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

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Mailed: December 19, 2011

Opposition No. 91201856

PRODEEN, INC.

v.

CARD TECH INTERNATIONAL, LLLP

Before Holtzman, Kuhlke and Cataldo,
Administrative Trademark Judges.

By the Board:

Card Tech International, LLLP ("applicant") seeks to register the mark PROVEN PRODUCTS and design (shown below) for "magnetic head cleaners" in International Class 9.[1]

PROVENProducts

ProDeen, Inc. ("opposer") filed a notice of opposition, listing on the ESTTA[2] cover sheet thereto the following grounds: 1) immoral or scandalous matter, pursuant to Trademark Act § 2(a); 2) deceptiveness, pursuant to Trademark Act § 2(a); 3) priority and likelihood of confusion, pursuant to Trademark Act § 2(d); and 4) "It is a business name that is currently in litigation." Opposer does not plead ownership of a trademark,

[1] Application Serial No. 85238971, filed February 10, 2011, asserting a bona fide intent to use the mark in commerce pursuant to Trademark Act § 1(b).

either by way of common law, or by ownership of a trademark registration or application. The notice of opposition reads in its entirety:

> 1. The requesting party, Card Tech, is currently in litigation with the former owner of Proven Products.
>
> 2. All rights remain with the current owner until resolution of the litigation filed in US. (sic) Federal Court.
>
> 3. The requesting party is trying to circumvent the legal system with this application by fraudulently and immorally representing to the USPTO that they (sic) have a legal and financial right to this trademark.

The notice of opposition is signed by "Sharyn Provenzano President of ProDeen, Inc. formerly DBA Proven Products."

In lieu of filing an answer, applicant moved to dismiss the opposition under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief may be granted.[3]

In response, opposer filed a copy of the answer and counterclaim filed by "Sharyn Provenzano, a.k.a. Sharyn Nappi, an individual; and Prodeen, Inc." in a civil action filed in the United States District Court for the Central District of California, captioned *Card Tech International, LLLP v. Sharyn*

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[2] ESTTA is the Board's online filing system, Electronic System for Trademark Trials and Appeals.

[3] Concurrently with its motion to dismiss, applicant submitted exhibits. Said exhibits have been given no consideration. *See Compagnie Gervais Danone v. Precision Formulations LLC,* 89 USPQ2d 1251, 1255-56 (TTAB 2009) (the Board generally will not convert motions to dismiss that refer to matters outside the pleadings into motions for summary judgment, if such motions are filed before the moving party serves its initial disclosures).

Provenzano, a.k.a. Sharyn Nappi, an individual; and Prodeen, Inc., Case No. CV11-02434 DSF (PLAX).

The motion to dismiss is fully briefed.

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. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). *See also* TBMP § 503.02 (3d ed. 2011). 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). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, 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,

1041 (Fed. Cir. 1993); *Otto Int'l Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1862 (TTAB 2007).

Standing

We turn first to the threshold issue of standing. A party has standing to cancel a registration if it can demonstrate a "real interest" in the proceeding and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark remains registered. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To plead a "real interest," opposer must allege a "direct and personal stake" in the outcome of the proceeding. *See Ritchie v. Simpson,* 50 USPQ2d at 1026. An opposer must show "a personal interest in the outcome of this case beyond that of the general public." *See Estate of Biro v. Bic Corp.,* 18 USPQ2d 1382, 1384 (TTAB 1991). If a plaintiff can show standing on one ground, it has the right to assert any other ground in an opposition. *See Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), citing *Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983). *See also* TBMP § 309.03(b) (3d ed. 2011).

The notice of opposition does not set forth allegations which, if proved, would establish that opposer has a direct and personal stake in the outcome of this opposition, or that opposer has a belief with a reasonable basis in fact that it

will be damaged by registration of applicant's mark. In particular, opposer's insertions of "PROVEN PRODUCTS" and "Magnetic Head Cleaning Cards" on the ESTTA cover sheet under the heading "Marks Cited by Opposer as Basis for Opposition" do not constitute specific factual allegations that demonstrate that opposer has, for example, a proprietary right in the applied-for mark, a right to use the mark in commerce, prior use of the mark as a trademark or in a manner analogous to trademark use, or a real commercial interest (*e.g.* as a manufacturer, a distributor, sole licensee) as a competitor of applicant in using the mark on goods that are the same as or similar to those identified in the application.

Within the body of the complaint, opposer merely alleges that applicant and "the former owner of Proven Products," a company which the signatory line identifies as the former name of opposer ProDeen, Inc., are "in litigation." While this suggests that there is a previous and/or ongoing association, connection or relationship between applicant and opposer, the pleading fails to set forth factual allegations that define and demonstrate the exact nature of the association, connection or relationship, and that establish the manner in which or reason by which this conferred or confers rights in the mark upon

opposer, proprietary or otherwise.[4]

In view thereof, opposer has not set forth in its pleading allegations which, if proven, would establish its standing to bring this opposition proceeding.

Grounds

The notice of opposition does not set forth allegations that sufficiently plead any of the grounds that opposer listed in the ESTTA filing cover sheet, or any other ground for opposition.

