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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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Attachments	Motions to Dismiss Amended Notice and Suspend -- Opp No 91224462 -- DIA-BETTX.pdf(29337 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 trademark dilution claim set forth in the Amended Notice of Opposition by FNC Medical Corporation ("Opposer") for failure to state a claim.

In that the Board's determination of Applicant's motion will affect the scope of discovery in 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

In its original pleading, Opposer asserted a claim for trademark dilution, but failed to allege that is mark was famous. Applicant moved to dismiss the dilution claim, observing that "Opposer fails to allege that its mark became famous prior to the filing of the subject application (the "Application"), or, for that matter, that it ever became famous at all." In its amended pleading (the "Amended Notice"), Opposer has corrected the latter defect but not the former. The omission is fatal to Opposer's dilution claim, and the claim should therefore be dismissed.

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 allege: (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 and third elements.

1. Opposer Fails to Allege That Its Mark Achieved Fame Prior to the Filing Date of the Application

Opposer's burden, in pleading a dilution claim against an intent-to-use application, is to allege that its mark became famous prior to the filing date of the subject application. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1174 ("We hold that in the case of an intent-to-use application, an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding."); *see also Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1050 (Fed. Cir. 2012)*; Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1294-5 (TTAB 2016)*; Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2024 (TTAB 2014). Because the Amended Notice is devoid of any such allegation, the dilution claim must be dismissed.

With respect to fame, Opposer alleges that it has used its mark extensively on personal care products and on the internet since at least as early as 1997, and "[a]s such, Opposer's 20 years use of its Mark has become a famous identifier of Opposer's goods." Amended Not. ¶ 3. Opposer fails, however, to allege – even in general terms – *when* its Mark became "a famous identifier," and specifically fails to allege that fame was acquired before the filing date of the Application.

The omission is striking because Opposer sufficiently alleges priority with respect to its confusion claim. *See* Amended Not. ¶ 9 ("Opposer's 1997 dates of first use and the application filing dates

of its above referenced registrations ***precede the filing date of Applicant's Application.***"); Amended Not. ¶ 4 ("Through Opposer's continuous and extensive use of Opposer's DIABET-X mark for 20 years, Opposer has developed strong common law rights in Opposer's Mark. ***These rights pre-date Applicant's filing date of the Application***.") (emphases added). The absence of any analogous claim with respect to when Applicant's mark became famous is fatal to Opposer's dilution claim.

2. Opposer Fails to Allege That Its Mark Is Famous, As The Term Is Defined Under The Trademark Dilution Revision Act

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 amended allegations are not sufficient to elevate DIABET-X to this rarified group of marks.

In its original pleading, Opposer failed to allege even that its mark is famous. The words "fame" and "famous" were entirely absent from the Notice of Opposition. Opposer's Amended Notice adds those words, but the allegations, accepted as true, still fall well short of asserting the level of fame that federal trademark dilution law requires.

To support of its claim that DIABET-X is essentially a household name, Opposer alleges that the mark has been used extensively for twenty years on "personal care products, including creams, lotions body washes and shampoos and on the internet." Amended Not. ¶ 3. Opposer further alleges that it has "strong common law rights," *Id.*, ¶ 4, and that "Opposer and its products for diabetics have an excellent and highly regarded reputation in the OTC [over the counter] industry." Of course, fame in a particular industry – or "niche fame" – is widely recognized as insufficient to support a claim for dilution under the Trademark Dilution Revision Act ("TDRA"). While its predecessor, the Federal Trademark Dilution Act, provided for such fame, the TDRA amended federal dilution law to expressly provide that only marks "widely recognized by the general consuming public of the United States" qualify for federal protection against dilution. "[N]iche fame is not sufficient." *Maker's Mark Distillery v. Diageo N. Am.*, 703 F.Supp.2d 671, 699 (W.D. Ky. 2010).

Twenty-years' use on personal care products aimed at a particular segment of the population – *i.e.*, diabetics – cannot give rise to the immense, widespread fame required to support a federal dilution claim. For this reason too, Opposer's dilution claim should be dismissed.

IV. CONCLUSION

For the foregoing reasons, Opposer's dilution claim 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.

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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 19th day of April, 2017.

/Daniel C. Neustadt/

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