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

Proceeding	91205081
Party	Defendant Dynamic Sports Nutrition, LLC
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application No. 85/340,058
Published in the Official Gazette on January 10, 2012

MSD OSS B.V.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91205081
	§	
DYNAMIC SPORTS NUTRITION, LLC,	§	
	§	
Applicant.	§	

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

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and TBMP §503, Applicant DYNAMIC SPORTS NUTRITION, LLC ("Applicant"), through its undersigned attorneys, submits this Motion to Dismiss the Notice of Opposition filed by Opposer MSD OSS B.V. ("Opposer") for failure to state a claim upon which relief can be granted as to all three of Opposer's claims.

In support of this Motion, Applicant states as follows:

I. INTRODUCTION

Opposer filed its Notice of Opposition on May 9, 2012, without citing as the basis of its claims any trademark registration, application, or even common law rights. *See* [Notice of Opposition, ¶¶ 1-6] (showing that Opposer has not cited any interest in any U.S. marks as the basis for this Opposition). Since no U.S. trademark rights are cited as a basis for Opposer's "claims," standing has not been established within the Notice of Opposition. *See id.* Furthermore, as discussed further below, a valid ground for denying the registration sought by Applicant has not been

established. For these reasons, the Board should grant this Motion to Dismiss for Failure to State a Claim and dismiss the present Opposition proceeding in due course.

II. ARGUMENTS

A. Opposer Has Failed to State a Claim Upon Which Relief May Be Granted.

In order to state a claim upon which relief may be granted in an opposition proceeding, the Opposer must allege facts which, if proved, establish that (1) the Opposer has standing to challenge the registration which the complaint is directed, and (2) that there is a valid ground for denying the application sought. *See* TMEP § 503.02; *see* Trademark Rule 2.112(a).

B. Standing Has Not Been Established.

To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the opposition. *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). In addition, plaintiff must have a reasonable basis for its belief that it would be damaged by the registration to establish standing. *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986). When pleading allegations relative to standing, the plaintiff's belief in damage must have some reasonable basis in fact. *Universal Oil Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972).

Opposer has, apparently, based its standing on a collection of foreign trademarks. *See* [Notice of Opposition, ¶¶ 4-6]. Moreover, Opposer has even conceded that "Opposer does not currently sell prescription injectable anabolic steroid products under the DURABOLIN and DECA-DURABOLIN marks in the United States." *See* [Notice of Opposition, ¶ 4]. In fact, Opposer does not allege any use of either mark in the United States. Applicant believes that citing a collection of

foreign trademark registrations, while admitting that the Opposer has abandoned rights in the U.S. to a previously held mark, does not create a "real interest" in this proceeding. Similarly, having abandoned rights in the U.S. to a previously held mark means that Opposer will not be damaged by registration of Applicant's mark. For this reason, no standing exists for Opposer in this proceeding.

C. Opposer Has Failed to State a Claim of Deceptiveness.

In an opposition proceeding alleging deceptiveness of a non-geographic mark, the opposer must allege facts sufficient to establish three essential elements, namely, (1) the term is misdescriptive of the character, quality, function, composition, or use of the goods, (2) prospective purchasers are likely to believe that the misdescription actually describes the goods, and (3) the misdescription is likely to affect the decision to purchase. *See* Lanham Act § 2(a); *see Hoover Co. v. Royal Applicant Mfg. Co.*, 238 F.3d 1357, 1361, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001); *In re Budge Mfg. Co., Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

In the present case, Opposer has not established, at the very least, the common requirement to all three of the elements of deceptiveness, namely, that the mark is a descriptive term. Applicant's non-geographic mark cannot be deceptive if it is not descriptive. The term "DECA-DURABOLIN" is a fanciful word that in no way describes the goods "dietary and nutritional supplements." Opposer implicitly recognizes this point by explicitly failing to include any allegation in the Notice of Opposition as to the descriptiveness of Applicant's mark. As a result, the Opposer's allegation of deceptiveness in the Notice of Opposition fails all three prongs of the test to determine whether a mark is deceptive and should, accordingly, be dismissed.

D. Opposer Has Failed to State a Claim of False Suggestion of a Connection.

In an opposition proceeding alleging false suggestion of a connection under Trademark Act Section 2(a), the Opposer must allege facts sufficient to establish four essential elements, namely, (1) the applicant's mark is the same as, or a close approximation of, the opposer's previously used name or identity; (2) it must be established that the applicant's mark would be recognized as such, in that it points uniquely and unmistakably to the opposer; (3) it must be shown that the opposer is not connected with the goods or services provided by the applicant under its mark, and (4) the opposer's name or identity is of sufficient fame or reputation that, when applicant's mark is used on its goods or services, a connection with Opposer would be presumed by someone considering purchasing the goods or services. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 (Fed. Cir. 1983); *see also In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). The Federal Circuit has made it clear that Section 2(a) was designed to protect "the name of an individual or institution which was not a technical 'trademark' or 'trade name' upon which an objection could be made under Section 2(d)." *University of Notre Dame du Lac*, 703 F.2d at 1375 (emphasis added). Furthermore, Opposer must establish proprietary rights in its name or identity which are allegedly prior to the applicant's proprietary rights. *In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1383 (TTAB 1993); *Kardex Systems, Inc. v. Sistemco N.V.*, 221 USPQ 149, 151 (TTAB 1983).

