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

Proceeding	91182207
Party	Plaintiff Johnson & Johnson and Roc International S.A.R.L.
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JOHNSON & JOHNSON and	:	
ROC INTERNATIONAL S.A.R.L.	:	
Opposers,	:	
v.	:	Opp. No. 91/182,207 (parent)
		91/184,467
OBSHESTVO S OGRANITCHENNOY;	:	
OTVETSTVENN OSTIU "WDS",	:	
Applicant.	:	

**RESPONDENTS' MOTION TO DISMISS PETITIONER'S
COUNTERCLAIM FOR CANCELLATION OF REG. NO. 1,015,041**

Opposers and Counterclaim Respondents, Johnson & Johnson and RoC International S.A.R.L. ("Respondents"), by and through undersigned counsel, hereby request that the Trademark Trial and Appeal Board (the "Board") dismiss the Counterclaim filed by Applicant and Counterclaim Petitioner, Obschestvo S Ogranitchennoy; Otvetstvenn Ostiu WDS's ("Petitioner"), for Cancellation of Reg. No. 1015041 (the "Cancellation Counterclaim") based on Petitioner's failure to state a claim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

BACKGROUND

Petitioner seeks partial cancellation of Respondents' Reg. No. 1,015,041 – RoC on the ground of abandonment. As the sole statutory basis for its claim, Petitioner relies on Section 18 of the Trademark Act, 15 U.S.C. § 1068. See Cancellation Counterclaim, unnumbered paragraph immediately preceding ¶ 32.¹

¹ The unnumbered paragraph between paragraphs 31 and 32 of Applicant's Second Amended Answer and Counterclaim states: "Applicant hereby seeks partial cancellation of Opposer Roc International's Registration No. 1015041 due to abandonment. As grounds for the Counterclaim, pursuant to Trademark Act § 18, 15 U.S.C. § 1068 and TBMP §§ 309.03(d), 313.01, it is alleged that:"

The Board, in an order dated June 29, 2011, granted Petitioner's December 13, 2010 motion for leave to amend to add the Cancellation Counterclaim. In doing so, the Board's order stated that a party adequately pleads and can prevail on a counterclaim for partial cancellation on the ground of abandonment if such party alleges and eventually proves: (1) standing; and (2) abandonment of the mark, as to the particular goods, as the result of nonuse or other conduct by the registrant. *See* Board's Order dated June 29, 2011. Noting that the Board "liberally grants leave to amend pleadings," the Board's Order stated that Applicant had pled facts sufficient to state a prima facie case of abandonment. *Id.*

However, Petitioner, through its pleading, has not pled and thus is not pursuing a pure abandonment claim, as erroneously assumed by the Board's June 29, 2011 Order. Rather, Applicant's Cancellation Counterclaim is premised *solely* on Section 18 and Sections 309.03(d) and 313.01 of the Trademark Trial and Appeal Board Manual of Procedure ("T.B.M.P.").²

Respondents now bring this motion to dismiss on grounds that Petitioner fails to state a claim for relief under Section 18 of the Trademark Act.

STANDARD OF REVIEW

The Board must dismiss a petition to cancel under Rule 12(b)(6) if it fails to state a claim that is "plausible on its face." T.B.M.P. § 503.02, citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *see also Advanced Cardiovascular Sys Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). The purpose of Fed. R. Civ. P. 12(b)(6) "is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants

² TBMP Sections 309.03(d) and 313.01, relied upon in Petitioner's pleading, merely describe the Board's current practice and procedure with respect to Section 18. As noted in the Introduction to the TBMP, the purpose of the manual is provide practitioners with useful information for practicing before the Board. The TMBP *does not* serve as a substitute for applicable statutes, codified regulations, or binding Board precedent.

the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys.*, 26 U.S.P.Q.2d at 1041, citing *Neitzke v. Williams*, 490 U.S. 319, 326-27 (1989). When ruling on a motion to dismiss, the Board must accept the factual allegations pleaded in the complaint as true, but “[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim.” *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998).³

When tested against these established standards for deciding a Rule 12(b)(6) motion to dismiss, Petitioner’s allegations under Section 18 of the Trademark Act fail as a matter of law.

