UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 8, 2015

Opposition No. 91220386

Dr. Linda S. Restrepo

v.

Alliance Riggers & Constructors, Ltd.

By the Board:

Alliance Riggers & Constructors, Ltd. ("Applicant") filed an application, based on use of the mark in commerce pursuant to Trademark Act § 1(a), to register the mark ALLIANCE RIGGERS & CONSTRUCTORS and design (shown below; RIGGERS & CONSTRUCTORS disclaimed) for "crane and erector services, namely, structural steel erection" in International Class 37.[1]

On January 29, 2015, Dr. Linda S. Restrepo ("Opposer") filed an amended notice of opposition, which the Board acknowledged as the operative pleading in this proceeding (*see* February 27, 2015 order, p. 1). In the operative pleading,

[1] The application is Serial No. 76716209, filed April 21, 2014, asserting a date of first use of the mark anywhere, and date of first use in commerce, of July 1, 1997.

Opposer sets forth allegations pertinent to a wide range of grounds for opposition (further discussed below).

In lieu of filing an answer, Applicant filed a motion to dismiss the amended notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief may be granted. The motion is fully briefed.[2]

Analysis

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 must allege sufficient factual matter as would, if proved, establish that 1) the plaintiff has standing to maintain the proceeding, 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). S*ee 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.*

[2] As noted in the February 27, 2015 order, to the extent that Opposer moves to strike Applicant's motion to dismiss, the requested relief is given no consideration. It is inappropriate for a party to respond to a motion by filing a motion to strike it. *See* TBMP § 517 (2014).

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).

The Board has reviewed the amended notice of opposition in its entirety. Moreover, the Board has reviewed the parties' briefs and arguments, but for efficiency does not restate each of the arguments herein, but notes that the majority of the parties' arguments discuss the merits of the allegations, rather than the sufficiency of them.[3]

Standing

To withstand a motion to dismiss, a plaintiff must sufficiently set forth allegations which, if proved, establish that it has a "real interest," *i.e.*, a direct and personal stake, in the outcome of the proceeding, as well as a "reasonable basis" for its belief of damage. *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. *See Ritchie v. Simpson, supra. See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). If a plaintiff pleads standing on one ground, it has the right to assert any other grounds. *See Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011);

[3] The materials that Applicant submitted with the motion which are outside of the pleadings, have been given no consideration. *See Compagnie Gervais Danone v. Precision Formulations LLC,* 89 USPQ2d 1251, 1255-56 (TTAB 2009); TBMP §§ 401.06 and 503.04 (2014).

Enbridge, Inc. v. Excelerate Energy LP, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009). *See also* TBMP § 309.03(b) n. 18, and cases cited therein.

A notice of opposition must include 1) a short and plain statement of the reason(s) why the opposer believes it would be damaged by the registration of the opposed mark, and 2) sufficient detail to give an applicant fair notice of the basis for each claim, with the elements of each claim stated concisely and directly. *See* TBMP § 309.03(a)(2) (2014). The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings.

In the motion to dismiss, Applicant challenges Opposer's standing. Standing may be pleaded in a variety of ways. Standing may be found where a plaintiff pleads that it has a bona fide intent to use the same mark for related goods or services, and is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of the defendant's registration. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). When descriptiveness or genericness of the mark is in issue, a plaintiff may plead its standing by alleging that 1) it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business), and 2) it has an interest in using the term descriptively in its business (that is, a plaintiff may plead that it is a competitor of the defendant). *Cf. Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.,* 107 USPQ2d 1750, 1760-61 (TTAB 2013) (petitioner is a

competitor using the term at issue as part of its domain name), *aff'd unpub'd,* No. 2014-1031 (Fed. Cir. 2014), *aff'd unpub'd,* No. 2014-1031 (Fed. Cir. 2014).

Opposer alleges, *inter alia*, that she "has an interest in utilizing the term descriptively in her business, opposer has utilized the words contained in the mark and has a bona fide intent to use the words contained in the mark and believes that registration of the mark will be refused in view of applicants (sic) registration," and alleges that she has a "commercial interest in the mark" (not. of opp., p. 1). Opposer also alleges that she is "grandfather owner of the domain name 'allianceriggersandconstructors.com' … applicant has made public claims that it is the owner of said domain name and of the webpages, videos, photographs, mp3s and originally created work produced by opposer" (not. of opp., p. 2). Opposer also alleges that she "has demonstrated a real interest in preventing registration of applicants (sic) proposed mark in state court proceedings" (not. of opp., p. 2).

