

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

Mailed: May 31, 2016

Opposition No. 91224626

Astucci U.S. Ltd.

v.

Gatto Astucci S.p.A.

By the Board:

Now before the Board is Opposer's motion (filed February 12, 2016) to dismiss Applicant's counterclaim for cancellation of Opposer's pleaded Registration No. 2627183 for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6).

Procedural Issues

It is difficult to determine if Applicant's brief in opposition to the motion to dismiss is fully double-spaced as required by Trademark Rule 2.126(b). However, given its length and the point size of the type, it is clear that Applicant has not attempted to circumvent the twenty-five page limit under Trademark Rule 2.127(a).

Applicant is reminded that none of the exhibits attached to the counterclaim petition are in evidence. Trademark Rule 2.122(c).

Motion to Dismiss

To withstand a motion to dismiss, a counterclaim for cancellation need only allege such facts as would, if proved, establish that the party bringing the counterclaim is entitled to the relief sought; that is, (1) such party has standing, and (2) a valid ground exists for cancelling the subject registration. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, the counterclaim “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 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

For purposes of determining Opposer’s motion, the counterclaim must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(e). All of Applicant’s (as the counterclaim petitioner) well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to Applicant. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Standing

Opposer does not challenge Applicant’s standing. Indeed, Applicant’s standing in the counterclaim is established by Opposer’s assertion of the involved registration against Applicant in the opposition. See *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005) (“There is no issue regarding the standing of the parties to bring their respective oppositions and cancellation.... Applicant, by virtue of its position as defendant in the opposition, has standing to

seek cancellation of the pleaded registrations.”), citing *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999).

Valid ground

In the counterclaim petition, Applicant alleges that the counterclaim subject mark is a “common descriptive or generic term” (Counterclaim, preamble) which is used by others in a “common descriptive or generic sense” (CC, paras. 4 and 5). Opposer moves to dismiss the counterclaim on the basis that claims of mere descriptiveness and genericness are time barred. Pledaded Registration No. 2627183 issued October 1, 2002, on the Principal Register.¹

Mere descriptiveness

As set forth in the provisions of Section 14 of the Trademark Act, once a registration is more than five years old, the grounds on which it may be cancelled are limited, and they do not include the ground of mere descriptiveness. *See* Trademark Act § 14. Applicant states in its brief in opposition that it did not assert a claim of mere descriptiveness; it asserted only a claim of genericness. Confusion about the claim likely arises from Applicant’s repeated use of the phrases “common descriptive or generic term” and “common descriptive or generic sense” in the counterclaim. Even in its brief in opposition, Applicant continued to use the phrase “common descriptive or generic term.” It is possible that Applicant chose this wording after reviewing case law which provides that a generic term “is the common descriptive name of a class of

¹ Board may look to subject registration date and register on which registration issued, as objective facts not subject to proof when determining a motion to dismiss. *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009).

goods or services.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). Inasmuch as Applicant affirmatively states that it did not base the counterclaim on a ground of mere descriptiveness, it appears that repeated use by Applicant of the words “common descriptive” in the counterclaim allegations is the result of inartful drafting rather than an attempt to assert a claim that is not available. In any event, Opposer’s motion to dismiss the ground that the mark is merely misdescriptive is **granted**, and reference to descriptiveness is **stricken** from the counterclaim petition. Fed. R. Civ. P. 12(f)(1).

Genericness

A generic mark is one that describe the genus of goods at issue and is understood by the relevant public primarily to refer to that genus of goods. *Ginn*, 228 USPQ at 530. The foreign equivalent of a generic English term is no more registrable than the English term itself. “[A] word taken from a well-known foreign modern language, which is, itself, descriptive of a product, will be so considered when it is attempted to be registered as a trade-mark in the United States for the same product.” *In re N. Paper Mills*, 64 F.2d 998, 1002, 17 USPQ 492, 493 (CCPA 1933). *See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (“Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of the connotation in order to

ascertain confusing similarity with English word marks.”). Because generic terms “are by definition incapable of indicating a particular source of the goods or services,” they cannot be registered as trademarks on either register. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001).

