

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

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Mailed: June 28, 2011

Opposition No. 91197571
Opposition No. 91197573
Opposition No. 91197574

Chase Brass, LLC

v.

Sipi Metals Corp.

**Before Kuhlke, Wellington, and Lykos, Administrative
Trademark Judges:**

By the Board:

This case comes up on applicant's combined motions, filed January 3, 2011 in each consolidated opposition, to dismiss the false association claim pursuant to Fed. R. Civ. P. 12(b)(6) and for a more definite statement of the likelihood of confusion claim pursuant to Fed. R. Civ. P. 12(e). The motions have been fully briefed. The Board sua sponte addresses the sufficiency of applicant's counterclaim to cancel Registration Nos. 2474958 and 2479029, which are owned by a third party.

Sipi Metals Corp. filed three applications pursuant to Trademark Act Sec. 1(b) for variants of the same mark, all

Opposition Nos. 91197571, 91197573, and 91197574

to be used on the same goods, namely "bronze and bronze alloy in bars, billets and sheets for use in manufacturing by machining, casting or forging."

App. Serial No. 77947606 ¹ (Opp. No. 91197571)	Application Serial No. (Opp. No. 91197573)	Application Serial No. (Opp. No. 91197574)
ECOBRONZE	ECO BRONZE	ECO-BRONZE

Chase Brass, LLC filed an ESTTA notice of opposition comprising the ESTTA notice of opposition form and nine numbered allegations which are essentially the same for each proceeding. The ESTTA form lists Trademark Act Sec. 2(a), 2(d), and 43(c) as grounds for opposition and cites Registration Nos. 2474958 for the mark ECOBRASS for "copper and copper alloy in bars, billets and sheets for use in future manufacturing by machining, casting or forging" and 2479029 for the mark ECO BRASS for "copper alloy in the nature of brass in bars, billets and sheets for use in future manufacturing by machining, casting and forging."²

In each proceeding the attached numbered paragraphs allege that applicant seeks registration of its respective marks (¶1); that opposer's licensor Sambo registered the

¹ App. Serial No. 77947606 is the basis for International Registration No. 1046194 issued July 30, 2010.

² On April 1, 2008, original registrant Sambo Copper Alloy Co., Ltd. merged with Mitsubishi Shindoh Co., Ltd., and on May 26, 2011, the merger was recorded with the Office Assignment Branch (Registration No. 2474958 at Reel 4549, Frame 0529, and Registration No. 2479029 at Reel 4549/0495).

Opposition Nos. 91197571, 91197573, and 91197574

pleaded registrations for ECO BRASS and ECOBRASS prior to applicant's filing of its application (¶2-3); that opposer has a license to use the registered marks (¶4); that opposer used the mark ECO BRASS for "copper alloys in rods for use in, among other things, manufacturing by machining, casting and forging" prior to applicant's filing of its application (¶5); that opposer's use of ECO BRASS predates applicant's filing of its application and any actual use applicant may have (¶6); and that applicant should be denied registration based on opposer's priority of use (¶7).

With respect to Paragraph 8, the issue to be decided is whether the allegations set forth below, in combination with those summarized above, state legally sufficient claims under Trademark Rule Sec. 2(a) and (d).³ Paragraph 8 states:

The mark sought to be registered by Applicant is confusingly similar to the ECO BRASS mark and the use of ECOBRONZE by Applicant is likely to cause confusion or mistake in the minds of the public and lead the public and prospective purchasers to believe that applicant's goods are those of Sambo and/or Chase or are endorsed, sponsored, or otherwise affiliated or connected with Sambo and/or Chase, or that Sambo's and/or Chase's goods and services are associated with applicant, contrary to 15 U.S.C. §1052(d), and all to the

³ Paragraph 9 alleges that applicant's use and registration dilutes the distinctiveness of the famous ECO BRASS mark. Applicant's motion sought dismissal of the dilution claim, and in its response, opposer voluntarily withdrew the dilution claim. Accordingly, the notice of opposition is amended to strike Paragraph 9, the dilution claim is no longer part of this consolidated proceeding, and applicant's motion is denied as moot with respect to that claim.

Opposition Nos. 91197571, 91197573, and 91197574

damage and injury of the purchasing public and to the damage and injury of Sambo and Chase.

To survive a motion to dismiss, 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*, _ U.S. _, 129 S.Ct. 1937, 1949 (2009) quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). The pleading is sufficient if it alleges plausible facts as would, if proved, establish that plaintiff is entitled to the relief sought, that is, that 1) plaintiff has standing to maintain the proceeding, and 2) a valid ground exists for denying or cancelling the registration. See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

Opposer's allegations that it uses the term ECO BRASS are sufficient to plead its standing. *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1873 n.2 (TTAB 1994) (plaintiff has standing "even if [its] use of the two pleaded marks is as a licensee or distributor for [the owner of the marks], for a plaintiff may have standing in a case brought under Section 2(d) of the Trademark Act even if it does not claim ownership of the assertedly similar mark, or the right to control its use.").

