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

Proceeding no.	92075025
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

RUBINSTEIN & ASSOCIATES, PLLC,

Petitioner,

v.

ENTREPRENEUR MEDIA, INC.,

Registrant.

Cancellation No. 92075025

Trademark: ENTREPRENEUR

Registration No. 2,263,883

**ENTREPRENEUR MEDIA, INC.’S REPLY IN SUPPORT OF MOTION TO DISMISS THE  
PETITION FOR CANCELLATION FOR FAILURE TO STATE A CLAIM**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (“FRCP”) and § 503 of the Trademark Trial and Appeal Board Manual of Practice (“TBMP”), Registrant Entrepreneur Media, Inc. (“EMI”) submits this Reply in Support of Its Motion to Dismiss the Petition (“Motion”). EMI respectfully requests that the Board dismiss the Petition with prejudice for failure to state a claim.

**I. INTRODUCTION**

There is an old saying that “if you can’t convince them, confuse them.” This is Petitioner’s strategy in this proceeding. Rather than address the simple issue of whether it has stated a plausible genericness claim, Petitioner throws red herrings left and right and misconstrues EMI’s arguments to try to stir confusion in this proceeding and obfuscate its failings. As explained below, once these red herrings and misrepresentations are overlooked, it becomes clear that the Petition must be dismissed.

*First*, Petitioner never addresses whether its allegations show that the “entrepreneur” term is generic under the “primary significance” test—the operative test for stating a genericness claim. Instead, Petitioner focuses its Opposition to the Motion (“Opposition”) on the legal standard for motions to dismiss and cancellation claims more generally. But, trademarks cannot be cancelled in the abstract, and Petitioner has attacked EMI’s mark on the grounds of genericness. *See* 1 TTABVUE. Thus, Petitioner must allege actual facts (beyond insults and conclusory allegations) that show the ENTREPRENEUR®

mark is generic. In turn, this requires allegations that show the “primary significance” of the “entrepreneur” term to the “relevant public is the class or category of goods or services on or in connection with which [the term] is used.” TMEP § 1209.01(c); *see also H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986). The Petition contains no such factual allegations. Perhaps realizing this flaw, Petitioner *never once* addresses the “primary significance” test.

**Second**, Petitioner claims that it is not required to specify its genericness theory and that EMI has “fail[ed] to cite any precedential opinion or provision of law that requires this specific disclosure.”

10 TTABVUE 6. But Petitioner is misconstruing EMI’s argument and ignoring basic pleading standards set by the Supreme Court. The issue—which Petitioner fails to address—is that Petitioner must provide EMI with “fair notice of what [its] ... claim is and the grounds upon which it rests,” as is the rule with any asserted claim or defense. *See Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).

Petitioner has failed to provide EMI with “fair notice” of its claim, because it is unclear what claim Petitioner is asserting against EMI. If Petitioner is claiming that EMI’s mark was generic *ab initio*, then EMI would have to defend against a claim that its mark was generic around 1992 (the year when EMI first used its mark). On the other hand, if Petitioner is claiming that EMI’s mark has become generic through genericide, then EMI would have to defend against a claim that its mark has lost its distinctive identity through time and thus can no longer function as a trademark. These are two different claims, and EMI’s defenses will depend on which type of claim has been asserted. Yet, Petitioner fails to specify the type of genericness claim being asserted. If Petitioner does not put EMI on notice of its claim now, then EMI may become a “victim of unfair surprise” later in the proceeding, which violates the “fair notice” requirement. *See First Fed. Sav. Bank of Hegewisch v. United States*, 52 Fed. Cl. 774, 789 (2002).

**Finally**, Petitioner attacks EMI’s litigation history by claiming that (1) EMI is “attempting to invoke the doctrine of *res judicata* or claim preclusion” and (2) the cases were “default judgments or against *pro se* defendants.” 10 TTABVUE 4-5. Both statements are misrepresentations. EMI is not seeking to invoke *res judicata* or claim preclusion; EMI cited these cases for their recognized precedential

value. *See In re Jeep Corp.*, 222 USPQ 333, 1984 WL 63039, at \*4 (TTAB 1984) (“[E]ach case must be determined on its own facts and merits, [but] the prior cases have precedential value to the extent that they may involve facts similar to the facts in this case.”).

