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

Proceeding	91242612
Party	Defendant Art Van Furniture, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NINGBO JARDI INNOVATION CO., LTD.,	)	
	)	
Opposer	)	
	)	Opposition No. 91242612
v.	)	Application No. 87908119
	)	Mark: ROMA
ART VAN FURNITURE, LLC	)	
	)	
Applicant.	)	
_____	)	

ART VAN'S MOTION TO DISMISS NOTICE OF OPPOSITION
PURSUANT TO FED. R. CIV. P. 12(b)(6)

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, Applicant, Art Van Furniture, LLC ("Art Van"), by and through its undersigned attorneys, hereby moves the Board to dismiss the instant Notice of Opposition ("Notice") filed by Ningbo Jardi Innovation Co., Ltd. ("Ningbo"), on the grounds that it fails to state a claim upon which relief can be granted. Additionally, Art Van requests that this proceeding be suspended pending the outcome of this motion.

In short, Ningbo has opposed Application No. 87908119 (hereafter, "Art Van's ROMA Application") on two grounds: (1) a claim that the specimens that Art Van submitted were unacceptable to show that Art Van was using "ROMA" at the time of its filing of the subject application; and (2) a claim of priority and likelihood of confusion. Because disputes regarding the acceptability of specimens do not give rise to a valid opposition basis, Ningbo's first ground should be dismissed. Because the facts pleaded and made of record by Ningbo demonstrate that Art Van (not Ningbo) has priority, Ningbo's second ground should be dismissed. *In short, there can be no dispute that Art Van has been using the ROMA mark since April 20, 2010, which is at*

least six years before Ningbo began using the PATIOROMA mark and seven years before it applied to register the PATIOROMA mark. [1]

I. STATEMENT OF FACTS

As a preliminary matter, Art Van will take a moment to explain how the parties have arrived at this juncture. Art Van has incontestable U.S. registration 4147167 for the mark  for "furniture, excluding cabinets," reciting dates of first use anywhere and in commerce of April 20, 2010. Notice, **Exhibit C**. Art Van also has used the word mark ROMA continuously since 2010, in connection with furniture.[2]

The mark at issue in the instant opposition is Application No. 87908119 for the standard character mark ROMA (hereafter, Art Van's ROMA Application), filed May 4, 2018, for "*furniture*" reciting dates of first use anywhere and in commerce of April 23, 2010. Notice, **Exhibit B**. Art Van identified Registration No. 4147167 as a prior registration in Application No. 87908119. Notice, **Exhibit B**.

On April 15, 2017, Ningbo filed Application No. 87412698 for PATIOROMA for, in relevant part, furniture, and Art Van filed Notice of Opposition No. 91241026 against this application, based on fraud and priority and likelihood of confusion with Art Van's ROMA marks and prior registration (Registration No. 4147167). *See Art Van Furniture, LLC v. Ningbo Jardi Innovation Co., Ltd* (Opposition No. 91241026) (hereafter, "Art Van's Opposition

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[1] In this Notice, Ningbo has actually alleged facts that would entitle *Art Van* to relief in its Opposition under its likelihood of confusion claim.

[2] **See Exhibit A** to Art Van's Reply in Support of its Motion to Strike, filed in the TTAB on August 3, 2018, in *Art Van Furniture, LLC v. Ningbo Jardi Innovation Co., Ltd* (Opposition No. 91241026). Exhibit A is a collection of screen shots from every year from 2010 to the present that feature Art Van's use of **ROMA per se** on its web site.

Proceeding"). In Art Van's Opposition Proceeding, Art Van filed a Motion to Strike Ningbo's Answer and Affirmative Defenses as being legally insufficient; that Motion is pending.

