

ESTTA Tracking number: **ESTTA905846**

Filing date: **06/27/2018**

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

Proceeding	91240520
Party	Plaintiff Omega Capital Management, LLC
Correspondence Address	PENINA MICHLIN CHIU FREDERIC DORWART LAWYERS PLLC OLD CITY HALL 124 EAST FOURTH STREET TULSA, OK 74103 UNITED STATES Email: pchiu@fdlaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Penina Michlin Chiu
Filer's email	pchiu@fdlaw.com
Signature	/Penina Michlin Chiu/
Date	06/27/2018
Attachments	2018-06-27 Motion to Dismiss Counterclaim - Opp 91240520.pdf(121418 bytes)

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

OMEGA CAPITAL)	
MANAGEMENT, LLC,)	Opposition No.: 91240520
Opposer – Counterclaim)	
Defendant,)	IN THE MATTER OF
)	
)	Application Serial No.: 86/883,902
)	Filed: January 22, 2016
v.)	Mark: OMEGA BANK
)	Class: 36
)	Published: February 6, 2018
F.N.B. CORPORATION,)	
Applicant – Counterclaim)	
Plaintiff.)	

**OPPOSER AND COUNTERCLAIM DEFENDANT’S MOTION TO DISMISS
COUNTERCLAIM FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN
BE GRANTED**

Pursuant to **TBMP § 503** and **Fed. R. Civ. P. 12(b)(6)**, Opposer and Counterclaim Defendant, Omega Capital Management, LLC (“*Omega Capital*”), hereby moves to dismiss Applicant and Counterclaim Plaintiff F.N.B. Corporation’s (“*Applicant’s*”) Counterclaim to cancel Omega Capital’s pleaded registration, U.S. Reg. No. 4,654,265. In support of its motion, Omega Capital states:

INTRODUCTION

On April 9, 2018, Omega Capital filed a Notice of Opposition with respect to the above-referenced intent-to-use Application for OMEGA BANK. In support of its Opposition, Omega Capital pleaded U.S. Reg. No. 4,654,265, in addition to common law usage of the mark OMEGA CAPITAL. On May 21, 2018, Applicant filed its Answer, and further filed a Counterclaim to cancel Omega Capital’s pleaded registration, US Reg. No. 4,654,265 (the “*Counterclaim*”). As more specifically set forth herein, the Counterclaim is devoid of factual allegations, consisting

entirely of threadbare, legal conclusions. As a result, the Counterclaim fails to state a claim as a matter of law and must be dismissed.

ARGUMENTS AND AUTHORITIES

A motion to dismiss under **Fed. R. Civ. P. 12(b)(6)** is a test of the sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). To survive such a motion, a claim must contain sufficient **factual** allegations that, if proven, would plausibly establish entitlement to the plaintiff's requested relief. **TBMP §503.02**; *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). In the context of an *inter partes* proceeding before the Board, the "claimant must allege well-pleaded factual matter and **more than** [t]hreadbare recitals of the elements of a cause of action, supported by **mere conclusory statements**." **TBMP § 503.02** (emphasis added); *Ashcroft v. Iqbal*, 556 US 662, 678 (citing *Bell Atlantic Corp. v. Twombly*, 550 US 544, 555 (2007)).

In the present instance, after identifying Omega Capital's registration, Applicant's Counterclaim contains **only** the following, four paragraphs:

1. F.N.B. CORPORATION and/or its predecessor in interest has priority of right, title, interest, and use and is first in time with respect to the mark OMEGA and OMEGA BANK and various iterations of same and as a result United States Trademark Registration No. 4654265 for the mark OMEGA CAPITAL (the "Subject Registration") should not have issued.
2. As further grounds for this Opposition, the Subject Registration issued in error, and should not have proceeded to register over F.N.B. CORPORATION's prior rights.
3. As a result of the facts set forth herein, OMEGA CAPITAL MANAGEMENT, LLC's mark suggests a false connection with F.N.B. CORPORATION, and/or the Subject Registration was obtained contrary to the provisions of Section 1052 of the Trademark Act, and/or of subsection (a), (b), (c) or (d) therein.
4. In view of the above, OMEGA CAPITAL MANAGEMENT, LLC is not entitled to the Subject Registration pursuant to Section 14(3) of the Trademark Act, 15

U.S.C. Section 1064(3), and T.M.B.P. Section 307.02(a), and as such the Registration should be cancelled.

Applicant's Counterclaim at p. 4-5.

These allegations are the very definition of threadbare recitals of the elements of a cause of action because **no pertinent facts are pleaded at all**. Thus, the Counterclaim does not provide enough detail to give Omega Capital fair notice of the basis of Applicant's claim. **TMBP § 309.03(a)(2)**. More to the point, such conclusory allegations are not entitled to be assumed true and cannot form the basis of a valid claim for relief. *Iqbal* at 1949-50.

