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

Proceeding	91216755
Party	Defendant Gardner Denver Thomas, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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<p>Thomas Magnete GmbH,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>Gardner Denver Thomas, Inc.,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91216755</p> <p>Serial No.: 86/014656 Mark: THOMAS</p> <p>Serial No.: 86/014661 Mark: THOMAS & design</p> <p>APPLICANT'S MOTION TO DISMISS UNDER FRCP 12(b)(6) AND TMBP § 503.01</p>
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Applicant's Motion to Dismiss

Thomas Magnete GmbH ("Opposer") has filed a Notice of Opposition against Application Serial Nos. 86/014656 and 86/014661 (the "Applications") filed by Gardner Denver Thomas, Inc. ("Applicant") for Applicant's THOMAS and THOMAS & design trademarks ("Applicant's Marks"). Opposer's Notice of Opposition is deficient, however, and Applicant's THOMAS and THOMAS & design marks have *priority* over any mark upon which Opposer could base its opposition. As a result, Opposer has not, and in fact *cannot*, state a claim upon which relief can be granted. Applicant respectfully requests the Trademark Trial and Appeal Board (the "Board") dismiss the Notice of Opposition in its entirety.

Procedural History

On 13 July 2013, Applicant filed Serial No. 86/014656, THOMAS, and Serial No. 86/014661, THOMAS & design, for use in connection with “*air compressors, vacuum pumps, liquid pumps*” (“Applicant’s Goods”), under Section 1(a) of the Lanham Act based on use in commerce since June 1971 and June 2005, respectively. In these filings, Applicant also claimed ownership of its prior registrations, namely, Registration Nos. 0967464, 0970500, and 1792370. The Applications were published for opposition on 10 December 2013.

On 9 June 2014, Opposer filed a Notice of Opposition to the Applications citing, in the ESTTA online form, the following grounds for opposition: 1) Deceptiveness under Section 2(a) of the Lanham Act, 2) False suggestion of a connection under Section 2(a) of the Lanham Act, 3) Priority and likelihood of confusion under Section 2(d) of the Lanham Act, and 4) Dilution under Section 43(c) of the Lanham Act. In its supporting Notice of Opposition, however, Opposer only pleaded false suggestion of a connection under Section 2(a) of the Lanham Act and priority and likelihood of confusion under Section 2(d) of the Lanham Act. Opposer neglected to make substantive allegations of deceptiveness under Section 2(a) of the Lanham Act and dilution under Section 43(c) of the Lanham Act.

As the basis for its grounds for opposition, Opposer cited Reg. No. 3547095, THOMAS, and Reg. No. 3543842, THOMAS DRIVEN BY MAGNETICS (“Opposer’s

Registrations”) both with filing dates of October 30, 2007.¹ Because Opposer’s Registrations were filed under Section 66(a) of the Lanham Act, the dates of first use in the United States are not listed on the registrations. Indeed, in an application based on Section 66(a) of the Act, actual use need not be demonstrated prior to issuance of a registration. *See*, 15 U.S.C. § 1141f(a). Opposer has not pleaded any use whatsoever in U.S. commerce of any of the marks set forth in the drawing pages of Opposer’s Registrations (“Opposer’s Marks”), and specifically Opposer has not pleaded use of Opposer’s Marks prior to the filing dates of Opposer’s Registrations.

ARGUMENT

Opposer’s Notice of Opposition should be dismissed in its entirety because it fails to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6) and TBMP § 503.01. In its Notice of Opposition, Opposer has failed to demonstrate standing necessary to oppose the Applications because it has not properly make its registrations of record. Even if Opposer had properly pleaded its registrations, Opposer would still not have standing to oppose Applicant’s Marks because Applicant has priority.

I. Standard of Proof Under Rule 12(b)(6).

Fed. R. Civ. P. 8 and TMBP § 309.03 only require a notice of opposition to contain “1) a short and plain statement of the reason(s) why oppose believes it would be

¹ Despite no discernible similarity to Applicant’s Marks, Opposer also cited Reg. No. 3543838, DRIVEN BY MAGNETICS and Reg. No. 3547094, Stylized Stripes Design, in its Notice of Opposition. Opposer has not alleged, nor can it allege (much less prove), in what sense either of these marks is similar in sound, connotation, or appearance to Applicant’s THOMAS and THOMAS & design marks. Nevertheless, for the sake of convenience only (and without conceding that either mark is relevant to the instant proceeding), Applicant includes both Reg. Nos. 3543838 and 3547094 in its reference to the defined term, “Opposer’s Registrations.”