Additionally, the *Smith* case that EMI cited was decided on the merits, and it even went up to the Ninth Circuit. *See Entrepreneur Media v. Smith*, 279 F.3d 1135, 1142 n.2 (9th Cir. 2002) (finding that the ENTREPRENEUR® mark “as applied to EMI’s magazine and to computer programs and manuals falls within the descriptive category” of trademarks and “therefore does not fit within the generic category”). This is far from being just a “default judgment,” as Petitioner misleadingly claims. Moreover, in the *Dermer* and *Roach* cases that EMI cited, both courts dismissed similar genericness counterclaims since the defendants failed to explain how the “entrepreneur” term can “simultaneously” identify a broad range of goods and services. *See Entrepreneur Media, Inc. v. Dermer*, 2019 WL 4187466, at \*7 (C.D. Cal. July 22, 2019); *Entrepreneur Media, Inc. v. Kelly Roach*, 2021 WL 4134837, at \*3 (C.D. Cal. May 18, 2021). EMI cited these cases because, similarly here, Petitioner is seeking to cancel a trademark registration that encompasses a broad range of goods/services, but Petitioner fails to explain how one word (entrepreneur) can simultaneously identify all of those goods/services. This issue in *Dermer* and *Roach* was extensively litigated by both sides, and all the defendants were represented by counsel. Again, this is far from being a “default judgment” or against “*pro se* defendants.”

In short, when Petitioner’s red herrings and misrepresentations are set aside, it becomes clear that the issues here are simple, straightforward, and require dismissal of the Petition. Thus, EMI requests that the Board dismiss the Petition with prejudice.

## **II. THE PETITION MUST BE DISMISSED BECAUSE PETITIONER FAILS TO STATE A PLAUSIBLE CLAIM FOR GENERICNESS.**

### **A. Petitioner fails to advance a *single* argument that addresses the “primary significance” standard for stating a genericness claim.**

Petitioner spends a significant portion of its Opposition focusing on the legal standard for a motion to dismiss. While Petitioner correctly recognizes that a party can bring a genericness claim if it makes sufficient allegations that “a valid ground exists for opposing or cancelling the registration,” *see*

10 TTABVUE 3-4, Petitioner fails to address the next (and more important) question in the analysis: Has Petitioner alleged sufficient facts showing that EMI's mark is generic? No, Petitioner has not, and perhaps revealingly, Petitioner never addresses the genericness standard even once in its Opposition.

A trademark cannot be cancelled in the abstract; there must be a basis for cancellation. Petitioner has alleged that EMI's mark is generic, which requires Petitioner to allege facts that show the "primary significance" of the ENTREPRENEUR<sup>®</sup> mark to the "relevant public is the class or category of goods or services on or in connection with which it is used." TMEP § 1209.01(c); *see also H. Marvin*, 782 F.2d at 990. Under the "primary significance" test, courts apply a two-step inquiry: (1) "what is the genus of goods or services at issue" and (2) "is the term sought to be . . . retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin*, 782 F.2d at 990. "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question," rather than the source of those goods or services. *See id.* Thus, for the Petition to be plausible, Petitioner *must* plead facts that show the ENTREPRENEUR<sup>®</sup> mark can be generic under the "primary significance" test.

Petitioner fails to plausibly allege that the "primary significance" of the "entrepreneur" term is to identify any class of goods or services (let alone the goods or services in the trademark registration that it seeks to cancel). In fact, Petitioner does not make any allegations about how the public understands the "entrepreneur" term to function. This is such a basic fact that must be plead as part of any genericness claim, yet Petitioner failed to allege any such fact. This, alone, is grounds to dismiss the Petition.

