

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

wbc

Mailed: March 8, 2014

Opposition No. 91214396

LUCITE INTERNATIONAL, INC.

v.

Hyun, Karen Y.

Wendy Boldt Cohen, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on March 6, 2014.

Participating in the conference were opposer's attorney, Drew Smith, applicant's attorney, Robert Gookin, and Board interlocutory attorney Wendy Boldt Cohen.

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/syndagmnt.jsp>. If the parties wish to add or modify any provisions to the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

The Board reminds the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) can occur until the parties make their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties are advised that the Board will consider at final hearing a printout of an excerpt from an Internet website that is submitted under notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e), where that printout identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL). See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

The parties indicated that they have not engaged in settlement negotiations and that there is no other pending litigation, in federal court or before the Board, between the parties.

The parties are informed that the Board encourages settlement. To that end, the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

The Board discussed accelerated case resolution (ACR), but the parties have not committed to ACR at this time. The parties are directed to review the Board's website regarding ACR at <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>. If the parties later agree to pursue ACR after some disclosures and discovery, they should notify the interlocutory attorney assigned to this proceeding by not later than two months from the opening of the discovery period.

Stipulations/Filings

The parties agreed to service by e-mail, with Trademark Rule 2.119(b)(6) being applicable to such service. The parties were reminded that by making this stipulation, the parties may not avail themselves of the additional five days contemplated by Trademark Rule 2.119(c), afforded to parties when service is made by first-class or express mail. See *MacDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at <http://estta.uspto.gov>. Throughout this proceeding, the

Opposition No. 91214396

parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, online at:

<http://www.law.cornell.edu/rules/frcp/>.

Pleadings

The Board then reviewed the pleadings in this case. In the notice of opposition, opposer has adequately pleaded its standing. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP Section 309.03(b) (3d ed. rev. 2012). That is, the statements in paragraphs 1-12 of the notice of opposition allege facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. See *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

The ESTTA cover sheet of the notice of opposition indicates that opposer intends to pursue claims of deceptiveness and false suggestion of a connection under Trademark Act § 2(a), 15 U.S.C. § 1052(a), priority and likelihood of confusion under Trademark Act § 2(d), 15

Opposition No. 91214396

U.S.C. § 1052(d), dilution under Trademark Act § 43(c) and lack of bona fide intent to use under Trademark Act § 1(b).

Likelihood of Confusion

Opposer adequately set forth a claim of likelihood of confusion with its pleaded registrations under Trademark Act § 2(d), 15 U.S.C. § 1052(d), in paragraphs 1-11 and 18-26 of the notice of opposition. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); TMEP § 1207.01 *et seq.* To the extent opposer relies on its pleaded registrations, priority will not be an issue in this case because opposer has included with its notice of opposition status and title copies of the pleaded registrations. See Trademark Rule 2.122(d)(2); *King Candy Co.*, 182 USPQ 108.

Dilution

Opposer's dilution claim is insufficiently pled because it does not aver when opposer's pleaded mark became famous,¹ which must be at least before the filing

¹ "Fame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

Opposition No. 91214396

date of the applicant's application. See *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001); *The Toro Company v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001); *Polaris Industries, Inc. v. DC Comics*, 59 USPQ2d 1978 (TTAB 2000).

Accordingly, **paragraph 27 in the notice of opposition is hereby sua sponte stricken.** See TBMP § 506.01.

False Suggestion of a Connection

To state a claim of false suggestion of a connection under Trademark Act Section 2(a), opposer must allege facts from which it may be inferred (1) that applicant's mark points uniquely and unmistakably to opposer as an entity -- i.e., that applicant's mark is opposer's identity or "persona;" (2) that purchasers would assume that goods and/or services rendered under applicant's mark are connected with opposer; and (3) either (a) that opposer was the prior user of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona", or (b) that there was an association of the mark with opposer prior in time to applicant's use.² See *id.* Unless opposer can in good faith assert that BLUE

² A false suggestion claim under Section 2(a) is not an alternative means of raising a likelihood of confusion claim under Trademark Act Section 2(d).

