

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

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Mailed: June 30, 2009

Opposition No. 91176065

Lenovo (Singapore) Pte. Ltd

v.

H. Co. Computer Products

**Before Bucher, Wellington, and Bergsman,
Administrative Trademark Judges.**

By the Board:

This case now comes up for consideration of opposer's motion to dismiss applicant's amended counterclaim of likelihood of confusion under Fed. R. Civ. P. 12(b)(6) on the grounds that applicant has failed to properly plead its standing, as well as its priority. Additionally, opposer seeks to dismiss applicant's amended counterclaim on the ground that applicant has failed to identify the class and marks sought to be canceled. Opposer's motion to dismiss is fully briefed.

To withstand a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted, a pleading need only allege such

facts, which if proved, would establish that the plaintiff is entitled to the relief sought: that is, that (1) the plaintiff has standing to maintain the proceeding and (2) a valid ground exists for denying the registration sought.

See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); see also 5A Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1357 (1990).

With respect to the issue of standing, we find that applicant has standing to petition to cancel opposer's pleaded registrations by virtue of applicant's position as defendant in the underlying opposition proceeding. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990). Accordingly, to the extent that opposer seeks to

dismiss applicant's amended counterclaim on the ground that applicant lacks standing, the motion is denied.¹

We next turn to the issue of priority. In its motion to dismiss, opposer argues that applicant's current claim of priority is deficient. Specifically, opposer contends that inasmuch as applicant does not plead ownership of any registered marks as the basis for its likelihood of confusion claim, but rather relies solely on twenty-nine asserted common law marks, it is incumbent upon applicant to plead that each of its relied upon common-laws marks has priority of use over each of opposer's pleaded registrations that it seeks to cancel. Opposer asserts that applicant has failed to do so in its amended counterclaim. Instead, opposer contends that applicant, in Paragraph 10 of its amended counterclaim, merely alleges that "[s]ince prior to the claimed priority date in some or all" of opposer's pleaded registrations, applicant has been using its common law marks in connection with applicant's identified goods. Opposer argues that the foregoing allegation not only fails to identify which of applicant's particular common law marks has priority of use over each of opposer's pleaded seven registration, but that the pleading also improperly attempts to group all of applicant's pleaded

¹In reaching our decision, we have carefully considered opposer's arguments in support of its motion that applicant lacks standing which are not explicitly discussed herein and do not find such arguments persuasive.

common law marks together. In doing so, opposer argues that the pleading fails to allege that any of applicant's pleaded common law marks has priority over any one of, let alone all of, opposer's seven pleaded registrations and, therefore, applicant's amended counterclaim should be dismissed.

In response, applicant contends that it has properly pleaded its priority. Specifically, applicant argues that all of opposer's pleaded registrations that are the subject to applicant's amended counterclaim were filed as intent-to-use applications under Section 1(b) of the Trademark Act, and, with the exception of one registration, i.e., Registration No. 2633094,² the date of first use in commerce for each registration occurred after the respective filing date of each registration. As such, applicant asserts that the presumptive priority date for all of these registrations is their filing date, except for Registration No. 2633094 which states a date of first use in commerce as February 20, 2001 a date prior to the filing date of the underlying application, which applicant contends is its presumptive priority date. In view of the foregoing, applicant contends that it has affirmatively alleged that "[s]ince prior to the filing date" of each of

²The Board notes that opposer's pleaded Registration No. 2633094 was canceled on May 16, 2009 for failure timely to file a Section 8 affidavit.

opposer's pleaded registrations, applicant has been using its pleaded common law marks in connection with the goods associated therewith. Additionally, applicant contends that it has alleged that it has been using its marks on the identified goods since at least as early as 1996, which applicant contends is three years prior to the earliest priority date for any of opposer's pleaded registrations, including Registration No. 2633094. Taking these allegations as true, as must be done on a motion to dismiss, applicant argues that it has properly alleged facts, if proved, would sufficiently support its claim of priority.