Ningbo has now opposed Art Van's ROMA Application on the grounds of priority and likelihood of confusion and non-use of the ROMA mark at the time of filing the Application. The Notice in this proceeding not only directly contradicts Ningbo's Answer in Art Van's Opposition Proceeding[3], it is entirely devoid of merit. Ningbo's allegations below are relevant to the instant motion:

- Opposer is the owner of U.S. Trademark Application Serial No. 87/412698 for the mark PATIOROMA, filed April 15, 2017 and published in the Official Gazette of May 01, 2018. Notice at ¶ 2.

- Opposer's date of first use for the mark PATIOROMA in the U.S. is earlier than any date of first use that may be relied upon by the applicant for its standard character mark ROMA in the U.S. Notice at ¶ 14.

- Art Van did not use the standard character mark ROMA in the U.S. prior to August 1, 2016 or prior to April 15, 2017. Notice at ¶ 12-13.

- All of the specimens showed in Exhibit B submitted in connection with the Application Serial No. 87/908119 for the standard character mark ROMA, however, were pictures of Applicant's U.S. registration No. 4147167 in use in commerce; U.S. registration No. 4147167 is a composite mark consists of both a design and a word ROMA ("ROMA and Design"). Notice at ¶ 7.

- The first piece of specimen of Application Serial No. 87/908119 for the standard character mark ROMA is identical to the third piece of specimen of U.S. registration No. 4147167 for the composite mark "ROMA and Design"; the specimens of the composite mark "ROMA and Design" filed on May 22, 2017 are attached as Exhibit D. Notice at ¶ 9.

[3] Ningbo's allegations in this Notice directly contradict its allegations in the Answer it filed in Art Van's Opposition Proceeding, wherein Ningbo's denied Art Van's allegations of likelihood of confusion and denied that Application No. 87412698 recited furniture. *See*, Art Van's Opposition Proceeding, Ningbo's Answer at ¶¶ 9, 12, 13. Notably, Ningbo alleges precisely the opposite in the Notice in this proceeding. *See* Notice at ¶ 5 (U.S. Trademark Application Serial No. 87412698 covers "Furniture."); ¶ 17 ("Consumers are likely to be confused between the standard character marks ROMA and PATIOROMA as used on related products").

- Therefore, applicant did not submit any specimen showing the standard character mark ROMA as used in commerce at the time of filing the trademark application on May 04, 2018, using Section 1(a) as filing basis and claiming the first use in commerce date was April 23, 2010. Notice at ¶ 10.

II. LEGAL STANDARD

To withstand a motion to dismiss, an opposer must demonstrate a valid ground exists for seeking to oppose registration. *Precision Formulations, LLC v. Compagnie Gervais Danone,* 89 USPQ2D 1251, 1254-55 (TTAB 2009) (citing *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982)). For purposes of determining whether a valid ground exists, all of the opposer's well-pleaded allegations must be accepted as true, and the notice of opposition must be construed in the light most favorable to the applicant as the non-movant. *Id.* (citing *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 26 USPQ2d 1038 (Fed. Cir. 1993)).

Despite the requirement that the Board must treat all well-pleaded allegations as true, the Board may look to Office records to determine if a party's allegations are well-pleaded. *Id.* (granting motion to dismiss where alleged facts were inconsistent with Office records). For example, the Board may look to such facts as the filing date, filing basis and priority date, as these are not facts that are subject to proof. *Id.* at 1255. Moreover, the Board may also consider a registration owned by any party to the proceeding even if the registration was not properly introduced in accordance with the applicable rules if the adverse party otherwise treats the registration as being of record. TBMP § 704.03(b)(1)(A).

When accepting only the well-pleaded allegations of the Notice as true for purposes of this Motion, Ningbo has failed to state a claim upon which relief may be granted as it has not pleaded sufficient facts to demonstrate (1) that Art Van had not used the ROMA mark in

commerce at the time of filing Application No. 87908119 and (2) priority of trademark rights in ROMA formative marks.