Opposition No. 91214396

LUCITE points uniquely and unmistakably to opposer, i.e., that BLUE LUCITE is opposer's identity or persona, there would appear to be no basis for a false suggestion claim herein.

Because opposer has not alleged that BLUE LUCITE is its persona or identity, false suggestion of a connection is not properly pled. Accordingly, **paragraph 28 in the notice of opposition is hereby sua sponte stricken.** See TBMP § 506.01.

Lack of Bona Fide Intent to Use

In paragraphs 13-14, opposer alleges that there was no use of applicant's mark prior to the filing of the involved application. Because the involved application was filed based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), applicant was not required to use the mark in commerce prior to filing the involved application. Accordingly, paragraphs 13-14 do not set forth a ground for opposition herein and are hereby **sua sponte stricken.** See TBMP § 506.01.

Notwithstanding the foregoing, paragraph 15 alleges that applicant does not have a bona fide intent to use³

³ Trademark Act Section 1(b), 15 U.S.C. § 1051(b), states that "a person who has a bona fide intention, under circumstances showing

BLUE LUCITE in commerce on the goods specified in the application. Paragraph 15 and 29 properly plead a claim of lack of bona fide intent to use.

Answer

In its answer applicant denied the salient allegations of the notice of opposition and raised four "affirmative defenses."

The first and second affirmative defenses, genericness and lack of fame, respectively, set forth allegations which are directed at a likelihood of confusion analysis and appear to go to the merits of the case. The defendant in a Board proceeding should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied. See Trademark Rule 2.106(b)(1); TBMP § 311.02. Notwithstanding the foregoing, inasmuch as applicant's allegations give opposer a more complete

the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "'in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act § 45, 15 U.S.C. § 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)).

Opposition No. 91214396

notice of its position, the Board treats applicant's allegations as amplifications of its denials. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 USPQ2d 1570 (TTAB 1988).

The third affirmative defense is failure to state a claim. For the reasons already noted herein, opposer has adequately pleaded its standing and at least one valid claim. Accordingly, **applicant's third affirmative defense is hereby sua sponte stricken**. *See* TBMP § 506.01.

The fourth affirmative defense is not an affirmative defense inasmuch as it attempts to reserve the right to raise additional affirmative defenses as they become available in discovery. This merely paraphrases Fed. R. Civ. P. 15, does not include any affirmative defense and thus, **the fourth affirmative defense is hereby, sua sponte, stricken** by the Board. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01. If applicant wishes to later amend its pleading to raise any affirmative defenses or otherwise, it will need to do so pursuant to Fed. R. Civ. P. 15. *See* Trademark Rule 2.107.

Opposer is allowed until **twenty days** from the mailing date set forth in this order to file an amended

Opposition No. 91214396

notice of opposition wherein it repleads its ground(s) for dilution and/or false suggestion of a connection under Trademark Act Section 2(a), failing which the opposition will proceed solely on the claims of priority and likelihood of confusion under Trademark Act Section 2(d) and lack of bona fide intent to use under Trademark Act Section 1(b). See Fed. R. Civ. P. 15(a); TBMP § 507.02. If opposer files an amended notice of opposition, applicant is allowed until **thirty days** from the date of service of the amended notice of opposition to file an answer, or otherwise respond to the amended notice.

Dates are reset as follows:

Discovery Opens	4/2/2014
Initial Disclosures Due	5/2/2014
Expert Disclosures Due	8/30/2014
Discovery Closes	9/29/2014
Plaintiff's Pretrial Disclosures	11/13/2014
Plaintiff's 30-day Trial Period Ends	12/28/2014
Defendant's Pretrial Disclosures	1/12/2015
Defendant's 30-day Trial Period Ends	2/26/2015
Plaintiff's Rebuttal Disclosures	3/13/2015
Plaintiff's 15-day Rebuttal Period Ends	4/12/2015

The Board thanks the parties for their participation.