

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

BUO

Mailed: January 17, 2015

Opposition No. 91217708

J.B. Marketing Int'l, Inc.

v.

*da Vinci Kunstlerpinselfabrik Defet
GMBH*

By the Trademark Trial and Appeal Board:

On August 6, 2014, J.B. Marketing International, Inc. (“Opposer”) filed a notice of opposition against da Vinci Kunstlerpinselfabrik Defet GMBH’s (“Applicant”) registration of the mark:

da Vinci

for use with “cosmetic and shaving brushes,” in International Class 021.¹

The notice of opposition alleges that registration should be denied based upon two grounds: 1) likelihood of confusion between the applied-for mark and the

¹ Application Serial No. 77555704, filed on August 26, 2008, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), alleging Applicant’s intent to use the mark in commerce. An allegation of use was filed on January 17, 2014, asserting 1988 as the first date of use anywhere and as the first date of use in commerce, which operates as an allegation of use as of December 31, 1988. *See* TMEP § 903.06.

mark DA VINCI owned by opposer, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and 2) Applicant committed fraud on the USPTO in the prosecution of the subject application. In support of its likelihood of confusion claim, opposer pleaded “senior” common law use of the mark DA VINCI in connection with “cosmetic brushes.” Notice of Opposition, ¶¶ 1 and 14. Additionally, Opposer’s claim of fraud is based upon the alleged inaccurate assertion of the dates of use in Applicant’s amendment to allege use, and Applicant’s “intent to deceive the Trademark Office into accepting the first use date set forth therein as the true and correct first date of use.” *Id.*, ¶¶ 6-9.

Now before the Board is Applicant’s motion, filed September 15, 2014, in lieu of filing an answer, to dismiss the notice of opposition for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6), or in the alternative for a more definite statement under Rule 12(e). Applicant argues that Opposer uses fact-barren conclusory allegations to assert that Applicant is not entitled to the registration sought. Specifically, with respect to its likelihood of confusion claim, Applicant avers that Opposer has failed to sufficiently plead its claim to priority. Applicant states:

Applicant cannot know, for example, whether Opposer’s alleged first use date is prior to Applicant’s first use date in 1988, or if Opposer is alleging priority only based on the 2008 filing date of the Application. Opposer’s conclusory claim that it is the “senior user” does not put Applicant on fair notice of the basis of Opposer’s claimed seniority, and therefore is legally insufficient.

Motion, p.7.

Further, with respect to the claim of fraud, Applicant argues that Opposer has failed to meet the standards of *In re Bose*,² inasmuch as Opposer failed to allege any facts impugning Applicant's subjective intent, or facts to support the proposition that any misstatement of the dates of use would be material to the determination of registrability. *Id.*, p.5.

In its response to the motion, Opposer withdrew its fraud claim. Therefore, Opposer's fraud claim stands **DISMISSED**. However, Opposer maintained that the pleading of its likelihood of confusion claim meets the notice pleading standards of Fed. R. Civ. P. 8(a). Opposer asserts that it has "alleged a short and plain statement showing that it is entitled to relief under Section 2(d) of the Lanham Act: (1) Opposer is the senior user of the subject mark; and (2) there is a likelihood of confusion between the parties' virtually identical marks." In the event the Board grants Applicant's motion however, Opposer requests leave to file an amended notice of opposition. *Id.*, p.9. The motion has been fully briefed.³

Motion to Dismiss

A motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). In order to withstand such a motion, a complaint need only allege such facts as would, if proven, establish that the plaintiff is

² *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938 (Fed. Cir. 2009).

³ Applicant's reply brief, filed October 22, 2014, is noted.

entitled to the relief sought; that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid statutory ground exists for cancelling the registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). The complaint need only “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); *see also Ashcroft v. Iqbal*, 556 U.S. 662 (2009). Opposer is not under a burden to prove its case in its notice of opposition. *Enbridge, Inc. v. Excelerate Energy Ltd. P’ship*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009).

- Standing

An opposer may establish a reasonable belief of damage by asserting proprietary rights and current ownership of a mark that is the same or similar to the applied for mark. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) (plaintiff may show standing based on common law rights in mark that is distinctive, inherently or otherwise); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (standing based on common law use of mark). In the present case, Opposer has pleaded “senior” use of the mark DA VINCI for use with goods that are alleged to overlap with those identified in the subject application. Therefore, Opposer has sufficiently pleaded its standing to bring this action, i.e. a real interest in the outcome of this proceeding and that it is not a “mere intermeddler.” *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

- Likelihood of Confusion

A claim of likelihood of confusion under Section 2(d), beyond priority, generally turns on two important factors: (1) similarity of the marks; and (2) relatedness and nature of the goods and/or services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567A (CCPA 1973); *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§ 1207.01 *et seq.*

A. Similarity of the Marks and Relatedness of the Goods

Opposer alleges that Opposer's Mark, DA VINCI "and Applicant's Mark are virtually identical in appearance, sound and commercial impression." Notice of Opposition, ¶ 12. Opposer also alleges that "[t]here is also direct overlap between the parties' products, i.e. cosmetic brushes." *Id.* Finally, Opposer asserts that "there is a risk that consumers will continue to mistake Opposer's products for those of Applicant, and vice versa," and thus, "Applicant's use of Applicant's Mark is likely to continue to cause confusion, mistake or deception in the minds of consumers as to the origin of Applicant's goods." *Id.*, ¶¶ 13 and 16.