The only allegations that Petitioner makes (beyond insults and legal conclusions) is the citation of two dictionary definitions for the word "entrepreneur." *See* 1 TTABVUE 5. As previously explained, it is a longstanding proposition that "dictionary definitions cannot be conclusive of genericness." *See* 2 McCarthy on Trademarks and Unfair Competition § 12:13 (5th ed.); *Legal Eagle, Inc. v. Mark Allen Davis*, 2008 WL 5417471, at \*3 (TTAB 2008) ("Opposer's one dictionary definition is clearly insufficient to establish the genus or class of opposer's services."); *Rita Abraham & Jesco Imports, Inc. v.*

*O'Neill*, 2007 WL 1276973, at \*5 (TTAB 2007) (“dictionary definition[s] cannot be conclusive on the issue of genericness”); *Editorial America, S.A. v. Gruner + Jahr Ag & Co.*, 213 USPQ 498, 1982 WL 52008, at \*8 (TTAB 1982) (“[D]ictionary definitions are never conclusive of the genericness of a term.”); *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999) (finding that dictionary definitions are not conclusive of genericness); *Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (“[D]ictionary definitions are not conclusive proof of a mark’s generic nature.”).

Rather than address this principle or the supporting cases, Petitioner dodges the issue. Indeed, Petitioner does not cite a single case showing that its genericness theory is plausible, i.e., that dictionary definitions can be used to plausibly state a genericness claim. Nor does Petitioner try to distinguish any of the above cases that resolve this issue in EMI’s favor. Instead, Petitioner digs its heels into the ground by continuing to cite one of those dictionary definitions in its Opposition, and thereafter concluding that EMI’s mark is generic. *See* 10 TTABVUE 1-2. Petitioner’s “[t]hreadbare recitals . . . supported by merely conclusory statements” are insufficient to state a genericness claim. *See Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009); *see also Collaborative Continuing Educ. Council Inc. v. The Alumni Inst., Inc.*, 2021 WL 2769893, at \*4 (TTAB 2021) (dismissing genericness claim because “Opposer merely recites the elements of the claim and repeats the conclusive assertion that the [mark] is [] generic”).

Finally, even if dictionary definitions were sufficient to state a genericness claim (they are not), Petitioner cites definitions that describe a *type of person* and not a *type of good or service*. *See* 1 TTABVUE 5 ¶ 11 (defining “entrepreneur” as “a person who . . .”). As stated above, to plausibly state that the ENTREPRENEUR® mark is generic, Petitioner must allege facts showing that the relevant public understands the “entrepreneur” term to refer to the genus of goods or services in the trademark registration at issue (which includes advertising services, promoting the goods and services of others through a global computer network, providing business information for the use of customers, providing a global computer network, and providing active links to the websites of others).

The definitions that Petitioner cites do not show that the “entrepreneur” term is understood to refer to advertising services, providing a global computer network, or any of the other goods/services in EMI’s trademark registration. In fact, the definitions do not show that the “entrepreneur” term is understood to refer to *any* goods or services at all. Instead, the definitions show that the term can be understood to reference “a person” who “starts a business” or “organizes, operates, and assumes the risks of a business term.” See 1 TTABVUE 5 ¶ 11. The significant disconnect between the goods/services in EMI’s registrations and the definitions that Petitioner cites is one (of many) reasons why Petitioner fails to state a genericness claim. Thus, the Board should dismiss the Petition.

**B. Petitioner fails to provide EMI with “fair notice” of its claim.**

Petitioner claims that it is not required to specify its genericness theory and that EMI has “fail[ed] to cite any precedential opinion or provision of law that requires this specific disclosure.” 10 TTABVUE 6. But Petitioner reads EMI’s arguments too narrowly, and in doing so, Petitioner is misconstruing the law about basic pleading requirements. The purpose of pleadings is to provide “fair notice” of the claims and defenses asserted. *Twombly*, 550 U.S. at 555; see also *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”). For the “fair notice” requirement to be met, a party must “sufficiently articulate” its claim so that the opposing party “is not a victim of unfair surprise.” See *First Fed. Sav. Bank*, 52 Fed. Cl. at 789. Based on how Petitioner has presented its genericness claim, EMI does not have fair notice of the claim.

