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

Proceeding	91163999
Party	Defendant Thomas P. Muchisky Muchisky, Thomas P. 13250 Lakefront Drive Earth City, MO 63045
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
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SYBARITIC, INC.,)	
)	
Opposer,)	Opposition No.: 91163999
)	Serial No. 78/282,661
v.)	
)	
THOMAS P. MUCHISKY,)	
)	
Applicant.)	

**APPLICANT’S MOTION TO DISMISS FOR FAILURE
TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED**

Applicant, Thomas P. Muchisky, hereby moves the Board, under Fed. R. Civ. P. 12(b)(6), to dismiss Opposer’s Notice of Opposition for failure to state a claim for which relief may be granted.

Applicant submits the following Memorandum in support of the Motion:

Introduction

By this Motion, Applicant moves the Board to dismiss Opposer’s Notice of Opposition for failure to state a claim upon which relief can be granted. A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038 (Fed. Cir. 1993). In order to withstand such a motion, in a trademark opposition proceeding, a pleading need only allege such facts as would, if proved, establish 1) that the plaintiff has standing to maintain the proceeding, and 2) that a valid ground exists for denying the registration sought. *Kelly Services Inc. v. Greene’s Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992).

Standing To Maintain Opposition

Opposer has not demonstrated a real interest in the Opposition. Opposer has pleaded its standing to be heard by its allegation that “it may not be able to use a similarly configured functional applicator in commerce”. However, there is no indication that Opposer has any intention to use a similar configuration. If, as Opposer contends, Applicant’s applicator “includes functional aspects”, Opposer would be entitled to use any such “functional aspects.” Thus, Opposer has not shown any “personal interest in the outcome of the case beyond that of the general public.” See *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385 (TTAB 1991); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

The damage alleged by Opposer is merely conjectural or hypothetical since Opposer has not alleged that it has used, is using, or will use, an applicator that is the same as, or similar to, Applicant’s applicator.

There is no Valid Ground For Opposing Registration

In Paragraph 3 of the Notice of Opposition, Opposer alleges that the “applicator... at issue includes functional aspects that cannot act as a trademark.” There is no indication as to which features of Applicant’s mark are “functional.” Section 2(e)(5) of the Trademark Act, 15 U.S.C. Section 1052(e)(5), expressly prohibits registration on the Principal Register of “matter that, as a whole, is functional.” Therefore, the standard of examination used by the Trademark Office is whether the matter as a whole is functional. In this case, the Trademark Office did not require that the drawing be amended to show the “features” that Applicant claims as its mark, or that Applicant restrict its claim to any individual features of its mark. Thus, it is clear that the Trademark Office did not

consider Applicant's applicator functional as a whole. Having failed to do so, the allegation that the applicator "includes functional aspects that cannot act as a trademark" is without merit.

Paragraphs 4 and 5 of the Notice of Opposition allege that Applicant's applicator has not acquired secondary meaning and does not function as a trademark. The record clearly establishes that Applicant's mark has acquired secondary meaning. All of the relevant factors to determine if the mark has acquired secondary meaning were considered by the Trademark Office, namely, the length and manner of use of the mark, the nature and extent of advertising and promotion of the mark and the volume of sales. This evidence was accepted by the Trademark Office, and the application was published under Section 2(f).

Section 45 of the Trademark Act, 15 U.S.C. Section 1127, defines a trademark as including any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods from those manufactured or sold by others and to indicate the source of the goods. Applicant's mark clearly falls within this definition since it consists of a "device" used to identify his goods and distinguish them from those manufactured or sold by others and to indicate the source of the goods. There is nothing in the Notice of Opposition which demonstrates that Applicant's mark does not meet the statutory definition of a trademark, particularly since the mark was not considered functional "as a whole."

Paragraph 6 (erroneously numbered "5") of the Notice of Opposition, Opposer alleges that it will be damaged because it may not be able to use a "similarly configured functional applicator in commerce." Registration of a word or design carries with it only

the presumption of an exclusive right to use the word or design as a mark. It has been clearly held, in many cases, “that registration of a word by one party does not preclude others from making descriptive or non-trademark uses of the word” *Kelly Services Inc. v. Greene’s Temporaries Inc., supra*, at 1463. The same is also true of designs.

Conclusion

Applicant properly applied for and received publication of its mark on the Principal Register of the Patent and Trademark Office. The Notice of Opposition fails to allege any “real interest” of Opposer which would establish Opposer’s standing to maintain the opposition, and there is no valid ground for denying the registration sought. Therefore, the opposition to the registration of Applicant’s mark should be dismissed.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED is being served via first class U. S. Mail, postage prepaid, this 7th day of March, 2005, upon the following:

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