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

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| Proceeding | 91224462 |
| Party | Plaintiff FNC Medical Corporation |
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**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.

Opposition No. 91224462



Mark:

Serial No. 86/521,466

RESPONSE TO APPLICANT'S MOTION TO DISMISS

On April 19, 2017, Applicant filed a motion to dismiss Opposer FNC Medical Corporation's Amended Notice of Opposition pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503. Pursuant to 37 C.F.R. § 2.127 and TBMP § 503, Opposer responds to Applicant's Motion to Dismiss and respectfully requests that the Trademark Trial and Appeal Board (the "Board") deny Applicant's Motion to Dismiss.

I. Legal Standard

"To survive a motion to dismiss, 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, 678 (2009). Specifically, in the context of an opposition, to withstand a motion to dismiss, "plaintiff need only allege sufficient factual matter that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark."

Nike, Inc. v. Palm Beach Crossfit, Inc., 2015 TTAB LEXIS 314, *6, 116 U.S.P.Q.2D 1025, 1028-1029 (T.T.A.B. Sept. 11, 2015); T.B.M.P. § 503.02. This standard is satisfied when opposer alleges enough factual matter to suggest its claim is plausible and raises a right to relief above the speculative level. *Corporacion Habanos, S.A. v. Rodriguez*, 2011 TTAB LEXIS 258, *3, 99 U.S.P.Q.2D 1873, 1874 (T.T.A.B. Aug. 1, 2011) (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949, 173 L. Ed. 2d 868 (2009)). In addressing a motion to dismiss for failure to state a claim, all of the petitioner’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the petitioner. *Id.*

a. The Notice of Opposition Sufficiently Pleads Opposer’s Standing

To satisfy standing, Opposer need only plead sufficient facts to show a real interest and a “reasonable basis” for its belief that it would suffer damages if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The standard for determining standing before the Board is § 13 of the Lanham Act, which provides:


Any person who believes that he would be damaged by the registration of a mark upon the principal register [...] may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office. . .

15 U.S.C. § 1063. Accordingly, “[s]tanding requires only that the petitioner have a ‘real interest’ in the cancellation [or opposition] proceeding.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161 (Fed. Cir. 2002).

Applicant does not dispute that the Amended Notice of Opposition meets this standard. Opposer’s federal registrations for its DIABET-X mark are *prima facie* evidence of Opposer’s exclusive right to use the mark in commerce in connection with the goods identified in the registration. Lanham Act §33(a), 33(b), 15 U.S.C.A. §§1115a, 1115b. Moreover, Opposer’s Amended Notice of Opposition alleges that Opposer has used its DIABET-X mark on personal

care products, including “creams, lotions, body washes and shampoos” since at least as early as 1997, for 20 years. Amended Notice of Opposition at 2. The Amended Notice of Opposition



alleges that the Applicant seeks registration for the mark  for “body creams and lotions.” Amended Notice of Opposition at 1. Opposer’s Amended Notice of Opposition alleges that Opposer’s mark and Applicant’s mark are similar. Amended Notice of Opposition at 3-5. Thus, Opposer reasonably alleges that Applicant’s registration of a similar mark is likely to cause confusion, and cause dilution of Opposer’s mark. *See Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q. 2d 1066, 2011 WL 810221, at *6 (T.T.A.B. Feb. 25, 2011) (holding opposer established its standing in the proceeding through its pleaded registrations, for several marks that include a term also included in applicant’s mark). Accordingly, Opposer’s Notice of Opposition properly alleges that Opposer has a real interest in this proceeding, and therefore, Opposer has standing to bring this Opposition.

b. The Notice of Opposition Sufficiently Pleads a Claim for Dilution

To plead dilution Opposer must allege that 1) Opposer owns a famous mark; 2) the Applicant is using a mark in commerce that allegedly dilutes Opposer’s famous mark; 3) the Applicant’s use of its mark began after Opposer’s mark became famous; and 4) the Applicant’s use of its mark is likely to cause dilution. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723–24 (Fed. Cir. 2012). Applicant contends that Opposer has failed to allege that Opposer’s mark achieved fame prior to the filing date of the Application. Motion to Dismiss at 4. However, Opposer submits that Opposer’s Amended Notice of Opposition sufficiently pleads facts to support a claim of dilution at the pleading stage.

Opposer's Amended Notice of Opposition alleges that Opposer is the owner of two incontestable registrations for the mark DIABET-X, that Opposer has used the mark since at least as early as 1997 – for 20 years – and that through substantial advertising, promotion, and sales, Opposer's mark has acquired extensive goodwill and consumer recognition prior to the filing of Applicant's Application, and that Applicant's use is likely to cause dilution. Amended Notice of Opposition at 2-5. Through Opposer's allegations of long standing - 20 years - and widespread use that predates Applicant's Application, and the extensive consumer recognition of Opposer's mark, Opposer's Amended Notice of Opposition sufficiently alleges the fame of Opposer's mark that is necessary at the pleading stage. Furthermore, because this extended use and consumer recognition predates Applicant's Application, Opposer sufficiently alleges that Opposer's mark acquired fame prior to the date – February 2, 2015 – of Applicant's filing of its Application.

Applicant contends that very few trademarks meet the “rigorous standard” of fame. Motion to Dismiss at 4. However, Opposer does not need to prove its claim at the notice stage, but only allege facts sufficient to state said claim, and therefore Applicant's Motion should be denied. *See* T.B.M.P. § 503.02 (“Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at a final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.”).

The pleading is only required to include enough detail to give the defendant fair notice of the basis for each claim. *See Nike, Inc. v. Palm Beach Crossfit, Inc.*, 2015 TTAB LEXIS 314 at *10; T.B.M.P. § 309.03(a)(2). Opposer's Amended Notice of Opposition provides fair notice to Applicant regarding its claim of dilution. Opposer's Amended Notice of Opposition alleges all

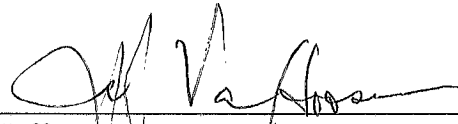
four (4) elements to state a claim for dilution. Applicant argues in its Motion to Dismiss that Opposer's mark does not meet the requirements of fame for dilution, and that Opposer has not shown that its mark became famous before Applicant began using its mark, however these arguments do not warrant dismissal. While Opposer understands the burden of proof as to the fame of its mark ultimately rests on Opposer, whether Opposer is able to prove its allegations is not a matter for determination on a motion to dismiss. *See Nike, Inc. v. Palm Beach Crossfit, Inc.*, 2015 TTAB LEXIS 314 at *12 (noting that whether Opposer is able to prove its allegations is not a matter for determination on a motion to dismiss).

II. Conclusion

Accordingly, Opposer's Amended Notice of Opposition sufficiently states a claim upon which the requested relief could be granted. Therefore, Opposer respectfully requests that Applicant's Motion to Dismiss Opposer's dilution claim be denied.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 8, 2017

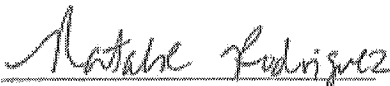
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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **RESPONSE TO APPLICANT'S MOTION TO DISMISS** upon Applicant's counsel via electronic mail on May 8, 2017, addressed as follows:

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