

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: February 10, 2005

Opposition No. 91161458

Hutchison Whamboa
Enterprises
Limited

v.

Celestial Pictures Limited

Before Seeherman, Quinn and Bucher, Administrative Trademark Judges.

By the Board:

On November 4, 2004, opposer, in response to the Board's October 21, 2004 order, filed and served its amended notice of opposition. Fed. R. Civ. P. 15(a). This case now comes up for consideration of applicant's contested motion (filed September 3, 2004) to dismiss the notice of opposition under Fed. R. Civ. P. 12(b)(6). Inasmuch as opposer's amended notice of opposition has now been filed and served, the motion to dismiss for failure to state a claim will be decided on the basis of the amended pleading.

By way of background, opposer, a British Virgin Islands corporation, seeks to oppose registration of the following mark.¹



Opposer alleges, inter alia, that: (1) "[it is] the owner of all right, title and interest in and to [a] STAR BUTTON [design mark and has] used the STAR BUTTON [mark] in connection with telecommunication services, including third generation mobile services and applications, video calling, premium content browsing, music, movie and multimedia messaging, location guides, and video games"; (2) "opposer's services...are rendered throughout the world, including Australia, Denmark, Hong Kong, Ireland, Israel, Italy, Sweden, Thailand, Austria and the United Kingdom"; (3) "opposer promotes and advertises the services offered under the STAR BUTTON [mark] throughout the world"; (4) "as a result of opposer's widespread use and advertising, opposer's mark is renowned throughout the world"; (5) "in view of the substantial similarity between the respective marks, the commercial relationship between the goods, as

¹ Application Serial No. 76476969, filed December 18, 2002, alleging a bona fide intent to use in commerce in connection with

well as the fame and recognition inherent in the STAR BUTTON [mark], registration of the mark is likely to cause confusion, mistake or deception for purchasers"; and (6) "opposer's mark is of such fame and repute that applicant's use of the mark on the goods set forth in the application will lead purchasers to assume a connection with opposer and to falsely suggest a common association."

In support of its motion to dismiss, applicant states that opposer "does not claim any proprietary interest in the alleged Star Button Device in the United States and it does not claim prior rights to its Star Button Device in the United States." Further, applicant states that opposer "merely claims it has rendered services in a limited number of countries, all of which are outside of North and South America." Applicant essentially argues that opposer has not sufficiently alleged standing or a claim under Section 2(d) of the Trademark Act.

In response, opposer states that the notice of opposition "sets forth specific facts concerning opposer's worldwide use and fame of its trademarks" and "[i]n view of the fact that purchasers in the U.S. can access opposer's website and thereby have access to opposer's use of its mark, and such accessibility occurred prior to the filing date of applicant's application, it is submitted that the

a variety of class 41 services in the entertainment field.

availability of opposer's marks in the United States serves as a basis for Section 2(d) and concomitantly that opposer has pleaded a valid cause of action." In addition, opposer states that it has "set forth a cause of action under Section 2(a)."

To state a proper claim, opposer must allege facts in its pleading which, if proved, establish that (1) it has standing to challenge the application, and (2) there is a valid ground for seeking to oppose registration. See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). For purposes of the motion to dismiss, all well-pleaded allegations of the nonmoving party must be accepted as true. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). In reviewing a complaint the Board construes the allegations therein liberally, as required by Fed. R. Civ. P. 8(f). See TBMP § 503.02 (2d ed. rev. March 2004).

In order to properly plead its standing, opposer need only allege that it has a real interest in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). As to the grounds, a necessary element in pleading a claim of likelihood of

confusion under Section 2(d) is use of the asserted mark in the United States.

Accepting all well-pleaded allegations in the opposition as true, opposer's Section 2(d) claim must fail because opposer has simply not alleged superior rights in its mark in the *United States* before applicant applied to register its mark in the United States. *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990) (foreign use has no effect on U.S. commerce and cannot establish priority in the United States).

Opposer's argument that consumers in the United States have access to opposer's website and thus "access to opposer's use of its mark" is not well taken. First, there are no allegations regarding a website in the pleading. Second, the argument that a party, outside of the United States, can maintain a website that displays a mark but does not offer its goods or services to a consumer in the United States is inconsistent with the doctrine of territoriality in trademark law. The Board is not aware of any case law, nor has opposer cited any, to support the proposition that maintaining a website outside of the United States that is accessible to anyone with Internet service constitutes use regulated by commerce as contemplated by the Trademark Act. Opposer has not stated that its services are offered for sale in the United States, much less that they have sold

their services in the United States, or that opposer is even capable of providing its services in the United States.

One exception to the use requirement for establishing priority is where a party plaintiff's mark has, as a result of extensive foreign use, become famous *in the United States* prior to the time that the party defendant knowingly adopted its mark in the United States. See *Vaudable v. Montmartre, Inc.*, 123 USPQ 357 (NY Sup. Ct. 1959).²

However, in this case, while opposer has alleged that its mark is "renowned throughout the world," opposer has not alleged that its mark was even known (much less that it was famous) *in the United States* prior to applicant's filing of its application in the United States on December 18, 2002. *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998)("Only the fame of opposer's mark amongst consumers in the United States is of relevance to us. The renown of opposer's marks outside the United States or exposure of the foreign public to opposer's marks is irrelevant.)

² See also *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*, 220 USPQ 1069 (TTAB 1983) (even in the absence of any pleaded registration of opposer, Board found that the record supported a finding that allowance of the application would have resulted in a likelihood of confusion as to source under Section 2(d) of the Trademark Act, due to the marks' fame and notoriety in connection with a tennis tournament held outside the United States); and *Empresa Cubana Del Tabaco v. Culbro Corp.*, 70 USPQ2d 1650 (S.D.N.Y. 2004) (under famous mark exception to territoriality principle a famous mark may have priority over first use in the United States).

Finally, after reviewing the amended pleading, we also find that opposer has not sufficiently alleged a claim under Section 2(a). Specifically, opposer has not alleged that applicant's proposed mark points uniquely and unmistakably to the identity or persona of opposer such that consumers *in the United States* would draw a connection between applicant's proposed mark and opposer. *Internet, Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1437 (TTAB 1996) (To state a claim of false suggestion of a connection under Section 2(a), opposer must allege facts from which it maybe inferred that (1) applicant's mark is the same as, or a close approximation of, opposer's previously used name or identity; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to the identity or persona of opposer; (3) opposer is not connected with the activities of applicant under the mark; and (4) opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods or services, a connection with opposer would be presumed.); *see also, Buffett v. Chi Chi's Inc.*, 226 USPQ 428 (TTAB 1985).

In view thereof, applicant's motion to dismiss is granted to the extent that opposer is allowed until **TWENTY DAYS** from the mailing date of this order to file and serve

an amended notice of opposition properly setting forth its grounds for opposition, as discussed in this order, failing which judgment will be entered against opposer and the opposition dismissed with prejudice. In the event opposer files an amended notice of opposition, applicant is allowed until **FIFTY DAYS** from the mailing date of this order to file an answer or other response thereto.

Proceedings are otherwise suspended.

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