall migrate and delete any of its content hosted under these Handles on or before the expiration of the Transition Period, as such term is defined in the Settlement Agreement. With respect to Handles that are used with Facebook.com, Assignor shall add a designee of Assignee as an "admin" of the Facebook.com page. Assignee's admin shall deactivate admin functions of Assignor at the expiration of the Transition Period.

2.3. Attorney-In-Fact. In the event that Assignee is unable for any reason whatsoever to secure Assignor's signature to any document Assignor is required to execute pursuant to the foregoing, Assignor hereby irrevocably designates and appoints Assignee and its duly authorized officers and agents, as their agents and attorneys-in-fact to act for and in its behalf and instead of Assignor, to execute and file any such document and to do all other lawfully permitted acts to further the purposes of the foregoing with the same legal force and effect as if executed by Assignor.

3. Additional Documents. Assignor agrees to take such other reasonable actions as are required to transfer the Domain Assets to Assignee as required under this Assignment. At Assignee's request, Assignor will execute and deliver such other documents as may be reasonably required to confirm, evidence, or establish Assignee's rights to the Domain Assets. Assignee agrees to pay all out-of-pocket costs actually incurred by Assignor in connection with such a request.

4. Severability. The invalidity of any provision of this Assignment or a portion of a provision shall not affect the validity of any other provision of this Assignment or the remaining portion of the applicable provision.

5. Binding Effect. This Assignment shall be for the benefit of and be binding upon the parties hereto, and their successors and assignees. Nothing in this Assignment, express or implied, shall confer on a person other than the parties hereto, and their respective successors and assigns, any rights, remedies, obligation or liabilities under or by reason of this Assignment.

6. Amendments. This Assignment shall not be modified or amended except pursuant to an instrument in writing executed and delivered on behalf of each of the parties.

7. Counterparts. This Assignment may be executed in any number of counterparts, each of which when executed and delivered shall be deemed an original; such counterparts shall together constitute but one agreement.

[Signature Page Follows]

IN WITNESS WHEREOF, intending to be legally bound hereby, the parties hereto have duly executed this Domain and Social Media Assignment, effective as of the Effective Date.

SUPERPOINTS, LLC

Dated: 12/14/15

By: [Signature]
Name: RYAN KOENIG
Title: CEO

This 14th day of Dec, 2015, before me personally came the before-mentioned known as the individual who executed the foregoing Domain and Social Media Assignment, who acknowledged to me that he executed the same of his own free will for the purposes and consideration therein expressed, and in the capacity therein set forth.

Witness my hand and Notarial seal the day and year immediately above-written.



[Signature]
Notary Public

Jourdan Arcilla, Notary Public

RAKUTEN, INC.

Dated: Dec. 10, 2015

By: [Signature]
Name: Akio Sugihara
Title: Managing Executive Officer and Director

Schedule A

Domain Names

www.superpoints.com
www.superpoints.info
www.superpoints.net
www.superpoints.ca
www.superpoints.us
www.superpoints.tv
www.superpoints.co.uk
www.superpoints.co

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Schedule B
Social Media Handles

Social Media	Handle	Username and Password
Twitter	/@SuperPoints	

Facebook Handles

Social Media	Handle	Name of Rakuten designated admin
Facebook	www.facebook.com/superpointslc	Yumiko Tajima yumiko.tajima@rakuten.com Aya Ishida aya.ishida@rakuten.com

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing MOTION TO DISMISS CANCELLATION AS MOOT was served on March 9, 2016 by United States Mail, first-class, postage paid to the following counsel of record:

JEFFREY E FAUCETTE
SKAGGS FAUCETTE LLP
ONE EMBARCADERO CENTER, SUITE 500
SAN FRANCISCO, CA 94111
UNITED STATES
jeff@skaggsfaucette.com
Phone: 415-315-1669

/s Kerry A. O'Neill _____
Kerry A. O'Neill
DLA PIPER LLP (US)
1251 Avenue Of The Americas
New York, NY 10020-1104
United States
Attorneys for Petitioner

