

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

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Mailed: September 29, 2003

Opposition No. 155,808

United Industries
Corporation

v.

OMS Investments, Inc.

Before Seeherman, Holtzman and Bucher, Administrative
Trademark Judges.

By the Board.

On April 28, 2003, applicant filed a motion to dismiss
the notice of opposition under Fed. R. Civ. P. 12(b)(6).
Opposer has contested applicant's motion in a response filed
on May 12, 2003.

The notice of opposition alleges, inter alia, the
following:

3. Opposer believes that Applicant's registration
of the single term "MIRACLE" for products in
Classes 1, 5, 7, 21 and 31 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.

* * *

5. A search of Class 1 revealed over 65 marks in
which the term "miracle" is used in conjunction
with other terms 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.

6. 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 [of the application which is the subject of this proceeding], it can be assumed that future applications containing the word "miracle" for fertilizers or plant food in Class 1 or herbicides 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.

7. If Applicant is granted the registration, it would obtain at least a prima facie exclusive right to the use of its mark and the federal rights that are associated with a registration. Such registration would be a source of damage and injury to the Opposer should it want to use the term "miracle" in conjunction with other terms for products that would be in Classes 1, 5, 7, 21 and 31.

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. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038 (Fed. Cir. 1993). In order to withstand such a motion, a pleading need only allege such facts as would, if proven, 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

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opposing the involved application. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982); and TBMP §503.02 (2d ed. 2003).

Applicant contends that that the notice of opposition "is fatally flawed" because "nowhere in the Opposition does Opposer set forth a statutory claim for relief." In response, opposer maintains, inter alia, that it has properly alleged a Section 2(d) statutory claim in the notice of opposition.¹

After reviewing the notice of opposition and carefully considering the arguments of each party, we conclude that opposer has not suitably alleged a valid ground for opposing the involved application. Section 2(d) precludes the registration of a mark that so resembles a registered mark "or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive ...". In order to properly state a claim under Section 2(d), an opposer must plead that it has a proprietary interest in its mark which was obtained prior to the filing date of applicant's application. See *Zirco Corp. v. American*

¹ Opposer argues that it has asserted a Section 2(d) claim in the notice of opposition because it has asserted that the term "miracle" is "a single term ... which will be the basis for rejecting future applications that incorporate that term ..."

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Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991); and *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993).

The notice of opposition does not set forth the elements of a Section 2(d) claim; it does not allege any proprietary rights in a trademark, such as ownership of a registration, or use as a trademark, or use analogous to trademark use, and the opposition is silent on the question of priority. Thus, the notice of opposition fails to state a claim upon which relief may be granted in accordance with Fed. R. Civ. P. 12(b)(6).

In view of the foregoing, applicant's motion to dismiss is hereby granted. However, to afford opposer another opportunity to plead a claim if indeed opposer has a proprietary right in a term which it believes is confusingly similar to applicant's MIRACLE mark, opposer is allowed until **thirty days** from the mailing date of this order to file and serve an amended notice of opposition which properly pleads a claim of priority and likelihood of confusion in accordance with Section 2(d) of the Trademark Act. See TBMP §503.03 (2d ed. 2003) and cases cited therein.

If opposer files an amended notice of opposition, applicant is allowed until **thirty days** from the date of service of any amended notice of opposition to file and

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serve an answer thereto. (If necessary and appropriate, the Board will reset the discovery and trial periods at the appropriate time in this case.)

If opposer does not file an amended notice of opposition, this opposition will be dismissed with prejudice.

Proceedings herein remain otherwise suspended.