

TTAB3

Attorney's Docket No.: 15621-002PP1

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

In the matter of Registration No. 2,035,944
For the Mark NVISION
Issued on February 4, 1997



03-31-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

In-Vision Communications, Inc.,

Petitioner,

v.

Cancellation No. 92041618

Envision East Photography, Inc.,

Registrant.

Commissioner for Trademarks
BOX TTAB – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

03 APR -8 AM 9:30
RECEIVED TRADEMARK TRIAL AND APPEAL BOARD

**REGISTRANT'S MOTION TO DISMISS
FOR FAILURE TO STATE A CLAIM FOR RELIEF,
AND EMBODIED MEMORANDUM IN SUPPORT THEREOF**

Motion

Pursuant to Fed. R. Civ. P. 12(b)(6), Registrant, Envision East Photography, Inc. ("Registrant"), moves the Trademark Trial and Appeal Board (the "Board") for an order

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

March 28, 2003

Date of Deposit

Amy Armitage

Signature

Amy V. Armitage

Typed or Printed Name of Person Signing Certificate

Registrant : Envision East Photography, Inc.
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dismissing Petitioner, In-Vision Communications, Inc.'s ("Petitioner"), Petition for Cancellation because Petitioner fails to state a claim upon which relief can be granted. The registration that is the subject of this proceeding, Registration No. 2,035,944, has been registered for more than five years. In its Petition for Cancellation, Petitioner fails to plead any ground as required under Section 14(3) of the Trademark Act, the section that sets forth the limited grounds for cancellation of trademarks registered for more than five years. Therefore, we respectfully submit that the Petition for Cancellation must be dismissed with prejudice.

Statement Of The Facts

Registrant is the owner of Registration No. 2,035,944 (the "Registration"), for the mark NVISION for "public relation services; advertising agencies" which issued on February 4, 1997. The Registration has been in full force and effect for more than five years from the date of issuance. A Combined Declaration of Use and Incontestability under Sections 8 and 15 of the Lanham Act was filed on April 1, 2002. The Patent and Trademark Office accepted Registrant's Combined Declaration on June 10, 2002. On November 6, 2002, Petitioner filed a Petition for Cancellation (the "Petition") against the Registration. In the Petition, a true and correct copy of which is attached hereto at Tab A, Petitioner alleges that it has suffered damage where it has used the marks IN-VISION and IN-VISION COMMUNICATIONS and Design and the trade name In-Vision Communication, Inc. prior to Registrant's use of NVISION, and where Registrant's NVISION registration has been cited as an impediment to registration of Petitioner's Application Serial No. 75/659,837 for the mark IN-VISION COMMUNICATIONS and Design on the basis of confusing similarity. Petitioner fails to allege any ground as required under Section 14(3) of the Trademark Act.

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Legal Standard

A motion to dismiss for failure to state a claim upon which relief can be granted "must be filed before or concurrently with, the movant's answer." Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 503.01. Such a motion tests the legal sufficiency of a complaint. Intellimedia Sports, Inc. v. Intellimedia Corp., 43 U.S.P.Q.2d 1203, 1205 (T.T.A.B. 1997); TBMP § 503.02. The following section of the TBMP sets forth the familiar principles that govern such motions:

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 which could be proved in support of its claim.

Id. § 503.02 (citations omitted). "The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer." TBMP § 503.01.

Argument

Petitioner fails to state a claim upon which relief can be granted where it does not allege a basis for cancellation under section 14(3) of the Trademark Act. Section 14(3) provides limited grounds for canceling registrations which, like Registration No. 2,034,944, issued more than five years ago:

[I]f the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act.

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15 U.S.C. § 1064(3). Section 14(3) "has the effect of a statute of limitations." National Service Industries, Inc. v. Turtle Wax, Inc., 154 USPQ 68, 70 (TTAB 1967). "[A] petitioner cannot attack a trademark registration more than five years old on the ground of priority of use." Consorzio del Prosciutto di Parma v. Parma Sausage Prods., Inc., 23 USPQ2d 1894 (TTAB 1992).

