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

Proceeding	92062356
Party	Defendant Air1st Aviation Companies, Inc. dba Air1st
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Submission	Motion to Dismiss - Rule 12(b)
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Date	04/19/2016
Attachments	Motion to Dismiss (final).pdf(88635 bytes) Brief in support (final) withexhibits.pdf(1149933 bytes)

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

<p>CONCORDE BATTERY CORPORATION</p> <p>Opposer,</p> <p>v.</p> <p>AIR 1ST AVIATION COMPANIES, INC.,</p> <p>Applicant.</p>	<p>Opposition No. 91224081 (parent) Mark: PLATINUM SERIES Ser. No. : 86/497,484</p>
<p>CONCORDE BATTERY CORPORATION</p> <p>Petitioner,</p> <p>v.</p> <p>AIR 1ST AVIATION COMPANIES, INC. AND MITSUBISHI HEAVY INDUSTRIES AMERICA, INC.</p> <p>Respondents.</p>	<p>Cancellation No. 92062356 Mark: PLATINUM SERIES MU-2 Reg. No.: 4,726,130</p>

**MITSUBISHI HEAVY INDUSTRIES AMERICA, INC.’S
MOTION TO DISMISS UNDER RULE 12(b)(6)**

Respondent, Mitsubishi Heavy Industries America, Inc. (“Mitsubishi”), by and through counsel and pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, hereby respectfully moves the Trademark Trial and Appeal Board (“Board”) for an order dismissing Mitsubishi from the above-referenced cancellation proceeding, as amended by the First Amended Petition for Cancellation, filed by Petitioner Concorde Battery Corporation (“Concorde”). The Amended Petition should be dismissed with respect to Mitsubishi because Petitioner Concorde has failed to state a claim upon which relief can be granted. Specifically, Mitsubishi is not the current owner of the Reg. No. 4,726,130 for PLATINUM SERIES MU-2

("Registration), and as the non-owner of the Registration, Mitsubishi is an improper party to this proceeding and should be dismissed from this proceeding.

WHEREFORE, for the reason stated above and provided in the Brief in Support of Mitsubishi Heavy Industries America, Inc.'s Motion to Dismiss Under Rule 12(b)(6), Mitsubishi respectfully prays that the Board grant this Motion dismissing the Amended Petition respect to Mitsubishi, removing Mitsubishi as a party to this proceeding.

This 19th day of April 2016.

Respectfully submitted,

/Deborah L. Lively/
Deborah L. Lively

THOMPSON & KNIGHT, LLP
1722 Routh Street, Suite 1500
Dallas, TX 75201
214-969-1700 (phone)
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ATTORNEYS FOR MITSUBISHI
HEAVY INDUSTRIES AMERICA, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on counsel for Concorde Battery Corporation, by mailing said copy on April 19, 2016, via First Class U.S. Mail, postage prepaid to:

Paul Bost, Esq.
Sheppard, Mullin, Richter & Hampton, LLP
1901 Avenue of the Stars Suite 1600
Los Angeles, CA 90067

This 19th day of April 2016.

/Deborah L. Lively/
Deborah L. Lively

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

CONCORDE BATTERY CORPORATION Opposer, v. AIR 1 ST AVIATION COMPANIES, INC., Applicant.	Opposition No. 91224081 (parent) Mark: PLATINUM SERIES Ser. No. : 86/497,484
CONCORDE BATTERY CORPORATION Petitioner, v. AIR 1 ST AVIATION COMPANIES, INC. AND MITSUBISHI HEAVY INDUSTRIES AMERICA, INC. Respondents.	Cancellation No. 92062356 Mark: PLATINUM SERIES MU-2 Reg. No.: 4,726,130

**MITSUBISHI HEAVY INDUSTRIES AMERICA, INC.’S BRIEF IN SUPPORT OF
MOTION TO DISMISS UNDER RULE 12(b)(6)**

FACTUAL BACKGROUND

On April 16, 2013, Air 1st Aviation Companies, Inc. (“Air 1st”) filed with the U.S. Patent and Trademark Office (“USPTO”) a use-based application for registration on the principal register for the mark PLATINUM SERIES MU-2 (the “Mark”), which registered on the Principal Register on April 28, 2015 as U.S. Reg. No. 4,726,130 (the “Registration”).

