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

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Mailed: October 16, 2009

Opposition No. 91191309

DAVID K. ABERIZK

v.

ICI SERVICES, LLC

Before Quinn, Holtzman and Ritchie,
Administrative Trademark Judges.

By the Board:

Applicant seeks registration of the mark ICI ICI SERVICES (stylized, the colors black and blue claimed as a feature of the mark; "SERVICES" disclaimed) shown below, for a variety of business management, database, delivery, decontamination, design, engineering and consulting services in four international classes.[1]

Opposer filed, via the ESTTA filing system, a notice of opposition, the electronic cover sheet of which indicates priority and likelihood of confusion under Trademark Act

[1] Application Serial No. 77592570, filed October 14, 2008, alleging use of the mark in commerce pursuant to Trademark Act Section 1(a), and a date of first use and first use in commerce of June, 2006.

Section 2(d) as grounds for opposition.[2] The notice pleads ownership of Registration No. 3107760 for the mark ICI INTEGRATED CONSULTANTS INCORPORATED (standard characters; "CONSULTANTS INCORPORATED" disclaimed).[3] The notice includes, inter alia, the following assertions:

> It is confusing to our common Government/NAVY client. Both companies hold SEAPORT Enhanced contracts, and regardless of the Goods and Services application claim (sic), ICI Services web site and other listings present engineering as a key business area.
>
> Highlighting Engineering (Ship) Design, Test and Evaluation. These are Electrical and Mechanical engineering functions.
>
> I believe highlighting ICI in any font, or highlighting ICI in any font followed by a name is an infringement.

Applicant filed a combined timely answer denying the salient statements in the notice of opposition, and a motion to dismiss the opposition under Fed. R. Civ. P. 12(b)(6) for failure to state a claim on which relief can be granted.

This proceeding is before the Board for consideration of applicant's motion (filed September 4, 2009) to dismiss. The motion has been fully briefed.

Applicant seeks dismissal on the basis that any alleged facts in the opposition, even if proven, would not establish opposer's entitlement to relief, and that "(N)o valid ground for denying the registration sought has been asserted."

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[2] The Board considers the filing form cover sheet to be part of a complaint filed through the ESTTA system. *Cf. PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926 (TTAB 2005).

[3] Registration No. 3107760, registered June 20, 2006, for "technical consultation in the field of electrical, mechanical, and nuclear engineering" in International Class 42, alleging a

In response, counsel for opposer asserts that opposer filed without the benefit of counsel, and failed to allege all grounds upon which relief is sought. Opposer requests leave to file an amended notice of opposition to correct any defect in the existing pleading, delete extraneous matters, and include allegations of common law rights with respect to "ICI." Opposer further argues that the notice of opposition 1) adequately sets forth a basis for relief, and 2) pleads ownership of a registration which covers services that overlap with applicant's services and which asserts a date of first use earlier than the date of first use cited in the opposed application.

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that opposer is entitled to the relief sought, that is, that (1) opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. *See Young v. AGB Corp.*, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). *See also* TBMP § 503.02 (2d ed. rev. 2004).

For purposes of determining the motion, all of opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most

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date of first use and date of first use in commerce of June 1,

favorable to opposer. Dismissal for insufficiency is appropriate only if it appears certain that opposer is entitled to no relief under any set of facts that could be proved in support of his claim. *Id.*

To establish standing, opposer must allege facts sufficient to show a "real interest" in the proceeding and a "reasonable basis" for his belief of damage. To plead a "real interest" in the case, opposer must allege a "direct and personal stake" in the outcome of the proceeding, and the allegations in support of his belief of damage must have a reasonable basis in fact. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); TBMP § 309.03(b)(2d ed. rev. 2004).

Turning to the pleading, opposer asserts ownership of a registration for a mark that includes ICI, an element in the opposed mark, and asserts that both parties provide engineering services. We find that opposer's allegations indicate that he has an interest in the proceeding that is beyond that of the general public, and indicate a reasonable basis for his belief of damage. Thus, opposer has adequately set forth allegations which, if proven, would establish his standing to bring this action.

Additionally, while not a model of clarity and not entirely in conformity with Trademark Rules 2.104(a), and 2.126(a) and (c), the substance of the notice sets forth allegations which adequately place applicant on notice that

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opposer seeks to challenge registration on the ground of likelihood of confusion, a valid statutory ground on which registration can be denied.

In view thereof, applicant's motion to dismiss for failure to state a claim is denied.

Leave to Amend

Amendments to pleadings in inter partes proceedings are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). After a responsive pleading has been filed, a party may amend its pleading only by written consent of every adverse party, or by leave of the Board. Leave shall be freely given when justice so requires. *See* Fed. R. Civ P. 15(a). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See* TBMP § 507.01 (2d ed. rev. 2004). *See also Hurley International LLC v. Volta,* 82 USPQ2d 1339, 1341 (TTAB 2007). The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment.

In this case, although opposer argues that the original pleading is sufficient to withstand a motion to dismiss for failure to state a claim, he also requests leave to amend to correct any defects, to delete extraneous matter, and to include allegations of common law rights. Thus, it appears

that opposer seeks to amend so as to set forth clarifications and/or additional allegations which are or may be relevant to the merits of this case. Moreover, inasmuch as opposer has sought leave to amend at an early stage in this proceeding, prior to the deadline for the parties' discovery conference and the opening of discovery, there has been little delay, and insubstantial prejudice to applicant.

In view thereof, opposer's request for leave to file an amended pleading is granted.

Opposer is allowed twenty (20) days from the mailing date of this order in which to file an amended notice of opposition, failing which the case will proceed on the original notice.[4] Applicant is allowed thirty (30) days from the date of service of the amended notice of opposition in which to answer or otherwise plead in response to the amended notice of opposition.

Schedule

Proceedings are resumed. Conference, discovery, disclosure and trial dates are reset as follows:

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[4] The notice of opposition provides sufficient detail to give fair notice of the basis for opposer's claim inasmuch as the ESTTA cover sheet specifically asserts priority and likelihood of confusion as the ground for opposition, and it is clear from the pleading that opposer's claim of priority is based on his ownership of a previously issued registration. However, to the extent that any amended pleading includes allegations of common law rights, opposer must also plead, if accurate, priority of use with respect to those rights. *See* TBMP § 309.03(c)(2d ed. rev. 2004).

Opposer will note that the preferred practice would have been to file his proposed amended notice of opposition concurrently with his brief in response to applicant's motion to dismiss, inasmuch as doing so would have advanced this proceeding in a more expeditious manner. *See* TBMP § 503.03 (2d ed. rev. 2004).

Deadline for Discovery Conference	**1/19/2010**
Discovery Opens	**1/19/2010**
Initial Disclosures Due	**2/18/2010**
Expert Disclosures Due	**6/18/2010**
Discovery Closes	**7/18/2010**
Plaintiff's Pretrial Disclosures	**9/1/2010**
Plaintiff's 30-day Trial Period Ends	**10/16/2010**
Defendant's Pretrial Disclosures	**10/31/2010**
Defendant's 30-day Trial Period Ends	**12/15/2010**
Plaintiff's Rebuttal Disclosures	**12/30/2010**
Plaintiff's 15-day Rebuttal Period Ends	**1/29/2011**

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.