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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 MOTION TO DISMISS THE PETITION FOR
CANCELLATION FOR FAILURE TO STATE A CLAIM**

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and the Trademark Trial and Appeal Board Manual of Practice (“TBMP”) § 503, Registrant Entrepreneur Media, Inc. (“EMI”) requests that the Board dismiss the Petition for Cancellation (“Petition”) filed by Petitioner Rubinstein & Associates, PLLC (“Petitioner”).

I. INTRODUCTION

Petitioner is seeking to cancel one of EMI’s longstanding trademark registrations for the ENTREPRENEUR[®] mark (registered in 1999) on the grounds of genericness. Yet Petitioner committed at least three fatal errors: (1) it disregarded and failed to address the various decisions that have already determined the near entirety of this issue in EMI’s favor by finding the ENTREPRENEUR[®] mark is descriptive, not generic; (2) it offered mere conclusory allegations and failed to meet the relevant pleading standard for stating a genericness claim; and (3) it failed to distinguish between the two potentially applicable genericness theories (generic *ab initio* vs. genericide). As explained below, the Petition must be dismissed for, at least, these reasons.

First, several courts have already found that the ENTREPRENEUR[®] mark is not generic, and their logic applies with full force to Petitioner's claim. In fact, the Ninth Circuit found that the ENTREPRENEUR[®] mark "does not fit within the generic category" as applied to EMI's "magazine and to computer programs and manuals." *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1142 n.2 (9th Cir. 2002). The Ninth Circuit reasoned that EMI's mark "does not state the general name of EMI's product," since "[t]he word 'entrepreneur' describes both the subject matter and the intended audience of the magazine and programs." *Id.* at 1142. Hence, it was descriptive (at minimum), not generic. *See id.* Similarly here, the word "entrepreneur" does not state the general name of the broad range of services at issue (such as providing a global computer network and providing active links to the websites of others, among many other services). This, alone, is grounds to dismiss Petitioner's genericness claim.

Second, Petitioner's claim is not plausible based on the alleged facts as it rests on mere conclusory allegations. Petitioner asserts that the ENTREPRENEUR[®] mark is generic for the goods and services offered under EMI's Registration No. 2,263,883 (a legal conclusion), and the only allegations to support this conclusion are two dictionary definitions for the word "entrepreneur." 1 TTABVUE 5 ¶¶ 9-11. Yet, "dictionary definitions cannot be conclusive of genericness." *See* 2 McCarthy on Trademarks and Unfair Competition § 12:13 (5th ed.) (*quoting In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981)); *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.").

To state a genericness claim, Petitioner must plausibly allege that the primary significance of the "entrepreneur" term is to identify the class of goods or services in EMI's Registration. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990

(Fed. Cir. 1986). And because EMI’s registration contains a broad range of goods and services, Petitioner must allege that the primary significance of “entrepreneur” is to identify *all* the goods and services at issue (i.e., 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).

Because EMI offers so many goods and services under its mark, there is no plausible claim that consumers would understand one word to simultaneously identify all of these goods and services. Indeed, consumers would not understand “entrepreneur” to identify (for example) “the promotion of the goods and services of others by means of a global computer network” *simultaneously* with “web advertising services.” See U.S. Reg. No. 2,263,883. In other words, the ENTREPRENEUR® mark “does not state the general name of” any of these types of services and “therefore does not fit within the generic category.” *Smith*, 279 F.3d at 1142 n.2.

Finally, Petitioner fails to allege whether it is claiming that EMI’s mark was generic upon registration (i.e., generic *ab initio*) or that EMI’s mark has become generic over time (i.e., genericide). Petitioner’s claim fails under either genericness theory, but regardless, Petitioner must specifically allege the purportedly applicable theory supporting its claim to provide EMI with adequate notice and an opportunity to fairly respond. Its failure to do so is fatal.

For these reasons, Petitioner’s claim is facially implausible and should be dismissed, as other courts have done in similar circumstances. See, e.g., *Entrepreneur Media, Inc. v. Dermer*, No. SACV 18-1562 JVS (KESx), 2019 WL 4187466, at *7 (C.D. Cal. July 22, 2019) (dismissing counterclaim alleging the ENTREPRENEUR mark is generic because the defendants did “not adequately allege[] how EMI’s ENTREPRENEUR mark can simultaneously identify” several different goods and services); see also *Entrepreneur Media, Inc. v. Kelly Roach*, No. SACV 20-

1690 JVS (ADSx), 2021 WL 4134837, at *3 (C.D. Cal. May 18, 2021) (dismissing similar counterclaim because “Defendants [could not] explain how ‘ENTREPRENEUR’ can simultaneously refer to three separate services as a generic term.”).

