

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

MT

Mailed: December 20, 2013

Opposition No. 91211162

Jongkind Grond B.V.

v.

Green Rain Inc.

**By the Trademark Trial and Appeal Board:**

Opposer's motion (filed September 18, 2013) to dismiss applicant's counterclaim for failure to state a claim is granted as conceded and as well-taken. See Trademark Rule 2.127(a).

Because opposer's pleaded Registration No. 4051374 is based on a request for extension of protection under Trademark Act Section 66(a), 15 U.S.C. Section 1141f, opposer was not required to use the mark in commerce prior to the issuance of that registration. See TMEP Section 1904.01(d) (October 2013). Accordingly, applicant's intended counterclaim based on nonuse is insufficient.

However, once that registration issued, any dispensation of use requirements ceased, and that registration may be subject to claims of abandonment. See Trademark Act Section 45, 15 U.S.C. Section 1127; *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990).

A pleading of abandonment requires allegation of at least three consecutive years of non-use or facts that show a period of non-use less than three years coupled with an intent not to resume use. Because the pleaded registration did not issue until November 8, 2011, applicant cannot base an abandonment claim on three consecutive years of non-use at this time. To the extent that applicant intends to allege abandonment based on a period of non-use of less than three years, applicant has alleged of non-use of opposer's pleaded registered mark, but has not alleged intent not to commence or resume use.

Applicant may also seek to cancel the pleaded registered mark based on a claim of genericness. However, applicant has failed to clearly set forth such a claim in the counterclaim. See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 USPQ 528 (Fed. Cir. 1986).

Applicant's consented motion (filed October 1, 2013) and the parties' stipulation (filed November 27, 2013) to suspend this proceeding for settlement negotiations are granted to the extent that applicant is allowed until sixty days from the mailing date set forth in this order to file an amended answer and counterclaim. If applicant does not file an amended answer and counterclaim, the counterclaim will be dismissed, and the proceeding will go forward with applicant's current answer as the operative responsive pleading of record.

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Proceedings herein are otherwise suspended until thirty days from the mailing date set forth in this order.