

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

GCP

Mailed: July 2, 2012

Opposition No. 91204897

John G. Marino

v.

Laguna Lakes Community  
Association, Inc.

**By the Trademark Trial and Appeal Board:**

Laguna Lakes Community Association, Inc. ("applicant") seeks to register the mark LAGUNA LAKES in standard characters for "association services, namely, promoting the interests of condominium association and homeowner associations; managing the business affairs of common community associations of HOAs and condominium associations, and promoting the use of and managing the maintenance of real estate." in International Class 35.<sup>1</sup>

John G. Marino ("opposer") has opposed registration of applicant's mark on the following grounds: (1) deceptiveness under Section 2(a) of the Trademark Act, (2) priority and likelihood of confusion under Section 2(d) of the Trademark

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<sup>1</sup> Application Serial No. 85411955, filed on August 31, 2011, based upon an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting October 6, 2003 both as the date of first use and the date of first use in commerce.

Act, (3) mere descriptiveness under Section 2(e)(1) of the Trademark Act, (4) geographic descriptiveness under Section 2(e)(2) of the Trademark Act, and (5) fraud.<sup>2</sup> In support of his asserted claims, opposer has pleaded that he has common law rights in the tradename MR. LAGUNA LAKES used in connection with his business of selling real estate in Laguna Lakes, a development in Fort Myers, Florida since 2005.

Opposer also alleges common law rights in the mark LAGUNA LAKES and that he has used the LAGUNA LAKES mark prior to applicant and as early as July 2005.

In lieu of filing an answer, applicant, on June 5, 2012, filed a motion to dismiss the opposition on the ground that opposer has failed to state any claims upon which relief may be granted under Fed. R. Civ. P. 12(b)(6). On June 28, 2012, opposer filed a response to applicant's motion to dismiss.<sup>3</sup>

We initially note that applicant's objections to opposer's notice of opposition are based, in part, to the proof of the allegations, not whether a claim has been sufficiently pleaded. It is well established that whether a plaintiff can actually prove its allegations is not a matter

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<sup>2</sup>The Board notes that opposer has identified each of these asserted grounds on the Notice of Opposition ESTTA filing cover page.

<sup>3</sup>By order dated June 22, 2012, the Board allowed opposer until June 29, 2012 in which to file and serve a response to applicant's motion.

to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. See *Libertyville Saddle Shop, Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of the case..."). Thus, contrary to applicant's contention that opposer's pleading should be dismissed because opposer cannot prove his asserted claims, we must judge the sufficiency of the pleading based on the pleading itself, and not on whether extrinsic evidence would prevent opposer from proving its case. In view thereof and after a careful review of the allegations set forth in opposer's notice of opposition, we make the following determinations:

Motion to Dismiss

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). 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 the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. 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).

A. Standing

We initially note that applicant does not directly attack opposer's standing to bring this opposition proceeding. We nonetheless find that the pleadings clearly include allegations which, if proven, are sufficient to establish opposer's standing to bring this case.

B. Deceptiveness under Section 2(a)

To state a claim of deceptiveness under Section 2(a), an opposer need only allege facts from which it may be inferred that opposer has a reasonable belief that it would be damaged by use of applicant's allegedly deceptive mark and facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's services. An opposer asserting such a claim need

not allege prior use, or any use at all, of a mark or trade name similar to applicant's mark.

Furthermore, a proper pleading of "deceptiveness" under Section 2(a) requires the plaintiff to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See, e.g. Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete).

Following a review of opposer's notice of opposition, we find that opposer's pleading is devoid of any allegations which set forth a proper claim of deceptiveness. Accordingly,

applicant's motion to dismiss is **GRANTED** with regard to this claim to the extent noted below.

C. Priority and Likelihood of Confusion

In order to properly state a claim of likelihood of confusion, opposer must plead that (1) the opposer's mark, as applied to its goods or services, so resembles the applicant's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use. See Fed. R. Civ. P. 8; and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Although opposer has pleaded his priority of use, opposer's notice of opposition fails to plead allegations that his mark, as applied to his services, so resembles applicant's mark as to likely cause confusion, mistake, or deception.

Accordingly, applicant's motion to dismiss opposer's likelihood of confusion claim is **GRANTED** to the extent noted below.

