

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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General Contact Number: 571-272-8500

JK

Mailed: February 6, 2015

Opposition No. 91217562

Uncle Sam GmbH

v.

Jennifer Zvitco

By the Board:

This proceeding is before the Board for consideration of 1) applicant's September 8, 2014 motion to dismiss the notice of opposition, 2) opposer's October 3, 2014 motion to amend its notice of opposition, and 3) applicant's October 17, 2014 motion to dismiss the first amended notice of opposition. The motions are fully briefed.¹

Opposer's motion for leave to amend notice of opposition

Plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, *inter alia*, an amended complaint. *See* TBMP § 503.03 (2014). In an untimely response to applicant's motion (*see* Trademark Rule 2.127(a)), opposer filed a motion to amend its pleading, as well as a first amended notice of opposition.

¹ Applicant's request for an oral hearing (applicant's brief, p. 17), is denied. *See* TBMP § 502.06 (2014) ("the Board will not decide by telephone conference any motion which is potentially dispositive").

Amendments to pleadings in *inter partes* proceedings are governed by Fed. R. Civ. P. 15, which is applicable to Board proceedings by Trademark Rule 2.116(a).² *See also* TBMP § 507.01 (2014). Fed. R. Civ. P. 15(a) governs amendments prior to trial. Pursuant to Fed. R. Civ. P. 15(a)(2), where, as here, a party may not amend its pleading as a matter of course under Fed. R. Civ. P. 15(a)(1),

...a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See* TBMP § 507.02 (2014). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309 (TTAB 2007); *Hurley International L.L.C. v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

² Opposer conflates Fed. R. Civ. P. 15 and Trademark Rule 2.119(c). The latter governs timeliness when a party is required to take action in an *inter partes* proceeding within a prescribed period. On a motion to amend, the applicable authority is Fed. R. Civ. P. 15.

In its first amended pleading, opposer seeks to add allegations regarding the filings in maintenance of one of its pleaded registrations (amd. not. of opp., para. 2), to affirmatively allege priority (amd. not. of opp., para. 5), and to add allegations regarding the parties' respective marks (amd. not. of opp., para. 11). Opposer does not seek to add a new claim, and none of the proposed new allegations would violate settled law. Regarding prejudice to applicant, inasmuch as it is applicant's motion which occasioned suspension, and inasmuch as opposer may respond to applicant's potentially dispositive motion by filing an amended pleading, applicant is not prejudiced by opposer's amended pleading.

In view of these findings, opposer's motion to amend its pleading is granted.

To the extent that opposer's October 3, 2014 filings are in response to the September 8, 2014 motion to dismiss, opposer's filings are untimely. *See* Trademark Rule 2.127(a). Notwithstanding, in the interest of advancing this proceeding to a determination on the merits, the Board declines to grant that motion to dismiss as conceded. *See* TBMP § 502.04 (2014). Applicant's September 8, 2014 motion is moot, and the Board has determined the merits of applicant's October 17, 2014 motion to dismiss the first amended notice of opposition.³

³ Inasmuch as the material outside of the pleadings, that applicant submitted with its motion to dismiss, is merely a highlighted version of opposer's first amended notice of opposition, the Board has given said material consideration for the purpose of clarification of the record.

The submission of a proposed order (*see* applicant's motion, p. 20) is contrary to Board procedure.

Applicant's motion to dismiss first amended notice of opposition

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. See TBMP § 503.02 (2014), and cases cited therein. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that 1) the plaintiff has standing to maintain the proceeding,⁴ and 2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). See also TBMP § 503.02 (2014). 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, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, 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, 1041 (Fed. Cir. 1993); *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

⁴ Opposer's standing to bring this proceeding is not challenged in applicant's motion. For completeness, the Board notes that opposer has set forth allegations which, if proven at trial, would establish its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v.*

The Board does not summarize the parties' arguments in this order, but notes, generally, that several of applicant's points argue the merits of opposer's claims. To reiterate, applicant's motion is a test solely of the legal sufficiency of the notice of opposition.

Trademark Act Section 2(d)

To state a claim under Section 2(d), opposer must sufficiently allege that 1) it has standing 2) it has registered or previously used a mark; and 3) contemporaneous use of the parties' respective marks on or in connection with their respective goods and/or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

In paragraphs 2 through 5 of the first amended notice of opposition, opposer sufficiently alleges priority of use. In paragraph 10 thereof, opposer sufficiently alleges likelihood of confusion, mistake or deception. Accordingly, opposer sufficiently pleads this ground.

Trademark Act Section 2(a)

In its brief, opposer affirmatively states that it did not and does not plead a Section 2(a) claim that the mark falsely suggests a connection (*see* opposer's brief, p. 12). It posits that applicant's motion, as directed to this purported claim, is moot.

Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ 185, 189 (CCPA 1982).

Based on opposer's clarification, under the resulting construction of the first amended notice of opposition, applicant's motion insofar as it is directed to the purported Section 2(a) claim, is moot.

In summary, applicant's motion to dismiss the first amended notice of opposition is denied. The first amended notice of opposition sets forth the sole ground under Section 2(d), and is opposer's operative pleading.⁵

Schedule

Proceedings are resumed. Applicant is allowed until thirty days from the mailing date of this order to file an answer to the first amended notice of opposition. Required conference, disclosure and discovery dates are reset:

Deadline for Required Discovery Conference	4/8/2015
Discovery Opens	4/8/2015
Initial Disclosures Due	5/8/2015
Expert Disclosures Due	9/5/2015
Discovery Closes	10/5/2015
Plaintiff's Pretrial Disclosures due	11/19/2015
Plaintiff's 30-day Trial Period Ends	1/3/2016
Defendant's Pretrial Disclosures due	1/18/2016
Defendant's 30-day Trial Period Ends	3/3/2016
Plaintiff's Rebuttal Disclosures due	3/18/2016
Plaintiff's 15-day Rebuttal Period Ends	4/17/2016

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

⁵ The Board acknowledges that opposer submitted, with the pleading, printouts of its pleaded registrations from the Office's TSDR system.

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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.