

ESTTA Tracking number: **ESTTA805296**

Filing date: **03/06/2017**

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

| | |
|------------------------|---|
| Proceeding | 91231833 |
| Party | Plaintiff Birds Eye Foods, LLC |
| Correspondence Address | MICHAEL L VISSER FISHMAN STEWARD PLLC 39533 WOODWARD AVENUE, SUITE 140 BLOOMFIELD HILLS, MI 48304 UNITED STATES |
| Submission | Motion to Dismiss - Rule 12(b) |
| Filer's Name | Michelle L. Visser |
| Filer's e-mail | tmdocketing@fishstewip.com |
| Signature | /Michelle L. Visser/ |
| Date | 03/06/2017 |
| Attachments | 12b6 motion.pdf(134653 bytes) |

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

| | | |
|------------------------------------|---|--------------------------------------|
| BIRDS EYE FOODS LLC, |) | |
| |) | |
| Opposer/Counterclaim Registrant, |) | Opposition No. 91231833 |
| |) | Application Serial No. 86869172 |
| v. |) | Mark: HAWAIIAN CHIP COMPANY & DESIGN |
| |) | Registration No. 3697408 |
| HAWAIIAN CHIP COMPANY LLC, |) | Mark: HAWAIIAN |
| |) | |
| Applicant/Counterclaim Petitioner. |) | |
| _____ |) | |

**REGISTRANT’S MOTION FOR PARTIAL DISMISSAL
OF THE COUNTERCLAIM FOR CANCELLATION**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Registrant hereby moves the Board to dismiss the counterclaim for cancellation as it relates to the claim of geographic deceptive misdescriptiveness pursuant to Section 2(e)(3) of the Trademark Act, on the ground Petitioner has failed to state a claim upon which relief can be granted.

INTRODUCTION

On October 20, 2009, the Office granted Registration No. 3697408 for the mark HAWAIIAN on the Principal Register. The five-year anniversary date of the registration was October 20, 2014. A Section 8 affidavit of use was filed on September 27, 2015 and accepted on September 30, 2015. The instant counterclaim for cancellation was filed on January 27, 2017. The counterclaim for cancellation specified two grounds¹: (1) geographic deceptive misdescriptiveness pursuant to Section 2(e)(3) of the Trademark Act; and (2) deceptiveness pursuant to Section 2(a) of the Trademark Act.

¹ Registrant notes that the cover sheet of the counterclaim for cancellation references genericness as a basis for cancellation, though genericness is nowhere mentioned in the pleading. Since the instant motion is based on the claim of geographic deceptive misdescriptiveness being time-barred, genericness has not been addressed.

Registrant moves to dismiss the counterclaim for cancellation as it relates to the claim based on geographic deceptive misdescriptiveness, as such claim is statutorily unavailable for registrations that are more than five years old. In this regard, Petitioner has failed to state a claim upon which relief can be granted, and accordingly, it should be dismissed with prejudice.

ARGUMENT

TBMP §503.01 states, in relevant part: “[w]hen the defense for failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant’s answer.” The filing of a motion to dismiss tolls the time for filing an answer. TBMP §510.03(a), n. 7; *Hollowform Inc. v. AEF*, 180 U.S.P.Q. 284, 285 (TTAB 1973). This Motion is timely filed as the time has not yet run for Registrant to file its answer.

Under Fed. R. Civ. P. 12(b)(6), the Board must dismiss a claim that is not “plausible on its face.” TBMP §503.02, citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. TBMP §503.02. The Board reviews a motion to dismiss by assuming all well-pleaded allegations are true, and construing these allegations in a light most favorable to the plaintiff. *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (TTAB 1985). To survive a motion to dismiss, Petitioner must show that a valid ground exists for denying the registration sought. TBMP § 503.02.

Petitioner has alleged, as a basis for cancellation of Registration No. 3697408, that the mark is geographically deceptively misdescriptive pursuant to Section 2(e)(3) of the Trademark Act. Under the Trademark Act, this is not a valid ground for cancellation of a registration that has been registered for more than five years.

