ESTTA Tracking number: **ESTTA508731**

Filing date: **12/03/2012**

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	TANYA MARIE CURCIO HINCKLEY ALLEN & SNYDER LLP 28 STATE STREET BOSTON, MA 02109 UNITED STATES tcurcio@haslaw.com, tmdocket@haslaw.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Tanya Marie Curcio
Filer's e-mail	tcurcio@haslaw.com
Signature	/tmc/
Date	12/03/2012
Attachments	Maine Ind. Tire- 12b5 Motion to Dismiss (Can. 92056352).PDF (5 pages)(26604 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.[1]

[1] 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 comprise 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: December 3, 2012

CERTIFICATE OF SERVICE

I, Tanya Marie Curcio, hereby certify that on this 3th day of December 2012, I served a true and accurate copy of the foregoing Motion to Dismiss, via Federal Express Overnight Courier, Postage Prepaid upon Respondent's attorney, Todd Deveau, Thomas Horstemeyer LLP, 400 Interstate North Parkway Se, Suite 1500, Atlanta, GA 30339.

/Tanya Marie Curcio/
Tanya Marie Curcio

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

Mark Information

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

Goods and Services

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

Basis Information (Case Level)

Filed Use:	No	**Currently Use:**	Yes	**Amended Use:**	No
Filed ITU:	Yes	**Currently ITU:**	No	**Amended ITU:**	No
Filed 44D:	No	**Currently 44D:**	No	**Amended 44D:**	No
Filed 44E:	No	**Currently 44E:**	No	**Amended 44E:**	No
Filed 66A:	No	**Currently 66A:**	No		
Filed No Basis:	No	**Currently No Basis:**	No		

Current Owner(s) Information

Owner Name:	MAINE INDUSTRIAL TIRE LLC		
Owner Address:	107 Audubon Road Wakefield, MASSACHUSETTS 01886 UNITED STATES		
Legal Entity Type:	LIMITED LIABILITY COMPANY	**State or Country Where Organized:**	DELAWARE

Attorney/Correspondence Information

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	**Correspondent e-mail Authorized:**	No

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
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	

TM Staff and Location Information

TM Staff Information - None

File Location

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

Assignment Abstract of Title Information

Summary

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

Assignment 1 of 2

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

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