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

Proceeding	92056635
Party	Plaintiff Richemont International S.A.
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Submission	Opposition/Response to Motion
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Date	04/08/2013
Attachments	Petitioner's Opp to Mtn to Dismiss.PDF (15 pages)(422209 bytes)

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

In the Matter of Registration 3,514,885
Registrant: Fin.Ing. S.r.L.
Mark: **REPORTER**
App. Serial No.: 77235011
Reg. Date: October 14, 2008

RICHEMONT INTERNATIONAL S.A.,	:	X	
	:		
	:		
Petitioner,	:		Cancellation No. 92056635
	:		
v.	:		
	:		
FIN.ING. S.R.L.,	:		
	:		
Respondent.	:		
	:		
	:		
	:	X	

PETITIONER'S OPPOSITION TO MOTION TO DISMISS

Petitioner, Richemont International S.A. (hereinafter "Petitioner" or "Richemont") respectfully submits this memorandum in opposition to the Motion to Dismiss filed by Respondent, Fin.Ing. S.r.l. (hereinafter "Respondent" or "Fin.Ing."). Specifically, the Motion to Dismiss should be denied because Richemont properly pleaded a claim for abandonment based on Respondent's lack of use with an intent not to resume use of the REPORTER mark in commerce in connection with the goods covered by U.S. Registration No. 3,514,885. Alternatively, should the Board find that Richemont has not effectively pleaded a claim for abandonment and to expedite this matter, Richemont respectfully requests that it be granted leave to amend its Petition for Cancellation which will in effect moot the motion; to that end, Richemont submits as Exhibit A attached hereto an Amended Petition For Cancellation.

STATEMENT OF FACTS

On January 4, 2013, Richemont filed United States Trademark Application Serial No. 85/815,409 for REPORTER “watches and chronometers” in International Class 14.

Contemporaneously with that filing, Richemont filed a Petition For Cancellation of U.S. Reg. No. 3,514,885 which issued on October 14, 2008 covering “clocks, watches, jewelry and imitation jewelry” in International Class 14 on the grounds that Respondent was not using the mark and abandoned the mark through non-use and an intent not to resume use of the mark in connection with the goods.

By the Board’s initial scheduling order, Respondent’s term to answer or otherwise respond to the Petition for Cancellation was set to expire on February 17, 2013.

Respondent moved to extend its time to answer or otherwise respond by 30 days, i.e., up to and including March 19, 2013. Richemont opposed that motion and only conceded to extend Respondent’s term to answer, not to serve a dispositive motion. Given Richemont’s concession, the Board did not consider the motion on the merits and apparently granted Respondent’s an additional thirty (30) days to answer the Petition for Cancellation.

On March 19, 2013, Respondent filed and served an Answer with affirmative defenses, as well as the instant Motion To Dismiss alleging that Richemont purportedly failed to state a claim upon which relief may be granted.

On March 26, 2013, the United States Patent and Trademark Office (“PTO”) issued an Office Action preliminarily refusing to register Richemont’s U.S. Application for REPORTER, based in part, on Respondent’s contested registration.

ARGUMENT

I. THE LEGAL STANDARD

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of the complaint. *Johnson & Johnson and Roc International S.A.R.L v. Obschestvo s Ogranitchennoy*, 104 U.S.P.Q.2d 2037 (T.T.A.B. 2012) (motion to dismiss abandonment claim denied) To survive a motion to dismiss, a petitioner need only allege sufficient factual matter as would, if proved, establish that 1) petitioner has standing to maintain the proceeding, and 2) a valid ground exists for cancelling the mark, in whole or in part, as may be applicable. *Id.* (citing *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982)); *see also, Saddlesprings, Inc. v. Mad Croc Brands Inc.*, 104 U.S.P.Q.2d 1948, *2 (T.T.A.B. 2012) (motion to dismiss denied).

