

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

KIM

Mailed: September 17, 2013

Cancellation No. **92054617**

Nouvelle Parfumerie Gandour

v.

Y.Z.Y., Inc.

**Before Seeherman, Taylor and Lykos,
Administrative Trademark Judges**

By the Board:

This proceeding now comes up on respondent's motion (filed February 12, 2013) to dismiss the petition to cancel for lack of subject matter jurisdiction pursuant to Fed. R. Civ. P. 12(b)(1). The motion is contested.

Respondent's subject matter jurisdiction claim is essentially a renewed attack on petitioner's standing, i.e., "[b]ecause the petition does not assert that [petitioner] has lawfully used the BIO CLAIRE mark in the United States whatsoever, it has no standing to seek cancellation of [respondent's] registration." *Respondent's Motion*, p. 5. Specifically, respondent asserts that any alleged use of the BIO CLAIRE mark by petitioner based upon shipments to the United States was unlawful based on a 2010 detention of

petitioner's goods by the United States Food and Drug Administration.

The Board previously determined, in deciding respondent's prior motion to dismiss under Fed. R. Civ. P. 12(b)(6), that petitioner has sufficiently pleaded its standing. Board order mailed September 6, 2012. The Board found that the allegations that petitioner was the owner of the mark and respondent was merely the importer and distributor of the goods were sufficient to show standing. Despite this finding, respondent filed an answer in which it asserted lack of standing as an affirmative defense. Petitioner filed a motion to strike respondent's affirmative defenses, and in the Board order of February 8, 2013, the Board struck the defense, and specifically stated that "[t]he Board has already determined in its order of September 6, 2012, that petitioner had sufficiently pleaded its standing." Board order mailed February 8, 2013, p. 3.

Despite the Board's finding in two previous orders that petitioner had sufficiently pleaded its standing, respondent has brought another motion with respect to it, although couched in terms of subject matter jurisdiction. As the Board previously explained, "standing in a Board proceeding is not a question of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1), as the Board has subject matter

jurisdiction by virtue of Trademark Act §§ 13 and 14, 15 U.S.C. §§ 1063 and 1064." *Id.*, n.1.

Thus, respondent's claim of lack of subject matter jurisdiction based on petitioner's alleged lack of lawful use in commerce is not a valid basis to dismiss the petition. Nor does this claim affect the sufficiency of petitioner's pleading of standing. As noted, petitioner's assertion of standing was based on allegations of petitioner's status as a foreign manufacturer and respondent's status as petitioner's United States distributor, not on allegations that petitioner had made shipments of goods to the United States itself. In view thereof, we hereby **DENY** respondent's motion to dismiss this proceeding.

Further, in view of the history of this case, as detailed above, **the Board will not entertain any further motions from respondent relating to the sufficiency of the pleadings.** See *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) ("Board possesses the inherent authority to control the disposition of cases on its docket"); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (Board prohibited opposer from filing any further motions to compel without prior Board permission). Respondent is allowed until **TWENTY (20) DAYS** from the mailing date of this order to replead

Affirmative Defense Nos. 2, 3, and 4, if it believes it can sufficiently allege a basis therefor, failing which respondent's answer of October 11, 2012, without the pleaded affirmative defenses,¹ will remain as respondent's operative pleading herein.

Proceedings are **RESUMED** and dates are **RESET** as follows:

Deadline for Discovery Conference	11/15/2013
Discovery Opens	11/15/2013
Initial Disclosures Due	12/15/2013
Expert Disclosures Due	4/14/2014
Discovery Closes	5/14/2014
Plaintiff's Pretrial Disclosures Due	6/28/2014
Plaintiff's 30-day Trial Period Ends	8/12/2014
Defendant's Pretrial Disclosures Due	8/27/2014
Defendant's 30-day Trial Period Ends	10/11/2014
Plaintiff's Rebuttal Disclosures Due	10/26/2014
Plaintiff's 15-day Rebuttal Period Ends	11/25/2014

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 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.

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¹ In the Board's order of February 8, 2013, the Board struck the affirmative defenses, although it gave respondent leave to replead Affirmative Defense Nos. 2-4.