

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GCP

Mailed: August 28, 2014

Opposition No. 91212768

INTS It Is Not The Same, GmbH

v.

Disidual Clothing, LLC

By the Trademark Trial and Appeal Board:

Disidual Clothing, LLC (“Applicant”) seeks to register the mark DISIDUAL, in standard characters, for “apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts” in International Class 25.¹

INTS It Is Not The Same, GmbH (“Opposer”) has opposed the registration of Applicant’s DISIDUAL mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In support of its asserted claim, Opposer has pleaded ownership of numerous registrations for the mark DESIGUAL and DESIGUAL and design, including Registration Nos. 2088319, used in association with various home goods, including furniture items and bedding, clothing items, as well as retail store services featuring clothing items.

¹ Application Serial No. 85836544, filed on January 30, 2013, based upon an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming June 1, 2010 as both the date of first use and the date of first use in commerce.

On December 20, 2013, Applicant filed its answer to the notice of opposition, as well as a counterclaim seeking to cancel Opposer's pleaded Registration No. 2088319 on the ground of abandonment.

In lieu of filing an answer to the counterclaim, Opposer, on April 21, 2014, filed a motion to dismiss the counterclaim for failure to state a claim upon which relief may be granted. This case now comes before the Board for consideration of Opposer's motion to dismiss. Opposer's motion is fully briefed.²

The Board carefully considered the arguments raised by the parties in their respective motion papers, as well as the supporting correspondence and the record of this case, in coming to a determination regarding Opposer's motion to dismiss. Based on the foregoing, the Board makes the following findings and determinations:

Decision

To survive a motion to dismiss, "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). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations.

² Applicant's change of correspondence address filed on May 14, 2014 is noted. Board records have been updated accordingly.

Id. Rather, 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). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter 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 ...”).

For purposes of determining such motion, 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 (Fed. Cir. 1993). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. *See Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

A. **Standing**

We initially note that Opposer does not directly attack Applicant’s standing to assert its counterclaim. The Board nonetheless finds that Applicant’s standing to assert its counterclaim arises from Applicant’s position as defendant in this opposition proceeding. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999).

B. Abandonment

To set forth a cause of action to cancel a registration which assertedly has been abandoned, a plaintiff must allege ultimate facts pertaining to the alleged abandonment that, if proved, would establish a prima facie case. *Otto International, Inc. v. Otto Kern GMBH*, 83 USPQ2d 1861, 1863 (TTAB 2007). To provide fair notice to a defendant, such a pleading must allege at least three consecutive years of non-use, **or** must set forth facts that show a period of nonuse less than three years, together with an intent not to resume use. See Trademark Act § 45, 15 U.S.C. § 1127. (emphasis added).

In its counterclaim, Applicant alleges, *inter alia*, the following:

Paragraph 9

Additionally, a search of INTS's deisual.com retail website reveals no trademark uses of the design mark on the goods identified in the registration --- footwear and headwear --- or on any other goods. See Exhibit A.

Paragraph 10

On information and belief, the DESIGUAL (Stylized) mark covered by Reg. No. 2,088,319 is not presently in use as a trademark on the identified goods.

Paragraph 11

On information and belief, and despite INTS's section 8 declarations in 2003 and 2006, the DESIGUAL (Stylized) mark covered by covered by Reg. No. 2,088,319 has not been used as a trademark on the identified goods.

Paragraph 12

Pursuant to 15 U.S.C. § 1064(3), Reg. No. 2,088,319 has been abandoned and should be cancelled in full.

The Board finds that the foregoing allegations are sufficient to set forth a claim of abandonment and provide Opposer fair notice of said claim. One can reasonably infer from the aforementioned allegations that Applicant is asserting that, even though Opposer filed declarations of use in 2003 and 2006, Opposer has not used the subject mark on the identified goods since said filings (which effectively constitutes a period of non-use over three years) and, therefore, has abandoned its mark.³

In view thereof, Opposer's motion to dismiss Applicant's counterclaim for failure to state a claim is **DENIED**.

Trial Schedule

Proceedings are resumed. Trial dates, beginning with the deadline to file an answer to Applicant's counterclaim, are reset as follows:

Answer to Counterclaim Due	September 25, 2014
Deadline for Discovery Conference	October 25, 2014
Discovery Opens	October 25, 2014
Initial Disclosures Due	November 24, 2014
Expert Disclosures Due	March 24, 2015
Discovery Closes	April 23, 2015
Plaintiff's Pretrial Disclosures Due	June 7, 2015
30-day testimony period for plaintiff's testimony to close	July 22, 2015

³ Although the Board has found that Applicant has sufficiently stated a claim of abandonment, Applicant is advised that a claim of abandonment based solely on the sufficiency of specimens submitted in connection with Opposer's affidavits of use is not a proper claim for cancellation. Indeed, the insufficiency of specimens, per se, does not constitute as a ground for cancellation. *See Marshall Field & Co., v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). *See also Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the adequacy of specimens is solely a matter of ex parte examination).

Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	August 6, 2015
30-day testimony period for defendant and plaintiff in the counterclaim to close	September 20, 2015
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	October 5, 2015
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	November 19, 2015
Counterclaim Plaintiff's Rebuttal Disclosures Due	December 4, 2015
15-day rebuttal period for plaintiff in the counterclaim to close	January 3, 2016
Brief for plaintiff due	March 3, 2016
Brief for defendant and plaintiff in the counterclaim due	April 2, 2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	May 2, 2016
Reply brief, if any, for plaintiff in the counterclaim due	May 17, 2016

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.