A petition to cancel must simply include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding -- *see* TBMP § 303.03 and TBMP § 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation. *See* TBMP § 309.03(a)(2) (3d ed. rev. 2012). A pleading should include enough detail to give the defendant fair notice of the basis for each claim. The elements of each claim should be stated simply, concisely, and directly, and taken together “state a claim to relief that is plausible on its face.” *Id.* (citing TBMP § 503.02 (3d ed. rev. 2012)); *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (T.T.A.B. 2007) (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice). That said, the pleading must be construed liberally by the Board, in the light most favorable to Petitioner. *See Miller Brewing Company v. Anheuser-Busch Inc.*, 27 U.S.P.Q.2d 1711 (T.T.A.B. 1993). Additionally, all factual

allegations are also presumed to be true and all factual inferences drawn in favor of the Petitioner. *See e.g., Erickson v. Pardus*, 551 U.S. 89, 93-94 (2007).

Richemont has met its burden. Indeed, little more can be asserted factually except that Respondent is not making use of the mark and it has no intent to use the mark in connection with the goods covered by the registration. Respondent, interestingly enough, never once in its papers even remotely contests the basic fact that it is not making use of REPORTER in the United States in connection with any of the goods set forth in the registration at issue.

II. RESPONDENT'S MOTION TO DISMISS SHOULD BE DENIED AS RICHEMONT HAS PROPERLY PLEADED ABANDONMENT

A. Richemont's Has Standing

Respondent does not apparently contend that Richemont does not have standing. Still, to demonstrate standing, Richemont must allege facts in the Petition For Cancellation which, if ultimately proven, would establish that it has a real interest in the cancellation proceeding. *See Saddlesprings, Inc.*, 104 U.S.P.Q.2d at *2. Richemont's standing is based on its pending application to register the mark REPORTER, its *bona fide* intent to use the mark in commerce, and that Respondent's prior registration poses a threat to its planned use. The following allegations in the Petition for Cancellation firmly establish Richemont's standing:

3. Petitioner has a bona fide interest in using and registering the mark REPORTER on or in connection with its products, including, but not limited to watches and chronometers. On January 4, 2013, Petitioner filed United States Trademark Application Serial No. 85815409 to register the mark REPORTER in connection with "watches and chronometers" in International Class 14.

4. On information and belief, on July 20, 2007, Respondent, Fin.Ing. S.r.l., a societa a responsabilita limitata legally organized under the laws of Italy, having an address of Corso di Porta Romana, 3 20122 Milano Italy, filed United States Trademark Application Serial Number 77-235,011 based on Italian Registration No. 00867892 and a bona fide intention to use the mark in commerce on or in connection with "clocks, watches, jewelry and imitation jewelry" in International Class 14. That application matured to United States Trademark Registration No. 3,514,885, issued to Respondent on October 14, 2008.

6. On information and belief, Petitioner and Respondent are apparently competitors in the field of time pieces such as watches. Respondent, by its

purported registration for REPORTER which is the subject of this proceeding, could attempt to prevent Petitioner from using the mark based upon the registration.

7. Continued registration by Respondent of the mark REPORTER under United States Registration No. No. 3,514,885 in connection with “clocks, watches, jewelry and imitation jewelry” in International Class 14 is damaging and will continue to cause damage to Petitioner. Unless Reg. No. 3,514,885 is cancelled, Registrant will be entitled to statutory protections and presumptions to which it is not entitled. Further, Petitioner’s own right to register and enforce rights in and to the mark REPORTER may be impacted by a registration that is no longer valid. Thus, the registration at issue comprises an improper obstacle to Petitioner’s right to register and enforce the REPORTER mark.

8. By virtue of the foregoing allegations, Petitioner would be, and is being damaged within the meaning of 15 U.S.C. § 1064 as a result of the continued registration of Respondent’s alleged mark REPORTER in International Class 14.

Richemont’s real interest is now confirmed as a result of the PTO’s recent Office Action preliminarily barring its application for REPORTER. *See Saddlesprings, Inc.*, 104 U.S.P.Q.2d 1948 at *2. Richemont has properly established a real interest in this cancellation action and damage such that it has standing to bring its claim for abandonment.

