UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 28, 2015

Opposition No. 91221590

Emerson Electric Co.

v.

S.C. Ion Mos S.R.L.

By the Trademark Trial and Appeal Board:

S.C. Ion Mos S.R.L. ("Applicant") seeks to register the mark EMERSOM TECHNIK and design for goods in International Classes 7 and 11.[1]

Emerson Electric Co. ("Opposer") filed a notice of opposition to registration of Applicant's mark. As grounds for opposition, Opposer alleged (1) likelihood of confusion with its previously used and registered marks that contain the word EMERSON under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); (2) deceptiveness under Trademark Act Section 2(a), 15 U.S.C. § 1052(a); (3) false suggestion of a connection under Trademark Act Section 2(a); and (4) dilution.

In lieu of an answer, Applicant, on June 30, 2015, filed a first motion to dismiss the deceptiveness and false suggestion claims under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim. In response thereto, Opposer filed a first

[1] Application Serial No. 79138965, filed May 13, 2013 under Trademark Act Section 66a, 15 U.S.C. § 1141f(a), based on International Registration No. 1182960.

amended notice of opposition in which it deleted the false suggestion claim.[2] Applicant, on August 3, 2015, filed a motion to dismiss the deceptiveness claim from the first amended notice of opposition.

Opposer, on August 24, 2015, filed a motion for leave to file a second amended notice of opposition and to suspend this proceeding pending final determination of actions between the parties to cancel the Romanian and international registrations upon which the involved Section 66(a) application is based. Applicant has filed a brief in response thereto.

In view of the deletion of the false suggestion claim set forth in the original notice of opposition from the first and second amended notices of opposition, that claim is dismissed without prejudice. *See* Trademark Rules 2.106(c) and 2.114(c).

Notwithstanding the filing of the motion to suspend, the Board, in its discretion, elects to consider Opposer's motion for leave to file a second amended notice of opposition and Applicant's motion to dismiss the deceptiveness claim from the first amended notice of opposition together at this time. *See* Trademark Rule 2.117(b). Under Fed. R. Civ. P. 15(a), Opposer may amend its complaint only with Applicant's written consent or leave of the Board; leave must be freely given when justice so requires. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02. The Board liberally grants leave to amend pleadings at any stage of a proceeding, but will deny addition of a claim or defense that is legally "futile." *See generally Foman v. Davis*, 371 U.S. 178, 183

[2] Although the first amended notice of opposition includes an allegation that "Applicant's [m]ark falsely suggests a connection" with Opposer, the headings therein indicate that allegation is part of Opposer's deceptiveness claim and not a separate claim. First amended notice of opposition, paragraph 14.

(1962) ("futility of amendment" is a reason to deny a Rule 15(a) motion); *see also, American Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297, 1300 (TTAB 2010) (leave to amend answer denied where proposed additional defense was futile); *Leatherwood Scopes Int'l Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (denying leave to amend where proposed amendment would be futile).

Trademark Act Section 2(a) states, in relevant part as follows: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... [c]onsists of or comprises immoral, deceptive, or scandalous matter." The Board's primary reviewing court has articulated the following test for whether a mark consists of or comprises deceptive matter: (1) Does the term misdescribe the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe the misdescription? and (3) If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase? *See In re Budge Mfg. Co. Inc.*, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g.*, 8 U.S.P.Q.2d 1790 (TTAB 1987) (LOVEE LAMB deceptive with regard to automotive seat covers not made from lamb or sheep products); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (SUPER SILK deceptive with regard to clothing made of a silk-like fabric); *In re Organik Technologies Inc.*, 41 USPQ2d 1690 (TTAB 1997) (ORGANIK deceptive with regard to textiles and clothing that are made of cotton that is neither from an organically grown plant nor free of

chemical processing or treatment). *See also* TMEP §§1203.02 through 1203.02(b) (July 2015).

The Board has long recognized the distinct elements and purposes of Section 2(d) as compared to Section 2(a) deceptiveness claims. Section 2(d) prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services, whereas Section 2(a) prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See Miller Brewing Co. v. Anheuser-Busch, Inc.*, 27 USPQ2d 1711, 1712 (TTAB 1993). When a plaintiff's allegation is that consumers are "deceived into" buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim. *See Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 515 (TTAB 1984).

The deceptiveness claim set forth in the second amended notice of opposition is based on the allegation that consumers are likely to believe mistakenly that goods sold under Applicant's mark were manufactured in accordance with Opposer's manufacturing techniques and are connected with Opposer. *See* second amended notice of opposition, paragraphs 17-20. Because this claim is at its core based on confusion as to source of the goods at issue, the Board finds that it is a proper basis for a Section 2(d) claim, and not a Section 2(a) claim. Accordingly, the deceptiveness

claim set forth in the second amended notice of opposition is futile, and the motion for leave to file a second amended notice of opposition is denied.

Because the first amended notice of opposition was timely filed in response to Applicant's motion to dismiss the original notice of opposition, the first amended notice of opposition is accepts and is the operative complaint herein. *See* Fed. R. Civ. P. 15(a)(1)(B); TBMP § 507.02 (2015) (plaintiff can amend its complaint once as a matter of course in response to a Rule 12(b)(6) motion). The deceptiveness claim set forth in the first amended notice of opposition is based on the allegation that consumers are deceived into buying Applicant's goods under the mistaken belief that were produced under Opposer's manufacturing techniques or that they originate from the same source as Opposer's or they are connected with Opposer. See first amended notice of opposition, paragraphs 14-17. Because this claim is at its core based on confusion as to source of the goods at issue, it is a proper basis for a Section 2(d) claim, and not a Section 2(a) claim. Accordingly, the motion to dismiss the deceptiveness claim from the first amended notice of opposition is granted to the extent that that claim as set forth in paragraphs 11-17 of the first amended notice of opposition is hereby stricken as insufficient. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01. In view of the denial of Opposer's motion for leave to file a second amended notice of opposition, the Board finds that allowing Opposer leave to file a third amended notice of opposition to replead its deceptiveness claim is unwarranted. *See* TBMP § 503.03.

The Board turns next to the motion to suspend. Under Trademark Rule 2.117(a), "[w]henever it shall come to the attention of the ... Board that a party or parties to a pending case are engaged in a civil action ... which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action." The Board generally requires that a copy of the operative pleadings from the civil action at issue be included as an exhibit to an unconsented motion to suspend pending the outcome of a civil action, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues in the Board proceeding. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011); TBMP § 510.02. Because Applicant did not include copies of the operative pleadings as exhibits to its motion, the Board cannot ascertain whether the civil actions at issue may have a bearing upon this proceeding. Accordingly, consideration of the motion to suspend is deferred.

Applicant is allowed until **thirty days** from the mailing date set forth in this order to file copies of the pleadings in the Romanian and international civil actions and translations thereof where necessary so that the Board can determine whether suspension of this proceeding is warranted. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.,* 98 USPQ2d 1921, 1928 (TTAB 2011) (Board conducts proceedings in English); *Forest Laboratories Inc. v. G.D. Searle & Co.,* 52 USPQ2d 1058, 1061 (TTAB 1999). *See also* Trademark Act Section 70(a), 15 U.S.C. § 1141j(a); Trademark Rule 7.30 ("When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or

in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States.”). Proceedings herein are otherwise suspended.