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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221590
Party	Defendant S.C. ION MOS S.R.L.
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EMERSON ELECTRIC CO.,)	
)	
Opposer,)	
)	Opposition No. 91221590
v.)	Application No. 79138965
)	Mark: EMERSON TECHNIK & DESIGN
S.C. ION MOS S.R.L.,)	
)	
Applicant.)	
_____	/	

**APPLICANT’S MOTION TO DISMISS COUNTS II AND III FOR FAILURE
TO STATE A CLAIM PURSUANT TO FED. R. CIV. P. 12(B)(6)
AND TBMP §503, AND MOTION FOR SUSPENSION OF PROCEEDING**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Applicant S.C. Ion Mos S.R.L., through its undersigned counsel, hereby moves to dismiss Counts II and III of Opposer’s Notice of Opposition for Deceptiveness and False Suggestion of Connection or Association pursuant to Section 2(a) of the Trademark Act on the ground Opposer has failed to state claims upon which relief can be granted. Opposer also moves the Board to suspend the instant proceedings pending the outcome of this potentially dispositive motion.

INTRODUCTION

On May 13, 2013, Applicant filed a request for extension of protection of International Registration No. 1182960; the application was assigned No. 79138965. The application was published for opposition on October 21, 2014. Opposer obtained extensions of time to file a notice of opposition, and on April 20, 2015, Opposer filed a notice of opposition against Application No. 79138965 alleging a likelihood of confusion pursuant to Section 2(d) of the Trademark Act, deceptiveness under Section 2(a) of the Trademark Act, false suggestion of connection or association under Section 2(a) of the Trademark Act and dilution under the Federal Trademark Dilution Act.

On April 21, 2015, the instant proceeding was instituted. On May 30, 2015, Applicant filed a consented motion to extend the deadlines in the opposition, extending the deadline to answer to June 30, 2015. Applicant moves to dismiss Counts II and III of the Notice of Opposition, on the ground that each claim fails to state a claim upon which relief can be granted.

ARGUMENT

I. TIMING AND LEGAL STANDARD FOR A MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM PURSUANT TO FED. R. CIV. P. 12(B)(6) AND TBMP §503.

TBMP §503.01 states in relevant part: “[w]hen the defense for failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant’s answer.” The filing of a motion to dismiss tolls the time for filing an answer. TBMP §510.03(a), n. 7; *Hollowform Inc. v. AEF*, 180 U.S.P.Q. 284, 285 (TTAB 1973). This motion is timely filed as the time has not yet run for Applicant to file its answer.

Additionally, pursuant to TBMP §510.03(a), the filing of a dispositive motion such as a motion to dismiss will suspend the case “with respect to all matters not germane to the motion.” *See also* 37 C.F.R. §2.127(d); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 U.S.P.Q.2d 1434 (TTAB 1995) (suspending proceeding pending disposition of motion for judgment on the pleadings); *SDT Inc. v. Patterson Dental Co.*, 30 U.S.P.Q.2d 1707 (TTAB 1994) (stating the Board “will always suspend a case in which a potentially dispositive motion has been filed”); *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. at 830 (TTAB 1985) (suspending proceeding when applicant filed, among other motions, a motion to dismiss pursuant to Fed. R. Civ.P. 12(b)(6)).

Suspension of a case upon the filing of a dispositive motion is not automatic; however, when issuing a suspension order “the Board ordinarily treats the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion.” TBMP §510.03(a). Any paper filed during the pendency of a dispositive motion which is not relevant thereto will be given no consideration. Trademark Rule 2.127(d).

II. THE BOARD SHOULD DISMISS COUNTS II AND III BECAUSE THEY ARE MERELY RESTATEMENTS OF OPPOSER'S SECTION 2(D) LIKELIHOOD OF CONFUSION CLAIMS AND HAVE NOT BEEN PROPERLY PLEAD.

Under Fed. R. Civ. P. 12(b)(6), the Board must dismiss a claim that is not “plausible on its face.” TBMP §503.02 citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). 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. TBMP §503.02. The Board reviews a motion to dismiss by assuming all well-pleaded allegations are true, and construing these allegations in a light most favorable to the opposer. *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (TTAB 1985). To survive a motion to dismiss, Opposer must show that a valid ground exists for denying the registration sought. TBMP §503.02.

