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

Proceeding	92065444
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Ultra PRO International, LLC,

Petitioner,

v.

Toastmasters International,

Registrant.

Cancellation No. 92/065,444  
U.S. Reg. No. 4,804,295  
Issue Date: September 1, 2015  
Mark: TABLE TOPICS

**PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO FILE  
SECOND AMENDED PETITION FOR CANCELLATION**

Petitioner's reply brief is aimed at supporting its Motion for Leave to File Its Second Amended Petition for Cancellation. Petitioner's bases are explained below.

**I. Leave to amend must be freely given**

Under Fed. R. Civ. P. 15(a), leave to amend pleadings must be freely given when justice so requires. Applying that permissive standard, the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See, e.g., *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

Petitioner's motion is timely, its amended pleading does not violate settled law and instead properly pleads this new count, and no prejudice to Registrant's rights would occur from granting leave to Petitioner.

## **II. Petitioner's Amendments Are Timely And Proper.**

Petitioner filed its Motion after it reviewed Petitioner's submissions in response to Requests for Production. In those submissions, Petitioner does not provide any evidence of use of the TABLE TOPICS mark in commerce. Petitioner, as it does in its brief in opposition, puts forth its specimens showing the words of their mark, but not using the mark in a manner that qualifies for registration as use in commerce. *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1381 113 USPQ2d 2042 (Fed. Cir. 2015) (*holding that* The Board in this case and the leading treatise on trademarks also agree that rendering services requires actual provision of services) (*citing McCarthy on Trademarks and Unfair Competition* § 19:103 (4th ed. Supp.2013) ("To qualify for registration, the Lanham Act requires that the mark be both used in the sale or advertising of services and that the services themselves have been rendered in interstate or foreign commerce." (emphasis in original))."); *See also* 15 U.S.C. §1127.

A term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first-class section of an airplane does not function as mark for air transportation services); *In re Editel Prods., Inc.*, 189 USPQ 111 (TTAB 1975) (MINI-MOBILE identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); *In re Oscar Mayer & Co.*, 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services); *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1625-26 (TTAB 2008) (finding the submitted specimen unacceptable

evidence of use of the mark in connection with custom manufacturing services because it did not show an association between the mark and the services, but instead the mark was used only to refer to computer software).

The fact that the proposed mark appears in a tab of the application, does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. *In re Graystone Consulting Assocs.*, 115 USPQ2d 2035 (TTAB 2015) (finding specimen did not show a direct association between the mark WALK-IN SHOPPER and the identified business training consultancy services, but instead showed the mark being used to identify a particular type of customer that is the focus of the consulting services); *Peopleware Sys., Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (term PEOPLEWARE used within a byline on calling card specimen does not constitute service mark usage of that term, even if specimen elsewhere shows that applicant provides the recited services).

Here, Registrant's purported use in commerce arises from a single tab in an application used on a smartphone ("app") called "TABLE TOPICS." This use, however, does not comport with use in commerce for a service mark as the services are not rendered through the app and TABLE TOPICS is solely identifying a product used in the rendering of the service (i.e. a group session).

As Registrant's response brief illustrates, the mark is used at in-person meetings. The services are not rendered through the application. *Cf.* Reg. Response Brief Ex. B and C. Thus, Registrant is not using the mark in commerce according to the requirements of the Lanham Act but is merely using it to refer to an in-person activity where the services are actually rendered. Thus, Registrant is not using the mark in the goods and services identified in their Registration and have not been using it, making it *void ab initio* as nonuse of the Mark, based on recent information, both

precedes and continues to present.

Petitioner, however, does not need to prove our claims. Rather, the pleading standards require that a that "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of Board inter partes proceedings, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Petitioner has met that standard in its proposed Second Amended Petition for Cancellation.

### **CONCLUSION**

Petitioner has met the permissive standard the Board has set in order to obtain leave and Petitioner requests that the Board grant Petitioner's Motion.

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/Rishi Nair/

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the forgoing Petitioner's Reply Brief in Support of Its Motion for Leave to File Second Amended Petition for Cancellation was served upon Registrant by email on the following individuals at the following addresses on April 16, 2018:

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