B. Richemont Has Effectively Pleaded An Abandonment Claim

Similarly, Richemont’s claim of abandonment is sufficiently plead. “A mark shall be deemed to be ‘abandoned’...[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” *See* 15 U.S.C. § 1127 (West 2006). In addition to the allegations above, Richemont has also asserted the following allegations:

5. On information and belief, Respondent’s alleged mark REPORTER is not in use in commerce regulated by Congress on or in connection with the some or all of the goods covered by Registration No. 3,514,885, Respondent has ceased use of such mark in connection with such goods, and Respondent has no intent to resume such use. On information and belief, Respondent has abandoned any and all trademark rights in and all claims or alleged rights to maintain a registration for said mark in connection with such goods in the United States, and has forfeited all claims of Federal trademark rights in and to said mark in connection with such goods afforded to it under the United States Trademark (Lanham) Act, 15 U.S.C. § 1051 et. seq. As such, Reg. No.

3,514,885 is subject to cancellation on the grounds of abandonment or nonuse for the aforementioned products.

Richemont alleges abandonment of the mark as to particular goods through nonuse with no intent to resume use. *See DAK Indust., Inc. v. Daiichi Kosho Co.*, 35 U.S.P.Q.2d 1434, 1438 (T.T.A.B. 1995); *see also Otto International Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1863 (T.T.A.B. 2007) (pleading of abandonment must set forth prima facie case by pleading either at least three consecutive years of non-use, or facts that show period of non-use less than three years coupled with pleading of defendant's intent not to resume use). Richemont is not obligated to assert that Respondent's mark has not been in use for three years as perhaps suggested by Respondent's Motion to Dismiss. Claiming non-use with an intent not to resume use is more than proper and the factual basis is quite simply that the alleged REPORTER mark, which is the subject of the registration at issue, is not in use in commerce regulated by commerce. Further, a review of Respondent's web sites which are in Italian (www.inghirami.com and www.inghirami.com/pitti-immagine-uomo-2013/) did not reveal any use of the mark REPORTER in the United States in connection with clocks, watches or jewelry. Nor was there any suggestion that Respondent has any outlets or business in the United States. Respondent has not presented any objective proof to the contrary. With that, Richemont has asserted that Respondent has no intent to resume use.

Further, in the context of the Petition for Cancellation and contrary to Respondent's allegations, it is clear "such goods", which are not in use, references all the goods which are the subject of the registration, that is, "clocks, watches, jewelry and imitation jewelry". Richemont's assertions of damage also confirm this by reciting all of the goods in the registration. Insofar as there is reference to "some" goods, that can reasonably be understood to refer to the "clocks" and "watches" which are also the subject of Richemont's pending

application. Again, this is confirmed by the claim that the continued registration would cause damage to Richemont's and its application to register watches and chronometers. This is not a matter where a registration include numerous articles that it is difficult to ascertain what products are at issue. Respondent knows as much but merely burdens the Board by placing form over substance and common sense.

III. THE LAW DISFAVORS DISMISSAL

It is widely recognized that “the motion to dismiss for failure to state a claim is viewed with disfavor and is rarely granted.” *Kaiser Aluminum & Chem. Sales, Inc. v. Avondale Shipyards, Inc.*, 677 F.2d 1045, 1050 (5th Cir. 1982); *see also Scotch Whisky Ass'n. v. U.S. Distilled Products Co.*, 952 F.2d 1317 (Fed Cir. 1991) (“complaint should not be dismissed for failure to state a claim unless it appears *beyond doubt* that the plaintiff [petitioner] can prove no set of facts in support of his claim which would entitle him to relief” (quoting *Conley v. Gibson*, 33 U.S. 41 (1957) (emphasis in original))). Indeed, ““a court’s discretion to dismiss a pleading without affording leave to amend is restricted by Rule 15(a), which directs that leave to amend shall be freely given when justice requires.”” *Frith v. Guardian Life Ins. Co. of America*, 9 F. Supp. 2d 734, 743 (S.D. Tex. 1998) (quoting 2 MOORE’S FEDERAL PRACTICE § 9.03[4] (3d ed. 1997)); *see also Buffett v. Chi-Chi’S, Inc.*, 226 U.S.P.Q. 428, 430-31 (T.T.A.B. 1985) (“The Board has granted leave to amend pleadings with considerable liberality in the past where the circumstances are such that the other party is not prejudiced.”). Therefore, should the Board find that Richemont has failed to state a claim upon which relief may be sought, Richemont alternatively requests that pursuant to Rule 15 of the Fed. R. Civ. Pro., it be granted leave to amend its Petition for Cancellation. In that regard and alternatively, to moot the Motion to Dismiss, Richemont submits herewith as Exhibit A an Amended Petition For Cancellation.

