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

|                        |  |
|------------------------|--|
| Proceeding             | 92056635   |
| Party                  | Defendant<br>FIN.ING. S.r.l.   |
| Correspondence Address | ANGELO NOTARO<br>NOTARO MICHALOS & ZACCARIA PC<br>100 DUTCH HILL ROAD, SUITE 240<br>ORANGEBURG, NY 10962<br>UNITED STATES<br>jzaccaria@notaromichalos.com, anotaro@notaromichalos.com,<br>bcorsello@notaromichalos.com |
| Submission             | Motion to Dismiss - Rule 12(b)   |
| Filer's Name           | John Zaccaria  |
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| Signature              | /J154-047JZ/   |
| Date                   | 03/19/2013   |
| Attachments            | J154-047-Motion Dismiss.pdf ( 7 pages )(447564 bytes )   |

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

In the Matter of Registration No. 3,514,885  
Registrant: Fin.Ing. S.r.L.  
Mark: REPORTER  
App. Serial No.: 77/235,011  
Reg. Date: October 14, 2008

|                               |   |                           |
|-------------------------------|---|---------------------------|
| -----X                        | : |                           |
|                               | : |                           |
| RICHEMONT INTERNATIONAL S.A., | : |                           |
|                               | : |                           |
| Petitioner,                   | : |                           |
|                               | : | Cancellation No. 92056635 |
| v.                            | : |                           |
|                               | : |                           |
| FIN.ING. S.r.l.,              | : |                           |
|                               | : |                           |
| Respondent.                   | : |                           |
| -----X                        |   |                           |

**MOTION TO DISMISS**

Respondent FIN.ING. S.r.l. ("Respondent"), by and through its counsel, pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, moves the Trademark Trial and Appeal Board ("Board") for an Order dismissing the Petition for Cancellation on the grounds that the Petition fails to state a claim for abandonment.

**STATEMENT OF FACTS**

Respondent owns Registration No. 3,514,885 for the trademark REPORTER ("the '885 Registration") registered for "clocks, watches, jewelry and imitation jewelry" ("the Registered Goods").

Petitioner filed the Petition on January 4, 2013.<sup>1</sup>

The Petition purportedly asserts abandonment as the basis for cancellation of the '885 Registration. The Petition, in pertinent part, provides:

5. On information and belief, Respondent's alleged mark<sup>2</sup> REPORTER is not in use in commerce regulated by Congress on or in connection with the some [sic] 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.

## ARGUMENT

### **A. Rule 12(b)(6) Pleading Standard**

Under the Supreme Court's pleading standards, which are applied by the Board, see TBMP § 309.03(a)(2) n.4, to survive a motion brought pursuant to Rule 12(b)(6) a pleading must allege "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). "A claim has facial plausibility," the Supreme Court has explained,

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<sup>1</sup> Respondent's Answer and Affirmative Defenses is filed concurrently herewith.

<sup>2</sup> Respondent's mark REPORTER is not "alleged". Rather, Respondent's mark is registered and entitled to a presumption of validity.

when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. The plausibility standard is not akin to a “probability requirement,” but it asks for more than a sheer possibility that a defendant has acted unlawfully. Where a complaint pleads facts that are “merely consistent with” a defendant’s liability, it “stops short of the line between possibility and plausibility of entitlement to relief.”

*Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Twombly*, 550 U.S. at 556–57). “[A] plaintiff’s obligation to provide the grounds of his entitlement to relief requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.” *Twombly*, 550 U.S. at 555 (internal quotation marks omitted). “In keeping with these principles,” the Supreme Court has stated,

[A] court considering a motion to dismiss can choose to begin by identifying pleadings that, because they are no more than conclusions, are not entitled to the assumption of truth. While legal conclusions can provide the framework of a complaint, **they must be supported by factual allegations**. When there are well-pleaded factual allegations, a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief.

*Iqbal*, 556 U.S. at 679 (emphasis added). The assumption that factual allegations are true is “inapplicable to legal conclusions,” *Iqbal*, 556 U.S. at 678, which, a complaint’s “labels and conclusions,” *Twombly*, 550 U.S. at 555, are disregarded. Nor should a court “accept [as] true a legal conclusion couched as a factual allegation.” *Id.* at 555.

## **B. The Petition Fails to State a Claim for Abandonment**

Trademark Act Section 45, 15 U.S.C. § 1127, defines “abandonment” of a trademark, in pertinent part, as:

When 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. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

A petition asserting abandonment must allege facts establishing a prima facie case by pleading either three consecutive years or more of discontinued use, or discontinued use coupled with an intent not to resume use. *See, Otto Int'l, Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1863 (2007) (dismissing claim of abandonment) ("In order to set forth a cause of action to cancel the registration of a mark which has been abandoned, plaintiff must allege ultimate facts pertaining to the alleged abandonment").

Petitioner's factual allegation in support of its abandonment claim is limited to a single sentence, in Paragraph 5 of the Petition, based on information and belief, namely:

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.

The remainder of Paragraph 5 is mere legal conclusions.

The Petition fails to allege the required factual content under the pleading standards of *Twombly* and *Iqbal* in at least the following respects:

1. The Petition fails to identify the goods as to which the mark has allegedly been abandoned. The Petition merely asserts that Respondent's REPORTER mark "is not in use in commerce . . . on or in connection with the some or all of the goods," without identifying which goods are in question. (Petition ¶ 5).

Petitioner fails to state any facts or circumstances that plausibly demonstrate that Respondent has either discontinued use and/or intends not to resume use of the mark REPORTER on or in connection with “some or all” of the Registered Goods.

Simply stated, Petitioner has demonstrated no information or belief for the conclusory allegation set forth.

2. The Petition does not include any allegation of the length of time during which the REPORTER mark has allegedly not been used by Respondent in connection with the Registered Goods. *See, Otto Int'l, Inc.*, 118 U.S.P.Q.2d at 1863 (“The allegation that respondent has ‘abandoned use’ makes no claim that respondent has failed to use its mark for a period greater than 3 years.”) Therefore, the Petition fails to provide any fair notice as to whether Petitioner alleges a claim of prima facie abandonment based on at least three (3) consecutive years of non-use. *See Id.* (to give fair notice to the registrant, the petitioner's pleading of abandonment must set forth the theory of abandonment petitioner is relying on, *i.e.*, discontinued use without intent to resume use, or the statutory presumption of abandonment arising from three consecutive years of non-use).

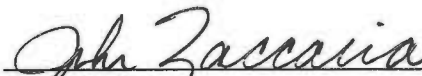
3. With respect to intent, the Petition merely alleges in a conclusory fashion, “on information and belief,” that “Respondent has no intent to resume such use.” (Petition ¶ 5.) The Petition does not factually allege any circumstances that provide facial plausibility supporting the conclusion that Respondent ceased use and does not intend to resume use of the REPORTER trademark. Petitioner’s legal conclusions are not supported by factual allegations and, therefore, do not meet the *Iqbal* and *Twombly* pleading standards.

**CONCLUSION**

For the forgoing reasons Respondent's motion to dismiss should be granted.

Dated: March 19, 2013

Respectfully submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that a complete copy of the foregoing MOTION TO DISMISS has been served on Paul J. Reilly, Esq. and Lauren B. Emerson, Esq., Attorneys for Petitioner, by mailing said motion on March 19, 2013 via First Class Mail, postage prepaid, to:

Paul J. Reilly, Esq.  
Lauren B. Emerson, Esq.  
Baker Botts LLP  
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John Zaccaria