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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 17, 2010

Opposition No. 91169226
Cancellation No. 92049146

Arcadia Group Brands Ltd

v.

Studio Moderna SA

Before Hairston, Cataldo and Bergsman, Administrative
Trademark Judges.

By the Board:

This case now comes up on applicant/respondent Studio Moderna SA's (hereinafter Studio Moderna) motion (filed November 9, 2009) to dismiss grounds 1, 4 and 5 of the amended/consolidated notice of opposition and petition to cancel.¹

By way of background, the opposition was filed by opposer Arcadia Group Brands Ltd. (hereinafter Arcadia Group) on February 17, 2006, with respect to Class 35² of

¹ Studio Moderna included exhibits to the motion. However, we construe this motion solely as one to dismiss inasmuch as the Board previously advised the parties that any motion for summary judgment is premature if filed prior to service of initial disclosures in the cancellation proceeding. Studio Moderna's reply brief has not been considered. Trademark Rule 2.127 specifically states "[t]he time for filing a reply brief will not be extended." The Board regrets the error in granting Studio Moderna's request for an extension of time to file a reply brief.

² Applicant's Class 35 services are as follows: "Providing home shopping services in the field of general consumer merchandise by

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Studio Moderna's multiclass application Serial No. 78239078
for the mark



on
the grounds of likelihood of confusion and violation of the
terms of the parties' settlement (coexistence) agreement.
On April 26, 2007, the Board granted partial summary
judgment in favor of Studio Moderna on the ground relating
to the parties' settlement agreement. The Board found that
the "agreement, . . . does not preclude applicant from using
the TOP SHOP mark in conjunction with any services" and
"that the provisions of the parties' settlement agreement do
not place any limitation upon applicant's use of the mark
TOP SHOP in association with any services, but only in
connection with goods classified in International Class 25."

means of television; order taking for goods of others; order
processing and fulfillment services; advertising, marketing and
promotional services for goods of others, namely preparing and
placing advertisements in print, radio, television, catalogs and
via a global communications network; direct response retail
services by means of infomercials in the field of general
consumer merchandise; production and distribution of
infomercials; promoting the sale of goods and services of others
and preparing and placing advertisements through a global
computer network; import, export and distributorship services
featuring general consumer merchandise; mail order catalog
services featuring general consumer merchandise; arranging and
conducting sales and marketing conferences; mail order services,
mail order catalog services, on-line retail services and

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The opposition then proceeded on the likelihood of confusion ground. On April 7, 2008, Arcadia Group filed a cancellation proceeding with respect to Studio Moderna's Registration No. 3389652 for the mark TOP SHOP TV for Class 35 services.³ On April 25, 2008, Arcadia Group filed a motion to consolidate the cancellation proceeding with the opposition proceeding, which the Board granted on September 15, 2008. Arcadia Group then sought, on April 30, 2009, a motion for leave to amend the notice of opposition and petition to cancel and to file a consolidated pleading, which the Board granted on September 30, 2009. Thereafter, Studio Moderna filed its motion to dismiss with respect to grounds 1, 4 and 5 of the amended consolidated notice of opposition and petition to cancel.

We now turn to the motion to dismiss.

To survive a motion to dismiss, Arcadia Group need only allege such facts as would, if proved, show (1) that Arcadia Group has standing to oppose registration of the involved application and to petition for cancellation of the involved registration and (2) that a statutory ground for denying the registration sought and for cancelling the registration exists. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d

electronic catalog services in the field of general consumer merchandise."

³ "On-line retail services in the field of general consumer merchandise."

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1023 (Fed. Cir. 1999); *Lipton Industries, Inc., v. Ralston Purina Co.*, 670 F.2d 1029, 213 USPQ 185 (CCPA 1982). For purposes of a motion to dismiss, all of Arcadia Group's well pleaded allegations in the consolidated pleading must be accepted as true. See TBMP § 503.02 (2d ed. rev. 2004).

Studio Moderna has not disputed Arcadia Group's standing, and standing is sufficiently pleaded by the allegations in paragraphs 1-9 and 16 of the consolidated pleading. Furthermore, if Arcadia Group can show standing as to one ground, it has the right to assert any other ground as well. See, e.g., *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n. 10 (TTAB 2009).

We turn then to consideration of whether Arcadia Group has sufficiently pleaded grounds 1, 4 and 5 of the consolidated pleading to state a claim, so that, if proved, Arcadia Group would be entitled to the relief it seeks.⁴

Ground 1 (Paragraphs 11-13)

Arcadia Group has essentially reasserted the claim in the opposition proceeding for which the Board granted summary judgment to Studio Moderna that the parties' settlement agreement prohibits registration of (and/or

⁴ Studio Moderna has argued the merits of grounds 1, 4 and 5 in its motion to dismiss. Because the scope of what may be considered on a motion to dismiss is limited to the legal sufficiency of the complaint, such arguments have not been considered in deciding the motion.

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subjects respondent to cancellation) with respect to any Class 35 services used in connection with TOP SHOP TV marks.

The parties dispute the availability of this claim in view of the Board's decision on summary judgment in the opposition.

