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Filing date: **12/27/2013**

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

Proceeding	91212993
Party	Plaintiff Empirical Concepts, Inc.
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Date	12/27/2013
Attachments	Reply in Support of Motion to Dismiss.pdf(1053233 bytes)

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

Empirical Concepts, Inc.	:	
Opposer,	:	
v.	:	Opposition No. 91212993
	:	
Empirical Financial Services,	:	Parent Proceeding: 91203384
	:	
Applicant.	:	Mark: EMPIRICAL

**OPPOSER’S REPLY IN SUPPORT OF
MOTION TO DISMISS APPLICANT’S COUNTERCLAIM**

Applicant Empirical Financial Services d/b/a Empirical Wealth Management’s (“Wealth”) “Objection” to Empirical Concepts, Inc.’s (“Concepts”) Motion to Dismiss fails to address many of the legal issues raised by Concepts that demonstrate the insufficiency of Wealth’s Counterclaim. Instead, Wealth propounds incomprehensible arguments and conjecture to support three grounds that all stem from a single misstatement of law and fact, namely that Concepts has not used its EMPIRICAL SYSTEMS mark in interstate commerce. None of Wealth’s arguments, however, are sufficient to state a claim upon which relief can be granted.

Nonuse

Wealth’s arguments concerning “nonuse” are not based on any assertions of relevant facts that the Board must accept as true. Instead, all of Wealth’s arguments are based on unsupported conjecture, and on an utter disregard of the law and regulations governing what constitutes a “use” in commerce.

First, Wealth makes several misrepresentations as to the nature of Concepts’ discovery responses, and falsely asserts that Concepts has “admitted” to certain facts that Wealth contends

demonstrate nonuse. Concepts has never “admitt[ed] themselves that they have no evidence of use in commerce beyond what is on their web site and what is in USPTO documents.” (Dkt. 7 at ¶1(a)). Importantly, the EMPIRICAL SYSTEMS registration that Wealth seeks to cancel was just added to the consolidated proceedings through Wealth’s November 4, 2013 counterclaim. There has not been any initial disclosures, discovery requests, or discovery responses pertaining specifically to this registration, let alone any “admissions” of nonuse.

Second, the assertion that “Concepts does not claim that they have made sales or that they have transported the goods or that there has been any public use of the mark” is nonsensical. By filing a Statement of Use for its EMPIRICAL SYSTEMS application, it has claimed precisely that. *See* Exhibit 1 (Statement of Use and Specimen for Reg. No. 4,306,870). Wealth’s proposed counterclaim alleges nonuse and no “public use of the mark,” despite Concepts’ specimen showing use of the mark on computer project management software for *a customer actually identified on the specimen*, namely “DHS” (Department of Homeland Security). *See* Exhibit 1; *see also* TMEP § 904.03(e).¹

Finally, Wealth’s statement that Concepts’ “confidential Power Point presentation” is somehow “an admission against interest” because “it is not an open and public use” is further nonsense. Those documents were *responsive to a discovery request/initial disclosure supplement*, not an admission of anything that is at issue with respect to this motion. And, they certainly demonstrate advertising of goods/services to a prospective customer – the Department of Homeland Security – that ultimately culminated in Concepts providing “computer project

¹ The authority cited by Wealth has no application to the instant facts. The *Blue Bell* case involved a dispute over which of two parties first used a particular mark in commerce, and whether consignment to sales personnel (not a sale to a customer), or re-labeling existing goods, constitutes use in commerce. *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265, 185 USPQ 1, 4 (5th Cir. 1975). The *Mendes* case involved a question of abandonment by a plaintiff who had used the mark prior to the defendant’s adoption of the same mark. *New England Duplicating Co. v. Mendes*, 190 F.2d 415(1st Cir. 1951). By contrast, Wealth’s proposed counterclaim alleges *nonuse* and no “public use of the mark,” despite Concepts’ specimen that actually identifies a customer for Concepts’ goods.

management software” to that customer. *See* Exhibit 1 (Specimen of Use).² In short, Wealth has not demonstrated any facts to support its “nonuse” theory that survive scrutiny under *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).

