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

Proceeding	91182537
Party	Defendant Trademarks LLC
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Date	03/28/2008
Attachments	91182537 Motion to Partially Dismiss Opposition.pdf (5 pages)(22289 bytes)

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

LORILLARD LICENSING COMPANY, LLC, Opposer, v. TRADEMARKS, LLC, Applicant.	Opposition No. 91182537 Mark: Serial No. 77199749 Filed: June 6, 2007

APPLICANT'S MOTION TO PARTIALLY DISMISS
OPPOSITION FOR FAILURE TO STATE A CLAIM

Trademarks, LLC ("Applicant") files this motion to partially dismiss Lorillard Licensing Company, LLC's ("Opposer") Notice of Opposition under Fed. R. Civ. P. 12(b)(6) and TBMP Section 503.01 because Opposer fails to allege facts sufficient to plead dilution under the Trademark Dilution Act of 2006 (the "TDA"). Specifically, Opposer fails to allege: (1) that its NEWPORT mark (Reg. No. 1191816) became famous before Applicant filed its application for the mark L&M FILTER MENTHOL 20 CLASS A CIGARETTES and Design as shown in Application Serial No. 77199749 (the subject of this proceeding), and (2) that Applicant's mark is likely to cause dilution of Opposer's mark in violation of Section 43(c), 15 U.S.C. § 1125(c). Without these facts, Opposer's allegations cannot give rise to claim for dilution. As such, Opposer's dilution claim should be dismissed.

A motion to dismiss for failure to state a claim is a test solely of the allegations set forth in a pleading. *Space Base Inv. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990). "The purpose of the rule is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced Cardiovascular Sys. v. SciMed Life Sys.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993) (citing *Neitzke v. Williams*, 490 U.S. 319, 326-27 (1989)). Dismissal is appropriate "if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations." *Hishon v. King & Spalding*, 467 U.S. 69, 73 (1984) (citing *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957)).

Here, Applicant's Motion to Dismiss should be granted because Opposer's alleged facts cannot give rise to a dilution claim. *See*, *e.g.*, *Intel Corp. v. Garaga Inc.*, 74 USPQ2d 1955 (opposer's dilution claim legally insufficient for failing to allege that opposer's mark became famous before the filing of applicant's intent-to-use application) (citing *Trek Bicycle Corporation v. StyleTrek Limited*, 64 USPQ2d 1540 (TTAB 2001)).

The TDA provides, in relevant part, that:

> [T]he owner of a *famous* mark…shall be entitled to an injunction against another person who, at any time *after* the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark
>
> …
>
> [A] mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner.

15 U.S.C. §1125(c) (emphasis added). For an intent-to-use application, "the owner of the famous mark must prove that its mark became famous prior to the filing date of the applicant's application." *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1728 (TTAB 2007) (citing *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001)). Accordingly, a prima facie claim for dilution requires, among other things, the claimant to allege that (1) its mark became famous before the other party filed an intent-to-use application for its mark, and (2) the applicant's mark is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.

Here, Opposer's allegations cannot give rise to a dilution claim, even if proven true at trial. First, Opposer fails to allege that its mark became famous *before* Applicant filed its intent-to-use application for its mark. *See*, *e.g.*, *7-Eleven Inc. v. Wechsler*, 83 USPQ2d at 1728 ("[I]n the case of an intent-to-use application, the owner of the famous mark must prove that its mark became famous prior to the filing date of the applicant's application."). Nowhere in the Notice of Opposition does Opposer allege that its mark became famous before Applicant filed its intent-to-use application.

Moreover, Opposer fails to allege that Applicant's mark is likely to cause dilution by blurring or dilution by tarnishment of Opposer's mark. Opposer only states in Paragraph 10 that registration of Applicant's mark "will dilute Opposer's [mark as shown in Registration No. 1191816]." Nowhere does Opposer allege that Applicant's mark is likely to cause dilution of Opposer's mark in violation of Section 43(c), 15 U.S.C. § 1125(c).

In light of the above, the facts alleged in Opposer's Notice of Opposition, even if proven true, cannot give rise to a dilution claim. As such, Opposer's dilution claim should be dismissed.

Respectfully submitted,

Date: March 28, 2008

/Christopher P. Foley/

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CERTIFICATE OF SERVICE

I hereby certify that on March 28, 2008, a true and correct copy of the foregoing APPLICANT'S MOTION TO PARTIALLY DISMISS OPPOSITION FOR FAILURE TO STATE A CLAIM was served by United States first class mail, postage prepaid, on counsel for Opposer:

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