

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

Pologeorgis

Mailed: June 29, 2010

Opposition No. 91191016

Intellectual Reserve, Inc.

v.

Kendal M. Sheets

**Before Seeherman, Walsh, and Taylor,
Administrative Trademark Judges.**

By the Board:

This case comes before the Board for consideration of (1) opposer's motion to dismiss applicant's counterclaim for failure to state a claim upon which relief may be granted and (2) opposer's motion to strike evidentiary matters pleaded in applicant's answer and counterclaims. The motions are fully briefed.

As background, applicant seeks to register the mark SECRET MORMON in standard character form for the following goods:

"CD-ROMs, DVDs, magnetic tape cassettes, high definition digital disks featuring non-fictional content of history and religious doctrine; computer software for database management and interactive reading and research of electronically formatted books of history and religion; downloadable electronic publications and publications on

recordable media, namely, books, magazines, newsletters, manuals, pamphlets, multimedia files, and magazine columns featuring non-fictional content of history and religious doctrine; audio and video recordings provided in analog and digital format featuring non-fictional content of history and religious doctrine; audio and video recordings that are downloadable to recordable media featuring books, seminars, movies, documentaries, and interviews of non-fictional content of history and religious doctrine; computer game software and DVDs, CD-ROMs, and downloadable digital media files containing such software featuring non-fictional content of history and religious doctrine" in International Class 9; and

"Publications, namely, books, magazines, newsletters, pamphlets, guides, manuals, and syndicated newspaper columns featuring non-fictional content of history and religious doctrine; screenplays, books, guides, and manuals featuring fictional and non-fictional content of historical and religious events, persons, and activities; posters, calendars, note cards, greeting cards, stationery items, namely, pens, pencils, notebooks, notepads, stickers, binders, folders, writing paper and envelopes" in International Class 16.¹

On July 13, 2009, opposer filed a notice of opposition to registration of applicant's mark on the grounds of (1) priority and likelihood of confusion under Section 2(d) of the Trademark Act, (2) false suggestion of a connection under Section 2(a) of the Trademark Act, and (3) dilution under Section 43(a) of the Trademark Act. In support of its opposition, opposer has pleaded ownership of the following registered marks:

1. MORMON HANDICRAFT (typed format) for "retail catalog mail order and telephone order services for craft items and materials, dolls, baby clothes, toys, young girls' clothing, quilts,

¹Application Serial No. 77337325, filed on November 27, 2007, based on an allegation of a *bona fide* intention to use the mark in commerce under Trademark Act Section 1(b).

- personal gifts, needlework, porcelain statues and the like" in International Class 42;²
2. MORMON HANDICRAFT (typed format) for "fabrics, linens, bats [sic], towels, dish cloths, pillowcases, afghans, lap robes, quilts, quilt kits, and wall hangings, table covers, soft gifts, and hem-stitched items of textile material" in International Class 24;³
 3. MORMON TABERNACLE CHOIR and design for various prerecorded audio and videotapes, publications and entertainment services featuring religious, family and educational themes in International Classes 9, 16 and 41;⁴
 4. MORMON TABERNACLE CHOIR (typed format) for various prerecorded audio and videotapes, publications and entertainment services featuring religious, family and educational themes in International Classes 9, 16 and 41;⁵
 5. BOOK OF MORMON (typed format) for various prerecorded audio and video matter and various forms of publications concerning religious subject matter in International Classes 9 and 16;⁶ and
 6. MORMON (typed format) for "educational services, namely, providing classes, conferences, and institutes in the fields of history and religion" in International Class 41 and "genealogy services" in International Class 42.⁷

²Reg. No. 1527447, registered on February 28, 1989, issued under Section 2(f) with a disclaimer of the term "HANDICRAFT."

³Reg. No. 1524555, registered on February 14, 1989, issued under Section 2(f).

⁴Reg. No. 2913694, registered on December 21, 2004, issued under Section 2(f), in part, as to "MORMON TABERNACLE CHOIR."

⁵Reg. No. 2766231, registered on September 23, 2003, issued under Section 2(f).

⁶Reg. No. 2883572, registered on September 14, 2004, issued under Section 2(f).

⁷Reg. No. 3239919, registered on May 8, 2007, issued under Section 2(f).

On August 24, 2009, applicant filed his answer to the notice of opposition which included a counterclaim seeking to cancel each of opposer's six pleaded registrations on the grounds of (1) mere descriptiveness, (2) failure to function as a mark, and (3) genericness. Essentially, applicant is alleging that the word MORMON in each of opposer's pleaded registrations cannot be exclusively appropriated, and that each of the registrations should be cancelled on the aforesaid grounds because of the inclusion of this word in each mark.

We first turn to opposer's motion to dismiss. In support of its motion, opposer maintains that applicant has failed to state a claim for any of the grounds asserted in his counterclaim. With respect to the alleged claim of functionality, opposer contends that applicant has not and cannot allege that the word "MORMON" is a functional feature of the goods or services identified in opposer's pleaded registrations. Opposer further argues that applicant cannot allege that the registrations protect any feature of the goods or services such as product design, product packaging, color, trade dress or anything else that is essential to the use or purpose of the article or that affects the cost or quality of the article or service. Opposer further maintains that applicant has not alleged that any design feature of the registered marks is functional and has only alleged that the word MORMON is functional.

