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January 30, 2007

Box TTAB

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: *Vanilla Box, Inc. v. House of Blues Brands Corp.*
Opposition No.: 91174717
Mark: FOUNDATION ROOM
Attorney Docket No. 064163.0077

Dear Madam:

Enclosed please find the following for filing in the above-identified matter:

- Applicant's Motion to Dismiss for Opposer's Failure to State a Claim; and
- A return receipt acknowledgment postcard.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment in the fees indicated above to Deposit Account No. 01-0477.

Respectfully submitted,



Daniel Moffett

Enclosures

02-02-2007

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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

VANILLA BOX, INC.,	§	
	§	Serial Nos. 78/728,092; 78/728,201,
Opposer,	§	78/728,306
	§	
v.	§	Opposition No. 91174717
	§	
HOUSE OF BLUES BRANDS CORP.	§	
	§	Mark: FOUNDATION ROOM
Applicant.	§	

APPLICANT'S MOTION TO DISMISS FOR OPPOSER'S FAILURE TO STATE A CLAIM

Pursuant to Federal Rule of Civil Procedure 12(b)(6), Applicant, House of Blues Brands Corp., files this motion to dismiss Opposer's claim in the alternative that is based on Opposer's alleged priority of use in Massachusetts. Opposer's claim in the alternative, which is asserted in Paragraph 17 of Opposer's Consolidated Notice of Opposition, fails to state a claim upon which relief can be granted and should therefore be dismissed by the Board.

In its Notice of Opposition, Opposer asserted that the above-referenced applications should be denied because Applicant's FOUNDATION ROOM trademark is merely descriptive and, alternatively, because Opposer had prior rights to the mark in Massachusetts. In support of this second claim, Opposer alleged that it has been using the mark FOUNDATION LOUNGE in Massachusetts "from a date prior to Applicant's filing date" (October 6, 2005) and that it has acquired common law rights to FOUNDATION LOUNGE *in Massachusetts*. See Notice of Opp'n ¶ 5. Notably, Opposer does not allege that it began using FOUNDATION LOUNGE prior to June, 1994, the date of first use stated in Applicant's use-based trademark applications. Accordingly, these allegations amount to an assertion that Opposer is a good faith junior user of the FOUNDATION LOUNGE mark in the State of Massachusetts.

Opposer relies on these allegations in support of its claim in the alternative that Applicant's FOUNDATION ROOM applications should be denied based on Opposer's priority of use in Massachusetts. Notice of Opp'n ¶ 17. But, even if Opposer were able to prove these allegations, it cannot prove that the applications should be denied based on Opposer's alleged status as a good faith junior user because no such claim exists. It is well settled that "the fact that a subsequent user adopts a mark in good faith in a territory where the prior user's mark has not been known or used will not preclude registration of a prior user's mark." *Hollowform, Inc. v. Aeh*, 515 F.2d 1174, 1176, 185 U.S.P.Q. 790, 791 (CCPA 1975) (stating that a good faith junior user cannot be legally "damaged" by registration of a mark because its rights in the mark are inferior to the prior user's right to registration). *See also Giant Food, Inc. v. Malone & Hyde, Inc.*, 522 F.2d 1386, 1394, 187 U.S.P.Q. 374, 381 (CCPA 1975). The proper forum for Opposer's claim is a concurrent use proceeding, not an opposition. *See Giant Food*, 522 F.2d at 1394; 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:17 (4th ed. 2006).


The Board has authority to dismiss a claim pursuant to Fed. R. Civ. P. 12(b)(6) if it appears to a certainty that the Notice of Opposition fails to allege any facts that would support that claim. *See Space Base, Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1218 (TTAB 1990). Therefore, because Opposer's claim based on its alleged prior use of the mark in Massachusetts cannot preclude registration of Applicant's mark, even if true, the Board should dismiss Opposer's alternative claim set out in Paragraph 17 of the Consolidated Notice of Opposition.

Prayer

WHEREFORE, Applicant respectfully requests that the Board dismiss Opposer's claim in the alternative for failure to state a claim upon which relief can be granted.

Respectfully submitted,

Date: 1/30/2007


By: 

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to: Box TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Name of Person Signing Certificate: Daniel Moffett


Signature: 

Date of Mailing: 1/30/2007

CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S MOTION TO DISMISS FOR OPPOSER'S FAILURE TO STATE A CLAIM was served on the following counsel this 30th day of January, 2007, via regular U.S. Mail, postage pre-paid:

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