D. Mere Descriptiveness

In order to assert properly a ground of mere descriptiveness under Section 2(e)(1) of the Trademark Act, opposer must assert that applicant's mark describes an ingredient, quality, characteristic, feature, function, purpose or use of applicant's identified services. See e.g.,

*In re Gyulay*, 820 F.2d 1216, 3 UPSQ2d 1009 (Fed. Cir. 1987).  
Opposer's pleading fails do to so. In view thereof,  
applicant's motion to dismiss opposer's mere descriptiveness  
claim is **GRANTED** to the extent noted below.

E. Primarily Geographically Descriptive

We note that opposer affirmatively alleges in his notice  
of opposition that applicant's mark is "merely geographically  
descriptive of a development and area in Ft. Myers, Florida."  
See ¶ 3 of opposer's notice of opposition. We find these  
allegations sufficient to state a claim of geographic  
descriptiveness under Section 2(e)(2) of the Trademark Act.

In view thereof, applicant's motion to dismiss is **DENIED**  
with regard to this claim.

F. Fraud

To assert a viable claim of fraud, the plaintiff must  
allege with particularity, rather than by implied  
expression, that the defending party knowingly made a false,  
material representation in the procurement of or maintenance  
of or renewal of a registration with the intent to deceive  
the U.S. Patent and Trademark Office. *See In re Bose Corp.*,  
580 F.3d 1240, 91 USPQ2d 1938, 1942 (Fed. Cir. 2009).

Further, fraud in procuring or maintaining a trademark  
registration may occur when an applicant for registration or a  
registrant in a declaration of use or a renewal application  
knowingly makes specific false, material representations of

fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it otherwise is not entitled. *Id.*

In his notice of opposition, opposer alleges that applicant fraudulently represented that it is using its involved mark in interstate commerce when, in fact, it is not used in interstate commerce at all since applicant is a non-profit entity. See ¶ 5 of opposer's notice of opposition.

The foregoing allegations do not set forth a proper claim of fraud inasmuch as these allegations do not state that applicant made a false, material representation in the procurement of its registration with the intent to deceive the USPTO in obtaining a registration for which it is otherwise not entitled. Accordingly, we find that opposer's fraud claim is deficiently pleaded. In view thereof, applicant's motion to dismiss opposer's fraud claim is **GRANTED** to the extent noted below.

Summary

Applicant's motion to dismiss opposer's claims of (1) deceptiveness, (2) priority and likelihood of confusion, (3) mere descriptiveness, and (4) fraud is **GRANTED**. Applicant's motion to dismiss opposer's claim of geographic descriptiveness, however, is **DENIED**.

Notwithstanding, the Board generally grants leave to amend pleadings that have been found insufficient, upon challenge under Fed. R. Civ. P. 12(b)(6) and/or Fed. R. Civ. P. 12(e).

Accordingly, opposer is allowed until **twenty days** from the mailing date of this order in which to file and serve an amended notice of opposition which sets forth proper claims of deceptiveness, priority and likelihood of confusion, mere descriptiveness, and fraud, if he has a reasonable basis for doing so, failing which these claims will be dismissed with prejudice.<sup>4</sup>

In turn, applicant is allowed **twenty days** from the date on the certificate of service of opposer's amended pleading in which to file and serve its answer to the amended notice of notice of opposition.

Trial Schedule

Proceedings herein are resumed. Trial dates, beginning with the deadline for the parties' required discovery conference, are reset as follows:

Deadline for Discovery Conference	9/9/2012
Discovery Opens	9/9/2012
Initial Disclosures Due	10/9/2012
Expert Disclosures Due	2/6/2013
Discovery Closes	3/8/2013
Plaintiff's Pretrial Disclosures Due	4/22/2013

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<sup>4</sup>Opposer should re-allege his primarily geographically descriptiveness claim in his amended pleading.

Plaintiff's 30-day Trial Period Ends	6/6/2013
Defendant's Pretrial Disclosures Due	6/21/2013
Defendant's 30-day Trial Period Ends	8/5/2013
Plaintiff's Rebuttal Disclosures Due	8/20/2013
Plaintiff's 15-day Rebuttal Period Ends	9/19/2013

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.