ARGUMENT

Section 18 of the Trademark Act gives the Board authority to cancel registrations in whole or in part. 15 U.S.C. § 1068; Trademark Rule 2.111(b), 37 C.F.R. 2.111(b); T.B.M.P. 309.03(d). Accordingly, a counterclaim for partial cancellation of a registration by deletion of specific items from the registrant’s identification of goods is in the nature of an equitable remedy, and is not an independent attack on the validity of the subject registration. See T.B.M.P. 313.01, citing *Dak Industries, Inc. v. Daiichi Kosho Co.*, 35 U.S.P.Q.2d 1434, 1437 (T.T.A.B. 1995); *Eurostar, Inc. v. “Euro-Star” Reitmoden GmbH*, 34 U.S.P.Q.2d 1266, 1271 n.3 (T.T.A.B. 1995). Furthermore, the equitable remedy of partial cancellation under Section 18 is available “only if the petitioner alleges (and later proves) that a likelihood of confusion will be avoided if the registration is restricted in the manner sought by the petitioner. . . .” *Eurostar*, 34 U.S.P.Q.2d at 1272; see also TBMP 313.01

³ More recently, the United States Supreme Court has clarified that sufficient factual matter must be pled to survive a motion to dismiss. *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009) (holding that “[t]o survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’”) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Under this standard, the plaintiff must plead “factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Iqbal*, 129 S. Ct. at 1949. Although it remains the case that the court must accept the well-pleaded factual allegations as true, “factual content” is required and the court need not, and indeed, should not, accept allegations that are “no more than conclusions” as sufficient to sustain a claim. *Iqbal*, 129 S. Ct. at 1950.

(under Section 18, “[t]he counterclaimant must allege that the partial cancellation will avoid a likelihood of confusion and that the registrant does not use the mark on the goods or services for which deletion is sought”).

In contrast, “[a] claim in which the plaintiff seeks to delete specific items on the grounds that the defendant is no longer using, and has no intent to resume use of its mark on those goods or services, is not a claim under Trademark Act § 18, but is essentially a ‘straightforward’ pleading of abandonment” pursuant to 15. U.S.C. § 1117 T.B.M.P. 309.03(d), citing *DAK Industries*, 35 U.S.P.Q.2d at 1437 (where Applicant sought to delete certain goods from Opposer’s registration on the basis that Opposer was no longer using and had no intent to resume, proper pleading was for abandonment); *see also* TBMP 313.01 (“a counterclaim to delete goods or services from the registration on the ground that registrant does not use the mark on those goods or services and has no intent to resume use, without regard to likelihood of confusion, is a straightforward abandonment claim and not a claim under Trademark Act § 18 . . .”).

In this case, Petitioner’s Cancellation Counterclaim brought under Section 18 is legally insufficient and is “fatally flawed” on its “legal premise,” and therefore should be dismissed under F.R.C.P. 12(b)(6). *See Advanced Cardiovascular*, 26 U.S.P.Q.2d at 1041. The equitable remedy of partial cancellation under Section 18 requires Petitioner to allege (and later prove) that deletion of the requested goods from Registrant’s registration will avoid likelihood of confusion with Petitioner’s opposed application. *Eurostar*, 34 U.S.P.Q.2d at 1272; TBMP 313.01. Because Petitioner’s Cancellation Counterclaim pleads *only* Section 18, *and* fails to plead avoidance of likelihood of confusion, it is facially deficient and must be dismissed as a matter of law. Whether or not Petitioner might have pled a prima facie abandonment claim under Sections 14 and 45 of the Trademark Act, 15 U.S.C. §§ 1064 and 1127 and *Dak* is of no moment, as Petitioner is entitled to,

and has, defined the precise abandonment claim that it wishes to pursue. Here, Petitioner chose Section 18, but failed to plead all necessary elements of such a claim.⁴ Petitioner is bound by its own choice of claims as set forth in its pleadings.

Because Petitioner fails to plead the necessary prerequisites of a claim based solely on Section 18, the Cancellation Counterclaim is legally insufficient and should be dismissed under F.R.C.P. 12(b)(6).

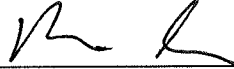
CONCLUSION

For the foregoing reasons, Respondents respectfully requests that the Board dismiss Petitioner's Cancellation Counterclaim in its entirety. Further, as this is a dispositive motion, Respondents request a suspension of the proceeding pending the determination of this motion, pursuant to 37 C.F.R. § 2.127(d) and T.B.M.P. § 510.

Respectfully submitted,

JOHNSON & JOHNSON and
ROC INTERNATIONAL S.A.R.L.

By: _____


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⁴ Petitioner's Cancellation Counterclaim pleads only: (1) Respondents' nonuse of the RoC mark shown in Reg. No. 1,015,041 for skin powder, rouge, and liquid foundation; and (2) Respondents' lack of intent to resume use of the RoC mark in Reg. No. 1,015,041 in connection with skin powder, rouge, and liquid foundation. It makes no mention at all as to whether the equitable relief it seeks would avoid a likelihood of confusion.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENTS' MOTION TO DISMISS PETITIONER'S COUNTERCLAIM FOR CANCELLATION OF REG. NO. 1,015,041** was served on Applicant this 27th day of July 2011, via first-class mail to:

Erik M. Pelton Esq.
ERIK M. PELTON & ASSOCIATES, PLLC
P.O. Box 100637
Arlington, VA 22210

A handwritten signature in black ink, appearing to be 'Erik M. Pelton', is written over a horizontal line.