

ESTTA Tracking number: **ESTTA1024035**

Filing date: **12/19/2019**

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

Proceeding	91237356
Party	Defendant Dexter Kan
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Date	12/19/2019
Attachments	4861-2-APPLICANT-RESPONSE-TO-MOTION-TO-DISMISS-DEC19-2019.pdf( 173385 bytes )

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

ROCKET SPORTS, LLC,

Opposer,

vs.

DEXTER KAN,

Applicant.

Opposition No. 91237356

**APPLICANT'S RESPONSE TO  
OPPOSER'S MOTION TO DISMISS  
FOR FAILURE TO STATE A  
CLAIM UPON WHICH RELIEF  
MAY BE GRANTED PURSUANT  
TO FEDERAL RULE OF CIVIL  
PROCEDURE 12(b)(6)**

Pursuant to TBMP §§ 502.02 and 503, Applicant Dexter Kan responds to Opposer Rocket Sports, LLC's Motion to Dismiss for Failure to State a Claim Upon Which Relief May Be Granted Pursuant to Federal Rule of Civil Procedure 12(b)(6) (the "Motion to Dismiss").

**I. FACTS AND PROCEDURAL HISTORY**

On March 25, 2017, Applicant filed US Trademark Application No. 87/385,665 ("the Application," for "the ROCKET MESH Mark") under 15 U.S.C. § 1051(b).

Opposer filed its Notice of Opposition in on October 21, 2017, and amended the Notice of Opposition on November 11, 2017, based on its ownership of US Trademark Registration No. 5,297,623 ("Opposer's Registration," for "the ROCKET SPORTS Mark"). 1 TTABVUE, 4 TTABVUE. Applicant, appearing pro se at the time, filed its Answer to the Amended Notice on November 16, 2017. 6 TTABVUE. Attorneys for Applicant made appearance in the case on October 16, 2018. 24 TTABVUE.

Discovery continued through to May 24, 2019. 39 TTABVUE 5. Late in the discovery process, Applicant became aware of new information, in the form of deposition testimony from

Opposer's sole owner, which indicated that there was no bona fide use of the ROCKET SPORTS mark in commerce for the services as identified in Opposer's Registration at the time of either filing or registration. *See* 41 TTABVUE 3. Therefore, on June 17, 2019, Applicant moved on that basis for leave to amend the Answer to add counterclaims. 41 TTABVUE ("the Counterclaim Motion").

Opposer responded to the Counterclaim Motion on July 7, 2019. 43 TTABVUE ("Response to the Counterclaim Motion"). The Response to the Counterclaim Motion argued, *inter alia*, that certain statements presented in the Counterclaim Motion and proposed counterclaims were false or misrepresented the facts. 43 TTABVUE 6-9.

Applicant filed a Reply to the Response to the Counterclaim Motion on July 22, 2019. 47 TTABVUE ("Reply to the Response"). In particular, Applicant directly addressed Opposer's arguments that the Counterclaim Motion and proposed counterclaims made false or misrepresenting statements. 47 TTABVUE 3-9.

On November 9, 2019, upon due consideration of the Counterclaim Motion as fully briefed by the parties, including Opposer's Response to the Counterclaim Motion and Applicant's Reply to the Response, the Board granted Applicant's Counterclaim Motion in part, permitting the addition of one of the proposed counterclaims ("the Counterclaim"), for cancellation of Opposer's Registration on the basis of non-use in commerce. 48 TTABVUE 12 ("the Counterclaim Decision"). In particular, the Board found, with regard to the Counterclaim, "that Applicant has sufficiently pleaded a claim of non-use in commerce of the services identified in Opposer's pleaded registration." *Id.* The Board also set November 30, 2019 as a deadline for Opposer to answer the Counterclaim. 48 TTABVUE 14.

On November 30, 2019, instead of filing an Answer to the Counterclaim, Opposer filed the presently-pending Motion to Dismiss. 49 TTABVUE. In summary, the Motion to Dismiss argues, much as in Opposer's Response to the Counterclaim Motion which had just been granted by the Board, that certain statements in the Counterclaim were false or misrepresented the facts, and therefore the pleading is insufficient. *Id.*

As of this filing, Opposer has yet to file an Answer to the Counterclaim.

## **II. ARGUMENT**

The deadline for Opposer to file an Answer to the Counterclaim was November 30, 2019. However, rather than file an Answer, Opposer filed the present Motion on the night of the deadline. The Motion presents no new arguments, but only repeats the same arguments already considered and decided by the Board. Additionally, the Motion again argues that the Counterclaim is based on false statements, without acknowledging Applicant's previous counterarguments on this point.

