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

Proceeding	91254264
Party	Defendant Ispira Srl
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Submission	Motion to Dismiss - Rule 12(b)
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Date	04/28/2020
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

M2BPens Florida LLC, Opposer, v. Ispira Srl, Applicant.	Opposition No.: 91254264

APPLICANT'S MOTION TO DISMISS

Ispira Srl ("Applicant") by and through the undersigned and pursuant to TBMP § 503 and Fed. R. Civ. P. 12(b) requests the Board dismiss all counts alleged in the Opposition because Opposer lacks standing, fails to state a claim *and* because the Opposition is not warranted by existing law or asserted for the purpose of establishing any new laws. The Opposition is nothing more than a plot to harass Applicant based on an unrelated dispute.

STANDARD FOR A MOTION TO DISMISS

In granting a motion to dismiss for failure to state a claim, Applicant need only show Opposer's allegations (1) do not establish standing or (2) do not form a valid basis to challenge a mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982) and TBMP §503.02.

Although Fed. R. Civ. P. 8(f) requires an Opposition be examined "liberally", Rule 12(b)(6) should be invoked when it is appropriate to "eliminate actions that are **fatally flawed** in their legal premises and destined to fail …" *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc*., 26 USPQ2d 1038, 1041 (Fed. Cir. 1993)(emphasis added); *5A Wright & Miller, Federal Practice And Procedure*: Civil 2d §1357 (1990).

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I. OPPOSER LACKS STANDING

Section 13 of the Trademark Act, 15 U.S.C. Section 1063, provides:

An opposition may be brought by "any person who believes he is or will be damaged by the registration of a mark on the principal register...."

The term "damage" does not support standing, if a party cannot plead a "real interest" in a case, i.e., a personal interest in the outcome of a proceeding beyond that of the general public or mere intermeddler. See *Otto Roth & Co., Inc. v. Universal Foods Corp*., 640 F.2d 1317, 209 USPQ 40, 41-42 (CCPA 1981). A personal interest is satisfied when a party is engaged in goods or services similar to an applicant or is otherwise situated such that it should have equal right to use all or part of an applicant's mark to describe its goods or services without restriction. See *Id.*

Opposer suggests it has standing based on several cases cited in the Opposition (1 TTABVUE at ¶¶ 1-5). The Opposition however meets neither.

For example,

- **Opposer alleged NO interest in Applicant's Mark**

In paragraph 1, Opposer cites, *Kellogg Co. v. General Mills Inc*., 82 USPQ2d 1766, 1768 (TTAB 2007) and *Monetecash LLC v. Anzar Enterprises, Inc*., 95 USPQ2d 1060 (TTAB 2010). In *Kellogg Co.* the Board found standing because Kellogg had commercial interest in the term "Cinnamon Toast" for cereal sufficient to oppose registration of CINNAMON TOAST CRUNCH (and the parties agreed to standing). *Kellogg Co.* at 1766. In *Monetecash LLC*, the Board found standing because Petitioner, a competitor, expressed a need to use a term that was part of respondent's mark.

Opposer alleged no interest in Applicant's Mark or need to use LEONARDO.

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- **Opposer is not a Defendant**

In paragraph 2, Opposer cites, *Bankamerica Corp v. Invest America*, 5 USPQ2d 1076 (TTAB 1987) which stands for the proposition that a party otherwise without interest in a mark can assert a claim *but when it is a Defendant, and in the form of a counterclaim*. Here, the Opposer is not a defendant.

- **Opposer alleged NO interest in LEONARDO**

In paragraph 3, Opposer cites, *Estate of Biro v. Bic Corp*., 18 USPQ2d 1382 (TTAB 1991) and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.,* 217 USPQ 505 (TTAB 1983). In *Estate of Biro*, the Estate was found to have standing to challenge BIRO based on the fact Biro is the surname of a pen inventor whose "persona" rights were implicated by Bic's application to register the surname as a mark for pens. In *University of Notre Dame* the university alleged a false association with Applicant's application to register NOTER DAME for cheese. The Opposer alleges no "persona" sights, personal stake or interest in Applicant's Mark.

In paragraph 4, Opposer cites, *Bose Corp. v. Hexawave, Inc.,* Opposition No. 91157315, 2008 WL 1741913 (TTAB 2008). The case concerns a Section 8 and 9 (renewal) and is not applicable or precedent of the TTAB.

- **Opposer plead NO intent to deceive**

In paragraph 5, Opposer cites, *Copelands' Enterprises Inc. v. CNV Inc*., 945 F.2d 1563 (Fed. Cir. 1991), as a basis for fraudulent misuse of the registration symbol. *Copelands'* requires misuse be done "with intent to deceive the purchasing public or others in the trade into believing the mark is registered." *Copelands' Enterprises* at 1566. Notwithstanding the fact there can be no "fraudulent misuse" (as further explained), Opposer plead no intent.

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Opposer has no "real interest" to challenge Applicant's Mark beyond that of the general public or intermeddler. The opposition is merely intended to harass Applicant based on an unrelated dispute as explained in the following,

II. OPPOSER'S PLEADINGS ARE INVALID

A. The Notice of Opposition, Claims 1 and 2 (1 TTABVUE, ¶¶ 6--14) are fatally defective because Opposer ratified "purported shortcomings" in Applicant's Application when <u>it too</u> filed a practically identical TM Application

Opposer's general allegations are that Applicant's mark is descriptive of Applicant's goods, e.g., pens, or it falsely suggests a connection with Leonardo Da Vinci.

Assuming true, Opposer cannot prevail or prove either claim based on its "ratification." (Ratification is a mechanism that estops a party from advancing a complained-of-act against it, when it too has committed the same act itself. See, *Town of Bloomfield v. Charter Oak Nat. Bank*, 121 U.S. 121 (1887)(when a party ratifies actions of another, it is estopped to thereafter deny validity of same).

(a) Applicant's mark is LEONARDO OFFICINA ITALIANA for pens (see Decl. DeFrancesco, ¶ 1)

(b) In December 2019, Opposer filed a nearly-identical application to register LEONARDO PENS for pens (see *id.,* ¶¶ 2-6).

(c) In December 2019, Opposer threatened *all legal* action against Applicant, including a baseless opposition, based on purported claims of patent infringement – even though it owns no patent (see *id.,* ¶ 8).

Once Opposer filed its TM application <u>under oath</u>, it took the position that Applicant's Mark is not unregisterable. Otherwise, Opposer admits its filing is fraudulent and that it is subject to penalty of perjury under 18 U.S.C. § 1001.

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