With respect to the Sec. 2(a) claim, a plaintiff asserting a claim that a mark falsely suggests a connection with persons living or dead, or institutions, must plead (i)

Opposition Nos. 91197571, 91197573, and 91197574

that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed. *Association pour la Defense et la Promotion de l'oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007) (citations omitted). The second factor has been construed to require that "the name claimed to be appropriated by the defendant must point uniquely to the plaintiff." *Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1424 (TTAB 2008). While we have not restricted our consideration to Paragraph 8, the notice of opposition considered in its entirety pleads none of the required elements set forth above.

In each proceeding applicant's motion to dismiss is granted with respect to the Sec. 2(a) claim to the extent that opposer is allowed until TWENTY DAYS from the mailing date of this order to file an amended notice of opposition properly asserting a Section 2(a) claim, failing which this

proceeding will go forward only as to the claim of priority and likelihood of confusion.

A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself. Fed. R. Civ. P. 12(e); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §505.01 (3rd ed. 2011). With respect to the Sec. 2(d) claim, applicant contends that a more definite statement is needed because the registered marks licensed to opposer specify that the copper alloy is in the shape of "bars, billets and sheets" but the notice of opposition alleges that opposer uses the mark on copper alloy in "rods", and thus applicant is not given sufficient notice of the rights claimed by opposer. The Board does not find the difference in the meaning of the terms ROD and BAR to be so great as to make the Sec. 2(d) claim ambiguous; and finds adequate notice of opposer's claim of priority and likelihood of confusion in connection with its use of the ECO BRASS mark on goods related to those with which applicant intends to use the mark. Because we find that the likelihood of confusion claim is sufficiently definite in each opposition, applicant's motion for a more definite statement is denied.

Inasmuch as applicant filed only a partial answer, applicant is allowed until FORTY DAYS from the mailing date of this order to file a substitute answer to the notice of opposition, or any amended notice of opposition, which complies with Fed. R. Civ. P. 8(b).⁴

The Board sua sponte addresses the counterclaim to cancel Registration Nos. 2474958 and 2479029 included in applicant's answer. The registrations are owned by a third party that is not a party to this proceeding. As set forth above, opposer explained that its use of the mark, which is the basis for its priority and likelihood of confusion claim, is through a license from the owner of the registered marks. Opposer may not rely on the Section 7(b) presumptions afforded to the owner of the registrations. Thus, to establish its claim, opposer must prove prior use of the mark, and likelihood of confusion between the goods in the application and the rods for which opposer alleges use. The fact that a third party related to the plaintiff, such as a parent or licensor of the plaintiff, may also have an interest in a mark relied on by the plaintiff does not

⁴ Inasmuch as its partial answer and counterclaim included exhibits, applicant is advised that - with the exception of pleaded registrations - no consideration is given to exhibits attached to pleadings. Trademark Rule 2.122(c) ("Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.").

Opposition Nos. 91197571, 91197573, and 91197574

mean that the third party must be joined as a party plaintiff. See *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992) (respondent's motion to join petitioner's licensor as party plaintiff denied); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §512 (3d ed. 2011).

Applicant asserts, as an "affirmative defense", that the owner of the registrations is an indispensable party who should be joined pursuant to Fed. R. Civ. P. 19(a), so that applicant cannot be subject to "double, multiple or otherwise inconsistent obligations" based on the registrations. However, cancellation of the registrations would not preclude opposer's assertion of its common law rights in this opposition, and applicant prevailing in the opposition would not mandate cancellation of Registration Nos. 2474958 and 2479029, owned by a third party.⁵ Thus, we find Fed. R. Civ. P. 19(a) inapplicable here, and applicant must bring any claims for cancellation against the owner of the registrations in a separate proceeding.

In sum, applicant's motion to dismiss is granted with respect to Trademark Act Sec. 2(a) and denied as moot with respect to Sec. 43(c); applicant's motion for a more definite statement with respect to Sec. 2(d) is denied.

⁵ We note that the notice of opposition does not allege that opposer is the exclusive licensee of the registered marks.

Opposition Nos. 91197571, 91197573, and 91197574

Applicant's proposed counterclaim to cancel the third party registrations is denied, and should not form any part of the substitute answer.

Proceedings herein are resumed and dates are reset below.

Deadline for Discovery Conference	9/15/2011
Discovery Opens	9/15/2011
Initial Disclosures Due	10/15/2011
Expert Disclosures Due	2/12/2012
Discovery Closes	3/13/2012
Plaintiff's Pretrial Disclosures Due	4/27/2012
Plaintiff's 30-day Trial Period Ends	6/11/2012
Defendant's Pretrial Disclosures Due	6/26/2012
Defendant's 30-day Trial Period Ends	8/10/2012
Plaintiff's Rebuttal Disclosures Due	8/25/2012
Plaintiff's 15-day Rebuttal Period Ends	9/24/2012

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

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