15 U.S.C. §1064, regarding cancellation of a registration, sets forth the time periods during which a petition for cancellation may be filed. Relevant to the instant case are subsections (1), (3) and (5), which provide that a petition for cancellation may be filed:

- (1) Within five years from the date of the registration of the mark under this chapter.
- (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.
- (5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies: Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

37 C.F.R § 2.111(b) and TBMP § 307 implement these sections. TBMP § 307.02(a) states:

Although a petition to cancel filed after the expiration of the five-year period, in the case of such a Principal Register registration, must recite one of the grounds specified in Trademark Act § 14(3) or 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), a petition to cancel filed prior to the expiration of the five-year period may be based on any ground which could have prevented registration initially. The grounds for cancellation which are thus available in the case of a petition filed within the five-year period, but not thereafter, include: all of the grounds specified in Trademark Act § 14(3) and Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) as well as likelihood of confusion under Trademark Act § 2(d), 15 U.S.C. § 1052(d); all of the grounds specified in Trademark Act § 2(e), 15 U.S.C. § 1052(e) (**including a claim** that respondent's mark is merely descriptive or deceptively misdescriptive, **that respondent's mark is geographically descriptive or geographically deceptively misdescriptive**, or that respondent's mark is primarily merely a surname); the ground that respondent is not the owner of the registered mark; and the ground that there was no bona fide use of respondent's mark in commerce to support the original registration. (Emphasis added.)

TBMP § 307.02(b) further notes that “[t]he five-year time limit specified in Trademark Act § 14, 15 U.S.C. § 1064, barring certain attacks on a Principal Register *registration*,” is not dependent on the filing of a declaration under Section 15 which provides incontestable rights of *use* to a limited extent.”

Sections 14(3) and 14(5) of 15 U.S.C. § 1064, listed above, set forth the sole grounds upon which a registration may be cancelled more than five years after registration of the mark.

In the counterclaim for cancellation, Petitioner stated:

12. The term "HAWAIIAN" is geographically descriptive and consumers are likely to believe that Respondent's Goods originate in the State of Hawaii.
13. Respondent's goods do not originate in the State of Hawaii.
14. Respondent's goods originate in the State of Washington and are not manufactured or produced in Hawaii.
15. Therefore, Respondent's Mark is geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act as applied to Respondent's Goods.

As previously noted, Registration No. 3697408 issued on October 20, 2009, on the Principal Register. The five-year anniversary date of this registration was October 20, 2014. The grounds upon which Petitioner could petition to cancel the registration were limited thereafter to those grounds set forth in Sections 14(3) and 14(5). The ground of geographic deceptive misdescriptiveness asserted in the Petition for Cancellation is statutorily unavailable. Accordingly, Petitioner has failed to state a claim upon which relief could be granted for this claim pursuant to Fed. R. Civ. P. 12(b)(6).

SUSPENSION

TBMP § 510.03(a) states:

When a party to a Board proceeding timely files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is considered automatically suspended by operation of 37 CFR § 2.127(d) with respect to all matters not germane to the motion.

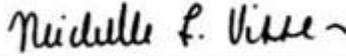
Inasmuch as this is a potentially dispositive motion, the Board should suspend the instant proceeding pending a decision on this motion.

RELIEF REQUESTED

Registrant respectfully requests that the Board grant the instant motion and strike Paragraph 15 with prejudice from Petitioner's counterclaim for cancellation.

Respectfully submitted,

Date March 6, 2017



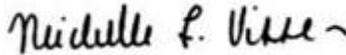
Michael D. Fishman
Michelle L. Visser
Barbara L. Mandell
FISHMAN STEWART PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304
Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing *Registrant's Motion for Partial Dismissal of the Counterclaim for Cancellation* upon Petitioner by causing a true and correct copy thereof to be sent by e-mail to kherring@awlaw.com and deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Kevin W. Herring
Ashford & Wriston LLP
999 Bishop Street,
Suite 1400
Honolulu, HI 96813-4438

Date: March 6, 2017



Michelle L. Visser