UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JK

Mailed: August 28, 2017

Opposition No. 91224462

FNC Medical Corporation

v.

Genomma Lab Internacional, S.A.B. de C.V.

By the Board:

This opposition proceeding is before the Board for consideration of Applicant's April 19, 2017 motion to dismiss for failure to state a claim upon which relief may be granted, pursuant to Fed. R. Civ. P. 12(b)(6).[1] The motion is fully briefed.

Background

On February 2, 2015, Applicant filed application Serial No. 86521466 to register the mark DIABETTX and design (shown below), based on Trademark Act Section 1(b), for "body creams and lotions" in International Class 3.

[1] Fed. R. Civ. P. 12(b)(6) is made applicable to Board *inter partes* proceedings by Trademark Rule 2.116(a).

In its operative pleading[2] Opposer opposes registration on the grounds of 1) likelihood of confusion, and 2) dilution. It pleads ownership of two incontestable registrations for the mark DIABET-X:

1) Registration No. 2470802, registered July 24, 2001, for "anti-microbial body cream for diabetic patients; anti-fungal cream for diabetic patients" in International Class 5; and

2) Registration No. 2610009, registered August 20, 2002, for "medicated personal hygiene and health care products for diabetic patients, namely, hand cream, shampoo, hair rinse, hair conditioners, and body wash" in International Class 5.

In lieu of filing an answer, Applicant moved to dismiss the dilution claim for failure to state a claim upon which relief may be granted.

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. TBMP § 503.02 (June 2017), and cases cited therein. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proven, establish that 1) the plaintiff has standing to maintain the proceeding, and 2) a valid ground exists for opposing or cancelling the mark. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). TBMP § 503.02. Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is

[2] 20 TTABVUE.
Throughout this proceeding, when referring to the record, the parties should reference filings and evidence by citation to the Board's TTABVUE docket by the entry and page number, *e.g.*, 20 TTABVUE 10. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

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).

Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038,1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2014).

Applicant does not challenge Opposer's standing. Standing is a threshold issue that must be alleged in every *inter partes* proceeding. *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Thus, for completeness, the Board notes that Opposer has sufficiently set forth allegations which, if proven, would establish its standing to bring this proceeding. Specifically, Opposer alleges, *inter alia*, a claim of likelihood of confusion, pursuant to Trademark Act Section 2(d), that is not wholly without merit and is based upon current ownership of a valid and subsisting registration. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189.

In its motion, Applicant challenges the sufficiency of Opposer's dilution claim. To state a claim of dilution, a plaintiff must sufficiently allege that 1) it owns a mark that is distinctive and famous; 2) its mark became famous before the applicant commenced use of the challenged mark, or in a proceeding opposing an intent-to-use application, that its mark became famous prior to the filing date of the applicant's

subject application; and 3) the applicant's use is likely to cause dilution of or blur the distinctive quality of plaintiff's mark or to lessen the capacity of the mark to identify and distinguish plaintiff's goods and services. *See* Trademark Act Section 43(c); 15 U.S.C. § 1125(c). *See also*, *Coach Svs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012); *Nat'l Pork Board v. Supreme Lobster and Seafood Co.,* 96 USPQ2d 1479, 1494-95 (TTAB 2010); *Toro Co. v. ToroHead Inc.,* 61 USPQ2d 1164 (TTAB 2001); *Polaris Indus. Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

Here, Applicant argues that the amended notice of opposition is devoid of the required allegation that Opposer's mark(s) became famous prior to the filing date of the subject application. It notes that Opposer alleges that it has used its mark extensively on personal care products since at least as early as 1997 and that its mark "has become a famous identifier of Opposer's goods," but argues that Opposer fails to allege, even in general terms, when its mark became "a famous identifier."[3]

Opposer maintains that its allegations of use since 1997 and for twenty years, which use predates Applicant's application, and its related allegation of extensive consumer recognition of its mark, sufficiently assert that its mark acquired fame prior to February 2, 2015, the subject application filing date.[4]

Turning to the amended notice of opposition, the Board notes that Opposer sets forth one allegation wherein it specifically references fame of its mark. That is,

[3] 22 TTABVUE 4.
[4] 23 TTABVUE 5.

Opposer alleges in ¶ 3: "… Opposer's 20 years use of its Mark has become a famous identifier of Opposer's goods."[5]

Opposer sufficiently alleges the first and third required elements of the dilution claim. Regarding the second required element, Opposer essentially relies upon its allegations of priority of use - which it set forth as a required element of its likelihood of confusion claim - to satisfy the pleading requirement for dilution. Opposer cites no authority for its position that such a pleading is sufficient, and no authority for the proposition that the Board will construe an allegation of prior use in such a manner that the allegation equates to a pleading that a mark became famous prior to the application filing date. Although the amended notice of opposition could possibly be construed as circuitously setting forth the required element, Applicant is entitled to fair notice of the basis for the dilution claim. Here, Opposer does not clearly set forth an allegation that its mark became famous prior to the filing date of the subject application. Thus, all required elements are not present, and consequently the pleading of dilution is insufficient.

Based on these findings, Applicant's motion to dismiss the dilution claim is granted.

Leave to Amend Pleading

If the Board finds, upon determination of a motion to dismiss, that the complaint fails to state a claim upon which relief may be granted, in whole or in part, it may exercise its discretion to allow the plaintiff an opportunity to file an amended

[5] 20 TTABVUE 9.

pleading. TBMP § 503.03. Allowing leave to amend is appropriate here. Accordingly, Opposer is allowed until twenty (20) days from the mailing date of this order to file a second amended notice of opposition which addresses the pleading deficiencies noted in this order, failing which the Board will dismiss the dilution claim with prejudice, and this case will proceed with respect to the likelihood of confusion claim only.

If Opposer files a second amended notice of opposition, Applicant is allowed until twenty (20) days from the date of service thereof to file its answer.

Schedule

Proceedings are deemed to have been suspended as of April 19, 2017. *See* Trademark Rule 2.127(d) ("When any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss … the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion."). *See also*, TBMP § 510. In view of the Board's adjudication of Applicant's motion to dismiss, conference, discovery, trial and briefing dates are reset as follows:

Deadline for Required Discovery Conference	11/7/2017
Discovery Opens	11/7/2017
Initial Disclosures Due	12/7/2017
Expert Disclosures Due	4/6/2018
Discovery Closes	5/6/2018
Plaintiff's Pretrial Disclosures Due	6/20/2018
Plaintiff's 30-day Trial Period Ends	8/4/2018
Defendant's Pretrial Disclosures Due	8/19/2018
Defendant's 30-day Trial Period Ends	10/3/2018
Plaintiff's Rebuttal Disclosures Due	10/18/2018
Plaintiff's 15-day Rebuttal Period Ends	11/17/2018

Plaintiff's Opening Brief Due	1/16/2019
Defendant's Brief Due	2/15/2019
Plaintiff's Reply Brief Due	3/2/2019
Request for Oral Hearing (optional) Due	3/12/2019

Generally, the Federal Rules of Evidence, Federal Rules of Civil Procedure and Trademark Rules of Practice apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).