damaged by the registration of the opposed marks, and 2) a short plain statement of one or more ground(s) for opposition.” TMBP § 309.03(a)(2). A notice of opposition must include enough detail to give the applicant fair notice of the basis for each claim. TMBP § 309.03(a)(2); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007), *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1562 (TTAB 2011). Conclusory allegations and unsupported factual averments are not enough to support an opposer’s notice of opposition. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985). To survive a challenge under Rule 12(b)(6) and TBMP § 503.01, a pleading must allege such facts that if proved, would establish that the plaintiff has standing to maintain the proceeding and that there exists a valid ground existing to deny the registration being sought. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Under Fed. R. Civ. P. 12(b)(6), dismissal is warranted where “it appears beyond doubt that plaintiff can prove no set of facts which would entitle him to relief.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed Cir. 1988); see also, *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 566, 189 USPQ 420, 422 (CCPA 1976). Under 12(b)(6), a court takes as true the factual allegations of the complaint and construes them in the light most favorable to the plaintiff. *Advanced Cardiovascular Systems Inc., v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 1160-1161 26 USPQ2d 1038 (Fed Cir. 1993); see also *Jenkins v. McKeithen*, 395 U.S. 411, 421 (1969).

Dismissal is proper in the absence of a cognizable legal theory or sufficient facts alleged to support a cognizable legal theory. *Navarro v. Block*, 250 F.3d 729, 732 (9th Cir.

2001). In deciding whether to grant dismissal, a court or tribunal applying the federal standards under a 12(b)(6) motion may consider the complaint and any attached exhibits incorporated therein. *Scognamillo v. Credit Suisse First Boston LLC*, 2005 U.S. Dist. LEXIS 7162, at *7; see also *Lee v. City of Los Angeles*, 250 F.3d 668, 688 (9th Cir. 2001). The court may also rely on “[a] document external to the complaint if the complaint ‘necessarily relies’ on the document and no party contests the document’s authenticity.” *Scognamillo*, at *7; see also *Parrino v. FHP, Inc.*, 146 F.3d 699, 706 (9th Cir. 1998).

II. Opposer Lacks Standing.

A. Opposer has not Made Its Registrations of Record.

In order to oppose an applicant’s registration, an opposer must first establish standing to oppose the pending application. An opposer establishes standing by alleging “facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis’ for its belief that it would suffer some kind of damage if the mark is registered.” TMBP § 309.03(b). Although an opposer may establish standing in any number of ways, in the present case, Opposer has relied solely on its purported ownership of several registrations to establish its standing to oppose.

That Opposer is relying on its registrations, *per se*, rather than actual use of its marks is plain from the allegations contained within its Notice of Opposition. In that Notice of Opposition, Opposer alleges that it “is the owner of U.S. Trademark Registration No. 3547095...3543842...3543838...[and] 3547094,” but it fails to allege that it has used any of these marks in interstate commerce. To be clear, in Paragraph 1 (of 2)

of its Notice of Opposition, Opposer makes general reference to the text of 15 U.S.C. § 1052(d), stating that “Defendant’s marks so resemble one or more marks registered by Opposer as well as marks and trade names previously used in the United States by Opposer and not abandoned as to be likely, when used on or in connection with the goods or services of Defendant, to cause confusion, or to cause mistake, or to deceive.” However, it is unclear to what Opposer is referring when it identifies “marks and trade names previously used in the United States,” because nothing in the remaining body of its pleading attempts to identify what marks have been used. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007) (standing established based on prior use). Without more, one cannot conclude that Opposer’s Registrations are the marks that have been used because all four of those registrations are § 66(a) registrations with no accompanying allegation of use. To assume these are the marks to which Opposer is referring would be inequitable and prejudicial to Applicant because it would be left to “guess” as to the relevant dates of first use in order to analyze the issue of priority.

It is clear, then, that Opposer is relying on its registrations to establish standing in this proceeding. When an opposer relies merely on its registrations for standing, the opposer must establish a real interest in the opposition by making its registrations of record and pleading the existence of its current ownership of a valid and subsisting registrations. TMBP § 309.03(b). In order for an opposer’s registrations to be made of record, the opposer must attach status and title copies of its registrations to its notice of

opposition. *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1315 (TTAB 2005) citing *Lipton Industries*, 670 F.2d 1024, 213 USPQ 185.

In the present case, opposer has not made any of its registrations of record because it has not attached the status and title copies of its registrations to the Notice of Opposition. Instead, Opposer has merely cited to the registration numbers, mark descriptions, registration dates, and International Classification for four registrations. It is unclear even, from the face of Opposer's pleading, whether it owns these four registrations at all. Opposer has therefore failed to plead the existence of valid and subsisting registrations. As a result, Opposer has failed to demonstrate its standing to oppose Applicant's Marks, and the Board should dismiss Opposer's Notice of Opposition.