Opposer's allegations are relevant to standing, but are lacking and therefore insufficient. Opposer does not allege that she has filed or is about to file an application to register a mark, and believes that the Office will refuse registration of that mark citing Applicant's opposed mark. Opposer references and discusses two registrations of which she is not the owner. Furthermore, Opposer alleges that she has an interest in using the terms in her business, but does not allege the specific nature of her business, and in particular does not allege that she is engaged in the offering or sale of goods or services that are the same as, related to or in the same industry as Applicant's identified services. A reading of the pleading as a

whole does not indicate allegations which, if proven, would establish that Opposer has a real interest in whether Applicant's mark is registered, as well as a reasonable basis for its belief of damage in the event that the mark registers.

In view of these findings, Opposer has not set forth allegations which, if proven, would establish her standing to bring this proceeding.

Grounds

Some initial points are necessary. First, Opposer listed Registration No. 3604909, on the cover page to the ESTTA filing of the original notice of opposition, as a pleaded registration on which it relies; Opposer also references Registration Nos. 3600905 and 3604909 at various points in the amended notice of opposition. The USPTO records indicate, as Opposer states, that these two registrations are owned by a nonparty third party entity, Alliance Steel, Inc., an Oklahoma corporation. To the extent that either registration forms the basis for or is relied upon to assert a purported ground for opposition in this proceeding, such assertion or reliance is inappropriate and legally insufficient inasmuch as Opposer does not have standing to assert the trademark rights, if any, that are owned by an unrelated entity.

Second, on the cover page to the ESTTA filing of the original notice of opposition, Opposer selected and listed ten grounds for opposition. In eighteen numbered paragraphs of the amended notice of opposition, Opposer has set forth allegations purported to state numerous grounds. The Board notes that the notice of opposition alleges none of the required elements of some of the listed claims.

Furthermore, the purported claim that the mark is primarily merely a surname pursuant to Trademark Act § 2(e)(4) is untenable given the nature of the mark.

Upon thorough review of the pleading, the Board finds as follows:

1) In paragraph 5, Opposer sufficiently alleges that Applicant did not use the opposed mark in commerce as of the filing date of Applicant's §1(a) use-based application. *See*, e.g., *Clorox Co. v. Salazar,* 108 USPQ2d 1083, 1086-87 (TTAB 2013).

2) In paragraphs 7 and 8, Opposer sufficiently alleges that the opposed mark is generic for the identified services. *See* Trademark Act § 23.

3) In paragraphs 7 and 8, Opposer sufficiently alleges that the opposed mark is incapable of functioning as a service mark because it is a mere background design that does not function as a mark separate and apart from the words, and would not be perceived by the relevant public as a service mark. *See* Trademark Act §§ 1, 2 and 45.

4) In paragraph 9, Opposer sufficiently alleges that Applicant was not the rightful owner of the opposed mark at the time of the filing of the application. *See, e.g., Nahshin v. Product Source Int'l, LLC,* 107 USPQ2d 1257 (TTAB 2013); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008).

5) In paragraph 10, Opposer sufficiently alleges that the opposed mark, "consisting of an end ruler symbol with a white background," is merely ornamental, is not inherently distinctive, and has not become

distinctive as an indicator of the source of the identified services. *See* Trademark Act §§ 1, 2 and 45.

The remainder of the enumerated paragraphs includes statements which either are incomprehensible in substance and content, or do not set forth the elements of grounds for opposition.[4]

In summary, in view of the finding that Opposer does not sufficiently allege standing, Applicant's motion to dismiss is granted. As noted above, the Board has

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[4] Due to the unclear nature of the allegations, the Board cannot list herein the pleading requirements for the insufficiently pleaded grounds. However, for clarification for Opposer, the Board specifically addresses the claims of fraud and abandonment. Fraud in procuring a federal trademark registration occurs when an applicant for registration knowingly makes a specific false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010). A claim of fraud *must* set forth *all* elements of the claim, that is, all *specific* factual circumstances alleged to constitute fraud on the USPTO, with a heightened degree of particularity in full compliance with Fed. R. Civ. P. 9(b), which is applicable to Board proceedings by operation of Trademark Rule 2.116(a). *See Asian and Western Classics B.V. v. Selkow,* 92 USPQ2d 1478, 1478 (TTAB 2009). At trial, a fraud claim carries a very high burden of proof; "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *See In re Bose, supra, citing Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

