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

MBA

Mailed: April 24, 2012

Opposition No. 91202245

Facebook, Inc.

v.

Jason A. Fedore

Opposition No. 91202494

Jason A. Fedore

v.

Facebook, Inc.

Before Bucher, Zervas and Bergsman, Administrative Trademark Judges

By the Board:

These proceedings now come up for consideration of Facebook, Inc.'s ("Facebook") motion to dismiss Opposition No. 91202494 under Fed. R. Civ. P. 12(b)(6), filed December 19, 2011, and Jason A. Fedore's ("Fedore") motion, filed March 1, 2012, to suspend related Opposition No. 91202245, pending resolution of Facebook's motion to dismiss in Opposition No. 91202494. Both motions are contested.

Background

Fedore seeks registration of FACEMEETING, in standard characters, for "Dating services, namely, providing an on-line computer database featuring single people interested in meeting other single people" ("Fedore's Involved Application").[1] In Opposition No. 91202445, Facebook alleges prior use and registration of FACEBOOK and variations thereof, for, *inter alia*, "Social introduction, networking and dating services," and that use of the mark in Fedore's Involved Application would be likely to cause confusion with, and dilute, Facebook's marks. Facebook also pleads ownership of several pending applications, including an application to register FACEBOOK, in standard characters, for "Social introduction, networking and dating services …" ("Facebook's Involved Application").[2] In his answer, Fedore denies the salient allegations in Facebook's notice of opposition.

In Opposition No. 91202494, Fedore opposes registration of the mark in Facebook's Involved Application. Specifically, Fedore cites the allegations in Opposition No. 91202445, and alleges that he "will be or is likely to be injured if Facebook acquires a registration of 'FACEBOOK'

[1] Application Serial No. 85196484, filed December 13, 2010 alleging first use in commerce on April 12, 2008.
[2] Application Serial No. 85147955, filed October 7, 2010 based on an alleged intent to use the mark in commerce.

for 'dating services' because the question of priority for the same competing respective marks and usages is at issue in" Opposition No. 91202445. Notice of Opposition ¶ 4. Fedore specifically asserts that 15 U.S.C. § 1063 "does not require an opposer to plead confusing similarity, but only damage by standing and a real interest in the proceeding and registration." Id. ¶ 8.

Consolidation

Before addressing the pending motions, it is clear that the two proceedings involve the same parties and marks, and common questions of law and fact. It is therefore appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, e.g., Wright & Miller, Federal Practice and Procedure: Civil § 2383 (2004); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).

Accordingly, the above-referenced opposition proceedings are hereby consolidated and may be presented on the same record and briefs. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989), and Hilson Research Inc. v. Society for Human Resource

Management, 26 USPQ2d 1432 (TTAB 1993). The Board file will be maintained in **Opposition No. 91202245** as the "parent" case. The parties should no longer file separate papers in connection with each proceeding (except for the answer in Opposition No. 91202494). Instead, only a single copy of each paper should be filed by the parties in the parent case, and each paper should bear the case caption as set forth above.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

If the parties to these proceedings are also parties to other Board proceedings involving related marks, or, during the pendency of this proceeding, become parties to such proceedings, they are ordered to notify the Board immediately, so that the Board can consider further consolidation of the proceedings.

Motions to Dismiss Opposition No. 91202494 and to Suspend Opposition No. 91202245

Facebook alleges that Opposition No. 91202494 should be dismissed because Fedore has failed to state a claim upon which relief may be granted. Specifically, Facebook argues that while Fedore has pled priority, he must also allege "statutory grounds for the opposition," but has not done so.

Facebook also points out that in his answer in Opposition No. 91202245, and in his notice of opposition in Opposition No. 91202494, Fedore claims that the parties' marks are "distinct" and not confusingly similar.

In response, Fedore reiterates that he does not believe that the parties' marks are confusingly similar. Nevertheless, Fedore argues that "[i]t is **FACEBOOK's** assertion in [Opposition No. 91202245] that creates the real interest, claim or controversy upon which this [Opposition No. 91202494] is based" (emphasis in original). According to Fedore, "neither the statute nor the TTAB require the assertion of 'confusing similarity' to maintain an opposition proceeding," and it would be "unfair" to not allow Fedore to challenge Facebook's Involved Application now, prior to its potential registration, which would "confer upon Facebook specific statutory rights and presumptions pursuant to the Lanham Act."

