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

coggins

Mailed: October 1, 2012

Opposition No. 91203541

Andre D. Rossouw

v.

Google Inc.

By the Board:

This case comes up on applicant's motion (filed March 6, 2012) to dismiss the notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6),[1] or, in the alternative for a more definite statement, or, in a further alternative, to strike; and opposer's motion (filed April 6, 2012) for leave to amend his brief in opposition to applicant's motion.[2]

Procedural Issues

Applicant included with its motion to dismiss matter outside the pleadings. Opposer included with his brief in

[1] Although applicant does not cite to Fed. R. Civ. P. 12(b)(6), the motion is clearly one to dismiss for failure to state a claim upon which relief can be granted and will be treated as such.

opposition to the motion, and with his amendment thereto, matter outside the pleadings. The matter has been excluded and not considered for purposes of determining the motion. *See* TBMP § 503.04 (3d ed. rev. 2012); and *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 (TTAB 2009).

Opposer's motion for leave to amend his earlier brief states that applicant "would like to amend evidence thereof." Opposer's motion appears to inappropriately argue the merits of the case and include matters outside the pleadings. *See* TBMP § 503.02 (an opposer "served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether [opposer] can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment ...."), *citing Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); and TBMP § 503.04 (Matters Outside the Pleading Submitted on Motion to Dismiss). In view thereof, opposer's motion for leave to amend is denied, and the substantively

[2] Applicant's change of correspondence address (filed April 27, 2012) is noted and entered.

inappropriate amendment to the original (and already amended[3]) brief has not been considered.[4]

Opposer's motion for leave to amend includes proof of service upon counsel for applicant by electronic means. Opposer states that applicant itself agreed to service by email, and that opposer will continue to use email service unless otherwise instructed by the Board. Trademark Rule 2.119(b)(6) allows for service by email only when mutually agreed upon by the parties. Inasmuch as applicant is now represented by counsel, and service must be made upon applicant's counsel, opposer may not use electronic service upon applicant's counsel unless counsel agrees. *See* Trademark Rules 2.119(b) and 2.119(b)(6). In the absence of an agreement, opposer must utilize another method of service available under 2.119(b).

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

[3] On March 11, 2012, opposer filed an amendment to his brief in opposition; then, on April 6, 2012, opposer filed the motion for leave to amend the brief (which is, in essence, a further amendment to the brief in opposition). The March 11th amendment was recognized by the Board's order dated March 16, 2012. Inasmuch as the March 11th amendment was filed within the time permitted under Trademark Rule 2.127(a) for filing a brief in opposition, the original amendment has been considered only to the extent that it does not contain matters outside the pleadings.

[4] The Board notes that, had it considered opposer's second amendment, the outcome of the motion to dismiss would be the same. The Board must look to the legal sufficiency of the complaint - not to allegations in a brief in support thereof.

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 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, the 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.*, *supra*, 26 USPQ2d at 1041.

When filing the notice of opposition via ESTTA, opposer checked a box to indicate that his ground for opposition against Class 45 of application Serial No. 85358119 is priority

and likelihood of confusion under Trademark Act §2(d).[5] Opposer attached to the ESTTA cover form a table of contents, a notice of opposition, a signed receipt for the opposition documents, a letter of protest memorandum, a cease and desist letter, and a market research appendix.[6]

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by registration of the opposed mark (i.e., opposer's standing to maintain the proceeding), and (2) a short and plain statement of one or more grounds for opposition. *See* Trademark Rule 2.104(a); and *Consolidated Natural Gas Co. v. CNG Fuel Sys., Ltd.*, 228 USPQ 752 (TTAB 1985). The elements of a claim should be stated simply, concisely, and directly. *See* Fed. R. Civ. P. 8(a). However, the pleading should include enough detail to give applicant fair notice of the basis for each claim. *See McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985). *See also Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988), and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). The current notice of opposition is a rambling document - more in the nature of a brief on the case

[5] Application Serial No. 85358119 is a five-class application, but opposer is challenging only Class 45; the ESTTA form identifies Class 45 as the sole class affected by the opposition.

[6] Pursuant to Trademark Rule 2.122(c), opposer's exhibits attached to the notice of opposition are not in evidence.

than a complaint - and does not comply with these pleading standards. Nonetheless, the Board has reviewed the notice of opposition, and, in determining the motion to dismiss, has construed opposer's allegations in the light most favorable to opposer.

Standing

A party has standing to oppose a particular application when it demonstrates that it has a real interest in the proceeding, and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Herbko Int'l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

It is difficult to determine from the notice of opposition who the opposer is and who is claiming that it will be damaged. While the ESTTA form names Andre D. Rossouw (hereafter "Rossouw") as opposer, the caption of the attached notice of opposition names Googabox World Incorporated (hereafter "GWI") as opposer. The Board considers the ESTTA filing form and the attachment thereto, i.e., the notice of opposition, to comprise a single document. *See PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005). In view thereof, opposer's filing creates an ambiguity as to the identity of the actual opposer.

