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

Proceeding	92063647
Party	Defendant K & N Distributors
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Attachments	101216 Opposition to Motion to Amend.PDF(677114 bytes)

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

TOPICLEAR, INC. Petitioner, v. K&N DISTRIBUTORS, INC. Respondent	:	Cancellation No. 92062923 U.S. Reg. No. 4,818,656 Mark: TROPIC CLAIR PLUS Registered: September 22, 2015

RESPONDENT'S OPPOSITION TO MOTION TO AMEND PETITION FOR CANCELLATION

Pursuant to Fed. R. Civ. P. 15, Trademark Rule 2.115, and TBMP § 507.01, Respondent K&N Distributors, Inc. hereby opposes Petitioner Topiclear, Inc.'s Motion to Amend Petition for Cancellation (Dkt. 12). As explained below, Petitioner's Motion is both procedurally and substantively defective, and should be denied.

First, Respondent's Motion is procedurally defective insofar as it does not include a signed copy of the proposed amended pleading as required by TBMP § 507.01. Rather, it merely cites a sole paragraph Petitioner wishes to add to its Petition for Cancellation, not a document that would serve as the operative pleading in this matter.

Second, Petitioner's addition of this paragraph does not satisfy the refined pleading standards set forth by the United States Supreme Court in in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007) and *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). While well-pleaded facts of a complaint are to be accepted as true, legal conclusions are not "entitled to the assumption of truth." *Iqbal,* 556 U.S. at 679 (citation omitted). Further, a court is not to strain to find inferences favorable to the plaintiff and is not to accept conclusory allegations, unwarranted

deductions, or legal conclusions couched as factual allegations. *Id.* (legal conclusions are not "entitled to the assumption of truth"). A plaintiff must plead "enough facts to state a claim to relief that is plausible on its face." *Twombly*, 550 U.S. at 570. "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Iqbal*, 556 U.S. at 678. Petitioner's proposed amendment does not satisfy this standard.

Even if Petitioner's sole paragraph it recites in its motion did constitute an appropriate Amended Petition for Cancellation, the Board should nevertheless deny motion for leave to amend, because the claim Petitioner seeks to add is legally insufficient and would serve no useful purpose. The claim Petitioner seeks to add is that Respondent is violating a Federal Regulation related to packaging, which is a legal issue that is not relevant to the sole issue the Board is entitled to determine, namely, the registrability of a mark. As the Board has repeatedly noted when parties have raised such claim,

> [T]he better practice in trying to determine whether use of a mark is lawful under one or more of the myriad regulatory acts is to hold a use in commerce unlawful only when the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regulating the sale of a party's goods.

General Mills, Inc. v. Health Valley Foods, 24 USPQ2d (BNA) 1270 (TTAB 1992), *citing Santinine Societa v. P.A.B. Produits*, 209 USPQ 958 (TTAB 1981).

Here, Petitioner has not and cannot satisfy either of these standards that would be necessary to assert this claim against Respondent. There has not been an adjudication of any wrongdoing by Respondent. Petitioner's allegation that Respondent has violated a regulation is

not sufficient to demonstrate a per se violation of the statute. Finally, as the Board has repeatedly recognized, it is not the appropriate forum to adjudicate such claims:

> Due to a proliferation of federal regulatory acts in recent years, there is now an almost endless number of such acts which the Board might in the future be compelled to interpret in order to determine whether a particular use in commerce is lawful. Inasmuch as we have little or no familiarity with most of these acts, there is a serious question as to the advisability of our attempting to adjudicate whether a party's use in commerce is in compliance with the particular regulatory act or acts which may be applicable thereto.

Santinine Societa, 209 USPQ at 964; *see also id.* at 967 ("There must be some nexus between the use of the mark and the alleged violation before it can be said that the unlawfulness of the sale or shipment has resulted in the invalidity of an application or registration."); *General Mills*, 24 USPQ2d at 1274 ("while some unlawful uses are such a nature (e.g., use of a mark in connection with an illegal drug) that it would be unthinkable to register a mark, other uses should not result in…cancellation of a registration [] because of some purely collateral defect").

As in *Santinine Societa* and *General Mills*, the claim Petitioner seeks to assert relates solely to a "purely collateral defect" that, even if proven, does not rise to the level of illegality necessary to refuse registration. As such, the claim Petitioner seeks to add is futile, would serve no useful purpose, and its motion to amend should be denied. *See* TBMP §507.02

Dated: October 12 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing is being served via U.S. Mail, with a courtesy copy via email, on the following, on this 10th day of October, 2016.

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