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

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| Proceeding no. | 92075025 |
| Party | Plaintiff Rubinstein & Associates, PLLC |
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| Attachments | Rubinstein v. EMI - Opposition to MtD.pdf(184245 bytes) |

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

In re Registration No. 2,263,883
For the mark: ENTREPRENEUR
Registration Date: July 27, 1999

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|--------------------------------|---|---------------------------|
| RUBINSTEIN & ASSOCIATES, PLLC, | : | |
| | : | Cancellation No. 92075025 |
| Petitioner, | : | |
| v. | : | |
| ENTREPRENEUR MEDIA, INC., | : | |
| | : | |
| Respondent. | : | |

OPPOSITION TO RESPONDENT'S MOTION TO DISMISS

I. Introduction

Respondent ENTREPRENEUR MEDIA, INC. (“Respondent”) aggressively enforces the generic term “entrepreneur” for the goods and services it provides (i.e., a magazine for entrepreneurs regarding entrepreneurship and a website regarding the same). As stated in the Petition for Cancellation, 1 TTABVUE, the Merriam-Webster dictionary defines the term “entrepreneur” as “one who organizes, manages, and assumes the risks of a business or enterprise.” The purpose of the goods and services that Respondent provides is to educate clients and consumers in how to organize, manage, and assume the risks of a business or enterprise and provide a network for such

clients and consumers to better pursue those endeavors. Therefore, the goods and services that Respondent provides directly relate to entrepreneurship and the mark “ENTREPRENEUR” is clearly generic. Accordingly, RUBINSTEIN & ASSOCIATES, PLLC (“Petitioner”) filed a Petition for Cancellation.

In its motion to dismiss, Respondent argues that Petitioner made conclusory allegations which failed to state a claim for genericness. Respondent attempts to use its Motion to Dismiss as an avenue to argue that its ENTREPRENEUR mark is descriptive. But under Fed. R. Civ. P. 12(b)(6), the only relevant question is whether it is *plausible* that relief could be granted. Respondent will have to wait for summary judgment or trial to make its arguments on the merits.

Respondent further argues that certain courts have previously found that ENTREPRENEUR is descriptive. However, under the doctrine of *res judicata* and non-mutual issue preclusion, Respondent’s impressive wins by default over *pro se* parties are of no moment here as Petitioner was not a party in any of those cases.

Lastly, Respondent argues that Petitioner failed to distinguish between the two potentially applicable genericness theories of generic *ab initio* and genericide. However, this level of specificity is not required in a petition for cancellation.

II. Standard on Motion to Dismiss Under Rule 12(b)(6)

Respondent’s motion to dismiss must be denied as long as Petitioner included allegations of fact that, *if proven*, would allow the Board to determine that (1) Petitioner has standing to bring this proceeding; and (2) a valid ground of cancellation exists. *Young v. AGB Corp.*, 152 F.3d 1377 (Fed. Cir. 1998); *Bayer Consumer Care Ag v. Belmora LLC*, 90 U.S.P.Q.2d 1587, 1590 (T.T.A.B. 2009); TBMP § 503.02.

In considering the Petition on a motion to dismiss, the Board “must accept as true all well-pled and material allegations of the complaint, and must construe the complaint in favor of the complaining party.” *Ritchie v. Simpson*, 170 F.3d 1092, 1097 (Fed. Cir. 1999). *See also The Scotch Whisky Assoc. v. U.S. Distilled Prods. Co.*, 952 F.2d 1317, 1319 (Fed. Cir. 1991) (reversing dismissal of cancellation proceeding where the Board failed to recognize that “[i]f the pleaded facts are proved, petitioner will be entitled to have the registration cancelled”) (emphasis added).

Construing Petitioner’s Petition in the light most favorable to Petitioner,

Petitioner has clearly alleged standing and a valid ground for cancellation.

III. The Issue of Genericness in Particular and Distinctiveness in General Are Not Decided At The Motion to Dismiss Stage

Respondent's Motion to Dismiss is based on the argument that Petitioner failed to state a claim for which relief can be granted. Respondent, in effect, argues that Petitioner is incorrect that the ENTREPRENEUR mark is generic. But a motion to dismiss is not the appropriate time to try the case.

This is a blatant attempt by Respondent to deny Petitioner its day in court. "To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding and (2) a valid ground exists for opposing or cancelling the registration." *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1 (T.T.A.B. 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 1378 (Fed. Cir. 1998)). Accordingly, "[a]t the motion to dismiss stage, the Board does not consider the merits of Opposer's standing or its claims but only considers whether the pleading is sufficient to state a claim to relief that is plausible on its face." *Joan Pletcher v. Ocala Horse Properties, LLC* 2020 WL 6638604 (T.T.A.B. 2020) (emphasis added). See also *Bell Atl. Corp. v Twombly*, 550 U.S. 544, 570 (2007); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 U.S.P.Q.2d 1594, 1597 (T.T.A.B. 1992). See also *Dawson v. Brandsberg*, No. 6:06 CV 019, 2006 WL 2915234, at *2 (W.D. Va. Oct. 10, 2006) ("As distinctiveness is an inherently factual issue and as it appears that this issue will be hotly disputed in this case, this issue cannot be resolved on the pleadings."); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012) (explaining that "[w]hether a mark has acquired distinctiveness is 'an inherently factual inquiry'"). And "in Board proceedings the issue of whether a mark is generic is typically **not amenable to resolution on summary judgment.**" *Biomedical Rsch. Lab'ys, LLC*, No. 91216751, 2015 WL 9906648, at *9 (Sept. 22, 2015) (emphasis added). Surely, if resolution of genericness is inappropriate *on summary judgment*, it is much more so *on motion to dismiss*.

