UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Greenbaum

Mailed: May 5, 2004

Opposition No. 91157128

TECHNOGYM S.p.A.

v.

MELALEUCA, INC.

Before Hairston, Bucher and Drost, Administrative Trademark Judges.

By the Board.

Applicant seeks to register the mark MELALEUCA . . . THE WELLNESS COMPANY for use in connection with:

> mail order catalog services featuring health care products, nutritionals, dietary supplements, vitamins and mineral supplements, nutritious foods, snacks and beverages, cosmetics, toiletries, laundry care products, cleaners, soaps, dishwasher detergents, air fresheners, detergents, and disinfectants.[1]

Opposer has opposed registration on the ground that applicant's mark, when used on the identified services, is likely to cause confusion with opposer's prior used mark THE WELLNESS COMPANY and opposer's family of registered marks containing the word WELLNESS for a wide variety of physical

[1] Application serial no. 76302883, filed as an intent-to-use application. Applicant has not yet filed an allegation of use.

exercise machines and health and physical fitness products and services.[2]

As an additional ground for opposition, opposer alleges that the term MELALEUCA is "the generic name for an ingredient in applicant's products and the tree from which the ingredient is derived," that "the leaves of the melaleuca tree are used to produce a substance commonly known as melaleuca or melaleuca oil, which is used in cosmetics and medicinal products of the type listed in the application at issue" and that "applicant did not disclaim exclusive rights in the word MELALEUCA and, therefore, registration of the mark should be refused." Applicant alternatively alleges that the term is merely descriptive of such products, and that applicant has not acquired distinctiveness in that term.

This case comes up on applicant's motion (filed November 3, 2003) to dismiss for failure to state a claim

[2] Opposer pleaded the following applications and registrations: 2569146, 2606995 and 2619545 for MY WELLNESS and pending application serial no. 75826504 for MY WELLNESS (identified as "currently allowed for registration); 2575179 for WELLNESS IN MOTION; 2597150 for WELLNESS ANGEL; 2671542 for WELLNESS SYSTEM; and pending application serial no. 76022977 for WELLNESS MANAGER, all for "a wide variety of goods and services in the fields of personal physical fitness, health and wellness." Opposer also pleaded pending application serial no. 76468521 for THE WELLNESS COMPANY for "handbooks and manuals in the field of physical exercise and medical, muscular, aerobic and cardiovascular rehabilitation through physical exercise; machines and equipment for physical and gymnastic exercises, for muscle training and rehabilitation, and for aerobic and cardiovascular exercise, namely, treadmills, step simulators, rowing machines, cycle simulators, barbells, dumbbells and exercise weights."

upon which relief may be granted insofar as the notice of opposition is based on the allegations that the "MELALEUCA" portion of the applied-for mark is generic or merely descriptive.[3] As grounds therefor, applicant contends that opposer has not alleged that it has a present or prospective right to use the term MELALEUCA descriptively in its business, and, therefore, opposer has no basis for opposition and no standing.

In its response to the motion, opposer argues that the notice of opposition includes allegations that the parties' respective products are closely related, and that applicant's goods are within opposer's zone of expansion.[4]

Opposer clearly has established its standing to maintain an opposition based on priority and likelihood of confusion under Section 2(d) of the Trademark Act with respect to the mark MELALEUCA . . . THE WELLNESS COMPANY.[5]

---

[3] Applicant filed the motion to dismiss concurrently with its answer.

[4] Opposer submitted copies of third party applications and registrations, and excerpts from several internet websites, including a press release from opposer's website, to support this position. Under Fed. R. Civ. P. 12(b), if matters outside the pleadings are submitted as part of a motion under 12(b)(6) and are not excluded by the court, the motion shall be treated as one for summary judgment and disposed of in accordance with Rule 56. In the present case, we have not relied on these extraneous materials in deciding the motion to dismiss, and have determined the sufficiency of the notice of opposition solely by looking at the notice of opposition. See Wellcome Foundation Ltd. v. Merck & Co., 46 USPQ2d 1478, 1479, n.2 (TTAB 1998); Internet Inc. v. Corp. For National Research Initiatives, 38 USPQ2d 1435, 1436 (TTAB 1996).

[5] Moreover, applicant does not challenge opposer's standing to bring the 2(d) claim.

Once a plaintiff has established its standing, it may raise any available statutory ground for opposition or cancellation. See Jewelers Vigilance Committee v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); Lipton v. Ralston, supra. Thus, having established its standing to oppose on grounds of likelihood of confusion, opposer may also raise claims of genericness or mere descriptiveness, assuming such grounds are otherwise available.

We note applicant's affirmative defense that it owns an incontestable registration for the mark MELALEUCA, and, therefore, that opposer may not challenge the applied-for mark on grounds of descriptiveness.[6] Applicant reiterates the purported "Morehouse Defense" in a footnote in the motion to dismiss. Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969). However, the marks MELALEUCA . . . THE WELLNESS COMPANY and MELALEUCA are neither the same mark nor are they legal equivalents. Therefore, the "Morehouse Defense" does not apply. See O-M Bread Inc. v. United States Olympic Committee, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995).

In view of the foregoing, the motion to dismiss is denied.

Proceedings are RESUMED. The parties are allowed THIRTY DAYS from the mailing date of this order to serve

responses to any outstanding discovery requests. Trial dates, including the close of discovery, are reset as follows:[7]

DISCOVERY PERIOD TO CLOSE:	**August 15, 2004**
Thirty-day testimony period for party in position of plaintiff to close:	**November 13, 2004**
Thirty-day testimony period for party in position of defendant to close:	**January 12, 2005**
Fifteen-day rebuttal testimony period to close:	**February 26, 2005**

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.l25.

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.l29.

---

[6] Registration No. 1917518. Applicant has not made a copy of this registration of record in this proceeding.

[7] Applicant's consented motion (filed March 5, 2004) to extend discovery and testimony periods is moot.