II. STATEMENT OF FACTS

A. EMI Has Developed Its Successful Brand Under the ENTREPRENEUR® Mark

For over forty years, EMI has offered many goods and services to entrepreneurs and small business owners, including its *Entrepreneur* magazine, online articles, and content, workshops, seminars, podcasts, and other training and educational materials. *See* Proceeding No. 91264565 at 2-3.¹ EMI has conducted its longstanding marketing and sales efforts primarily under its ENTREPRENEUR® mark. *Id.* at 2. Through careful cultivation of its various products and services throughout the years, EMI has developed an outstanding reputation as an innovator in the field of business start-ups and strategy and has established an extremely loyal customer following. *Id.* at 3. EMI has received a tremendous amount of public recognition and acclaim for the goods and services provided under its ENTREPRENEUR® mark, and this mark has acquired extensive goodwill, developed a high degree of distinctiveness, and become well-known and associated with EMI. *Id.*

B. EMI Has Developed Strong Intellectual Property Rights in Its Trademarks

EMI owns, and has obtained federal trademark registrations for the ENTREPRENEUR® mark, as well as a family of related marks incorporating the “entrepreneur” term. *Id.* at 2. EMI registered its marks in connection with a broad range of diverse goods and services, including the following:

¹ Proceeding No. 91264565 is the “parent case,” which was initiated after EMI filed a Notice of Opposition against Petitioner’s application Serial No. 88816134 for the ENTREPRENAWYER mark. EMI filed this opposition after Petitioner filed the Petition, and both proceedings have since been consolidated. *See* 7 TTABVUE 6.

Magazines	Books	Advertising and business services	Conducting seminars on the development and operation of businesses
Providing business information for the use of customers in the field of starting and operating small businesses	Arranging and conducting trade show exhibitions in the field of entrepreneurial activities	Arranging for the promotion of the goods and services by means of a global computer network and other computer online services providers	Conducting workshops on computer technology, telecommunications, marketing, financing options, real estate management, tax planning, and insurance

See U.S. Reg. Nos. 1,453,968; 2,263,883; 2,502,032.

Besides all of the federal registrations that EMI has obtained for its marks, many courts have recognized the strength of EMI’s trademarks. The Ninth Circuit reviewed and affirmed a District Court’s findings that “[t]he extensive advertising and public recognition over the past 25 years have established [the ENTREPRENEUR® mark] as a strong mark in the industry”; the ENTREPRENEUR® mark “is a strong distinctive mark, deserving of significant protection”; and the ENTREPRENEUR® mark “has acquired secondary meaning.” *Entrepreneur Media, Inc. v. Smith*, No. 98-3607, 2004 U.S. Dist. Lexis 24078, at *9-10, 13 (C.D. Cal. June 23, 2004); *Entrepreneur Media, Inc. v. Smith*, 101 Fed. App’x 212, 215 (9th Cir. 2004).

The U.S. District Court for the Central District of California recently adopted the holding of the District Court in *Smith*, and once again found that the ENTREPRENEUR® mark is “a strong mark in the industry” and it “is a strong distinctive mark, deserving of significant protection.” See *Entrepreneur Media, Inc. v. Alfonso*, 2021 WL 2941983, at *2 (C.D. Cal. July 12, 2021). Additionally, the U.S. District Court for the Central District of California has held that “the ENTREPRENEUR Mark and EMI’s related marks have developed a high degree of distinctiveness and become well-known and recognized as identifying goods and services that

originate from EMI.” *Entrepreneur Media, Inc. v. Entrepreneurs Opportunities, LLC*, No. SACV 17-1341 JVS, 2018 WL 4860036, at *3 (C.D. Cal. Jan. 14, 2018); *see also Entrepreneur Media, Inc. v. John Doe, et al.*, No. 19-cv-1706, ECF No. 23 (C.D. Cal. Oct. 21, 2020) (“EMI’s ENTREPRENEUR mark is a strong mark”).

