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

Proceeding	91216552
Party	Defendant Technicolor
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	FRAMELOGIC motion to dismiss.pdf(131447 bytes )

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

FRAME LOGIC DIGITAL LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91216552
	)	Application Serial No. 85682937
TECHNICOLOR,	)	Mark: FRAMELOGIC
	)	
Applicant.	)	
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	)	
	/	

**APPLICANT’S MOTION TO DISMISS FOR FAILURE TO  
STATE A CLAIM PURSUANT TO FED. R. CIV. P 12(B)(6) AND  
TBMP § 503, AND MOTION FOR SUSPENSION OF PROCEEDING.**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP § 503, Applicant TECHNICOLOR, through its undersigned attorneys, hereby moves the Board for dismissal of the Opposition as relates to the dilution claim, for failure to state a claim upon which relief can be granted. Further, Applicant moves the Board to suspend the instant proceedings pending the outcome of this potentially dispositive motion.

**INTRODUCTION**

On July 20, 2012, Applicant filed Application Serial No. 85682937 for the mark FRAMELOGIC. On January 28, 2014 this application was published for opposition. On May 27, 2014, Opposer, Frame Logic Digital LLC, filed a notice of opposition against this application. The proceeding was instituted on the same day.

Applicant moves to dismiss the opposition as relates to the dilution claim, on the ground such claim was not properly plead and therefore has failed to state a claim upon which relief can be granted.

I. TIMING AND LEGAL STANDARD FOR A MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO FED. R. CIV. P. 12(B)(6).

TBMP § 503.01 states in relevant part “[w]hen the defense for failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant’s answer.” This motion is timely filed as it has been filed before Applicant filed its answer.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. TBMP § 503.02. The Board reviews a motion to dismiss by assuming all well-pleaded allegations are true, and construing these allegations in a light most favorable to the opposer. *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (TTAB 1985). To survive a motion to dismiss, Opposer must show that a valid ground exists for denying the registration sought. TBMP § 503.02.

In the instant case, Opposer’s dilution claim should be dismissed because Opposer failed to allege when its mark allegedly became famous.

Section 43(c), 15 U.S.C. § 1125(c), of the Trademark Act provides:

Injunctive relief. – Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, ***at any time after the owner’s mark has become famous***, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or tarnishment of the famous mark ...” (Emphasis added.)

A properly plead dilution claim in an opposition or cancellation proceeding must allege that the mark is famous and must allege when the mark at issue became famous. *See Polaris Indus. Inc. v. DC Comics*, 59 U.S.P.Q.2d 1798, 1800 (TTAB 2000) (finding a dilution pleading insufficient because opposer included “no allegations as to when opposer’s mark became famous”).

While the notice of opposition alleges 2008 as Opposer’s date of first use of the mark FRAME LOGIC DIGITAL, and alleges that the mark is famous, it does not state when Opposer’s mark allegedly became famous. Consequently, Opposer has failed to properly plead its dilution claim, and the claim should be dismissed.

## **II. REQUEST FOR SUSPENSION OF PROCEEDINGS**

The filing of the instant Motion to Dismiss tolls the time for Applicant to file an answer. TBMP § 510.03(a), n. 7; *Hollowform Inc. v. AEF*, 180 U.S.P.Q. at 285 (denying the opposer's Motion for Judgment by Default where the applicant filed a Motion to Dismiss in lieu of an answer, thereby tolling the applicant's time to file an answer).

Pursuant to TBMP § 510.03(a), the filing of a dispositive motion like a motion to dismiss will suspend the case "with respect to all matters not germane to the motion." *See also* 37 C.F.R. § 2.127(d); *SDT Inc. v. Patterson Dental Co.*, 30 U.S.P.Q.2d 1707 (TTAB 1994) (stating the Board "will always suspend a case in which a potentially dispositive motion has been filed"); *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. at 830 (TTAB 1985) (suspending proceeding when applicant filed, among other motions, a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6)). It is the Board's practice to suspend a proceeding pending the decision on any potentially dispositive motion. TBMP § 503.01. When issuing a suspension order "the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion." TBMP § 510.03(a).

Accordingly, Applicant requests the Board suspend the instant proceeding pending a decision on the motion.

### **CONCLUSION**

Opposer's claim of dilution is deficient and therefore fails to state a claim upon which relief can be granted. Accordingly, Applicant requests that the Board grant the instant motion, dismiss the dilution claim with prejudice, and suspend the instant proceeding pending the outcome of this dispositive motion.

Respectfully submitted,

Date July 7, 2014

s/Michelle L. Visser  
Michelle L. Visser  
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**CERTIFICATE OF SERVICE**

This will certify that a copy of the foregoing *Applicant's Motion to Dismiss for Failure to State a Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, and Motion for Suspension of Proceeding* has been served upon the following via first class mail, postage prepaid, on the date below:

Stewart J. Bellus  
Collard & Roe, P.C.  
1077 Northern Blvd.  
Roslyn, NY 11576

Date: July 7, 2014

s/Michelle L. Visser  
Michelle L. Visser