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

Proceeding	92048869
Party	Plaintiff Future Media Architects, Inc.
Correspondence Address	James E. Rosini Kenyon & Kenyon LLP One Broadway New York, NY 10004 UNITED STATES tmdocket@kenyon.com, jrosini@kenyon.com, mrupp@kenyon.com, mkelly@kenyon.com
Submission	Opposition/Response to Motion
Filer's Name	Michael Kelly
Filer's e-mail	tmdocket@kenyon.com, jrosini@kenyon.com, mkelly@kenyon.com, jkung@kenyon.com
Signature	/mk/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration Nos. 3,005,595 3,234,089 3,329,817 3,336,431 3,349,665		
FUTURE MEDIA ARCHITECTS, INC., Petitioner, vs. IDEASTREAM CONSUMER PRODUCTS, LLC, Respondent.	:	Cancellation No. 92/048,869

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS AMENDED PETITION FOR CANCELLATION

Petitioner, Future Media Architects, Inc. (the "FMA"), submits this memorandum of law in opposition to Respondent IdeaStream Consumer Products, LLC's ("IdeaStream") motion to dismiss the amended petition for cancellation for failure to state a claim (the "Motion"). As explained below, FMA has more than sufficiently pled grounds for cancellation of Registration Nos. 3,005,595, 3,234,089, 3,329,817, 3,336,431 and 3,349,665 (the "Registrations"). Moreover, and while entirely not addressed by Respondent, Petitioner has sufficiently pled grounds for cancellation due to genericness. *See* Amended Petition for Cancellation, ¶¶ 41-46. Therefore, IdeaStream's motion to dismiss should be denied.

Moreover, Petitioner notes that, pursuant to the Board's Order of March 12, 2008, Respondent's Filing of a Second Motion to Dismiss is inappropriate prior to the Board rendering its decision on Respondent's first Motion to Dismiss filed on February 20, 2008. Respondent's

attempt to bolster its first Motion with this Second Motion, in spite of the Board's Order, is improper and should be given no consideration. *See* Trademark Rule 2.127(d).

I. FMA HAS SUFFICIENTLY PLED GROUNDS FOR CANCELLATION

A. FMA's Petition for Cancellation Sufficiently States A Claim Against Respondent

For purposes of determining a motion to dismiss, all of FMA's allegations must be accepted as true, and the Petition for Cancellation ("Petition") must be construed in the light most favorable to FMA. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 503.02. Dismissal due to an insufficient Petition for Cancellation is appropriate *only* if it appears certain that FMA is entitled to no relief under any set of facts that could be proved in support of its claims. *Id.* In determining the sufficiency of the Petition, it is the Board's duty to examine the Petition in its entirety, construing the allegations contained therein liberally to determine whether it contains any allegations, which, if proved, would entitle FMA to the relief sought.

The elements of a claim should be stated simply, concisely, and directly. Fed. R. Civ. P. 8(e)(1). Evidentiary matters need not be pleaded in the Petition as such matter are matters for proof, not for pleading. *See* TBMP § 309.03(a)(2). Even under the heightened pleading standard of Federal Rule of Civil Procedure 9(b), Petitioner has outlined sufficient allegations for Respondent to understand the claims against it.

Petitioner's Amended Petition for Cancellation clearly sets forth the Statements of Use at issue, relevant dates, applications, and surrounding circumstances. Indeed, taking FMA's Petition as a whole, it contains sufficient allegations that Respondent made statements that were (1) false, (2) made knowingly, and (3) material representations.

Respondent's myopic reading of Petitioner's Amended Petition for Cancellation has

prevented it from recognizing that FMA's Petition does not allege fraud based on falsely stated § 1(a) first use dates. Moreover, Respondent mistakenly relies on TMEP § 903.09 for Respondent's statement that "[t]here is . . . no requirement that an applicant allege a date of first use that is applicable to every good or service in a given application." TMEP § 903.09 certainly does not stand for the proposition that only one item in the identified class have a first use date; rather, it clearly states that "[t]here must be at least one specified item in a class to which the specified dates pertain. Where the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain." In a recent precedential opinion, the TTAB stated that

> [a]n applicant may file a statement of use only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the notice of allowance, for which applicant seeks registration, unless the statement of use asserts use on only some goods or services and either deletes those goods and/or services on which the mark is not in use or is accompanied by a request in accordance with Trademark Rule 2.87 to divide out from the application the goods or services to which the statement of use pertains.

Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc., Cancellation No. 92045172, p. 10 (Trademark Trial & Appeal Bd. March 7, 2008).

