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

Proceeding	91225838
Party	Defendant R.C. Bigelow, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Motion to Dismiss - Steep.pdf(343576 bytes)

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

Steep	)	
	)	Opposition No. 91225838
Opposer,	)	
	)	Serial No. 86595088
v.	)	
	)	
R.C. Bigelow, Inc.	)	
	)	
Applicant.	)	

MOTION TO DISMISS OPPOSER'S NOTICE OF OPPOSITION

In response to the Notice of Opposition filed by Steep ("Opposer") against R. C. Bigelow, Inc. ("Applicant" or "Bigelow") regarding Bigelow's application for registration of the mark STEEP BY BIGELOW ("Application"), Bigelow, by its attorneys, hereby moves for dismissal of this proceeding pursuant to Fed.R.Civ.P. 12(b)(6) and T.B.M.P. § 503.02 for failure to state a claim for relief and T.B.M.P. § 306.01 for Opposer's failure to timely file an opposition ("Motion to Dismiss"). In support of its Motion to Dismiss, Applicant submits the following:

FACTUAL BACKGROUND

R.C. Bigelow, a corporation of Fairfield, Connecticut, filed Application Serial No. 86/595,088 in the Trademark Office on April 13, 2015 for the mark STEEP BY BIGELOW for use in connection with "tea" in International Class 30 (hereinafter, the "Application"). The Application was published for opposition in the Official Gazette on September 8, 2015. Pursuant to 37 C.F.R. § 2.101(c), any interested party had until October 8, 2015 to either file an Opposition to the Application or, pursuant to 37 C.F.R. § 2.102, file a request to extend the time for filing an opposition.

On October 6, 2015, a First 90 Day Request for Extension of Time to Oppose for Good Cause was requested for "STEEP . . . a partnership, composed of JEFF PIAZZA, USA under the laws of DELEWARE [sic]" with an address of 80 Daniel St., #53, Portsmouth, New Hampshire 03802 ("Delaware Steep Entity"). The request was submitted by Jordan Brooks of STEEP with the same New Hampshire address. The request was granted and the Delaware Steep Entity's deadline to oppose the Application was extended until January 6, 2016.

On January 5, 2016, a different corporate entity, namely, Steep, Inc., a California corporation with an address at 119 N. Fairfax Avenue Suite 428, Los Angeles, CA 90036 ("California Steep Corporation"), filed the subject Notice of Opposition.[1] The Notice of Opposition identifies the Opposer as Steep, Inc. a "tea company formerly of the State of Connecticut" with an address of 119 N. Fairfax Avenue Suite 428, Los Angeles, CA 90036. (D.I. # 1). The form submitted with the Notice of Opposition alleges that the relationship to the party who filed the extension of time to oppose is that the "opposition will be handled by another director of the corporation, namely the founder of Steep, former long-time state of Connecticut resident and former trademark holder for former registered trademarks for Steep in IC 030 and IC032: 2821874, 2844179." However, the alleged corporation that filed the request for extension of time, namely, the Delaware Steep Entity is different from the California Steep Corporation, which filed the Notice of Opposition.

In the Notice of Opposition, Opposer alleges that Applicant's mark is confusingly similar to the mark STEEP which was "formerly registered and still in common law use under Registration numbers 2821874 and 2844179" (collectively referred to as "Cancelled Registrations") and cites

[1] The Form lists Steep as the Opposer, but the pleading attached to the form makes clear that the Opposer is "Steep, Inc."

Trademark Act § 2(d), likelihood of confusion, as the basis for its opposition. However, the cited registrations were cancelled over five years ago on October 22, 2010 and December 31, 2010, respectively, for failure to file the required Section 8 Declarations of Continued Use. The Notice of Opposition baldly alleges priority on the basis of the Cancelled Registrations and that the mark(s) are allegedly "still in common law use" and allegedly have "prior usage for nearly twenty years" without any other facts.

Applicant respectfully submits that Opposer's failure to timely file an opposition and to sufficiently plead a claim for relief warrants dismissal of the opposition.

ARGUMENT

I. The Board Should Dismiss The Notice of Opposition Because Opposer's Filing Is Untimely

Opposer failed to timely file an extension of time to oppose Bigelow's Application, and as a result, was not entitled to file an opposition past the statutorily imposed deadline. An opposition must be filed within thirty days after publication of an applicant's application, or within an extension of time for filing an opposition. 37 C.F.R. § 2.101(c). Pursuant to T.B.M.P. § 206.02, an extension of time to oppose is a personal privilege, and an opposition filed during an extension of time may only be filed in the name of the party to whom the extension was granted. T.B.M.P. § 206.02.