In the present case, Opposer has misconstrued the purpose of the cause of action intended under Section 2(a) of the Lanham Act, and Opposer has subsequently failed to establish all of the requisite elements of the cause of action. In the Notice of Opposition, Opposer first cites a variety of background information. *See* [Notice of Opposition, ¶¶ 1-18]. Opposer then posits that

"[b]because the DURABOLIN and DECA-DURABOLIN marks are closely identified with Opposer and its prescription anabolic steroid product, Applicant's use and registration of the mark DECA-DURABOLIN . . . likely will lead consumers to purchase Applicant's DECA-DURABOLIN product in the mistaken belief that Applicant's DECA-DURABOLIN product originates with, is affiliated with, is sponsored or approved by, or is somehow connected to Opposer" as a feeble attempt to allege false suggestion of a connection. *See* [Notice of Opposition, ¶ 22]. Such a statement is an inadequate attempt to plead false suggestion of a connection, and the fact that Opposer pleads the cause of action in the present case vitiates the entire purpose for which the false suggestion of a connection cause of action was devised.

As to the first prong of the test for false suggestion of a connection, Opposer makes no claim that Opposer ever previously used the term "DURABOLIN" or "DECA-DURABOLIN" as the "name or identity" of a "person or institution", as the relevant statute has been interpreted by the Federal Circuit. *See University of Notre Dame du Lac*, 703 F.2d at 1375. As espoused by the Federal Circuit, "the drafters sought by § 2(a) to embrace concepts of the right to privacy . . . . It is a right of this nature to control the use of one's identity". *Id.* at 1376. In the case at bar, Opposer does not allege that Opposer has ever been identified as "DURABOLIN" or "DECA-DURABOLIN". Instead, Opposer appears to postulate that foreign trademark registrations for these phrases should serve as the basis for asserting false suggestion of a connection. Such an interpretation is clearly at odds with the plain language of the statute, which enumerates that the cause of action exists to protect "persons, living or dead, institutions, beliefs, or national symbols". 15 USC § 1052(a). Foreign trademark registrations are not among the class of persons or institutions protected under the statute. Opposer's interpretation of the statute also violates the legislative intent behind the statute and the Federal

Circuit's interpretation of the statute, as the statute was supposed to protect the "name or identity" of a "person or institution". *See University of Notre Dame du Lac*, 703 F.2d at 1375. In the Notice of Opposition, Opposer fails to satisfy the pleading requirements for false suggestion of a connection and that claim should, accordingly, be dismissed.

As to the second prong of the test for false suggestion of a connection, because Opposer does not allege that Opposer, as an institution or individual, has ever been identified as "DURABOLIN" or "DECA-DURABOLIN", Opposer has necessarily made no claim that Applicant's mark points uniquely to Opposer's alleged "name or identity." *See University of Notre Dame du Lac*, 703 F.2d 1372.

As to the fourth prong of the test for false suggestion of a connection, Opposer has made no mention of sufficient fame or reputation, which is required by the statute. Indeed, in light of the above-described elements for a claim of false suggestion of a connection, and assuming the facts in the Notice of Opposition are true, any amendment to such a claim would be futile. *See Foman v. Davis*, 371 U.S. 178, 182 (1962). If such a claim were allowed to continue, the claim would unduly prejudice Applicant in this proceeding due to the inevitable delay in the proceeding and expense it would cause. *See id.*

E. Opposer Has Failed to State a Claim of the Mark being Deceptively Misdescriptive.

In an opposition proceeding alleging that a mark is deceptively misdescriptive, the opposer must allege facts sufficient to establish that (1) the term misdescribes a characteristic, quality, function, composition, or use of the underlying goods or services, and (2) if so, that prospective purchasers are likely to believe that the misdescription actually describes the goods. *See* Lanham Act § 2(e)(1); *see In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984). *See also Bureau*

Nat'l. Interprofessional Du Cognac v. Int'l Better Drinks Corp., 6 USPQ2d 1610, 1615 (TTAB 1988) (if the mark misdescribes the goods, and purchasers are likely to believe the misrepresentation, but the misrepresentation is not material to the purchasing decision, then the mark is deceptively misdescriptive); *In re Woodword & Lothrop Inc.*, 4 USPQ2d 1412, 1413 (TTAB 1987).

It is axiomatic that in order for a mark to be deceptively misdescriptive, the mark must first be descriptive. The term "DECA-DURABOLIN" is a fanciful word that in no way describes the goods "dietary and nutritional supplements." Opposer implicitly recognizes this point by explicitly failing to include any allegation in the Notice of Opposition as to the descriptiveness of Applicant's mark. As a result, the Opposer's allegation of deceptiveness in the Notice of Opposition fails both prongs of the test to determine whether a mark is deceptively misdescriptive and should, accordingly, be dismissed.

III. CONCLUSION

For the foregoing reasons, it is evident that Opposer has not alleged facts that would, if proved, establish that it is entitled to the relief sought in any of its claims. *See* TMEP §503.02. For this reason, Applicant respectfully requests that the Board grant Applicant's Motion to Dismiss for Failure to State a Claim, that judgment is entered against Opposer and that this Opposition proceeding is dismissed with prejudice.

Respectfully submitted,

May 30, 2012
Date

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CERTIFICATE OF SERVICE

I hereby certify that Applicant's Motion to Dismiss for Failure to State a Claim is being sent by first class mail on May 30, 2012 to the attorney of record for Opposer at the following address:

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