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

Proceeding	92064181
Party	Defendant DiMarzio, Inc.
Correspondence Address	DIMARZIO INC 1338 RICHMOND TERRACE, PO BOX 100387 STATEN ISLAND, NY 10310 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
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Date	09/09/2016
Attachments	Motion to Dismiss.pdf(14646 bytes)

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

In the Matter of Trademark Registration No. 1,169,205
Registered on September 15, 1981

_____)	
ANDREW R FLANDERS)	
)	
Petitioner,)	
)	Cancellation No. 92064181
v.)	
)	Registration No. 1,169,205
DIMARZIO, INC)	
)	
)	
Registrant.)	
_____)	

DIMARZIO, INC'S MOTION TO DISMISS

DiMarzio, Inc. ("Registrant"), by and through its counsel, pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure ("Fed.R.Civ.P.") and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure (the "TBMP"), and in lieu of an Answer, moves the Trademark Trial and Appeal Board (the "Board") for an Order dismissing Andrew R Flanders' ("Petitioner") petition to cancel U.S. Trademark Registration No. 1,169,205 (the "'205 Mark"), initiated on August 3, 2016 (the "Petition for Cancellation"), for Petitioner's failure to allege facts sufficient to demonstrate the requisite standing to cancel the '205 Mark (the "Motion"). For the reasons set forth below, the Motion should be granted in its entirety, with prejudice.

ARGUMENT

A petition for cancellation of a U.S. trademark registration must include, inter alia, a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing). See 37 CFR § 2.104(a); Young v.

AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752, 753 (TTAB 1985). Damage can be established by a showing that petitioner has “real interest” in the case. See Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). “To plead a “real interest,” plaintiff must allege a “direct and personal stake,” in the outcome of the proceeding.” TBMP § 309.03(b); See also Empresa Cubana del Tabaco v. General Cigar Co., 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

Standing has been found where there is a claim of likelihood of confusion with another mark that is not wholly without merit (see, for example, Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000)), whether based upon ownership of a valid registration (Id.), including a mark on the Supplemental Register (see Otter Products LLC v. BaseOneLabs LLC, 105 USPQ2d 1252, 1254 (TTAB 2012)), or prior use of a similar mark (see, for example, First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc., 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007)). Standing has also been found where plaintiff has been refused registration, advised it will be refused registration, or has a reasonable belief that registration will be refused because of defendant’s registration. See, for example, Empresa Cubana del Tabaco v. General Cigar Co., 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); Mattel Inc. v. Brainy Baby Co., 101 USPQ2d 1140, 1142 (TTAB 2011); Weatherford/Lamb Inc. v. C&J Energy Services Inc., 96 USPQ2d 1834, 1837 (TTAB 2010). Plaintiffs likewise has been found to have standing where plaintiff is about to file an intent to use application to register a mark with a bona fide intent to use the same mark for related goods. See American Vitamin Products Inc. v. Dow Brands Inc., 22 USPQ2d 1313, 1314 (TTAB 1992). Standing has also been found where plaintiff is part of a class of potential purchasers it alleges are disparaged or brought into

contempt or disrepute by the mark. See Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1024 (Fed. Cir. 1999); McDermott v. San Francisco Women’s Motorcycle Contingent, 81 USPQ2d 1212, 1214 (TTAB 2006), aff’d unpub’d, 240 Fed. Appx. 865 (Fed. Cir. 2007), cert. denied, 552 U.S. 1109 (2008). Standing has also been found where there is another proceeding between plaintiff and defendant and defendant has either relied on the mark or asserted a likelihood of confusion claim involving the cited marks. See Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857, 859 (TTAB 1986); M. Aron Corp. v. Remington Products, Inc., 222 USPQ 93, 96 (TTAB 1984). Further, standing has been found, in the context of claims of genericness or descriptiveness, where plaintiff is a competitor. Target Brands Inc. v. Hughes, 85 USPQ2d 1676, 1679 (TTAB 2007); Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp., 94 USPQ2d 1549, 1553 (TTAB 2009).

Petitioner has not alleged any facts sufficient to show that it is or will be damaged by the ‘205 Mark, as it has not established any “direct and personal stake” in the outcome of the Proceeding. Petitioner does not allege any claim of likelihood of confusion, refusal of a registration, a bona fide intent to use the mark and file an intent to use application for same, another proceeding between the parties involving the mark, or that plaintiff is a competitor (in regards to a descriptiveness or genericness issue). All that Petitioner alleges, in regards to his alleged damage, is that, “[t]he [‘205 Mark] prevents consumers from purchasing aftermarket humbucking pickups that will color-match the existing cream colored plastic retainers included with their electric guitars, unless they choose to purchase from [Registrant].” See Petition for Cancellation. Even assuming such statement to be true, such alleged damage does meet the standard for damage to establish Petitioner’s standing, as it does not establish that Petitioner has any “real interest” or “direct and personal stake” in the outcome of the Proceeding. Although

Petitioner may be a potential purchaser, he does not allege, nor can he, that he would be disparaged or brought into contempt or disrepute by the mark. As such, Petitioner has no standing to bring the Petition for Cancellation.

Finally, upon information and belief, and based upon Registrant's counsel's investigation of Petitioner based on the limited facts provided in the Proceeding, Petitioner cannot, without violating Rule 11 of the Fed.R.Civ.P, make any allegations of fact satisfy standing as expressed above. In the interest of saving the Board's time and resources, the Proceeding should be dismissed with prejudice.

CONCLUSION

For the reasons stated above, Registrant's Motion should be granted in its entirety, with prejudice, as Petitioner has not alleged sufficient facts that, if proven, would establish standing to maintain this Proceeding.

Dated: September 9, 2016
Lyndhurst, New Jersey

Respectfully submitted,

SCARINCI & HOLLENBECK, LLC

By: /s Brent M. Davis, Esq. _____
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COUNSEL FOR REGISTRANT

CERTIFICATE OF MAILING

I, Brent M. Davis, Esq., hereby certify that the foregoing DiMarzio, Inc.'s Motion to Dismiss has today been deposited with the United States Postal Service on the date below as first class mail, postage prepaid, in an envelope addressed as follows:

Mr. Andrew R Flanders
4406 S 189th Street
Seatac, WA 98188

September 9, 2016
Date

s/ Brent M. Davis, Esq.
Brent M. Davis, Esq.

CERTIFICATE OF FILING

I hereby certify that this correspondence, including all enclosures and attachments, is being transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, via the TTAB's ESTTA procedure on September 9, 2016.

September 9, 2016
Date

s/ Brent M. Davis, Esq.
Brent M. Davis, Esq.