

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

Skoro

Mailed: December 9, 2010

Cancellation No. 92051757

Phoenix Trading Inc. dba  
Americare Products, Inc.

v.

Loops, LLC

Before Quinn, Zervas and Cataldo,  
Administrative Trademark Judges.

By the Board:

This case now comes up on respondent's motion for judgment on the pleadings, filed July 30, 2010. The ground for respondent's motion is that petitioner's claims that the subject trade dress Registration Nos. 3430304<sup>1</sup> and 3430305<sup>2</sup> for the overall appearance of the goods and a specific dot pattern are de jure functional are not legally correct and respondent should prevail as a matter of law (Br. pp. 5,

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<sup>1</sup> It is noted that Reg. No. 3430304 does not specifically discuss "raised dots", rather, the description of the mark states: "The mark consists of a three-dimensional, overall appearance of a toothbrush featuring a smoothly rounded handle, having a top aspect which is generally barbell shaped with the rear end portion being larger than the front end portion and with a narrow intermediate portion smoothly interconnecting both ends, and a side aspect being slightly bowed and smoothly tapered toward its rear end."

<sup>2</sup> The mark in Reg. No. 3430305 is generally described as a flexible-handled toothbrush with specific design features.

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10).<sup>3</sup> Primarily, with respect to the '305 registration, respondent argues that petitioner has misunderstood the subject of the trademark registrations and *In re Morton-Norwich Products Inc.*, 671 F.2d 1336; 213 USPQ 9, 15-16 (CCPA 1982), because both trademark registrations are for design aspects of the goods and not the functionality of the design.<sup>4</sup>

Petitioner's complaint alleges that the designs described in both trademark registrations<sup>5</sup> are "protected" by a utility patent,<sup>6</sup> thereby making the marks de jure functional and subject to cancellation.<sup>7</sup> Respondent, in its answer, denied the salient allegations.

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<sup>3</sup> The petition also seeks cancellation of Registration No. 3424838 for the mark DESIGNED FOR PRISON SAFETY. This registration is not subject to the allegations at issue in the present motion. More importantly, petitioner agreed to dismiss its claim of mere descriptiveness in view of the fact that this claim is not a proper claim upon which to cancel a Supplemental Register registration. Accordingly, claim number 1, paragraphs 6-18, is hereby dismissed.

<sup>4</sup> This appears to be an argument over *de facto* vs. *de jure* functional features. See *Valu Engineering Inc. v. Renard Corp.*, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002).

<sup>5</sup> Reg. Nos. 3430304 and 3430305, for trade dress.

<sup>6</sup> Patent No. 7334286.

<sup>7</sup> The petition also alleges that because the trademark applications were prosecuted simultaneously with the patent application, and because applicant knew it was making material misrepresentations that were false, respondent thereby committed fraud on the USPTO. These allegations have not been raised in the motion for judgment on the pleadings, and therefore will not be given any consideration by the Board at this time.

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A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.<sup>8</sup>

For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(d), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted.<sup>9</sup> All reasonable inferences from the pleadings are drawn in favor of the nonmoving party.

A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is

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<sup>8</sup> *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009); *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008); and *The Scotch Whisky Association v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1713 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

<sup>9</sup> *Kraft Group LLC v. Harpole*, *supra*; *Media Online Inc. v. El Clasificado Inc.*, *supra*; *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, *supra*; *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); and *Wright & Miller*, Federal Practice and Procedure: Civil 3d § 1367 et seq. (2009).

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entitled to judgment, on the substantive merits of the controversy, as a matter of law.<sup>10</sup>

A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment.

After careful consideration of respondent's arguments in support of its motion for judgment, we are of the opinion that the allegations pleaded in the petition to cancel are sufficient, and that if proven, they will enable petitioner to prevail.

The petition alleges functionality of the claimed trade dress in the registrations, which registrant denies. This is a question of material fact to be determined. See *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 58 USPQ2d 1001, 1007 (U.S. 2001). Construing these allegations, as we must, most favorably to petitioner's position, we hold that the petition to cancel has adequately asserted standing and a ground for cancellation, including damage to petitioner. Accordingly, respondent's motion for judgment on the pleadings is denied and trial dates, including the period for discovery, are reset as indicated below.

Expert Disclosures Due

**February 28, 2011**

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<sup>10</sup> *Kraft Group LLC v. Harpole, supra; Media Online Inc. v. El Clasificado Inc., supra; Ava Enterprises Inc. v. P.A.C. Trading Group, Inc., supra; Baroid Drilling Fluids Inc. v. Sun Drilling Products, supra.*

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Discovery Closes	<b>March 30, 2011</b>
Plaintiff's Pretrial Disclosures	<b>May 14, 2011</b>
Plaintiff's 30-day Trial Period Ends	<b>June 28, 2011</b>
Defendant's Pretrial Disclosures	<b>July 13, 2011</b>
Defendant's 30-day Trial Period Ends	<b>August 27, 2011</b>
Plaintiff's Rebuttal Disclosures	<b>September 11, 2011</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>October 11, 2011</b>

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