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

Proceeding	92062050
Party	Plaintiff Kamal Karmakar
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 4657862

Petition to Cancel No: 92062050

For the mark “VEND (and design)”

Kamal Karmakar,

Petitioner

v.

Vend Limited,

Registrant

MOTION FOR RECONSIDERATION OF FINAL DECISION

Petitioner, Kamal Karmakar, responds to the November 16, 2015 decision and requests reconsideration under TBMP 544, 37 CFR §2.129(c): “Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 CFR §2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence (see *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978), and *In re Cosmetically Yours, Inc.*, 171 USPQ 563 (TTAB 1971)), nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a

demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change.”

In the November 16, 2015 decision, the Board concluded that the Respondent’s motion to dismiss (hereinafter “Motion”) was conceded by the Petitioner. However, the Motion did not seek to dismiss Petitioner’s claim of Priority and Likelihood of confusion under Trademark Section 2(d) and the Petitioner did not concede Petitioner’s claim of Priority and Likelihood of confusion under Trademark Section 2(d). The motion only sought to dismiss the claim under Section 2(a) and the claim under Section 2(e). See, for example:

“As detailed below, Petitioner has failed to state a claim of Mere Descriptiveness under Section 2(e), and failed to state a claim of False Suggestion of a Connection under Section 2(a) of the Trademark Act, 15 U.S.C. §§ 1052(a) & (e). Accordingly, Petitioner’s above claims should be dismissed. In addition, Respondent respectfully requests suspension of all proceedings pending disposition of this motion.” Motion at page 1.

* * *

“For all of the above reasons, Petitioner has failed to state a claim of False Suggestion of a Connection under Section 2(a) upon which relief may be granted, and the claim must be dismissed.” Motion at page 5.

* * *

“Accordingly, Petitioner has failed to state a claim of Mere Descriptiveness under Section 2(e) upon which relief may be granted, and this claim must be dismissed.” Motion at Page 6.

In the Motion, Respondent admits that the Motion does not address all of Petitioner’s claims: “Respondent reserves the right to challenge the sufficiency of **Petitioner’s other claims and pleadings**, and this motion does not contain a complete recitation of Respondent’s defenses or waive any of Respondent’s rights to defend this matter.” Motion at Page 3, Footnote 1, emphasis supplied.

In particular, the Motion did not seek dismissal of Petitioner’s claim of Priority and Likelihood of confusion under Trademark Section 2(d). See also: “Trademark Rule 2.117 provides that proceedings may be suspended pending disposition of a potentially dispositive motion or upon a showing of good cause. Respondent’s motion to dismiss is potentially dispositive of Petitioner’s Section 2(a) and Section 2(e) claims in this proceeding. Accordingly, **Respondent respectfully requests that all proceedings not germane to the motion to dismiss be suspended pending disposition of the motion.**” Motion at page 6, emphasis supplied.

To reiterate, the Motion did not seek dismissal of Petitioner’s claim of Priority and Likelihood of confusion under Trademark Section 2(d).

On September 28, 2015, the Board suspended the Petition to Cancel.

In reliance on the absence of a request by Respondent to dismiss Petitioner’s claim of Priority and Likelihood of confusion under Trademark Section 2(d), the Petitioner did not file a response to the Motion. It was the Petitioner’s intention to proceed with the Petition to Cancel based on the Trademark Section 2(d) claim present in the petition.

The Petitioner's allegations in the Petition to Cancel demonstrate that the Petitioner has standing and that Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d) is legally sufficient on its face. Petitioner has alleged facts in the Petition to Cancel showing that the Petitioner has standing to maintain the proceeding and the Petitioner has demonstrated that a valid ground exists for cancelling the subject registration due to Priority and Likelihood of confusion. See, for example, Petition allegations 1-18; and note, for example (emphasis provided):

9. **There is no issue as to priority.** Registrant acquired no rights in Registration no. 4657862 before Petitioner acquired rights in Petitioner's Marks.

