

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: December 9, 2015

**Opposition No. 91218100 (Parent)**

*Kingston Technology Corp.*

*v.*

*Spansion LLC*

Opposition No. 91222728;  
Cancellation No. 92061796

*Spansion LLC*

*v.*

*Kingston Technology Corp.*

**Benjamin U. Okeke, Interlocutory Attorney:**

Now before the Board are Kingston Technology Corp.'s ("KTC") motions filed August 27, 2015, to: 1) dismiss the amended counterclaims filed by Spansion LLC ("SL") in Opposition No. 91218100 ("the '100 opposition"); 2) dismiss the amended notice of opposition filed by SL in Opposition No. 91222728 ("the '728 opposition"); and 3) dismiss the amended petition to cancel filed by SL in Cancellation No. 92061796 ("the '796 cancellation"). Each motion filed in the various proceedings is similar, and all allege that SL's amended claims "do not state grounds upon which relief can be granted, failing to allege descriptiveness sufficient to be plausible on

its face.” 23 TTABVUE 2.<sup>1</sup> SL contests KTC’s motions, arguing that KTC “largely ignores the actual allegations ... [and] [i]nstead ... attempts to argue the merits of the claims in this proceeding.” 26 TTABVUE 2. The motions are fully briefed.

The Board has considered the parties’ submissions and presumes the parties’ familiarity with the arguments made therein. The parties’ arguments will not be summarized herein except as necessary to explain the Board’s decision.

### ***Consolidation***

Whenever it comes to the Board’s attention that cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. Such consolidation may be ordered on the Board’s own initiative. *See* Fed. R. Civ. P. 42(a); and TBMP § 511 (2015). Inasmuch as the parties to Opposition Nos. 91218100 and 91222728 and Cancellation No. 92061796 are the same and the proceedings involve common questions of law or fact, the Board finds that consolidation of the above-referenced proceedings is appropriate. Consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays.

Accordingly, Opposition Nos. 91218100 and 91222728 and Cancellation No. 92061796 are consolidated and may be presented on the same record and briefs.

**The record will be maintained in Opposition No. 91218100 as the “parent” case.** However, because these proceedings are being consolidated during the pendency of motions to dismiss that were filed in lieu of answers to the amended plead-

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<sup>1</sup> For ease of reference, where arguments are consistent among the three disparate motions to dismiss, the Board will simply cite to the quote as taken from the papers filed in the parent case – the ’100 opposition, unless otherwise noted.

ings/counterclaims in each of the now consolidated matters, if its motions to dismiss are denied, KTC must file appropriate answers in each proceeding, following which subsequent filings should be filed only in the parent case. *See* TBMP § 511. Thereafter, the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as the parent case by following it with: “**(Parent)**,” as in the case caption set forth above.<sup>2</sup>

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

### ***Motion to Dismiss***

By way of background, SL seeks registration of the mark HYPERRAM, in standard character format, for “volatile memory devices, namely, random-access memory semiconductor chips; applications and utility software for functions associated with random-access volatile memory devices, namely, code and data

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<sup>2</sup> The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

management software and random-access memory semiconductor chip drivers.”<sup>3</sup> Meanwhile, KTC is seeking registration of the marks HYPERX,<sup>4</sup> in standard characters, for “headphones, headsets and related accessories, namely, detachable microphone, microphone plug, earphone cushions, audio cable, splitter cable, extension cable, airplane headphone adapter, and mesh bag for headsets; mousepads,” in International Class 9; and “headphones, headsets and related accessories for playing video games, namely, detachable microphone, microphone plug, earphone cushions, audio cable, splitter cable, extension cable, airplane headphone adapter, and mesh bag for headsets,” in International Class 28; and HYPERX BLITZ,<sup>5</sup> in standard characters, for “mouse pads,” in International Class 9. On August 28, 2014, KTC filed its notice of opposition against SL’s ’104 application on the grounds of: (i) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and (ii) descriptiveness or genericness under Section 2(e)(1), 15 U.S.C. § 1052(e)(1). On February 12, 2015, following several extensions of the trial schedule, SL filed its answer to KTC’s notice of opposition denying the salient allegations of the notice, except that SL admitted that the “United States Patent and Trademark Office records indicate that [KTC] owns the