Unclean Hands/Fraud

Wealth accuses Concepts of “fraudulently creat[ing] a specimen just to acquire a registration.” Wealth also makes some convoluted argument that Concepts merely changed the name on a screenshot from EMPIRICAL FINANCIALS, which is an application for similar goods that Wealth opposed in Parent Proceeding No. 91203384, to EMPIRICAL SYSTEMS in order to secure a registration. (Dkt. 7 at ¶¶ 2-3). Wealth’s wild accusations disregard that the EMPIRICAL FINANCIALS application is *an intent-to-use* application, and no Statement of Use has been filed by Concepts (*see* Application SN 85/268,585, Opp. No. 91203384), so any statements by Wealth that Concepts fabricated the EMPIRICAL SYSTEMS specimen by using screen shots from EMPIRICAL FINANCIALS is utter conjecture. These are serious, unsubstantiated allegations that border on sanctionable, which the Board certainly is not obligated to accept as true. *See, e.g. Hagans v. Lavine* 415 U.S. 528, 536-37 (Board not required to accept as true allegations that are totally implausible, attenuated, unsubstantiated, frivolous, and devoid of merit). Finally, merely making the bald statement that “[t]he remaining elements of fraud were pleaded” does not make it so. (Dkt. 7 at ¶ 2(b)).

² Wealth’s statement that Concepts’ “late answer to the discovery request is also an admission against interest as to the sufficiency of Concepts’ discovery responses” disregards that Fed. R. Civ. P. 26(e)(1)(A) explicitly permits Concepts to supplement its discovery responses in a timely manner, that proceedings in the consolidated proceedings were suspended until November 1, 2013, and that Wealth can show no prejudice by not having them sooner. Most importantly, Concepts’ registration for EMPIRICAL SYSTEMS was not even the subject of the consolidated proceedings until November 4, when Wealth filed its counterclaim, so there has not even been any initial disclosures, or discovery requests, related to this specific registration and mark.

Conclusion

Wealth has failed to refute any of Concepts' arguments that demonstrate that Wealth's counterclaim for cancellation of Concepts' registration of EMPIRICAL SYSTEM does not state a claim that is plausible on its face. Instead, Wealth has propounded a series of arguments based on mere conjecture and misrepresentations, which are refuted by the evidence already of record in the instant and the consolidated proceedings. *See* 37 C.F.R. § 2.122(b). Accordingly, Concepts respectfully requests that the Board dismiss Wealth's counterclaim with prejudice.

Date: December 27, 2013

Respectfully submitted,

/s/ Carrie A. Shufflebarger

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Counsel for Empirical Concepts, Inc.

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing is being served via U.S. Mail on the following, on this 27th day of December, 2013:

Wendy Peterson, Esq.
Not Just Patents
PO Box 18716
Minneapolis, MN 55418

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger

EXHIBIT 1

Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85271167
LAW OFFICE ASSIGNED	LAW OFFICE 111
EXTENSION OF USE	NO
MARK SECTION	
MARK	EMPIRICAL SYSTEMS
OWNER SECTION	
NAME	EMPIRICAL CONCEPTS, INC.
STREET	120 WATERFRONT STREET, SUITE 425
CITY	NATIONAL HARBOR
STATE	Maryland
ZIP/POSTAL CODE	20745
COUNTRY	United States
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	009
CURRENT IDENTIFICATION	Computer project management software
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	10/02/2012
FIRST USE IN COMMERCE DATE	10/02/2012
SPECIMEN FILE NAME(S)	