As applicant points out, GWI did not file either a timely notice of opposition or a request for an extension of time to oppose. *See* Motion, p. 9, fn. 4. Office records confirm this fact.[7] As applicant also points out, it appears from the notice of opposition that GWI claims that it will be damaged by registration of the mark in the subject application. In response, opposer argues that it "is clear" that he is the owner of the mark cited as a basis for the opposition, and that if applicant had researched Office records for that cited mark, opposer would have easily discovered that Rossouw is the owner of the mark (and presumably, therefore, the opposer). However, although opposer listed U.S. Registration No. 3541298 on the ESTTA cover form as the "mark cited by opposer as basis for opposition," opposer did not actually plead ownership of that registration.

Due to the ambiguity within the four corners of the notice of opposition as to whether Rossouw or GWI is the opposer in this proceeding, it is difficult to determine whether opposer has appropriately alleged facts that demonstrate he or it has a real interest, that is, a personal stake, in opposing registration of applicant's mark.

[7] The Board may look to Office records for objective facts not subject to proof when determining a motion under Fed. R. Civ. P. 12(b)(6). *See Compagnie Gervais Danone v. Precision Formulations LLC*, *supra*, 89 USPQ2d at 1256.

Grounds

As noted above, opposer checked a box to indicate that his ground for opposition against the subject application is priority and likelihood of confusion. It appears from the attached notice of opposition that opposer also attempted to allege dilution.

In order to properly state a claim of priority and likelihood of confusion, opposer must plead that (1) applicant's mark, as applied to its services, so resembles opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has priority of use. *See* Fed. R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As to priority, opposer has not alleged this element and none can be inferred since opposer did not claim ownership of the cited registration. *See, for example, King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, applicant did not allege any dates of use for his mark.

In order to properly state a claim of dilution, opposer must plead that his mark became famous prior to applicant's first use of the mark or applicant's filing date. *See General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011); *The Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001). As applicant correctly

points out, opposer has not alleged that his mark became famous prior to the earliest date on which applicant can rely.

To the extent opposer alleges "infringement" and "continued infringement" based on applicant's provision of search engine services, opposer is advised that the Board is empowered only to determine the right to register; questions of trademark infringement and unfair competition are not within the Board's jurisdiction. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994); TBMP § 102.01.

Conclusion

In view of the above analysis, applicant's motion to dismiss is granted.[8] However, the Board freely grants leave to amend pleadings if found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where the challenged pleading is the initial pleading. *See* TBMP § 503.03. Accordingly, opposer is allowed until October 26, 2012, to file an amended pleading that properly alleges his standing and a claim upon which, if proved, would allow him to prevail in this proceeding; failing which the opposition will be dismissed.[9]

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[8] In view thereof, applicant's alternative motions for a more definite statement and to strike are moot.

[9] While it is permissible for opposer to replead a proper dilution claim, the Board reminds opposer that "[f]ame for dilution purposes is difficult to prove … The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *See Toro Co. v. ToroHead Inc.*, *supra*, 61 USPQ2d at 1180. *See also Avery Dennison Corp. v. Sumpton*, 189 F.3d 1868, 51 USPQ2d 1801, 1805 (9th Cir. 1999)("The Federal Trademark Dilution Act of 1995 applies only to a very select class of marks - those with such powerful consumer

Opposer's complaint must comply with Fed. R. Civ. P. 8(a) and 10(b) which require a short and plain statement of the claims to be made in numbered paragraphs that are limited as far as practicable to a single set of circumstances. Applicant is allowed until November 26, 2012, to file an answer to the amended notice of opposition, if an amended notice is filed.

Schedule

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

Amended Notice of Opposition Due	**10/26/2012**
Answer Due	**11/26/2012**
Deadline for Discovery Conference	**12/26/2012**
Discovery Opens	**12/26/2012**
Initial Disclosures Due	**1/25/2013**
Expert Disclosures Due	**5/25/2013**
Discovery Closes	**6/24/2013**
Plaintiff's Pretrial Disclosures	**8/8/2013**
Plaintiff's 30-day Trial Period Ends	**9/22/2013**
Defendant's Pretrial Disclosures	**10/7/2013**
Defendant's 30-day Trial Period Ends	**11/21/2013**
Plaintiff's Rebuttal Disclosures	**12/6/2013**
Plaintiff's 15-day Rebuttal Period Ends	**1/5/2014**

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

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associations that even non-competing uses can impinge upon their value.").

oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

Counsel Recommended for Applicant

It is obvious from opposer's filings in this case that opposer is unfamiliar with many of the substantive and procedural details of Board proceedings. As mentioned in the Board's order dated March 16, 2012, the Board strongly encourages opposer to obtain trademark counsel who is familiar with Board proceedings. Whether or not he is represented by counsel, opposer will be expected to comply with all applicable rules and Board practices during the remainder of this case.