

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

Mailed: January 25, 2010

Cancellation No. 92051140

Leonid Nahshin

v.

Product Source International,
LLC

Before Bucher, Kuhlke, and Taylor,
Administrative Law Judges

By the Board:

Petitioner seeks to cancel respondent's registration¹ for the mark NIC OUT for "mechanical cigarette filters for removing nicotine" in International Class 34.

As grounds for cancellation, petitioner states, in relevant part, as follows:

Grounds for cancellation: Priority of use and filing in USPTO.

Trademark Application Serial Number: 78206651.

Nahshin, Leonid used this trademark logo prior current user and filed a U.S. Trademark application for the same trademark in USPTO on January 23, 2003 before current owner did, but was refused registration. (See Trademark application Serial number 78206651). At that time current owner was customer of Nahshin, Leonid.²

¹ U.S. Registration No. 3350041, issued December 4, 2007, reciting December 8, 2003 as the date of first use and January 1, 2004 as the date of first use in commerce.

² We note that this portion is contained within what appears to be correspondence from Mr. Nahshin's counsel. We presume petitioner intends this to be his petition to cancel. We further

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In lieu of an answer, respondent filed a motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted and for petitioner's lack of standing. We note that petitioner's response brief to the motion was due on September 8, 2009. On September 23, 2009 petitioner filed what we construe as a response to the motion. Inasmuch as this response is untimely, it will not be considered. Nevertheless, because it appears that petitioner contests the motion, we have not granted the motion as conceded, but have considered the motion on the merits.

In support of its motion, respondent essentially argues that the petition to cancel neither asserts a proper statutory ground for relief, nor properly pleads Nahshin's standing to bring this action. Respondent further argues that the petition to cancel does not adequately apprise respondent of the grounds upon which the cancellation proceeding is brought, contains irrelevant and impertinent material, and, as to that portion contained within correspondence from Nashin's counsel, fails to conform to the technical requirements for a pleading submitted to the Board.

note that on the ESSTA cover sheet the same statement is made under the field "Grounds for Cancellation."

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It has often been stated that in order to withstand a motion to dismiss under Fed. R. Civ. P. 12(b)(6), a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. See *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Turning first to the question of standing, we find that petitioner has failed to allege facts to establish his standing to bring this proceeding. While petitioner pleads that he used the mark at some point before respondent and was previously refused a registration when he filed an application with the Office, he fails to set forth facts that he has or will suffer damage as a result of the continued registration of respondent's mark. A party may properly plead its standing to petition to cancel a registration by alleging that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceeding sufficient to constitute a "reasonable basis for its belief in damage." See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

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We next consider whether petitioner has set forth a valid ground for cancelling the registration of respondent. If petitioner intended to assert a claim of likelihood of confusion under Trademark Act Section 2(d), he has failed to do so.

To properly state a claim of likelihood of confusion, petitioner must plead (and later prove) that (1) respondent's mark, as applied to his goods, so resembles a mark or trade name owned by petitioner as to be likely to cause confusion, mistake, or deception; and (2) priority of use. See Fed. R. Civ. P. 8; *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1978). Petitioner has not alleged in the petition to cancel, either directly or hypothetically, that respondent's mark NIC OUT as applied to his identified goods so resembles the mark previously used by petitioner as to be likely to cause confusion or mistake. Nor has petitioner sufficiently pled priority of use in the instant case. Petitioner's use of the mark at some unknown point prior to respondent's priority date, and his allegation concerning the filing of his application, are insufficient bases for claiming priority or establishing trademark rights. See Section 7(c) of the Trademark Act.

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In view of the foregoing, respondent's motion to dismiss the petition to cancel for failure to state a claim upon which relief can be granted and for lack of sufficient facts to establish petitioner's standing is granted to the extent that petitioner is allowed **thirty days** from the date set forth in the caption above to file an amended pleading consistent with the discussion above, failing which the cancellation will be dismissed with prejudice.

Proceedings are otherwise suspended. If and when petitioner files a legally sufficient amended complaint, proceedings will resume and the Board will reset discovery and trial dates, as well as respondent's time in which to file its answer to the amended petition to cancel.