

ESTTA Tracking number: **ESTTA507900**

Filing date: **11/28/2012**

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

Proceeding	92056352
Party	Defendant Maine Industrial Tire LLC
Correspondence Address	MAINE INDUSTRIAL TIRE LLC 107 AUDUBON ROAD WAKEFIELD, MA 01886 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Tanya Marie Curcio
Filer's e-mail	tcurcio@haslaw.com, tmdocket@haslaw.com
Signature	/tmc/
Date	11/28/2012
Attachments	Maine Ind. Tire- 12b5 Motion to Dismiss (Can. 92056352).PDF ( 4 pages ) (24716 bytes ) Exhibit A- Maine Ind. Tire- 12b5 Motion (Can. 92056352).PDF ( 1 page )(35400 bytes ) Exhibit B- Maine Ind. Tire- 12b5 Motion (Can. 92056352).pdf ( 5 pages )(21456 bytes )

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

Blackstone/OTR, LLC	)	
	)	
Petitioner,	)	Cancellation No. 92056352
	)	Reg. No.: 3,851,316
v.	)	Reg. Date: Sept. 21, 2010
	)	Mark: AERIAL MAX
Maine Industrial Tire, LLC	)	Class: 12
Registrant.	)	

**REGISTRANT’S MOTION TO DISMISS FOR INSUFFICIENT SERVICE**

Pursuant to Rule 12(b)(5) of the Federal Rules of Civil Procedure and Trademark Rules of Practice 2.111, 2.126 and 2.127, Registrant Maine Industrial Tire, LLC (“Maine Tire”) hereby moves to dismiss the Petition to Cancel filed by Blackstone/OTR, LLC (“Petitioner”).

Maine Tire is the owner of the registration at issue in this proceeding, U.S. Registration No. 3,851,316, for the trademark AERIAL MAX (the “Registration”). Because Petitioner failed to serve a copy of its Petition to Cancel (the “Petition”) on Maine Tire, as expressly required by the Trademark Rules of Practice and precedent established by the Trademark Trial and Appeal Board (the “Board”), the cancellation proceeding has not been properly instituted and should be dismissed.<sup>1</sup>

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<sup>1</sup> Pursuant to Trademark Rule 2.116(a), a party may raise the defense of insufficient service of process under Fed. R. Civ. P. 12(b)(5). See *Chocoladefabriken Lindt & Sprungli AG*, Opp. No 91187963, 91 U.S.P.Q.2D 1698 (T.T.A.B. July 30, 2009). Rule 12(b) allows the affirmative defense of insufficient service to be presented by motion to be filed prior to, or concurrently with, the defendant’s answer. See *id.*

## STATEMENT OF FACTS

On October 19, 2012, Petitioner, acting through its attorney Todd Deveau of the law firm Thomas Horstemeyer, filed the Petition by means of the Board's Electronic Filing System ("ESTTA"). The Petition is comprised of the complete electronic ESTTA form and a five-page document attached by Petitioner entitled "Petition for Cancellation." The Certificate of Service at the end of the ESTTA form indicates that a copy of the Petition has been served on all parties, with Mr. Deveau's electronic signature appearing below. The Petition also included a Certificate of Service that read: "I hereby certify that a copy of the Petition for Cancellation filed with the United States Patent and Trademark Office Trademark Trial and Appeal Board on October 19, 2012, is being deposited with the United States Postal Service on the date shown below, with sufficient postage as first class mail, in an envelope addressed to: Deborah L. Benson, Hinckley, Allen & Snyder LLP 28 State St, Boston, MA 02109-1775" with Mr. Deveau's electronic signature appearing below.

Ms. Benson received an electronic copy of the Petition and a letter. The same documents were also sent to Ms. Benson via US Mail.

In the letter to Ms. Benson that accompanied the Petition, the Petitioner's counsel states that Ms. Benson is listed as the attorney of record *and domestic representative* for the Registration. See Exhibit A for a copy of such correspondence. However, no Domestic Representative has been appointed for the Registration. See Exhibit B for printout of the TARR record for Registration No. 3,851,346.

Maine Tire is a limited liability company organized in the state of Delaware with an address on record with the United States Patent and Trademark Office as 107 Audubon Road, Wakefield, MA, 01886. Maine Tire never received a service copy of the Petition at its address of record.

### **ARGUMENT**

Petitioner failed to properly serve the Petition and accordingly, the cancellation proceeding should be dismissed. Trademark Rule of Practice 2.111(a) provides that a cancellation proceeding is commenced by timely filing in the Office a petition for cancellation with the required fee. 37 C.F.R. 2.111(a).

