

ESTTA Tracking number: **ESTTA445045**

Filing date: **12/07/2011**

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

Proceeding	92054876
Party	Defendant J.R. Simplot Company
Correspondence Address	J R SIMPLOT COMPANY PO BOX 27 BOISE, NV 83707 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Barbara A. Friedman
Filer's e-mail	baf@usiplaw.com, efile@usiplaw.com
Signature	/Barbara A. Friedman/
Date	12/07/2011
Attachments	Motion to Dismiss.pdf ( 2 pages )(100023 bytes )

Registrant moves to dismiss the cancellation for Petitioner's failure to state a claim upon which relief may be granted under F.R.C.P. 12(b)(6), because the claim is untimely and time barred under 15 U.S. C. § 1064. Support for the Motion is provided below.

### MEMORANDUM

The Petition for Cancellation was filed in the Trademark Trial and Appeal Board on November 21, 2011, and served by mail on Registrant, which received it on November 21, 2011. The Board has set January 14, 2012 as the date for filing the Answer. This motion is filed prior to the filing of Registrant's Answer to the Petition for Cancellation, and prior to the deadline for filing the Answer, and thus is timely.

Registration 2929193 issued on March 1, 2005, so as of the filing of the Petition for Cancellation, it was well over five years old. On November 1, 2010, Registrant filed in the United States Patent and Trademark Office its Combined Declaration of Use and Incontestability under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065, which filing was found to have met the statutory requirements, and was accepted and acknowledged by the USPTO on November 13, 2010. Thus, the Registration is now considered to be "incontestable" pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065.

The sole ground for cancellation stated in the Petition for Cancellation is likelihood of confusion as between Petitioner's mark SUPERCAL and Registrant's mark SP SUPER CAL FORMULA. Petitioner alleges it has prior use of a mark SUPERCAL, that Registrant's mark SP SUPER CAL FORMULA is confusingly similar thereto, and that the parties' respective products are similar. Petitioner states in Paragraph No. 11 "In light of the similarity with Petitioner's mark SUPERCAL, Registrant's mark was improperly registered by the USPTO as substantially likely to cause confusion under Trademark Act §2(d) and should be canceled".

Petitioner might have brought its claim up to and including February 28, 2010, but there is no question that as of March 1, 2010, the fifth anniversary following issuance of the registration, Section 2(d) was no longer an available basis for cancellation of Registration No. 2929193. Section 14 of the Lanham Act, 15 U.S.C. §1064. Section 14(1) provides that cancellation may be brought "Within five years from the date of the registration of the mark under this Act". Section 14(3) sets forth certain specific grounds for cancellation that are not barred after five years, but likelihood of confusion under Section 2(d) is not among those enumerated grounds. Thus, it is an accepted aspect of trademark registration law that a claim of likelihood of confusion under Section 2(d) is time barred by Section 14(3) of the Lanham Act, as to registrations which are more than five years old. *Otto Int'l, Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862-1863 (TTAB 2007). Petitioner's Section 2(d) claim, on which the Petition for Cancellation against Registration No. 2929193 is based, is thus time barred by Section 14 of the Lanham Act, and must be dismissed.

There is no question that the basis for the Petition for Cancellation is Section 2(d). The “Grounds” for cancellation are set forth in the Petition in Paragraphs 7 through of 12, and are of the type typically presented in support of a Section 2(d) claim – priority, similar marks, related goods, and damage to the Petitioner resulting therefrom. See Otto Int’l, Inc. v. Otto Kern GmbH at 1863. Paragraph 11 specifically cites Section 2(d) as the reason Reg. No. 2929193 should be cancelled. There are no additional grounds for cancellation set forth in the Petition, and no facts are alleged other than those typically found in a Section 2(d) claim. The Section 2(d) claim is time-barred under Section 14(3) of the Lanham Act, and there being no other basis for cancellation alleged, Petitioner has failed to state a proper claim for relief in the Petition for Cancellation. Otto Int’l, Inc. v. Otto Kern GmbH at 1863.

For the above-stated reasons, Registrant requests that its Motion to Dismiss be granted and that this cancellation be dismissed.

Respectfully submitted,

J.R. Simplot Company  
By its Attorneys

/Barbara A. Friedman/  
Attorney for Registrant  
Edell Shapiro & Finnan LLC  
1901 Research Blvd. Suite 400  
Rockville, MD 20850  
301-424-3640  
[efile@usiplaw.com](mailto:efile@usiplaw.com); [baf@usiplaw.com](mailto:baf@usiplaw.com)

#### CERTIFICATE OF SERVICE

The undersigned certifies that a copy of this MOTION TO DISMISS was served upon Petitioner, through its counsel of record, this 7<sup>th</sup> day of December 2011, by first class mail, postage pre-paid, in an envelope addressed to Emily E. Harris, Davis, Brown, Koehn, Shors, & Roberts, PC, 215 10<sup>th</sup> Street, Suite 1300, Des Moines, Iowa 50309

/Barbara A. Friedman/  
Attorney for Registrant  
Edell Shapiro & Finnan LLC  
1901 Research Blvd. Suite 400  
Rockville, MD 20850  
[efile@usiplaw.com](mailto:efile@usiplaw.com); [baf@usiplaw.com](mailto:baf@usiplaw.com)