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Filing date: **01/27/2014**

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

Proceeding	91212792
Party	Plaintiff META4 Spain, S.A.
Correspondence Address	JUSTIN R YOUNG DINEFF TRADEMARK LAW LIMITED 160 NORTH WACKER DRIVE CHICAGO, IL 60606 UNITED STATES jyoung@dineff.com,tmlaw@dineff.com
Submission	Motion to Dismiss - Rule 12(b)
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Signature	/justinryoung/
Date	01/27/2014
Attachments	Motion to dismiss counterclaim in 91212792 - 1-27-14.pdf(66035 bytes)

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

Proceeding	91212792
Applicant	Protobrand Sciences, Inc.
Opposer	META4 Spain, S.A.

**Opposer's Motion To Dismiss For Failure To State A Claim
Upon Which Relief Can Be Granted**

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, Opposer-Counterclaim Defendant META4 Spain, S.A. (“Opposer”), hereby moves to dismiss Applicant-Counterclaim Plaintiff Protobrand Sciences, Inc.’s (“Applicant”) counterclaim for cancellation of Opposer’s Registrations Nos. 3,573,292, 3,369,502 and 4,372,302 on the bases of abandonment. Opposer’s brief in support of this motion is attached.

Applicant’s Counterclaim fails to state a statutory ground upon which it is based and it fails to sufficiently plead facts to establish a cause of action for abandonment.

It is noted that Opposer’s time in which to answer the Counterclaim is tolled pending the outcome of the present Motion to Dismiss.

Opposer has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service: I hereby certify that a true and complete copy of this paper has been served on this date January 27, 2014 upon Attorney for Applicant at his address of record by email as agreed by the parties.

Respectfully submitted,



Justin R. Young

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212792
Applicant	Protobrand Sciences, Inc.
Opposer	META4 Spain, S.A.

Opposer's Brief In Support Of Its Motion To Dismiss For Failure To State A Claim Upon Which Relief Can Be Granted

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, Opposer-Counterclaim Defendant META4 Spain, S.A. ("Opposer"), hereby moves to dismiss Applicant-Counterclaim Plaintiff Protobrand Sciences, Inc.'s ("Applicant") counterclaim for cancellation of Opposer's Registrations Nos. 3,573,292, 3,369,502 and 4,372,302 ("Registration") on the bases of abandonment.

The entirety of Applicant's abandonment claim is found in paragraphs 2 and 3 of its Counterclaim, which state:

"Upon information and belief, Opposer never commenced use of, or is not now using and has no intention to resume use of, the marks in Registration Nos. 3,573,292, 3,369,502 and 4,372,302 in connection with some or all of the goods and services listed in the registrations." (Countercl. ¶ 7)

"Upon information and belief, Opposer has abandoned the marks in Registration Nos. 3,573,292, 3,369,502 and 4,372,302 in connection with some or all of the goods and services listed in the registrations." (Countercl. ¶ 7)

Applicant did not plead any facts about the circumstances or duration of any such abandonment.

STATEMENT OF FACTS

Opposer is the owner of Registration No. 3,573,292, for the mark "META4 PeopleNet" for *"apparatus for recording, transmission or reproduction of sound and images; Central processing units for processing information, data, sound or images; Cinematographic machines and apparatus; Computer memories; Computer peripherals; Computer printers; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage*

and sharing of data and information in the field of human resources management; Computers; Data processors; Weighing equipment, namely, scales and balances; Word processing equipment” in International Class 9 and “computer consultation; Computer programming; Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer services, namely, data recovery services; Computer software design for others; Computer software design, computer programming, or maintenance of computer software; Computer systems analysis; Development, updating and maintenance of software and data bases; Providing temporary use of on-line non-downloadable software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information in the field of human resources management; Rental of a database server (to third parties); Rental of computers and software” on International Class 42, registered in February 10, 2009.

Opposer is the owner of the incontestable Registration Nos. 3,369,502, for the mark “META4” for *“apparatus for recording, transmission or reproduction of sound and images; Central processing units for processing information, data, sound or images; Cinematographic machines and apparatus; Computer memories; Computer peripherals; Computer printers; Computer software for human resources management; Computers; Data processors; Weighing equipment, namely, scales and balances; Word processing equipment; all in the field of human resources management” in International Class 9. “adhesive tape dispensers; Blank paper tapes and cards for the recording of computer programs; Correcting fluid for type; Finger-stalls; Franking machines; Manuals in the field of computer software for human resources management; Office requisites, namely, envelope sealing machines; Paper and cardboard; Paper embossers; Paper folding machines as office requisites; Printed instructional, educational, and teaching materials in the field of computer software for human resources management; Punches; Rubber bands; Staplers; Stationery; all in the field of human resources management” in International Class 16, “communication by telegram; Communication via fibre optical networks; Communications by computer terminals; Computer aided transmission of information and images; Data transmission and reception services via telecommunication means; Electronic mail services; Radio broadcasting; Rental of telecommunication equipment; Telecommunication services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions; Telecommunications consultation; Telephone communication services” in International Class 38 and “computer consultation; Computer programming; Computer service, namely, acting as an application service provider in*

the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer services, namely, data recovery services; Computer software design for others; Computer software design, computer programming, Computer systems analysis; Development and updating of software and data bases; Providing temporary use of on-line non-downloadable software for human resources management; Rental of a database server (to third parties); Rental of computers and software; all in the field of human resources management” on International Class 42, registered in January 15, 2008.

