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

Proceeding	92071596
Party	Plaintiff Schiebel Industries AG
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SCHIEBEL INDUSTRIES, AG,

Petitioner,

v.

CAMERA COPTERS, INC.,

Respondent.

Mark: Camera Copters & Design

Registration No. 5,440,864

Cancellation No. 92071596

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO DISMISS FOR
MOOTNESS**

Introduction

Petitioner, Schiebel Industries, AG (“Petitioner” or “Schiebel”) files this Opposition to Registrant’s Motion To Dismiss For Mootness filed March 15, 2021 (“Motion”).

Petitioner wishes to make it clear that its Petition to Cancel seeks cancellation of only Registrant’s Class 12 *goods* in Registration No. 5,440,864 on the grounds of priority in Class 12. Petitioner does not seek cancellation of Registrant’s *services* in Class 41. Petitioner asserts that any issue involving Class 41 *services* in this Registration is irrelevant to this proceeding,

Petitioner also asserts that, for the purposes of this Motion, all allegations in Petitioner’s Petition for Cancellation (“Petition”) should be taken as true, and all facts in dispute should be resolved in favor of Petitioner as the non-moving party for the Motion.

Registrant's Motion

To the extent understood, Registrant's argument is that there is no "case or controversy" which entitles Petitioner to the relief it seeks. Although Registrant uses the term "mootness", Petitioner believes that this is a misdescription of Registrant's position, as understood by Petitioner. Mootness implies that a case or controversy once existed and no longer exists. But Registrant appears to allege that there was never at any time a "case or controversy."

Regardless of how entitled, Registrant's sole argument is that it has prior rights in Class 41 *services*, which would preclude Petitioner from ultimately obtaining a registration in Class 12 for Petitioner's *goods*. But registrability of Petitioner's mark in Class 12 in view of Registrant's Class 41 *services* is not an issue in this proceeding, and registrability is not a requirement for Petitioner to obtain the relief it seeks in this proceeding. Petitioner's grounds for cancellation do not allege priority in Class 41 *services* and Petitioner seeks cancellation, on grounds of priority, of only Registrant's *goods* in Class 12, not Class 41 *services*. Registrant's date of first use for Class 41 *services* are irrelevant to this proceeding. The registrability of Petitioner's mark in Class 12 in view of Registrant's alleged prior use of *services* in Class 41, and the relationship of Class 41 *services* to Class 12 *goods*, are also entirely irrelevant to this proceeding.

Petitioner will demonstrate that Registrant's Motion is without merit, and should be dismissed or denied, because a "case or controversy" existed when Petitioner filed its Notice of Opposition on June 24, 2019, and a "case or controversy" still exists to this day to satisfy the standing requirement entitling Petitioner to move forward with this proceeding.

Petitioner Has Alleged Facts Sufficient To Demonstrate the Existence of a Case or Controversy and Standing

In its Petition, Petitioner alleged that its trademark application Ser. No. 87820467 for CAMCOPTER was subject to an Office Action refusing registration in view of Registrant's No. 5,440,864 (the subject Registration here) on alleged likelihood of confusion, because the Registration covered *goods* in Class 12, in the same Class 12 as Petitioner's *goods*. Petitioner's relief sought is cancellation of Registrant's *goods* in Class 12, on the basis of priority, solely within Class 12. To be clear, Registrant does not seek any cancellation of Registrant's *services* in Registration No. 5,440,864.

Petitioner also alleged in its Petition that it has common law rights in CAMCOPTER for its *goods* back to at least October 12, 2009. This date is almost seven years earlier than Registrant's claimed date of first use on August 4, 2016, for Class 12 *goods*. Petitioner also alleged (in paragraph 12) that Petitioner is being injured by Registrant's Registration for Class 12 *goods*, based on Petitioner's prior common law rights in Class 12. The existence of Registrant's Registration for Class 12 *goods* will cause a likelihood of confusion to the public, who would cause the public to mistakenly believe that Registrant, rather than Petitioner, has prior rights in Class 12 goods, even if Petitioner does not obtain a registration in Class 12.