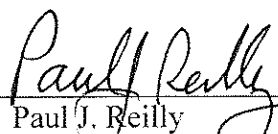
CONCLUSION

Contrary to Respondent's demand that the Petition For Cancellation be dismissed, Richemont has fully complied with the Federal Rules of Civil Procedure, set forth clear, plain and sufficient statements of fact to support all of the elements necessary to establish standing and abandonment of the REPORTER mark in the United States by Respondent thereby, giving it adequate, fair notice of the claim. For the reasons discussed herein, Richemont respectfully requests that the Board deny in its entirety the Motion To Dismiss or alternatively, allow Richemont to amend its Petition For Cancellation and provide Respondent ten (10) days to serve an answer so this matter may proceed on the merits.

Respectfully submitted,

BAKER BOTTS LLP

Dated: April 8, 2013

By: 
Paul J. Reilly
Lauren B. Emerson
30 Rockefeller Plaza
New York, NY 10112-0228
(212) 408-2634

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of April, 2013 a copy of the foregoing, PETITIONER'S OPPOSITION TO THE MOTION TO DISMISS, was served on the Respondent's United States counsel of record via overnight courier, postage prepaid, to the following address:

John Zaccaria, Esq.
Notaro & Michalos P.C.
100 Dutch Hill Road
Ste. 110
Orangeburg, New York 10962-2107
United States

Dated: April 8, 2013

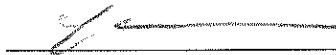
By: 
Lauren B. Emerson

EXHIBIT A

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

In the Matter of Registration 3,514,885
Registrant: Fin.Ing. S.r.L.
Mark: **REPORTER**
App. Serial No.: 77235011
Reg. Date: October 14, 2008

RICHEMONT INTERNATIONAL S.A.,	x		
	:		
	:		
Petitioner,	:	Cancellation No. 92056635	
	:		
v.	:		
	:		
FIN.ING. S.R.L.,	:		
	:		
Respondent.	:		
	:		
	x		

AMENDED PETITION FOR CANCELLATION

Petitioner, Richemont International S.A., a *société anonyme* (sa) legally organized under the laws of Switzerland, having an address of Route des Biches 10 Villars-sur-Glane, Switzerland (hereinafter “Petitioner”) believes that it will be damaged by Registration No. 3,514,885 for the mark REPORTER for “clocks, watches, jewelry and imitation jewelry” in International Class 14, purportedly owned by Respondent, Fin.Ing. S.r.l., a *societa a responsabilita limitata* legally organized under the laws of Italy, having an address of Corso di Porta Romana, 3 20122 Milano Italy (hereinafter “Respondent”) and hereby petitions to cancel such registration.

As grounds for cancellation, Petitioner alleges the following:

1. Petitioner, Richemont and its affiliate companies, one of the world’s leading luxury goods groups, produces some of the world’s finest brands of watches, jewelry, writing

instruments, apparel, handbags and other goods. Among its many holdings, Richemont is the owner of all right, title, and interest in and to certain of the world's most renowned and well-known luxury brands including, inter alia, IWC, JAEGER LECOULTRE, and VACHERON CONSTANTIN.

2. Richemont and the aforementioned brands, by their respective predecessors-in-interest, have been engaged in the manufacture and sale in interstate, intrastate, and foreign commerce, of high-quality watches, watch movements, watch bracelets, jewelry, and other luxury products.

3. Petitioner has a *bona fide* interest in using and registering the mark REPORTER on or in connection with its products, including, but not limited to watches and chronometers. On January 4, 2013, Petitioner filed United States Trademark Application Serial No. 85815409 to register the mark REPORTER in connection with "watches and chronometers" in International Class 14.