In order to survive Facebook's motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), Fedore's notice of opposition must allege facts which would, if proved, establish that: (1) Fedore has standing to maintain the proceeding; and (2) there is a valid ground for opposing registration of Facebook's mark. Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); TBMP § 503.02 (3d ed. 2011). With respect to standing,

Fedore must allege facts which, if ultimately proven, would establish that Fedore has a real interest in the proceeding. Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); Lipton Industries, Inc. v. Ralston Purina Co., 213 USPQ 185, 189 (TTAB 1982). With respect to whether Fedore has alleged a valid ground for opposition, his "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)). Furthermore, "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." Id., 556 U.S. at 662, 129 S.Ct. at 1949 (citing Twombly, 550 U.S. at 555).

Here, Fedore has adequately alleged his standing by alleging that he is the defendant in Opposition No. 91202245. See, e.g., Anthony's Pizza & Pasta International Inc. v. Anthony's Pizza Holding Co., 95 USPQ2d 1271, 1274-75 (TTAB 2009) ("Defendant has standing to cancel plaintiff's pleaded registration by virtue of being the defendant in the consolidated proceeding, and the fact that plaintiff has asserted its registration against defendant"); Ohio State University v. Ohio University, 51 USPQ2d 1289, 1293 (TTAB 1999); TBMP § 309.03(b) (standing established where

"[d]efendant has relied on its ownership of its application or registration in another proceeding between the parties, or defendant has asserted a likelihood of confusion in another proceeding between the parties involving the same marks"). Indeed, Opposition No. 91202494 is analogous to a counterclaim, and these now-consolidated proceedings will be scheduled in the same manner as a claim by Facebook in Opposition No. 91202245, with a counterclaim by Fedore in Opposition No. 91202494.

Turning next to whether Fedore has alleged a valid ground for opposing Facebook's Involved Application, we find that he has. In fact, a "plaintiff may plead likelihood of confusion directly or hypothetically." TBMP § 309.03(c). Such a claim may consist of allegations that if, as the defendant contends, "plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then the registration sought by defendant should be refused … because plaintiff has priority of use." Id. That is, in essence, what Fedore alleges in Opposition No. 91202494, by asserting prior use of his mark. Cf., Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696, 1698 (TTAB 1987) ("applicant could have raised the priority issue in a counterclaim by pleading likelihood of confusion hypothetically,

notwithstanding the inconsistency of that pleading with its position in the opposition”).

For all of these reasons, Facebook’s motion to dismiss Opposition No. 91202494 is hereby **DENIED**. Fedore’s motion to suspend Opposition 91202245 is hereby **DENIED AS MOOT**, both because we have now denied Facebook’s motion to dismiss, and because Opposition No. 91202494 is effectively a counterclaim such that both oppositions may proceed simultaneously in the manner of a claim by Facebook with a counterclaim by Fedore.

Conclusion

Facebook’s motion to dismiss and Fedore’s motion to suspend are both denied. Proceedings in Opposition No. 91202245 are resumed. Answer, conferencing, disclosure, discovery, trial and other dates are hereby reset as follows:

Facebook’s Answer Due in Opposition No. 91202494	May 18, 2012
Deadline for Discovery Conference	June 17, 2012[3]
Discovery Opens	June 17, 2012
Initial Disclosures Due	July 17, 2012
Expert Disclosures Due	November 14, 2012
Discovery Closes	December 14, 2012
Facebook's Pretrial Disclosures	January 28, 2013
30-day testimony period for Facebook's testimony to close	March 14, 2013

[3] In the event the parties’ discovery conference in Opposition No. 91202245 sufficiently addressed all required topics with respect to Opposition No. 91202494, the parties need not hold another discovery conference.

Fedore's Pretrial Disclosures	March 29, 2013
30-day testimony period for Fedore, and for Fedore in the counterclaim to close	May 13, 2013
Facebook's Rebuttal Disclosures Due	May 28, 2013
30-day testimony period for Facebook in the counterclaim and rebuttal testimony for Facebook to close	July 12, 2013
Fedore's Rebuttal Disclosures Due	July 27, 2013
15-day rebuttal period for Fedore in the counterclaim to close	August 26, 2013
Brief for Facebook due	October 25, 2013
Brief for Fedore due	November 24, 2013
Brief for Facebook in the counterclaim and reply brief, if any, for Facebook due	December 24, 2013
Reply brief, if any, for Fedore in the counterclaim due	January 8, 2014

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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