With respect to the ground of abandonment, for a pleading to provide fair notice of the plaintiff's theory of abandonment, it must specifically allege (*e.g.* allege specific dates) at least three years of nonuse of the mark in commerce for the identified goods and services, or a period of such nonuse less than three years coupled with an intent not to resume use. *See* Trademark Act § 45; *Imperial Tobacco Ltd. v. Philip Morris Inc.,* 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Otto Int'l Inc. v. Otto Kern GmbH,* 83 USPQ2d 1861, 1863 (TTAB 2007). Furthermore, abandonment of an application during the *ex parte* examination process does not equate to either abandonment of use of a mark, or abandonment for purposes of asserting the claim as a ground for opposition.

found that Opposer sufficiently pleads certain grounds for opposing registration of Applicant's mark.[5]

Leave to re-plead deferred

Upon granting a motion to dismiss, the Board may exercise its discretion to allow the plaintiff an opportunity to file an amended pleading, as appropriate. *See* TBMP § 503.03 (2014). The Board finds it appropriate to allow Opposer an opportunity to file a second amended notice of opposition which addresses the deficiencies noted herein.

However, in view of the Board's requirement for a written response relevant to the issue of suspension pursuant to Trademark Rule 2.117(a) (further discussed below), the Board defers setting a time allowing Opposer to file a second amended notice of opposition until such time as the Board ascertains if suspension of this proceeding is appropriate, and in the event that the Board suspends this proceeding, until such time as this proceeding is resumed.

Opposer shall note that in Board proceedings, Fed. R. Civ. P. 11, and Patent and Trademark Office Rule 11.18, require that all pleadings and papers be made in good faith and with evidentiary support. All grounds for relief and allegations in

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[5] To the extent that Opposer, in her brief, challenges Mr. Pritchard's appearance as counsel on behalf of Applicant, the assertions lack merit and support, and are not relevant to the issue before the Board in the motion to dismiss, namely, the sufficiency of the amended notice of opposition. In the absence of a meritorious petition to disqualify a practitioner in an *inter partes* matter in the Office pursuant to 37 CFR §11.19(c), the Board generally will not prohibit an otherwise procedurally proper appearance of legal counsel on behalf of a party. Moreover, Opposer cites no applicable authority for her assertions.
To the extent that Opposer, in her brief, challenges Applicant's standing, the point is inapposite and is given no consideration. Pleading, and later proving, standing are threshold requirements that a plaintiff must meet, not a defendant.

support thereof must have a basis in law or fact, and must not be filed for any improper purpose. This is a firm requirement for all pleadings in *inter partes* proceedings.

Potential suspension pursuant to Trademark Rule 2.117(a)

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or may have a bearing on the Board proceeding. The applicable authority, Trademark Rule 2.117(a), provides as follows:

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a) (2014); *General Motors Corp. v. Cadillac Club Fashions Inc.,* 22 USPQ2d 1933, 1937 (TTAB 1992). Suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. S*ee* TBMP § 510.02(a) (2014). The filing of a motion to suspend pursuant to Trademark Rule 2.117(a) is not a prerequisite to the Board's consideration of whether suspension under this rule is appropriate.

Both parties reference civil actions between the parties in state and/or federal court (*see, e.g.,* amended notice of opposition, p. 2; Applicant's motion to dismiss, p. 2; Opposer's brief p. 3). The Board must determine if suspension of this proceeding is appropriate.

Accordingly, this proceeding remains suspended. The parties are allowed until thirty (30) days from the mailing date of this order to file herein notification[6] which includes 1) a statement as to whether the parties are or were previously parties to any disposed or pending civil action(s) or litigation, in either a federal or state forum, which involves either Applicant's opposed mark or Opposer's pleaded mark, or both parties' marks; 2) a copy of the pleadings (complaint, and answer to complaint) that were filed in any such action; 3) a copy of any final judgment on the merits issued therein; and 4) the procedural status of any civil action(s) that are currently pending.[7]

Opposer advised to secure legal representation

Given Opposer's pleading and brief on the motion to dismiss, the Board reiterates that it is advisable for persons who are not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney, and as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to purely procedure matters. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are

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[6] The Board strongly encourages the parties to file a stipulated notification. In the alternative, one party may file notification.

[7] Certified copies are not required, but the submission should be clearly readable. *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998). The parties need not submit the entire file; the complaint and answer filed in any action that is pending are sufficient.

represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent,* 81 USPQ2d 1212, n.2 (TTAB 2006).