III. ARGUMENT

A. NINGBO'S OBJECTIONS TO ART VAN'S SPECIMENS DO NOT GIVE RISE TO A VALID GROUND FOR OPPOSITION.

Ningbo has opposed the instant Application on the purported ground that its specimens show that Art Van was not using the ROMA mark at the time of filing the Application; Ningbo, however, has not pleaded any facts to support this ground. Rather, all of Ningbo's allegations regarding Art Van's alleged non-use of the ROMA mark relate to Ningbo's belief that Art Van's specimens were unacceptable. Notice at ¶¶ 7, 9-10. Inasmuch as the adequacy of specimens is solely a subject of *ex parte* examination and does not give rise to a cause of action in an opposition, this claim should be dismissed. *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989).

B. NINGBO FAILED TO PLEAD FACTS SUFFICIENT TO DEMONSTRATE PRIORITY OF TRADEMARK RIGHTS.

In an opposition proceeding alleging likelihood of confusion, the opposer must allege facts sufficient to establish that (1) opposer has priority of rights in and to the mark at issue and (2) applicant's mark, as applied for, is so similar to opposer's mark as to be likely to cause confusion, mistake or deception. *Bongrain Int'l (Am.) Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626, 626 (TTAB 1986). This claim should be dismissed in view of Art Van's prior incontestable registration (Registration No. 4147167) and Art Van's priority of trademark rights in ROMA marks.

The facts of this case are not novel: in fact, the Board has dismissed an opposition under nearly identical facts. Specifically, in *Hammond-Montel Inc. v. Universal Oil Products*

Company, an application was opposed on the ground of likelihood of confusion. The applicant filed a motion to dismiss the opposition, reasoning that, in view of the fact that applicant already owned an existing incontestable registration covering the same mark (in stylized form) for the same goods, the opposer could not possibly be damaged. The relevant application contained a claim of ownership to the prior incontestable registration. Although the opposer argued the applied-for word mark was not in use (because the prior registration was for a stylized version of the same mark), the Board agreed with the applicant and granted applicant's Motion to Dismiss the opposition. 162 USPQ 608 (TTAB 1969).

Just as in the *Hammond-Montel Inc. v. Universal Oil Products Company* case, Art Van owns a prior incontestable registration that recites the same mark (ROMA) in design form; the prior registration and instant Application recite virtually the same goods; and a claim of priority was made to the prior incontestable registration when filing the Application. As a result, Ningbo cannot be harmed by registration of the instant Application as Art Van already owns a registration for essentially the same mark and goods.

Alternatively, the evidence of record shows that Art Van has superior trademark rights in ROMA marks vis a vis Ningbo by virtue of its prior registration:[4] the filing date of the application that resulted in U.S. Registration No. 4147167 (April 23, 2010) and the corresponding recited date of first use (April 20, 2010) predates Ningbo's filing date by nearly seven years (April 15, 2017) and alleged date of first use (August 1, 2016) by more than six

[4] Recognizing that in the context of a motion to dismiss the Board is simply considering the sufficiency of the pleadings, it should consider Art Van's prior registration as part of the pleadings as it was referenced four times in the Notice (¶¶ 7-9) *and* identified as a prior registration in the instant Application (Exhibit B). Ningbo also attached a TESS printout of the details of such registration, including its incontestable status, as Exhibit C. TBMP § 704.03(b)(1)(A).

years. In view of the above, the pleadings do not demonstrate that Ningbo has priority. Thus, Ningbo cannot sustain a likelihood of confusion claim against Art Van.

IV. CONCLUSION

Ningbo has failed to state any claim upon which relief could be granted as it has not alleged any well-pleaded facts in its Notice that would give rise to a claim of non-use of the ROMA mark at the time of filing the subject application or that would give Ningbo priority over Art Van's date of first use or filing date of Registration No. 4147167. Therefore, the instant proceeding should be dismissed as a matter of law.

Respectfully submitted,

Date: August 21, 2018

By: /s/ Barbara L. Mandell

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CERTIFICATE OF SERVICE

I certify that on August 21, 2018, a copy of the foregoing was served by e-mail on counsel for Applicant as follows:

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By: /s/ Barbara L. Mandell
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