### **A. Opposer's Motion Is Repetitious Against Matters Already Considered By The Board.**

Opposer's Motion to Dismiss repeats allegations and arguments already presented in the Response to the Counterclaim Motion, and adds nothing new other than repeated emphasis on the phrase "well-pleaded factual matter." *See* 49 TTABVUE 5. Indeed, other than some minor stylistic alterations, and alterations to reflect that the Counterclaim is no longer proposed but granted and that this is a different filing, every allegation of fact presented in the Motion to Dismiss was presented word-for-word in the Response to the Counterclaim Motion. These similarities between the factual allegations in the Motion to Dismiss and corresponding

allegations in the Response to the Counterclaim Motion are presented in the attached Exhibit 1, with differences underlined (legal contentions and citations from the Motion to Dismiss have been removed).

As shown clearly in Exhibit 1, Opposer has not presented new information to the Board, but merely repeats itself. Opposer's Motion to Dismiss does not even attempt to address the arguments in Applicant's Reply to the Response with additional information, but acts as if the Reply to the Response was never presented. Opposer in fact acknowledges that the fact patterns in the Motion to Dismiss have already been presented and considered by the Board: "Earlier, *as described in Opposer's Response*, Applicant's Counterclaim represents to the Board several fact patterns that are misleading in parts and plainly false in others." 49 TTABVUE 5 (emphasis added). That is, Opposer is moving the Board to once again rule on the exact same question which it has just ruled on, and make said ruling based on the exact same facts.

Opposer asserts that its rephrasing of the same earlier factual allegations shows that the Counterclaim is not well-pled. 49 TTABVUE 8. Opposer completely ignores the fact that the Board has *already* ruled, squarely to the contrary, that the Counterclaim is legally sufficient and well-pled, based in part on consideration of these very allegations. 48 TTABVUE 12 ("Applicant has sufficiently pleaded a claim of non-use in commerce of the services identified in Opposer's pleaded registration.") Opposer does not challenge the Board's earlier ruling as being based on anything less than full consideration of all the facts and allegations currently presented in the Motion to Dismiss; that is, as already presented in the Response to the Counterclaim Motion. *See* Exhibit 1.

Opposer does not explain why, without newly-discovered facts for consideration, the Board should ignore principles of collateral estoppel and allow Opposer to reargue the same

issue, much less why the result should be different based on the same facts. The Board should not allow this reargument of the issue, and should instead deny the Motion to Dismiss.

**B. Opposer's Motion to Dismiss Misstates the Law Regarding Motions Under FRCP 12(b)(6).**

Regardless, assuming *arguendo* that the new emphasis on the phrase "well-pleaded factual matter" somehow transforms the argument, such that the Board can or should consider it again, it is noted that this phrase does not indicate that a Motion to Dismiss can succeed by arguing that the factual matter is false. To the contrary, it is a basic legal principle that, for a Motion to Dismiss under FRCP 12(b)(6), all factual claims by the nonmovant *must* be assumed to be true. "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." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (emphasis added, quotations omitted). "Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions." TBMP 503.02. This principle is so fundamental that TBMP 503.02 further notes that "a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted *need not, and should not respond by submitting proofs* in support of its complaint" (emphasis added).

It is noted that the phrase "well-pleaded" or "well-pled" facts in Opposer's own cited cases on the subject (*see* 49 TTABVUE 4) simply stands for the principle that the pled facts must be coherent, and cannot be "mere conclusory statements" or "legal conclusions." *Ashcroft*, 556 U.S. at 678. The phrase does *not* carry Opposer's argued meaning in any of these cases, which to the contrary consistently agree with the principle that challenged allegations must be accepted as

true. *See, e.g., Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011) (“In our assessment of respondent’s motion to dismiss, we must accept as true all of the petitioner’s well-pleaded allegations, and we must construe the complaint in the light most favorable to the petitioner.”)

If the Opposer’s sole argument is that the allegations in the Counterclaim are not factually accurate, this should have been asserted in an Answer to the Counterclaim, and shown by evidence over the course of the proceeding. Opposer has deliberately declined to file such an Answer by the deadline to do so, and has instead filed the present Motion to Dismiss, which is plainly the improper means to deliver such arguments. The Board should therefore deny the Motion to Dismiss, and furthermore should hold Opposer accountable for failing to Answer the Counterclaim.