An opposition filed by a party different from the party to whom the extension of time was granted might be accepted upon a showing to the Board's satisfaction that the 1) opposer is in privity with the party to whom the extension was granted; or 2) the misidentification of the party in the request for extension of time was by "mistake" as set forth in 37 C.F.R. §2.102(b). Privity between the party filing the opposition and the party to whom the extension was granted can be established based on a principle of mutual or successive relationship to the same right of property

namely, the successive ownership of a mark, or use by related companies as defined in Lanham Act §§5 and 45. T.B.M.P. §206.02. "Mistake" as used in 37 C.F.R. §2.102(b) means "a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named." T.B.M.P. §206.03; *see also Cass Logistics Inc.*, 27 U.S.P.Q.2d 1075, 1077 (P.T.O. Apr. 27, 1993); *Custom Computer Servs., Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 1337 (Fed. Cir. 2003) (holding that a mistake as to the form of the correct entity's name is excusable, but it is not excusable to substitute one entity in the place of a different existing legal entity). Applicant respectfully submits that neither of the foregoing two conditions are met in the instant matter and, as such, the opposition should be dismissed.

The party who initially requested an extension of time to oppose the Application was the Delaware Steep Entity, namely, STEEP, a Delaware partnership allegedly compromised of Jeff Piazza and Jordan Brooks with an address at Portsmouth, New Hampshire. *See* Extension of Time Request, TTAB Proceeding Number 86595088. The party who filed the Notice of Opposition was the California Steep Corporation, namely, Steep, Inc., a "company formerly of the State of Connecticut" with an address in Los Angeles, California. *See* Notice of Opposition, pg. 1.

Here, there can be no "mistake" because the Delaware Steep Entity and the California Steep Corporation are separate and distinct legal entities. Moreover, Opposer did not state in its Notice of Opposition any plausible facts on which to base a claim that Opposer is in privity with respect to its alleged STEEP mark with the party to whom the extension of time was granted, namely, the Delaware Steep Entity. There are no allegations in the Notice of Opposition that the Delaware Steep Entity ever owned the alleged mark, nor used it under Opposer's control. There is no plausible basis on which to conclude that the Opposer and the Delaware Steep Entity are in privity

or that any mistake was made in the misidentification. Accordingly, the Board should dismiss this Opposition as untimely.[2]

II. Opposer's Notice of Opposition Should be Dismissed for Failure to State a Claim for Relief

A. Legal Standard for A Motion To Dismiss

A motion to dismiss under Fed.R.Civ.P. 12(b)(6) is a test of the sufficiency of the complaint. *See* T.B.M.P. § 503.01. To survive such a motion, Opposer must allege sufficient factual matter, which if proven, establish that (1) Opposer has standing to maintain the proceeding; and (2) a valid ground exists for opposing the mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (C.C.P.A. 1982); *see also Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); T.B.M.P. § 503.02.

A complaint must include sufficient allegations "to give the defendant fair notice of what the . . . claim is and the grounds upon which it rests." *Bell Atlantic v. Twombly,* 550 U.S. 544, 545 (2007). A complaint that fails to state a claim for relief may be dismissed. Fed.R.Civ.P. 12(b)(6). When deciding a motion to dismiss under Fed.R.Civ.P. 12(b)(6), all factual allegations in the complaint must be taken as true, but "the tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions." *Ashcroft v. Iqbal,* 556 U.S. 662, 663 (2009).

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[2] It should also be noted that Opposer incorrectly and impermissibly opposes the Application with a Letter of Protest "pursuant to TMEP 1715.01(A)(2)." The deadline to file a Letter of Protest regarding the Application expired on October 8, 2015, 30 days after the September 8, 2015 date of publication. Filing a request for extension of time to oppose does not extend the 30-day deadline for filing a Letter of Protest. See TMEP §1715.03(b). As such, Opposer's Letter of Protest should be denied as untimely. *In re BPJ Enterprises Ltd.*, 7 USPQ2d 1375 (1988); TMEP §1715.03(b).

For opposition proceedings before the Board, a claim has facial plausibility if the opposer pleads factual content that allows the Board to draw a reasonable inference that the opposer has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, an opposer should allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *TotesIsotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

For all the reasons stated below, the Board should dismiss the Notice of Opposition for failure to state a claim.

B. Opposer Has Failed To Plead Sufficient Facts To Set Forth The Elements Of Standing Or Priority of Use, Especially Where The Registrations Relied Upon Were Cancelled

Opposer fails to adequately plead its grounds of opposition under the standard of *Iqbal* and *Twombly*. The entirety of Opposer's allegations are set forth in the following paragraphs:

> As grounds for this Letter of Protest [and initial pleading], it is alleged that the proposed mark in application Serial Number 86595008 is confusingly similar to the marks formerly registered and still in common law use under Registration Numbers 2821874 and 2844179, and should be refused registration on the principal register of trademarks under Trademark Act §2(d). . . .
>
> Pleading opposer STEEP alleges a reasonable basis for confusion, a real interest and a direct personal stake in the outcome of this proceeding. . . .
>
> Opposer believes confusion is evidenced by the same word used for the same international class of goods, with prior usage for nearly twenty years, ten of which in the same state of Connecticut where Steep was founded.

