

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

coggins

Mailed: June 17, 2013

Cancellation No. 92055343

William R. Simon Jr. and Tom
Parashos dba San Diego Law
Firm

v.

Higgs Fletcher & Mack LLP

By the Board:

This case comes up on respondent's motion (filed February 19, 2013) pursuant to Fed. R. Civ. P. 12(b)(6) to partially dismiss the petition for cancellation for failure to state a claim upon which relief can be granted.

Procedural Issue

Petitioners' brief in opposition to the motion is single spaced.¹ Trademark Rule 2.126(a)(1) requires that the brief be double-spaced. Inasmuch as it is clear that the four-page brief would otherwise be within the twenty-five page limit under Trademark Rule 2.127(a), and that the single-spacing is not a subterfuge to avoid the page limit,

¹ The petition for cancellation also contains single-spacing. It is further noted that the petition contains repeating paragraph numbers 6, 7, and 8.

the Board has considered plaintiffs' brief. All future filings must comply with requirements of Trademark Rule 2.126(a).

Motion to Dismiss

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) is a test solely of the sufficiency of a complaint. See TBMP § 503.01. To survive such a motion, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint must contain sufficient factual matter, accepted as true, which states a claim to relief that is plausible on its face. See *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the petitioner has standing and that a valid ground for the cancellation exists. Cf. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 556 (2007). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

By way of its motion to partially dismiss, respondent argues only that petitioners' second ground for cancellation fails to state a claim. Respondent does not challenge petitioners' standing or first ground for cancellation (i.e., priority and likelihood of confusion); and, indeed, upon review of the petition, the Board finds that petitioners have sufficiently alleged their standing and the ground of priority and likelihood of confusion. *See, e.g., Cervecería Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1300 (TTAB 2000) (standing found where subject registration was cited as bar to petitioner's application); and Trademark Act § 2(d).

However, the Board agrees with respondent that petitioners' second ground fails to state a claim.² Petitioners' second paragraph 6 in the petition states, *inter alia*, that "[a]s evidenced by the specimen that [respondent] submitted in support of the [s]ubject [r]egistration, the phrase 'SAN DIEGO'S LAW FIRM SINCE 1939' was being used by [respondent] only as a slogan, not a trademark." Similarly, petitioners' second paragraph 7 in the petition states "[f]urther evidence in this regard can be found by reviewing the specimen submitted by [respondent] when it first sought registration. The only specimen

² On the ESTTA cover form, petitioners call this second ground "does not function as a trademark."

submitted was a business card...." Petitioners explain in their brief in opposition to the motion that it is, in fact, the specimen submitted by respondent that has led to their second ground: "In this case, [p]etitioner has alleged that based on the specimen submitted by [respondent] in its application ... [the mark] was being used by [respondent] only as a slogan , not a trademark." Brief in Opp., p. 3.

To the extent that petitioner relies solely on the specimen that respondent submitted during examination of the underlying application which matured into the subject registration, and is arguing that the specimen of use was unacceptable, the Board informs petitioner that the *ex parte* examination of a specimen is not itself a basis for cancellation. See *Flash & Partners S.p.A. v. I.E. Manufacturing LLC*, 95 USPQ2d 1813 (TTAB 2010) (*ex parte* examination issues do not form a basis for cancellation); and *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, *per se*, does not constitute grounds for cancellation). The adequacy of specimens is solely a matter of *ex parte* examination. *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989).

While the law is settled that the insufficiency of the specimens, *per se*, does not constitute grounds for cancelling a registration (see *Granny's Submarine*

Sandwiches, Inc. v. Granny's Kitchen, Inc., 199 USPQ 564 (TTAB 1978)), a "proper ground for cancellation of an existing registration [may be] that the term for which registrant obtained registration has not been used as a trademark or service mark." *Marshall Field & Co., supra*, 11 USPQ2d at 1359. See also *Anheuser-Busch Inc. v. the Florists Association of Greater Cleveland, Inc.*, 29 USPQ2d 1146, 1160 (TTAB 1993).

In view of petitioners' reliance solely on the "specimen submitted by [respondent] in its application," respondent's motion to dismiss is granted with respect to the second ground, and second paragraphs 6, 7, and 8, and paragraph 9 (all on unnumbered p. 3 of the petition) are stricken.

The Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient. *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1955 (TTAB 2009). In view thereof, petitioner is allowed until July 3, 2013, in which to file an amended petition which sufficiently alleges a ground that respondent has failed, as of the filing date of the underlying application, to make proper service mark use in commerce of the term SAN DIEGO'S LAW FIRM SINCE 1939; failing which, this cancellation proceeding will move forward on the sole ground of priority and likelihood of

confusion. Respondent is allowed until, July 19, 2013, in which to file an answer to the amended petition, if an amended petition is filed.

Summary

Respondent's motion to partially dismiss is granted. Petitioners are allowed until July 3, 2013, in which to file an amended petition; failing which, this proceeding will move forward only on the ground of priority and likelihood of confusion. Respondent is allowed until July 19, 2013, in which to file an answer to the amended petition, if filed.

Schedule

Proceedings are resumed, and dates are reset on the following schedule.

Amended Petition Due (if filed)	7/3/2013
Time to Answer Amended Petition	7/19/2013
Deadline for Discovery Conference	8/9/2013
Discovery Opens	8/9/2013
Initial Disclosures Due	9/8/2013
Expert Disclosures Due	1/6/2014
Discovery Closes	2/5/2014
Plaintiff's Pretrial Disclosures	3/22/2014
Plaintiff's 30-day Trial Period Ends	5/6/2014
Defendant's Pretrial Disclosures	5/21/2014
Defendant's 30-day Trial Period Ends	7/5/2014
Plaintiff's Rebuttal Disclosures	7/20/2014
Plaintiff's 15-day Rebuttal Period Ends	8/19/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits must

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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.