

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

GOODMAN

Mailed: January 22, 2004

Cancellation No. 92032853

CONCHITA FOODS, INC.

v.

FRITAS ENCANTO DE MONTERREY,
S.A. DE C.V

Before Simms, Cissel and Drost, Administrative Trademark Judges.

By the Board:

This case now comes up on petitioner's motions to compel filed May 5, 2003, and June 30, 2003; respondent's "amended answer"¹ or alternative motion to dismiss, filed August 6, 2003; and petitioner's consented motion to extend dates, filed August 7, 2003.

Petitioner's motion to extend is granted.

We now turn to respondent's motion to dismiss.

In support of its motion to dismiss, respondent argues that the petition to cancel should be dismissed because petitioner did not timely file the petition to cancel.

¹ Respondent has not filed a signed amended answer with its motion; has not made any arguments regarding amending its answer; and the motion itself is not a proper answer under Fed. R. Civ. P. 8. Therefore, we construe respondent's motion as one for dismissal only.

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Respondent asserts that the involved registration, Registration No. 2105538², was registered on October 14, 1997; that petitioner filed the petition to cancel "as stamped by the TTAB" without filing fee on August 8, 2002³; that the filing fee was not paid until October 22, 2002; that according to statute, the new filing date for the petition to cancel is October 22, 2002, the date the filing fee was paid; that petitioner had five years to file the petition to cancel or until October 14, 2002, and therefore, the petition to cancel is untimely and should be dismissed.

In response, petitioner argues that its petition to cancel was acknowledged as received by USPTO on September 6, 2002 and is timely; that to the extent respondent's motion is an attempt to amend its answer, it should be stricken for noncompliance with the rules, which require a signed copy of

² Presently, no Section 8 affidavit of continued use has been filed by registrant. See Trademark Rule 2.160(a)(i). Under Section 8(a) of the Trademark Act, the owner of a registration must file an affidavit or declaration of continued use or excusable nonuse on or after the fifth anniversary and no later than the sixth anniversary of the date of registration or date of publication under Section 12(c) of the Act. Under Section 8(c)(1) of the Trademark Act, an owner may file the affidavit or declaration of use within a grace period of six months after the expiration of the deadline set forth in Section 8(a) of the Act, accompanied by an additional grace period surcharge. The pendency of the petition to cancel does not obviate a registrant's fulfillment of the Section 8 requirements by filing the prescribed declaration or affidavit. See, e.g., *Abraham Seed v. John One Ten*, 1 USPQ2d 1230, 1232, n. 7 (TTAB 1986).

³ Board records indicate that the petition to cancel was filed with the USPTO on August 2, 2002.

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the proposed pleading and leave of the party or the Board; and that respondent's argument with regard to dismissal due to incontestability fails because the petition to cancel is based on the ground of abandonment under Section 14(3) which can be filed at any time.

Respondent filed its answer on March 4, 2003 and filed its motion to dismiss on August 6, 2003. Because the motion to dismiss was filed after respondent filed its answer, we construe respondent's motion as one for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c).

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings. See 5A Wright and Miller, *Federal Practice and Procedure: Civil 2d* Section 1367 (2d ed. 2003); TBMP Section 504.02.

Inasmuch as respondent is essentially arguing that petitioner has failed to state a claim, the standard we apply to respondent's motion is the same as that set forth in Fed.R.Civ.P. 12(b)(6). *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990). Therefore, we shall consider whether petitioner has alleged such facts as would, if proven, show that petitioner has standing to petition for cancellation of the registered mark and that a statutory ground for cancelling such registration exists. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

After consideration of the petition to cancel, we find that petitioner has adequately alleged standing.

We now turn to consideration of whether the grounds for cancellation state a claim.

With regard to the ground of likelihood of confusion, we find this ground is not an available ground for cancellation inasmuch as the filing date of the petition to cancel is after the fifth year anniversary of the involved registration.

As respondent correctly argued, the filing date of a petition to cancel is the date of receipt of the petition in the USPTO and the required fee. In this case, the fifth year anniversary for the registration was October 14, 2002, and although petitioner filed the petition to cancel on August 2, 2002, petitioner did not pay the filing fee for the petition to cancel until October 22, 2002. Therefore, October 22, 2002 is the filing date for the petition to cancel, and the ground of likelihood of confusion under Section 2(d) is unavailable.⁴ See e.g., *Texas Instruments*

⁴ Section 14(3) states in part that a petition to cancel may be filed "[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 USC §1054] or of subsection (a), (b), or (c) of section 2 [15 USC §1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used."

Inc. v. Conklin Instruments Corp., 161 USPQ 740, 741 (TTAB 1969) ("[S]ubsequently filed complaint by petitioner was untimely" even when preceded by a timely unverified petition).

In view thereof, petitioner's allegations regarding likelihood of confusion are stricken from the petition to cancel.

With regard to the remaining ground for cancellation, abandonment, we find that the claim of abandonment is adequately pled, and as petitioner correctly argues, this ground for cancellation may be brought at any time. In view thereof, respondent's motion to dismiss is denied with respect to the ground of abandonment.

We now turn to petitioner's motions to compel.

Petitioner filed a motion to compel on May 5, 2003 due to respondent's failure to provide responses to its discovery requests. Respondent served its partial discovery responses on May 23, 2003. Thereafter, petitioner filed another motion to compel on June 30, 2003 complaining about the completeness of respondent's discovery responses.

Respondent has not filed a response thereto.

In view of the later filed motion to compel, we consider the only remaining issue with respect to respondent's discovery responses to be whether they are complete.

Upon review of respondent's discovery responses, we find that its responses to interrogatory nos. 7 and 8 are insufficient⁵ and that its responses to petitioner's document requests are also insufficient⁶.

In view thereof, petitioner's motion to compel is granted to the extent that if respondent has not already supplemented its responses to petitioner's interrogatory nos. 7 and 8 and petitioner's document requests, respondent is allowed until THIRTY DAYS to serve complete responses to these requests.

Proceedings are resumed.

Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	March 31, 2004
30-day testimony period for party in position of plaintiff to close:	June 29, 2004
30-day testimony period for party in position of defendant to close:	August 28, 2004
15-day rebuttal testimony period for party in position of plaintiff to close:	October 12, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

⁵ Respondent's response to both interrogatory nos. 7 and 8 is "will supplement."

⁶ Respondent's response to each of petitioner's document requests is "Registrant has not been given a sufficient amount of time for compliance with the request. Registrant will supplement."

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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.