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

Proceeding	91186018
Party	Plaintiff In-N-Out Burgers
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In-N-Out Burgers)	
Opposer)	Opposition No.: 91186018
)	
v.)	Application No. 76/687,302
)	
Brian Quaglia and Sandra Quaglia,)	Filed: March 3, 2008
Applicants)	
_____)	

**REQUEST PURSUANT TO 37 C.F.R. § 2.127(b) FOR RECONSIDERATION OR
MODIFICATION OF DECISION ISSUED ON APPLICANT’S MOTION TO
DISMISS**

To the TTAB:

Opposer In-N-Out Burgers requests reconsideration and modification of the Board’s decision of March 13, 2009, with respect to the Board’s finding that Opposer’s claim of dilution to be deficient.

INTRODUCTION

Opposer’s Notice of Opposition was filed August 16, 2008, via the Electronic System for Trademark Trials and Appeals. Under the caption entitled “Grounds for Opposition,” Opposer entered, *inter alia*, “Dilution” “Trademark Act Section 43(c).” Further, under Attachments, Opposer entered a five-page PDF “NOTICE OF OPPOSITION, Paragraph 11 of which reads:

--11. Applicant’s mark so resembles Opposer’s previously used, registered, and famous marks inn-n-out, IN-N-OUT and IN-N-OUT BURGER as to be likely, when used in connection with the goods set forth in Applicant’s application, to lessen the capacity of Opposer’s said marks to identify and distinguish Opposer’s services and goods, regardless of the presence or absence of competition between Opposer and Applicant, or likelihood of

confusion, mistake or deception within the meaning of Section 43(c) of the Lanham Act.--

On September 26, 2008, Opposer filed an Opposition to Applicant's Answer filed with the Board on September 19, 2008, directed particularly to Applicant's Motion to Dismiss for failure to state a claim upon which relief can be granted.

After issuance of an Order suspending the proceedings pending disposition of Opposer's Motion to Strike that part of Applicant's Answer that could be construed as a Motion to Dismiss, to which Applicant did not file a reply brief, the Board reviewed the Notice of Opposition in its entirety, and as stated in its Opinion of March 13, 2009, found:

“-- Opposer's claim of dilution to be deficient because opposer does not plead when its mark became famous, which must be at least before the filing date of Applicant's application.”

citing *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q. 2d 1164 (TTAB 2001); and *Polaris Industries, Inc. v. DC Comics*, 59 U.S.P.Q. 2d 1798 (TTAB 2000).

By TTAB Order of April 3, Sandra Quaglia was joined as an Applicant.

This Request is filed pursuant to 37C.F.R. § 2.127(b) which provides that such request must be made within one month from the date of the Board's decision.

ARGUMENT

F.R.C.P. Rule 8(a)(2) requires only a short and plain statement of a claim showing that the pleader is entitled to relief, in order to give a defendant fair notice of what the claim is and the grounds upon which it rests. All that is required is a “short and plain statement” showing only that the pleader is entitled to relief.

Section 43 (c)(1) of the Trademark Act (15 U.S.C. § 1125(c)) reads as follows:

“PATENT AND TRADEMARK STATUTES

(c) Dilution By Blurring; Dilution By Tarnishment-

(1) INJUNCTIVE RELIEF-

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, 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, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”

Opposer’s dilution claim reads as follows:

11. Applicant’s mark so resembles Opposer’s previously used, registered, and famous marks inn-n-out, IN-N-OUT and IN-N-OUT BURGER as to be likely, when used in connection with the goods set forth in Applicant’s application, to lessen the capacity of Opposer’s said marks to identify and distinguish Opposer’s services and goods, regardless of the presence or absence of competition between Opposer and Applicant, or likelihood of confusion, mistake or deception within the meaning of Section 43(c) of the Lanham Act.

The decision of March 13 states: “We find Opposer’s claim of dilution to be deficient because Opposer does not plead when its mark became famous, which must be at least before the filing date of Applicant’s application.” However, the plain meaning of Opposer’s Paragraph 11 is that its marks “inn-n-out¹, IN-N-OUT and IN-N-OUT BURGER” were used, registered and famous **previously** to Applicant’s use of Applicant’s Mark in connection with the goods set forth in Applicant’s application.

The Board cites *Toro Co. v. ToroHead, Inc.* in support of its ruling. At 61 U.S.P.Q. 2d 1164, 1174, fn 9, it is stated: “In a use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), the party alleging fame must show that the mark has become famous prior to the applicant’s use of the mark.” Opposer concedes that the fame

¹. “inn-n-out” is a typographical error and clearly refers to Registration 2,285,823 for “in-n-out”, the first mark cited by Opposer as a basis for Opposition.

of Opposer's Marks prior to Applicant's use of its mark must be established by evidence introduced to sustain Opposer's claim of dilution. But in the present instance, a different issue is presented – whether Opposer's claim set forth in the Notice of Opposition gives Applicants fair notice of what the claim is and the grounds upon which it rests, as mandated by F.R.C.P. Rule 8(a)(2).

The *Polaris Case* 59 U.S.P.Q. 2d 1798 is distinguishable from the instant situation. In that case, the issue arose in the context of a motion to amend a Notice of Opposition to add a claim for dilution, the language of which was deemed insufficient in view of the language of Trademark Act Section 43(c), as it read at that time, pursuant to the Trademark Amendment Act of 1999. The language of the proffered claim was clearly insufficient, but as Opposer has illustrated, the language of Opposer's dilution claim clearly meets the standards of F.R.C.P. 8(a)(2) and Trademark Act Section 43(c) as amended by the Trademark Dilution Revision Act of 2006, enacted October 6, 2006.

SUMMARY

The purpose of a Motion to Dismiss is to test the sufficiency of a complaint, not to decide the merits of the case. Under the “simplified notice pleading” of the F.R.C.P., the allegations of the complaint should be construed liberally and the “complaint should not be dismissed for failure to state a claim unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief. See *Conley v. Gibson* 355 U.S. 41, 78 S. Ct. 99, 102 L. Ed 2d 80 (1957). See also, *The Scotch Whiskey Association v. United States Distilled Products Co.*, 18 U.S.P.Q. 2d 1391 (TTAB 1991); *Stanspec. Co. v. American Chain and Cable Co., Inc.*, 531 F2d 563, 189 U.S.P.Q. 420 (CCPA 1976).

WHEREFORE, Opposer requests reconsideration and modification of the Board's
March 13, 2009 Order to reinstate Opposer's claim of dilution.

Respectfully submitted,

In-N-Out Burgers

By /Edward O. Ansell/
Edward O. Ansell
Attorney for Opposer

Date: April 9, 2009

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PROOF OF SERVICE:

I hereby certify that on April 9, 2009, a copy of the foregoing Opposer's Request For Reconsideration Or Modification Of Decision Issued On Applicant's Motion To Dismiss Pursuant To 37 C.F.R. § 2.127(b) was deposited with the U.S. Postal Service, first class mail postage prepaid, to the Applicant, Brian Quaglia, 151 Airport Rd., Warwick, RI 02886.

/Edward O. Ansell/
Edward O. Ansell

PROOF OF SERVICE:

I hereby certify that on April 9, 2009, a copy of the foregoing Opposer's Request For Reconsideration Or Modification Of Decision Issued On Applicant's Motion To Dismiss Pursuant To 37 C.F.R. § 2.127(b) was deposited with deposited with the U.S. Postal Service, first class mail postage prepaid, to the Assignee Sandra Quaglia, 77 Peck Street, Rehoboth, MA 02769-2806

/Edward O. Ansell/
Edward O. Ansell