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Filing date: **02/21/2013**

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

|                           |  |
|---------------------------|--|
| Proceeding                | 92054821   |
| Party                     | Defendant<br>Traci Macaro  |
| Correspondence<br>Address | DAVID R BURKHOLDER<br>BALCH & BINGHAM LLP<br>PO BOX 306<br>BIRMINGHAM, AL 35201-0306<br>UNITED STATES<br>dburkholder@balch.com |
| Submission                | Motion to Dismiss - Rule 12(b)   |
| Filer's Name              | David R. Burkholder  |
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| Date                      | 02/21/2013   |
| Attachments               | Renewed_Motion_to_Dismiss.pdf ( 5 pages )(26969 bytes )  |

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

To the Assistant Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

In the Matter of Registration No. 3040209  
Filed: March 26, 2004  
Mark: OOH LA LA  
Published in the *Official Gazette* dated October 18, 2005

**OOH LA LA! JEWELRY and  
ACCESSORIES, INC., a Florida  
corporation, AMY TURNER and TAMMY  
KIPP,** )  
)  
)  
)  
**Petitioners,** )  
)  
)  
**v.** )  
)  
**OOH LA LA, LLC, an Alabama limited  
liability company, KENNETH R. MACARO )  
and TRACI MACARO,** )  
)  
**Registrants.** )

**Cancellation No.: 92054821**

**CERTIFICATE OF MAILING**

I hereby certify that the original of this filing is being electronically filed with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office through the web site at <http://estta.uspto.gov> on July 16, 2012.

/s/ David R. Burkholder  
David R. Burkholder

**REGISTRANTS' AMENDED AND RENEWED MOTION TO DISMISS**

Registrants, OOH LA LA, LLC, Kenneth R. Macaro, and Traci Macaro (hereinafter "Registrants"), by and through their undersigned counsel and pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, hereby moves for dismissal of this cancellation proceeding for

failure to state a claim upon which relief can be granted against the federally registered trademark OOH LA LA (Reg. No. 3040209). In support thereof, Registrants state as follows:

1. Registrants' federal trademark registration (Reg. No. 3040209 for the mark OOH LA LA) (the "Mark") issued on the Principal Register on January 10, 2006.
2. Petitioners filed this cancellation proceeding on October 20, 2011, more than five (5) years **after** registration of the Mark.
3. Since the Mark was over five (5) years old when Petitioners sought to cancel, only limited specific grounds under Lanham Act § 14(3) were available for cancellation of the Mark at the time Petitioners filed.
4. The limited specific grounds that can be asserted for cancellation at any time under Lanham Act § 14(3) do **not** include Petitioners' stated grounds of "using the mark, Ooh La La Jewels Du Jour... since 2009." Petition for Cancellation, ¶ 1. Junior use of a mark is not grounds for cancellation.
5. The fact that Registrants brought a civil suit in federal court for trademark infringement and later dismissed that lawsuit without prejudice are **not** included in the limited specific grounds that can be asserted for cancellation at any time under Lanham Act § 14(3), despite the fact that this is cited as grounds by the Petitioners. See Petition for Cancellation, ¶ 2.
6. The limited specific grounds that can be asserted for cancellation at any time under Lanham Act § 14(3) do **not** include Petitioners' stated grounds of "widespread prior use of the name Ooh La La for the same and related products and/or services covered by the Registration." Petition for Cancellation, ¶ 3. Neither is a mark being alleged to be "ubiquitous" among the limited grounds for cancellation. *Id.* While a mark

becoming generic for goods or services is among the limited grounds for cancellation stated in Lanham Act § 14(3), Petitioners have not stated the Mark is generic or provided any evidence the Mark OOH LA LA is generic for purses and handbags. Instead, they have only alluded to “widespread” use.

7. Petitioners counsel responded to Registrant’s initial Motion to Dismiss by stating “Registrant’s failure to file the motion to dismiss prior to or concurrently with the answer waives the motion.” The original Motion to Dismiss has not been ruled upon. Registrant responds that failure to state a claim upon which relief can be granted is the first listed of Registrant’s Affirmative Defenses, so said defense has not been waived.
8. Furthermore, this tribunal can and should take judicial notice of the fact that Petitioner’s cancellation proceeding is facially improper under the Lanham Act and dismiss it as a matter of law. Since no allowable ground for cancellation has been presented by Petitioners, the cancellation proceeding should be dismissed without requiring the parties to go to the time and expense of discovery so this same motion can be presented as a motion for summary judgment. To force such a procedure is a waste of judicial and economic resources.

WHEREFORE, premises considered, Registrants move the Trademark Trial and Appeal Board to dismiss this Petition for Cancellation for failure to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6) or as a matter of law.

Dated: February 21, 2013

/s/David R. Burkholder

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Attorney for Registrants

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that the original of this **Renewed Motion to Dismiss** was mailed to:

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via electronic service on February 21, 2013.

/s/ David R. Burkholder \_\_\_\_\_

David R. Burkholder  
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