

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

Cancellation No. 92061955

DFASS Brands Holdings, LLC

v.

Reginald Williams

By the Trademark Trial and Appeal Board:

Reginald Williams (“Respondent”) obtained a registration for the mark **TIME TRAVEL ACADEMY** in standard character form for “Provision of space on websites for advertising goods and services; Promotion, advertising and marketing of on-line web sites; Operating an online shopping site in the field of Movies, books, clothing, interactive videos, time pieces, hand bags, purses, video courses, toys; Producing promotional videotapes, video discs, and audio visual recordings; Providing a website featuring audio and video interviews, transcripts and other educational materials all concerning business topics” in International Class 35.¹ On July 31, 2015, DFASS Brands Holdings, LLC (“Petitioner”) filed a petition to cancel Respondent’s registration on the grounds that the mark consists of the generic term **ACADEMY** and the descriptive and disclaimed term **TIME TRAVEL** that is a descriptive mark which has not acquired “secondary meaning.”

¹ Registration No. 4313253, issued April 2, 2013. The registration includes a disclaimer of **TIME TRAVEL**.

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In lieu of an answer, Respondent, on September 14, 2015, filed a motion to dismiss for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6). Petitioner has filed a brief in response thereto.

A motion to dismiss for failure to state a claim is solely a test of the sufficiency of a complaint. *See* TBMP § 503.01 (2015). That is, “[a] motion made under Rule 12(b)(6) challenges the legal theory of the complaint, not the sufficiency of any evidence that might be adduced.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). To survive such a motion, Petitioner need only allege sufficient factual matter as would, if proved, establish that (1) each has standing to maintain the proceeding, and (2) a valid ground exists for opposing or 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, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In deciding such a motion, “the Board ... must accept as true all material allegations of the complaint, and must construe the complaint in favor of the complaining party.” *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). The purpose of pleadings is to provide fair notice as to the basis of each plaintiff’s standing and the claims and defenses at issue in a proceeding. *See* TBMP § 506.01. The content of the ESTTA cover sheet is read in conjunction with the petition to cancel as an integral

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component thereof. *See PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005).

Petitioner's standing is based on its having "expended significant resources to create a subsidiary to sell, among other things, watches, clocks, jewelry, and travel related goods" (paragraph 2), its filing of an application for an unspecified mark that was denied registration based on Respondent's involved mark and registration (paragraph 8), and its allegation that registration of Respondent's mark is a source of injury to Petitioner who is entitled to use the term TIME TRAVEL (paragraph 33). Although Petitioner provides additional information concerning its intended use of TIME TRAVEL in connection with retail store services and its application to register the mark TIME TRAVEL in its brief in opposition to the motion to dismiss, that information was not incorporated into the petition to cancel.

When descriptiveness or genericness of the mark is in issue, a plaintiff may plead its standing by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using a descriptive term in its business. *See Otto Roth & Co. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Petitioner has alleged in paragraph 2 that it has created a subsidiary to sell goods under an unspecified mark that could conceivably be sold through Respondent's services and has alleged in paragraph 33 that it is entitled to use the term TIME TRAVEL. However, in view of the application to register the TIME TRAVEL mark to which Petitioner refers in its

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brief in opposition, Petitioner appears to be asserting trademark rights in TIME TRAVEL rather than the right to use that term descriptively in its business. Accordingly, these allegations are insufficient to allege standing herein.

However, as a general matter, an allegation that a plaintiff's mark was refused registration based on a defendant's registration is a sufficient pleading of standing. *See Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *Hartwell Co. v. Shane*, 17 USPQ2d 1569,1570 (TTAB 1990). Although Petitioner referred to an unspecified application for registration being denied by an unspecified entity, Petitioner has failed to provide fair notice of the factual basis for its standing in the text of the petition to cancel. In particular, it has not pleaded sufficient factual matter in support of its allegation that its application was denied registration based on Respondent's involved mark and registration, including such information as what kind of application it filed and with whom (e.g., to register a specific trademark for specific goods and/or services with the United States Patent and Trademark Office), and the filing date of the application. Respondent should not be required to guess as to the application upon which Petitioner is relying as the basis for its assertion of standing. *Cf. ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1301 (TTAB 2012) (a defendant should not be required to guess the claims against which it is defending). Based on the foregoing, the Board finds that Petitioner has failed to adequately plead its standing to maintain this proceeding.

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Although Respondent alleges that Petitioner failed “to provide a legally sufficient ground for cancellation,” Petitioner has failed to allege any specific deficiency in the claim set forth in the petition to cancel in its brief in support of its motion to dismiss. In paragraphs 10 through 43 of the petition to cancel, Petitioner has pleaded that the involved TIME TRAVEL ACADEMY mark, as a whole, is “is a descriptive mark that ... has not acquired secondary meaning.” Petition to cancel, paragraph 43. Such pleading is a sufficient allegation that the mark, as a whole, is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and is not distinctive under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).²

Nonetheless, even if the Board assumes that the mark is indeed a combination of a descriptive term and a generic term,³ as Petitioner alleges, such combination does not necessarily render the mark merely descriptive as a whole. A combination of descriptive terms that “creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods” and/or services is not treated as merely descriptive. TMEP § 1209.03(d). *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). *But see In re Leonhardt*, 109 USPQ2d 2091 (TTAB 2008) (BOBBLE POPS merely

² “Secondary meaning” and “distinctiveness” are synonymous. *Union Carbide Corp. v. Ever-Ready Inc.*, 185 USPQ 464, 469 n.9 (N.D. Ill. 1975); TMEP § 1212. However, use of “distinctiveness” is preferred.

³ A generic term is the “ultimate in descriptiveness.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

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descriptive for “candy,” which the record showed was a lollipop candy featuring a bobble head device); *In re Cox Enters. Inc.*, 82 USPQ2d 1040 (TTAB 2007) (THEATL – a compressed version of the term “THE ATL,” a recognized nickname for the city of Atlanta – held merely descriptive of printed matter of interest to residents of and tourists and visitors to Atlanta, Georgia).

In view of Petitioner’s failure to adequately plead its standing, the motion to dismiss is granted. In keeping with Board practice, Petitioner is allowed until twenty days from the mailing date set forth in this order to file an amended petition to cancel, failing which the petition to cancel will be dismissed. *See* TBMP § 503.03. Proceedings herein otherwise remain **suspended**.