Opposer has alleged facts regarding the similarity of the marks and relatedness of the goods, and damage that would result from the registration of Applicant's mark. These are sufficient facts that, if proven, would support Opposer's claim to relief under Section 2(d) of the Trademark Act. That is,

Opposer has informed Applicant of the nature of its marks, the goods that it claims are used in connection with its pleaded mark (it is presumed that Applicant is familiar with its own claimed goods and its mark), and Opposer then alleged the similarity of the applied-for mark with its pleaded marks and the relatedness of the goods and services covered by those marks.

B. Priority

However, as previously indicated, in order to carry a claim of likelihood of confusion a plaintiff must satisfy the threshold of a properly pleaded claim of priority. While Opposer claims that it is the “senior user of DA VINCI for cosmetic brushes,” this allegation does not provide sufficient factual background to support such a claim. Claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the defendant on notice of the basis for the claims. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”). A party must allege sufficient facts beyond a tender of ‘naked assertion[s]’ devoid of ‘further factual enhancement,’ to support its claims. *Cf. Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (*quoting Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

Inasmuch as Opposer failed to allege any facts regarding the dates of use of its claimed mark DA VINCI in connection with the pleaded goods beyond

the naked conclusion that it is the “senior” user, the notice of opposition fails to state a claim of likelihood of confusion under Trademark Act Section 2(d).⁴

Accordingly, Applicant’s motion to dismiss the notice of opposition alleging likelihood of confusion for failure to state a claim upon which relief may be granted is **GRANTED**, and Opposer’s likelihood of confusion claim is **DISMISSED**.

However, the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient. *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1955 (TTAB 2009). Accordingly, Opposer is allowed until **TWENTY DAYS** from the mailing date of this order to file an amended notice of opposition;⁵ failing which, the opposition will be dismissed with prejudice. Applicant is allowed until

⁴ To state a claim of likelihood of confusion under Trademark Act Section 2(d), Opposer must merely allege facts from which it may be inferred that Applicant’s applied-for mark so resembles Opposer’s previously used or registered marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the Applicant and Opposer. See 15 U.S.C. § 1052(d); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also TMEP § 1207.01.

⁵ Accordingly, Applicant’s alternative motion for a more definite statement under Fed. R. Civ. P. 12(e) is rendered moot.

Additionally, Opposer is cautioned to carefully consider the efficacy of reviving its fraud claim in light of the standards established by *In re Bose*. *In re Bose*, 580 F.3d 1240 (Fed. Cir. 2009). Fraud must be proven “to the hilt.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). The particularly standard includes proof of applicant’s actual knowledge of the falsehood of the declaration and its intent to defraud the USPTO. The declaration submitted with an application is a statement of the declarant’s *belief*, not absolute facts. Therefore, in order to prove fraud, Opposer must show that Applicant *subjectively believed* its own declaration to be false. See *Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 (CCPA 1978) (“Appellant misreads the cited statute and rules. They require the statement of *beliefs* about exclusive rights, not their actual possession. Appellant has produced no evidence impugning appellee’s beliefs.”) The standard of “knew or should have known” set forth in *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003), was discarded, by *In re Bose*. Consequently, from the circumstances presented, the Board is doubtful of Opposer’s ability to sufficiently plead this claim or any similar claim.

TWENTY DAYS from the date of service of the amended notice, if any amended notice is filed, to file an answer to that amended notice.

Schedule

Proceedings are **RESUMED**. The remaining conferencing, disclosure, discovery, and trial dates are reset as follows:

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| Deadline for Discovery Conference | 3/26/2015 |
| Discovery Opens | 3/26/2015 |
| Initial Disclosures Due | 4/25/2015 |
| Expert Disclosures Due | 8/23/2015 |
| Discovery Closes | 9/22/2015 |
| Plaintiff's Pretrial Disclosures | 11/6/2015 |
| Plaintiff's 30-day Trial Period Ends | 12/21/2015 |
| Defendant's Pretrial Disclosures | 1/5/2016 |
| Defendant's 30-day Trial Period Ends | 2/19/2016 |
| Plaintiff's Rebuttal Disclosures | 3/5/2016 |
| Plaintiff's 15-day Rebuttal Period Ends | 4/4/2016 |

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.