

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

Goodman

Mailed: February 1, 2012

Cancellation No. 92053902

Harris Corporation and HAL
Technologies, Inc.

v.

Harris Connect, LLC

Before Grendel, Bergsman and Shaw, Administrative Trademark
Judges

By the Board:

This proceeding was filed on April 15, 2011, with the notice of institution issuing on April 18, 2011. This case now comes up on respondent's motion, filed May 27, 2011, to dismiss under Fed. R. Civ. P. 12(b)(6). A brief history of the prosecution of this proceeding will be helpful.

1. On April 8, 2011, respondent filed a Section 7 request to amend the recitation of services in the subject registrations;¹ and

2. On April 15, 2011, petitioners filed their petition for cancellation.

¹ The Section 7 amendments were issued by the Post Registration division on April 14, 2011 with respect to Registration Nos. 3093943 and 3196826, May 5, 2011 with respect to Registration No. 3083552, and May 25, 2011 with respect to Registration No. 3196825.

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In support of its motion, respondent argues that petitioners have "failed to state a claim upon which relief can be granted" because petitioners "bases [sic] its [sic] Petition to Cancel on the description of services in effect prior to the granting of the Section 7 requests with respect to each of the four registrations." In particular, respondent argues that since the "description of services in those registrations have been modified, any such confusion would not serve as a basis for cancellation for the registrations in their current form" since the "allegations proffered . . . are based on inaccurate description of services." Respondent also requests that the petition to cancel to be dismissed with respect to Registration No. 3083552 because the Section 15 affidavit of incontestibility was filed on April 18, 2011 (three days after the petition for cancellation was filed) and acknowledged by the Office on May 5, 2011.

In opposition to the motion, petitioners, while noting that the requests for amendment of each of the registrations were filed on April 8, 2011, argue that the amendments with respect to Registration Nos. 3083552 and 3196825 were "improvidently granted" as the amendments did not issue until May 5, 2011 and May 25, 2011, respectively. Petitioners complain that these amendments were "issued during the pendency of this proceeding without the consent

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of petitioner and the approval of the Trademark Trial and Appeal Board." Petitioners also argue that the motion to dismiss should be denied with respect to Registration Nos. 3093943 and 3196826, as these amendments, while issued before the commencement of the proceeding, had not been published in the Official Gazette until after this proceeding instituted and it was not possible to incorporate the amended recitation of services of these registrations in the petition.

Alternatively, petitioners argue the motion to dismiss should be denied as moot, seeking leave to file an amended petition to cancel, such amended petition submitted with their motion to amend. The amended petition to cancel references the amended recitation of services for each involved registration.

In reply, respondent submits that petitioners have no basis for arguing that the amendments were improvidently granted and has cited to no authority to support their contentions. Respondent argues that it timely submitted the amendments prior to the commencement of the cancellation proceeding and that the Office properly acted on them. Respondent submits that its motion to dismiss should be

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granted in its entirety, although acknowledging the filing of petitioners' amended petition to cancel.²

To avoid dismissal, petitioners must allege such facts in the petition to cancel as would, if proved, show (1) that petitioners have standing to petition for cancellation of the registered mark and (2) that a statutory ground for canceling such registration exists. See TBMP § 503.02 (3d ed. 2011) and cases cited therein.

Respondent does not dispute petitioners' allegations of standing. Respondent has only argued that petitioners' allegations with regard to respondent's registrations are insufficient because all of the allegations are based on an incorrect recitation of services with respect to each registration.

We find petitioners' arguments that the amendments to the registrations were improvidently granted is without merit. As both parties acknowledge, the amendments were filed prior to commencement of the Board proceeding. The amendments were therefore properly handled by the Office's Post Registration division and did not require petitioners' consent because the amendments were filed prior to the Board having jurisdiction to consider the amendments. Cf. TBMP Section 212.01 ("Board has no jurisdiction over an

² Respondent indicated it had no objection to the filing of an amended petition to cancel on July 5, 2011.

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application . . . until the commencement of an inter partes proceeding . . . unless an inter partes proceeding . . . is pending, all-post publication amendments must be filed with the Trademark Examining Operation"). We also find that petitioners timely filed the petition to cancel against Registration No. 3083552, which registered on April 18, 2006, with respect to the likelihood of confusion ground inasmuch as the petition to cancel was filed on April 15, 2011. See TBMP Section, 307.02(a) (a petition to cancel on a likelihood of confusion ground must be filed within five years of the date of registration; the filing date is the date of receipt in the Office of the petition, with proof of service and the required fee).

We grant leave to amend with respect to the amended petition to cancel which allegations are now based on the amended recitation of services for each involved registration. Accordingly, the amended petition to cancel is accepted.

In view of the acceptance of the amended petition to cancel, the motion to dismiss moot. Additionally, because the motion to dismiss was filed prior to the fifth year anniversary of Registration No. 3083552, respondent's request that the Board dismiss the proceeding against Registration No. 3083552 is denied.

Proceedings are resumed.

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Respondents' time to answer the amended petition to cancel, and all other dates, are reset as follows:

Time to Answer	2/29/12
Deadline for Discovery Conference	3/30/12
Discovery Opens	3/30/12
Initial Disclosures Due	4/29/12
Expert Disclosures Due	8/27/12
Discovery Closes	9/26/12
Plaintiff's Pretrial Disclosures	11/10/12
Plaintiff's 30-day Trial Period Ends	12/25/12
Defendant's Pretrial Disclosures	1/9/13
Defendant's 30-day Trial Period Ends	2/23/13
Plaintiff's Rebuttal Disclosures	3/10/13
Plaintiff's 15-day Rebuttal Period Ends	4/9/13

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.