

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: January 11, 2016

Opposition No. 91221951

Geoffrey, LLC

v.

Hair Are Us, Inc.

By the Trademark Trial and Appeal Board:

Pursuant to the Board's August 8, 2015 discovery conference memorandum, Applicant, on August 28, 2015, filed an amended answer wherein it pleaded a counterclaim to cancel Opposer's pleaded Registration Nos. 3859458 for the mark TOYRUS and design in the following form, , for "[r]etail store and on-line retail store services" in International Class 35.¹ In lieu of an answer to the

¹ Such registration was issued on October 12, 2010. The complete recitation of services in that registration is as follows:

Retail store and on-line retail store services all featuring toys, games, playthings, natural wooden toys, natural plush animals, organic cotton dolls, dolls, doll houses, doll accessories, doll house furniture, furniture, clothing, baby clothing, children's clothing, maternity clothing, outdoor toys, play sets, sandboxes, play swimming pools, swimming aids, pool rings, life jackets and arm floats for recreational use, outdoor play sets, sporting goods and equipment, roller skates, in-line skates, toy cars, toys trucks, toy airplanes, toy vehicle play sets, toy race tracks, toy action figures and play sets, toy activity tables for children with storage, toy boxes, board games, hand-held electronic games, puzzles, dolls, doll accessories, plush toys, educational toys, microscopes, telescopes, binoculars, science experiment kits, nature kits, magic sets, remote control vehicles and toys; retail store and on-line retail store services all featuring dress-up sets, Halloween costumes, books, cassettes, videos, CDs, DVDs, portable digital media players, musical instruments, toy musical instruments and microphones, computers, toy computers, educational computers, computer and video games, computer and

counterclaim, Opposer, filed a motion to dismiss the counterclaim under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim. Applicant filed a brief in response thereto.

A motion to dismiss under Rule 12(b)(6) is solely a test of the sufficiency of a complaint. *See* TBMP § 503.01 (2015). As plaintiff in the counterclaim, Applicant need only allege such facts which, if proved, would establish that Applicant is entitled to the relief sought; that is, (1) Applicant has standing to bring the proceeding, and (2) a valid statutory ground exists for cancelling the pleaded registration at issue. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Applicant's standing to bring the counterclaim is inherent in its position as defendant in the opposition. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999).

video game consoles and accessories, home and car electronics, baby safety items, baby monitors, humidifiers, vaporizers, baby food and formula, food, beverages, and utensils; retail store and on-line retail store services all featuring diapers, medicine, skin and hair care products, bedding and room decor, baby furniture, children's furniture, adult furniture, rocking chairs, lamps, light fixtures, safety gates, safety night lights, rear view mirror attachments, car seats, high chairs, step stools, booster seats, carriages and strollers. retail store and on-line retail store services all featuring bicycles, tricycles, toy motorized vehicles, ride-on toys, playpens, portable playpens, baby travel systems, play yards and beds for children, bed linen, comforters, pillow cases, rugs, wall paper, swings and bouncers, diaper bags and carriers, bath products and bibs; retail store and on-line retail store services all featuring, pens, paper, crayons, stationery, school supplies, artist supplies, stickers, coloring books, puzzle books, knapsacks, school bags, sports bags, gift cards and gift wrap; gift registry services.

The registration includes the a statement that “[t]he mark consists of the words ‘TOYSRUS’ with a backwards letter ‘R’ in blue with a white star design in the center with the letter ‘T’ in red, the letter ‘O’ in orange, the letter ‘Y’ in green” the letter ‘S’ in red, the letter ‘U’ in green and the letter ‘S’ in red.” The registration also includes a statement that “[t]he color(s) red, orange, green, blue and white is/are claimed as a feature of the mark.”

Regarding whether Applicant has pleaded a valid ground for cancelling the pleaded registration at issue, Federal Rule of Civil Procedure 8(a)(2) requires that a pleading contain a “short and plain statement of the claim showing that the pleader is entitled to relief.” Rule 8(a)(2) announces does not require detailed factual allegations, but requires more than labels, conclusions, formulaic recitations of the elements of a cause of action, and naked assertions. *See Ashcroft v. Iqbal*, 555 U.S. 662, 678 (2009). Indeed, “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Id.*, quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. *Ashcroft*, 555 U.S. at 678. The plausibility standard is not akin to a “probability requirement,” but it asks for more than a sheer possibility of the allegations asserted. *Id.* Indeed, a plaintiff need not allege specific facts that would establish a *prima facie* case for the claim(s) asserted. *See Bell Atlantic Corp.*, 550 U.S. at 547, *citing Swierkiewicz v. Sorema N. A.*, 534 U.S. 506, 508 (2002).

In the context of Board *inter partes* proceedings, a claim is plausible on its face when the plaintiff pleads factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that, the petitioner has standing and that a valid ground for cancellation exists. *Cf. Bell Atlantic Corp.*, 550 U.S. at 556. In particular, a plaintiff need only allege enough factual matter to suggest its claim is plausible and “raise a right to relief above the speculative level.” *Id.* at 555-56.

Although the Board, in deciding a Rule 12(b)(6) motion, must accept as true all factual allegations in the complaint, it is not bound to accept as true a legal conclusion couched as a factual allegation. *Id.* at 555.