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<sup>3</sup> Application Serial No. 86189104 (“the ’104 application”), filed February 10, 2014, asserting SL’s intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

<sup>4</sup> Application Serial No. 86462159 (“the ’159 application”), filed November 22, 2014, asserting KTC’s current use of the mark in commerce under Section 1(a), 15 U.S.C. § 1051(a). KTC asserts January 6, 2014, as both the date of first use of the mark anywhere and as the date of its first use in commerce.

<sup>5</sup> Application Serial No. 86418063 (“the ’063 application”), filed October 8, 2014, asserting KTC’s intent to use the mark in commerce under Section 1(b).

[pleaded] registrations ..., with the listed registration dates.” 14 TTABVUE 4. Additionally, SL advanced counterclaims to cancel two of KTC’s pleaded registrations – Registration Nos. 4162334 and 4316905, and for restriction of its third pleaded registration – Registration No. 4452249, all based upon claims of descriptiveness or genericness.

On July 24, 2015, the Board granted KTC’s first motion to dismiss the counterclaims. However, the Board allowed SL until August 25, 2015, to file amended counterclaims properly pleading descriptiveness or genericness and properly pleading a Section 18 restriction.

In the meantime, on July 8, 2015, SL filed a combined notice of opposition against KTC’s ’159 and ’063 applications. SL alleges, similar to the allegations advanced by KTC in its opposition of SL’s ’104 application, that the term HYPERX is descriptive, and therefore the ’159 application should not register and the ’063 application should be limited by a disclaimer of the term HYPERX. Additionally, on the same day SL filed a petition to cancel Registration No. 4721431, owned by KTC, for the mark HYPERX SKYN in standard characters.<sup>6</sup> Similar to its opposition of KTC’s pending applications, SL asserts that the term HYPERX is descriptive of the goods covered by the mark, and therefore seeks a restriction of the registration under Section 18 to enter a disclaimer of the term.

On August 13, 2015, SL filed amended pleadings in both the cancellation and opposition proceedings as a matter of course under Fed. R. Civ. P. 15(a). Similarly,

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<sup>6</sup> Issued April 14, 2015, from an application filed March 11, 2014, for “computer accessories, namely, mouse pads for use with electronic and online gaming,” in International Class 9.

on August 18, 2015, SL filed an amended counterclaim in the '100 opposition pursuant to the Board's leave granted in its July 24, 2015 order. KTC now seeks dismissal of the amended counterclaims, combined notice of opposition, and petition to cancel.

In particular, KTC argues that SL "has not pleaded a real interest ... sufficient for standing" in its amended notice of opposition and petition to cancel. 6 TTABVUE 2 ('728 Opposition); 7 TTABVUE 2 ('796 Cancellation). However, KTC does not contest SL's standing with regard to its amended counterclaims, which the Board previously determined had been sufficiently pleaded. 21 TTABVUE 3 ('100 opposition) Further, and with respect to each amended pleading, KTC contends that "descriptiveness of 'hyper' is expressly denied by [SL]," and "[f]urther, the 'descriptive connotations' [asserted by SL] present irrelevant interpretations beyond immediate relevant meanings of [the involved marks]." 23 TTABVUE 3. KTC concludes that SL's "parsed analysis" of the components of the challenged marks leaves "the descriptiveness allegations fatally incomplete." *Id.* at 6.

To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the registration. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *Order of Sons of Italy in Am. v. Pro-*

*fumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); and TBMP § 503.02. 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, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Iqbal*, 556 U.S. 662 (citing *Twombly*, 550 U.S. at 555).

However, the plaintiff is not under a burden to prove its case in its notice of opposition or petition to cancel. *Enbridge, Inc. v. Excelerate Energy Ltd. P’ship*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009).

