

ESTTA Tracking number: **ESTTA802657**

Filing date: **02/21/2017**

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

Proceeding	91224462
Party	Defendant Genomma Lab Internacional, S.A.B. de C.V.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	02/21/2017
Attachments	Motions to Dismiss and Suspend -- Opp No 91224462 -- DIABETTX and Design.pdf(122837 bytes )

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

**FNC MEDICAL CORPORATION,**

Opposer,

v.

**GENOMMA LAB INTERNACIONAL,  
S.A.B. de C.V.**

Applicant.

Opp. No.: 91224462

Mark: **DIABETTX  
(& Design)**

Serial No.: 86521466

**APPLICANT’S MOTIONS TO DISMISS  
AND TO SUSPEND PROCEEDINGS**

**MOTIONS**

Applicant Genomma Lab Internacional, S.A.B. de C.V. (“Applicant”) hereby moves, pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, to dismiss the Notice of Opposition by FNC Medical Corporation (“Opposer”) for failure to state a claim.

In that Applicant’s motion may be dispositive of this proceeding, Applicant also moves that this proceeding be suspended pending consideration of its motion to dismiss.

## MEMORANDUM OF LAW IN SUPPORT OF MOTION TO DISMISS

### **I. INTRODUCTION**

Opposer's Notice of Opposition ("NOO") consists of (1) a recitation of Opposer's alleged rights; (2) a claim of priority; (3) conclusory allegations of a likelihood of confusion and dilution; (4) a conclusory allegation of "grave" damage; and (5) a prayer for relief. The sum of these contents do not add up to a cognizable claim for relief.

With respect to confusion, the NOO is devoid of any allegation (or facts supporting such allegation) that Applicant's and Opposer's goods are related, only that the marks resemble each other. A claim based solely on the resemblance of the marks is one element of a claim for dilution, not confusion. Scores of identical marks coexist on the Principal Register without confusion. In the absence of any allegation with respect to a relatedness between the respective goods of Applicant and Opposer (which fall into different Classes), Opposer's conclusory claim of confusion must fail.

As to Opposer's claim of dilution, Opposer fails to allege that its mark became famous prior to the filing of the subject application, or, for that matter, that it ever became famous at all. Such omissions are fatal to Opposer's dilution claim.

In the absence of a cognizable claim for relief, the Board should dismiss Opposer's opposition.

### **II. MOTION TO DISMISS STANDARD**

For purposes of a motion to dismiss, all factual allegations must be accepted as true. A pleaded claim survives if the complaint contains 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, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). The Board should not merely

accept legal conclusions as true. *Ashcroft*, 556 U.S. at 678 (“the tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions”). Moreover, “only a complaint that states a plausible claim for relief survives a motion to dismiss.” *Id.*, at 679. In assessing plausibility, the Board should “draw on its judicial experience and common sense,” and reject claims that stop “short of the line.” *Id.*, at 678-79.

### **III. ARGUMENT**

#### **A. OPPOSER HAS FAILED TO STATE A CLAIM FOR TRADEMARK DILUTION**

To state a claim for federal trademark dilution, a claimant must show: (1) that it owns a famous mark that is distinctive; (2) that applicant is using or intends to use a mark in commerce that allegedly dilutes the claimant’s famous mark; (3) that applicant’s use of the mark began, or its intent-to-use application was filed after, claimant’s mark became famous; and (4) the applicant’s use or intended use of its mark is likely to cause dilution by blurring or by tarnishment. *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 U.S.P.Q.2d 1289 (TTAB 2016); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, (TTAB 2001). Opposer’s dilution claim must be dismissed because the claim fails, at a minimum, to satisfy the first, third and fourth elements.

Trademark dilution is “a cause of action reserved for a select class of marks.” *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1011 (9th Cir. 2004). The Trademark Dilution Revision Act expressly defines what degree of fame is required to support a claim for dilution:

For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following: “(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. “(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. “(iii) The extent of actual recognition of

the mark. (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. § 1125(c)(2)(A). “Very few” trademarks meet this “rigorous standard.” *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012) (quoting *Everest Capital, Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 763 (8th Cir. 2005) (“The judicial consensus is that ‘famous’ is a rigorous standard.”)) (also quoting 4 McCarthy, § 24:104 at 24-286, 24-293 (noting that fame for dilution is “a difficult and demanding requirement” and that very few [marks] are ‘famous’)).

A famous mark, in this context, must be a “household” name, like APPLE or COKE. *Nissan*, 378 F.3d at 1012. Its use must eclipse “the common or proper noun uses of the term or third-party uses of the mark,” such that in almost any context, the general public at least initially associates the mark with the mark’s owner. *Coach Services*, 668 F.3d at 1373 (quoting *Toro*, 61 U.S.P.Q.2d at 1180). Opposer’s allegations are not sufficient to elevate DIABET-X to this rarified group of marks.

Indeed, Opposer fails to allege even that its mark is famous. The words “fame” and “famous” are entirely absent from the NOO.

Opposer *does* allege that “Applicant’s use and registration of Applicant’s Mark causes, and will cause, dilution of the distinctive quality of Opposer’s Marks under Section 43(c) of the Trademark Act to the damage and injury of Opposer,” Not. ¶ 9, but the conclusory assertion lacks any factual underpinning. *See Ashcroft*, 556 U.S. at 678 (“Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” to state a claim for relief).

