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

Proceeding	92050603
Party	Defendant KIM, PHILIP
Correspondence Address	KIM, PHILIP 2871 DUSTY STONE CT. SANTA ROSA, CA 95405 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Valerie Ann Nemeth
Filer's e-mail	VANemeth@cs.com
Signature	/ss/
Date	03/30/2009
Attachments	TTAB Motion to Dismiss Cancellation Ferry-Kim.tif (13 pages)(540564 bytes) KIMvFERRY Order 3-25-09 EX A.pdf (12 pages)(96026 bytes) FerryC&D10-07ExhibitB.pdf (2 pages)(1376650 bytes) FerryKimExhibitC.tif (1 page)(178880 bytes)

In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board

.....
Ray Ferry,

Petitioner,

v.

Cancellation No. 92050603

Philip Kim,

Registrant.
.....

Registrant's Motion to Dismiss Petition for Cancellation

And Memorandum of Law in Support Thereof

The Registrant, Philip Kim, owner of Trademark Registration No. 2519146, pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, through his undersigned attorney, hereby moves before this Board for an order dismissing the Petition for Cancellation filed by Ray Ferry for failure to state a claim upon which relief can be granted.

Introduction

Petitioner Ray Ferry comes to this Board seeking Cancellation of an over five-year old Registration for the mark FAMOUS MONSTERS OF FILMLAND, appearing to allege fraud as a basis therefore. The averments in the Petition are not set forth numerically or otherwise in accordance with the Federal Rules of Civil Procedure 10(b), 37 CFR §2.126 et. al., however, while reserving all rights to object to the same, Registrant will attempt to summarize as best as Registrant can decipher, the allegations as follows;

1. That the Registrant Philip Kim, with the aid of his attorney of Record, filed specimens in support of the Sections 8 and 15 which Petitioner claims “they did not publish or create or use” (Petition for Cancellation, First Page, 2nd Paragraph, hereafter referred to as “Paragraph 2”).

2. That the reason for such allegedly false submissions is to establish a use which Petitioner alleges to have been using in interstate commerce since 2004 (Petition for Cancellation, First Page, 3rd Paragraph, hereafter referred to as “Paragraph 3”).
3. That the while mark [allegedly used by Petitioner] is not registered with the USPTO, Petitioner’s “property and identity” were used to defraud the USPTO (Petition for Cancellation, First Page, 4th Paragraph, hereafter referred to as “Paragraph 4”).
4. That Registrant purchased certain items from Petitioner’s bankruptcy estate in October of 2007 but the status of the intellectual property remains allegedly unresolved, and therefore no use in commerce could have commenced prior to said date (Petition for Cancellation, First Page, 5th Paragraph, hereafter referred to as “Paragraph 5”).
5. That the mark had been abandoned by the bankruptcy estate trustee from whom the Registrant purchased the estate property since July of 2001, and “[N]o party claiming interest by transfer or assignment anywhere had used the trademark FAMOUS MONSTERS OF FILMLAND in interstate commerce or in any manner whatsoever” from July 2001 until October of 2007 (Petition for Cancellation, First through Second Page, 6th Paragraph, hereafter referred to as “Paragraph 6”).
6. Only Petitioner had used the mark in commerce commencing in January of 2004 (Petition for Cancellation, Second Page, 1st Paragraph, hereafter referred to as “Paragraph 7”).
7. That Petitioner’s motivation for the alleged fraudulent filing is to “advance a Lanham Act complaint in California Federal District Court” and as a basis to prosecute a pending application by Petitioner for “FAMOUS MONSTERS”, which is allegedly “being opposed by at least two parties”, and further allegedly to obtain a prior cancellation of Registration No. 2666798 (Petition for Cancellation, Second Page, 2nd Paragraph, hereafter referred to as “Paragraph 8”).

It is clear from these allegations, both standing alone and when taken into context of the history of the facts concerning the Registration at issue, much of which is of record with the USPTO, that the Petition fails to state a claim against the Registrant for fraud and, in fact, brings light to a history of fraudulent conduct by and on behalf of Petitioner.

Background of Facts

I. History of Mark and Chain of Ownership:

A. Petitioner's Registration and Bankruptcy Filing: Prior to filing the Bankruptcy Action Petition referred to hereinbelow, the Petitioner herein, Ray Ferry aka Raymond Ferry, had been the registered owner of a "Famous Monsters of Filmland" trademark nos. 1759269 and 1864434, dated April 20, 1992 and July 31, 1992 respectively, and had been publishing magazines and selling other merchandise in connection therewith. As a result of an adverse judgment in a civil matter, (*Ackerman v. Ferry*, LASC Case No. LC 039960, Judgment entered May 10, 2000) Petitioner filed for Chapter 7 Federal Bankruptcy Protection on October 26, 2000 (*In re Ray Ferry*, US Bankruptcy Court, Central District of California, San Fernando Valley Division, Case No. SV 01-019655-AG) (The "Bankruptcy Action"). The history of these proceedings is long, protracted and voluminous; Registrant does not wish to burden the Board with other than the most pertinent documents, and requests the Board to take judicial notice of those public court records in accordance with 37 CFR §2.122 and Fed. R. Evid. 201.

B. Fraudulent Transfers by Petitioner: Petitioner had been found to have secretly and fraudulently transferred those trademarks and the assets connected therewith on or about May 15, 2000, and was ordered by the Bankruptcy Court to turn the same over to the Trustee. The list of assets to be turned over included all items used for the production of the magazines, t-shirts, posters, and assets evidencing the goodwill of the Magazine (*In re Ray Ferry*, supra, "Fraudulent Transfer Summary Judgment" dated October 12, 2001, holding that Petitioner "owns no interest in the

Magazine Assets and goodwill of the Magazine which constitute property of the estate”, and further holding the Defendant/Petitioner herein, “a constructive trustee for the Plaintiff’s benefit since May 15, 2000” and assigning the same to the Trustee (Summary Judgment, supra, Page 4).

C. Transfer of Assets to Trustee: As part of the scheme of avoiding the Bankruptcy rulings, Petitioner transferred the then-registered trademarks as well as the pending application for the subject Registered Trademark to Petitioner’s counsel-of-record, which then assigned the Registration to Esketores Systems, LLC, an entity owned/controlled by Petitioner’s counsel. As a result thereof, an adversarial proceeding was commenced by the Trustee to avoid said transfer, ultimately resulting in a settlement resolving the dispute which was approved by the Bankruptcy Court on November 19, 2003, and effectively and assigning the subject Trademark to the Trustee.

D. Assignment by Trustee to Registrant: Finally, pursuant to an Order re Motion for Authority to Sell or Abandon Personal Property dated October 3, 2007, the subject Trademark, together with those assets set forth in the Turnover Order, were ordered sold to the Registrant Philip Kim herein. Registrant thereby acquired said Trademark, goodwill and assets by duly executed Assignment, (the “Assignment”) which was recorded with the USPTO on October 10, 2007. A true and correct copy of the Order re Motion for Authority to Sell as well as the duly acknowledged Assignment were recorded with the Assignment Division of the USPTO, Reel/Frame No. 003637/0388, and Judicial Notice therefore is respectfully requested. A complete history of the transfers and court decisions is included in a Preliminary Injunction decided as of March 25, 2009, which is submitted herewith as Exhibit “A” and incorporated by reference herein.

II. Acquisition by Registrant and Continuation of Business:

Following the Assignment, Registrant Philip Kim immediately commenced to take actions to continue the business and goodwill associated with the subject Trademark and to protect the same,

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