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

Proceeding	92048869
Party	Defendant IdeaStream Consumer Products, LLC
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Date	10/28/2008
Attachments	10-28-2008 Opposition to Motion to Sever - 92048869.pdf (11 pages)(1447594 bytes)

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

Future Media Architects, Inc.	)	
	)	Cancellation No. 92048869
Petitioner,	)	
	)	Reg. No. 3005595
v.	)	Reg. No. 3234089
	)	Reg. No. 3329817
IdeaStream Consumer Products, LLC,	)	Reg. No. 3336431
	)	Reg. No. 3349665
Registrant.	)	

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REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO MOTION TO SUSPEND AND REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION TO SEVER

Registrant, IdeaStream Consumer Products, LLC ("IdeaStream"), seeks the continued suspension of the above-identified cancellation proceeding pending the final determination of an ongoing civil action between the parties, Case 0:08-cv-60496-WPD Future Media Architects, Inc. v. IdeaStream Consumer Products LLC. Petitioner, Future Media Architects, Inc. ("FMA"), has opposed IdeaStream's Motion to Suspend and is seeking in the alternative to divide the cancellation proceeding. IdeaStream opposes FMA's Motion to Sever.

I. Background

On January 23, 2008, an arbitration proceeding involving the domain name vaultz.com was commenced at the National Arbitration Forum ("NAF") under the Uniform Domain-Name Dispute-Resolution Policy (UDRP).

On February 11, 2008, FMA filed the instant Petition to Cancel with the Trademark Trial and Appeal Board.

On March 24, 2008, the NAF issued a decision transferring the domain name vaultz.com to IdeaStream.

On April 4, 2008, FMA filed a Complaint in the United States District Court for the Southern District of Florida to appeal the NAF decision by seeking (Count I) a declaratory judgment that its ownership of the disputed domain name "does not violate any rights owned by" IdeaStream. Complaint at ¶ 32. FMA also requested (Count II) the cancellation of the five registrations that are the subject of its Petition to Cancel. Complaint at ¶ 34.

On May 7, 2008, IdeaStream filed its Answer to the declaratory judgment claim (Count I) and a counterclaim under the Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125(d).

On May 7, 2008, IdeaStream also filed a motion in the civil action to dismiss the cancellation claim (Count II) under FRCP 9(b).

On June 2, 2008, FMA filed its Answer to IdeaStream's counterclaim in the civil action. A copy of this pleading is submitted herewith.

On July 21, 2008, the court issued an Order[1] dismissing FMA's cancellation claim (Count II) without prejudice.

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[1] A copy of the court's July 21, 2008 Order dismissing Count II of the Complaint was submitted with IdeaStream's Motion to Suspend.

On August 22, 2008, FMA filed an Amended Complaint seeking (Count I) a declaratory judgment that its ownership of the disputed domain name "does not violate any rights owned by" IDEASTREAM. Amended Complaint at ¶ 32. FMA also requested (Count II) the cancellation of only US Reg. No. 3,349,665. Amended Complaint at ¶ C.

On September 4, 2008, IdeaStream filed a second motion in the civil action to dismiss the Amended Complaint's cancellation claim (Count II) under FRCP 12(b)(6).

On September 25, 2008, IdeaStream filed a Motion requesting that the Trademark Trial and Appeal Board (TTAB) suspending the above-referenced cancellation proceeding pending the final determination of an ongoing civil action between the parties.

On October 10, 2008, the TTAB issued an Order granting IdeaStream's Motion to Suspend.

After the issuance of the TTAB's Order, FMA filed its Opposition to IdeaStream's Motion to Suspend and filed, in the alternative, a Motion to Sever.

II. Suspension is Proper

FMA opposes IdeaStream's Motion to Suspend on the grounds that the civil action currently only seeks the cancellation of one (U.S. Reg. No. 3,349,665) of the five registrations at issue in the cancellation proceeding.

