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

Proceeding	92056318
Party	Defendant W & W Concept, Inc.
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Attachments	Reply To Petitioner's Opposition to Motion to Dismiss .pdf ( 4 pages )(129248 bytes )

In the United States Patent and Trademark Office  
Before the Trademark Trial and Appeal Board

PERCEPTIONS, INC., a New York  
Corporation,

Petitioner,

W & W CONCEPT, INC., d/b/a  
PERSEPTION, a California corporation,

Registrant.

Cancellation No. 92056318

**REPLY TO PETITIONER'S  
OPPOSITION TO MOTION TO DISMISS**

Registrant, W & W Concept, Inc. d/b/a Perseption (“W & W”), respectfully submits the following reply in support of its motion to dismiss the petition for failure to state a claim on which relief can be granted.

**1. The Petition Should Not Be Allowed to Proceed Because Priority of Use Provides No Basis For Cancellation of a Mark Which Has Been on the Principal Register for Over Five Years.**

Even assuming that Petitioner is correct in stating the PERSEPTION mark has been on the Principal Register for just six years and not thirteen years (which Registrant contends is legally erroneous), Petitioner’s argument still fails because six years is sufficient to confer incontestable status on the mark.

While Petitioner is correct in citing 15 U.S.C. §1065 as standing for the proposition that the presence of a mark on the Principal Register for over five years does not completely immunize the registration from cancellation, prior use does not fall under one of the expressly enumerated exceptions to incontestability. Under the express provisions of that section, “a petition for cancelation of a registration cannot

be brought after five years from the date of the registration of the mark under this Act except under subsection (c) thereof, which provides that a person may apply to cancel a registration at any time if the registered mark becomes the common descriptive name of an article or substance on which a patent has expired, or has been abandoned or its registration was obtained fraudulently.” *Dunleavy Co. v. Koepfel Metal Furniture Corp.*, 122 U.S.P.Q. 395, 396, 1959 WL 6186 (TTAB Jul. 31, 1959); 15 U.S.C. §1065.

If a mark has been registered for over five years, a petitioner may not assert prior use as a ground for cancellation and is forever barred from doing so under 15 U.S.C. §1064. *FS Servs., Inc. v. Feed Serv. Corp.*, 150 U.S.P.Q. 201, 202, 1966 WL 7249 (TTAB May 5, 1966) (“as opposer’s pleaded registrations all issued more than five years prior to the filing of applicant’s counterclaim, the only bases for the cancellation thereof are those set forth in Section 14(c)... Since opposer’s pleaded registration has become incontestable, applicant’s assertion of priority of use provides no basis for the cancellation of the registrations”); *Dunleavy Co.*, supra (granting motion to dismiss where petitioner brought a petition to cancel registrations older than five years and asserted prior use as the grounds for cancellation). Because the PERSEPTIONS mark has been registered for over five years, Petitioner may not assert prior use as a ground for cancellation.

Finally, Petitioner misunderstands another provision in 15 U.S.C. 1065 which excepts a mark from incontestable status “[t]o the extent, if any, to which the use of [the registered mark] infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of the registration under this Act of such registered mark.” Petitioner’s argument that this

provides another ground for cancelation of a registration is misguided. Instead of providing another ground for cancelation, it provides a defense to a charge of infringement of an otherwise incontestable registration. See *Marcon, Ltd. v. Helena Rubenstein, Inc.*, 225 U.S.P.Q. 895 (4th Cir. 1985); *Casual Corner Associates, Inc. v. Casual Stores of Nevada, Inc.*, 493 F.2d 709, 711-712 (9th Cir. 1974).

Petitioner's petition to cancel is untimely and barred as a matter of law.

Therefore, the Board should grant W & W's motion to dismiss.

**2. The Board Should Consider the Motion To Dismiss Before Considering Any Suspension of Proceedings Because it is Dispositive, But, In the Alternative, Should Stay the Petition Pending Litigation.**

Before suspending proceedings pending the outcome of another proceeding, the Board should establish that there are no outstanding motions before it that are potentially dispositive. 37 C.F.R. §2.711(b); TBMP §510.02. The motion to dismiss will be dispositive in this case because dismissal will conclusively end all proceedings before the Board.

If the Board decides that the motion to dismiss will not be dispositive, then W & W respectfully submits that the Board should stay this proceeding pending resolution of the litigation over the same issues. The request for a stay is uncontested.

Dated this 7th day of January, 2013.

By: s/ Keith J. Wesley

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