In Count II, Opposer alleged that the mark that is the subject of the opposed application is deceptive under Section 2(a) of the Trademark Act. In Count III, Opposer alleged that the mark creates a false suggestion of connection or association under the same section. Section 2(a) of the Trademark Act 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—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute ...

15 U.S.C. §1052(a).

Opposer has also alleged Applicant's Mark is likely to be confused with Opposer's EMERSON formative marks. Section 2(d) of the Trademark Act relating to likelihood of confusion 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—

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be **likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive ...**

15 U.S.C. §1052(d) (emphasis added).

The factual and legal allegations made in connection with Opposer's Section 2(a) and Section 2(d) claims are virtually identical. As will be discussed in detail below, the Board has long recognized the distinct elements and purposes of Section 2(d), Section 2(a) deceptiveness and Section 2(a) false suggestion of connection claims. Opposer has not properly plead these claims, but merely restated its likelihood of confusion claim accompanied by cites to Section 2(a). Opposer's Counts II and III should be dismissed because Opposer has failed to properly plead these claims.

A. COUNT II FAILS TO STATE A CLAIM BECAUSE OPPOSER DID NOT PLEAD THE ESSENTIAL ELEMENTS OF A § 2(A) DECEPTIVENESS CLAIM.

As TMEP §1203.02(b) notes, a mark is deceptive if the following criteria are met:

1. The mark is misdescriptive of the character, quality, function, composition or use of the goods;
2. Prospective purchasers are likely to believe that the misdescription actually describes the goods; and
3. The misdescription is materially likely to affect a consumer's decision to purchase.

As the Board stated in *Miller Brewing Co. v. Anheuser-Busch, Inc.*, 27 U.S.P.Q. 2d 1711, 1712 (TTAB 1993):

A proper pleading of "deceptiveness" under Section 2(a) requires the plaintiff to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act 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, e.g. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. Bell South Corp.*, 18 USPQ2d 1307 (TTAB 1990) (issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984) (issue was whether use of phrase CERTIFIED HEARING AID AUDIOLOGIST as part of a collective membership mark deceived consumers into believing that hearing aid dealers possessed training and education of audiologists); and *Tanners' Council of America, Inc. v. Samsonite Corporation*, 204 USPQ 150 (TTAB 1979) (issue was whether use of SOFTHIDE for imitation leather material deceived consumers by leading them to conclude goods were made of real leather).

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. (Emphasis added.)

See also, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:58 (4th ed. 2011); *Springs Indus., Inc. v. Bumblebee Di Stefano Ottina et.al*, 222 U.S.P.Q. 512, 515 (dismissing Section 2(a) claim based on alleged source of origin deceptiveness because such deception “is the basis for a Section 2(d), but not a Section 2(a) ... claim”).

None of the statements in the notice of opposition address the elements required for a finding that Applicant's mark is deceptive under Section 2(a). Opposer has not alleged *any* facts that, if true, would demonstrate that Applicant's Mark leads consumers to draw a false conclusion about the *nature or quality* of the applied-for goods, that consumers would be likely to believe that the misdescription describes the goods, or that the misdescription would materially affect purchasing decisions. Rather, the claims of Count II merely parrot the likelihood of confusion claims under Section 2(d) of the Trademark.

As such, Opposer has not properly plead a claim of deceptiveness pursuant to Section 2(a) of the Trademark Act, and Count II should be dismissed on such basis. Applicant further submits that the EMERSON TECHNIK & DESIGN mark is not descriptive or misdescriptive of any goods or services, and as such, is not the proper subject of a Section 2(a) claim.

B. COUNT III FAILS TO STATE A CLAIM BECAUSE OPPOSER FAILED TO PLEAD THE ESSENTIAL ELEMENTS OF A § 2(A) FALSE SUGGESTION OF CONNECTION CLAIM.

Count III is likewise merely another likelihood of confusion claim in disguise. A claim of false association of a connection pursuant to Section 2(a) must address the following elements:

1. The mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
2. The mark would be recognized as pointing uniquely and unmistakably to that person or institution;
3. The person or institution named by the mark or using the mark is not connected with the activities performed by the applicant under the mark; and,
4. The fame or reputation of the person or institution is such that when the mark is used to identify the applicant's goods or services, a connection with that person or institution would be presumed.

