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

Proceeding	91169654
Party	Plaintiff Visual Changes Skin Care International, Inc. Visual Changes Skin Care International, Inc. ,
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1                                   **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
 2                                   **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

3                                   \* \* \*

4 In the matter of Trademark Application No. 78/490,974  
 5 Published in the "Official Gazette" of September 13, 2005  
 6 Filing Date: September 28, 2004  
 7 For the Mark: **RESURRECTION BIOMIST**

8 -and-

9 In the matter of Trademark Application No. 78/490,954  
 10 Published in the "Official Gazette" of September 13, 2005  
 11 Filing Date: September 28, 2004  
 12 For the Mark: **NEWAYS RESURRECTION BIOMIST**

11 VISUAL CHANGES SKIN CARE 12 INTERNATIONAL, INC. 13                                   Opposer 14 v. 15 NEWAYS, INC. 16                                   Applicant	11 <b>OPPOSER'S MEMORANDUM          OF POINTS AND AUTHORITIES          IN OPPOSITION TO NEWAYS'          MOTION TO DIMSIMSS</b>  13                                   Opposition No. 91169654 14 - consolidated with - 15                                   Opposition No. 91169655
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18                   Opposer, Visual Changes Skin Care International, Inc. ("Visual Changes") submits this  
 19 memorandum in opposition to the motion of Neways, Inc. ("Neways") to dismiss Visual  
 20 Changes' proposed Amended Notice of Opposition.

21 **I. THE MOTION TO DISMISS SHOULD BE DENIED**

22 **A. The Motion to Dismiss is Procedurally Defective**

23                   Neways' motion to dismiss is procedurally defective for at least two reasons, and Visual  
 24 Changes objects to the motion on both grounds. First, the motion to dismiss is premature in that  
 25 it is directed toward an amended pleading (the Amended Notice of Opposition) that is the subject  
 26 of a separate and pending motion for leave to amend, but which has not yet been approved by the  
 27 Trademark Trial and Appeal Board (the "Board"). Thus, the present motion to dismiss the  
 28 amended pleading is premature and should therefore be denied.

1 Second, Neways has already filed an answer to the original Notice of Opposition. Where  
2 the defense of failure to state a claim upon which relief can be granted is raised by means of a  
3 motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer.  
4 TBMP 503.01; See Fed. R. Civ. P. 12(b). The present motion is therefore untimely, and should  
5 therefore be denied.

6 **B. The Amended Notice of Opposition States a Claim Upon Which Relief Can**  
7 **be Granted**

8 Without waiving the above procedural objections to the motion to dismiss, Opposer  
9 contends that the Amended Notice of Opposition properly states a claim upon which relief can  
10 be granted, so the motion to dismiss should be denied in any event.

11 **1. Legal Standards for a Motion to Dismiss**

12 Motions to dismiss are disfavored, and are rarely granted. *Gilligan v. Jamco Develop.*  
13 *Corp.*, 108 F.3d 246, 249 (9th Cir. 1997). Dismissal is only proper in extraordinary cases. *United*  
14 *States v. Redwood City*, 640 F.2d 963, 966 (9th Cir. 1981). The issue is not whether a plaintiff  
15 will ultimately prevail, but whether the claim is so specious that the plaintiff should not be  
16 entitled to offer evidence to support it. *Scheuer v. Rhodes*, 416 U.S. 232, 236, 94 S.Ct. 1683, 40  
17 L.Ed.2d 90 (1974). A complaint should not be dismissed for failure to state a claim unless it  
18 appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which  
19 would entitle him to relief. *Conley v. Gibson*, 355 U.S. 41, 45-46, 78 S.Ct. 99, 102, 2 L.Ed.2d 80  
20 (1957). The court must accept the plaintiff's factual allegations as true. *Albright v. Oliver*, 510  
21 U.S. 266, 268, 114 S.Ct. 807, 810, 127 L.Ed.2d 114 (1994). The complaint must be construed in  
22 the light most favorable to plaintiff. *Parks School of Business, Inc. v. Symington*, 51 F.3d 1480,  
23 1484 (9th Cir. 1995). The allegations should be construed liberally because the rules only require  
24 general or notice pleading rather than detailed fact pleading. *Leatherman v. Tarrant County*  
25 *Narcotics Intelligence and Coordination Unit*, 507 U.S. 163, 168, 113 S.Ct. 1160, 122 L.Ed.2d  
26 517 (1993).

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1                   **2. The Amended Notice of Opposition States a Claim under Section 2(d)**  
2                   **of the Trademark Act (15 U.S.C. § 1052(d))**

3                   In order to withstand a motion to dismiss, a pleading need only allege such facts as  
4 would, if proved, establish that the plaintiff is entitled to the relief sought. Neways acknowledges  
5 this on page 3 of its memorandum of law. In the present case, the pleading must show (1) the  
6 plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the  
7 registration sought therein. *See Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d  
8 1024, 213 USPQ 185 (CCPA 1982). No question of standing has been raised by Neways in its  
9 motion to dismiss, so the only issue presented is whether the pleading sets forth valid grounds for  
10 denying the registrations sought. As set forth above, it is not necessary to prove any of the  
11 allegations of the pleading at this stage, but simply to allege them.

12                   A valid ground for denying registration that must be alleged and ultimately proved by an  
13 opposer must be a statutory ground which negates the appellant's right to the subject registration.  
14 *Lipton*, 670 F.2d at 1030. Here the amended pleading is premised on Section 2(d) of the  
15 Trademark Act, 15 U.S.C. § 1052(d), which provides that a mark should not be registered if it:

16                   “Consists of or comprises a mark which so resembles a mark registered in the Patent and  
17 Trademark Office, *or a mark or trade name previously used in the United States by*  
18 *another and not abandoned*, as to be likely, when used on or in connection with the  
19 goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . .”  
20 (Emphasis supplied.)

