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

Proceeding	92062050
Party	Defendant Vend Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KAMAL KARMAKAR, Petitioner v. VEND LIMITED, Respondent.	Cancellation No. 92062050 Registration No. 4657862 Mark: vend Registered: Dec. 16, 2014

RESPONDENT'S COMBINED MOTION TO DISMISS
AND MOTION TO SUSPEND

Vend Limited ("Respondent") moves to dismiss Kamal Karmakar's ("Petitioner") Petition for Cancellation ("Petition") for failure to state a claim under Fed. R. Civ. P. 12(b)(6). 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.

I. MOTION TO DISMISS

A. The Petition for Cancellation

On August 14, 2015, Petitioner filed a Petition to Cancel Respondent's Registration No. 4657862 for the mark VEND & Design shown above for various computer software in International Class 9, business management and administration services in International Class 35,electronic data storage in International Class 39, and non-downloadable software in International Class 42 (the "VEND Mark").

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.) and "COUNT 2 – Merely Descriptive: Trademark Act Section [sic] 2(d), 15 USC Section 1052(e)." (Dkt. 1, p. 10.) The Petition does not contain a separate "COUNT" for a "False Suggestion of a Connection" claim, but Petitioner does cite Section 2(a) within the "COUNT 1" discussion.

On the same date, the Board instituted the cancellation proceeding, and allowed Respondent forty days up to and including September 27, 2015 (which falls on a Sunday, so the deadline is the next business day, Monday, September 28, 2015) to file an Answer or otherwise plead. (Dkt. 2.)

In lieu of an Answer, Respondent files this motion to dismiss.

B. Argument

A motion to dismiss for failure to state a claim upon which relief can be granted tests the legal sufficiency of a complaint. To withstand such a motion, a pleading must allege facts that would, if proved, establish that Petitioner is entitled to the relief sought, i.e., that Petitioner has standing to maintain the proceeding and that a valid ground exists for cancelling the registration.[1] *Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). *See also* TBMP § 503.02 (3d ed. 2013).

A valid ground for cancellation that must be alleged (and ultimately proved) based on the grounds enumerated in the Trademark Act, namely, the statutory grounds pertaining to the right to obtain and maintain a registration. *Young*, 47 USPQ2d at 1754. For purposes of determining a motion to dismiss, all of Petitioner's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to Petitioner. *Id.*

1. Petitioner has Failed to State a Claim of False Suggestion of a Connection Under Section 2(a), 15 U.S.C. § 1052(a)

Petitioner has failed to state a valid claim of False Suggestion of a Connection under Section 2(a) of the Trademark Act. Section 2(a) bars registration of a mark that falsely suggests a connection with persons, living or dead, or institutions, beliefs, or national symbols. To assert a claim of false suggestion of a connect, Petitioner must plead (and eventually prove):

1. The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution;

[1] 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.

2. The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;

3. The person or institution identified in the mark is not connected with the goods sold or services performed by respondent under the mark; and

4. The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when respondent's mark is used on its goods and/or services.

See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 217 USPQ 505, 508-10 (Fed. Cir. 1983); *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

Petitioner has failed to allege any of the required factors under Section 2(a). The Petition contains only a conclusory allegation that "Registrant's proposed use of the goods/services in Registration no. 4657862 suggests that Registrant is planning to trade off the valuable goodwill that Petitioner has developed in Petitioner's Marks. Accordingly, Petitioner will be damaged by Registration no. 4657862 because consumers will be likely to believe, falsely, that Registrant's services are authorized, sponsored or approved by Petitioners or that Registrant is otherwise affiliated or connected with Petitioner, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a)." (Dkt. 1, Pet. ¶ 12.) This allegation is insufficient to state a claim of False Suggestion of a Connection. *See Am. Hygienic Labs., Inc. v. Tiffany & Co.*, 228 USPQQ 855, 859 (TTAB 1986) (Pleading "that the mark sought to be registered . . . falsely suggests a connection between applicant and opposer" failed to state a claim under § 2(a)). Indeed, Petitioner's statement does not even allege that there is a false suggestion of a connection; it only alleges that consumers are "likely to believe" that Petitioner has authorized, sponsored, or approved Respondent's services.

Further, Petitioner has failed to allege that his alleged IVEND mark is famous or that it points "uniquely and unmistakably" to Petitioner's name, identity or persona. *See Internet Inc. v. Corp. for Nat'l Research Initiatives*, 38 USPQ2d 1435, 1436-1438 (TTAB 1996) (dismissing Section 2(a) claim where pleading did not allege mark was "uniquely and unmistakably" associated with petitioner). Nor has Petitioner alleged that IVEND would be recognized by others as Petitioner's name, identity or persona. *Id.* Any one of these deficiencies requires dismissal of Petitioner's Section 2(a) claim. *See Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993).

Moreover, the Board has routinely dismissed Section 2(a) claims where, as here, a plaintiff conflates Sections 2(d) and 2(a), and the underlying pleaded facts relate exclusively to the issue of likelihood of confusion under a Section 2(d) claim. *Miller Brewing Co.*, 27 USPQ2d at 1713. Petitioner alleges, for example, that he has used its IVEND marks to promote "its *goods/services*" (Dkt 1., Pet. ¶ 2), but he does not allege any of the above required factors under Section 2(a). Unlike a Section 2(d) claim, a Section 2(a) claim must assert that Petitioner's mark is famous and it points "uniquely and unmistakably" to Petitioner, as an identifier of his name or *corporate persona*, rather than as an identifier of the source of particular goods. *Miller Brewing Co.*, 27 USPQ2d at 1713. Petitioner has failed to make any such allegations.

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.

2. Petitioner Has Failed to State a Claim of Mere Descriptiveness Under Section 2(e), 15 U.S.C. § 1052(e)

Petitioner has failed to state a valid ground for cancellation based on Mere Descriptiveness under Section 2(e) of the Trademark Act.[2] Section 2(e) bars registration on the Principal Register of a mark that is merely descriptive, but does not bar registration on the Supplemental Register. *See In re Bush Bros. & Co.*, 884 F.2d 569 (Fed. Cir. 1989) (for mark on the Supplemental Register is capable of becoming distinctive); *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, n. 3 (TTAB 1998). Thus, Petitioner cannot bring a clam of Mere Descriptiveness against Respondent's Supplemental Registration.

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.

II. MOTION TO SUSPEND

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.

[2] Petitioner's Count 2 heading on p. 10 includes references to both "Trademark Act Section 2(d)" *and* "Merely Descriptive" and "15 U.S.C. Section 1052(e)." For purposes of this motion, we assume Petitioner is alleging a claim of Mere Descriptiveness under Trademark Section 2(*e*).

III. CONCLUSION

For the foregoing reasons and authorities, Respondent respectfully requests that its Combined Motion to Dismiss Amended Petition and Motion to Suspend be granted.

Respectfully Submitted,

Dated: September 28, 2015

/Linda McLeod /

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AMENDED CERTIFICATE OF SERVICE – Cancellation No. 92062050

I hereby certify that on September 28, 2015, a true and correct copy of the RESPONDENT'S COMBINED MOTION TO DISMISS AND MOTION TO SUSPEND filed as Docket # 5 on September 28, 2015 was served by United States first-class mail, postage prepaid, on Petitioner's counsel at the following address of record:

BRUCE MARGULIES
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