Likewise, several courts outside the Ninth Circuit have similarly found that the ENTREPRENEUR[®] mark is a strong mark deserving of significant protection. *See, e.g., Entrepreneur Media, Inc. v. seattleentrepreneur.com*, 2011 WL 13234092, at *1 (finding that EMI’s “Entrepreneur Marks are distinctive”) (E.D. Va. Dec. 6, 2011); *Entrepreneur Media, Inc. v. JMD Entm’t Grp, LLC*, 958 F. Supp. 2d 588, 595 (D. Md. 2013) (finding that the “ENTREPRENEUR[®] Mark has been used for over thirty years and is recognized as a valid, strong, and distinct mark by federal district courts”).

III. LEGAL STANDARD

Under Rule 12(b)(6), a party may move to dismiss a claim for “failure to state a claim upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6); TBMP § 503. This motion solely tests the legal sufficiency of the petition. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014).

To survive a motion to dismiss, a petition for cancellation “must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *See Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). While the Board must generally accept allegations as true for a motion to dismiss, it is “not bound to accept as true a legal conclusion couched as a factual allegation.” *See id.* Thus, “threadbare recitals of a cause of action’s elements, supported by mere conclusory statements, do not suffice.” *Id.*; *see also* TBMP § 503.02.

IV. PETITIONER FAILS TO STATE A CLAIM FOR CANCELLATION BASED ON GENERICNESS

A. Multiple Courts Have Ruled That the ENTREPRENEUR® Mark Is Not Generic

Petitioner's claim that the ENTREPRENEUR® mark is generic conflicts with multiple prior court determinations and EMI's longstanding federal registration. For example, 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." *Entrepreneur Media v. Smith*, 279 F.3d 1135, 1142, 1142 n.2, 1142 (9th Cir. 2002). 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.* This reasoning applies with full force here: the word "entrepreneur" does not state the general name of the various services at issue (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). Thus, EMI's mark "does not fit within the generic category." *Id.* at 1142 n.2.

Not only did the Ninth Circuit find that the ENTREPRENEUR® mark was not generic, but it also recognized the strength of the mark. Indeed, 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® mark] as a strong mark in the industry"; (2) the ENTREPRENEUR® mark "is a strong distinctive mark, deserving of significant protection"; and (3) the ENTREPRENEUR® mark "has acquired secondary meaning." *Entrepreneur Media, Inc. v. Smith*, 2004 U.S. Dist. LEXIS 24078, *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).

The U.S. District Court for the Central District of California recently adopted the holding of the District Court in *Smith*, and once again found that the ENTREPRENEUR[®] mark is “a strong mark in the industry” and “is a strong distinctive mark, deserving of significant protection.” *See Entrepreneur Media, Inc. v. Alfonso*, 2021 WL 2941983, at *2 (C.D. Cal. July 12, 2021). The Court also found that EMI’s mark has “acquired extensive goodwill, developed a high degree of distinctiveness, and *become famous, well known, and . . . deserving of strong protection.*” *Id.* at *3 (emphasis added). The U.S. District Court for the Central District of California also held that “the ENTREPRENEUR Mark and EMI’s related marks have developed a high degree of distinctiveness and become well-known and recognized as identifying goods and services that originate from EMI.” *Entrepreneur Media, Inc. v. Entrepreneurs Opportunities, LLC*, 2018 WL 4860036, at *3 (C.D. Cal. Jan. 14, 2018); *see also Entrepreneur Media, Inc. v. John Doe, et al.*, No. 19-cv-1706, ECF No. 23 (C.D. Cal. Oct. 21, 2020) (“EMI’s ENTREPRENEUR mark is a strong mark.”).

Several courts across the country have followed suit in finding that the ENTREPRENEUR[®] mark is a strong mark deserving of significant protection. *See, e.g., Entrepreneur Media, Inc. v. Whitehill*, 2015 U.S. Dist. LEXIS 191688, at *6 (D. Conn. Aug. 19, 2015) (“[T]he EMI Marks, and in particular the ENTREPRENEUR Mark, have acquired extensive goodwill, developed a high degree of distinctiveness and secondary meaning, and become well known and recognized as identifying goods and services that originate from EMI, such that they are deserving of strong protection.”); *Entrepreneur Media, Inc. v. Spencer*, 2017 WL 6405810, at *4 (D. Colo. Dec. 15, 2017) (same); *Entrepreneur Media, Inc. v. seattleentrepreneur.com*, 2011 WL 13234092, at *1 (finding that EMI’s “Entrepreneur Marks are distinctive”) (E.D. Va. Dec. 6, 2011); *Entrepreneur Media, Inc. v. JMD Entm’t Grp, LLC*, 958 F.

