ESTTA Tracking number: **ESTTA236789**

Filing date: **09/15/2008**

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

Proceeding	91185600
Party	Defendant Icon Brands Group, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	09/15/2008
Attachments	515.11 Opposition MOtion to Dismiss.pdf (8 pages)(57111 bytes) 515.11 Opposition MOtion to Dismiss.2.pdf (1 page)(31658 bytes)

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Iconix Brand Group, Inc. Opposer v. Icon Brands Group, Inc. Applicant	Opposition No.: 91185600 Serial No. 77176965

APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

Applicant, Icon Brands Group, Inc., hereby moves for dismissal of Opposer's Notice of Opposition based on Opposer's failure to state a claim upon which relief can be granted, and based on Opposer's apparent lack of standing. This motion is made pursuant to TBMP § 503 and Fed. R. Civ. Pro. 12(b)(6).

After consultation with counsel for the Opposer, it appears that the Opposer does not consent to the relief sought in this motion.

MEMORANDUM IN SUPPORT

The Notice of Opposition identifies the Opposer as Iconix Brand Group, with no indication as to what this opposer does, or what business it is engaged in, or how it has any interest in this opposition. The Notice of Opposition does not suggest that Iconix Brand Group is engaged in any business related to that described in the application. Iconix Brand Groups appears to be a mere intermeddler, with no indication that it has an interest in this opposition. Regarding each basis put forth for opposition, the Notice of Opposition is deficient in that it avoids alleging facts necessary to establish the ground for opposition.

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff must allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. TBMP § 503.02. At the pleading stage, the Opposer must establish both. Young v. AGB Corp., 152 F.3d 1377, 47 U.S.P.Q. 2d 1752, 1755 (Fed. Cir. 1998). Opposer has done neither.

To establish standing, an opposer must allege facts establishing a "real interest" in the proceedings and a

"reasonable" basis for his belief in damage. Ritchie v. Simpson, 170 F.3d 1092, 50 U.S.P.Q. 2d 1023 (Fed. Cir. 1999). The purpose of requiring standing is to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer is no more than an intermeddler. Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 U.S.P.Q. 184, 189 (CCPA 1982).

Regarding standing, Opposer has provided no facts which indicate that it will be harmed by the registration. From the pleadings, the Opposer is a mere interloper. In Otto International, Inc. v. Otto Kern Gmbh, 83 U.S.P.Q.2d 1861 (TTAB 2007), the petitioner owned conflicting trademark registrations. In the present case, the Opposer has pleaded no trademark rights in a conflicting name, trademark or service mark. Opposer has not even pleaded that it engages in any business that is related to the goods and services described in the application. It certainly has not suggested that its name, ICONIX BRAND GROUP, is confusing similar to IIKONN BRANDS GROUP. Accordingly, per the pleadings, Opposer has not established that is has any interest whatsoever in the proceedings, or that it has any reasonable belief that it would be damaged in any way bY the registration.

Opposer's allegation of abandonment is insufficient. It consists of a mere conclusory statement of abandonment. As stated in Otto International:

> In order to set forth a cause of action to cancel the registration of a mark which assertedly has been abandoned, plaintiff must allege ultimate facts pertaining to the alleged abandonment. See Clubman's Club Corporation v. Martin, 188 USPQ 455, 456 (TTAB 1975). The facts alleged must set forth a prima facie case of abandonment by a pleading of at least three consecutive years of non-use or must set forth facts that show a period of non-use less than three years coupled with an intent not to resume use. See Section 45 of the Trademark Act; Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). By so alleging, a plaintiff provides fair notice to the defendant of plaintiff's theory of abandonment.

The conclusion of OTTO International applies almost verbatim: The opposer has provided no facts to support its conclusory allegation of abandonment in paragraph 4 of the notice of opposition. The allegation that respondent has "abandoned use" makes no claim that respondent has failed to use its mark for a period greater than 3 years, nor does it make the

claim that respondent has discontinued use of its mark with an intent not to resume use.

This is because, as a matter of fact, they cannot allege such facts with any honest belief that they are true, or even provable. As Opposer indicates, this Opposition is a side skirmish in a trademark litigation in California. Discovery is closed in that case and there is no evidence whatsoever to support the abandonment claim. Any allegation of facts supporting abandonment would be frivolous and malicious given what Opposer knows. But the facts and lack of facts are irrelevant to the motion to dismiss: The Opposition fails to state a claim because it is devoid of facts. Accordingly, the motion to dismiss should be granted.