As grounds for cancellation, Petitioner alleges:

Petition ¶ 5:

That Petitioner's use of "The IVC Marks" In the United States since at least early as January, 1991 creates common law rights in the "IN-VISION" and "IN-VISION COMMUNICATIONS and Design" mark and name, which rights are superior to Registrant's rights.

Petition ¶ 6:

That Respondent's "n-VISION" registration was cited by the Trademark Examining Attorney...as an impediment to the Petitioner's registration of Application Serial No. 75/659,837 for the mark "IN-VISION COMMUNICATIONS & Design," filed subsequent to the cited registration but reciting an earlier date of first use. On May 6, 2002, the Trademark Examining Attorney issued a Final Office Action refusing Petitioner's aforesaid application on the grounds that Petitioner's "IN-VISION COMMUNICATIONS & Design" mark so resembles Respondent's "nVISION" mark for the services recited in Registration No. 2,035,944 as to be likely to create confusion, mistake or deception with respect to the marks and services offered by the respective parties.

Petition ¶ 7:

That the Examiner's final refusal and citing of the Respondent's registration as an impediment to the Petitioner's application is damaging the Petitioner in that Petitioner is unable to secure a registration of its distinctive mark resulting in loss of revenue to Petitioner and damaging its reputation and good will and value of Petitioner's business.

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Accepting Petitioner's statements as true and in a light most favorable to it, Petitioner has failed to state any claim for relief under 15 U.S.C. § 1064. Petitioner does not allege that Registrant's Mark has become generic, is abandoned or was obtained fraudulently or contrary to the registration requirements of Section 4 or of Sections 2(a)-(c) of the Trademark Act. Instead, Petitioner has only alleged its purported prior use of similar marks pursuant to Section 2(d) of the Trademark Act. Such a basis is time barred under 15 U.S.C. § 1064 due to the fact that the Registration Petitioner seeks to cancel issued more than five years ago. As such, Petitioner fails to state a claim upon which relief can be granted.

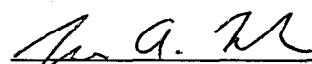
Conclusion

For the reasons set forth above, Registrant's Motion should be granted in its entirety and the Petition for Cancellation dismissed with prejudice.

Opposer reserves the right to assert additional claims and defenses in this action, as allowed under the Trademark Act and Federal Rules of Civil Procedure.

Respectfully submitted,

Date: 3/27/03


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Attorneys for Registrant,
ENVISION EAST PHOTOGRAPHY, INC.

