

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

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Mailed: August 2, 2014

Opposition No. 91216552

Frame Logic Digital LLC

v.

Technicolor

***By the Trademark Trial and Appeal Board:***

This case comes up on Applicant's motion, filed July 7, 2014, to dismiss the dilution claim for failure to state a claim for relief. The motion has been fully briefed.

Proceedings are suspended retroactive to the date of filing of the motion, and Opposer's motion seeking suspension, while unnecessary, is granted. Trademark Rule 2.127(d).

On May 27, 2014, Frame Logic Digital LLC filed a notice of opposition against Applicant's mark FRAMELOGIC for "film production and post-production software, namely, computer software for the dailies processing" (application Serial No. 85682937), pleading claims of priority of use, and likelihood of confusion with, and dilution of, its common law mark FRAME LOGIC DIGITAL for a variety of goods and services in the audiovisual field,

and that Applicant committed fraud with the statement in its application regarding Applicant's exclusive right to use the mark.

Applicant's motion seeks dismissal of the dilution claim as legally insufficient inasmuch as the notice of opposition fails to allege when Opposer's mark became famous. Opposer maintains that its pleading is sufficient because the subject application is not based on use, but an allegation of a bona fide intent to use the mark in commerce, and that it is implicit that Opposer alleges fame as of the filing date of the notice of opposition.<sup>1</sup> In reply Applicant points out its Trademark Act Sec. 44(d) priority claim of February 13, 2012, based on the filing date of its French application, and contends that Opposer must plead – and later prove – fame as of this date.

To withstand a motion to dismiss for failure to state a claim upon which relief may be granted, a notice of opposition need only allege such facts as would, if proven, establish Opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to Applicant. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). The allegation that Opposer uses a similar common law mark on the same or related goods or services is sufficient to plead that Opposer has a real interest in the proceeding, and therefore has standing. *Threshold.TV, Inc. and Blackbelt TV, Inc. v. Metronome Enterprises, Inc.*, 96 USPQ2d 1031, 1036

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<sup>1</sup> Opposer is advised that submissions must be double-spaced. Trademark Rule 2.126.

(TTAB 2010). With respect to the contested claim of dilution, pursuant to Trademark Act Sec. 43(c), “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 dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury. “an owner of an allegedly famous mark would have to show fame prior to the constructive use date; otherwise the intent-to-use provisions would lose much of their value.” (emphasis added).

When brought against applications not based on use, the Board has consistently held that a dilution claim must plead fame before Applicant’s constructive use date. *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 n31 (TTAB 2014) (“Opposer did not properly plead the fame of its mark prior to the earliest date on which Applicant can rely for purposes of priority”); *Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1880 n6 (TTAB 2012) (“Opposer's dilution claim is insufficiently pleaded because Opposer did not allege that any of its pleaded marks became famous prior to any date upon which Applicant can rely in support of his application”); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (“Opposer, however, has not alleged that its TREK mark became famous

before the constructive use date of the involved intent-to-use application”); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001) (“in the case of an intent-to-use application, an 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 against which it intends to file an opposition or cancellation proceeding”).

Accordingly, inasmuch as the notice of opposition fails to plead that Opposer’s mark was famous as of Applicant’s constructive use date of February 13, 2012, Applicant’s motion to dismiss the dilution claim is GRANTED.

Opposer is allowed until TEN DAYS from the mailing date of this order to file by ESTTA an amended notice of opposition with a legally sufficient claim of dilution, failing which the claim will be dismissed, and Applicant’s answer will not have to address paragraphs 10-13 of the present notice of opposition.

Applicant is allowed until THIRTY DAYS from the date of service of any amended notice of opposition to file its answer, or, if no amended notice of opposition is filed, FORTY DAYS from the mailing date of this order to file its answer to the original notice of opposition.

Dates are reset below:

|                                   |                   |
|-----------------------------------|-------------------|
| Deadline for Discovery Conference | <b>9/13/2014</b>  |
| Discovery Opens                   | <b>9/13/2014</b>  |
| Initial Disclosures Due           | <b>10/13/2014</b> |
| Expert Disclosures Due            | <b>2/10/2015</b>  |

|   |                  |
|---|------------------|
| Discovery Closes                        | <b>3/12/2015</b> |
| Plaintiff's Pretrial Disclosures        | <b>4/26/2015</b> |
| Plaintiff's 30-day Trial Period Ends    | <b>6/10/2015</b> |
| Defendant's Pretrial Disclosures        | <b>6/25/2015</b> |
| Defendant's 30-day Trial Period Ends    | <b>8/9/2015</b>  |
| Plaintiff's Rebuttal Disclosures        | <b>8/24/2015</b> |
| Plaintiff's 15-day Rebuttal Period Ends | <b>9/23/2015</b> |

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.