Supp. 2d 588, 595 (D. Md. 2013) (finding that the “ENTREPRENEUR[®] Mark has been used for over thirty years and is recognized as a valid, strong, and distinct mark by federal district courts”).

Consistent with the multitude of cases that have found the ENTREPRENEUR[®] mark to be strong, distinctive, and deserving of significant protection, the Board should dismiss Petitioner’s claim that the ENTREPRENEUR[®] mark is generic as it is simply implausible.

B. Under the “Primary Significance” Test, Petitioner Does Not Plausibly Allege That the Entrepreneur[®] Mark Is Generic

A registered trademark is endowed with a presumption of validity. 15 U.S.C. §1057. The general presumption of validity “includes the specific presumption that the trademark is not generic.” *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016) (quoting *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 (9th Cir. 1982)). A party challenging the validity of a registered trademark bears the burden of proving genericness by a preponderance of the evidence. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 114 USPQ2d 1827, 1830 n.2 (Fed. Cir. 2015); *see also Cold War Museum Inc. v. Cold War Air Museum Inc.*, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“A party seeking to cancel a registration must overcome the registration’s presumption of validity by a preponderance of the evidence.”).

To determine “whether [a] registered mark has become the generic name of goods or services,” courts must determine whether the “primary significance” of the mark to the “relevant public is the class or category of goods or services on or in connection with which it is used.” 15 U.S.C. §1064(3); TMEP § 1209.01(c). Under this 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 Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir.

1986). “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.*; *see also Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (“A mark answers the buyer’s questions ‘Who are you?’ [] But the generic name of the product answers the question ‘What are you?’”).

Petitioner fails to plausibly allege that the primary significance of the “entrepreneur” term is to identify any particular class of goods or services (let alone any of the goods or services in EMI’s registration). In fact, Petitioner does not make any allegations about how the public understands the “entrepreneur” term to function. Instead, Petitioner merely cites two dictionary definitions for the word “entrepreneur” and then concludes that “entrepreneur” is generic. This cannot state a genericness claim. *See 2 McCarthy on Trademarks and Unfair Competition* § 12:13 (5th ed.) (“dictionary definitions cannot be conclusive of genericness, ‘if for no other reason than that this would endow editors of such works with the power to destroy trademarks merely by defining them generically.’”) (*quoting In re Minnetonka, Inc.*, 212 USPQ 772 (TTAB 1981)); *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”). Even if dictionary definitions could be conclusive of genericness (they cannot), 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 . . .”). Thus, Petitioner’s definitions do not support a genericness claim.

Additionally, because Petitioner is seeking to cancel a registration that encompasses a broad range of goods and services, Petitioner must show that the “primary significance” of the “entrepreneur” term refers to the genus of *all* those goods and services, including:

1. Advertising and business services, namely, arranging for the promotion of the goods and services of others by means of a global computer network and other computer online services providers;
2. providing business information for the use of customers in the field of starting and operating small businesses and permitting customers to obtain information via a global computer network and other computer online service providers; and
3. web advertising services, namely, providing active links to the websites of others.

See U.S. Reg. No. 2,263,883. Petitioner makes no such allegation (since again, Petitioner has alleged no facts beyond citing two dictionary definitions). Nor could Petitioner make any such allegation, as there is simply no plausible claim that the “entrepreneur” term primarily functions to *simultaneously* identify a diverse set of goods and services, 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. Consumers would not understand a single word—entrepreneur—to *simultaneously* identify so many different goods and services.

For example, a consumer encountering a billboard outside Madison Square Garden that states “ENTREPRENEUR” would not know that “advertising and business services” or “web advertising services” were being provided within the arena, and so forth. That is because the “entrepreneur” term is not generic and the primary significance of the term is not to generally identify advertising or business services, or any of the other goods/services in EMI’s registration.