On March 1, 2015, prior to the issuance of the Certificate of Registration for the Mark, Air 1st assigned to Mitsubishi its entire right, title and interest in and to the Mark, together with

the goodwill symbolized by the Mark.¹ See Exhibit A. Mitsubishi granted Air 1st a license to continue its use of the Mark following the Mark's assignment to Mitsubishi. On information and belief, Air 1st currently uses and has continually used the Mark since at least as early as the application filing date and has been the only party using the Mark in its entirety during this time.

On September 28, 2015, Concorde Battery Corporation ("Concorde") filed a Petition to Cancel the Registration ("Petition"), citing two grounds for cancellation: (1) likelihood of confusion, and (2) failure to use as a trademark. It served the Petition on Air 1st, and Air 1st filed its answer on November 11, 2015. Mitsubishi was not aware of either of these pleadings at the time they were filed and served.

On January 13, 2016, Concorde filed with the Board the Motion to Join Mitsubishi Heavy Industries America, Inc. as a Party Defendant and for Leave to Amend Its Notice of Opposition and Petition for Cancellation (the "Amended Petition"), which among other changes, added Mitsubishi as another defendant in this proceeding. Concorde neither served Mitsubishi with this Motion nor provided any notice to Mitsubishi regarding the filing of this Motion. On April 4, 2016, the Board entered an order granting Concorde's motion, and Concorde then served Mitsubishi with this order by first class mail.

Upon Mitsubishi's receipt of the Amended Petition and the Trademark Trial and Appeal Board's order granting the motion for this Amended Petition, Mitsubishi and Air 1st reached an agreement for Air 1st to re-acquire all rights to the Registration. On April 8, 2016, Mitsubishi assigned to Air 1st the entire right, title and interest that Mitsubishi had in and to the Mark, together with the goodwill symbolized by the Mark, including the Registration. This assignment was filed with the USPTO on April 11, 2016, and Concorde's counsel was immediately

¹ The Assignment was recorded with the USPTO on October 16, 2015, at reel/frame 005647/0319.

informed. *See Exhibit B.*² Accordingly, Air 1st is the current owner of all right, title and interest in and to the Registration, and upon information and belief is the sole user of the Mark in its entirety. In addition to the assignment of the Mark (including the Registration) to Air 1st, Mitsubishi also granted Air 1st with the limited right to use Mitsubishi's MU-2 mark within the Mark, subject to certain terms and conditions.

Upon the recordation of the April 8, 2016 assignment of the Mark (including the Registration) to Air 1st, Mitsubishi provided Concorde's counsel, Paul Bost, with notice of such assignment on April 12, 2016, and requested that Concorde withdraw the Amended Petition with respect to Mitsubishi. Concorde refused to grant this request, even though Mitsubishi was no longer the owner of the Registration or the Mark and had never used the Mark³—all use of PLATINUM SERIES MU-2 has been by Air 1st, either as owner or licensee of the Mark.

ARGUMENT

Under Rule 12(b)(6), “to survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim for relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544 (2007)). Furthermore, “a complaint should be dismissed for improper party as a matter of law.” *Pierre v. Schlemmer*, 932 F. Supp. 278, 279 (M.D. Fla. 1996). In the Amended Petition, Concorde seeks cancellation of the Registration, but Concorde also identifies Mitsubishi as a registrant of the Mark. Mitsubishi is not the owner of the Registration, and thus, is an improper defendant in this proceeding. Under 15 U.S.C. § 1119, cancellation proceedings may only proceed against a

² As of the filing date of this Motion, the assignment reel/frame was not available.

