

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

BUO

Mailed: March 14, 2014

Opposition No. 91205803

Vertex Pharmaceuticals
Incorporated

v.

Hercules Brand Corporation

Benjamin U. Okeke, Interlocutory Attorney:

Motion for Summary Judgment

Opposer's motion for summary judgment, filed February 28, 2014, will be given no consideration as it exceeds the page limits specified in Trademark Rule 2.127(a). *See* 37 C.F.R. § 2.127(a). Trademark Rule 2.127(a) states, in pertinent part, that "[n]either the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, **including table of contents, index of cases,** description of the record, statement of the issues, recitation of the facts, argument, and summary." (emphasis added) *See Saint-Gobain Corp. v. Minn. Mining and Mfg. Co.*, 66 USPQ2d 1220, 1222 (TTAB 2003); *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB) (overlength reply brief included a table of

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contents and a table of authorities). *See also* TBMP § 502.02(b) (3d ed. rev.2 2013).

Motion for Leave to File Amended Notice of Opposition

Additionally, on January 14, 2014, opposer filed a motion for leave to file an amended notice of opposition. Opposer seeks to amend its notice of opposition to assert claims of (i) fraud, (ii) that applicant lacked a bona fide intent to use its mark as of the filing date of the application, and (iii) that applicant was not using its mark in commerce on the date an allegation of use was filed in connection with the application as grounds for opposition of Application Serial No. 85505191. Applicant contends that opposer's motion is untimely, and in any event that the claims are "without merit." The motion has been fully briefed.

The amendment of pleadings prior to trial is contemplated by Federal Rule of Civil Procedure 15(a). *See* Trademark Rule 2.107(a) (Fed. R. Civ. P. 15 applicable to oppositions). With respect to the circumstances at hand, Rule 15(a)(2) states: "a party may amend its pleading only with the opposing party's written consent or the court's leave. The court should freely give leave when justice so requires." *See* TBMP § 507.01. *See also Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

In interpreting Rule 15(a), the Supreme Court noted in *Forman v. Davis*, 371 U.S. 178, 182 (1962), that:

If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he ought to be

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afforded an opportunity to test his claims on the merits. In the absence of any apparent or declared reason—such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc.—the leave sought should, as the rules require, be “freely given”.

Opposer, by its motion, seeks leave to add its claims of lack of bona fide intent to use, nonuse, and fraud, set forth in paragraphs 11-16 of its proposed amended pleading, as new grounds for its opposition in addition to its existing claim of likelihood of confusion.

Opposer alleges that:

...

11. Applicant did not have a bona fide intent to use its mark in the United States on all the goods and services listed in the Application at the time the Application was signed.
12. Applicant has not used Applicant’s Mark in connection with all of Applicant’s Goods or Services anywhere and/or in U.S. interstate commerce as of the filing date of the Amendment to Allege Use.
13. Applicant did not first use Applicant’s Mark in U.S. interstate commerce in connection with Applicant’s Goods or Services on February 16, 2012.
14. One or more material misrepresentations of fact was made by Applicant at the time of filing the Application and/or at the time of filing the Amendment to Allege Use and/or during the prosecution of the Application.
15. Applicant knew or should have known that such misrepresentations of fact as referenced in Paragraphs 11, 12, and 13 herein were false and/or misleading.

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16. Applicant has committed fraud in attempting to procure a registration for Applicant's Mark, thus making Applicant's Application void *ab initio*.

Proposed Amended Notice of Opposition, ¶¶ 11-16.

Opposer's amendment does not otherwise substantively modify the notice of opposition in any significant respect.¹

We find that under the circumstances of this case, any delay by opposer in asserting its claims was not excessive. We find the claims to have been promptly made, inasmuch as they are based on information yielded from opposer's discovery requests. There is no evidence of record to indicate any bad faith or dilatory motive on the part of opposer in filing this motion. Finally, while fact discovery has closed, given the nature of opposer's proposed claims, it is likely that much — if not all — of the information relevant to those claims is already in applicant's possession. Therefore, opposer's motion would not prejudice applicant or significantly delay resolution of the proceeding.

While we find that opposer's proposed amendment was timely asserted, we must also consider whether the amendment is legally sufficient. *See Commodore Elects. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993); *Forman*, 371 U.S. at 182.

¹ The Board notes the change of applicant's address from 130 Waverly Street, Cambridge, Massachusetts 02139-4242, to 50 Northern Avenue, Boston, Massachusetts 02110; and opposer's correction of the date in paragraph 2 for the filing of the allegation of use in connection with the subject application.

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The Board applies the same standard as would be applied to the determination of a motion under Fed. R. Civ. P. 12(b)(6), testing the sufficiency of a complaint. *See* TBMP § 503.02. To survive such a motion, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), *quoting Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556. In particular, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

A. Standing

Opposer has adequately pleaded its standing. *See Lipton Indus., Inc.*, 213 USPQ at 188-89 (CCPA 1982); TBMP § 309.03(b). That is, the statements in paragraphs 2-6 of the proposed amended notice of opposition

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allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for opposer's belief that it would be damaged by registration. *See Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458, 459 (CCPA 1972). Additionally, because opposer has established its standing with respect to its likelihood of confusion claim, it has the right to assert any other appropriate grounds for opposition in the same proceeding. *Enbridge Inc.*, 92 USPQ2d at 1543 n.10, *citing Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983) (averments of priority, likelihood of confusion and resulting damage accepted to show petitioner's standing with respect to pleaded grounds of fraud and abandonment).

Therefore, as standing has been sufficiently pleaded in opposer's likelihood of confusion claim, opposer need not separately establish its standing for the additional statutory grounds for refusal.

B. The Proposed Additional Claims

Notwithstanding the timeliness of opposer's motion, and its standing to bring these claims, opposer failed to plead sufficient facts to support its claims of lack of bona fide intent to use, non-use, and fraud. Paragraphs 11-16 of the proposed amended notice of opposition are merely conclusory recitations of the elements of these claims.² For example, opposer asserts

² Indeed, opposer failed to plead the elements of fraud at all. In order to sufficiently plead a claim of fraud, opposer would need to allege that applicant knowingly filed a material, false statement, with the intention to deceive the USPTO and thereby obtain or maintain a registration to which it was not entitled. Further opposer would need to plead, and of course

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that applicant made “[o]ne or more material misrepresentations of fact,” but fails to disclose to the Board the nature or substance of those misrepresentations.

Therefore, opposer’s proposed amended notice of opposition must fail under a Rule 12(b)(6) standard, since there are insufficient facts presented to prove the claims in the first place. *See Twombly*, 550 U.S. at 555. “Nor does a complaint suffice if it tenders ‘naked assertion[s]’ devoid of ‘further factual enhancement.’” *Id.* at 557.

Accordingly, opposer’s motion is **DENIED**.

Dates remain as previously set by the Board’s December 30, 2013 order.

then prove, that respondent subjectively believed its own declaration to be false. *See Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 (CCPA 1978). Further, opposer’s allegation that “Applicant knew or should have known” of its alleged misrepresentation fails to recognize that the standard of “knew or should have known” set forth in *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003), was discarded by *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).