A mark can be cancelled for genericness either because it is generic *ab initio* or has become generic over time. See *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1569-70 (Fed. Cir. 1995) (“[A] term may be generic for a designation *ab initio*, or it may become generic over time through common usage.”) (internal citations omitted); *In re Pennington Seed, Inc.*, 466 F.3d 1053, 1060 (Fed. Cir. 2006) (drawing a distinction between a mark that “*became* generic” vs. a mark that was “generic *ab initio*”) (emphasis in original). If Petitioner is claiming that EMI’s mark was generic *ab initio*, then EMI would have to defend against a claim that its mark was generic around 1992, the year when EMI began

using its mark. *See Pods Enterprises, Inc. v. U-Haul Intern., Inc.*, 2015 WL 1097374, at \*2 (M.D. Fla. Mar. 11, 2015) (“A mark is generic *ab initio* if it is generic at the time the company adopted it as a trademark.”); *San Diego Comic Convention v. Dan Farr Prods.*, 2017 WL 4227000, at \*4 (S.D. Cal. Sept. 12, 2017) (“[G]eneric *ab initio* is when a mark is generic before a producer began using it as a trademark to advertise their products or services.”).

On the other hand, if Petitioner is claiming that EMI’s mark has become generic through genericide, then EMI would have to defend against a claim that its mark has lost its distinctive identity through time and thus can no longer function as a trademark. *See In re Montrachet S.A.*, 878 F.2d 375, 376 (Fed. Cir. 1989) (“If through usage [a mark] has become the common or generic name of the [product], and is no longer an indication of source, it would no longer be entitled to trademark status.”); McCarthy § 12:1 (“If one seller develops trademark rights in a term which a majority of the relevant public then appropriates as the name of a product, the mark is a victim of genericide.”). These are two different claims that require different types of evidence to prove and refute. Thus, depending on which claim Petitioner is asserting, the scope of the proceedings will be different.

For example, if EMI is led to believe that it is defending against a genericide claim, then EMI will focus a significant portion of its time, resources, effort, document productions, deposition testimony, expert testimony, discovery efforts, and so forth showing how the “entrepreneur” term functions today. EMI would do this to show that the “primary significance” of the “entrepreneur” term in the **present day** is to identify EMI as the source of its goods/services, rather than identifying any particular class of goods or services. But if Petitioner later changes course and decides to attack EMI’s mark at trial for being generic *ab initio* (i.e., generic in **1992** when the mark was first used), then EMI will effectively be sandbagged. This is because EMI would have spent its resources building a defense to one claim, only to later realize that it must defend against an entirely separate claim that requires different types of evidence from over two decades ago to properly defend against. Surely, EMI is entitled to fair notice now of Petitioner’s claim to avoid such a situation.



EMI remains firm that Petitioner's conclusory allegations and dictionary definitions do not plausibly state a claim for genericness. That said, the allegations are also flawed because they do not provide EMI with fair notice of Petitioner's claim. Thus, the Petition must be dismissed.

**C. EMI's prior lawsuits about the ENTREPRENEUR® mark have precedential value.**

Petitioner claims that EMI is "attempting to invoke the doctrine of *res judicata* or claim preclusion" by citing previously litigated cases on the genericness issue. 10 TTABVUE 5. Not so. EMI is providing these cases to the Board for their recognized precedential value in making the Board's determination. *In re Jeep Corp.*, 222 USPQ 333, 1984 WL 63039, at \*4 (TTAB 1984) ("[E]ach case must be determined on its own facts and merits, [but] the prior cases have precedential value to the extent that they may involve facts similar to the facts in this case.").

Petitioner claims that many of EMI's cited cases recognizing the strength of EMI's trademarks were allegedly "default judgments or against *pro se* defendants." 10 TTABVUE 4. This claim is misleading for at least three reasons. **First**, Petitioner cites no authority for the proposition that a default judgment or a case against a *pro se* defendant has no precedential value. **Second**, Petitioner claims that EMI cannot use these cases to invoke issue or claim preclusion, but EMI is not seeking to invoke either doctrine in this proceeding. **Third**, Petitioner cherry-picked certain cases to support its argument (which again, lacks any authority), but conveniently omitted cases decided on the merits and/or against represented parties, including a case decided by the Ninth Circuit. *See Smith*, 279 F.3d 1135; *Dermer*, 2019 WL 4187466; *Roach*, 2021 WL 4134837.