Opposer is the owner of Registration No. 4,372,302, for the mark “META4” for *“administration of business payroll for others; Business administration assistance; Business organization and management consultancy including personnel management; Consultancy of personnel recruitment; Consulting services in the fields of business management, human resources, and business organizational design; Data processing services; Human resource analysis and consulting services; Human resources services, namely, personnel selection for others; Outsourcing in the field of human resources; Payroll administration and management services; Payroll preparation; Payroll processing services; Personnel management consultation; Serving as a human resources department for others”* in International Class 35, registered on July 23, 2013.

Registrations Nos. 3,573,292, 3,369,502 and 4,372,302 were asserted by Opposer in its October 2, 2013 Notice of Opposition seeking to oppose Applicant’s Application No. 85/684174 for the mark “META4 INSIGHT” for *“marketing and branding services, namely, providing customized communication and research programs to obtain consumer data and develop branding strategies; business services, namely, consumer research and consulting related thereto”* in International Class 35.

In its November 11, 2013 Answer and Counterclaim, Applicant sought cancellation of the Registrations Nos. 3,573,292, 3,369,502 and 4,372,302 on the ground of abandonment. Other than setting forth its conclusion that cancellation is warranted on this ground, Applicant provides no other well-pleaded allegations and offers no details or factual predicates for its claims.

ARGUMENTS

Proceedings before the Board are governed by the Federal Rules of Civil Procedure, except where otherwise provided by the Trademark Rules of Practice. 37 C.R.F. § 2.116(a).

Where a complaint or counterclaim is legally insufficient, Rule 12(b)(6) of the Federal Rules of Civil Procedure permits a defendant to seek the dismissal for “failure to state a claim upon which relief can be granted.”

I. Applicant’s Abandonment Claim Must Be Dismissed

Pursuant to TBMP § 503, “*for purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.*”

In order to set forth a cause of action to cancel the registration of a mark which allegedly has been abandoned, Applicant should have alleged ultimate facts pertaining to the alleged abandonment. *See Clubman’s Club Corporation v. Martin*, 188 USPQ 455, 456 (TTAB 1975).

Applicant’s allegation of abandonment – that “***upon information and belief, Opposer never commenced use of, or is not now using and has no intention to resume use of, the marks in Registration Nos. 3,573,292, 3,369,502 and 4,372,302 in connection with some or all of the goods and services listed in the registrations.***” (Countercl. ¶ 7) and that “***upon information and belief, Opposer has abandoned the marks in Registration Nos. 3,573,292, 3,369,502 and 4,372,302 in connection with some or all of the goods and services listed in the registrations.***” (Countercl. ¶ 7) (Emphasis added) – is all conclusion with no substance. Indeed, the pleading lacks any facts that would support such allegation. A conclusion is not a cause of action.

Applicant’s failure to provide this basic, essential information suggests that Applicant filed this counterclaim in bad faith, with no genuine basis for asserting that Opposer abandoned its use of its trademarks “META4 PeopleNet” and “META4” for any period of time. *See Fed. R. Civ. P. 11*. Applicant cannot be permitted to assert legally insufficient claims in the hope that through discovery it may be able to justify them. Applicant has the burden of setting forth facts to bear out its claims. Here, it has wholly failed to do so.

Given Applicant’s failure to provide any facts to support its conclusory allegation of abandonment, Applicant’s abandonment claim must be dismissed for failure to state a claim. *See Fed. R. Civ. P. 12(b)(6); TBMP § 503; see Otto Int’l, Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (noting “[i]n order to set forth a cause of action to cancel the registration of a

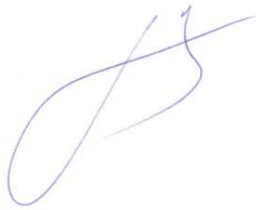
mark which assertedly has been abandoned, [a party] must allege ultimate facts pertaining to the alleged abandonment,” and dismissing claim where party “has provided no facts to support its conclusory allegation of abandonment in [its] petition to cancel”).

CONCLUSION

For the reasons set forth above, this motion should be granted in its entirety, Applicant’s counterclaims must be dismissed for failure to state a claim upon which relief may be granted.

Certificate of Service: I hereby certify that a true and complete copy of this paper has been served on this date January 27, 2014 upon Attorney for Applicant at his address of record by email as agreed by the parties.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read 'Justin R. Young', is written over a horizontal line.

Justin R. Young

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