**C. Applicant’s Counterclaim Is Based on Facts Which Are Shown by the Existing Evidence.**

Furthermore, it is *not* the case that the allegations of the Counterclaim are false or misleading. Rather, the allegations of the Counterclaim are supported by the existing record, as already demonstrated to the Board and the Opposer in Applicant’s Reply to the Response.

It is again noted that the arguments of the Reply to the Response were already presented to both the Board and Opposer on July 22, 2019. Opposer has declined to address or even acknowledge these arguments as part of the present Motion to Dismiss. It is therefore assumed that Opposer has no counter to these arguments. The Board should therefore deny the Motion to Dismiss.

**D. Opposer's Motion Was Filed in Bad Faith.**

The Motion to Dismiss is completely repetitive of questions raised in prior motions, namely the Counterclaim Motion, and presents no information that has not already been fully briefed by the parties and considered by the Board. Opposer seems to have simply copied the factual allegations directly from its Response to the Counterclaim Motion, with only trivial edits which add no new substance (*see* Exhibit 1), and therefore must have been fully aware that the Motion to Dismiss presented no new allegations.

Additionally, Opposer was informed by the Counterclaim Decision, and therefore must have been fully aware, that the Board had already ruled directly on the sufficiency of the pleadings in the Counterclaim. 48 TTABVUE 12 (“Applicant has sufficiently pleaded a claim of non-use in commerce of the services identified in Opposer’s pleaded registration.”)

Furthermore, as it is established law that all allegations of a Counterclaim are assumed true when considering a Motion to Dismiss under FRCP 12(b)(6), and as the Opposer’s sole argument in the Motion is that certain allegations are not true, the Motion to Dismiss is defective and meritless on its face. Opposer must have been fully aware that any argument directed to the accuracy of the allegations was meritless for this purpose, as the Board specifically informed all parties of this principle in the Counterclaim Decision. 48 TTABVUE 6 (“For purposes of determining the sufficiency of Applicant’s pleading, all of his well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to Applicant.”)

In summary, not only is the Motion to Dismiss defective and meritless, but Opposer *must have been aware* at the time of filing that the legal contentions within were not warranted by existing law, under both the principles of res judicata and the law regarding FRCP 12(b)(6).



As such, the only reasonable conclusion is that Opposer, in bad faith, prepared and filed a Motion to Dismiss which it *knew* was meritless and defective, leading to unnecessary delay of proceedings, prejudice to Applicant with the burden and expense of having to respond to a meritless and frivolous motion, and waste of the Board's time and resources to address the same. Such actions are impermissible and deserving of equitable remedies. The Board should therefore hold Opposer accountable for knowingly filing a meritless Motion to Dismiss instead of Answering the Counterclaim.

### **III. CONCLUSION**

For the foregoing reasons, Applicant pleads for the Board to find, based on equitable principles of bad faith, that the deadline to Answer the Counterclaim was *not* tolled by Opposer's knowing filing of a plainly defective and meritless Motion to Dismiss.

Applicant also pleads for the Board to demand that Opposer show cause why it should not be found in default for failing to Answer the Counterclaim before the deadline to do so.

Applicant also pleads for the Board to dismiss the Motion to Dismiss with prejudice.

Respectfully submitted,  
FOR: ROSENBERG, KLEIN & LEE

DATE: December 19, 2019

/Christopher Reaves/  
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**CERTIFICATE OF SERVICE**

I hereby certify that on December 19, 2019, I served a copy of the Document entitled **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED PURSUANT TO FEDERAL RULE OF CIVIL PROCEDURE 12(b)(6)** on Opposer by sending a true and correct copy of the Document by email to Paul Koda at [paul@kodafirm.com](mailto:paul@kodafirm.com).

/Christopher Reaves/  
Christopher Reaves

# **EXHIBIT 1**

**Comparison of Factual Allegations in Opposer’s Response (43 TTABVUE 13-18) and Opposer’s Motion to Dismiss (49 TTABVUE 5-8) (differences in content are underlined)**

First, paragraph 9(a) of the Applicant’s proposed Counterclaim states that, “[d]uring the Deposition of Registrant on May 23, 2019, Registrant admitted to non-use of each of the services identified in the RS Application and Registration, both in connection with the ROCKET SPORTS Mark and generally.” This statement is completely false. During the Deposition of Registrant on May 23, 2019, Registrant carefully and completely explained the use of each service recited in the Registrant’s (Opposer’s) ROCKET SPORTS (Reg. No. 5,297,623) Registration. These explanations are highlighted in the deposition transcript of Stephen Koda taken May 23, 2019 and shown in Opposer’s Response Exhibit A.