For example, in *Smith*, the Ninth Circuit found that the ENTREPRENEUR® mark "as applied to EMI's magazine and to computer programs and manuals falls within the descriptive category" of trademarks and "therefore does not fit within the generic category." *Smith*, 279 F.3d at 1142 n.2. The Ninth Circuit reasoned that "'ENTREPRENEUR' does not state the general name of EMI's product—a magazine"; rather, the word "describes both the subject matter and the intended audience of the magazine and programs." *Id.* Further, the Ninth Circuit later upheld the District Court's findings that (1) "[t]he

extensive advertising and public recognition over the past 25 years have established [the ENTREPRENEUR<sup>®</sup> mark] as a strong mark in the industry”; (2) the ENTREPRENEUR<sup>®</sup> mark “is a strong distinctive mark, deserving of significant protection”; and (3) the ENTREPRENEUR<sup>®</sup> mark “has acquired secondary meaning.” *Entrepreneur Media, Inc. v. Smith*, 2004 U.S. Dist. LEXIS 24078, at \*9-10, 13 (C.D. Cal. June 23, 2004), *aff’d*, *Entrepreneur Media, Inc. v. Smith*, 101 Fed. App’x 212, 215 (9th Cir. 2004). Achieving a successful affirmation from the Ninth Circuit in recognizing the strength of EMI’s trademarks is far from a result of default judgment, as Petitioner misleadingly suggests.

Petitioner also conveniently ignores *Dermer* and *Roach*, which were recent decisions from the Central District of California that were both (1) decided on the merits and (2) against represented parties. In *Dermer*, the court dismissed a counterclaim alleging that the ENTREPRENEUR<sup>®</sup> mark is generic because the defendant did “not adequately allege[] how EMI’s ENTREPRENEUR mark can ***simultaneously identify***” several different goods and services. *See Dermer*, 2019 WL 4187466, at \*7 (emphasis added). Similarly in *Roach*, the court dismissed a similar counterclaim because “Defendants [could not] explain how ‘ENTREPRENEUR’ can ***simultaneously*** refer to three separate services as a generic term.” *See Roach*, 2021 WL 4134837, at \*3 (emphasis added).

Applying that legal reasoning here, Petitioner does not allege how the “entrepreneur” term can simultaneously identify the broad range of goods/services in the registration that it seeks to cancel (including advertising services, promoting the goods and services of others through a global computer network, providing business information for the use of customers, providing a global computer network, and providing active links to the websites of others). Nor does Petitioner even try to address this issue or explain how the facts here warrant a different result than the *Dermer* or *Roach* cases.

In short, the Petition is implausible and asserts mere conclusory allegations. The prior cases that EMI has cited have precedential value and only further highlight why the Petition is implausible. Thus, the Board should dismiss the Petition.

### III. PETITIONER SHOULD NOT BE GRANTED LEAVE TO AMEND

“[W]here justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment.” TBMP § 503.03; *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1929 n.10 (TTAB 2014) (Board did not grant leave to replead claim because of futility and lack of plausibility based on recited facts); *Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1044 (TTAB 2017) (Board did not grant leave to replead opposer’s Trademark Act § 2(d) claim because of futility). The Petition should be dismissed with prejudice because amendment would be futile, especially as the parties already met and conferred on this issue.

When presented with EMI’s arguments, Petitioner refused to amend or withdraw its claim. Petitioner should not be given the chance to amend after a ruling on this motion, as that would essentially reward it for obstructionist behavior and unnecessarily draining the Board’s and EMI’s time and resources. Petitioner decided to stand firm under its Petition, and the Board should hold Petitioner to this decision and dismiss the claim with prejudice and without further leave to amend. In other words, as any attempt to amend the Petition would be futile and unnecessarily delay the resolution of this action, the Board should exercise its discretion to dismiss these claims with prejudice. Thus, Petitioner should not be granted leave to amend, and the Petition should be dismissed with prejudice.

### IV. REQUEST FOR RELIEF

For these reasons, EMI respectfully requests that the Board dismiss the Petition with prejudice.



Dated: March 15, 2022

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing:

**ENTREPRENEUR MEDIA, INC.'S REPLY IN SUPPORT OF MOTION TO DISMISS THE  
PETITION FOR CANCELLATION FOR FAILURE TO STATE A CLAIM**

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