

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

coggins

Mailed: June 20, 2012

Opposition No. 91197005

Gold Rush Brands, LLC

v.

Pan Am World Airways, Inc.

By the Board:

This case comes up on applicant's motion (filed January 17, 2012) to dismiss the amended notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6). Opposer has filed a brief in opposition thereto.

Background

On September 20, 2012, opposer filed a notice of opposition against subject application Serial No. 77931658 for the mark PAN AM (and design) for use in connection with "transportation of passengers and freight."¹ Opposer alleged fraud and deceptiveness as grounds for the

¹ Application Serial No. 77931658 was filed February 9, 2010, in the name of Pan Am World Airways, Inc., under § 1(b) of the Trademark Act. The mark consists of the outline of a globe with the words "PAN AM" across it. Color is not claimed as a feature of the mark.

opposition, under the general theory that applicant does not exist as a legal entity. Prior to filing an answer, applicant filed with the Board an unconsented motion to amend applicant's name as that name identifies applicant in the subject application. On December 12, 2011, the Board issued an order deferring consideration of applicant's unconsented motion to amend applicant's name until final decision or until the case is decided upon summary judgment; struck opposer's allegations of fraud and deceptiveness from the notice of opposition; and allowed opposer time in which to submit an amended notice of opposition that properly alleges fraud and/or deceptiveness as a ground for opposing registration of the subject application. Opposer then filed an amended notice of opposition, and the outstanding motion to dismiss followed.²

Motion to Dismiss

A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the complaint. To withstand a motion to dismiss for failure to state a claim in a Board opposition proceeding, the plaintiff need only allege such facts as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing the subject application. *Lipton Industries, Inc. v. Ralston*

² Applicant's change of correspondence address (filed January 17, 2012) is noted and entered.

Purina Co., 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010).

For purposes of determining the motion, opposer's amended pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(e). All of opposer's well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to opposer. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993).

Standing

Opposer alleges facts that demonstrate it has a real interest, that is, a personal stake, in opposing registration of applicant's mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Opposer, in addition to alleging that it owns broad rights to the mark PAN AM internationally (para. 1), has alleged that it

filed an application for the mark PAN AM (and design) for use in connection with "transportation of goods, passengers and travelers by air," and that its application was refused registration on the basis of likelihood of confusion with applicant's mark (para. 3). These allegations are sufficient to allege standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, supra.*; and *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) (the filing of opposer's application and the Office's action taken in regard to that application provides opposer with a basis for pleading its standing). Indeed, applicant does not contend otherwise; instead, applicant directs its motion to opposer's amended ground for opposition.

Ownership

As its sole amended ground for opposition, opposer alleges that applicant is not, and was not at the time of filing the application, the rightful owner of the involved mark (para. 9). The underlying basis for this claim is that applicant does not exist as a legal entity (para. 4), applicant filed the application in the wrong name (para. 5), and no valid ground exists for amending the application to the correct owner's name (para. 9).

When construing opposer's allegations liberally, accepting them as true and in a light most favorable to

opposer, the Board determines that opposer has clearly and sufficiently stated a claim that applicant is not the rightful owner of the mark.

In its motion to dismiss, applicant argues that the determination of the ownership issue is properly suited for disposition on applicant's (deferred) motion to amend. The Board agrees, and reminds applicant that determination of its motion to amend is appropriate at either final hearing or when the case is decided upon summary judgment -not upon a motion to dismiss for failure to state a claim. See TBMP §§ 503.02 and 514.03 (3d ed. rev. 2012). Many of applicant's arguments relate to the merits of opposer's amended claim rather than to the sufficiency of the claim and as such are inappropriate on a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6).

Applicant's argument that opposer was permitted (by the Board's December 12, 2012, order) to amend the notice of opposition to allege only fraud or deceptiveness is unavailing. Opposer's amended notice of opposition is essentially based on the same set of facts alleged in the original notice of opposition; the major difference being the alleged ground - that is, that applicant is not the rightful owner of the mark - is now properly identified instead of couched in terms of fraud or deceptiveness.

In view thereof, applicant's motion to dismiss is denied. Applicant is allowed until July 19, 2012, in which to file an answer to the amended notice of opposition.

Schedule

Proceedings are resumed, and dates are reset on the following schedule.

Time to Answer	7/19/2012
Deadline for Discovery Conference ³	8/18/2012
Discovery Opens	8/18/2012
Initial Disclosures Due	9/17/2012
Expert Disclosures Due	1/15/2013
Discovery Closes	2/14/2013
Plaintiff's Pretrial Disclosures	3/31/2013
Plaintiff's 30-day Trial Period Ends	5/15/2013
Defendant's Pretrial Disclosures	5/30/2013
Defendant's 30-day Trial Period Ends	7/14/2013
Plaintiff's Rebuttal Disclosures	7/29/2013
Plaintiff's 15-day Rebuttal Period Ends	8/28/2013

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.

³ In view of the apparently narrow issue to be determined in this proceeding, the parties are encouraged, during the mandatory settlement and discovery conference, to discuss shortening the discovery period and employing other efficiencies so this case may be quickly and efficiently resolved.