In regard to applicant's asserted mere descriptiveness claim, opposer alleges that a claim of mere descriptiveness is not available in this instance because some of the registrations are more than five years old. As to the registrations less than five-years old, opposer contends that applicant has not alleged that the marks are merely descriptive of any of the corresponding identified goods and/or services, but that applicant merely alleges that the term MORMON identifies The Church of Jesus Christ of Latter-Day Saints. Further, opposer argues that many of its pleaded registrations were issued after a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. As such, opposer maintains that the registrations are *prima facie* evidence of the validity of the marks and of the fact that the marks are either inherently distinctive or have acquired distinctiveness.

Finally, in regard to applicant's genericness claim, opposer contends that applicant has failed to allege that the term MORMON is generic for any of the goods and/or services identified in opposer's registrations. Rather, opposer maintains that applicant has merely alleged that the term MORMON is generic for religious groups. Accordingly, since opposer's marks are not registered for religious organizations, opposer contends that applicant's genericness claim must fail as a matter of law.

In order to withstand a motion to dismiss for failure to state a claim in a Board cancellation proceeding, a plaintiff need only allege such facts as would, if proved, establish that (1) plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for seeking to cancel 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 such motion, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the 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). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of

its claim. See *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

Initially, we find that applicant not only properly alleged his standing, but has established his standing to pursue his counterclaim inasmuch as a counterclaimant's standing to cancel a pleaded registration is inherent in his position as defendant in the original proceeding. See *General Mills, Inc. v. Natures Way Products*, 202 USPQ 840, 841 (TTAB 1979) (counterclaimant's position as defendant in the opposition gives him a personal stake in the controversy).

Turning to the claims set forth in applicant's counterclaim and following a careful review thereof, we find that applicant has failed to state a claim for mere descriptiveness, functionality, or genericness, except to the extent noted below.

With regard to applicant's mere descriptiveness claim, Section 14 of the Trademark Act provides that after five years from the date of the registration of a mark, a petition (or counterclaim) to cancel said registration may be filed only on grounds specified in subsections 14(3) and 14(5).⁸ A claim for mere descriptiveness, however, is not one of the grounds specified in subsections 14(3) and 15(5).

⁸ This latter subsection involves certification marks and thus is not relevant herein.

In this instance, two of opposer's pleaded registrations, namely, Registration Nos. 1524555 and 1527447, both for the mark MORMON HANDICRAFT, were issued more than five years before opposer filed its notice of opposition. Accordingly, applicant's mere descriptiveness claim as to these two registrations fails as a matter of law.

With respect to the remaining registrations, the Board notes that applicant has only alleged that the term MORMON, by itself, is merely descriptive of the goods and services identified in opposer's pleaded registrations. With the exception of Registration No. 3239919 which consists solely of the word MORMON in typed format, the registrations contain terms in addition to the word MORMON. Inasmuch as applicant has not affirmatively alleged that the marks in these registrations, as a whole, are merely descriptive of the identified goods and/or services, applicant has failed to state a proper claim of mere descriptiveness as to these registrations. Moreover, we note that opposer's pleaded Registration No. 2913694 for the mark MORMON TABERNACLE CHOIR contains a design element consisting of a pictorial depiction of a Mormon temple. As such, a claim that the mark as a whole is merely descriptive is not available in light of the inclusion of the design element. We do find, however, that applicant has asserted a proper claim of mere descriptiveness as to the mark MORMON in Registration No.

3239919.⁹ Accordingly, with the exception of Registration No. 3239919 which consists solely of the word MORMON, we find that applicant has failed to state a proper claim of mere descriptiveness in regard to the following pleaded registrations: Registration No. 2883572 for the mark BOOK OF MORMON; Registration No. 2766231 for the mark MORMON TABERNACLE CHOIR; and Registration No. 2913694 for the mark MORMON TABERNACLE CHOIR and design.

We next turn to applicant's genericness claim. In order to properly plead a claim of genericness, a plaintiff must affirmatively allege that the registered term is generic as applied to the specific goods and services for which it is registered. *See, e.g., In re Dial-A-Matress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). As with its mere descriptiveness claim, applicant has merely alleged that the term MORMON alone is a "well-known, generic term." Applicant has not specifically alleged that the term MORMON is generic for any of the goods and/or services identified in the pleaded registrations. Moreover, a claim for genericness must state that the mark,

⁹ While we acknowledge that opposer, by registering its MORMON mark pursuant to Section 2(f), has conceded that this mark is merely descriptive of the underlying services, we nonetheless presume that applicant is arguing that the mark has not acquired distinctiveness. However, because the mark was registered under Section 2(f), the better practice would have been for applicant to plead that the mark is merely descriptive and has not acquired distinctiveness.

as a whole, is generic for the identified goods and/or services and not that a portion of the mark may be generic. In regard to Registration No. 3239919 for the mark MORMON, applicant has failed to allege affirmatively that the term MORMON is generic for the services identified in the registration. As to the remaining pleaded registrations, applicant has not alleged that the marks, as a whole, are generic for the underlying goods and/or services. Accordingly, applicant has failed to state properly a claim for genericness as to any of opposer's pleaded registrations.¹⁰