Petitioner's alleged facts as stated above clearly establish that Petitioner has standing to bring and maintain this Cancellation proceeding. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029, 213 USPQ 185, 189 (CCPA 1982) (rejection of petitioner's pending application, on the basis of the challenged registration, supports standing to cancel); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (petitioner has standing in view of the refusal of its own application based on likelihood of confusion with the mark in respondent's registration); *Parfums Nautee Ltd. v. American Int'l Indus.*, 22 USPQ2d

1306, 1307 (TTAB 1992) (standing found where respondent admitted in its answer to petitioner's allegations that petitioner's application was refused based on respondent's registration).

Once Petitioner has established standing, it is entitled to rely on any pleaded ground for cancellation that may negate the Registrant's right to maintain the challenged registration. *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ 1713, 1727-28 (Fed. Cir. 2012); *Jeweler's Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F. 2d 490, 493, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F. 2d 1024, 1031, 213 USPQ 185, 190 (CCPA 1982); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1248 n. 8 (TTAB 1987).

Petitioner's allegation in its Petition that Registrant's Registration in Class 12 is invalid due to Petitioner's prior rights in Class 12 is a sufficient ground for cancellation of Registrant's Registration in Class 12, because the allegations satisfy standing and the existence of a "case or controversy." The same facts which establish standing when the Petition was filed exist today, so a "case or controversy" still exists, and there is no "mootness" of the contested matter in this proceeding.

Moreover, standing does not require that a petitioner plead or demonstrate registrability of its mark. It is still enough to cancel a registration if a petitioner alleges and proves priority and likelihood of confusion based on common law rights. *Cent. Fid. Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438, 439-40 (TTAB 1984) (prior common law rights found to be sufficient to cancel a registration; although the petitioner also pled that registrant's registration was cited against petitioner's application, petitioner did not prove up this rejection by offering its

file history into the record, so the decision was based only on prior common law rights and likelihood of confusion).

For the forgoing reasons, Petitioner has standing on both its pending application being rejected over Registrant's Registration in Class 12, and its prior common law rights in Class 12, thereby satisfying the "case or controversy" requirement. The relevant facts still exist today, so there is no mootness to this proceeding.

None of Registrant's Cited Cases Support Its Requested Relief

While Petitioner's cases cited above clearly demonstrate the existence of Petitioner's standing and a "case or controversy," Registrant's cited cases do nothing more than state that a "case or controversy" must exist for a court or tribunal to have jurisdiction. Registrant has not cited any cases in support of its position that a case or controversy does not exist based on the specific facts of this case.

Registrant's Registration for Class 41 *Services* Are Irrelevant To This Proceeding

As stated above, Petitioner's sole remedy sought is cancellation of Registrant's *goods* in Class 12, on grounds of priority and likelihood of confusion. Petitioner does not seek cancellation of Registrant's *services* in Class 41. Registrant's arguments regarding its Class 41 *services* are not relevant to this proceeding and merely confuse the main issue in this proceeding, which is priority of *goods* in Class 12. Registrant's statement regarding priority of its Class 41 *services* should be stricken or at least ignored for the purposes of its Motion, and for the purposes of this proceeding.

The Exhibits Submitted by Registrant are Inadmissible and Even if Admissible
Do Not Support Its Position

Registrant has submitted a number of exhibits which purport to demonstrate that third parties offer drone *services* for aerial photography.

Firstly, none of these documents have been authenticated, and they are therefore inadmissible. They were produced for the first time as exhibits to the Motion. Registrant has failed to establish that these exhibits are authentic and admissible under any Federal Rule of Evidence.

Secondly, the purported dates of these documents are in March 2021, and are irrelevant to what *services* and *goods* were offered to the public on the eve of Petitioner's date of first use in October, 2009, on which Petitioner bases its prior use.

Thirdly, the documents merely purport to show that third parties are offering aerial photography *services* using drones (instead of offering *services* with manned helicopters), but the *services* are in Class 41). None of these third parties appear to *sell* drones which would be classed in Class 12.

Thus, even if the exhibits were admissible, they still fail to support Registrant's purported position about a relationship between Class 12 *goods*, and Class 41 *services*, which relationship is anyhow irrelevant to this proceeding.

Conclusion

For the foregoing reasons, Petitioner respectfully requests that Registrant's Motion be dismissed or denied.

Respectfully submitted,

Dated: March 29, 2021

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Certificate of Service

I hereby certify that a copy of the foregoing was served by email on attorney for Registrant as follows, this 29th day of March, 2021:

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