Opposer failed to allege that its mark is famous, that it became famous before Applicant's filing date, or any facts related to how Applicant's use will cause dilution by blurring or tarnishment. Accordingly, Opposer's claim for dilution should be dismissed.

**B. OPPOSER HAS FAILED TO STATE A CLAIM FOR LIKELIHOOD OF CONFUSION**

Federal dilution, as discussed above, requires the existence of a famous mark. An opposer's mark and an applicant's mark may be identical, but if the prior is not famous, there is no cause of action for dilution. Similarly, confusion requires relatedness between the respective goods and services. Opposer alleges that the marks resemble one another, but the complaint is devoid of any allegation that the respective goods are related. In the absence of such allegation, there is no cognizable claim for a likelihood of confusion, especially here, where the goods of the parties fall into two different Classes of the Nice Classification system (Classes 3 and 5).

To state a claim for a likelihood of confusion, an opposer must allege that an applicant's mark "so resembles" opposer's mark "as to be likely, *when used on or in connection with the goods of the applicant*, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. §1052(d) (emphasis added). Opposer's complaint lacks any such allegation. It recites Applicant's goods (Not. at 1), and recites the goods with which Opposer's mark is used and for which it is registered (Not. ¶¶1, 3-4), but it draws no comparison between the two. Mere recitation of the respective goods and services is insufficient, especially where, as here, those goods are in two different Classes and therefore are not, and could not be, identical. *See Ashcroft*, 556 U.S. at 678 (well-pleaded facts that "permit the court to infer the mere possibility" of a legal conclusion are insufficient; complainant must "show" that it is entitled to relief) (quoting FRCP 8(a)(2)). Opposer was required by the rules of pleading to indicate in the NOO a reasonable basis as to why use of Applicant's mark on or in connection with its goods would cause confusion, mistake, or deception.

Indeed the only comparison Opposer actually draws between *any* aspect of the Application and Opposer's prior use and registrations comes in Opposer's conclusory allegation of confusion:

In view of the similar nature of Opposer's Mark and Applicant's Mark, Opposer alleges that Applicant's Mark so resembles Opposer's Mark as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Trademark Act.

Not. ¶8. As stated above, “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” to state a claim for relief. *Ashcroft*, 556 U.S. at 678. Moreover, the “similar nature” of the marks cannot alone support a claim for likelihood of confusion. If it could, there would be no identical marks on the Principal Register and no federal dilution law. Yet, identical marks abound. *Compare, e.g.*, Reg. No. 4,116,340, for DIABET-X, and Opposer's registrations for DIABET-X, (Reg. Nos. 2,470,802 and 2,610,009).

Of course, *dissimilarity* of marks alone can suffice to rule out any possibility of confusion – *see Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (affirming dismissal of opposition based on dissimilarity of marks) – because resemblance between the marks is a necessary element of any confusion claim. So too is a relatedness between the respective goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1102-03 (C.C.P.A. 1976) (“The fundamental inquiry mandated by s 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see In Re G.H.L. Int'l, Inc.*, Serial No.77886169, 2012 WL 5196141, at \*4 (TTAB Sept. 25, 2012) (quoting *Federated Foods* “fundamental inquiry” language and finding sufficient distinction between pet water fountains and water filtration units for domestic use so as to permit registration of a similar mark); *In Re Houston Shutters, LLC*, Serial No. 78896946, 2008 WL 4877063, at \*3 (TTAB Oct. 30, 2008) (“meager evidence” insufficient to show similarity between window coverings and furniture) (“In any likelihood of confusion

analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services”); *In Re Trinidad Benham Corp.*, Serial No. 78446099, 2007 WL 1676775, at \*7-\*9 (TTAB May 21, 2007) (quoting *Federated Foods* “fundamental inquiry” language and finding that subject goods are sufficiently different to warrant registration, despite similar marks and channels of trade); *In Re Consulting Servs. Int'l Inc.*, Serial No. 76376622, 2003 WL 22321035, at \*2 (TTAB Oct. 3, 2003) (quoting *Federated Foods* “fundamental inquiry” language and holding that “[m]ere argument and conclusory assertions do not suffice” to show requisite relatedness of goods or services). Opposer’s failure to allege any relation at all between its goods and those of Applicant is therefore fatal to its claim of a likelihood of confusion.

#### **IV. CONCLUSION**

For the foregoing reasons, the instant opposition should be dismissed for failure to state a claim upon which relief can be granted. Moreover, the proceeding should be suspended pending consideration of Applicant’s motion to dismiss, and the deadlines for the answer, initial discovery conference, discovery and trial periods reset accordingly.

Respectfully submitted,

**GENOMMA LAB INTERNACIONAL,  
S.A.B. DE C.V.**

By:           s/Daniel C. Neustadt          

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Date: February 21, 2017

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**CERTIFICATE OF SERVICE**

The undersigned certifies that a true copy of the foregoing **MOTIONS TO DISMISS AND TO SUSPEND PROCEEDINGS** was sent by first class mail, postage pre-paid, and via email, to counsel for Opposer:

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on this 21st day of February, 2017.

/Daniel C. Neustadt/

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