

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: February 14, 2015

Cancellation No. 92059737

Michael E. Zall

v.

Salon Hairroin, Inc.

By the Trademark Trial and Appeal Board:

Petitioner seeks to cancel Respondent's registration¹ for the mark HAIRROIN SALON for "hair salon services, namely, hair cutting, styling, coloring, and hair extension services" in International Class 33.

As grounds for cancellation, Petitioner asserts that Respondent's mark consists of matter that disparages those affected by addiction and is scandalous and immoral in violation of Section 2(a) of the Lanham Act.

Following Petitioner's filing of an amended pleading, Respondent, in lieu of an answer, filed a motion (on September 27, 2014) to dismiss under Fed. R. Civ. P. 12(b)(6). The Board has not considered any evidentiary

¹ Registration No. 3461064, issued July 8, 2008, citing September 1, 2005 as the date of first use anywhere and the date of first use in commerce.

materials submitted by the parties in deciding this motion. Rather, it has looked solely at the pleading itself.² See TBMP Section 503.02 (2014).

In support of its motion, Respondent argues that its “Mark is not scandalous and Petitioner has not, and cannot, state a valid basis for cancellation of the Mark.” Respondent asserts that the Office has registered hundreds of marks that explicitly reference controlled (i.e., illegal) substances; that the mark here is not even a direct reference to an illegal drug—it is merely a play on words; that the mark is “innocuous”; that the mark “contains no explicit drug reference, it relates solely to the utterly benign enterprise of hair salon services”; and, therefore, the petition contains no viable basis for cancellation.

In response, Petitioner argues that he has sufficiently pleaded his standing to bring the instant cancellation proceeding; that his son died of a drug overdose at the age of 34 and his “family has suffered for twenty years with the ravages of addiction”; that he is now Vice President of the Board of Directors of the Rockland Council on Alcoholism and Other Dependence, Inc., a non-profit corporation in Nanuet, New York, dedicated to the prevention of addiction; that he is a member of a large community trying to end the scourges of addiction; that he finds the use of the term HAIROIN to be offensive, scandalous, immoral, contemptuous, disreputable, and disparaging.

² The time for serving initial disclosures has not passed; therefore the Board has not construed this motion as one for summary judgment. See Trademark Rule 2.127(e)(1). Petitioner’s October 7, 2014 motion to extend his time to file a brief in response is granted as conceded. Trademark Rule 1.127(a).

In reply, Respondent argues there is no dispute that the mark pertains only to hair salon services and does not contain any direct or explicit reference to any illegal drugs or otherwise illicit activities. In addition, Respondent contends that Petitioner has no personal or economic relationship to Respondent; that the only identifiable ground for Petitioner's challenge is that he is personally offended by the word "Hairroin" because his son had a longstanding addiction to heroin and ultimately died of a drug overdose; and that Petitioner's personal sensitivity and moral opposition to the word "Hairroin" is insufficient to confer standing upon him in this matter.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. *Id.* In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for canceling the subject registration. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA

1982); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). The tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice. Only a complaint that states a plausible claim for relief survives a motion to dismiss. *See Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009), *citing Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 555-56 (2007). To survive a motion to dismiss, a complaint must contain “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 570. The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e); *see also Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007). Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment. *Advanced Cardiovascular Systems*, 26 USPQ2d at 1041.

As a threshold matter, the Board will analyze whether Petitioner has sufficiently pleaded his standing to bring the instant cancellation. In the case of a petition to cancel, the standing requirement has its basis in Section 14 of the Trademark Act which provides in relevant part that “[a] petition to cancel a registration of a mark...may, upon payment of the prescribed fee, be filed by any person who believes that he is or will be damaged...by the registration of a mark on the principal register....” A petitioner must also

satisfy two judicially-created requirements in order to have standing: the petitioner (1) must have a "real interest" in the proceedings, and (2) must have a "reasonable" basis for his belief of damage. *See Ritchie v. Simpson*, 17 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

With regard to the first prong, Petitioner has sufficiently pleaded a "real interest" in the proceedings by alleging that his son died of a drug overdose; that his family suffered for twenty years dealing with his son's addiction; that after his son's death he became active in the addiction prevention community and is now Vice President of the Board of Directors of the Rockland Council on Alcoholism and Other Dependence, Inc. in Nanuet, N.Y.; that he has been or will be damaged by the subject registration; and that Respondent's mark consists of or comprises matter that disparages those affected by addiction, and brings them into contempt, ridicule, and disrepute, and is scandalous and immoral in violation of Section 2(a) of the Lanham Act.

As for the second prong regarding the reasonableness of Petitioner's belief of damage, we note that Petitioner has alleged that others share the belief of harm from the subject registration by indicating in Paragraph 13 of the Petition that over 6,000 signatures were included on a petition to the owners of a store in which Respondent's salon was opened demanding an end to the company's marketing tactics and that such petition was sponsored by Shatterproof, a non-profit organization that advocates against addiction and the stigma associated therewith. These allegations are more than sufficient

to establish that Petitioner has objective proof that he is not alone in believing that he would be damaged if the marks were registered.

Having now determined that Petitioner has adequately pleaded his standing, the Board turns to determine whether the petition states a proper ground for cancellation.

Section 2(a) bars the registration of a mark that "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute...." The wording of the statute makes clear that the prohibition against marks which contain immoral or scandalous matter constitutes a distinct legal claim, as opposed to the prohibition against marks which disparage or bring into contempt or disrepute persons, institutions or beliefs, or as opposed to the prohibition against marks which falsely suggest a connection. *See McDermott v. San Francisco's Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006

After carefully reviewing the amended petition to cancel the Board finds that Petitioner has sufficiently pleaded his claim that the mark at issue is scandalous and immoral and is disparaging of those affected by addiction by alleging, for example, that that the mark is "offensive, scandalous, immoral, contemptuous..." (Paragraph No. 15); by alleging that he "finds the use of the term HARROIN for the services rendered by

Registrant...despicable, scandalous, immoral and vulgar, and shocking to the sense of propriety..." (Paragraph No. 16); and by alleging that the registered mark "consists of or comprise [sic] matter that disparages those affected by addiction, and brings contempt, ridicule, and disrepute, and is scandalous and immoral in violation of Section 2(a) of the Lanham Act, 15 U.S.C. Section 1052(a)" (Paragraph 19).³

In view thereof, Respondent's motion to dismiss is denied.

Proceedings are hereby resumed. Dates are reset as follows:

Answer Due	3/23/2015
Deadline for Discovery Conference	1/21/2011
Discovery Opens	1/21/2011
Initial Disclosures Due	2/20/2011
Expert Disclosures Due	6/20/2011
Discovery Closes	7/20/2011
Plaintiff's Pretrial Disclosures	9/3/2011
Plaintiff's 30-day Trial Period Ends	10/18/2011
Defendant's Pretrial Disclosures	11/2/2011
Defendant's 30-day Trial Period Ends	12/17/2011
Plaintiff's Rebuttal Disclosures	1/1/2012
Plaintiff's 15-day Rebuttal Period Ends	1/31/2012

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 of 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.

³ The Board does not find that Petitioner has pled a claim of false suggestion of a connection under Section 2(a). For purposes of properly pleading a claim of false

suggestion of a connection under Section 2(a), see *Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403 (TTAB 2010), and authorities cited therein.