³ Mitsubishi is the owner of MU-2 (U.S. Reg. No. 4,605,448) and MU-2 LIMITED EDITION (U.S. Reg. No. 3,702,499).

federal registration; therefore, only the owner of such registration can be a party. *See Informix Software, Inc. v. Oracle Corp.*, 927 F. Supp. 1283, 1286 (N.D. Cal. 1996).

Mitsubishi has no current ownership rights in the Registration or the Mark, and it was not the original applicant for the Mark. At no time has Mitsubishi used the Mark or has it made any filing with the USPTO for the Mark other than to record the initial assignment of the Mark from Air 1st. Because Mitsubishi is not the current owner of the Registration, there is no case or controversy with respect to Mitsubishi in this proceeding. *See, e.g., Hokto Kinoko Co. v. Concord Farms, Inc.* 810 F. Supp. 2d 1013, 1034 (C.D. Cal. 2011) (holding that the a party’s claim for trademark cancellation should proceed against the party that currently owns the mark and not the former owner of the registrations); *see also Informix Software, Inc.* at 1286 (holding “the owner of a trademark is the only proper defendant” in a suit for cancellation). Accordingly, the only proper defendant in the present action is Air 1st—the current registrant. Mitsubishi cannot possibly provide any of the relief sought under the Amended Petition because it owns no rights in the Registration and has no authorization to request a withdrawal of registration.

The courts that have addressed the issue of whether a non-trademark owner can be a proper defendant in an action to cancel a trademark have held uniformly that the statute requires the action to proceed only against the current owner of the mark. *Ann Arbor T-Shirt Company, LLC v. Lifeguard Licensing Corp.* 2016 WL 1323784, at *6 (E.D. Mich. April 5, 2016); *see, e.g., Van Well Nursery, Inc. v. Momy Life Ins. Co.*, 421 F. Supp. 2d 1321, 1332 (E.D. Wash. 2006) (“[Section 1119 of the Lanham Act] suggests that a complaint for trademark cancellation should proceed against the party who currently owns the trademark”); *Iowa Health Sys. v. Trinity Health Corp.*, 177 F. Supp. 2d 897, 911 (N.D. Iowa 2001) (finding that “the owner of the...mark [is]

thus the only proper [defendant on] a claim for cancellation of the mark”). Therefore, the Amended Petition with respect to Mitsubishi does not state a claim for relief that is even possible.

CONCLUSION

For the reasons discussed above, Concorde’s Amended Petition for cancellation should be dismissed with respect to Mitsubishi because Mitsubishi is not a proper party to the Amended Petition or this cancellation proceeding, and accordingly, the petition for cancellation fails as a matter of law as it relates to Mitsubishi.

This 19th day of April 2016.

Respectfully submitted,

/s/Deborah L. Lively
Deborah L. Lively

THOMPSON & KNIGHT, LLP
1722 Routh Street, Suite 1500
Dallas, TX 75201
214-969-1700 (phone)
214-9691751 (fax)

ATTORNEYS FOR MITSUBISHI
HEAVY INDUSTRIES AMERICA, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on counsel for Concorde Battery Corporation, by mailing said copy on April 19, 2016, via First Class U.S. Mail, postage prepaid to:

Paul Bost, Esq.
Sheppard, Mullin, Richter & Hampton, LLP
1901 Avenue of the Stars Suite 1600
Los Angeles, CA 90067

This 19th day of April 2016.

/s/Deborah L. Lively
Deborah L. Lively

EXHIBIT A

TRADEMARK ASSIGNMENT

This Trademark Assignment is made and entered into by Air 1st Aviation Companies, Inc. d/b/a Air 1st ("Air 1st"), a Georgia corporation, whose address is 234 Air Park Blvd., Aiken, South Carolina 29805 ("ASSIGNOR") in favor of Mitsubishi Heavy Industries America, Inc. ("MHIA"), a Delaware corporation, whose address is 4951 Airport Parkway, Suite 530, Addison, Texas 75001 ("ASSIGNEE").