Rather, consumers would understand the term to identify the source of all the various unidentified goods and services being offered in the arena—EMI—because the ENTREPRENEUR[®] mark “is a strong distinctive mark, deserving of significant protection” and it “has acquired secondary meaning.” *Smith*, 2004 U.S. Dist. LEXIS 24078, at *9–10, 13, *aff’d*, *Smith*, 101 Fed. App’x at 215; *see also Alfonso*, 2021 WL 2941983, at *2 (“the ENTREPRENEUR[®] mark [has] acquired extensive goodwill, developed a high degree of distinctiveness, and become famous).

On the other hand, a consumer encountering a large billboard outside Madison Square Garden stating “ASPIRIN” would immediately understand what was being sold inside: a common pain relieving drug for minor aches, pains, and fevers. *See Elliott v. Google, Inc.*, 860 F.3d 1151, 1156 (9th Cir. 2017). Similarly, consumers would immediately know what to find being sold inside the arena if the sign said “CELLOPHANE,” i.e., a clear plastic food wrap. *Id.* That is because these are generic terms for those particular types of products (i.e., pain relieving medication and plastic wrap). The Board’s decisions on this issue are replete with examples of generic marks that clearly identify a good/service, none of which are like the ENTREPRENEUR[®] mark and the many goods/services associated with this mark. *See, e.g., In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for premoistened cloths for cleaning computer and television screens); *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017) (PRETZEL CRISPS generic for pretzel crackers); *In re Empire Tech, Dev. LLC*, 123 USPQ2d 1544 (TTAB 2017) (COFFEE FLOUR generic for flour made from coffee cherry skins, pulp, and pectin); *see also McCarthy* § 12:18 (identifying examples of generic terms as “ale house,” “allergy care,” “all news channel,”

“baby oil,” “bath oil beads,” “body soap,” “call forwarding,” “furniture warehouse,” “light beer,” “meth lab cleanup,” “pilates,” “space shuttle,” “super glue,” “thermos,” and “trampoline”).

Petitioner provides no plausible explanation or allegations as to how *one word* (“entrepreneur”) can simultaneously identify so many different goods and services. Nor does Petitioner explain how *one word* can have several different primary significances in the mind of consumers. Petitioner cannot plausibly make any such allegation because the “entrepreneur” term does not function in such a manner. It does not identify all of these different goods and services. To the contrary, it identifies EMI as the source of all these goods and services, and it thereby functions as “a strong distinctive mark, deserving of significant protection,” as several federal courts have found. *Smith*, 2004 U.S. Dist. LEXIS 24078, at *9–10, 13, *aff’d*, *Smith*, 101 Fed. App’x at 215.

Indeed, the U.S. District Court for the Central District of California recently considered and rejected a genericness claim from another party which sought to cancel the same registration at issue (among other registrations). *See Entrepreneur Media, Inc. v. Dermer*, 2019 WL 4187466, at *6-7 (C.D. Cal. July 22, 2019). In dismissing that claim, the Court explained that:

Defendants allege that EMI’s ENTREPRENEUR mark has become so common that it is now generic, and thus, EMI’s Trademark Registration Numbers 1,453,968; 2,263,883; 2,502,032; 4,260,948; 4,345,424; and 5,256,907 should be cancelled. The aforementioned registration numbers encompass over twenty different goods and services, including, but not limited to paper goods and printed matter, educational services, and streaming of video and digital material on the Internet. ***As EMI correctly points out, Defendants have not adequately alleged how EMI’s ENTREPRENEUR mark can simultaneously identify over twenty different goods and services.*** As currently alleged, Defendants merely assert that the ENTREPRENEUR mark has become “so common that it is now generic.” Defendants provide no other allegations supporting their argument. Recognizing that an analysis for whether a mark is generic is often a question of fact not generally suitable for a Motion to Dismiss [], ***this Court finds***

that Defendants have failed to plausibly allege how EMI's ENTREPRENEUR mark is generic beyond the bare-bones, conclusory allegation that the mark is generic. Accordingly, the Court grants EMI's motion to dismiss Defendants' cancellation counterclaim. (emphasis added) (internal quotations and citations omitted).

Another court recently adopted this legal reasoning to dismiss a genericness claim brought against the same registration at issue. *See Entrepreneur Media, Inc. v. Kelly Roach*, No. SACV 20-1690 JVS (ADSx), 2021 WL 4134837, at *3 (C.D. Cal. May 18, 2021) (“Defendants cannot explain how ‘ENTREPRENEUR’ can simultaneously refer to three separate services as a generic term.”).

