

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

Faint

Mailed: March 17, 2014

Opposition No. 91210715 (Parent)
Opposition No. 91210753

Cancellation No. 92057574

Transamerica Corporation

v.

Transtrend B.V.

**Before Seeherman, Ritchie and Hightower,
Administrative Trademark Judges.**

By the Board:

This case now comes up on the following contested motions:

1. Defendant's motion, filed August 30, 2013,¹ in connection with the cancellation proceeding, to dismiss the petition for cancellation for failure to state a claim upon which relief can be granted, and
2. Plaintiff's motion, filed October 28, 2013, to consolidate the cancellation proceeding with the two pending oppositions noted in the caption.

¹ Petitioner filed a consented motion to reopen its time to respond to the motion dismiss, and to suspend for settlement negotiations, which the Board granted on October 1, 2013. Petitioner filed a consented motion to further extend its time to respond to the motion to dismiss until October 29, 2013, which the Board granted on October 21, 2013.

Motion to Dismiss

Plaintiff seeks to cancel defendant's Registration No. 2723185. The mark as originally registered appeared as:



On June 5, 2013, defendant submitted a request under Section 7 of the Trademark Act, 15 U.S.C. § 1057(e), to amend the mark in its registration to the following:



and the Office accepted the amendment on July 23, 2013.

As grounds for cancellation, plaintiff enumerates three counts in its petition to cancel: nonuse, abandonment and fraud. By way of its motion to dismiss, defendant argues that plaintiff fails to state cognizable claims of abandonment and fraud, and that plaintiff's claims are "meritless on their face," as plaintiff is limited to pleading grounds set forth in Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), against a registration that is more than five years old. In response, plaintiff argues that while it has alleged its cause of action in terms of abandonment, this was because defendant's application for renewal and amendment of the mark in its registration had been filed, but not yet granted, at the time plaintiff filed the petition to cancel. Plaintiff argues it has sufficiently alleged a cause of action for cancellation of a registration that

was amended after it was more than five years old. Further, plaintiff argues, to the extent amendment of the mark may have enlarged defendant's rights, plaintiff's petition to cancel filed within five years of the amendment is not limited to the grounds in §§ 14(3) or 14(5), but may be challenged on other grounds, such as likelihood of confusion.² See *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822 (TTAB 1984); *Stanspec Co. v. American Chain & Cable Co.*, 189 USPQ 420 (CCPA 1976); see also TBMP § 307.02(c)(2) (3d ed. rev. 2 2013).

In order to survive a defendant's motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), the plaintiff's complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). In the context of inter partes proceedings before the Board, a plaintiff need only allege sufficient facts that, if proven, would allow the Board to

² To the extent plaintiff intends its allegations in paragraphs 10, 11, 12 and 13 to state a claim of likelihood of confusion, plaintiff did not list this as one of its enumerated causes of action, and such a claim would require amendment of the pleadings. Defendant argues in its reply brief that a claim of likelihood of confusion would be futile, because the Supreme Court ruled in *Park 'N Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 197 (1985) that a mark more than five years old is protected from cancellation except on the grounds stated in §§ 14(3) and 14(5). The Supreme Court in *Park 'N Fly* held that an infringement action brought by the holder of an incontestable mark may not be defended on the ground that the mark is merely descriptive and therefore invalid. *Id.* at 667. The holding did not address the issue of a mark that has been amended under Section 7.

draw a reasonable inference that 1) the plaintiff has standing to maintain the proceeding, and 2) a valid ground exists for cancelling the mark. *Caymus Vineyards v. Caymus Medical, Inc.*, 107 USPQ2d 1519, 1521 (TTAB 2013). For purposes of a motion to dismiss, all of the plaintiff's well-pleaded allegations in the complaint must be accepted as true and the complaint must be construed in a 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).

Standing

Plaintiff has sufficiently alleged standing for pleading purposes through its allegations that it owns similar marks for similar services. Proof of plaintiff's standing is left to summary judgment or final decision.

Nonuse and Abandonment Pleading

A mark is abandoned when its use has been discontinued with intent not to resume such use, and nonuse for three consecutive years is prima facie evidence of abandonment. Trademark Act § 14(3), 15 U.S.C. § 1127. While nonuse is an element of abandonment, nonuse may also be considered a count different from abandonment, for example that a registrant did not make use of its mark prior to filing a use-based application, or prior to the expiration of time for filing an amendment to allege use or a statement of use, and thus the registration is void. Trademark Act § 1(a), 15 U.S.C. § 1051(a).

