

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

Baxley

Mailed: December 10, 2009

Opposition No. 91190169

Susino Umbrella Co., Ltd.

v.

Susino USA, LLC

Before Hairston, Kuhlke, and Wellington,
Administrative Trademark Judges

By the Board:

This case now comes up for consideration of: (1) applicant's motion (filed August 27, 2009) to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim; and (2) applicant's motion (filed September 19, 2009) to strike opposer's corrected brief in response to the motion to dismiss or, in the alternative, the exhibits to the corrected brief.¹

The Board notes initially that applicant's motion to dismiss is untimely because the motion was filed after applicant filed its answer. See Fed. R. Civ. P. 12(b)(6); TBMP Section 503.01 (2d ed. rev. 2004). However, because opposer did not object to such motion as untimely and

¹ Because opposer filed a corrected brief in response on September 15, 2009, the original brief that opposer filed one day earlier will receive no consideration.

responded fully to the merits thereof, the untimeliness of the motion is waived. See *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478 (TTAB 1998).

In connection with the motion to dismiss, both parties have relied upon matters outside of the pleading in support of their positions. We elect to exclude those matters and decline to convert applicant's motion to one for summary judgment. See *Wellcome Foundation Ltd. v. Merck & Co.*, *supra*; TBMP Section 503.03 (2d ed. rev. 2004). Neither party's exhibits have received consideration in this decision, and applicant's motion to strike opposer's exhibits in support of its corrected brief in response is moot.

To the extent that applicant otherwise seeks to strike opposer's corrected brief in response, such motion is essentially based on an objection to the content of that brief. The Board will not strike a brief upon motion or a portion thereof based on an adversary's objection to the content thereof. Rather, the Board will consider the brief, as well as the adversary's objections thereto, and disregard any portions that are found to be improper. See TBMP Section 517. Based on the foregoing, the motion to strike opposer's corrected brief in response is denied.

Turning to the motion to dismiss under Fed. R. Civ. P. 12(b)(6), such a motion is a test solely of the legal

sufficiency of a complaint. See, e.g., *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). To withstand a motion to dismiss under Rule 12(b)(6), a pleading need only allege such facts as would, if proved, 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, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). In determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999).

Applicant contends that opposer failed to properly plead a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because "the facts plead[ed] in its [n]otice of [o]pposition and incorporated by reference by virtue of [applicant's involved application] support the conclusion that [applicant] and not [opposer] has priority of rights in the [involved] SUSINO mark." Applicant further contends that application Serial No. 79001855 for the SUSINO

mark ("the SUSINO application"), upon which opposer relies upon in support of its claim of standing, was filed by another entity, Jinjiang Hengshum Gingham Company ("Jinjiang"),² and was abandoned four years ago. Applicant further contends that opposer, by filing the notice of opposition, is improperly seeking to revive rights in its long-abandoned application through this proceeding. Based on the foregoing, applicant asks that the Board grant its motion to dismiss this opposition.

In response, opposer contends that its notice of opposition "fulfills the requirements set out for [o]pposition [p]leading."

Inasmuch as opposer cannot rely upon an abandoned application in support of its claims herein, the Board considers any reference to the SUSINO application to be merely informational. However, applicant's apparent belief that abandonment of the SUSINO application equals an abandonment of all rights in that mark is incorrect. Even if the SUSINO application was abandoned in 2005, such abandonment does not preclude opposer from relying upon any common law rights that it has in that mark. See *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481 (TTAB 1975).

² Opposer contends in paragraph 3 of the notice of opposition that Jinjiang was its previous name.

In reviewing the notice of opposition, opposer has adequately pleaded that it has a real interest in this proceeding and therefore standing to oppose by alleging in paragraph 3 of the notice of opposition that it has common law rights in the involved SUSINO mark; that applicant's claim of use of the mark is based on sales of umbrellas manufactured and marked SUSINO by opposer; and that applicant was merely a middleman that received opposer's product. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*. Opposer's standing is further pleaded in paragraph 9 of the notice of opposition wherein opposer alleges that, if the involved application is allowed to register, opposer, despite its prior use, would likely be prevented from obtaining a registration for the SUSINO mark on umbrellas. See *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP Section 309.03(b).

In addition, opposer has adequately pleaded its priority of use in paragraph 4 of the notice of opposition by alleging its use of the SUSINO mark, which it contends began prior to both the filing date of applicant's involved application and the use dates alleged therein. Opposer has adequately pleaded likelihood of confusion through the allegations set forth in paragraphs 5-8 and 10 of the notice

of opposition.³ See Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Based on the foregoing, applicant's motion to dismiss is denied.

Notwithstanding the foregoing, we note that opposer alleges in paragraph 5 of the notice of opposition that "the designation SUSINO for the goods identified in the [a]pplication so resembles [opposer's] nationwide common law rights in the trademark and pending application to register SUSINO as to be likely to cause confusion, mistake, or deception...." However, because opposer has identified no currently pending application that it has filed to register the SUSINO mark, we *sua sponte* strike the wording "and pending application to register" from that paragraph. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

After the withdrawal of its attorney on October 27, 2009, opposer stated in a November 29, 2009 submission that it intends to represent itself in this proceeding. While Patent and Trademark Rule 10.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who

³ Whether or not opposer can prevail herein is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

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is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, opposer should note that Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which opposer may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made, e.g., by first class mail. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service.

Further, opposer is based in China and may not use certificate of mailing procedure on submissions mailed to the Board from China. See Trademark Rule 2.197; TBMP Section 110. Any documents that opposer files by mail from China will be considered filed on the date such documents are received at the USPTO. See Trademark Rule 2.195. Accordingly, opposer is urged to file submissions in this case electronically through the Board's Electronic System for Trademark Trials and Appeals (ESSTA) at <http://estta.uspto.gov/>.

In prosecuting this opposition, opposer should review the Trademark Rules of Practice, online at <http://www.uspto.gov/web/offices/tac/tmlaw2.pdf>, and the Trademark Board Manual of Procedure, online at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/index.html>. The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure.

Proceedings herein are resumed.⁴ Remaining dates are reset as follows.

Expert Disclosures Due	4/11/10
Discovery Closes	5/11/10
Plaintiff's Pretrial Disclosures	6/25/10
Plaintiff's 30-day Trial Period Ends	8/9/10
Defendant's Pretrial Disclosures	8/24/10
Defendant's 30-day Trial Period Ends	10/8/10
Plaintiff's Rebuttal Disclosures	10/23/10
Plaintiff's 15-day Rebuttal Period Ends	11/22/10

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁴ Applicant filed its motion to dismiss six days after the due date for its initial disclosures. Accordingly, the Board presumes that the parties have served their disclosures. If the parties have not so served, they should do so as soon as possible.

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If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.