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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215688
Party	Defendant Maco Pharma
Correspondence Address	ANDY I. COREA ST. ONGE STEWARD JOHNSTON & REENS LLC 986 BEDFORD ST STAMFORD, CT 06905-5610 tm-pto@ssjr.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Andy I. Corea
Filer's e-mail	acorea@ssjr.com, litigation@ssjr.com
Signature	/Andy I. Corea/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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THERAKOS, INC.,)	
)	
Opposer,)	
)	
v:)	Opposition No. 91215688
)	
MACO PHARMA,)	
)	
Applicant)	
)	

**APPLICANT’S MOTION TO DISMISS
OPPOSER’S CLAIM OF DILUTION**

Applicant Maco Pharma (“Applicant”) moves to dismiss Opposer Therakos, Inc.’s (“Opposer”) claim of dilution under Lanham Act Section 43(c), 15 U.S.C. § 1125(c), on grounds that the Notice of Opposition fails to state a claim for which relief may be granted. Fed. R. Civ. P. 12(b)(6).

INTRODUCTION

Applicant seeks registration of its trademark THERAFLEX for use in connection with “pharmaceutical products, namely, solutions for use in connection with the processing of blood and blood components for medical purposes, bags filled with solutions for processing blood for medical purposes; none of the foregoing being preparations of the treatment of colds or influenza” in international class 005; and “medical devices for processing blood, namely, medical kits comprised of blood filters, pouches and plastic tubing, pouch and container systems comprising blood collection bags for medical purposes for the processing of blood or blood components” in international class 010.

On April 1, 2014, Opposer filed its Notice of Opposition (“Opposition”) objecting to registration of the THERAFLEX mark on grounds of priority and likelihood of confusion under Lanham Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Lanham Act Section 43(c), 15 U.S.C. § 1125(c).¹ (Notice of Opposition ¶¶ 8-10, Cover Sheet.)

Because Opposer’s Opposition fails to allege that its THERAKOS mark is famous or that it became famous before Applicant’s first use of its THERAFLEX mark, Applicant respectfully requests the Board to dismiss Opposer’s dilution claim under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim upon which relief can be granted.

I. Pleading Standard

An “opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.” 37 C.F.R. § 2.104(a); *see also* TMEP § 1503.01; TBMP § 309.03(a)(2). Each element of each claim should be pleaded “simply, concisely, and directly.” TBMP § 309.03(a)(2). The pleading must “state a claim to relief that is plausible on its face.” *Id.* (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” to satisfy the pleading burden. *Doyle v. Al Johnson’s Swedish Restaurant Butik Inc.*, 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012) (quoting *Iqbal*, 556 U.S. at 678).

To withstand a motion to dismiss for failure to state a claim, a pleading must “allege such facts as would, if proved, establish that the [opposer] is entitled to the relief sought.” TBMP § 503.02 (citing *Young v. AGB Corp.*, 152 F.3d 1377, 1379 (Fed. Cir. 1998)); *Doyle* 101 U.S.P.Q.2d 1780. Thus, dismissal is proper if the pleading fails to allege facts to support each

¹ Although Applicant disputes the substance of Opposer’s Section 2(d) claim, Applicant does not challenge that claim in this motion.

element of a claim. *See* TBMP § 309.03(a)(2).

II. Elements of a Dilution Claim

Section 43(c) of the Lanham Act requires a party claiming dilution to show that the mark is distinctive and famous. 15 U.S.C. § 1125(c)(1). The Act defines a famous mark as one that “is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.” 15 U.S.C. § 1125(c)(2)(A). Factors relevant to the fame determination are: (1) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (3) the extent of actual recognition of the mark; and (4) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. *Id.* Section 43(c) requires a mark to have nationwide fame, not merely geographically localized fame or fame in a limited market. *Id.*

Furthermore, the Lanham Act requires the mark to have acquired the requisite level of fame prior to the first use of the alleged diluting mark. 15 U.S.C. § 1125(c)(1). The Notice of Opposition fails to allege facts supporting either element and therefore fails to state a claim for dilution.