Here, plaintiff has identified its counts as “non-use and abandonment,” but the Board construes these as one claim of abandonment with two aspects, that is, nonuse of the registered mark for three or more consecutive years which constitutes a prima facie claim of abandonment, and an allegation that even if there was not a period of nonuse for three consecutive years, defendant has not used the mark for some period of time, and it intends not to resume use of the mark depicted in the registration as originally issued.

In view thereof, defendant’s motion to dismiss on the ground of abandonment, as discussed herein, is **denied**.

Fraud Pleading

Plaintiff alleges that defendant’s Section 7 request was to amend its mark to one that is “virtually identical” to the mark that appears in defendant’s pending application Serial No. 79116365, and defendant’s failure to inform the USPTO of this in its request for amendment was “an intentional omission of material fact.”

The Court of Appeals for the Federal Circuit has held that a trademark registration is obtained, or maintained, fraudulently only if a party knowingly makes a false, material representation with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009).

Here, plaintiff’s allegations do not sufficiently allege fraud because at the time defendant filed its Section 7 amendment, defendant did not own another identical registration, as it had, and still has, only a pending application for

registration. Accordingly, there is no false misrepresentation that could have been knowingly made with intent to deceive. Thus, the claim is insufficient on its face and is **stricken**.

While the Board is liberal in allowing amendments to pleadings, in this posture, any such amendment of the fraud claim would be futile, and therefore plaintiff may not file an amendment to further allege fraud based on this set of facts.

Motion to Consolidate

Plaintiff moves to consolidate the cancellation proceeding with two pending opposition proceedings, Nos. 91210715 and 91210753, involving the same parties, based on plaintiff's "registration and use of the same family of service marks." Defendant opposes consolidation, arguing that while there is "factual overlap," the issues are different as the opposition proceedings involve claims of likelihood of confusion, while this cancellation proceeding involves only claims of abandonment.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from

consolidation against any prejudice or inconvenience which may be caused thereby. *See, e.g.*, 9A Wright & Miller, *Federal Practice and Procedure Civ.* § 2383 (3d ed. 2013); and *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982). Consolidation is discretionary with the Board. *See, e.g.*, *Regatta Sport Ltd.*, 20 USPQ2d at 1156 (proceedings consolidated on Board's own initiative).

Since the involved marks share some commonality, and these proceedings involve the same parties, it is believed these proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually, and would serve the Board's interest in judicial economy. *See* Rule 42(a).

Accordingly, the motion to consolidate is **granted**, and Opposition Nos. 91210715 and 91210753 and Cancellation No. 92057584 are now treated as consolidated proceedings.

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all proceeding numbers in its caption, as shown in the caption of this order. The filings are to be made in the "parent" proceeding, which was the one that was

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first instituted. In this case the parent is **Opposition No. 91210715**. The exception to this rule is that the pleadings should be filed in the proceeding which they address. Therefore, **the answer in Cancellation No. 92057574 should be filed in the cancellation proceeding.**

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 and a copy of the decision shall be placed in each proceeding file.

While discovery had opened previously in the consolidated opposition proceedings, those proceedings were suspended pending disposition of this motion to dismiss. Discovery in the now consolidated proceedings will resume on the schedule set out below.

Summary

Plaintiff has sufficiently alleged its standing for pleading purposes. The Board construes plaintiff's petition to cancel as alleging abandonment. The fraud claim is **stricken**. In view of the foregoing, defendant's motion to dismiss is **denied**.

Plaintiff's motion to consolidate is **granted**.

Schedule

Proceedings are resumed. Plaintiff is allowed until **TWENTY DAYS** from the mailing date of this order to file an amended petition to cancel,

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failing which proceedings will go forward on the petition as construed herein.

An amended pleading, if any, should be filed only in Cancellation No.

92057574. Defendant is allowed until **THIRTY DAYS** from the filing and

service of any amended pleading, if any, to file its answer thereto. If no

amended pleading is filed, defendant is allowed is allowed until **FORTY**

DAYS from the mailing date of this order to file its answer. The answer

should be filed only in Cancellation No. 92057574.

Dates are reset as set out below.

Deadline for Discovery Conference	5/20/2014
Discovery Opens	5/20/2014
Initial Disclosures Due	6/19/2014
Expert Disclosures Due	10/17/2014
Discovery Closes	11/16/2014
Plaintiff's Pretrial Disclosures Due	12/31/2014
Plaintiff's 30-day Trial Period Ends	2/14/2015
Defendant's Pretrial Disclosures Due	3/1/2015
Defendant's 30-day Trial Period Ends	4/15/2015
Plaintiff's Rebuttal Disclosures Due	4/30/2015
Plaintiff's 15-day Rebuttal Period Ends	5/30/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within

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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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