Trademark Rule of Practice 2.111(b) further provides that “Petitioner must serve a copy of the petition, including any exhibits, *on the owner of record for the registration*, or on the owner’s domestic representative of record, if one has been appointed, *at the correspondence address of record in the Office*. The petitioner must include with a petition for cancellation proof of service, pursuant to Sec. 2.119, *on the owner of record*, or on the owner’s domestic representative of record, if one has been appointed, *at the correspondence address of record in the Office*. 37 C.F.R. 2.111(b) (emphasis added).

Affixing proof of service to a petition for cancellation without actually effecting service in accordance with the rules is insufficient to commence the proceeding. See Jacques Moret, Inc. v. Speedo Holdings B.V., 102 U.S.P.Q.2D 1212 (T.T.A.B. 2012) (granting a motion to dismiss when the petition to cancel was not served on the owner of the registration or its appointed domestic representative but instead was served on prior counsel who had responded to a cease and desist letter). Thus, a cancellation proceeding has not been instituted if a copy of the petition (with any exhibits) is not served on the

owner of the mark in question, or its domestic representative, at the correspondence address of records listed in the Office records.

In this case the TSDR system lists Maine Tire as the owner of the Registration with an address of record as 107 Audubon Road, Wakefield, MA, 01886 and indicates that Maine Tire has not appointed a domestic representative. The Certificate of Service attached to the Petition did not indicate service to Maine Tire nor did Maine Tire receive the Petition from the Petitioner at its address of record.

Service of a courtesy copy of the Petition on Ms. Benson at Hinckley, Allen & Snyder LLP- who was never appointed Maine Tire's domestic representative for the Registration - does not comply with the straightforward rule for service set forth in Trademark Rule 2.111.

Accordingly, the Petition was not properly served and the cancellation proceeding should be dismissed.

### **CONCLUSION**

For the foregoing reasons, Registrant respectfully requests the Board to exercise its authority under Rule 12(b)(5) and dismiss the cancellation proceeding against Maine Tire for improper service.

Respectfully submitted,

Maine Industrial Tire, LLC

/tmc/

Tanya Marie Curcio  
HINCKLEY, ALLEN & SNYDER LLP  
28 State Street  
Boston, MA 02109  
Tel: (617) 345-9000  
Fax: (617) 345-9020  
E-mail: tcurcio@haslaw.com

Dated: November 28, 2012



Thomas | Horstemeyer  
INTELLECTUAL PROPERTY ATTORNEYS

October 19, 2012

Deborah I. Benson  
Hinckley, Allen & Snyder LLP  
28 State St  
Boston, MA 02109-1775

Via Email and First Class Mail  
tmdocket@haslaw.com

Re: U.S. Trademark Registration  
Mark: **AERIAL MAX**  
Registration No.: 3,851,316  
Registration Date: September 21, 2010  
Our File No.: 820602-7020

Dear Ms. Benson:

I see that you are listed as the attorney of record and domestic representative in connection with the above-identified US Trademark Registration. As a courtesy, enclosed is a copy of the Petition we have filed to cancel the registration.

With best regards,

Sincerely,

Todd Deveau  
todd.deveau@tkhr.com

TD/ak  
Enclosure  
cc: Blackstone/OTR, LLC

**Generated on:** This page was generated by TSDR on 2012-11-28 10:46:38 EST

**Mark:** AERIAL MAX

**AERIAL MAX**

**US Serial Number:** 77792959

**Application Filing Date:** Jul. 30, 2009

**US Registration Number:** 3851316

**Registration Date:** Sep. 21, 2010

**Register:** Principal

**Mark Type:** Trademark

**Status:** A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

**Status Date:** Oct. 23, 2012

**Publication Date:** Dec. 29, 2009

**Notice of Allowance Date:** Mar. 23, 2010

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### Mark Information

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**Mark Literal Elements:** AERIAL MAX

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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### Goods and Services

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**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Tires, off-the road tires

**International Class:** 012 - Primary Class      **U.S Class:** 019, 021, 023, 031, 035, 044  
**Class Status:** ACTIVE  
**Basis:** 1(a)  
**First Use:** Apr. 13, 2010      **Use in Commerce:** Apr. 13, 2010

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### Basis Information (Case Level)

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<b>Filed Use:</b>	No	<b>Currently Use:</b>	Yes	<b>Amended Use:</b>	No
<b>Filed ITU:</b>	Yes	<b>Currently ITU:</b>	No	<b>Amended ITU:</b>	No
<b>Filed 44D:</b>	No	<b>Currently 44D:</b>	No	<b>Amended 44D:</b>	No
<b>Filed 44E:</b>	No	<b>Currently 44E:</b>	No	<b>Amended 44E:</b>	No
<b>Filed 66A:</b>	No	<b>Currently 66A:</b>	No		
<b>Filed No Basis:</b>	No	<b>Currently No Basis:</b>	No		