Finally, we turn to applicant's alleged claim that opposer's pleaded marks are functional. A mark may be found to be functional under Section 2(e)(5) of the Trademark Act if a feature of the mark is essential to the use or purpose of the product or if it affects the cost or quality of the

¹⁰ We note that applicant, as an alternative, requests a disclaimer of the term MORMON as an unregistrable portion of opposer's pleaded marks. The Board construes applicant's alternative request as seeking to cancel the pleaded registrations absent the requested disclaimer. However, Section 14(3) of the Trademark Act does not contemplate such disclaimer requests as a basis for partial cancellation for registrations that are over five years old. Accordingly, applicant's alternative request for a disclaimer of the term MORMON as it pertains to Registration Nos. 1524555 and 1527447, both for the mark MORMON HANDICRAFT and which were both issued more than five years before opposer filed its notice of opposition, is unavailable as a matter of law. This is not to say that applicant cannot argue, in defense of his application, that the mere fact that MORMON is present in opposer's marks and applicant's mark is not a sufficient basis for finding likelihood of confusion.

device. See *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995). The types of marks that may be construed as functional are marks which consist of product design, product packaging, color or other trade dress. See generally TMEP Sections 1202(a) and (b) (6th Edition rev. 2, 2010). In this instance, none of opposer's pleaded registrations is for the type of mark that may be construed as being functional. Indeed, each of opposer's pleaded marks is solely a word mark, with the exception of the MORMON TABERNACLE CHOIR mark in Reg. No. 2913694 which contains a pictorial design element of a Mormon temple. As such, applicant's functional claim fails as a matter of law.

In view thereof, opposer's motion to dismiss applicant's counterclaim is granted in its entirety as it pertains to opposer's pleaded Registration Nos. 2883572, 2766231, 2913694, 1524555, and 1527447. In regard to opposer's pleaded Registration No. 3239919 for the mark MORMON, opposer's motion is denied with respect to applicant's claim of mere descriptiveness, but is granted with respect to applicant's claims of genericness and functionality.

The Board, however, freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where the challenged pleading is the initial pleading. In view

thereof, applicant is allowed until **twenty (20) days** from the mailing date of this order to file an amended answer and counterclaim which either (1) properly sets forth a claim of genericness as to all of opposer's pleaded registrations, as well as asserts a proper claim of mere descriptiveness and lack of acquired distinctiveness as to those registrations less than five years old at the time opposer filed its notice of opposition or (2) limit his counterclaim to the claim the Board has found sufficient herein, i.e., the claim of mere descriptiveness as to Registration No. 3239919 for the mark MORMON. For the reasons discussed above, however, applicant is precluded from re-asserting claims that opposer's pleaded registered marks are functional or, as to the registrations that were more than five years old at the time the notice of opposition was filed, are merely descriptive.¹¹ If applicant fails to submit an amended counterclaim within the allotted time as ordered herein, the counterclaim will be dismissed in its entirety.

¹¹In light of the instant order, opposer's motion to strike the evidentiary matter in applicant's counterclaim is deemed moot and will be given no further consideration. Applicant is advised, however, that if he chooses to file an amended counterclaim, as permitted herein, he should refrain from attaching evidentiary proof of his asserted claims in his amended pleading. See TBMP § 309.03(a)(2) (2nd ed. rev. 2004) ("Evidentiary matters should not be pleaded in a complaint. They are matters for proof, not for pleading). Applicant will have the opportunity to submit such evidence and/or proof in support of his asserted claims during applicant's assigned testimony period.

In turn, opposer is allowed until **twenty (20) days** from the date indicated on the certificate of service of the amended counterclaim to file an answer or otherwise plead to the amended counterclaim, if filed.

Proceedings herein are resumed and trial dates, including the close of discovery and disclosure deadlines, are reset as follows:¹²

Deadline for Discovery Conference	September 8, 2010
Discovery Opens	September 8, 2010
Initial Disclosures Due	October 8, 2010
Expert Disclosures Due	February 5, 2011
Discovery Closes	March 7, 2011
Plaintiff's Pretrial Disclosures	April 21, 2011
30-day testimony period for plaintiff's testimony to close	June 5, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	June 20, 2011
30-day testimony period for defendant and plaintiff in the counterclaim to close	August 4, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	August 19, 2011
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	October 3, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	October 18, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	November 17, 2011
Brief for plaintiff due	January 16, 2012
Brief for defendant and plaintiff in the counterclaim due	February 15, 2012

¹²In the event applicant does not file an amended counterclaim, as permitted by this order, the Board will reset the trial schedule accordingly to delete any dates concerning the counterclaim.

Brief for defendant in the
counterclaim and reply brief, if any,
for plaintiff due

March 16, 2012

Reply brief, if any, for plaintiff in
the counterclaim due

March 31, 2012

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 Rule
2.128(a) and (b).

An oral hearing will be set only upon request filed as
provided by Trademark Rule 2.129.