

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

MBA

Mailed: December 10, 2008

Opposition No. 91185256

Room Service Home, LP and R  
S Design, Inc. d/b/a Room  
Service by Ann Fox

v.

Room Service Interiors, Ltd.

**Before Zervas, Bergsman and Ritchie, Administrative  
Trademark Judges**

**By the Board:**

This case now comes up for consideration of applicant's motion, filed August 26, 2008, to dismiss the original notice of opposition as untimely with respect to opposer R S Design, Inc. ("RSD") and for failure to state a claim upon which relief may be granted with respect to opposer Room Service Home, LP ("RSH"). On September 10, 2008, opposers filed: (1) an amended notice of opposition; and (2) a response to the motion to dismiss.

Background

Applicant seeks to register ROOMSERVICE for television and radio programs under Section 44(e), claiming a priority

date of December 17, 1999 under Section 44(d).<sup>1</sup> After applicant's mark was published for opposition, RSH filed a timely motion for an extension of time within which to oppose the application, which was granted, thus extending RSH's time to oppose until November 24, 2007.

On November 23, 2007, opposers RSH and RSD filed their original notice of opposition, which alleged that opposers have priority of use and that applicant's mark is likely to cause confusion with opposers' marks ROOM SERVICE and ROOM SERVICE HOME. Specifically, opposers alleged that RSD and RSH are "related companies with common ownership," and that: (1) RSD has provided interior design services and operated a home furnishings and accessories store since 1987 under the mark ROOM SERVICE; and (2) RSH has operated an online store offering home furnishings under the mark ROOM SERVICE HOME since 2004. In other words, although opposers alleged that "Opposers's dates of first use of the trademarks ROOM SERVICE and ROOM SERVICE HOME preceded" applicant's priority date, Original Notice of Opposition ¶ 8, it appears that the claim of priority may in fact be based only on RSD's alleged use of ROOM SERVICE, because only RSD's use predates applicant's priority date.

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<sup>1</sup> Application Serial No. 76071006, filed June 15, 2000, for "ongoing television and radio programs in the field of architecture, antiques, furniture, interior design and decorating."

In their amended notice of opposition, opposers essentially maintain their claims of priority and likelihood of confusion, but expand upon the allegations regarding the alleged relationship between RSD and RSH. Specifically, in the amended notice of opposition, opposers allege, among other things, that: (1) "Ann Fox owns 100% of the shares of [RSD];" (2) "Ann Fox owns 50% of the shares" of non-party Room Service Management, LLC ("RSM"); (3) "Donna King owns 50% of the shares" of RSM; (4) Ms. Fox and Ms. King acquired their shares of RSM prior to the date on which RSH filed its request for an extension of time to oppose the application; (5) RSM is the general partner of RSH; (6) "Donna King and Ann Fox jointly and severally exercise control over use by" RSH of the ROOM SERVICE mark; and (7) RSD and RSH "are in privity." The allegation that RSD and RSH are in privity is unexplained.

Amended Notice of Opposition Accepted

Before addressing applicant's motion to dismiss, it is well-settled that a notice of opposition may be amended as of right prior to the filing of a responsive pleading. Because applicant's motion to dismiss is not considered a responsive pleading, the amended notice of opposition is hereby accepted, and is now opposers' operative pleading herein. See Fed. R. Civ. P. 15(a). See also Beth A.

Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Although applicant's motion to dismiss is directed at the original notice of opposition, which has now been superseded by the amended notice of opposition, we exercise our discretion to consider the motion to dismiss, as it applies to the allegations contained in the amended notice of opposition, and applicant specifically addressed the amended notice of opposition in its reply brief. In short, because the amended notice of opposition includes the claims applicant seeks to dismiss, in expanded form, it would be inefficient to require applicant to file another, essentially identical motion to dismiss directed at the amended notice of opposition.

Applicant's Motion and Opposers' Response

By its motion,<sup>2</sup> applicant argues that "[i]f an opposition if (sic) filed during an extension period and the

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<sup>2</sup> Although applicant's motion is captioned a "motion to dismiss," applicant introduces with it two unauthenticated corporate documents from outside of the pleadings. Applicant argues that "the Board should [therefore] treat the subject Motion to Dismiss as a motion for summary judgment." However, because this case operates under the Board's "new rules," by virtue of being filed on or after November 1, 2007, Trademark Rule 2.127(e)(1) applies. It provides that a party "may not file a motion for summary judgment until the party has made its initial disclosures ...." Because applicant has not yet made its initial disclosures, we decline to treat the motion to dismiss as a motion for summary judgment, and the exhibits submitted with applicant's motion are excluded and have not been considered.

opposer is not privity (sic) with the person who was granted an extension of time [to oppose], the opposition will be dismissed." Applicant further claims that in this case, "the Notice of Opposition does not allege that [RSD] is in privity with" RSH, and therefore "the opposition by [RSD] is untimely." With respect to RSH, applicant argues that "[t]he earliest date of use alleged by [RSH] is 2004 long after Applicant's filing and priority dates," that RSH "cannot benefit from any alleged earlier use of [RSD] because [RSH] is not a successor or assign of [RSD]," and, because RSH "has not and cannot allege priority it cannot prevail." Therefore, according to applicant, the notice of opposition should be dismissed under Fed. R. Civ. P. 12(b)(6) with respect to RSH.

In response, opposers argue that they are "related companies" under 15 U.S.C. § 1127, and thus in privity. Specifically, opposers claim that they are related companies and in privity because "they share common ownership and common control."