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### Current Owner(s) Information

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**Owner Name:** MAINE INDUSTRIAL TIRE LLC  
107 Audubon Road  
**Owner Address:** Wakefield, MASSACHUSETTS 01886  
UNITED STATES

**Legal Entity Type:** LIMITED LIABILITY COMPANY      **State or Country Where Organized:** DELAWARE

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### Attorney/Correspondence Information

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#### Attorney of Record

**Attorney Name:** Deborah L. Benson

#### Correspondent

**Correspondent Name/Address:** MAINE INDUSTRIAL TIRE LLC  
107 AUDUBON ROAD  
WAKEFIELD, MASSACHUSETTS 01886  
UNITED STATES

**Phone:** 617-345-9000

**Fax:** 617-345-9020

**Correspondent e-mail:** [tmdocket@haslaw.com](mailto:tmdocket@haslaw.com)

**Correspondent e-mail Authorized:** No



## Domestic Representative - Not Found

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### Prosecution History

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<b>Date</b>	<b>Description</b>	<b>Proceeding Number</b>
Oct. 23, 2012	CANCELLATION INSTITUTED NO. 999999	56352
Sep. 21, 2010	REGISTERED-PRINCIPAL REGISTER	
Aug. 19, 2010	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Aug. 18, 2010	LAW OFFICE REGISTRATION REVIEW COMPLETED	76538
Aug. 18, 2010	ASSIGNED TO LIE	76538
Aug. 02, 2010	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jul. 20, 2010	STATEMENT OF USE PROCESSING COMPLETE	76874
Jun. 24, 2010	USE AMENDMENT FILED	76874
Jul. 20, 2010	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76874
Jun. 24, 2010	TEAS STATEMENT OF USE RECEIVED	
Mar. 23, 2010	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 10, 2010	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 29, 2009	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 29, 2009	PUBLISHED FOR OPPOSITION	
Nov. 23, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	77075
Nov. 23, 2009	ASSIGNED TO LIE	77075
Nov. 05, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 03, 2009	ASSIGNED TO EXAMINER	85331
Aug. 03, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 03, 2009	NEW APPLICATION ENTERED IN TRAM	

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### TM Staff and Location Information

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TM Staff Information - None

**File Location**

**Current Location:** PUBLICATION AND ISSUE SECTION      **Date in Location:** Aug. 18, 2010

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**Assignment Abstract of Title Information**

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**Summary**

**Total Assignments:** 2      **Registrant:** MAINE INDUSTRIAL TIRE LLC

**Assignment 1 of 2**

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**Conveyance:** ASSIGNS THE ENTIRE INTEREST  
**Reel/Frame:** [4142/0404](#)      **Pages:** 5  
**Date Recorded:** Feb. 02, 2010  
**Supporting Documents:** [assignment-tm-4142-0404.pdf](#)

**Assignor**

**Name:** [GPX INTERNATIONAL TIRE CORPORATION](#)      **Execution Date:** Jan. 12, 2010  
**Legal Entity Type:** CORPORATION      **State or Country Where Organized:** MASSACHUSETTS

**Assignee**

**Name:** [MAINE INDUSTRIAL TIRE LLC](#)  
**Legal Entity Type:** LIMITED LIABILITY COMPANY      **State or Country Where Organized:** DELAWARE  
**Address:** 730 EASTERN AVENUE  
MALDEN, MASSACHUSETTS 02148

**Correspondent**

**Correspondent Name:** DEBORAH L. BENSON  
**Correspondent Address:** 28 STATE STREET  
HINCKLEY, ALLEN & SNYDER LLP  
BOSTON, MA 02109-1775

**Domestic Representative - Not Found**

**Assignment 2 of 2**

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**Conveyance:** SECURITY INTEREST

Reel/Frame: [4146/0925](#)

Pages: 13

Date Recorded: Feb. 09, 2010

Supporting Documents: [assignment-tm-4146-0925.pdf](#)

### Assignor

Name: [MAINE INDUSTRIAL TIRE LLC](#) Execution Date: Jan. 12, 2010

Legal Entity Type: LIMITED LIABILITY COMPANY State or Country Where Organized: DELAWARE

### Assignee

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)

Legal Entity Type: NATIONAL ASSOCIATION State or Country Where Organized: No Place Where Organized Found

Address: 300 COMMERCIAL STREET  
WELLS FARGO BUSINESS CREDIT  
BOSTON, MASSACHUSETTS 02109

### Correspondent

Correspondent Name: RENEE INOMATA

Correspondent Address: 125 SUMMER STREET  
BURNS & LEVINSON LLP  
BOSTON, MA 02110

**Domestic Representative - Not Found**