Second, paragraph 9(a)(i) of the Applicant’s proposed Counterclaim states that, “[r]egistrant repeatedly denied being “an advertising agency” and admitted that Registrant was not hired by others to provide advertising or promotional services. (See Exhibit 4.)” This statement utterly misrepresents the Registrant’s (Mr. Stephen Koda’s) testimony during his deposition on May 23, 2019. The context of the testimony shown in Applicant’s Exhibit 4 was a series of questions about the goods and services recited in the third-party ROCKET MEDIA (Reg. No. 4,069,932) Registration. In each of the highlighted instances shown, Mr. Stephen Koda, on behalf of the Registrant, Rocket Sports, LLC, stated that Rocket Sports, LLC did not provide the services as they were recited in the third-party ROCKET MEDIA (Reg. No. 4,069,932) Registration. Opposer’s Response Exhibit B shows the testimony of Mr. Stephen Koda, including pages 134, 135, and 136 of Mr. Koda’s May 23, 2019 deposition, which show that his testimony concerned the third-party ROCKET MEDIA (Reg. No. 4,069,932) Registration rather than the Opposer’s ROCKET SPORTS (Reg. No. 5,297,623) Registration. It is unfortunate that Applicant omitted these critical pages in the presentation of Applicant’s “facts.” Furthermore, the services recited in third-party ROCKET MEDIA (Reg. No. 4,069,932) Registration are not the same services recited in the

Opposer's ROCKET SPORTS Mark. Again, Applicant's counsel seems incredulous that Mr. Stephen Koda "repeatedly denied being 'an advertising agency.'" On behalf of Rocket Sports, LLC, Mr. Koda did deny that Rocket Sports, LLC was an advertising agency. This is because Rocket Sports, LLC is not an advertising agency. Nor does the ROCKET SPORTS (Reg. No. 5,297,623) Registration recite that it provides advertising agency services. Apparently, Applicant's counsel was confused about which services were being discussed during the deposition, those services recited in the Opposer's ROCKET SPORTS (Reg. No. 5,297,623) Registration or those of the third-party ROCKET MEDIA (Reg. No. 4,069,932) Registration.

Third, paragraph 9(a)(ii) of the Applicant's proposed Counterclaim states that, "[w]hen asked about the services provided in connection with the ROCKET SPORTS Mark, Registrant described only services which do not qualify as any of "marketing," "advertising," "promotion," or "distributorship" for the primary benefit of others. Rather, the ROCKET SPORTS Mark was described as used in connection with advertising and promoting sales of products solely within Registrant's own inventory, sold solely through Registrant's own website. Registrant is also not paid other than by the end consumer. (See Exhibit 5.)" Contrary to the Applicant's assertion in paragraph 9(a)(ii) of the Applicant's proposed Counterclaim, Mr. Stephen Koda's testimony, on behalf of Rocket Sports, LLC, demonstrates that for each service recited in the ROCKET SPORTS (Reg. No. 5,297,623) Registration, Mr. Koda confirmed that each such service was provided by Rocket Sports, LLC and then proceeded to explain each of those services either in testimony or by directing opposing counsel to the corresponding deposition Exhibit or both. (See Opposer's Response Exhibit A.) In this instance, Applicant is engaging in a sleight of hand only by choosing to use the words "marketing," "advertising," "promotion," or "distributorship" to describe the Opposer's services and then object to those services rather than the Opposer's actual services recited in Opposer's ROCKET SPORTS (Reg. No. 5,297,623) Registration. Using these improperly defined services, Applicant then attempts to plead that Rocket Sports, LLC is somehow not providing such "services" for the benefit of others. Not only does Mr. Koda's deposition testimony contradict this

argument, but the very Specimen of Use offered by the Applicant in Exhibit 3 of Applicant's Motion shows that Rocket Sports, LLC is promoting and advertising a "Prequel Lacrosse Head," "Signature Lacrosse Balls," and "Integra Gloves," all of which are the products and brands of others. It could not be any more clearly stated that Rocket Sports, LLC is providing "[m]arketing services, namely, promoting or advertising the goods and services of others," which is one of the recited services in Opposer's ROCKET SPORTS (Reg. No. 5,297,623) Registration. In addition, page 91 of Mr. Stephen Koda's May 23, 2019 deposition shows that services provided by Rocket Sports, LLC are done so for the benefit of others – namely Epoch Lacrosse.