WHEREAS, ASSIGNOR is the owner of record of common law and statutory rights in and to U.S. Serial No. 86/089204 for PLATINUM SERIES MU-2 (the "Mark"); and

WHEREAS, ASSIGNEE has obtained a license from Assignee to use the Mark in association with Assignor's business; and

WHEREAS, in light of the foregoing, this Trademark Assignment is intended to effectuate a full and complete assignment by ASSIGNOR to ASSIGNEE of all rights in and to the Trademarks.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR hereby assigns, conveys and transfers to ASSIGNEE, its successors, assigns and legal representatives ASSIGNOR'S entire right, title and interest in and to the Mark, together with the goodwill symbolized by the Mark, and any and all trademark applications and renewals and all registrations or certificates that may be issued or granted for the Mark throughout the United States and in any and all other countries of the world, as well as the right to sue for and recover damages for past, present and future infringements and all rights of priority.

IN TESTIMONY WHEREOF, Assignor has caused its duly authorized representative to execute this Trademark Assignment as of March 1st, 2015.

Air 1st Aviation Companies, Inc.

By: Michael S. Laver
Name: MICHAEL S LAVER
Title: PRESIDENT

EXHIBIT B



United States Patent and Trademark Office

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TRADEMARK ASSIGNMENT COVER SHEET

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SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Mitsubishi Heavy Industries America, Inc.		04/08/2016	Corporation:
RECEIVING PARTY DATA			
Name:	Air 1st Aviation Companies, Inc. d/b/a Air 1st		
Street Address:	234 Air Park Blvd		
City:	Aiken		
State/Country:	SOUTH CAROLINA		
Postal Code:	29805		
Entity Type:	Corporation: GEORGIA		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	4726130	PLATINUM SERIES MU-2	

CORRESPONDENCE DATA

Fax Number: 7067221822

Phone: 8032922208

Email: msnyder@wsmclaw.com

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.

Correspondent Name: Mitchell Snyder

Address Line 1: PO Box 1495

Address Line 4: Augusta, GEORGIA 30903

NAME OF SUBMITTER:

Mitchell B. Snyder

Signature:

/Mitchell B. Snyder/

Date:

04/11/2016

Total Attachments: 1

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RECEIPT INFORMATION

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TRADEMARK ASSIGNMENT

This Trademark Assignment is made and entered into by Mitsubishi Heavy Industries America, Inc., a Delaware corporation, whose address is 4951 Airport Parkway, Suite 530, Addison, Texas 75001 ("MHIA") in favor of Air 1st Aviation Companies, Inc. d/b/a Air 1st, a Georgia corporation, whose address is 234 Air Park Blvd., Aiken, South Carolina 29805 ("Air 1st").

WHEREAS, MHIA acquired the right, title, and interest in and to Reg. No. 4,726,130 for PLATINUM SERIES MU-2 (the "Mark") by assignment from Air 1st, who filed the application for the PLATINUM SERIES MU-2 mark that issued as Reg. No. 4,726,130;

WHEREAS, MHIA now wishes to assign all right, title, and interest in and to the Mark back to Air 1st as set forth herein;

WHEREAS, in light of the foregoing, this Trademark Assignment is intended to effectuate a full and complete assignment by MHIA to Air 1st of all rights in and to the Mark.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, MHIA hereby assigns, conveys and transfers to Air 1st, its successors, assigns and legal representatives MHIA's entire right, title and interest in and to the Mark, together with the goodwill symbolized by the Mark, and the trademark application and renewal and registration or certificate that may be issued or granted for the Mark throughout the United States, as well as the right to sue for and recover damages for past, present and future infringements and all rights of priority.

IN TESTIMONY WHEREOF, MHIA has caused its duly authorized representative to execute this Trademark Assignment as of April 8, 2016.

Mitsubishi Heavy Industries America, Inc.

By: K. Takeuchi

Name: Kensuke Takeuchi

Title: General Manager APD