In order to properly state a claim of likelihood of confusion, plaintiff must plead that (1) the plaintiff's mark, as applied to its goods or services, so resembles the defendant's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. See Fed. R. Civ. P. 8; and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

After a careful review of applicant's amended counterclaim, the Board finds that applicant's allegations of priority remain unclear. In one instance, applicant alleges that, since prior to the filing dates of opposer's pleaded registrations and at least as early as 1996, applicant has been using its common law marks in connection

with its identified goods. See Paragraphs 8 and 9 of applicant's amended counterclaim. However, in another instance, applicant alleges that since prior to the claimed priority date in some or all of opposer's pleaded registrations, applicant has been using its common law marks in connection with the goods associated therewith. (emphasis added). See Paragraph 10 of the amended counterclaim.

It is clear from the allegations noted above that an inconsistency exists with applicant's allegations of priority of use which renders applicant's claim of likelihood of confusion deficient.

Accordingly, opposer's motion to dismiss for failure to properly allege priority is granted to the extent that applicant is allowed twenty days from the mailing date of this order in which to file and serve an amended counterclaim which properly and clearly asserts its priority, failing which the Board may dismiss applicant's counterclaim for applicant's failure to state a claim upon which relief may be granted.

Opposer is then allowed twenty days from the date of service of applicant's amended counterclaim to file and serve its answer or otherwise respond to the amended counterclaim. Further, the Board wishes to advise applicant that we are not inclined to afford applicant yet another

opportunity to amend its counterclaim if applicant fails properly to state its claim of priority as ordered herein.³

As a final matter, we turn to the issue of whether applicant has properly identified the registrations and classes of goods which applicant seeks to cancel. The Board notes that opposer has pleaded ownership of seven registrations in support of its grounds for its opposition in this case. Two of the seven registrations are multiple-class registrations that identify two classes of goods each. The remaining five pleaded registrations identify only one class of goods. Accordingly, opposer's pleaded registrations consist of ten classes of goods. The Board further notes that, despite only identifying seven classes on its ESTTA cover sheet, applicant, in both the preamble of its amended counterclaim, as well as the prayer for relief paragraph, states that it seeks to cancel each of opposer's seven pleaded registrations in their entirety. Applicant, however, has only paid a fee for seven classes.

Accordingly, if applicant seeks to cancel each of opposer's pleaded registrations in their entirety and taking into consideration that opposer's pleaded Registration No.

³The Board notes that applicant has properly asserted the essential elements for a claim of likelihood of confusion, notwithstanding its failure to properly plead priority. However, the Board further notes that applicant may only rely on the common law marks and the goods associated therewith that applicant specifically identifies in its counterclaim as a basis for its likelihood of confusion claim.

2633094 has already been canceled for failure to file a timely Section 8 affidavit, then applicant is allowed the same twenty days in which it must file and serve its amended counterclaim, as ordered herein, in which to submit any additional and appropriate filing fees for its counterclaim. In the alternative, if applicant seeks to cancel partially either or both of opposer's two multiple class registrations identified in its amended counterclaim, then applicant should set forth its request for partial cancellation when filing and serving the amended counterclaim ordered herein and submit any additional filing fees, if appropriate.

Proceedings herein are resumed. Discovery and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	11/1/2009
Testimony period for plaintiff in the opposition to close: (opening thirty days prior thereto)	1/30/2010
Testimony period for defendant in the opposition and as plaintiff in the counterclaim to close: (opening thirty days prior thereto)	3/31/2010
Testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close: (opening thirty days prior thereto)	5/30/2010
Rebuttal testimony period for plaintiff in the counterclaim to close: (opening fifteen days prior thereto)	7/14/2010
Briefs shall be due as follows: [See Trademark Rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	9/12/2010
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	10/12/2010
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	11/11/2010
Reply brief (if any) for plaintiff in the counterclaim shall be due:	11/26/2010

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>