ORIGINAL PDF FILE	<u>SPN0-2084648166-123131618 . Class 9 Specimen.pdf</u>
CONVERTED PDF FILE(S) (1 page)	<u>\\TICRS\EXPORT16\IMAGEOUT16\859\785\85978576\LM2Copy\85271167\ASC</u>
SPECIMEN DESCRIPTION	Screen shot of software displaying mark.
INTERNATIONAL CLASS	042
CURRENT IDENTIFICATION	Computer project management services; consulting in the field of IT project manage consulting services; customization of computer hardware and software; consulting ir configuration management for computer hardware and software; computer and comp configuration services; design and development of websites and webpages for others
GOODS OR SERVICES	DELETE ALL ITU GOODS/SERVICES IN THIS CLASS OR PROCESS ACCOR] REQUEST TO DIVIDE
REQUEST TO DIVIDE	YES
GOOD(S)/SERVICE(S) IN USE	Class 009
GOOD(S)/SERVICES INTENT TO USE	Class 042
PAYMENT SECTION	
NUMBER OF CLASSES IN USE	1
SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]	100
REQUEST TO DIVIDE FEE	100
TOTAL AMOUNT	200
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Carrie A. Shufflebarger/
SIGNATORY'S NAME	Carrie A. Shufflebarger
SIGNATORY'S POSITION	Attorney of record, Ohio bar member
DATE SIGNED	01/11/2013
SIGNATORY'S PHONE NUMBER	513.352.6678
REQUEST TO DIVIDE SIGNATURE	/Carrie A. Shufflebarger/

SIGNATORY'S NAME	Carrie A. Shufflebarger
SIGNATORY'S POSITION	Attorney of record, Ohio bar member
DATE SIGNED	01/11/2013
SIGNATORY'S PHONE NUMBER	513.352.6678
AUTHORIZED SIGNATORY	YES

FILING INFORMATION

SUBMIT DATE	Fri Jan 11 12:49:03 EST 2013
TEAS STAMP	USPTO/SOU-208.46.48.166-2 0130111124903050208-85271 167-4908654a41f71ccc1c651 5bd4a23027e93-CC-10645-20 130111123131618383

**Trademark/Service Mark Statement of Use
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

MARK: EMPIRICAL SYSTEMS
SERIAL NUMBER: 85271167

The applicant, EMPIRICAL CONCEPTS, INC., having an address of
120 WATERFRONT STREET, SUITE 425
NATIONAL HARBOR, Maryland 20745
United States

is submitting the following allegation of use information:

For International Class 009:
Current identification: Computer project management software

The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 10/02/2012, and first used in commerce at least as early as 10/02/2012, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Screen shot of software displaying mark..

Original PDF file:
[SPN0-2084648166-123131618 . Class 9 Specimen.pdf](#)
Converted PDF file(s) (1 page)
[Specimen File1](#)

For International Class 042:
Current identification: Computer project management services; consulting in the field of IT project management; IT consulting services; customization of computer hardware and software; consulting in the field of configuration management for computer hardware and software; computer and computer network configuration services; design and development of websites and webpages for others

All ITU goods/services in this class are to be deleted or processed according to a request to divide.

REQUEST TO DIVIDE

The applicant is requesting to divide the application and specifies the following:

The following good(s) or service(s) is/are now in use: Class 009

The following good(s) or service(s) remain(s) under the Section 1(b), intent to use basis: Class 042

A fee payment in the amount of \$100 will be submitted with the form, representing payment for the allegation of use for 1 class.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for the request to divide fee.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Carrie A. Shufflebarger/ Date Signed: 01/11/2013

Signatory's Name: Carrie A. Shufflebarger

Signatory's Position: Attorney of record, Ohio bar member

Signatory's Phone: 513.352.6678

Request to Divide Signature

Signature: /Carrie A. Shufflebarger/ Date: 01/11/2013

Signatory's Name: Carrie A. Shufflebarger

Signatory's Position: Attorney of record, Ohio bar member

Signatory's Phone: 513.352.6678

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing

him/her as an associate attorney in this matter.

RAM Sale Number: 10645

RAM Accounting Date: 01/11/2013

Serial Number: 85271167

Internet Transmission Date: Fri Jan 11 12:49:03 EST 2013

TEAS Stamp: USPTO/SOU-208.46.48.166-2013011112490305

0208-85271167-4908654a41f71ccc1c6515bd4a

23027e93-CC-10645-20130111123131618383

FEE RECORD SHEET

Serial Number: 85271167



RAM Sale Number: 10645

Total Fees: \$200

RAM Accounting Date: 20130111

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Total Fee</u>
Statement of Use (SOU)	7003	20130111	\$100	1	\$100
Request to Divide (per new app.)	7006	20130111			\$100

Transaction Date: 20130111