The issue is not whether the civil action and the cancellation proceeding involve the same registrations, but whether the civil action "involves issues in common with those in a proceeding before the Board". TBMP Rule 510.02(a). In Count I of its Complaint and its Amended Complaint, FMA is seeking declaratory judgment that its ownership of the vaultz.com domain

name "does not violate any right" IdeaStream has in the mark VAULTZ which is the subject of all five of the registrations at issue in this cancellation proceeding. Complaint at ¶ 32 and Amended Complaint at ¶ 32. In addition, FMA asserts as an affirmative defense to IdeaStream's ACPA counterclaim that "[IdeaStream's] U.S. registrations for the Alleged Mark are subject to cancellation based on fraud and genericness." FMA's Answer, Affirmative Defenses ¶ 4. Clearly, the civil action will have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues.

The civil action and the cancellation proceeding involve the same parties. IdeaStream's VAULTZ mark which is the sole mark at issue in the civil action is the subject of all five of the registrations involved in the cancellation proceeding. The claims and defenses being asserted by the parties in the civil action overlap with the claims and defenses being asserted and likely to be asserted in the cancellation proceeding.

Under such circumstances, a suspension of the instant proceedings is warranted. *See* TBMP Section 510.02(a), n. 167 and cases cited therein.

III. Severance would be Improper

The sole basis for FMA's Motion to Sever is that the civil action currently relates to one of the five registrations at issue in this cancellation proceeding. While this is true at present, FMA's original Complaint sought the cancellation of the same five registrations that are at issue in the instant proceedings. It was only after the court dismissed FMA's request for cancellation (Count II) under FRCP (9)(b) that FMA filed the Amended Complaint wherein it elected to seek only the cancellation of one of IdeaStream's five registrations for its VAULTZ mark. Therefore,

although FMA is no longer seeking the cancellation of the other four registrations IdeaStream owns for its VAULTZ mark, it was clearly within the court's jurisdiction to consider such claims. In fact, it was permissible, if not mandatory, for FMA to allege (subject to the Federal Rules of Civil Procedure) all of the claims it is asserting in the cancellation proceeding in the civil action. Thus, the FMA's failure to pursue the cancellation of IdeaStream's other registrations should not enable it to simultaneously pursue their cancellation in the cancellation proceeding.

IV. Conclusion

FMA is not prejudiced by the continued suspension of the entire cancellation proceeding. Instead, it is clearly attempting to drive up the costs of litigation and waste judicial resources by pursuing one theory for its claims in its civil court action and another theory for its claims in the cancellation proceeding. To avoid such waste, IdeaStream requests that the entire cancellation proceedings remain suspended.

Respectfully submitted,

IDEASTREAM CONSUMER PRODUCTS, LLC

Dated: October 28, 2008

By: 

James R. Menker

Registrant's Attorneys

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO MOTION TO SUSPEND AND REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION TO SEVER has been served on the attorneys for Applicant by mailing said copy on October 28, 2008, via first class mail, postage prepaid to:

James E. Rosini
KENYON & KENYON LLP
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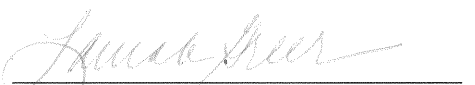
New York, NY 10004



Laura K. Greer

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

Case No.: 08-60496-DIMITROULEAS

FUTURE MEDIA ARCHITECTS, INC.,

Plaintiff,

v.

IDEASTREAM CONSUMER PRODUCTS LLC,

Defendant.
_____/

PLAINTIFF'S ANSWER AND AFFIRMATIVE DEFENSES TO DEFENDANT'S COUNTERCLAIM

Plaintiff-Counterclaim Defendant Future Media Architects, Inc. ("FMA"), as and for its Answer to the counterclaim filed by Defendant- Counterclaim Plaintiff IdeaStream Consumer Products LLC. ("ICP"), responds as follows, through its undersigned attorneys:

1. Responding to the allegations set forth in paragraph 1 of the counterclaim, FMA admits that the counterclaim purports to set forth a claim for cyber piracy, and otherwise denies said allegations.

2. Admitted.

3. Admitted.

4. Admitted

5. FMA is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 5 of the counterclaim concerning ICP, and denies such allegations on this basis. FMA otherwise denies the remaining allegations of this paragraph.

6. FMA admits that its address is P.O. Box 71, Road Town, Tortola, British Virgin Islands. The allegations set forth in paragraph 6 are otherwise denied.

