

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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coggins

Mailed: December 2, 2014

Opposition No. 91215553

Guinot

v.

Ebel International Limited

By the Board:

Now before the Board is applicant's motion, filed April 30, 2014, to dismiss the notice of opposition for failure to state a claim under Fed. R. Civ. P. 12(b)(6). The motion is fully briefed.

Procedural Issues

Although applicant's motion and reply brief in support thereof are not double-spaced, as required by Trademark Rule 2.126(b), it is clear that neither filing approaches the respective page limitations imposed by Trademark Rule 2.127(a). In view thereof, the filings will be considered; however, all future filings must be double-spaced.

Opposer's change of correspondence address (filed August 14, 2014) is noted and entered.

To the extent opposer's brief in opposition to the motion to dismiss contains matters outside the pleadings such matters will be excluded from consideration. The Board notes that applicant's motion seeks dismissal under Fed. R. Civ. P. 12(b)(6), and therefore only the sufficiency of opposer's claims as pleaded is at issue, rather than any particular facts or the ultimate merits of opposer's claims (including opposer's standing). *See e.g., Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009) ("...if a motion to dismiss is filed that references matters outside the pleadings, the Board may exclude from consideration the matters outside the pleadings and may consider the motion for whatever merits it may present as a motion to dismiss.").

Opposer's request in its brief in opposition that the Board order the Examining Attorney of opposer's pleaded application to approve opposer's application for publication is misplaced. The Board has no jurisdiction over the pleaded application in context of this opposition proceeding.

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 a motion to dismiss for failure to state a claim in a Board opposition proceeding, the opposer need only allege such facts in the notice of opposition 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 (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, 1354 (Fed. Cir. 2010).

For purposes of determining the motion, the notice of opposition 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. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

(1) *Standing*

Opposer must allege facts in the notice of opposition which, if ultimately proven, would establish that opposer 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).

Opposer claims ownership of one pending U.S. application and two foreign registrations, all for the mark SUMMUM. Opposer also alleges that it will be damaged by registration of the subject mark, which opposer states is merely SUMMUM, that the parties' marks are identical, that parties' goods are closely related, and that a likelihood of confusion exists.

The allegation that opposer's mark is merely SUMMUM is not well-taken because the subject mark is SUMMUM L'BEL. Despite the requirement that the Board must treat all well-pleaded allegations as true, there are objective facts the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d at 1256. For example, the Board may look to what the subject mark actually is; that is a fact not subject to proof, and the Board may look to Office records for such facts to determine if a party's allegations are well-pleaded. *Id.* Further, because opposer misstates what applicant's mark is, the allegation that the parties' marks are identical is not well-taken.

Although opposer alleges that if the subject application matures into a registration it would represent a false connection with opposer, opposer does not allege any facts that state opposer's belief that the designation applicant seeks to register as a mark is the same as or a close approximation of opposer's name or identity or facts that state its reasonable belief that

applicant's mark would be recognized in the United States. *See Canovas v. Venezia 80 S.R.L.*, 220 USPQ 660, 662 (TTAB 1983).

There are no allegations in the notice of opposition, even when read in conjunction with any other allegations in the complaint, to demonstrate that opposer has a real interest in opposing the subject mark and thus, if proved, would establish its standing.¹ Opposer has, thus, failed to plead facts sufficient to allege its standing.

(2) *Valid ground*

The notice of opposition was filed utilizing ESTTA and includes an ESTTA cover sheet which indicates that the grounds for opposition are priority and likelihood of confusion under Trademark Act Section 2(d), false suggestion of a connection under Trademark Act Section 2(a), dilution under Trademark Act Section 43(c), and that applicant lacked a *bona fide* intent to use the mark in commerce at the time of filing. *See PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (content of ESTTA cover sheet is integral component and read in conjunction with complaint). The Board will examine the notice of opposition for these four grounds only. *See O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d

¹ Although opposer's brief in opposition explains that applicant's mark was cited as a potential bar to opposer's pleaded application, there is no such allegation in the notice of opposition. As noted above, the motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the complaint, and all matters outside the pleadings have been excluded from consideration.

1327 (TTAB 2010) (Board will not parse an asserted ground to see if elements might go to state a separate ground).

