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

Proceeding	91212054
Party	Plaintiff Threshold Enterprises, Inc.
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Date	11/15/2013
Attachments	Threshold MTD Counterclaim.PDF(58714 bytes )

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

In the Matter of U.S. Application Serial No. 85/665,992  
For: VISTA NATURAL WELLNESS CENTER

THRESHOLD ENTERPRISES LTD.,	)	
	)	
Opposer/Counterclaim-	)	
defendant,	)	
	)	Opposition No. 91212054
v.	)	
	)	
EUREKA CAT d/b/a VISTA NATURAL	)	
WELLNESS CENTER,	)	
	)	
Applicant/	)	
Counterclaimant.	)	

**THRESHOLD ENTERPRISES, LTD.'S MOTION TO DISMISS COUNTERCLAIM FOR  
FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED**

## INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and Section 503 of the Trademark Trial & Appeal Board Manual of Procedure (“TBMP”), Opposer/Counterclaim-defendant Threshold Enterprises, Ltd. (“Threshold”) respectfully moves the Trademark Trial and Appeal Board (the “Board”) for an order dismissing the counterclaims of Applicant/Counterclaimant Eureka Cat d/b/a Vista Natural Wellness Center (“Applicant”). In its Answer to the Notice of Opposition, Applicant attempts to plead a counterclaim based on genericness. The counterclaim, however, consists solely of factual recitations about this proceeding and one conclusory legal allegation that is neither supported by any factual assertions or sufficient to even plead the requirements for a genericness claim.

## ARGUMENT

A motion to dismiss tests the allegations set forth in the pleading. “To 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.” *Ashcraft v. Iqbal*, 556 U.S. 662, 678 (2009) (citations and internal quotation marks omitted). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* That is, “[f]actual allegations must be enough to raise a right to relief above the speculative level . . . .” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007) (citations omitted). *Twombly* and *Iqbal* require a “heightened form of pleading;” “simple notice pleading” will not survive a motion to dismiss. *Fowler v. UPMC Shadyside*, 578 F.3d 203, 210 (3d Cir. 2009). A party may not rely on “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements” to meet the pleading requirements. *Iqbal*, 556 U.S. at 663. “[A] complaint [will not] suffice if it tenders ‘naked assertion[s]’ devoid

of ‘further factual enhancement.’” *Id.* (quoting *Twombly*, 550 U.S. at 557). Applicant’s counterclaim comes nowhere close meeting this standard, as we particularize below.

**A. Applicant’s Genericness Claim Rests Solely On A Single Conclusory Allegation and Must Be Dismissed.**

The genericness of a mark is determined by identifying the category or class of goods or services at issue and then determining if the mark is understood by the relevant public primarily to refer to that genus of goods or services. *See In re American Fertility Society*, 188 F.3d 1341 (Fed. Cir. 1999). In other words, a generic mark is one that in and of itself identifies “the genus of which the particular products is a species.” *Official Airline Guides v. Goss*, 6 F.3d 1385, 1398 (9th Cir. 1993). It “simply state[s] what the product is.” *Kendell-Jackson Winery v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998).

Applicant’s counterclaim fails to allege that Threshold’s WELLNESS FORMULA mark in and of itself states what the product is. The counterclaim is comprised of seven paragraphs. Only one paragraph, however, contains any allegation addressing the supposed genericness of Threshold’s mark. There, Applicant states that “[t]he words ‘Wellness’ and ‘Formula’ are so widely used and registered by unrelated third parties in connection with vitamins, dietary and nutritional supplements and related goods that the term ‘Wellness Formula’ must be considered generic.” Answer at 5, ¶4. That is the entirety of Applicant’s genericness claim and it boils down to one proposition: “Wellness” and “Formula” -- independently -- are widely used by parties in connection with vitamins and supplements. This allegation says nothing about whether the relevant purchasing public believes those terms are synonymous with the goods. It says nothing about what the *combined terms* “Wellness Formula” means. And it says nothing tantamount to WELLNESS FORMULA “simply stat[ing] what the products is.” *Kendall-Jackson Winery*, 150 F.3d at 1047 n.8. Rather, it is simply a conclusory legal argument cast in

form of a factual allegation. Such a threadbare recital is not enough absent additional factual pleadings supporting it. *See Iqbal*, 556 U.S. at 663.

**B. The Counterclaims Should Be Dismissed With Prejudice.**

No amendment can save Applicant's counterclaim, and it should therefore be dismissed with prejudice, as we detail below. *See Leider v. United States*, 301 F.3d 1290, 1299 n.10 (Fed. Cir. 2002) (district court did not err in dismissing complaint without granting leave to amend where amendment would be futile).

The USPTO has examined Threshold's mark on multiple occasions: at the time of application, when examining for continued use, and when examining for incontestability. On none of these occasions did the USPTO require Threshold to disclaim WELLNESS or indicate that the mark was generic. Indeed, on each occasion, the USPTO granted Threshold the relief it sought. Applicant cannot plead any *facts* undermining these points and, therefore, permitting any amendment would be futile.

In addition, as explained above, determining whether a mark is generic involves a two-step inquiry: "First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 USPQ 528, 530 (Fed. Cir. 1986). Applicant does not *and cannot* plead facts sufficient to meet this standard. On their face, the mark WELLNESS FORMULA does not refer to dietary and nutritional supplements, and the USPTO's actions approving the mark on April 2, 1996 and acknowledging its incontestability on April 18, 2001 demonstrate that Applicant cannot plead otherwise.

November 15, 2013

Respectfully submitted,

THRESHOLD ENTERPRISES, LTD.

By: /s/ \_\_\_\_\_

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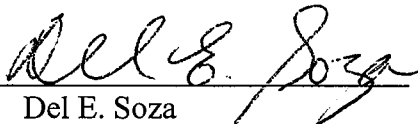
Attorneys for Opposer/Counterclaim-defendant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing THRESHOLD ENTERPRISES, LTD.'S MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED has been served on Applicant Eureka Cat d/b/a Vista Natural Wellness Center, by mailing said copy on November 15, 2013, via United States Postal Service, to:

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By:   
Del E. Soza