4. On information and belief, on July 20, 2007, Respondent, Fin.Ing. S.r.l., a *societa a responsabilita limitata* legally organized under the laws of Italy, having an address of Corso di Porta Romana, 3 20122 Milano Italy, filed United States Trademark Application Serial Number 77-235,011 based on Italian Registration No. 00867892 and a *bona fide* intention to use the mark in commerce on or in connection with "clocks, watches, jewelry and imitation jewelry" in International Class 14. That application matured to United States Trademark Registration No. 3,514,885, issued to Respondent on October 14, 2008.

5. On information and belief, Respondent does not sell any of the goods described in U.S. Registration No. 3,514,885 in the United States under the mark REPORTER and there are no online web sites of Respondent that apparently target the United States. For example, on

information and belief, Respondent's web sites at www.inghirami.com and www.inghirami.com/pitti-immagine-uomo-2013, which are in Italian, do not apparently reveal any use of the mark REPORTER in the United States connection with clocks, watches or jewelry; nor was there any overt indication that Respondent has any outlets or business in the United States.

6. On information and believe, Respondent is not using and has ceased using the mark REPORTER in U.S. Commerce in connection with all the goods in the registration at issue, namely, clocks, watches, jewelry and imitation jewelry, and has no intent to resume such use. Alternatively, on information and believe, Respondent is not using and has ceased using the mark REPORTER in U.S. Commerce in connection with clocks and watches, and has no intent to resume such use.

7. On information and belief, Respondent has ceased use of the mark REPORTER in connection with all of the goods covered by Registration No. 3,514,885, or alternatively, at least clocks and watches, and Respondent has no intent to resume such use. On information and belief, Respondent has abandoned any and all trademark rights in and all claims or alleged rights to maintain a registration for said mark in connection with all the goods in the registration at issue, namely, clocks, watches, jewelry and imitation jewelry, or at the very least, clocks and watches, in the United States, and has forfeited all claims of Federal trademark rights in and to said mark in connection with such goods afforded to it under the United States Trademark (Lanham) Act, 15 U.S.C. § 1051 et. seq. As such, Reg. No. 3,514,885 is subject to cancellation on the grounds of abandonment or nonuse for the aforementioned products.

8. On information and belief, Petitioner and Respondent are apparently competitors in the field of time pieces such as watches. Respondent, by its purported registration for

REPORTER which is the subject of this proceeding, could attempt to prevent Petitioner from using the mark based upon the registration.

9. Continued registration by Respondent of the mark REPORTER under United States Registration No. No. 3,514,885 in connection with “clocks, watches, jewelry and imitation jewelry” in International Class 14 is damaging and will continue to cause damage to Petitioner. Unless Reg. No. 3,514,885 is cancelled, Registrant will be entitled to statutory protections and presumptions to which it is not entitled. Further, Petitioner’s own right to register and enforce rights in and to the mark REPORTER may be impacted by a registration that is no longer valid. Thus, the registration at issue comprises an improper obstacle to Petitioner’s right to register and enforce the REPORTER mark.

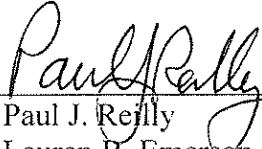
10. By virtue of the foregoing allegations, Petitioner would be, and is being damaged within the meaning of 15 U.S.C. § 1064 as a result of the continued registration of Respondent’s alleged mark REPORTER in International Class 14.

WHEREFORE, Petitioner prays that this petition for cancellation be sustained, and that Registration No. 3,514,885 be cancelled in its entirety, or in the alternative, for clocks and watches, at a minimum.

Respectfully submitted,

BAKER BOTTS LLP

Dated: April 8, 2013

By: 
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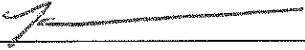
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of April, 2013 a copy of the foregoing, AMENDED PETITION FOR CANCELLATION, was served on Respondent's United States counsel of record via overnight courier, postage prepaid, to the following address:

John Zaccaria, Esq.
Notaro & Michalos P.C.
100 Dutch Hill Road
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Orangeburg, New York 10962-2107
United States

Dated: April 8, 2013

By: 

Lauren B. Emerson