(a) *Priority and likelihood of confusion*

In order to properly state a claim of priority and likelihood of confusion, opposer must plead that (1) applicant's mark, used in connection with its goods, so resembles opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has either priority of use or a federal registration of opposer's pleaded mark. *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 noted above, opposer claims ownership of two foreign registrations and one U.S. application for the mark SUMMUM. By opposer's own allegation, the U.S. application was filed after the subject application. Opposer claims no prior common law rights in (i.e., priority of use of) its mark, and opposer makes no allegations as to any priority in the United States or allegations that it may rely on any foreign priority. Opposer has failed to plead that it has used SUMMUM as a mark or trade name in the United States, much less that its use was prior to the filing date of applicant's application. *See Canovas v. Venezia 80 S.R.L.*, 220 USPQ at 662. Because opposer has not alleged that it has priority, the notice of opposition fails to state a claim of priority and likelihood of confusion. Moreover, as noted above, opposer incorrectly alleges what the subject mark is.

(b) *False suggestion of a connection*

In order to properly assert a ground of false suggestion of a connection, opposer must plead that (1) applicant's mark is the same or a close approximation of opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to opposer; (3) that opposer is not connected with the goods provided by applicant under the mark; and (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with opposer would be presumed. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

Opposer makes only a conclusory allegation as to a claim of false suggestion of a connection. Because the notice of opposition contains no allegations of the individual elements necessary to this claim, the notice of opposition fails to state a claim of false suggestion of a connection.

(c) *Dilution*

In order to properly state a claim of dilution, opposer must plead that its mark is distinctive and famous and that its mark became famous prior to applicant's first use or 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 (TTAB 2001). Opposer has not alleged that its mark is distinctive or famous, or that its mark became

famous prior to applicant's filing date. Indeed, it appears that opposer merely checked the box on the ESTTA coversheet for this ground without making any relevant allegations in the body of the notice of opposition. Because the notice of opposition contains no allegations of the individual elements necessary to this claim, the notice of opposition fails to state a claim of dilution.

(d) *No bona fide intent*

Section 1(b) of the Trademark Act requires that an applicant filing an intent-to-use application verify that it has a "bona fide intention" to use the mark in commerce. 15 U.S.C. § 1051(b)(1). If an applicant lacks a *bona fide* intent to use a mark in commerce at the time of its filing, the Section 1(b) application is void. An alleged trademark owner's *bona fide* intentions can be fully tested in the context of an *inter partes* proceeding. See TBMP § 309.03(c)(5) (2014) (defendant's lack of a bona fide intent to use a mark in commerce with the identified goods is an appropriate ground for an opposition or cancellation).

In the notice of opposition, opposer alleges as to this ground only that applicant "lacked a bona fide intent to use the mark in commerce at the time it filed its application...." Opposer makes no further allegations as to this ground; therefore, opposer has not stated this claim with enough detail to give applicant fair notice of the basis of the claim. Because the notice of opposition contains no allegations as to the basis of the claim (i.e., no detail

or any factual matter to suggest that the claim is plausible), the notice of opposition fails to state a claim that applicant did not have a *bona fide* intent to use the mark in connection with the identified goods as of the filing date of the application under Trademark Act § 1(b).

(3) *Summary*

Inasmuch as the notice of opposition fails to allege that opposer has standing and fails to allege a single ground for opposing the subject application, the motion to dismiss is **granted**.

(4) *Opposer May Replead*

The Board freely grants leave to amend pleadings if found, upon challenge under Fed. R. Civ. P. 12(b), to be insufficient, particularly where the challenged pleading is the initial pleading. *See* TBMP § 503.03 (2014). Accordingly, opposer is allowed until December 22, 2014, to file an amended pleading that properly alleges standing and at least one ground for opposition²; failing which, the opposition will be dismissed with prejudice.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Amended Notice Due

12/22/2014

² While it is permissible for opposer to replead a proper dilution claim, opposer is reminded 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*, at 1180 (TTAB 2001). *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 associations that even non-competing uses can impinge upon their value.”).

Time to Answer	1/12/2015
Deadline for Discovery Conference	2/11/2015
Discovery Opens	2/11/2015
Initial Disclosures Due	3/13/2015
Expert Disclosures Due	7/11/2015
Discovery Closes	8/10/2015
Plaintiff's Pretrial Disclosures	9/24/2015
Plaintiff's 30-day Trial Period Ends	11/8/2015
Defendant's Pretrial Disclosures	11/23/2015
Defendant's 30-day Trial Period Ends	1/7/2016
Plaintiff's Rebuttal Disclosures	1/22/2016
Plaintiff's 15-day Rebuttal Period Ends	2/21/2016

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