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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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**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
REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS**

INTRODUCTION

In its brief Opposer/Petitioner, Concorde Battery Corporation (“Concorde”) argues that Mitsubishi Heavy Industries America, Inc. (“Mitsubishi”) should be forced into the proceeding because of a short, five-month period that Mitsubishi possessed the rights related to the PLATINUM SERIES MU-2 mark even though Mitsubishi never used the PLATINUM SERIES MU-2 mark (“Mark”), currently does not own any rights in or to the Mark, and cannot provide any relief sought by Concorde. This is not the law and does not facilitate the efficient adjudication of this proceeding.

Mitsubishi's sole connection to this proceeding stems from an agreement made with Applicant/Registrant Air 1st Aviation Companies, Inc. ("Air 1st") on March 1, 2015, prior to Concorde's filing of its Petition for Cancellation to cancel the registration for the Mark, U.S. Reg. No. 4,726,130 (the "Registration"). Concorde now seeks to complicate this proceeding by joining, unnecessarily, a party for which there is no basis for a claim for relief. In neither its Motion to Join Mitsubishi as a Party Defendant and For Leave to Amend its Notice of Opposition and Petition for Cancellation nor in its response to Mitsubishi's Motion to Dismiss does Concorde provide a basis for any claim for which Mitsubishi can provide relief. Simply put, Mitsubishi cannot possibly provide any of the relief sought under the Amended Petition because it owns no rights in the Registration and has no authority to surrender the Registration. Furthermore, 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 party's claim for trademark cancellation should proceed against the current owner of the registrations and not the former owner); *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.

ARGUMENT

In its response to Mitsubishi's Motion to Dismiss, Concorde fails to assert that Mitsubishi's presence in the proceeding facilitates discovery or is beneficial to its adjudication. Furthermore, Concorde fails to cite any basis or articulate any reason why Mitsubishi should be joined as a party in this proceeding beyond Concorde's claim that the Trademark Trial and Appeal Board Manual of Procedure and two cases allow for this—specifically, the following:

TBMP § 512.01; *NSM Res. Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 1031 (TTAB 2014); and *Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1422, 1434 (TTAB 2007). Those references cited by Concorde contemplate facts distinctly different from those at issue in this proceeding and set forth in Mitsubishi's Motion to Dismiss. In those cases, the assignee who is joined as party to the Trademark Trial and Appeal Board ("TTAB") proceeding is the current trademark owner, and thus, controls the relevant mark. Concorde essentially oversimplifies the issue by suggesting that any assignee of a mark is a proper party to a TTAB proceeding. This, however, is an assumption that would be illogical and flawed if applied uniformly in all cases where a mark has undergone a change in ownership, especially in the case of multiple conveyances of title, as in the case here.

Three critical facts are present here—Mitsubishi was not the original applicant; all use of the Mark was and is currently used by Air 1st (as either the owner of the Mark or the licensee of the Mark); and Mitsubishi is not the current owner of the Mark or Registration. In its response to Mitsubishi's Motion, Concorde claims, without citation to any applicable authority, that "Mitsubishi does not cease to be an appropriate party merely because, after the commencement of the proceedings, it purports to have assigned its rights in the PLATINUM SERIES MU-2 Mark, including the registration, to Air 1st." (Concorde's Response Brief p. 5). Yet, both the TTAB and federal case law support Mitsubishi's claim that Mitsubishi is not an appropriate party to the cancellation proceeding due to the transfer of its rights in the PLATINUM SERIES MU-2 Mark to Air 1st and that the proper party is the current assignee of the Mark. For example, in the TTAB cancellation proceeding of *Binney & Smith, Inc. v. Magic Marker Ind., Inc.*, Magic Marker Industries, Inc., was substituted as a defendant in place of the original applicant following the recordation of multiple documents reflecting changes in ownership of the

trademark that occurred during the proceeding. 222 USPQ 1003, 1004 n.1,8 (TTAB 1984). In *Liberty & Co. v. Liberty Trouser Co.*, the TTAB substituted the trademark assignee in place of the original applicant/assignor during the opposition proceeding in which the assignment was recorded after the applicant's answer had been filed. 216 USPQ 65, 66 n.1 (TTAB 1982). In both of these cases before the TTAB, each assignee (and current owner of the mark) replaced the prior trademark owner as a party in the proceeding. *See also, e.g., Hokto Kinoko Co. v. Concord Farms, Inc.*, 810 F. Supp. 2d 1013, 1034 (C.D. Cal. 2011); *see also, e.g., Informix Software, Inc. v. Oracle Corp.*, 927 F. Supp. 1283, 1286 (N.D. Cal. 1996). Clearly, both the Board and federal courts provide precedent for the facts applicable in Mitsubishi's Motion to Dismiss.

Concorde's criticism of "irrelevant case law" cited by Mitsubishi fails to acknowledge that the reasoning in the federal cases is equally applicable to the current action. (Concorde's Response p. 6). What should be noted is that Concorde has not cited a single authority supporting the facts as set forth herein, whereby a party who has been joined in a Board proceeding does not currently own the mark at issue in the proceeding. There is no plausible claim for relief that Concorde can assert against Mitsubishi.

Conclusion

Rule 12(b)(6) of the Federal Rules of Civil Procedure requires that 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. Concorde has simply not met this standard. There is no relief in the current proceeding that Mitsubishi can provide. Concorde has failed to cite one instance of a party being joined to a TTAB proceeding who does not currently own the Mark at issue in the proceeding. Furthermore, Concorde has made no attempt to argue why Mitsubishi should be joined and made no claim that Mitsubishi's joinder is necessary or even beneficial to the

proceeding. Mitsubishi is a party who has never used the Mark at issue in this proceeding,¹ currently does not own or possesses any right to use any Mark in this proceeding, and can provide no relief sought by Concorde whatsoever.

Mitsubishi can add nothing to this proceeding. Mitsubishi should be dismissed.

Dated: May 25, 2016

Respectfully submitted,

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¹ All use of PLATINUM SERIES MU-2 has been solely by Air 1st (either as owner of the Mark or as a licensee).

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the Reply Brief to Mitsubishi Heavy Industries America, Inc.'s Motion to Dismiss has been served on counsel for Concorde Battery Corporation and to counsel for Air 1st Aviation Companies, Inc. by mailing said copy on May 25, 2016, via First Class U.S. Mail to:

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