The TTAB finds fraud based on an applicant's Statement of Use where the mark has not been used in commerce on all of the identified goods and services. *See Herbaceuticals* at p. 11-12 (citations omitted). In this case, like in *Herbaceuticals* and *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003), a statement of use may not be submitted for use on multiple goods or services when the mark is not actually used on such goods or services. The Board stated that "[t]here is no question that the statement of use would not have been accepted nor would registration have issued but for respondent's misrepresentation, since the USPTO will

not issue a registration covering goods upon which the mark has not been used." *Id.* at 1208.

Paragraphs 5, 7, 12, 13, 18, 19, 24, 25, 30, and 31 of the Amended Petition for Cancellation allege that Registrant was not using its mark on all of the goods set forth in the registrations as of the dates claimed in the Statement of Use, which, if true, would be a clear case of fraud under the *Medinol* line of cases. As such, the Petition for Cancellation must stand.

Respondent misinterprets Petitioner's allegations because it states that "[t]he failure to use a mark in connection with all of the goods in an application as of the claimed date of first use does not . . . constitute fraud." Petitioner does not allege that Respondent had not used the alleged mark in connection with all of the goods in the Application; rather Petitioner alleges that Respondent had not used the alleged mark in connection with all of the goods in its Statement of Use. Because, as Respondent points out in its Motion, *Medinol* "does not set forth a *new* standard for fraud in trademark cases," Respondent should be cognizant of the requirement that an applicant must have used the alleged mark in connection with all of the goods in its Statements of Use. Particularly in light of the fact that Respondent signed a declaration at the end of no fewer than five Statements of Use which affirms that "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."

"Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register." *Herbaceuticals* at 10, *citing Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986). The Board further states that "[s]tatements regarding the use of the mark on the identified goods and/or services are certainly material to issuance of a

registration" and that "even if [Respondent's] attorney was signing the statements of use based on information and belief, he was clearly in a position to know (or to inquire) as to the truth of the statements providing reason to believe." *Id.* at 11, 14-15. Respondent's acts of fraud are incurable, and the resulting Registrations are void and subject to cancellation.

B. Respondent's Motion to Dismiss Fails to Address Petitioner's Allegations that Respondent's Alleged Mark is Generic

Petitioner also alleged in its Amended Petition for Cancellation that Respondent's alleged marks are generic and subject to cancellation under 15 U.S.C. § 1064(d). *See* Amended Petition for Cancellation, ¶¶ 41-46.

"Dismissal for insufficiency is appropriate only if it appears certain that the [Petitioner] is entitled to no relief under any set of facts that could be proved in support of its claim." TBMP § 503.02. By failing to address Petitioner's genericness claim, Respondent's Motion is inadequate to test the legal sufficiency of the Petition for Cancellation as to this issue, and therefore, Respondent cannot seek dismissal of the Petition for Cancellation.

In any event, Petitioner has alleged a sufficient claim for cancellation due to genericness. The test for determining genericness is a two-step procedure. The first step requires a determination of the class of goods and services at issue; the second step requires a determination of whether the term is understood by the relevant consuming public to refer to the class of goods and services. *See In re Hotels.com, L.P.*, Serial No. 78277681, p. 8-9 (Trademark Trial & Appeal Bd. March 24, 2008) (*citing In re Reed Elsevier Properties, Inc.*, 482 F.3d 1376, 82 U.S.P.Q.2d 1378, 1380 (Fed. Cir. 2007)). Here, Respondent uses the alleged mark VAULTZ in connection with a variety of locking, protective devices for the safekeeping of valuables. The alleged mark is aurally identical to the term "vaults" and, therefore, lends itself to an identical consumer impression. "Vaults" is the plural form of "vault," and a common definition for a

"vault" is "a room or compartment for the safekeeping of valuables." *Merriam-Webster's Collegiate Dictionary* 1385 (11th ed. 2003). Therefore, the term "vaults" is the generic term for locking compartments for the safekeeping of valuables.

II. CONCLUSION

In view of the foregoing, FMA respectfully requests that the Board deny IdeaStream's Motion in its entirety, and allow FMA to continue to move toward resolution of this matter.

Respectfully submitted,

KENYON & KENYON LLP

Dated: April 3, 2008

s/Michael Kelly____
James E. Rosini
Michael Kelly
Mimi K. Rupp
One Broadway
New York, New York 10004
(212) 425-7200

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on April 3, 2008, a copy of the OPPOSITION TO RESPONDENT'S MOTION TO DISMISS AMENDED PETITION FOR CANCELLATION was sent via first class mail to the following counsel of record:

James R. Menker, Esq.
Holley Menker, P.A.
P.O. Box 331937
Atlantic Beach, FL 32233

s/Michael Kelly
Michael Kelly