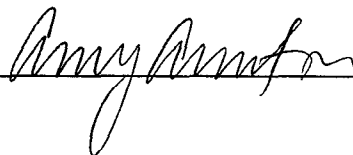
Registrant : Envision East Photography, Inc.
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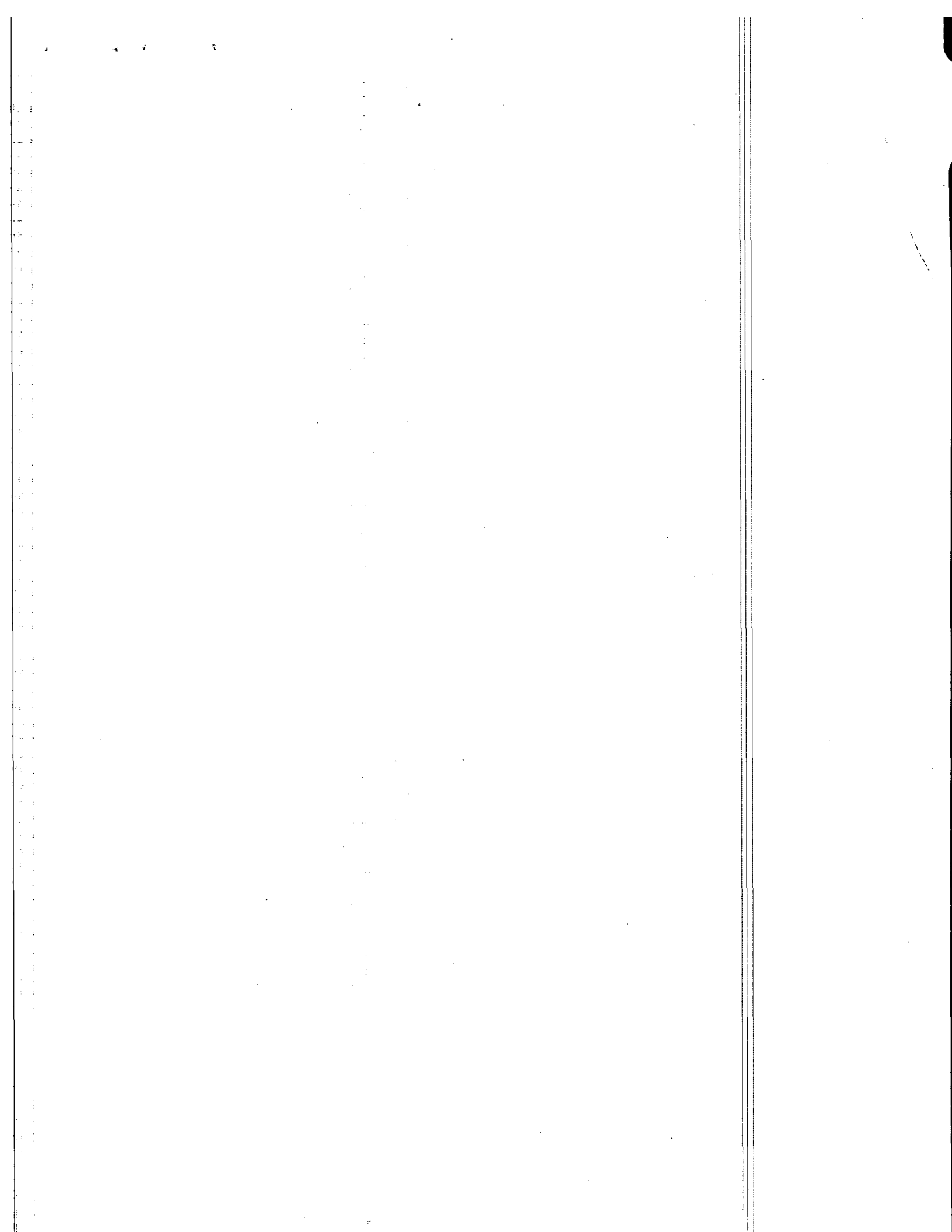
Attorney's Docket No. 15621-002PP1

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing REGISTRANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM FOR RELIEF, AND EMBODIED MEMORANDUM IN SUPPORT THEREOF has this 28th day of March 2002 been mailed by prepaid first class mail to Petitioner's Attorney at his/her place of business:

Mr. Barry F. Soalt
Brown Martin Haller & McClain
1660 Union Street
San Diego, CA 92101





TTAB

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

In the Matter of Service Mark nVISION)
Registration No. 2,035,944)
Registered February 4, 1997)
Principal Register by ENVISION EAST)
PHOTOGRAPHY, INC.)
(a New York corporation))
For public relation services; advertising)
agencies)
International Class 35)

Cancellation No. _____

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TRADEMARK TRIAL AND APPEAL BOARD

IN-VISION COMMUNICATIONS, INC., a
California corporation,

Petitioner,

v.

ENVISION EAST PHOTOGRAPHY, INC., a
New York corporation,

Registrant.

11-06-2002
U.S. Patent & Tm. Off/TM Mail Acct. Doc #20

PETITION FOR CANCELLATION

IN-VISION COMMUNICATIONS, INC., having a principal place of business at
1280 Civic Drive, Suite 306, Walnut Creek, California 94596, believes it has been

I, Amy K. Wolfe, hereby certify that the foregoing document is being deposited with the United States Postal Service as Express Mail, postage pre-paid, in an envelope addressed to Attn: TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on November 6, 2002.