A. Opposer has Failed to Plead that the THERAKOS Mark is Famous

The Notice of Opposition fails to allege facts sufficient to support a finding that the THERAKOS mark is nationally recognized as source identifying, making Opposer’s pleading insufficient to state a claim for dilution under the Lanham Act. Section 43(c) plainly requires a finding of a famous mark to sustain a dilution claim and defines a mark as famous only if “widely recognized” as source indicative “by the general consuming public of the United States.”

15 U.S.C. § 1125(c). Opposer conclusorily states that it has “spent significant time and money promoting the trademark to customers nationwide” since 2009, but fails to allege facts supporting this conclusion, such as the amount of money spent, the nature of the promotional materials, or the medium through which the advertisements were sent to customers. (Notice of Opposition ¶ 3.) The same paragraph states that Opposer has sold its products under the THERAKOS mark since 1999 and summarily concludes that “[c]ustomers have come to know the THERAKOS mark as a symbol of the Therakos’ quality products and services.” (*Id.*) It is well established that such conclusory statements “do not suffice” to carry the pleading burden. *Iqbal*, 556 U.S. at 678.

Other than the conclusory, threadbare statements of paragraph 3, the Opposition fails to allege any facts regarding the THERAKOS mark’s fame, simply concluding in paragraph 10 that “Applicant’s use of the THERAFLEX mark will . . . dilute Therakos’ prior rights in the THERAKOS mark.” (Notice of Opposition ¶ 10.) Accordingly, Opposer has failed to plead the fame element of its dilution claim, and the Board should therefore grant Applicant’s motion to dismiss this claim.

B. Opposer has Failed to Plead that the THERAKOS Mark Became Famous Prior to Applicant’s First Use of its THERAFLEX Mark

Even more striking is the Opposition’s failure to plead that the THERAKOS mark became famous prior to Applicant’s first use of the THERAFLEX mark, also making the dilution claim legally insufficient. As noted above, the Lanham Act requires the famous mark to have acquired the requisite level of fame prior to the first use of the alleged diluting mark. 15 U.S.C. § 1125(c)(1). The Opposition fails to provide any date upon which Opposer alleges the THERAKOS mark became famous. Without alleging such information and facts to support it, the Opposition clearly fails to plead this element of a dilution claim. *See Toro Co. v. Torohead*,

Inc., 61 U.S.P.Q.2d 1164, 1174 (T.T.A.B. 2001) (holding that the “owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration” it is contesting).

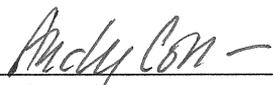
The Opposition fails to allege facts to support the prior fame element of dilution, and the Board should therefore grant Applicant’s motion to dismiss the dilution claim.

CONCLUSION

Opposer has plainly failed to allege facts sufficient to support its dilution claim under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Thus, the Opposition fails to provide Applicant with fair notice of Opposer’s dilution claim. Accordingly, Applicant respectfully requests that the board dismiss Opposer’s dilution claim under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim upon which relief may be granted.

Respectfully submitted,

May 6, 2014



Andy I. Corea
Stephen S. Zimowski
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905
Tel. (203) 324-6155
Facsimile (203) 327-1096
Email: litigation@ssjr.com

Attorneys for Applicant, Maco Pharma

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing **APPLICANT'S MOTION TO DISMISS OPPOSER'S CLAIM OF DILUTION** was served via electronic mail and first class mail, postage prepaid, on counsel for the Opposer at the following address:

James G. Goggin
Verrill Dana, LLP
One Portland Square P.O. Box 586
Portland, ME 04112-0586
jgoggin@verrilldana.com

Date: May 6, 2014

/s/ Joan M. Burnett
Joan M. Burnett