21                   In its opposition, Neways asserts that the Amended Notice of Opposition presents “an  
22 entirely new legal theory.” (Neways’ brief, p. 4, line 13.). This is incorrect. With the exception of  
23 clarifying the listing of goods, the allegations in paragraph 1 of the Amended Notice of  
24 Opposition are *identical* to the allegations that were made in paragraph 2 of the original Notice  
25 of Opposition – which Neways answered. These paragraphs are worded so as to set forth the  
26 necessary allegations under Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)), as suggested  
27 in the McCarthy treatise (*See McCarthy on Trademarks and Unfair Competition*, § 20:30.), and

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1 provide the necessary statutory ground for the opposition. The allegations of both the original  
2 and amended pleading clearly meet this standard. In particular, both pleadings allege:

3           “Opposer since May 31, 2003, has been and is now, using the mark RESURRECTION in  
4 connection with [listed goods]. Said use has been valid and continuous since said date of  
5 first, and has not been abandoned. . . . it is alleged that Applicant’s mark[s] [NEWAYS]  
6 RESURRECTION BIOMIST so resemble[s] Opposer’s mark RESURRECTION,  
7 previously used in the United States and not abandoned, as to be likely to cause  
8 confusion, or to cause mistake or to deceive.”

9 These allegations track the language of section 2(d) almost word for word. So, if these  
10 allegations are proven, they provide a valid statutory ground for denying the registrations sought.

11           This is not a “new” claim or allegation because, with the exception of clarifying the  
12 listing of goods, these identical allegations were made in paragraph 2 of the original Notice of  
13 Opposition – which Neways answered. Such amplification of pleadings is expressly permitted  
14 under the applicable rules. TBMP 507.02. *See Avedis Zildjian Co. v. D.H. Baldwin Co.*, 180  
15 USPQ 539, 541 (TTAB 1973). Indeed, Neways has not objected to nor made any mention of the  
16 amplified listing of goods. Both the original and amended pleadings meet all of the elements  
17 required by Section 2(d). No authority is cited in Neways’ moving papers regarding the alleged  
18 insufficiency of the amended or original pleading, other than the bare statement that it is a “new  
19 legal theory.” The statute does not use or require recitation of the words “common law,” nor does  
20 it require mention of any specific geographic region. It simply refers to prior use “in the United  
21 States” which is what has been alleged. Thus, if these allegations are proven, they provide a valid  
22 statutory ground for denying the registrations sought. They therefore properly state a claim upon  
23 which relief may be granted, and the motion to dismiss should be denied.

24           **4. If the Amended Pleading is Deficient in Some Way, Leave to Amend Should**  
25           **be Granted.**

26           Rule 15(a) of the Federal Rules of Civil Procedure provides liberality in amending  
27 pleadings, that “leave shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a). The  
28 Supreme Court has declared that “this mandate is to be heeded.” *Foman v. Davis*, 371 U.S. 178,

1 182, 83 S.Ct. 227, 230, 9 L.Ed. 2d 222 (1962). In view thereof, the Trademark Trial and Appeal  
2 Board (the "Board") liberally grants leave to amend pleadings at any stage of a proceeding when  
3 justice so requires. TBMP § 507.02.

4       Because dismissal is such a drastic remedy, should the Board identify some defect in the  
5 pleadings that may be corrected by amendment, the appropriate course in such a case is not to  
6 dismiss, but to grant leave to amend. Unless the facts alleged in the complaint clearly show that  
7 plaintiff has no legitimate claim, courts will ordinarily allow the plaintiff leave to amend. *Health*  
8 *Cost Controls v. Skinner*, 44 F.3d 535, 538 (7th Cir. 1995). Where a more carefully drafted  
9 complaint might state a claim, a plaintiff must be given at least one more chance to amend the  
10 complaint before dismissal of the action. *Silva v. Bieluch*, 351 F.3d 1045, 1048 (11th Cir. 2003).  
11 Accordingly, should such an amendment be appropriate, Opposer hereby respectfully requests  
12 leave to amend.

13       **5.       Extension of Trial Deadlines**

14       Although the discovery period has not yet closed, that deadline as well as the other  
15 deadlines that have been established in these consolidated proceedings are approaching.  
16 Accordingly, Opposer requests that the discovery cutoff and all other deadlines in these  
17 proceedings be extended for a period of at least 60 days following the Board's ruling on the  
18 present motion.

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1 **II. CONCLUSION**

2 In light of the above, it is respectfully requested that Opposer's Motion to Dismiss be  
3 denied. In the alternative, if the motion is granted, Opposer requests that it be provided leave to  
4 amend. Finally, Opposer requests that the discovery cutoff and all other deadlines in this  
5 proceeding be extended for a period of at least 60 days following the Board's ruling on the  
6 present motion.

7  
8 Dated: October 5, 2006

Respectfully Submitted,

9 KIMBLE, MacMICHAEL & UPTON  
A Professional Corporation

10  
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**Certificate of Mailing 37 CFR § 2.197**

I hereby certify that that a true copy of the foregoing Opposer's Memorandum of Points and Authorities in Opposition to Neways' Motion to Dismiss is being served on the Applicant by being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

John C. Stringham  
Robyn L. Phillips, Esq.  
WORKMAN NYDEGGER  
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60 East South Temple Street  
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on October 5, 2006.

Signed:   
Deniece Turner

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