Applicant alleges in the counterclaim that the counterclaim subject mark ASTUCCI is generic for the eyeglass case and handbag goods identified in the counterclaim subject registration (CC, para. 1); the Italian word ASTUCCI is the foreign equivalent the English word “cases” (CC, para. 2); U.S. consumers who understanding Italian will equate ASTUCCI with the word “cases” (CC, para. 4); eyeglass cases are often referred to as ASTUCCI in Italian (CC, para. 5). *See* 6 TTABVUE 7-8. These allegations are sufficient to allege a ground that the counterclaim subject mark is generic. *See In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009) (the “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English”); *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (“The ‘ordinary American purchaser’ in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language.... [defining “ordinary American purchaser” as the “average American buyer”] would write the doctrine out of existence.”).

Indeed, Opposer does not challenge the sufficiency of the allegations; instead, Opposer argues that a ground of genericness is time barred. Opposer’s argument is a matter of semantics, focusing on the wording in Section 14(3) that a mark may be

subject to cancellation “[a]t any time if the registered mark *becomes* the generic name for the goods....” (Emphasis added). Specifically, Opposer essentially argues that Section 14(3) allows cancellation of registered marks that have been registered for more than five years only on the grounds of genericide and not as generic *ab initio*. A mark is generic *ab initio* if it is generic at the time Opposer adopted it as a trademark. *See Schwan’s IP, LLC v. Kraft Pizza Co.*, 460 F.3d 971, 974 (8th Cir. 2006). A mark is generic as a result of genericide if the mark once functioned as a trademark but became generic through common usage. *See Hunt Masters, Inc. v. Landry’s Seafood Rest., Inc.*, 240 F.3d 251, 255 (4th Cir. 2001). In the section of its motion arguing that the genericness ground is time-barred, Opposer failed to provide any citation for its theory – there is not a single reference to case law or legislative history.

The Board and courts have found marks that have been registered for more than five years to be generic *ab initio*. *See e.g., Better Turf Seed Co., Inc. v. Garfield Williamson, Inc.*, 138 USPQ 396 (TTAB 1963); *Retail Servs. Inc. v. Freebies Publ’g*, 364 F.3d 535, 542–43 (4th Cir. 2004); *Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 936–39 (7th Cir. 1986). *See also Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812 (2d Cir. 1999) (“Our case ... concerns a mark that starts out generic and is sought to be given trademark significance by a manufacturer. That is what *Abercrombie [& Fitch Co. v. Hunting World*, 537 F.2d 4 (2d Cir. 1976)] and other cases forbid.”). Accordingly, Opposer’s motion to dismiss as time barred the ground that the counterclaim subject mark is generic is **denied**. The counterclaim petition will move forward on the sole ground that the mark in Opposer’s Pleaded Registration No.

2627183 is generic. Opposer is allowed until June 21, 2016, in which to file an answer to the counterclaim.

Schedule

Proceedings are **resumed**. Dates are reset on the following schedule:

Answer to Counterclaim Due	June 21, 2016
Deadline for Discovery Conference	July 21, 2016
Discovery Opens	July 21, 2016
Initial Disclosures Due	August 20, 2016
Expert Disclosures Due	December 18, 2016
Discovery Closes	January 17, 2017
Plaintiff's Pretrial Disclosures	March 3, 2017
30-day testimony period for plaintiff's testimony to close	April 17, 2017
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	May 2, 2017
30-day testimony period for defendant and plaintiff in the counterclaim to close	June 16, 2017
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	July 1, 2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	August 15, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	August 30, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	September 29, 2017
Brief for plaintiff due	November 28, 2017
Brief for defendant and plaintiff in the counterclaim due	December 28, 2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	January 27, 2018
Reply brief, if any, for plaintiff in the counterclaim due	February 11, 2018

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

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