

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: September 9, 2015

Opposition No. 91221438

Node Source LLC

v.

YLD Limited

By the Trademark Trial and Appeal Board:

YLD Limited (hereafter “Applicant”) seeks registration of the mark THE NODE FIRM, in standard character format, for “[c]omputer programming; computer programming consultancy; computer software consulting; computer software development and computer programming development for others; creating of computer programs,” in International Class 42.¹ Node Source LLC (hereafter “Opposer”) opposes registration of the mark on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), false suggestion of a connection under Section 2(a), 15 U.S.C. § 1052(a), descriptiveness under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), abandonment under Section 45, 15 U.S.C. § 1127, fraud, and nonuse. In support of its grounds for opposition, Opposer pleaded ownership of common law rights in the mark THE NODE FIRM, for “computer programming; computer programming consultancy; computer software consulting; computer software development and computer

¹ Application Serial No. 86174797, filed January 24, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a); alleging November 28, 2011, as both the first date of use of the mark anywhere and its first use in commerce.

programming development for others; and creating of computer programs.” 1 TTABVUE 4, ¶ 1.²

This case now comes up for consideration of Applicant’s motion, filed in lieu of filing an answer on May 19, 2015, to dismiss the notice of opposition “on the grounds that the Opposition was untimely [filed] and as such the Board lacks jurisdiction over this proceeding,” under Fed. R. Civ. P. 12(b)(1). Opposer, in response, filed an opposition to the motion on June 8, 2015, containing argument against the motion, and also attaching various exhibits. The motion has been fully briefed.

Where a motion to dismiss is based on issue or claim preclusion or lack of Board jurisdiction, the Board may treat the motion as one for summary judgment. *See* Fed. R. Civ. P. 12(d). In general a party may not file a motion for summary judgment until the party has made its initial disclosures. Trademark Rule 2.127(e)(1); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010). However, this general rule has two exceptions: 1) a motion asserting lack of jurisdiction by the Trademark Trial and Appeal Board; or 2) a motion asserting claim or issue preclusion. Trademark Rule 2.127(e)(1); *Zoba Int’l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011) (motion to dismiss considered as one for summary judgment where it asserts claim preclusion). Therefore, Applicant’s motion, even construed as one for summary judgment, is timely and properly asserted.

However, pursuant to Fed. R. Civ. P. 12(d) and 56(d), the Board will generally defer consideration of a motion to dismiss which has been converted to a motion for summary

² Citations to the record will be to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

judgment to allow the parties time to supply evidence (and supplemental briefing) in support of their respective positions under the summary judgment standard. *See Zoba Int'l Corp.*, 98 USPQ2d at 1108. Accordingly, the parties are allowed **THIRTY DAYS** from the issuance of this order to present all materials pertinent to the motion for summary judgment, including supplemental briefs if necessary. Determination of the motion is **DEFERRED** until the parties have submitted supplemental materials or have informed the Board that they elect not to submit any additional materials, in which case the Board will make its determination on the record as presented.