UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: January 2, 2013

Opposition No. 91205964
Cancellation No. 92055812

Central Park Conservancy, Inc.

v.

Susoix LLC

By the Trademark Trial and Appeal Board:

This case comes up on defendant's motion for partial dismissal of the notice of opposition in Opposition No. 91205964 and the petition to cancel in Cancellation No. 92055800 for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6) with respect to the Trademark Act Section 2(a) claim. The motion is fully briefed. For the reasons set forth below, the proceedings listed above are consolidated.

Susoix LLC owns Registration No. 4022850 for the mark CENTRAL PARK SKATEBOARDER and design (SKATEBOARDER in Class 35 and CENTRAL PARK SKATEBOARDER in Class 41 disclaimed) and pending application Serial No. 85393670 for the mark CENTRAL

PARK LONGBOARDER GLOBAL ROLLING and design (LONGBOARDER disclaimed) for[1]:

> Int. Cl. 35
> On-line wholesale and retail store services featuring apparel and sports equipment related to skateboarding, longboarding, cycling, and other endurance sports
>
> Int. Cl. 41
> Personal coaching services in the field of skateboarding, longboarding, cycling, and other endurance sports.

On July 6, 2012, Central Park Conservancy, Inc. (CPCI) filed a petition to cancel the registration and a notice of opposition against the application.[2] In both proceedings CPCI brings the same claims that Susoix LLC's mark falsely suggests a suggestions with CPCI, is confusingly similar to CPCI's registered marks, and is primarily geographically deceptively misdescriptive.

On August 6, 2012, Susoix LLC filed motions to dismiss the claim of false suggestion of a connection in both the opposition and the cancellation for failure to state a claim upon which relief can be granted.

In order to withstand a motion to dismiss, plaintiff need only allege such facts which, if proved, would

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[1] The services in the registration and the application are identical except in the pending application the Int. Cl. 35 services include the term "products" in lieu of "apparel and sports equipment."

[2] Registration No. 4022850 also is the subject of Cancellation No. 92055800 and pending application Serial No. 85393670 also is the subject of Opposition No. 91205879, both filed by the same

establish that plaintiff is entitled to the relief sought; that is, (1) plaintiff has standing to bring the proceeding, and (2) a valid statutory ground exists for opposing or cancelling the registration. Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536, 1538 (TTAB 2007). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), quoting Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007).

With respect to standing, CPCI has pleaded ownership of several registrations including the term CENTRAL PARK and design as well as prior common law use of marks including the term CENTRAL PARK. No more is necessary. L.C. Licensing Inc. v. Berman, 86 USPQ2D 1883, 1887 (TTAB 2008).

A plaintiff asserting a claim that a mark falsely suggests a connection with persons living or dead, or institutions, must plead (i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or

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plaintiff, City of New York, by and through its Department of Parks and Recreation.

identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed. Association pour la Defense et la Promotion de l'oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk, 82 USPQ2d 1838, 1842 (TTAB 2007)(citations omitted). The second factor has been construed to require that "the name claimed to be appropriated by the defendant must point uniquely to the plaintiff." Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. TJX Companies, Inc., 87 USPQ2d 1411, 1424 (TTAB 2008).

Here, both the notice of opposition and the petition to cancel allege the fame of Central Park, that Central Park is an institution, that CPCI is the entity with which the City of New York contracted to manage Central Park and which owns the CENTRAL PARK mark, that Susoix LLC's mark incorporates the terms CENTRAL PARK as well as a map of Central Park, that Susoix LLC's mark points to Central Park, that there is no connection between Central Park and Susoix LLC's services, and that the public would presume a connection upon encountering Susoix LLC's mark. The Board finds these allegations sufficient to plead a Section 2(a) claim of false suggestion of a connection.

Accordingly, Susoix LLC's motions to dismiss CPCI's claims of false suggestion of a connection in the opposition and the cancellation are hereby **DENIED.**

Because the parties are the same, and the two proceedings involve common issues of law and fact, the Board believes that the interest of judicial economy will be served by consolidation of Opposition No. 91205964 and Cancellation No. 92055812. *See* Fed. R. Civ. P. 42(a) and TBMP §511 (3rd ed., rev. 2012). Accordingly, the Board sua sponte consolidates Opposition No. 91205964 and Cancellation No. 92055812, which, with the exception of the need for separate answers in each proceeding, may be presented on the same record and briefs.[3]

For the reasons explained below, this consolidated proceeding is SUSPENDED. Upon resumption, Susoix LLC's time to answer the petition to cancel and notice of opposition will be reset.

It has come to the Board's attention that before institution of Opposition No. 91205964, Susoix LLC filed a petition to the USPTO Director seeking to change the basis of application Serial No. 85393670 from Trademark Act Section 1(a), use in commerce, to Section 1(b), intent to

[3] The Board file will be maintained in Opposition No. 91205964 as the "parent" case, but all papers filed herein must include the proceeding numbers of all consolidated cases in ascending order.

use. On June 26, 2012, the petition was granted and jurisdiction was restored to the examining attorney for consideration of the amendment to the basis of the application. The Director's petition decision notes that if the amendment is accepted, republication is required. The amendment remains pending.

Pursuant to Trademark Trial and Appeal Board Manual of Procedure (TBMP) §214 (3rd ed., rev. 2012), if the amendment to the basis is accepted, the opposition will be determined on the basis of the application as amended, but opposer will be allowed time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition dismissed.

Proceedings are suspended pending the disposition of Susoix LLC's amendment to the basis for opposed Application Serial No. 85393670.

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