#### A. Standing

The doctrine of standing is broad by its terms, requiring only that a party have a belief that it would suffer some kind of damage if the subject mark is registered. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *cf. NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1033 (TTAB 2013) (“The fact that the word ‘Huck’ may be used in respondent’s written materials that happen also to bear respondent’s registered mark [XBOX 360], a mark not remotely similar to the word ‘Huck,’ does not establish a basis upon which to allege standing to cancel the registration of the subject mark.”). Although SL has alleged that KTC filed a notice of opposition against SL’s application for the mark HYPERRAM, 5 TTABVUE 3, ¶ 4 (’728 opposition), 6 TTABVUE 3, ¶ 4 (’796 cancellation), SL has not, and it does not appear plausible to allege that KTC’s marks that are the subject of the ’728

opposition and '796 cancellation were relied upon by KTC in the '100 opposition, or that KTC's assertion of likelihood of confusion in that proceeding involves the same marks. *Cf. Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 859 (TTAB 1986) (petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action); *M. Aron Corp. v. Remington Prods., Inc.*, 222 USPQ 93, 96 (TTAB 1984).

Further, while SL alleges that it is "one of the leading manufacturers of computer memory products and embedded systems solutions, including a broad portfolio of flash memory, microcontrollers, mixed-signal and analog products, and system-on-chip solutions," and that "[s]uch products have a wide variety of applications, including in connection with consumer electronics, industrial and automotive applications," these assertions fall short of alleging that SL has a business need to use the applied-for and registered terms to describe its goods, that its goods are the same or related to those offered by KTC or are within its normal zone of expansion, or simply that SL is a competitor of KTC. The Board is left to surmise this conclusion from SL's listing of goods. *Cf. Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1951-52 (TTAB 2014) (opposer established it is a manufacturer of the same or related goods as applicant and applicant did not contest opposer's standing), *on appeal*, No. 14-1517 (Fed. Cir.); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760-61 (TTAB 2013) (petitioner established and respondent admitted that petitioner is a competitor using the term at issue as part of its domain name), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014), (mem.).

In light of the forgoing, SL has indeed failed to allege facts sufficient to show a “real interest” in the ’728 opposition and ’796 cancellation, and a “reasonable basis” for its belief that it would suffer some kind of damage by the registration of the involved marks. *See Ritchie*, 50 USPQ2d at 1025.

However, as previously noted, SL’s standing to bring its counterclaims in the ’100 opposition is inherent in its position as defendant in the original proceeding. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014) (“Applicant has standing based on opposers’ assertion of their marks and registrations against applicant in their notice of opposition.”); *Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013) (standing assessed at time the counterclaim is filed and Board’s dismissal of the main claim does not render counterclaim moot).

#### B. Descriptiveness

Paragraphs 9, 20 and 26 allege, *inter alia*, that “Opposer’s composite mark – HYPERX – is, when taken as a whole, merely descriptive ... and ... merely describes an ‘advanced’ computer data storage or memory product with very fast speeds for use in ‘extreme’ computer gaming applications.” 22 TTABVUE 4, 6 and 8. This allegation, read in conjunction with the allegations made in paragraphs 4, 7-8, 18-19, 24-25 and 27 are sufficient to plead that the mark conveys a “quality, feature, function, or characteristic,” of the goods at issue. 22 TTABVUE 3-4 and 6-8. Therefore, with respect to its counterclaims to cancel Registration Nos. 4162334 and 4316905, SL has set forth sufficient facts to plead its claims of descriptiveness under Section

2(e)(1), which allegations must of course be later proven. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)(a mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services).

Similarly, paragraphs 29, 31-32, and 34 allege sufficient facts to support SL's claim under Section 18 for restriction of Registration No. 4452249 by disclaimer of the term HYPERX.

KTC's arguments for dismissal of the counterclaims are unavailing. First, a party may state as many separate claims as it has, regardless of consistency; a plaintiff may also set forth two or more statements of a claim alternatively or hypothetically, either in one count or in separate counts. *See Fed. R. Civ. P. 8(d)(2) and (3); Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *see also Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation).

