

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 76//291959
Published September 10, 2002



04-28-2003

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #11

United Industries Corporation
Opposer,

v.

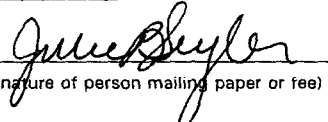
Opposition No. 91155808

OMS Investments, Inc.
Applicant.

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

APPLICANT'S MOTION TO DISMISS
FOR FAILURE TO STATE A CLAIM

Applicant hereby requests that the opposition filed on behalf of United Industries Corporation be dismissed for failure to state a claim upon which relief may be granted. The Brief in support of this Motion is set forth below.

CERTIFICATE OF MAILING
Date of Deposit : April 24, 2003
 I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.
JULIE B. SEYLER

 (signature of person mailing paper or fee)

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BRIEF

INTRODUCTION

Applicant is seeking to register the trademark MIRACLE for lawn and garden fertilizer, plant food, fertilizer in the form of spikes for houseplants, outdoor plants, trees and shrubbery; peat, compost, humus, loam and manure; potting soil, soil conditioners, soil amendments, and growing media for plants all for domestic use; herbicides for domestic use; mechanical spreaders for seed; fertilizer mixers and sprayers attached to garden hoses; and live plants.

Opposer is requesting that the Trademark Trial and Appeal Board refuse registration of the mark. However, a review of the seven allegations set forth in the Notice of Opposition reveals that Opposer has failed to state grounds upon which relief may be granted. Opposer's bald assertion in Paragraph 3 of the Opposition "that Applicants registration of the single term MIRACLE...will be detrimental to Opposer's right to use the term in conjunction with other terms or as part of slogans for the same or related products," does not support refusal of the application. In fact, nowhere in the Opposition does Opposer set forth a statutory claim for relief. This is because there is no statutory basis.

THE OPPOSITION FAILS TO SET FORTH A CLAIM AS TO WHY REGISTRATION SHOULD BE REFUSED UNDER SECTIONS 2(a), 2(b), 2(c), 2(d) OR 2(e) OF THE TRADEMARK ACT.

Section 2 of the Trademark Act sets forth the statutory grounds as to why a trademark must be refused registration. Section 2(a) prohibits the registration of a scandalous, immoral or disparaging trademark. Opposer is not asserting that Applicant's mark should be precluded from registration on these grounds.

Section 2(b) provides that marks that consist of a national or state flag, insignia, or coat of arms shall be refused registration. Opposer is not challenging registration of the trademark MIRACLE on the basis of Section 2(b).

Section 2(c) prohibits the registration of a trademark that consists of the name, portrait or signature of a living individual. Opposer has not pleaded Section 2(c) as a basis for refusing registration of MIRACLE.

Section 2(d) speaks to likelihood of confusion. Opposer has not claimed that it has prior common law rights in the trademark MIRACLE, nor has it claimed that it has filed a prior pending application or owns a registration for any mark such that registration of Applicant's mark would result in confusion.

Section 2(e) provides that no trademark that:

[c]onsists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional

shall be registrable on the Principal Register. Section 2(f) speaks to an exception for marks that fall into Section 2(e).

Opposer has not asserted that Applicant's mark is merely descriptive of the goods or deceptively misdescriptive of them. Opposer has not asserted that MIRACLE is geographic in nature or that it bears a surname significance. Opposer does not claim that MIRACLE is generic or functional.

Section 2 of the Trademark Act asserts that no trademark shall be refused registration **unless** it falls into one of the statutory prohibitions discussed above. MIRACLE does not, and Opposer has not claimed that it does. Rather Opposer is requesting that the Trademark Trial and Appeal Board refuse registration because it may be detrimental to Opposer. This is not a legal cause of action.

ASSUMING ALL OF OPPOSER'S ALLEGATIONS ARE TRUE, OPPOSER HAS FAILED TO STATE A CLAIM FOR RELIEF.

It is well-settled that for purposes of determining a Motion to Dismiss, all of Opposer's well-pleaded allegations must be accepted as true. In this case, and solely for purposes of determining the Motion to Dismiss, Applicant will not challenge Opposer's allegation in Paragraph 1 that it is a manufacturer of fertilizers, herbicides, insecticides plant food and other plant and garden products. This does not establish that MIRACLE should be refused registration.

Paragraph 4 states that "based on a review of Applicant's application file, it was noted that the Trademark Examining Attorney initially rejected the application on the basis of a prior filed application for MIRACLE RID-ROOT for weed killers in Class 5 which was abandoned for failure to file a statement of use."

The allegation, if accepted as true, is irrelevant to the opposition. Opposer is not claiming rights in MIRACLE RID-ROOT, and even if it was, it would be irrelevant since the application was based on intent to use and has been abandoned.

Paragraph 5 of the opposition asserts that "A search of Class 1 revealed over 65 marks in which the term MIRACLE is used in conjunction with other term and in Class 5 over 60 marks. To allow Applicant the right to use MIRACLE by itself appears to be in conflict with prior registrations using the term in conjunction with other terms." This allegation is meaningless. If such fact is proved, Opposer has not set forth a basis why MIRACLE should be refused.

Paragraph 6 states:

Furthermore, based on the fact that the Trademark Examining Attorney initially cited a prior filed application using the term MIRACLE as a basis of rejection, it can be assumed that future applications containing the word MIRACLE for fertilizers or plant food in Class 1 or herbicide or related products in Class 5 or in any of the other classes sought to be covered by this application will be rejected based on the prior registration for the single term MIRACLE. Future applicants, including Opposer, who may wish to obtain protection of a unitary mark consisting of terms including MIRACLE will therefore be damaged and suffer injury as a result of a registration for MIRACLE by itself.

There is no provision in the Trademark Act that prevents registration on this ground.

Paragraph 7 simply repeats that Opposer might be damaged by registration of the mark. Not only does the opposition fail to assert a claim, but the allegations as to damage are purely speculative in nature.

Reviewing the Opposition in its entirety, it is readily apparent that Opposer is on a fishing expedition. Construing all of Opposer's allegations in the most favorable light possible, there is not a scintilla of a chance that Opposer will be entitled to relief. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038 (Fed. Cir. 1993); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *National Ass'n of Blue Shield Plans v. Standard Mattress Co.*, 176 USPQ 29 (TTAB 1972).

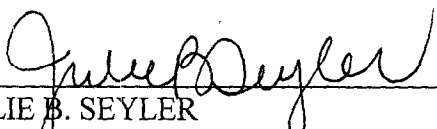
Further, inasmuch as there is not even one allegation that comes close to stating a claim for relief, Applicant respectfully requests that the Board not grant Applicant the opportunity to leave to amend its pleading. The Opposition has no basis in fact or law. FRCP 15(a); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984)(amendment would serve no useful purpose); TBMP 507.02.

The purpose of Rule 12(b)(6) "is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens

of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038, 1041, (Fed. Cir. 1993). The Opposition is fatally flawed.

WHEREFORE, it is requested that this MOTION TO DISMISS be granted and the Opposition refused with prejudice.

Respectfully submitted



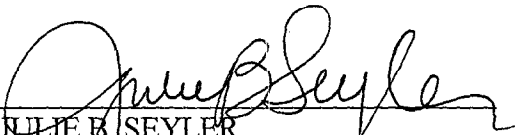
JULIE B. SEYLER

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM** was served by first class mail, postage prepaid this 24th day of April 2003 upon the following:

Annette P. Heller
UNITED INDUSTRIES CORPORATION
14323 South Outer Forty Drive
Suite 512 S
Town & Country, MO. 63017



JULIE B. SEYLER