UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: March 22, 2006

Opposition No. **91166249**

KAJANE McMANUS, OWNER OF McMANUS ASSOCIATES

v.

Steven G. Lisa, Ltd.

Before Walters, Rogers, and Walsh, Administrative Trademark Judges.

By the Board:

An application has been filed by Steven G. Lisa, Ltd., to register the mark PATENT IT! for "legal services" in International Class 42.[1] Kajane McManus has opposed the application claiming that it uses its trade name, PATNTIT, to identify its business and has used that name since June, 1990.

In addition to an answer, applicant filed a motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6), on September 26, 2005, for failure to state a claim upon which relief may be granted. As grounds for the motion to

[1] Application Serial No. 78436516, filed June 16, 2004, alleging first use and first use in commerce dates of January 29, 1994.

dismiss, applicant states that opposer "has alleged priority without any direct or hypothetical pleading of likelihood of confusion." Opposer responds contending that "opposer's plea is more than hypothetical. It is… inherent."[2]

Applicant replies by pointing out that opposer fails to understand the sufficiency of pleadings required before the Board.[3]

In deciding a motion to dismiss, the Board must accept all of opposer's well-pleaded allegations in its notice of opposition as true, and these allegations must be construed liberally and in the light most favorable to opposer. Fed. R. Civ. P. 8(f). *See also*, 5A Wright & Miller, Federal Practice and Procedure: Civil 2d Section 1357 (1990). Only if it appears certain that there is no set of facts which, if proven to be true, would support opposer's claim will the Board dismiss the proceeding for insufficiency. *See, Stanspec Co. v. American Chain & Cable Co., Inc.,* 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

In this case, the Board finds that opposer has not alleged a statutory ground for opposition. Construing the

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[2] Opposer implies that the marks are "identical" and because opposer has used the mark for 15 years prior to applicant, its notice of opposition adequately pleads a statutory ground of refusal based on a likelihood of confusion.

[3] Opposer filed a surreply to applicant's reply on November 22, 2005 and applicant moved to strike that filing. Because surreplies are not accepted, it has not been considered and applicant's motion is moot. See Trademark Rule 2.127(a).

allegations, as we must, most favorably to opposer's position, we find that the notice merely asserts that opposer has used a trade name which is phonetically equivalent to applicant's mark. Opposer's allegations give it standing to bring this action because they are allegations of use of allegedly similar marks. However, opposer has not pleaded any statutory ground upon which the Board could grant relief, such as a likelihood of confusion between the marks. See Section 2(d) of the Trademark Act and TBMP Chapter 300.[4] A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark and (2) a short and plain statement of one or more grounds for opposition. *See* 37 CFR § 2.104(a) and *Young v. AGB Corp.,* 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) (standing and grounds are distinct inquiries; allegation of "economic damage" while relevant to standing does not constitute a ground).

In view of the foregoing, applicant's motion to dismiss is granted. Opposer is allowed until **thirty days** from the date hereof to amend its notice of opposition, absent which the proceeding will be dismissed. If opposer files an amended notice of opposition, applicant is allowed until 30 days from the date of service of opposer's amended pleading

[4] The parties are advised to refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) which is on the Office web site at: http://www.uspto.gov/web/offices/dcom/ttab/tbmp/.

to file an amended answer. Discovery remains open; trial dates may be reset upon motion of either party, approved by the Board or upon stipulation of the parties, approved by the Board.

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