Further, KTC's brief on its motion to dismiss is presented largely as more of a brief for summary judgment, principally discussing the merits of the claims being asserted, rather than focusing on the sufficiency of the allegations. KTC's conclu-

sions that “the ‘descriptive connotations’ present irrelevant interpretations beyond immediate relevant meanings,” that “HYPERX is fanciful or suggestive,” and that “‘Hyperx’ considered in relation to the particular computer memories of the Registrations at issue according to the terms raised by [SL] ..., does not describe a specific quality, feature, function or characteristic related to goods,” are questions properly left for the proofs, and specifically address the merits of the counterclaims and SL’s probability of success, rather than identifying deficiencies in the pleadings. 23 TTABVUE 3, 7, and 9.

Finally, KTC’s argument regarding SL’s alleged “parsing” of the marks is similarly futile. Indeed, a party may allege the descriptive significance of each element of a compound mark separately in ultimately pleading that the mark, when considered as a whole, is merely descriptive under Section 2(e)(1). *See DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F3d 1247, 1253, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012); *see also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of “commercial and industrial coding towers and accessories therefor, sold as a unit”).

Accordingly, KTC’s motion to dismiss for failure to state a claim upon which relief may be granted is **DENIED** with respect to SL’s counterclaims based on descriptiveness under Section 2(e)(1). KTC is allowed until **December 23, 2015**, to file an answer to the amended counterclaims for cancellation and restriction.

However, KTC’s motion to dismiss is **GRANTED** with respect to the notice of opposition filed in Opposition No. 91222728 and the petition to cancel filed in Can-

Opposition Nos. 91218100 and 91222728; and Cancellation No. 92061796

cellation No. 92061796, for failure to state claims upon which relief may be granted, inasmuch as SL failed to sufficiently plead its standing. Accordingly, Opposition No. 91222728 and Cancellation No. 92061796 are **DISMISSED** without prejudice.

It is the Board's policy, however, to allow amendment of pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6), particularly following an initial challenge. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997). In view thereof, SL is allowed until **TWENTY DAYS** from the mailing date of this order to submit an amended notice of opposition and petition to cancel, if possible, justified and appropriate. KTC is allowed **TWENTY DAYS** from the filing of any amended pleading(s), to file an answer, or otherwise move with respect to the amended pleading(s).

### ***Schedule***

The remaining conferencing, disclosure, discovery, and trial dates are reset as follows:

Deadline for Discovery Conference	February 1, 2016
Discovery Opens	February 1, 2016
Initial Disclosures Due	March 2, 2016
Expert Disclosures Due	June 30, 2016
Discovery Closes	July 30, 2016
KTC's Pretrial Disclosures Due	September 13, 2016
30-Day Testimony Period for KTC's testimony to Close	October 28, 2016

SL's Pretrial Disclosures as Defendant in 91218100 and Plaintiff in its Counterclaims and Opposition No. 91222728 and Cancellation No. 92061796 Due	November 12, 2016
30-Day Testimony Period for SL to Close	December 27, 2016
KTC's Rebuttal Disclosures Due	January 11, 2017
30-Day Testimony Period for KTC as Counterclaim Defendant and Its Rebuttal Testimony to Close	February 25, 2017
SL's Rebuttal Disclosures as Plaintiff in 91218100 Counterclaims and Opposition No. 91222728 and Cancellation No. 92061796 Due	March 12, 2017
15-Day Rebuttal Period for SL in the Counterclaim and Opposition No. 91222728 and Cancellation No. 92061796 to Close	April 11, 2017
Brief for KTC Due	June 10, 2017
Brief for SL Due	July 10, 2017
Brief for KTC in the Counterclaim and Reply Brief, if any, Due	August 9, 2017
Reply Brief, if any, for SL as Plaintiff in 91218100 Counterclaim and Opposition No. 91222728 and Cancellation No. 92061796 Due	August 24, 2017

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.

Opposition Nos. 91218100 and 91222728; and Cancellation No. 92061796

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.