We find that this ground is unavailable in view of the law of the case. Under the doctrine, courts should generally "refuse to reopen what has been decided."

Messenger v. Anderson, 225 U.S. 436, 444 (1912). The doctrine precludes our reconsideration of the Board's prior decision on summary judgment regarding the plain meaning of the parties' settlement agreement unless "special circumstances" exist such as intervening changes in decisional law applicable to such issues, avoiding clear error, or preventing a manifest injustice. *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 31 USPQ2d 1001, 1007 (Fed. Cir. 1994).

Although Arcadia Group argues that it has uncovered evidence in discovery which was not available at the time of the motion for summary judgment regarding Studio Moderna's use of Class 25 goods in connection with the Class 35 services, we find that this evidence does not fall under one of the special circumstances such that we need to revisit the plain meaning of the coexistence agreement.

In view thereof, Studio Moderna's motion to dismiss ground 1 (paragraphs 11-13) from the consolidated notice of opposition and petition to cancel is granted.

Ground 4 (paragraph 18)

Under this ground, Arcadia Group has alleged that Studio Moderna's "conduct may rise to the level of fraud" in that Studio Moderna is not using the mark in connection with all categories of general consumer merchandise and its use is limited to "five items". Arcadia Group further alleges that the description of services in the registration is "overly broad and indefinite."

Studio Moderna argues that this claim is an insufficiently pleaded fraud ground under Fed. R. Civ. P. 9(b) and that allegations relating to the scope of the recitation of services are not a basis for cancellation.

In response, Arcadia Group argues that it "does not presently assert fraud" and that its allegations regarding the description of services serve as a basis for cancellation as the Board has upheld refusals to register a mark when an applicant is unable to support a full line of goods or when an identification of goods is indefinite and unnecessarily broad.

Arcadia Group indicates it is not alleging fraud; therefore we need not consider the sufficiency of the pleading with respect to fraud. To the extent that Arcadia

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Group is raising the adequacy of the recitation of services as an additional ground for cancellation, the sufficiency of the recitation of services i.e., whether overbroad or indefinite or whether Studio Moderna's use can support a broad range of goods, is considered an ex parte examination issue which is not a proper ground for an inter partes proceeding. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989). To the extent that Arcadia Group is seeking a Section 18 restriction (i.e., modification) of the recitation of services to five items of general merchandise (dicing kitchenware, kitchen pan, kitchen knife, hand cleaning solution and back remedy), the allegation is insufficiently pleaded as Arcadia Group has not alleged abandonment as required for such a restriction. *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1438 (TTAB 1995) (in order to prevail on a counterclaim for partial cancellation based on nonuse with no intent to resume (or commence) use, a party must plead and prove standing and abandonment as a result of nonuse or other conduct by registrant in conjunction with the modification or limitation it seeks). Accordingly, Studio Moderna's motion to dismiss is granted with regard to this ground.

Ground 5 (paragraphs 19-20)

In this ground, Arcadia Group has alleged that the goods and services covered in Studio Moderna's U.S.

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application exceed the scope of goods covered in its Swiss Registration upon which its U.S. application is based.

Although the parties dispute the availability of this ground, this claim is available as a basis for opposition. See *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843 (TTAB 1989).

In view thereof, Studio Moderna's motion to dismiss is denied with regard to Ground 5 of the consolidated pleading.

In summary, Studio Moderna's motion to dismiss is granted with regard to Grounds 1 and 4, and denied with respect to Ground 5. Arcadia Group is granted leave to replead Ground 4 only to assert a Section 18 restriction, which includes a claim of abandonment in conjunction with its allegations of Studio Moderna's use on only five goods in connection with the Class 35 services, if appropriate.

If Arcadia Group determines it will not be amending Ground 4 to assert a Section 18 restriction, it should nonetheless, file a "clean copy" of the amended consolidated notice of opposition and petition to cancel in accordance with our ruling on the motion to dismiss to delete the unavailable grounds.

Proceedings are resumed in the consolidated proceeding with regard to the filing of an answer to the consolidated pleading. Proceedings are otherwise resumed in Cancellation No. 92049146 only, with Opposition No. 91169226 remaining suspended until the parties exchange initial disclosures in

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the Cancellation No. 92049146. Once the parties exchange initial disclosures in the cancellation proceeding, the suspension in the opposition proceeding will be lifted and both cases will proceed under the same amended Trademark Rules schedule.

Dates for filing an amended consolidated pleading (and/or clean copy) and Studio Moderna's time to answer, disclosure, discovery and trial dates are set forth below.

Time to File an amended pleading/clean copy	4/5/10
Time to Answer	4/25/10
Deadline for Discovery Conference	5/25/10
Discovery Opens	5/25/10
Initial Disclosures Due	6/24/10
Expert Disclosures Due	10/22/10
Discovery Closes	11/21/10
Plaintiff's Pretrial Disclosures	1/5/11
Plaintiff's 30-day Trial Period Ends	2/19/11
Defendant's Pretrial Disclosures	3/6/11
Defendant's 30-day Trial Period Ends	4/20/11
Plaintiff's Rebuttal Disclosures	5/5/11
Plaintiff's 15-day Rebuttal Period Ends	6/4/11

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