Amy K. Wolfe
(signature)

EL744393985US
(Express Mail label number)

11-6-02
(date of signature)

11/19/2002 KGIBBONS 00000003 024070 2035944
01 FC:6401 300.00 CH

and will continue to be damaged by U.S. Registration No. 2,035,944, and hereby petitions to cancel such registration pursuant to the provisions of 15 U.S.C. § 1064 and hereby appoints the law firm of Brown, Martin, Haller & McClain LLP as its attorneys, with full power of substitution and revocation, to present this Petition for Cancellation and to transact all business before the United States Patent and Trademark Office connected herewith.

As grounds for this Petition, Petitioner alleges:

1. That the Petitioner, IN-VISION COMMUNICATIONS, INC., is a California corporation, having a principal place of business at 1280 Civic Drive, Walnut Creek, California 94596.

2. That Petitioner in connection with the operation of its business activities, has continuously used "IN-VISION" (since at least as early as January, 1991) and "IN-VISION COMMUNICATIONS and Design" (since at least as early as March, 1993) as service marks for development and production of interactive and traditional communications programs and audio-visual presentations for corporate events, namely annual shareholders meetings, awards programs, trade shows, sales and marketing meetings, keynote presentations, training seminars, executive road shows, analyst briefings, press conferences, product launches and conferences; and is using "IN-VISION COMMUNICATIONS, INC." as a trade name for its business. Petitioner continues to currently use its marks and name, particularly "IN-VISION COMMUNICATIONS and Design" and the aforesaid name for the stated services and business (hereinafter all collectively "The IVC Marks").

3. That Petitioner has continuously used and advertised "The IVC Marks" in interstate commerce in connection with the promotion and sales of its aforesaid

services and business; that the aforesaid mark and name is owned by Petitioner and are well-known and recognized by a significant portion of the public as identifying the services and business of Petitioner, and therefore "The IVC Marks" (and name) and the goodwill associated therewith are valuable assets of the Petitioner.

4. That Petitioner's first use of "The IVC Marks" commenced long prior to Respondent's alleged date of first use of the "nVISION" mark, recited in said registration as May, 1994.

5. That Petitioner's use of "The IVC Marks" in the United States since at least as early as January, 1991 creates common law rights in the "IN-VISION" and "IN-VISION COMMUNICATIONS and Design" mark and name, which rights are superior to Registrant's rights.

6. That Respondent's "nVISION" registration was cited by the Trademark Examining Attorney in the U.S. Patent and Trademark Office as an impediment to the Petitioner's registration of Application Serial No. 75/659,837 for the mark "IN-VISION COMMUNICATIONS & Design", filed subsequent to the cited registration but reciting an earlier date of first use. On May 6, 2002, the Trademark Examining Attorney issued a Final Office Action refusing the Petitioner's aforesaid application on the grounds that Petitioner's "IN-VISION COMMUNICATIONS & Design" mark so resembles Respondent's "nVISION" mark for the services recited in Registration No. 2,035,944 as to be likely to create confusion, mistake or deception with respect to the marks and services offered by the respective parties.

7. That the Examiner's final refusal and citing of the Respondent's registration as an impediment to the Petitioner's application is damaging the Petitioner in that Petitioner is unable to secure a registration of it's distinctive mark, resulting in

loss of revenue to Petitioner and damaging it's reputation and good will and value of Petitioner's business.

8. That by virtue of Petitioner's prior, longstanding and current use of "The IVC Marks" and for the other reasons with respect to the invalidity of Respondent's aforesaid registration specified above, Respondent is not entitled to Registration No. 2,035,944, and the aforesaid registration should be canceled pursuant to the provisions of 15 U.S.C. § 1064.

The Commissioner is hereby authorized to charge the required filing fee for this document in the amount of \$300.00 and any additional fees or credit any overpayment to Deposit Account No. 02-4070 in connection with the filing of this Petition.

WHEREFORE, Petitioner believes and avers that it is and will continue to be damaged by Registration No. 2,035,944, as aforesaid, and requests that Respondent be required to answer the allegations of this Petition for Cancellation and that said registration be canceled and the cancellation be sustained.

This Petition for Cancellation is being filed in triplicate herewith.

Respectfully submitted,

Dated: November 6, 2002

By: 
Barry F. Soalt
Attorney for Petitioner

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Facsimile: (619) 238-0062

Atty. Docket No. 7346-SM03