

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GCP

Mailed: January 20, 2016

Opposition No. 91223528

Clariant Corporation

v.

Multisorb Technologies, Inc.

By the Trademark Trial and Appeal Board:

This proceeding now comes before the Board for consideration of Opposer's motion (filed December 11, 2015) to dismiss Applicant's counterclaim filed on November 5, 2015 in its entirety for failure to state a claim upon which relief may be granted. The motion is fully briefed.

As background, Applicant seeks to register the mark DESIPAX, in standard characters, for "desiccants" in International Class 1.¹

On August 27, 2015, Opposer filed a notice of opposition opposing registration of Applicant's mark on the following grounds: (1) priority and likelihood of confusion under Section 2(d) of the Trademark Act, and (2) dilution under Section 43(a) of the Trademark Act. In support of its opposition, Opposer, *inter alia*, has pleaded ownership of a registration for the mark DESI PAK for "prepackaged desiccants for

¹ Application Serial No. 86569259, filed on March 19, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming 1996 as both the date of first use and the date of first use in commerce.

use in closed packages for machine parts, electronic components, surgical instruments and supplies, tools, pharmaceuticals, food and film” in International Class 1.²

On November 5, 2015, Applicant filed its answer to the notice of opposition which included a counterclaim seeking to cancel Opposer’s pleaded Registration No. 1369682 for the mark DESI PAK on the sole ground of abandonment.

In lieu of filing an answer to Applicant’s counterclaim, Opposer filed a motion to dismiss the counterclaim for failure to state a claim.

Opposer’s Motion To Dismiss

The Board now turns to Opposer’s motion to dismiss Applicant’s counterclaim. To survive a motion to dismiss, “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). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its

² Registration No. 1369682, registered on November 12, 1985. Section 8 and 15 affidavits accepted on November 12, 2015. The term PAK is disclaimed.

allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case ...”).

For purposes of determining such motion, 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. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. *See Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

The Board has considered the parties’ submissions with regard to Opposer’s motion, presumes the parties’ familiarity with the facts and arguments therein, and does not recount the facts or arguments here.

A. Standing

The Board initially notes that Opposer does not directly attack Applicant’s standing to assert its counterclaim. The Board nonetheless finds that Applicant’s standing to assert its counterclaim arises from Applicant’s position as defendant in this opposition proceeding. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999).

B. Grounds for Cancellation

Turning next to the claim set forth in Applicant's counterclaim and following a careful review thereof, the Board notes that Applicant has asserted the following allegations to support its counterclaim of abandonment:

“Upon information and belief, Opposer has abandoned the DESI PAK mark by discontinuing use of the mark for each of the goods listed therein, with an intention not to resume use, and accordingly, Registration No. 1,369,682 should be cancelled.”

See ¶ 25 of Applicant's answer and counterclaim.

In order to set forth a sufficient claim to cancel the registration of a mark on grounds of abandonment, the plaintiff must plead ultimate facts pertaining to the alleged abandonment, thus providing fair notice to the defendant of plaintiff's theory of abandonment. *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). In this context, a mark is abandoned “[w]hen its use has been discontinued with intent not to resume such use. ... Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” Trademark Act Section 45, 15 U.S.C. § 1127. Therefore, to adequately plead such a claim, a plaintiff must recite facts which, if proven, would establish at least three consecutive years of nonuse, or alternatively, a period of nonuse less than three years coupled with proof of intent not to resume use. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990).

In this instance, Applicant has not pleaded any ultimate facts to support its allegations that Opposer's has abandoned use of its registered DESI PAK mark on

the goods identified in Opposer's pleaded registration with not intent to resume such use. Specifically, Applicant's pleading fails to set forth any facts regarding when the purported abandonment took place and/or a course of conduct that has resulted in an abandonment of Opposer's pleaded registered mark over a certain time period. Accordingly, the Board finds that Applicant has failed to plead properly a counterclaim of abandonment.

In view thereof, Opposer's motion to dismiss Applicant's counterclaim is **GRANTED** to the extent that Applicant is allowed until **February 9, 2016** in which to file and serve and amended answer and counterclaim which properly pleads a claim of abandonment pursuant to the guidelines set forth herein, failing which Applicant's counterclaim will be given no further consideration. In turn, Opposer is allowed until **twenty (20) days** from the date indicated on the certificate of service of Applicant's amended answer and counterclaim in which to file and serve an answer to the counterclaim.

Trial Schedule

Proceedings herein are resumed.³ Remaining trial dates are reset as follows:

Deadline for Discovery Conference	March 15, 2016
Discovery Opens	March 15, 2016
Initial Disclosures Due	April 14, 2016
Expert Disclosures Due	August 12, 2016
Discovery Closes	September 11, 2016
Plaintiff's Pretrial Disclosures	October 26, 2016
30-day testimony period for plaintiff's testimony to close	December 10, 2016

³ In the event Applicant fails to file and serve and amended answer and counterclaim by the deadline set forth in this order, the Board will issue an order modifying the trial schedule for this proceeding by deleting deadlines concerning Applicant's counterclaim.

Defendant/Counterclaim Plaintiff's Pretrial Disclosures	December 25, 2016
30-day testimony period for defendant and plaintiff in the counterclaim to close	February 8, 2017
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	February 23, 2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	April 9, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	April 24, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	May 24, 2017
Brief for plaintiff due	July 23, 2017
Brief for defendant and plaintiff in the counterclaim due	August 22, 2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	September 21, 2017
Reply brief, if any, for plaintiff in the counterclaim due	October 6, 2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.