

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Baxley

Mailed: August 12, 2014

Opposition No. 91215036


Tommie Copper Inc.

v.

Tristar Products, Inc.

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

Tristar Products, Inc. (“Applicant”) seeks to register the mark COPPER

WEAR and design in the following form, , for “clothing, namely, socks, shirts, tights, sleeves, undershorts, shorts, and gloves, all the foregoing goods featuring copper-infused fabric” in International Class 25.<sup>1</sup>

Tommie Copper Inc. (“Opposer”) filed a notice of opposition to the registration of Applicant’s mark. In lieu of an answer, Applicant filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. Opposer filed a brief in response thereto.

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<sup>1</sup> Application Serial No. 85826741, filed January 18, 2013, 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). The application includes a disclaimer “to the exclusive right to use ‘COPPER WEAR’ apart from the mark as shown.” The application also includes the following description: “The color(s) copper and grey is/are claimed as a feature of the mark. The mark consists of the wording “COPPER WEAR” in grey, with a copper-colored paintbrush-style stroke at the diagonal between the two words.”

A motion to dismiss under Rule 12(b)(6) is solely a test of the sufficiency of the complaint. For a complaint to be legally sufficient, 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 Industries, 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, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In deciding such a motion, “the Board ... must accept as true all material allegations of the complaint, and must construe the complaint in favor of the complaining party.” *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). In addition, under the simplified notice pleading requirements of the Federal Rules of Civil Procedure, the allegations of a complaint are construed liberally “so as to do substantial justice.” Fed. R. Civ. P. 8(e); *Scotch Whisky Assoc. v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991).

Applicant does not allege in its motion that Opposer has failed to plead its standing to maintain this proceeding. Nonetheless, the Board, in the interest of completeness, finds that Opposer has adequately pleaded a reasonable basis for a belief of damage and a real interest in the outcome of the

proceeding in paragraphs 1-7 of the notice of opposition based on its application Serial No. 85046513 for the mark TOMMIE COPPER WEAR, its ownership of Registration No. 4236726 for the mark TOMMIE COPPER, and its “substantial investment and effort in marketing and promoting its products and services offered under” the TOMMIE COPPER mark. *See* Trademark Act Section 13(a), 15 U.S.C. § 1063(a); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

The electronic cover sheet of the notice of opposition indicates that Opposer intends to plead claims of (1) priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); (2) mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); and (3) fraud. However, in the text of the notice of opposition, Opposer sets forth only claims that (1) the mark is unregistrable under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), and (2) Applicant committed fraud on the USPTO in a disclaimer that Applicant submitted in an October 3, 2013 response to an Office Action during *ex parte* examination. Opposer did not plead a claim under Section 2(d) based on either any alleged prior use of the TOMMIE COPPER WEAR<sup>2</sup> or its prior use and registration

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<sup>2</sup> Opposer’s application Serial No. 86046513 was filed based on an assertion of a bona fide intent to use the TOMMIE COPPER WEAR mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), on August 23, 2013, i.e., more than seven months after the filing of Applicant’s involved application.

of the TOMMIE COPPER mark. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In Opposer's Section 6(a) claim, Opposer alleges that, notwithstanding Applicant's disclaimer of COPPER WEAR, the design element of Applicant's involved mark "is insignificant in relation to Applicant's [mark] as a whole and insufficiently distinctive to allow registration of the mark as a whole." Notice of opposition, paragraph 32. However, Section 6(a) provides only that the Director may require a disclaimer of an unregistrable component of a mark and that an applicant may voluntarily disclaim a component of a mark. Thus, a claim under Section 6(a) is one that a mark is unregistrable without a disclaimer of an allegedly unregistrable component of the mark at issue. *See, e.g., Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1548-49 (TTAB 1990).

Applicant has already disclaimed all of the wording in the involved mark and therefore may not also disclaim the design element of that mark. So disclaiming would result in an impermissible disclaimer of the entire mark. *See* TMEP § 1213.06 (April 2014). Moreover, Opposer has merely alleged that the involved mark is "insufficiently distinctive" and not provided fair notice of a specific ground for alleging that the mark in its entirety is not distinctive, e.g., that the mark, when considered in its entirety, is merely descriptive

under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).<sup>3</sup> *See Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100, 1107-08 (TTAB 1997). Based on the foregoing, Opposer's Section 6(a) claim fails to state a valid basis for refusing registration of the involved mark.

In Opposer's fraud claim, Opposer alleges that Applicant committed fraud because, on the same day that it submitted a response to an Office Action wherein it included a disclaimer of the exclusive right to use the wording COPPER WEAR apart from the mark as shown, Applicant sent Opposer a cease and desist letter in which it claimed trademark rights in that wording. Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact in a filing in support of an application to register, or in a post-registration filing, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

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<sup>3</sup> A design is merely descriptive under Trademark Act Section 2(e)(1) where it consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services. *See In re Soc'y for Private & Commercial Earth Stations*, 226 USPQ 436 (TTAB 1985). In addition, common geometric shapes and background designs that are not sufficiently distinctive to create a commercial impression separate from the word and/or design marks with which they are used, are not regarded as indicators of origin absent evidence of distinctiveness of the design alone. *See Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2014 (TTAB 2013); *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998); TMEP § 1202.11.

In this case, the disclaimer upon which Opposer relies is material, but is not a false statement that gives rise to a fraud claim. Notwithstanding the cease and desist letter that Applicant sent on the same day that it filed the Office Action response at issue, Applicant made the disclaimer, as required by the examining attorney, of any exclusive right to use the wording COPPER WEAR apart from the mark as shown. By so disclaiming, Applicant conceded the mere descriptiveness of such wording. *See In re Page*, 51 USPQ2d 1660, 1663 (TTAB 1999); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012 (TTAB 1988). Rather, any false statement regarding the extent of Applicant's rights in that wording, notwithstanding such disclaimer, would have been made in the cease and desist letter, which was not at issue in *ex parte* examination of the involved application and thus cannot be the basis of a fraud claim.

Further, the copy of the cease and desist letter that Opposer submitted as an exhibit to the notice of opposition indicates that Applicant relies upon its common law rights in the wording COPPER WEAR in addition to its involved application in support of that letter. Under Trademark Act Section 6(b), 15 U.S.C. § 1056(b), the disclaimer does not prejudice or affect Applicant's rights then existing or thereafter arising in the disclaimed matter, or its right of registration on another application if the disclaimed matter is or has become distinctive of its identified goods. Based on the foregoing, Opposer's fraud

claim is insufficient. Because neither of Opposer's pleaded claims are sufficient, the Board finds that Opposer has failed to state a claim upon which relief can be granted.

In view thereof, the motion to dismiss for failure to state a claim is granted. In keeping with Board practice, Opposer is allowed until thirty days from the mailing date set forth in this order to file an amended notice of opposition, failing which the opposition will be dismissed with prejudice. *See* TBMP § 503.03.

If Opposer files an amended notice of opposition, this proceeding will go forward under the following schedule.

Answer Due	10/7/2014
Deadline for Discovery Conference	11/6/2014
Discovery Opens	11/6/2014
Initial Disclosures Due	12/6/2014
Expert Disclosures Due	4/5/2015
Discovery Closes	5/5/2015
Plaintiff's Pretrial Disclosures Due	6/19/2015
Plaintiff's 30-day Trial Period Ends	8/3/2015
Defendant's Pretrial Disclosures Due	8/18/2015
Defendant's 30-day Trial Period Ends	10/2/2015
Plaintiff's Rebuttal Disclosures Due	10/17/2015
Plaintiff's 15-day Rebuttal Period Ends	11/16/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.