In its reply brief, applicant addresses the now-operative amended notice of opposition, and claims that it does not adequately allege privity because it does not allege that opposers have "mutual or successive relationships to the same right of property." Specifically, applicant claims that RSD "is alleged to use the ROOM

SERVICE mark in connection with retail store services and interior design services," while RSH "is alleged to use the ROOM SERVICE HOME mark in connection an online store and website." Applicant points out that the amended notice of opposition is "silent as to any allegation of ownership of the ROOM SERVICE and ROOM SERVICE HOME marks," and therefore "[t]here is no basis to conclude that the Opposers have a mutual interest (ownership) in the same property right (mark)." Applicant further contends that opposers are not related companies because neither is a parent or subsidiary of the other, opposers have "separate corporate legal existence," and neither "is alleged to control the others (sic) use of its mark." Finally, "[t]he fact that Ann Fox is a shareholder of [RSD] and a shareholder of [RSM] which is the general partner of [RSH], does not satisfy the control requirement of the related company doctrine."

#### Decision

The Board recently set forth the standard applicable to motions to dismiss under Fed. R. Civ. P. 12(b)(6):

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if

proved, would entitle plaintiff to the relief, sought. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); and TBMP §503.02 (2d. ed. rev. 2004). 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). ... The purpose of a Rule 12(b)(6) motion is to challenge "the legal theory of the complaint, not the sufficiency of any evidence that might be adduced" and "to eliminate actions that are fatally flawed in their legal premises and destined to fail ..." Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra at 26 USPQ2d 1041.

Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536, 1538 (TTAB 2007); see also, Young v. AGB Corp., 152 F.3d 1377, 1379, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998).

The question presented by applicant's motion is whether opposers adequately allege that they are in privity. If they do, dismissal would not be appropriate for failure to state a claim upon which relief may be granted. See, SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707, 1709 (TTAB 1994). On the other hand, if privity is not adequately

alleged, then dismissal may be appropriate at least with respect to RSD. In re Cooper, 209 USPQ 670 (Commr. 1980).<sup>3</sup>

In this case, applicant's arguments notwithstanding, opposers do not merely allege that "Ann Fox is a shareholder of [RSD] and a shareholder of [RSM] which is the general partner of [RSH]." Rather, they specifically allege that they "are in privity." Amended Notice of Opposition ¶ 8. They also allege that they "are related companies" and that "both have continued to advertise and use the ROOM SERVICE and ROOM SERVICE HOME marks in connection with interior design services and retail sales. Id. ¶ 7 (emphasis supplied). Finally, opposers allege that their "dates of first use of the trademarks ROOM SERVICE and ROOM SERVICE HOME precede any date on which Applicant may rely ..." Id. ¶ 14 (emphasis supplied). Construing these allegations liberally and in the light most favorable to opposers, and

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<sup>3</sup> As applicant points out, privity may be established where one party exerts control over the other's use of the mark in question, such as in a parent-subsidary or licensor-licensee relationship. See, Great Seats, Ltd. v. Great Seats, Inc., 84 USPQ2d 1235, 1242-43 (TTAB 2007); Pneutek, Inc. v. Scherr, 211 U.S.P.Q. 824, 833 (TTAB 1981); Rolex Watch U.S.A., Inc. v. Madison Watch Co., Inc., 211 USPQ 352, 358 (1981); F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co., 140 USPQ 281 (Commr. 1963). Privity may also be established where the parties "hold successive interests in the same property." International Nutrition Co. v. Horphag Research, Ltd. 220 F.3d 1325, 1329, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000); Daltronics, Inc. v. H.L. Dalis, Inc., 158 USPQ 475, 479 n. 2 (TTAB 1968). On the other hand, "the mere fact that two sister companies are both controlled by a third company," or that two companies have the same principal stockholder and officer does not necessarily establish privity. See, Great Seats, 84 USPQ2d at 1243; In re Pharmacia Inc., 2 USPQ2d 1883, 1884 (TTAB 1987); In re Raven Marine, Inc., 217 USPQ 68 (TTAB 1983).

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accepting them as true, they are sufficient to state a claim upon which relief may be granted. Applicant, like the applicant in Fair Indigo, has "confused the requirements for pleading" with "the requirements for proving," at trial, opposers' claims. Fair Indigo, 85 USPQ2d at 1538.

Accordingly, applicant's motion to dismiss is hereby

**DENIED.**<sup>4</sup>

Conclusion

Proceedings herein are resumed. Applicant is allowed until January 10, 2009 to file an answer to the amended notice of opposition. Disclosure, conferencing, discovery, trial and other dates are reset as follows:

Time to Answer Amended Notice of Opposition	<b>January 10, 2009</b>
Deadline for Discovery Conference	<b>February 9, 2009</b>
Discovery Opens	<b>February 9, 2009</b>
Initial Disclosures Due	<b>March 11, 2009</b>
Expert Disclosures Due	<b>July 9, 2009</b>
Discovery Closes	<b>August 8, 2009</b>
Plaintiff's Pretrial Disclosures	<b>September 22, 2009</b>
Plaintiff's 30-day Trial Period Ends	<b>November 6, 2009</b>
Defendant's Pretrial Disclosures	<b>November 21, 2009</b>

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<sup>4</sup> Of course, in the event applicant files a motion for summary judgment after serving its initial disclosures, the applicable standard will be different, and opposers may be required to establish that there is a genuine issue of material fact as to whether they are in privity. Fed. R. Civ. P. 56(e)(2).

Defendant's 30-day Trial Period Ends	<b>January 5, 2010</b>
Plaintiff's Rebuttal Disclosures	<b>January 20, 2010</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>February 19, 2010</b>

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](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>

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