Consequently, any argument made regarding the genericness, or lack thereof, of the ENTREPRENEUR mark at this point in the proceedings is inappropriate.

IV. Respondent's Prior Litigation History With Non-Parties is Irrelevant

Respondent lists several cases in which a court held that the ENTREPRENEUR mark is descriptive. Respondent went as far as to say that “the Board should dismiss Petitioner’s claim that the ENTREPRENEUR® mark is generic as it is simply implausible.” 8 TTABVUE 9.

This argument is without merit. Respondent is implicitly attempting to invoke the doctrine of *res judicata* or claim preclusion in stating that, because this very issue has been previously litigated, that previous ruling binds the Board. However, in order to properly invoke the doctrine of *res judicata* or claim preclusion, the parties involved in the suits in question must involve “**the same parties** or their privies based on the same cause of action.” *In re Bose Corp.*, 476 F.3d 1331, 1335 (Fed. Cir. 2007) (emphasis added) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 (1979)). Petitioner was not a party to any of the cases cited by Respondent, nor is Petitioner in privity with any of the parties to said cases. Thus, *res judicata* cannot be used to bar this proceeding.

Additionally, it is important to note that the vast majority of cases that Respondent so enthusiastically cites as “recogniz[ing] the strength of EMI’s trademarks” were default judgments or against *pro se* defendants.¹ 8 TTABVUE 5. The Federal Circuit has explained that “[i]n the case of a judgment entered by confession, consent, or **default**, none of the issues is actually litigated’ and issue preclusion does not apply.” *Kearns v. General Motors Corp.* 94 F.3d 1553, 1557 (Fed. Cir. 1996) (emphasis added) (quoting Restatement (Second) of Judgments § 27 comment e (1982)). The Court then proceeded to warn that, “*res judicata* is not readily extended to claims that were not before the court, and precedent weighs heavily against denying litigants a day in court unless there is a clear and persuasive basis for that denial.” *Id.* Accordingly, *res judicata* is inapplicable here.

¹*Entrepreneur Media, Inc. v. Entrepreneurs Opportunities, LLC*, 2018 WL 4860036; *Entrepreneur Media, Inc. v. John Doe, et al.*, No. 19-cv-1706, ECF No. 23 (C.D. Cal. Oct. 21, 2020); *Entrepreneur Media, Inc. v. Spencer*, 2017 WL 6405810 (D. Colo. Dec. 15, 2017); *Entrepreneur Media, Inc. v. seattleentrepreneur.com*, 2011 WL 13234092; *Entrepreneur Media, Inc. v. Whitehill*, 2015 U.S. Dist. LEXIS 191688 (D. Conn. Aug. 19, 2015) were all decided on default.

The defendant in *Entrepreneur Media, Inc. v. JMD Entm’t Grp, LLC*, 958 F. Supp. 2d 588, 595 (D. Md. 2013) appeared *pro se*.

V. Petitioner is Not Required to Specify its “Theory” of Genericness

Respondent also argues that the petition fails to state a claim because “Petitioner’s failure to specify whether it is claiming that EMI’s mark was generic *ab initio* or has become invalid due to genericide” But Respondent fails to cite any precedential opinion or provision of law that requires this specific disclosure.

VI. In The Alternative, Petitioner Should Be Granted Leave To Replead

As discussed above, Petitioner’s standing is adequately pled. However, should the Board conclude that Petitioner’s allegations as to its standing are insufficient (such as its lack of distinguishing between generic *ab initio* and genericide), the proper remedy is to grant leave to replead. When the Board grants a motion to dismiss for failure to state a claim, “the Board generally will allow the plaintiff an opportunity to file an amended pleading.” TBMP § 503.03 (citing *Wise F&I, LLC, et al. v. Allstate Insurance Co.*, 120 U.S.P.Q.2d 1103, 1110 (T.T.A.B. 2016); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1208 (T.T.A.B. 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 U.S.P.Q.2d 1711, 1714 (T.T.A.B. 1993); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 U.S.P.Q. 154, 156 (T.T.A.B. 1985); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. 151, 154 (T.T.A.B. 1983), *aff’d*, 739 F.2d 624 (Fed. Cir. 1984)). Accordingly, should the Board find that Petitioner’s claims are insufficient in any respect, Petitioner should be given leave to replead.

Dated: February 23, 2022
New York, New York

Respectfully submitted,
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