The same result follows here.² In its entirety, all Petitioner has alleged is (1) EMI's ENTREPRENEUR[®] mark is generic because “[t]he term ‘entrepreneur’ is generic as applied to ‘advertising and business services’ . . . [and] as applied to the ‘field of starting and operating small businesses’” and (2) the dictionary defines “‘entrepreneur’ as a “‘person who starts a business” and “[a] person who organizes, operates, and assumes the risk for a business venture.” *See* 1 TTABVue 5 ¶¶ 9-11. As explained above, dictionary definitions cannot establish that EMI's long-standing and well-recognized mark is generic.

Beyond those definitions, Petitioner makes no other unique allegations about the alleged genericness of EMI's mark. This is the definition of a “threadbare recital[] of a cause of action's elements, supported by mere conclusory statements,” which “do not suffice.” *Iqbal*, 556 U.S. at 678. Such “bare-bones conclusory allegations” cannot plausibly state a viable and plausible

² Although Petitioner is only seeking to cancel a single registration that encompasses fewer goods and services than in *Dermer*, that does not change the analysis here. The important similarity between this proceeding and *Dermer* is that Petitioner fails to explain how the ENTREPRENEUR[®] mark can *simultaneously* identify several different goods/services (regardless of the exact number of goods/services at issue).

genericness claim. *See Dermer*, 2019 WL 4187466, at *6-7. As the Petition is implausible and asserts mere conclusory allegations, the Board should dismiss it.

C. Petitioner’s Claim Is Unclear Because the Petition Does Not Distinguish Between Generic *Ab Initio* or Genericide

Petitioner’s entire claim rests on two dictionary definitions. Not only is this insufficient (as explained above), but Petitioner also fails to allege whether it is claiming that EMI’s mark was generic upon registration (i.e., generic *ab initio*³) or that EMI’s mark has become generic over time (i.e., genericide⁴). To be clear, Petitioner’s claim fails under either genericness theory. But still, Petitioner’s claim must clearly advance one of these genericness theories, as these theories require different supporting factual allegations and EMI is entitled to fair notice as to the nature of the claims it must defend against.

For example, if Petitioner is claiming that EMI’s mark was generic *ab initio*, then Petitioner must plausibly allege that the ENTREPRENEUR[®] mark was generic in 1999, the year that EMI registered its mark. In turn, this requires Petitioner to allege that the primary significance of the “entrepreneur” term in 1999 was to identify the class of goods/services in EMI’s registration. But Petitioner has alleged no such facts about the public’s understanding of the “entrepreneur” term in 1999 or how this term could operate then to simultaneously identify such disparate services. Instead, Petitioner has only provided two dictionary definitions, which were accessed on August 10, 2020. A dictionary definition from 2020 cannot be used to support a claim that requires factual allegations from 1999.

³ “[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.” *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-cv-1865 AJB (JMA), 2017 WL 4227000, at *4 (S.D. Cal. Sept. 12, 2017); *see also Pods Enters., Inc. v. U-Haul Int’l, 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.”).

⁴ “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’ and trademark rights may cease.” McCarthy § 12:1.

On the other hand, if Petitioner is claiming that the “entrepreneur” term has become generic through genericide, then Petitioner must plausibly allege that the primary significance of the “entrepreneur” term today is to identify the class of goods/services in EMI’s registration. While Petitioner has offered dictionary definitions from August 2020, as explained above, those definitions cannot support a genericness claim. *See Rita Abraham & Jesco Imports, Inc. v. O’Neill*, 2007 WL 1276973, at *5 (TTAB 2007) (dismissing a genericide counterclaim and explaining that “dictionary definition[s] cannot be conclusive on the issue of genericness”). Importantly, “genericide can occur as a result of a trademark owner’s failure to police the mark, resulting in widespread usage by competitors leading to a perception of genericness among the public.” *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007). Petitioner’s own allegations undermine a genericide theory, because rather than accusing of EMI of failing to enforce its mark, Petitioner has criticized EMI for having a “trademark enforcement program.” 1 TTABVUE 5 ¶ 12.

In short, Petitioner has failed to distinguish whether its claim rests on generic *ab initio* or genericide. Thus, the Board should dismiss the Petition.

V. REQUEST FOR RELIEF

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

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CERTIFICATE OF SERVICE

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

**ENTREPRENEUR MEDIA, INC.'S MOTION TO DISMISS
FOR FAILURE TO STATE A CLAIM**

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