B. Opposer Does Not Have Priority of Use.

Even assuming Opposer had sufficiently pleaded the existence of valid and subsisting registrations for Opposer's Registrations, Opposer would still lack the standing necessary to oppose the Applications because Opposer has not pleaded, and cannot plead, priority of use. In order to properly assert priority, an opposer must allege facts showing proprietary rights in its pleaded mark that are prior to applicant's rights in the challenged mark. TMBP § 309.03(c)A. The four marks identified by Opposer in the Notice of Opposition were all registered under Section 66(a) based on Opposer's foreign trademark registrations. As such, these registrations do not include the dates of first use for these marks in the United States. In the absence dates of first use, Opposer must rely upon the filing dates of its registrations based on Section 66(a).

Aktieselskabet af 21 November 2001 v. Fame Jeans, Inc., 77 USPQ2d 1861, 1864 (TTAB 2006), *motion granted*, 511 F.Supp.2d 1 (D.D.C. 2007), *aff'd in part and rev'd in part*, 525 F.3d 8, 86 USPQ2d 1527 (D.C. Cir. 2008).

Here, the filing dates of the Section 66(a) registrations identified in the Notice of Opposition are all 30 October 2007. As a result, had Opposer made its registrations of record, the earliest priority date Opposer could have only relied upon was 30 October 2007 without alleging earlier, common law use. However, as alleged in its Applications, Applicant has continuously used its THOMAS and THOMAS (stylized) trademarks in connection with the Described Goods since June 1971 and June 2005 respectively. Both of these dates are senior to Opposer's priority date. Because Applicant's use of Applicant's Marks predates Opposer's priority date, Opposer does not have standing to Oppose the Applications. Therefore, Opposer's Opposition should be dismissed.

III. Opposer has not Sufficiently Pleaded its Grounds for Opposition.

A. Opposer Failed to Adequately Plead Two of its Four Grounds for Opposition.

In its Notice of Opposition, Opposer pleaded the following grounds for opposition:

- 1) *Deceptiveness under Section 2(a) of the Lanham Act,*
- 2) *False suggestion of a connection under Section 2(a) of the Lanham Act,*
- 3) *Priority and likelihood of confusion under Section 2(d) of the Lanham Act, and*
- 4) *Dilution under Section 43(c) of the Lanham Act.*

Although Opposer ticked the boxes in the ETTSA form for all four of these grounds, Opposer failed to substantively plead grounds 1 and 4 (deceptiveness and dilution). The mere statement of a ground for opposition and a citation to a particular code section is not sufficient to give the applicant fair notice of the basis for each claim, an opposer must plead all the required elements of each ground for opposition. TMBP 309.03(c); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000). Because Opposer has not pleaded any element of either Deceptiveness under Section 2(a) or Dilution under Section 43(c), these grounds for opposition should be dismissed.

B. Opposer Has Not Pleaded the Priority of Use Necessary to Sustain Its Remaining Grounds for Opposition.

In order to successfully oppose a registration on the grounds of either false suggestion of a connection under Section 2(a) of the Lanham Act or priority and likelihood of confusion under Section 2(d) of the Lanham Act, an opposer must be the prior user of that mark. See *In Re Nuclear Research Corp.*, 16 U.S.P.Q.2d 1316 at *3-4 (T.T.A.B. 1990) (Stating that an opposition based on false suggestion of a connection under Section 2(a) of the Lanham Act “necessarily requires by implication that the person or institution with whom a connection is suggested must be the prior user”); *Otto Roth & Co. v. Universal Food Corp.*, 540 F.2d 1317, 1320, 209 USPQ 40, 48 (CCPA

1981). As previously stated, Opposer has not established, and cannot establish, priority in this case, as it has not made of record status copies of its registrations, and even assuming it had done so, it can only rely on a priority date - 30 October 2007 - which is junior to Applicant's dates of first use of Applicant's Marks. Accordingly, the Notice of Opposition should be dismissed in its entirety.

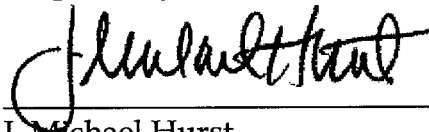
C. Opposer has not Requested Relief.

Under Fed. R. Civ. P. 8(c)(2), a notice of opposition must contain "a demand for the relief sought." There is nary a trace of such demand anywhere in the Notice of Opposition. As a result, the Notice of Opposition is facially defective and should be dismissed.

CONCLUSION

For the aforementioned reasons, Applicant respectfully requests that the Board dismiss the Notice of Opposition in its entirety for failure to state a claim upon which relief can be granted.

Respectfully submitted,



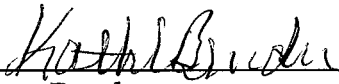
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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing Applicant's Motion to Dismiss was served by first class mail, postage prepaid, on 21 July 2014, upon counsel for Opposer:

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