In order to plead a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), Opposer must allege enough facts to demonstrate (1) priority, based on its ownership of pleaded registrations/applications filed prior to the filing date of Applicant's application or common law rights in the mark used continuously since prior to the filing date of Applicant's application; and (2) likelihood of confusion between the marks at issue. See Trademark Act Section 7(c), 15 U.S.C.

Section 1057(c); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001); *Zirco Corp. v. American Telephone and Telegraph Co.,* 21 USPQ2d 1542 (TTAB 1991). Opposer has failed to plead specific facts to support each of the above-referenced elements for at least the following reasons.

First, Opposer fails to set forth sufficient facts to demonstrate priority of use of the mark prior to Applicant's application date, April 13, 2015. The registrations cited by Opposer were cancelled by the Trademark Office on October 22, 2010 and December 31, 2010, respectively, because the registrant failed to file the required Section 8 Declarations of Continued Use. According to T.B.M.P. §704.03(b)(1)(A), a cancelled registration is "not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used." TBMP § 704.03(b)(1)(A); *see also In Re Visionstar, Inc.*, 2013 WL 6046653, at *6 (Nov. 6, 2013) (cancelled registrations have no probative value); *Action Temporary Services Inc. v. Labor Force Inc.,* 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a cancelled registration does not provide constructive notice of anything."). In view thereof, any benefits conferred by Opposer's cancelled registrations, including the presumptions afforded by Section 7(b) of the Trademark Act, were lost when the registrations expired. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007) (a cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act); *In re Hunter Publishing Company*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought."). As a result, any reliance by Opposer on the Cancelled Registrations as support for "priority" is misplaced.

The Trademark Act permits opposition on the basis of prior use of "a mark or trade name previously used in the United States by another and not abandoned," i.e., ownership of a common-law trademark right. Trademark Act § 2(d). But because unregistered marks are not entitled to the presumptions established by statute, it is Opposer's burden to plead that it owns a trademark, which was used prior to applicant's mark, and not abandoned. See Trademark Act §§ 2(d) and 7(b)-(c). Opposer fails to plead any of the foregoing elements.

Other than its misplaced reliance on the Cancelled Registrations, Opposer has alleged no facts to prove any dates of use of the mark. Opposer fails to plead any facts to establish that it has any rights to the marks from the alleged trademark owner, which is a different entity from the Opposer, namely, Steep, LLC. Opposer also fails to plead that the marks have been in continuous use in interstate commerce and also fails to allege the lack of abandonment. Indeed, the lack of any factual allegations regarding abandonment (or alleged lack thereof) is problematic when the Cancelled Registrations were cancelled over five years ago for failure to file Statements of Use. "Merely because a party has used a mark a long time ago and it could use the mark in the future is not enough to avoid abandonment." *Gen. Motors Corp.*, 87 U.S.P.Q.2d 1179 (T.T.A.B. Apr. 21, 2008); *see also Silverman v. CBS Inc.*, 870 F.2d 40, 9 USPQ2d 1778, 1783 (2d Cir. 1989) (a proprietor may not protect a mark if he discontinues use of a mark and has no plans to use or permit its use in the reasonably foreseeable future; a bare assertion of possible future use is not enough) (citations omitted). In addition, the Trademark Act establishes that "[n]onuse for 3 consecutive years shall be *prima facie* evidence of abandonment." 15 U.S.C. § 1127. Opposer's marks were cancelled five years ago. The opposition fails to state whether Opposer's claimed common law usage pre-dates Applicant's use and whether the mark has been continuously used despite cancellation of the registrations. The only possible inference from the pleadings is that Opposer

abandoned its mark and, as such, failed to satisfy its burden in establishing that it "owns a trademark, which was used prior to applicant's mark, and not abandoned." Trademark Act § 2(d). Opposer's failure warrants dismissal of the opposition.

CONCLUSION

Accordingly, for all the reasons set forth above, Opposer's pleading falls short of meeting the requirements under *Twombly* and *Iqbal* and should be dismissed for failure to state a claim under Fed.R.Civ.P. 12(b)(6) as well as for failing to timely file an opposition in accordance with T.B.M.P. § 307.01.

Date: February 23, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of February, 2016, a true and correct copy of the foregoing Motion to Dismiss Opposer's Notice of Opposition was electronically filed with the Trademark Trial and Appeal Board as well as served via First Class mail to:

Steep
119 N. Fairfax Avenue, Suite 428
Los Angeles, CA 90036
Attn: Jeff Steep

Tonia Sayour