

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

MBA/mb

Mailed: February 18, 2010

Cancellation No. **92050284**

CHERUBS - The Association of
Congenital Diaphragmatic
Hernia Research, Advocacy and
Support

v.

Breath of Hope, Incorporated

**Before Walters, Walsh and Ritchie, Administrative Trademark
Judges**

By the Board:

This case now comes up for consideration of respondent's fully-briefed motion to dismiss petitioner's second amended petition for cancellation, filed August 11, 2009, and petitioner's uncontested motion for leave to file a third amended petition for cancellation, filed September 9, 2009.

Background

Respondent owns a Supplemental Registration of the mark COGENITAL DIAPHRAGMATIC HERNIA AWARENESS, in standard characters, for "Promoting public awareness of congenital diaphragmatic hernia; Public advocacy to promote awareness

of congenital diaphragmatic hernia" (the "Registration").¹ In its currently-operative second amended petition for cancellation, petitioner alleges that respondent "has harassed Petitioner and others asserting its purported trademark rights in the phrase 'congenital diaphragmatic hernia awareness,'" including by threatening to sue petitioner for infringement and contacting third parties regarding petitioner's use of phrases allegedly similar to "congenital diaphragmatic hernia awareness." As grounds for cancellation, petitioner alleges that respondent's mark is generic, and that respondent committed fraud when it swore in its application that no other person had a right to use a similar mark. Petitioner specifically alleges in support of its fraud claim that respondent's CEO, who swore to respondent's exclusive use of the mark in its Registration, "knew that Petitioner had prior use of the Purported Mark or phrases substantially similar to the Purported Mark and, by failing to disclose these facts to the USPTO, intended to procure a registration to which Registrant was not entitled" (Third Amended Petition for Cancellation, ¶19), and that these statements are material false statements that were knowingly made.

¹ Supplemental Registration No. 3503325, issued September 16, 2008 from an application filed April 1, 2008 which originally sought a Principal Registration, with a claimed date of first use in commerce of July 1, 2007.

Motion to Dismiss

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish: (1) that it has standing; and (2) a valid ground for opposition. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought. *See, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); TBMP §503.02 (2d ed. rev. 2004). 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); *see also* 5A Wright & Miller, *Federal Practice And Procedure: Civil 2d* §1357 (1990). 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).

Respondent first argues that the second amended petition for cancellation should be dismissed because the petition cites to 15 U.S.C. § 1064, which applies to marks on the Principal Register, rather than 15 U.S.C. § 1091, which applies to marks on the Supplemental Register. However, as petitioner notes in its response, a pleading need not include citation to any particular statute or rule, and respondent's arguments elevate form over substance. Furthermore, petitioner's motion for leave to file a third amended petition for cancellation to correct the error by citing to 15 U.S.C. § 1092 is uncontested, and is therefore hereby **GRANTED** as conceded. Trademark Rule 2.127(a). Petitioner's third amended petition for cancellation is now its operative pleading herein.² As the only difference between the second and third amended pleadings is the amendment to the statutory cite from 15 U.S.C. § 1064 to 15 U.S.C. § 1092, for judicial economy (i.e., so that respondent does not have to file a new motion to dismiss), we will consider the motion to dismiss in connection with the third amended pleading since they are substantively the same.

² While respondent argues that respondent should have cited 15 U.S.C. § 1091, the correct citation is to 15 U.S.C. § 1092, which addresses petitions for cancellation of Supplemental Registrations.

Respondent next argues that petitioner has not adequately alleged standing, because it has not asserted a "real interest" or a direct and personal stake in this proceeding's outcome. Specifically, respondent claims that petitioner has not alleged prior use of a trademark, and that because a Supplemental Registration confers limited rights, petitioner would not be damaged if the Registration is maintained. Respondent is wrong on both counts. First, petitioner alleges not only use of the phrase "congenital diaphragmatic hernia awareness," but that respondent is specifically challenging this use based on its Registration. Third Amended Petition for Cancellation ¶¶ 8, 19. This is an adequate allegation of petitioner's standing. Indeed, even if petitioner had not alleged use of the phrase "congenital diaphragmatic hernia awareness," petitioner has standing because petitioner alleges that both it and respondent are competitors who both raise awareness related to the disease. See *Books on Tape, Inc. v. The Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999). And petitioner has adequately alleged its standing by claiming that respondent is challenging petitioner's use of "congenital diaphragmatic hernia awareness." *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1977 (TTAB 1988). Second, petitioner is statutorily

entitled to seek cancellation of respondent's Supplemental Registration, even though it confers limited rights, and respondent's arguments directly contravene the statute. 15 U.S.C. § 1092.

Finally, respondent argues that Supplemental Registrations cannot, as a matter of law, be cancelled based on fraud, relying on 15 U.S.C. § 1091. Respondent is incorrect, once again, because the controlling statute is 15 U.S.C. § 1092, which does not so limit petitions to cancel Supplemental Registrations. *See, Bruce Foods Corp. v. B. F. Trappey's Sons, Inc.*, 192 USPQ 725, 727 (TTAB 1976) (in dicta: "[A] registration on the Supplemental Register may be cancelled on grounds other than prior use, such as abandonment, or non-use; and the language in Section 24 is broad enough to encompass other grounds such as those enumerated in Sections 2(a), (b), or (c), fraud and the like including any misstatement or false representation of fact contained in the application upon which the registration is based.").

Conclusion

For all of these reasons, respondent's motion to dismiss is hereby denied.³

Respondent is allowed until March 12, 2010 to answer the third amended petition for cancellation. Disclosure,

conferencing, discovery, trial and other dates are reset as follows:

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| Time to Answer | 3/19/10 |
| Deadline for Discovery Conference | 4/18/2010 |
| Discovery Opens | 4/18/2010 |
| Initial Disclosures Due | 5/18/2010 |
| Expert Disclosures Due | 9/15/2010 |
| Discovery Closes | 10/15/2010 |
| Plaintiff's Pretrial Disclosures | 11/29/2010 |
| Plaintiff's 30-day Trial Period Ends | 1/13/2011 |
| Defendant's Pretrial Disclosures | 1/28/2011 |
| Defendant's 30-day Trial Period Ends | 3/14/2011 |
| Plaintiff's Rebuttal Disclosures | 3/29/2011 |
| Plaintiff's 15-day Rebuttal Period Ends | 4/28/2011 |

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.

³ Respondent's motion to dismiss is substantively silent on the issue of genericness.

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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.