The main thrust of the Counterclaim appears to allege that Applicant has priority over Omega Capital's pleaded registration. In order for a counterclaimant to properly assert a claim of priority, it must **allege facts** showing proprietary rights in a pleaded mark that are prior to the defendant's rights. **TBMP §309.03(c)(A)**. Such rights might be shown through ownership of an application with a prior application filing date, prior trademark or service mark use, or prior use analogous to trademark use. *See TBMP § 309.03(A)*. Applicant has not alleged facts to plausibly support any of these potential scenarios, and a claim should be dismissed where it fails to plead any facts relevant to a statutory ground negating entitlement to a registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

As an initial matter, it should be noted that the Office records do not support Applicant's claim of priority. Applicant's Application is an intent-to-use Application with a filing date ***subsequent*** to the filing date of Omega Capital's pleaded registration. "[T]he Board may look to such facts as the filing date, filing basis, priority date, publication date, and applicant's name in an application that is the subject of an opposition proceeding. These are facts not subject to proof, and the Board may look to Office records for such facts to determine if a party's allegations are

well-pleaded.” *Compagnie Gervais Danone v. Precision Formulations, LLC*, Opp’n Nos. 91179589, 91184174 at p. 11 (TTAB Jan. 5, 2009) (precedential). In the present instance, the Office records **do not** lend factual support or plausibility to Applicant’s Counterclaim of priority.

Further, Applicant fails to allege use of a mark **in the United States**. The express statutory language of Section 2(d) of the Trademark Act requires prior use of a mark *in the United States*. In *Sun Hee Jung v. Magic Snow*, 124 USPQ2d 1041 (TTAB 2017), the Board granted a motion to dismiss because the opposer in that instance did not allege priority of use **in the United States**. The same is true here. If Applicant’s alleged prior use is only abroad, Applicant’s requested relief is implausible. In the present instance, the Counterclaim alleges no facts one way or the other.

Further, in this case, the Application being opposed is an **intent-to-use** application and no other registrations, applications, or facts have been asserted or alleged by the Applicant to plausibly support a theory of past common law or analogous use, such as allegations regarding trade name usage or open and public continued use. Applicant appears to be known as “F.N.B. Corporation,” and otherwise no reasonable inferences can be drawn from Applicant’s claim of priority, other than there is some illusory usage of “Omega”, “Omega Bank” or “various iterations of same” in some unspecified place, at some unspecified time, of some unspecified nature, and for unspecified services. By way of just one specific example, in the Counterclaim, Applicant does not provide any indication as to when its supposed use began, and Applicant’s failure to plead **facts** demonstrating a priority date prior to the filing date of Omega Capital’s pleaded registration is insufficient to survive a motion to dismiss. *See Precise Formulations*, Opp’n Nos. 91179589, 91184174 at 12-13 (“For purposes of pleading, Precisions’s allegations of priority are insufficient. . . .The allegations therefore **do not allege such facts** that, if proved, would establish that Precision is entitled to the relief sought.”)(emphasis added). In that same vein, Applicant does not allege

inherent or acquired distinctiveness, a required element of a priority claim. *See Threshold TV, Inc. v. Metronome Ent., Inc.*, 96 USPQ2d 1031 (TTAB 2010). In short, no facts in Applicant's Counterclaim support its bare, conclusory claim to priority.

To the extent Applicant has attempted to allege some basis other than priority for cancellation of Omega Capital's registration, the pleading is similarly conclusory and entirely devoid of facts. For example, Applicant's allegation that "Registration was obtained contrary to the provisions of Section 1052 of the Trademark Act, and/or of subsection (a), (b), (c) or (d) therein" is the definition of a threadbare legal conclusion. This allegation, like the Counterclaim as a whole, fails to provide enough detail to give Omega Capital fair notice of the basis of any claim. Accordingly, the Counterclaim should be dismissed.

CONCLUSION

WHEREFORE, Omega Capital respectfully requests that the Board dismiss Applicant's Counterclaim with prejudice, and such further relief as the Board deems appropriate.

RESPECTFULLY SUBMITTED,

Dated: June 27, 2018

By: /Penina Michlin Chiu/
Penina Michlin Chiu, Cal. Bar No. 239431
pchiu@fdlaw.com
Jared Burden, OBA No. 30026
jburden@fdlaw.com
FREDERIC DORWART, LAWYERS PLLC
124 East Fourth Street
Tulsa, Oklahoma 74103
918/583-9922 – Telephone
918/583-8251 – Facsimile

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER AND COUNTERCLAIM DEFENDANT'S MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED was served by electronic transmission on the 27th day of June, 2018, on counsel for Applicant at:

Jennifer L. Whitelaw
Whitelaw Legal Group
ttabmail@whitelawfirm.com
usptomail@whitelawfirm.com.

/Penina Michlin Chiu/ _____
Penina Michlin Chiu