

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

Mailed: April 8, 2009

Cancellation No. 92050318

Makur Designs, Inc.

v.

Solid 21 Incorporated

**Robert H. Coggins,
Interlocutory Attorney:**

On March 16, 2009, respondent filed what it titled a "motion to dismiss ... for failure to state a claim for which relief can be granted" under Fed. R. Civ. P. 12(b)(6). However, a reading of the substance of the motion reveals that the motion is instead one for summary judgment.

Respondent's motion does not argue that petitioner either lacks standing or that a valid ground does not exist for cancelling the registration of the mark, as is usual for motions to dismiss under Fed. R. Civ. P. 12(b)(6). *See, for example, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), and *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992). Instead, the motion argues that the involved mark is suggestive instead of merely descriptive, and includes reference to a dictionary definition of "gold." The arguments

and dictionary definition are matters outside the pleadings and relate to the merits of petitioner's ground of descriptiveness instead of to the sufficiency of the allegations in the petition for cancellation.

Except for assertions of claim or issue preclusion or lack of jurisdiction by the Board, a motion for summary judgment may not be filed until the moving party has made its initial disclosures. Trademark Rule 2.127(e)(1). Respondent filed its motion for summary judgment on March 16, 2009, on the grounds of descriptiveness. The deadline for making initial disclosures is May 16, 2009. The motion does not contain a statement that movant made its required initial disclosures prior to filing the motion. *See Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255 at fn. 7 (TTAB 2009). Inasmuch as respondent's motion was filed prior to the deadline for initial disclosures (and even prior to the deadlines to answer and for the mandatory discovery conference), the Board presumes that movant has not yet made its initial disclosures.

Accordingly, the motion is denied without prejudice as premature.¹ Respondent is allowed until May 8, 2009 in which to file an answer to the petition for cancellation. Dates are reset on the following schedule:

¹ The Board notes that this case is not well suited for disposition on a motion to dismiss for failure to state a claim on which relief can be granted. The petition for cancellation clearly alleges petitioner's standing (in paragraph 1) and a valid ground for cancellation (in paragraphs 4-8). These allegations, of course, remain to be proven at trial.

Time to Answer	5/8/2009
Deadline for Discovery Conference	6/7/2009
Discovery Opens	6/7/2009
Initial Disclosures Due	7/7/2009
Expert Disclosures Due	11/4/2009
Discovery Closes	12/4/2009
Plaintiff's Pretrial Disclosures	1/18/2010
Plaintiff's 30-day Trial Period Ends	3/4/2010
Defendant's Pretrial Disclosures	3/19/2010
Defendant's 30-day Trial Period Ends	5/3/2010
Plaintiff's Rebuttal Disclosures	5/18/2010
Plaintiff's 15-day Rebuttal Period Ends	6/17/2010

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.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint

of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>