The Notice of Opposition does not allege likelihood of confusion. Even if paragraph 12 is taken as a suggestion that likelihood of confusion could be pled, it does not plead likelihood of confusion or facts sufficient it support it. It carefully avoids making the allegation[1]. It merely alleges "prior trademark rights" but fails to indicate how those prior

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[1] The reasons for doing so will be evident in an upcoming summary judgment motion, if the Opposer decides to amend the Notice of

trademark rights would be harmed by the registration. As an example, Exxon could have prior trademark rights for Exxon as a trademark for gasoline, but that would be immaterial to an applicant seeking to register EGGSON for omelets. Exxon would (should) not be permitted to allege "prior trademark rights" as the sole support for an opposition based on likelihood of confusion. Exxon would have to allege some relationship between the goods and services it provides with the goods and services provided by "Eggson." The same rule would apply for the many companies in the world the have similar names (Apple Computer and Apple Insurance, or Johnson Wax and Johnson & Johnson for example). As indicated in Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 U.S.P.Q.2d 1879 (TTAB 1990), if the relationship between the parties goods is not apparent from the face of the Opposer's registration, dismissal is warranted. In this case, Opposer has scrupulously avoided identifying the goods and services it offers, and has therefore failed to establish any relationship between the party's goods.

Further addressing the allegations of paragraph 12 of the Notice of Opposition, the allegation of priority depends on the allegation of abandonment. Because the abandonment allegations

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Opposition in contradiction to the facts in its possession. Facts are not at issue in this motion.

are not sufficiently pleaded, any allegation of trademark rights based on priority is not sufficiently pled. In any case, even if every fact alleged is proven, it still would not amount to proof of likelihood of confusion. Dismissal of this claim is warranted.

Regarding paragraph 11 of the Notice of Opposition, it does not state a basis for opposition. The allegation is conditioned on an understanding of some unknown person at some unknown future time that the word IIKONN means something. However, there is no allegation that it does mean something, or that the word IIKONN is or will be understood to mean a symbol, image or representation. Paragraph 11 suggests that maybe it will, or maybe it won't. This is insufficient to apprise the Applicant of the theory applied against the application. If Opposer proves that if IIKONN means something it is in that case descriptive or generic, all that it will have achieved is proofing a legal theory (that is, that if a mark is understood to be descriptive of the goods, then it would in that case be descriptive of the goods). For some reason, Opposer studiously avoids making the allegation necessary to state the claim. Accordingly, the allegation is insufficient to state a cause of action. Furthermore, this allegation describes a dispute that will arise only on the occurrence of some future event, and not

on any current state of facts. Accordingly, the allegations fail to apprise the Applicant of any basis of opposition.

CONCLUSION

Because Opposer Iconix Brand Group has not pleaded facts sufficient to establish standing, Applicant's motion to dismiss should be granted based on lack of standing.

Because Opposer has pleaded insufficient facts to establish abandonment, descriptiveness and genericness, or likelihood of confusion, the oppositions should be dismissed as to each basis. Opposer alleges no other basis for opposition. Accordingly, Applicant respectfully requests that the Board dismiss Opposer's Notice of Opposition for failure to state a claim upon which relief can be granted.

Respectfully submitted,

Date: September 15, 2008

/K. David Crockett/

K. David Crockett, Esq.
Crockett & Crockett, PC
Attorneys for Applicant
Icon Brands Group, Inc.

CERTIFICATE OF SERVICE

I, K. David Crockett, Esq., am an active member of the State Bar of California. I am not a party to this case. My address is 26020 Acero, Suite 200, Mission Viejo, CA 92691.

On September 15, 2008, I served the following documents in the case Iconix Brand Group, Inc. v. Icon Brands Group, Inc., Opposition Number 91185600:

1. APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

2.

3.

by placing a true and correct copy thereof enclosed in a sealed envelope, addressed as follows:

Roberta S. Bren Oblon Spivak McClelland Maier & Neustadt, P.C. 1940 Duke Street Alexandria, VA 22314	Tel: 703 413 3000 Fax: 703 413 2220

[ ] I placed this envelope with first class postage thereon fully prepaid in the U.S. mail at Mission Viejo, California.

[ ] I deposited this envelope with delivery fees paid or provided for, with Express Mail at Mission Viejo, California.

[X] I deposited this envelope with delivery fees paid or provided for, with Federal Express at Mission Viejo, California.

Date: September 15, 2008

/K. David Crockett/
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