

ESTTA Tracking number: **ESTTA916160**

Filing date: **08/16/2018**

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

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|------------------------|--|
| Proceeding | 91242268 |
| Party | Defendant Boston Scientific Scimed, Inc. |
| Correspondence Address | LUKE DOHMEN Boston Scientific Corporation 1 Scimed PI Maple Grove, MN 55311-1565 trademarks@bsci.com, michelle.anderson@bsci.com no phone number provided |
| Submission | Motion to Dismiss - Rule 12(b) |
| Filer's Name | James R. Steffen |
| Filer's email | james.steffen@faegrebd.com, trademark@faegrebd.com, shanon.jankowski@faegrebd.com |
| Signature | /JRSteffen/ |
| Date | 08/16/2018 |
| Attachments | Motion to Dismiss.pdf(79270 bytes) Memo re Motion to Dismiss.pdf(105962 bytes) |

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

Application Serial No. 86627956
Mark: LOTUS EDGE

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| _____ |) | |
| SAID I. HAKKY, |) | |
| |) | Opposition No. 91242268 |
| Opposer, |) | |
| |) | |
| v. |) | <u>APPLICANT'S MOTION TO</u> |
| |) | <u>DISMISS OPPOSER'S NOTICE</u> |
| BOSTON SCIENTIFIC SCIMED, INC. |) | <u>OF OPPOSITION FOR</u> |
| |) | <u>FAILURE TO STATE A CLAIM</u> |
| Applicant. |) | |
| _____ |) | |

Applicant Boston Scientific Scimed, Inc. hereby moves to dismiss with prejudice the Notice of Opposition filed by Opposer Said I. Hakky for failure to state a claim for which relief can be granted under Fed. R. Civ. P. 12(b)(6). As detailed in the Memorandum in Support filed herewith, Opposer failed to allege facts that, if accepted as true, would support a claim to relief. Applicant therefore respectfully requests that the Board grant Applicant's motion to dismiss with prejudice.

Dated: August 16, 2018

FAEGRE BAKER DANIELS LLP

/JRSteffen/

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CERTIFICATE OF SERVICE

I, Shannon Jankowski, do hereby certify that on this 16th day of August 2018, a true and correct copy of the Applicant's Motion to Dismiss Notice of Opposition has been served via electronic mail to counsel for the Opposer at RKL@rklpatlaw.com

/Shannon Jankowski/

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

Application Serial No. 86627956
Mark: LOTUS EDGE

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| SAID I. HAKKY, |) | |
| |) | Opposition No. 91242268 |
| Opposer, |) | |
| |) | |
| v. |) | <u>APPLICANT’S MEMORANDUM</u> |
| |) | <u>IN SUPPORT OF MOTION TO</u> |
| BOSTON SCIENTIFIC SCIMED, INC. |) | <u>DISMISS NOTICE OF OPPOSITION</u> |
| |) | <u>FOR FAILURE TO STATE A CLAIM</u> |
| Applicant. |) | |
| |) | |

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP § 503, Applicant Boston Scientific Scimed, Inc. respectfully submits this Memorandum of Law in Support of its Motion to Dismiss Opposer Said I. Hakky’s Notice of Opposition (the “Notice”) with prejudice for failure to state a claim upon which relief may be granted.

Opposer has not allege facts sufficient to support any claim for relief asserted in the Notice. More specifically, both Opposer’s Section 2(d) claim and his dilution allegations require that Opposer have priority of right, but Opposer’s own factual allegations make clear that Opposer enjoys no such priority. The Notice of Opposition should therefore be dismissed with prejudice.

BACKGROUND

Applicant filed the subject intent-to-use Application Serial No. 86627956 for the mark LOTUS EDGE on May 13, 2015 (“Applicant’s Mark”). *See* Notice, ¶ 11.

On February 18, 2017, Opposer filed intent-to-use Application Serial No. 87341273 for the mark, LotusCatheter & Design (“Opposer’s Mark”). *See* Notice, ¶ 1. Opposer

alleges a date of first use in commerce in the United States at least as early as March 31, 2017. *See* Notice, ¶¶ 7, 8.

Applicant's subject application published for opposition on May 15, 2018. *See* Notice, ¶ 6.

Opposer's July 9, 2018 Notice is grounded in likelihood of confusion under Section 2(d) of the Lanham Act and in dilution of distinctive quality within the meaning of Section 43(c) of the Lanham Act. *See* Notice, ¶¶ 21-23.

STANDARD OF REVIEW

Rule 12(b)(6) motions are decided by the Board based on the allegations of the notice of opposition. TBMP § 503.02. In the notice, an opposer needs to allege sufficient factual content 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 the subject application. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

Moreover, to survive a motion to dismiss under Rule 12(b)(6), the allegations in a complaint must meet a standard of "plausibility." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 546 (2007). A claim is facially plausible "when the plaintiff pleads factual content that allows the court to draw the reasonable inference that [plaintiff is entitled to relief]." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). But "[t]hreadbare recitals of elements of a cause of action, supported by mere conclusory statements," will not suffice, and "where the well-pleaded facts do not permit the court to infer more than the mere possibility of misconduct,

the complaint has alleged—but it has not ‘show[n]’—‘that the pleader is entitled to relief.’”
Id. at 679 (quoting Fed. R. Civ. P. 8(a)(2)).

OPPOSER HAS NOT ALLEGED FACTS SUPPORTING PRIORITY

To state a claim under Section 2(d), an opposer must plead that it has proprietary rights in its pleaded mark that are prior to applicant's rights in the challenged mark. *The Board of Trustees of The University of Alabama v. Pitts*, 107 USPQ2d 2001, 2012-20 (TTAB 2013); *Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402, 182 USPQ 108, 110 (CCPA 1974). Similarly, to state a claim for dilution, an opposer must plead that it has proprietary rights in its pleaded mark that are prior to applicant's rights in the challenged mark. *Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q.2d 2013 (TTAB 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1180 (TTAB 2001).

Applicant's priority date is no later than May 13, 2015, the filing date of the subject application. Consistent with Section 7(c) of the Lanham Act, Applicant “may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority.” *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 U.S.P.Q.2d 1112 (TTAB 2009). *See also Larami Corp. v. Talk to Me Programs, Inc.*, 36 U.S.P.Q.2d 1840 (TTAB 1995) (applicant is entitled to rely upon the filing date of its intent-to-use application in an opposition filed by a party alleging prior use, notwithstanding that the application is still pending registration: “if the constructive use provision only came into play after the issuance of a registration, an intent-to-use applicant would never be able to defend its application in an opposition” and that “[t]o require registration of an applicant's mark prior to realization of its

rights under Section 7(c) would defeat the purpose of filing applications based on intent-to-use.”).

Opposer’s Notice contains no allegation forming any plausible basis for a priority date earlier than May 13, 2015. To the contrary, Opposer alleges only the February 18, 2017, filing of an intent-to-use application and use in commerce at least as early as March 31, 2017.

Because Opposer has alleged no facts plausibly supporting a claim for priority, Opposer’s Notice fails to state a claim upon which relief can be granted under either of the legal claims asserted in the Notice.

CONCLUSION

For the reasons set forth above, Opposer has not stated a claim upon which relief can be granted. The Board should therefore grant Applicant’s motion to dismiss Opposer’s Notice of Opposition with prejudice.

Dated: August 16, 2018

FAEGRE BAKER DANIELS LLP

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/Shannon Jankowski/