TMEP §1203.03(c).

The notice of opposition is primarily defective as to at least the first and second elements. Relative to these two elements, to properly state a claim for false association, an opposer must “allege facts from which it may be inferred that the applicant's mark points uniquely to opposer, as an entity -- i.e., that applicant's mark is opposer's identity or "persona" -- and that purchasers would assume that goods bearing applicant's mark are connected with opposer.” *Miller Brewing* at 1712. Stated another way, a proper claim must “assert that the letters applicant seeks to register point ‘uniquely and unmistakably’ to opposer, as an identifier of its corporate persona, rather than as an identifier of the source of particular goods.” *Miller Brewing* at 1713, citing *McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 U.S.P.Q. 45 (TTAB 1985).

The notice of opposition fails to do this. Opposer includes no allegations relating to its identity or persona. Instead, Opposer summarily alleges that “use of Applicant’s Mark in connection with the goods claimed in the Opposed Application falsely suggest a connection with Opposer ...” Notice of Opposition, ¶ 13. All of the statements in the notice of opposition allege likelihood of confusion with regard to the source of the goods, not a false suggestion of an association with Opposer’s identity or persona. Nowhere does Opposer state how or why such false suggestion of connection arises with regard to Opposer’s identity or persona. In fact, the allegations included in paragraphs one to twelve of the Notice of Opposition relate primarily to source confusion with respect to the parties’ goods, not with respect to Opposer itself. *See e.g., Traveling Software, Inc. v. Alan E. Mittell*, Opposition No. 94,678, at 4, n. 2 (TTAB 1996) in which the Board dismissed allegations highly similar to the allegations in the instant notice of opposition because they were based on the premise that purchasers would be deceived into buying applicant’s goods under the mistaken belief they originate from the same source as the opposer.

Importantly, like in *Miller Brewing*, Opposer has also failed to allege that the designations that comprise its identity or persona “point uniquely and unmistakably” to Opposer, Emerson Electric Co.¹ That the marks at issue point uniquely and unmistakably to Opposer, and only Opposer, is an essential element of a false association claim, which is missing from the notice of opposition.

The allegations in Claims II and III in the notice of opposition are mere restatements of Opposer’s claim of likelihood of confusion under Section 2(d). They do not meet the standards set forth under Fed.R.Civ.P. 12(b)(6) and therefore should be dismissed.

REQUEST FOR SUSPENSION OF PROCEEDINGS

The filing of the instant Motion to Dismiss tolls the time for Applicant to file an answer. TBMP §510.03(a), n. 7; *Hollowform Inc. v. AEF*, 180 U.S.P.Q. at 285 (denying the opposer’s Motion for Judgment by Default where the applicant filed a Motion to dismiss in lieu of an answer, thereby tolling the applicant’s time to file an answer). Moreover, it is the Board’s practice to suspend a proceeding pending the decision on any potentially dispositive motion. TBMP §503.01. Accordingly, Applicant requests the Board suspend the instant proceeding pending a decision on the motion.

Applicant respectfully requests that the Board grant *Applicant’s Motion to Dismiss Counts II and III for Failure to State a Claim Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503, and Motion for Suspension of Proceeding* with prejudice.

¹ While a matter for trial, Applicant questions how Opposer will be able to demonstrate that the EMERSON mark and name “points uniquely unmistakably” to Opposer, since Opposer has entered into coexistence agreements with third parties permitting such third parties to use and/or register EMERSON formative trademarks.

Respectfully submitted,

Date June 30, 2015

s/Michelle L. Visser
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CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing *Applicant's Motion to Dismiss for Failure to State a Claim pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, and Motion for Suspension of Proceeding* by causing a true and correct copy thereof to be sent via first class mail, postage prepaid to:

Lisabeth H. Coakley
Harness, Dickey & Pierce, P.L.C
5445 Corporate Dr, Suite 200
Troy, MI 48098

Date: June 30, 2015

s/Michelle L. Visser
Michelle L. Visser