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

Proceeding	92069434
Party	Defendant OMAHA STEAKS INTERNATIONAL, INC.
Correspondence Address	OMAHA STEAKS INTERNATIONAL INC 11030 "O" Street OMAHA, NE 68137 UNITED STATES mazour@thomtelaw.com no phone number provided
Submission	Motion to Dismiss - Rule 12(b)
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Date	10/07/2018
Attachments	MTD 434.pdf(46607 bytes )

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

<p><b>GREATER OMAHA PACKING CO., INC.,</b></p> <p><b>Petitioner</b></p> <p>v.</p> <p><b>OMAHA STEAKS INTERNATIONAL, INC.,</b></p> <p><b>Respondent</b></p>	<p><b>CANCELLATION NO. 92069434</b></p> <p><b>MOTION TO DISMISS</b></p>
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Comes now, Omaha Steaks International, Inc. (Omaha Steaks), and for its Motion to Dismiss, states as follows:

**FACTS & PROCEDURAL BACKGROUND**

1. Prior to the filing of this cancellation proceeding, Omaha Steaks filed the following Opposition Proceedings against various Greater Omaha Packing’s trademark applications:

<b>Date Opposition Filed</b>	<b>Opposition No.</b>	<b>Registrations relied upon in Oppositions <u>and</u> sought to be cancelled here</b>
6/07/2018	91241668	1458802, 1515602, 1555215, 1674686, 2002499, 2414603, 2840193, 2893159, 3758608
6/07/2018	91241670	“”
6/11/2018 (Amended Notice)	91241680	“”

6/07/2018	91241810	“”
6/20/2018	91241924	“”
7/17/2018	91242450	“”
7/17/2018	91242451	“”
7/17/2018	91242452	“”

2. Greater Omaha Packing did not assert counterclaims in any of its Answers filed in the Opposition Proceedings.

3. Instead, on August 23, 2018, one day before it filed its Answers, Greater Omaha Packing filed this cancellation proceeding seeking to cancel Omaha Steaks’ trademark registrations Nos. 1458802, 1515602, 1555215, 1674686, 2002499, 2414603, 2840193, 2893159, 3758608. Each of these registrations is asserted against Greater Omaha’s applications in the earlier-filed Opposition Proceedings.

## **ARGUMENT**

### ***Introduction***

Omaha Steaks respectfully submits that this cancellation proceeding be dismissed because it is time-barred as to each registration. If the Board disagrees, it should nonetheless dismiss the Petition because it is asserted against Omaha Steaks’ registrations relied upon in the first-filed Opposition Proceedings. Thus, the allegations comprise compulsory counterclaims that must be filed in the Opposition Proceedings.

### ***Cancellation as to All Registrations is Time-Barred***

The Petition to Cancel is addressed to nine Omaha Steaks’ registrations; cancellation of each of them is time-barred under 15 U.S.C. § 1064(1) (limiting the time to petition to cancel to five years from the date of registration). The Petition to Cancel was filed on August 23, 2018.

(TTABVue 1). Therefore, the registrations may not be cancelled on the grounds alleged in the Petition to Cancel:

<b>Registration No.</b>	<b>Registration Date</b>
1458802	September 22, 1987
1515602	December 6, 1988
1555215	September 5, 1989
1674686	February 4, 1992
2002499	September 24, 1996
2414603	December 19, 2000
2840193	May 11, 2004
2893159	October 12, 2004
3758608	March 9, 2010

***Filing a Separate Petition for Cancellation Improper***

Greater Omaha Packing’s attack on any one or more of the registrations pleaded in the first-filed Opposition Proceedings comprise a counterclaim which

. . . *shall* be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim *shall* be pleaded with or as part of the answer.

37 C.F.R. § 2.114(b)(3)(i) (emphasis added); *accord id.* § 2.106(b)(3)(i); *see also* Fed. R. Civ. P. 13(a) (“A pleading *must* state as a counterclaim any claim that—at the time of its service—the pleader has against an opposing party if the claim . . . arises out of the transaction or occurrence that is the subject matter of the opposing party's claim.”) (emphasis added).

The requirement that counterclaims arising out of the same transaction or occurrence as the opposing party's claim "shall" and "must" be stated in the pleadings was designed to prevent multiplicity of actions and to achieve resolution in a single lawsuit of all disputes arising out of common matters. *S. Constr. Co., Inc. v. Pickard*, 371 U.S. 57, 60 (1962).

Although Sections 2.106 and 2.11 permit a defense attacking the validity of a plaintiffs' pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim. TBMP § 313.01 (citing *Vitaline Corp. v. General Mills, Inc.*, 891 F.2d 273 (Fed. Cir. 1989)). The *Vitaline* Court stated that the rule requiring the pleading of counterclaims is "clearly" violated when it is pled, not in the Answer in the original proceeding, but as a purportedly new claim in a separate proceeding. *Id.* at 276.

### CONCLUSION

Based upon the foregoing, Omaha Steaks respectfully asks that the Board enter its Order dismissing the Petition to Cancel.

Dated this 7th day of October, 2018.

Respectfully submitted,

/s/ Nora M. Kane

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing document was served on Applicant by sending the same this 7th day of October, 2018, via electronic mail to I. Stephen Samuels at ISS@SamuelsTM.com.

*/s/ Nora M. Kane*

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Nora M. Kane, Attorney for Respondent