10. Petitioner uses Petitioner's Marks to offer closely related services and products as those listed in Registration no. 4657862 . As such, Registrant's planned or actual use of its "VEND (and design)" mark in connection with the goods/service listed in Registration no. 4657862 **is likely to cause confusion with Petitioner's Marks..** Petitioner's Marks and Registration no. 4657862 both have "VEND" in common, which constitutes a distinctive aspect of each mark. In addition, the goods/services in Petitioner's Marks and the goods/services in Registration no. 4657862 operate through the same channels of trade.

11. In view of the similarity and related nature between the goods/services in Registration no. 4657862 and the goods/services of Petitioner's Marks, Registrant's use of the trademark in Registration no. 4657862 **is likely to result**

in confusion, mistake, or deception with Petitioner's Marks, or in the belief that Registrant or its services are in some way legitimately connected with, licensed or approved by Petitioner.

* * *

13. Registration no. 4657862 will damage Petitioner because Registrant's use of Registration no. 4657862 **would be confusingly similar to Petitioner's Mark being used on closely related goods/services. As such, Applicant's proposed or actual use of the goods/services in Registration no. 4657862 is likely to cause confusion, deception, and/or mistake among the consuming public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).**

14. Petitioner will be further damaged by Registration no. 4657862 because such registration will support and assist Registrant in the **confusing and misleading use of the "VEND (and design)" mark**, and will give color of exclusive statutory rights to Registrant in violation and derogation of **the prior and superior rights of Petitioner.**

In the Motion, the Respondent acknowledged Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d): "As grounds for the cancellation, the ESTTA cover page identifies: 'False suggestion of a connection' under 'Trademark Act Section 2(a); **Priority and Likelihood of confusion**' under '**Trademark Act Section 2(d)**;' and 'The mark is merely descriptive' under 'Trademark Act Section 2(e)(1).' The contents of the Petition, however, allege only two claims: **COUNT 1 – Priority and Likelihood of Confusion [sic]**

Merely Descriptive: Trademark Section 2(d)' (Dkt. 1, p. 2.)..." Motion page 2 (emphasis provided).

TBMP 503.02 states in pertinent part: "A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *See, for example, Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985). In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for cancelling the subject registration (in the case of a cancellation proceeding). *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982);"

The pleadings in the petition meet these requirements and show that with respect to the Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d) that: (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the subject registration. In the Motion, the Respondent did not attempt to dismiss Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d). Therefore, the Motion did not meet its burden to dismiss Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d), nor did the Motion meet its burden to dismiss the Petition to Cancel, and as such, the Petition to Cancel should not have been dismissed.

For the foregoing reasons and based on the evidence of record and the prevailing authorities, the Board erred in reaching its decision to dismiss the Petition to Cancel. The Petitioner requests that the Petition to Cancel be reinstated and continue with Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d).

In the alternative, if the Board finds the subject Petition to be defective with respect to Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d), the Petitioner respectfully requests that pursuant to TBMP 503.03 that the Petition to Cancel be reinstated and that the Board grant Petitioner leave to amend its Petition, which is freely given when justice so requires. See also TBMP § 507.02, which states: "If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading." See Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Petitioner maintains that the subject Petition for Cancellation is sufficient on its face as properly showing standing, and properly providing grounds for Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d); and that the dismissal of Petitioner's claim of Priority and Likelihood of confusion under Trademark Section 2(d) and therefore, the cancellation of the Petition to Cancel were in error.

The Petitioner respectfully requests that the Petition to Cancel be reinstated and proceed with the Respondent filing an Answer to ensure that the parties have a full opportunity to present their respective cases. However, in the alternative, if the Board finds the subject Petition to be

defective, Petitioner respectfully requests that the Board reinstate the Petition to Cancel and grant the Petitioner leave to amend its Petition, which is freely given when justice so requires.

Respectfully submitted,

/BruceMargulies/

11/23/2015

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Date

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Certificate of Service

I certify that on the date noted below, I caused a copy of the foregoing MOTION FOR RECONSIDERATION OF FINAL DECISION to be transmitted by First Class U.S. Mail to the Registrant at the following address:

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11/23/2015
Date

/BruceMargulies/
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