7. FMA admits that Thunayan Khalid AL-Ghanim is the Founder and CEO of FMA. Mr. AL-Ghanim is a Kuwaiti citizen. The allegations set forth in paragraph 7 are otherwise denied. FMA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegation set forth in paragraph 7 of the counterclaim, and denies such allegation on this basis.

8. FMA is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 8 of the counterclaim, and denies such allegations on this basis.

9. FMA is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 9 of the counterclaim, and denies such allegations on this basis.

10. In response to the allegations of paragraph 10 of the counterclaim, FMA admits that records of the United States Patent and Trademark Office ("USPTO") reflect that ICP owns Reg. Nos. 3005595, 3234089, 3329817, 3336431, and 3349665. FMA avers that these registrations are subject to cancellation, *inter alia*, because ICP was not using its alleged mark on all the goods set forth in the registration as of the dates claimed in its Statements of Use. Moreover, a cancellation proceeding is currently pending before the Trademark Trial and Appeal Board (Cancellation No. 92/048,869). FMA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 10 of the Complaint, and denies such allegations on this basis.

11. Denied. FMA avers that the alleged mark, vaultz, (the "Alleged Mark") is generic and the registrations for same should be canceled due to genericness.

12. FMA admits it registered its domain name <vaultz.com> (sometimes "FMA's Domain Name") on February 10, 2004 well before any of ICP's U.S. registrations for the alleged mark were issued. The records of the United States Patent and Trademark Office ("USPTO")

reflect that ICP's Reg. Nos. 3005595, 3234089, 3329817, 3336431, and 3349665 for the Alleged Mark were issued October 11, 2005, April 24, 2007, November 6, 2007, November 13, 2007, and December 4, 2007, respectively. In fact, the applications for ICP's Reg. Nos. 3336431 and 3349665 for the Alleged Mark were not filed until August 23, 2005, over a year **after** FMA registered its Domain Name. Of the U.S. applications for the Alleged Mark which were filed on January 9, 2003, all such applications were filed as "intent to use" applications. ICP did not file any evidence of use for any of its registrations for the Alleged Mark until well after FMA registered its Domain Name. Indeed, for four of the five U.S. registrations, ICP filed evidence of use as late as 2007. The earliest date that ICP filed evidence of use for its U.S. registrations for the Alleged Mark was January 23, 2005, nearly a year after FMA registered its Domain Name. Moreover, for this registration (Reg , No. 3,005,595), ICP does not allege use of its Alleged Mark for protective storage cases for DVDs and CDs until June 30, 2004, nearly half a year after FMA registered its Domain Name. FMA is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 12 of the counterclaim, and denies such allegations on this basis.

13. FMA's Domain Name is <vaultz.com>. The allegations set forth in paragraph 13 are otherwise denied.

14. Denied.

15. Denied.

16. FMA admits that it had used its Domain Name in connection with its search engine optimization business. Any objectionable links were populated by third-party automated software. Nevertheless, promptly after learning of ICP's objection to such links, FMA instructed the removal of such links. The allegations set forth in paragraph 16 are otherwise denied.

17. Denied.

18. FMA responds to the allegations realleged and incorporated by reference in paragraph 18 of the counterclaim in the same manner as set forth above.

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19. Responding to the allegations set forth in paragraph 19 of the counterclaim, FMA admits that the counterclaim purports to set forth a claim for cyber piracy, and otherwise denies said allegations.

20. Denied.

21. Denied.

22. FMA's Domain Name is <vaultz.com>. The allegations set forth in paragraph 22 are otherwise denied.

23. Denied.

24. Denied.

AFFIRMATIVE DEFENSES

1. The counterclaim fails to state a claim on which relief can be granted.

2. The counterclaim is barred by unclean hands.

3. ICP's Alleged Mark was not distinctive as defined in 15 U.S.C. § 1125(d)(1)(A) when FMA registered its Domain Name, and is not distinctive as defined in 15 U.S.C. § 1125(d)(1)(A).

4. ICP's U.S. registrations for the Alleged Mark are subject to cancellation based on fraud and genericness.

Dated: May 30, 2008

LOTT & FRIEDLAND, P.A.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the referenced date, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the Manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

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