The Board construes Applicant's counterclaim as seeking cancellation of Opposer's aforementioned registration on the ground of genericness. A generic term "is the common descriptive name of a class of goods or services." *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are incapable of being source indicators and are therefore unregistrable on both the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and the Supplemental Register.² *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015); *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *id.* "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn*, 228 USPQ at 530. The relevant public's perception is the primary consideration in determining whether a term is generic. *See Loglan Inst. Inc. v. Logical Language Group Inc.*, 902 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992); *Magic Wand Inc.*, 19 USPQ2d at 1552-53.

When a registered term is generic for one or more of the goods or services identified in a registration, that registration may be cancelled in its entirety. *See In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988). Where the term at issue

² However, a descriptive term that has become distinctive of an applicant's goods and/or services is registrable on the Principal Register under Trademark Act Section 2(f).

identifies goods that are a primary or central focus of the retail store or distributorship services, the Board has generally found that term to be generic. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (TIRES TIRES TIRES generic for retail tire store services). However, a display of descriptive, generic or otherwise unregistrable matter may be registrable on the Principal Register where the stylization of the matter or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves, or where it can be shown by evidence that the particular display has acquired distinctiveness. *See In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753-54 (TTAB 2002).

There are two steps in determining whether a term is generic: (1) What is the genus of goods or services at issue?;³ and (2) Is the term sought to be registered or retained on the register understood by the relevant public to refer primarily to that genus of goods or services? *See H. Marvin Ginn Corp.*, 228 USPQ at 531-32. The inquiry is based on whether the phrase *as a whole* is generic. *See Princeton Vanguard, LLC*, 114 USPQ2d at 1830-31. “Aptness is insufficient to prove genericness.” *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836-37 (Fed. Cir. 1999) (finding that the component words SOCIETY and

³ “Often, the genus is defined by the identified goods or services of the involved registration.” *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1761 (TTAB 2013). *See also* Trademark Act Section 14(3) (cancellation permitted “if the registered mark becomes the generic name for the goods or services”); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). The Board notes that many of Applicant’s cited examples of third-party use of the phrase R US are not for retail store services.

REPRODUCTIVE MEDICINE are generic is insufficient, without more, to render the phrase SOCIETY FOR REPRODUCTIVE MEDICINE generic as a whole).

Turning to the allegations in the counterclaim, Applicant alleges that the phrase “R US” is neither exclusively owned by Opposer nor distinctive to Opposer (paragraph 36); that the phrase “R US” is “a phonetic version of a generic term to denote a contextual relation with a subject matter immediately preceding it (paragraph 36); that the phrase “R US” is “a generic reference to the limited services offered under the mark, i.e., toys, games, playthings, natural wooden toys, natural plush animals, organic cotton dolls, dolls, doll houses, etc. (paragraph 37);” that the word “ARE” is an intransitive verb meaning “BE,” and the word “US” is a form of the pronoun “WE” (paragraph 38); that “[w]ithin the commercial context, the phrase ‘R Us’ is simply saying ‘you can buy a certain product here in our store, as this is what we specialize in selling’” (paragraph 39); that “[n]umerous commercial businesses utilize versions of “R Us” in connection with their goods and services for their consumers” (paragraphs 41, 51, and 84); that “[n]umerous marks have been registered and filed with the USPTO containing the words ‘R Us’, indicating that the words ‘R Us’ are not solely distinctive to Opposer or its alleged family of ‘R US’ marks (paragraph 85); and that, “because of the widespread use of the phrase “R Us” as alleged, *inter alia*, Opposer’s mark should be canceled (paragraph 90).

Applicant has failed to plead a plausible genericness claim in the counterclaim because that counterclaim is based only on the RUS component of the mark and not

the mark as a whole. *See Princeton Vanguard, LLC*, 114 USPQ2d at 1830-31. Even if Applicant intends to allege that the TOYSRUS mark is merely a combination of a generic term for goods sold through Opposer's retail stores, i.e., TOYS, and a generic term for retail store services, i.e., R US, such combination, without more, is not necessarily generic.⁴ *See In re American Fertility Society*, 51 USPQ2d at 1836-37. Rather, Applicant essentially must allege sufficient facts which would establish that the term TOYSRUS as a whole is the common descriptive name of a class of the services at issue and that the stylization of that term and design element as set forth in Opposer's registration does not create a separate commercial impression over and above that made by the generic term. *See Princeton Vanguard, LLC*, 114 USPQ2d at 1830-31; *H. Marvin Ginn Corp.*, 228 USPQ at 530; *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1232 (TTAB 2014) and cases cited therein. As such, Applicant has failed to state a claim upon which relief can be granted in the counterclaim.

In view of the foregoing, Opposer's motion to dismiss the counterclaim under Federal Rule of Civil Procedure 12(b)(6) for failure to state a claim is granted. In keeping with Board practice, Applicant is allowed until twenty days from the

⁴ Other than status and title copies of pleaded registrations, exhibits to pleadings are not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during that party's testimony period. *See* Trademark Rule 2.122(c). In any event, Applicant's lists of third-party corporations, applications and registrations that include the R US formative are insufficient to make the items identified in those lists of record. *See In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994).

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mailing date set forth in this order to file an amended answer and counterclaim. See TBMP § 503.03. Proceedings herein otherwise remain suspended.