For example, to state a claim under Trademark Act § 2(d), opposer must sufficiently allege that 1) it has standing; 2) it has registered or previously used a mark; and 2) contemporaneous use of its and applicant's respective marks on or in connection with their respective goods and/or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Moreover, opposer's statement on the ESTTA cover sheet, "(I)t is a business name that is currently in litigation," does not constitute a cognizable ground for opposition. Rather, the Board construes this statement as an

[4] Similarly, to the extent that opposer intended to assert, by way of filing in response to the motion to dismiss a copy of the answer and counterclaim filed in the civil action, that it has rights in the applied-for mark for the same goods as those identified in the application, specific factual allegations of this are not set forth in the notice of opposition.

amplification of opposer's assertion that there is pending litigation involving one or both parties.[5]

In summary, opposer has failed to sufficiently plead its standing, and has failed to sufficiently plead at least one statutory ground for opposing applicant's applied-for mark. In view of these findings, applicant's motion to dismiss for failure to state a claim upon which relief may be granted is hereby granted.

Leave to amend

Upon granting a motion to dismiss, the Board generally will allow the plaintiff an opportunity to file an amended pleading, as appropriate. *See* TBMP § 503.03 (3d ed. 2011).

Inasmuch as the Board finds it appropriate to do so in this case, opposer is allowed until thirty (30) days from the mailing date of this order in which to file an amended notice of opposition which sufficiently sets forth its standing, as well as at least one well-pleaded ground for opposition, failing which this proceeding will be dismissed with prejudice, and the Board will give no consideration to the issue of suspension of this proceeding (discussed further below).[6]

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[5] The Board addresses the referenced pending civil matter in more detail below in its discussion of the issue of suspension of this opposition under Trademark Rule 2.117(a).

[6] Opposer is advised that Fed. R. Civ. P. 11 is applicable to all pleadings filed in Board inter partes proceedings. *See* Fed. R. Civ. P. 2.116(a); TBMP § 318 (3d ed. 2011).

Suspension

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board proceeding. Specifically, Trademark Rule 2.117(a) reads:

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a)(3d ed. 2011); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the district court. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d

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In an opposition proceeding, the Board's jurisdiction is limited to determining the right to registration. The Board does not have jurisdiction over the right to use, infringement or unfair competition claims. Whether a party's use of its/his/her mark, or of any other mark, is otherwise appropriate is beyond the Board's jurisdiction. *See* TBMP § 102.01 (3d ed. 2011), and cases cited therein.

Also, opposer shall note the requirements for all motions, briefs and papers filed in Board proceedings, and is referred, as appropriate, to Trademark Rule 2.126 ("Form of submissions to the Trademark Trial and Appeal Board").

1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.,* 650 F Supp 563, 2 USPQ2d 1208 (D.Minn 1986). Suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. See TBMP § 510.02(a) (3d ed. 2011).

In view of the document filed by opposer in response to the motion to dismiss, the Board must ascertain whether suspension of this opposition is appropriate. Accordingly, if opposer files an amended pleading, opposer is also directed to file, within the same thirty (30) days from the mailing date of this order, a copy of the complaint filed in the pending civil matter.[7]

To be clear, the filing of a copy of the civil action complaint does not constitute the filing of an amended notice of opposition in this Board proceeding. To avoid dismissal of this proceeding, opposer must separately file herein an amended notice of opposition within the time allowed.

Schedule

This opposition proceeding remains suspended pending opposer's filings, as allowed above.

Information for pro se party

[7] Said submission need not be a certified copy, but rather may be a clear, legible photocopy.

It is apparent from opposer's filings that opposer is not familiar with applicable substantive laws and rules of procedure that govern inter partes proceedings before the Board. While Patent and Trademark Rule 11.14 permits any person to represent itself, it is strongly recommended that a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

All parties, including pro se parties, are bound by Fed. R. Civ. P. 11 and Patent and Trademark Rule 11.18. *See* TBMP § 106.02 (3d ed. rev. 2011). The Board requires compliance with all applicable procedural and substantive authorities, as appropriate.

Every motion, paper or communication filed with the Board must include proof of service of a copy on opposing counsel or party, in compliance with Trademark Rule 2.119(a) and (b). The Board may decline to consider any motion, paper or communication filed herein which does not include proof of service, such as a Certificate of Service. The Board's Manual of Procedure (TBMP) sets forth the following suggested format for a Certificate of Service:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail,

postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel or party). *See* TBMP § 113.03 (3d ed. 2011).

It is recommended that opposer be familiar with the Trademark Rules of Procedure, the Federal Rules of Civil Procedure that apply to Board proceedings (*see* Trademark Rule 2.116(a)), and the Board's Manual of Procedure ("TBMP"). Strict compliance with these authorities, as applicable, is required of all parties throughout all stages of an inter partes proceeding, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent,* 81 USPQ2d 1212, n.2 (TTAB 2006).

The Board's September 29, 2011 order instituting this proceeding also includes information with which opposer should be familiar.