

THIS ORDER IS NOT A
PRECEDENT OF THE
TTAB

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

November 25, 2019

Opposition No. 91248129

Remus Repta

v.

Pablo Prichard

By the Trademark Trial and Appeal Board:

This proceeding now comes before the Board for consideration of Applicant's motion (filed June 21, 2019) to dismiss the notice of opposition for failure to state a claim upon which relief can be granted pursuant to Fed. R. Civ. P. 12(b)(6). The motion is contested.

As an initial matter, Opposer's response to the motion to dismiss indicates service by First Class Mail. Trademark Rule 2.119(b) requires that service be made by email unless otherwise stipulated, or unless the serving party can show by written explanation that service by email was attempted but could not be made. In this instance, the Board exercises its discretion to consider Opposer's response to Applicant's motion to dismiss. Both parties are advised, however, that the Board may

refuse to consider any future filings that fail to include the appropriate certificate of service.¹

I. Background

Applicant seeks to register the mark AAA PLASTIC SURGERY, in standard characters, for “Plastic surgery services; Cosmetic surgery services; Reconstructive surgery services; Trauma Surgery Services; Migraine surgery services; Providing a website featuring information about a holistic cosmetic and plastic surgery practice” in International Class 44.²

On May 13, 2019, Opposer filed a notice of opposition opposing registration of Applicant’s mark on the following grounds, as identified on the ESTTA cover sheet: (1) the mark is generic; (2) the mark is merely descriptive without acquired distinctiveness; and (3) Applicant is not the owner of the mark.

In lieu of an answer, Applicant filed a motion to dismiss the notice of opposition for failure to state a claim upon which relief can be granted.

After a careful review of the arguments raised by the parties in their respective papers, the Board makes the following findings and determinations.

II. Motion to Dismiss

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.’”

¹ As noted in the Board’s June 28, 2019 suspension order, Applicant’s motion to dismiss did not include proof of service as required by Trademark Rule 2.119(a) and the Board therefore served a copy of the motion to dismiss on Opposer to expedite proceedings.

² Application Serial No. 88197995, filed November 17, 2018, alleging September 30, 2005 as both the date of first use anywhere and the date of first use in commerce. “PLASTIC SURGERY” is disclaimed.

Ashcroft v. Iqbal, 556 U.S. 662, 663, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 5470, 127 S. Ct. 1955, 1974 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. See *Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. See *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case...”).

In deciding Applicant’s motion, the Board has given no consideration to the matters that are outside of the pleadings. See, e.g., *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009); TBMP § 503.04 (2019). Additionally, the Board has not considered arguments that go to the merits of the case and whether Opposer ultimately will be able to prove his allegations. See, e.g., *Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041; *Covidien LLP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2017); *Scotch Whiskey Ass’n. v. U.S. Distilled Prods. Co.*, 18 USPQ2d 1391, 1393 (TTAB 1991).

A. Standing

Section 13 of the Trademark Act provides that “[a]ny 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, stating the grounds therefor... .” Section 13 thus establishes a broad doctrine of standing; by its terms, the statute requires only that a person have a belief that he would suffer some kind of damage if the mark is registered. As interpreted in binding precedent, a plaintiff must have a “real interest” in the outcome of the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage by the registration of the mark. *See Empresa Cubana del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *Universal Oil Prods. Co. v. Rexall Drug & Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

Here, Opposer has pleaded that applicant has filed a civil action against Opposer, *Richard v. Repta, et al.* Civ. No. 2018-009323 in the Superior Court of Arizona, to obtain Opposer’s domain name www.aaaplasticsurgery.com based on Applicant’s rights in his involved mark. 1 TTABVUE 1-2. Opposer has therefore pleaded facts, if proved, sufficient to establish his interest in the proceeding.³ *See Tonka Corp. v.*

³ Moreover, contrary to Applicant’s assertion, it is not necessary that a plaintiff have exclusive proprietary interest in a mark in order to have standing. *See Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1977 (TTAB 1988) (“[A]ll that is required to demonstrate standing is that a party have a real interest in the outcome of the proceedings, so that it is more than a meddling party. It is not an absolute requirement that a party have proprietary rights in a mark in order to maintain an opposition.”). *See also Girard Polly-Pig, Inc. v. Polly Pig by Knapp, Inc.*, 217 USPQ 1338, 1344 (TTAB 1983) (“It is settled that a registration may be cancelled if a petitioner can show that the existence of the registration is inimical to **an equal**

Tonka Tools, Inc. et al. 229 USPQ2d 857, 858-59 (TTAB 1986) (petitioner established standing where registration was asserted defensively against petitioner in a civil action).

In his motion to dismiss, Applicant argues that Opposer cannot prove his standing and attaches exhibits in support thereof. A motion to dismiss is **solely** a test of the sufficiency of the pleadings and “does not involve a determination of the merits of the case... .” *Libertyville Saddle Shop Inc.*, 22 USPQ2d at 1597. Where a motion styled as one to dismiss involves a determination of the merits of the case or relies on matter outside the pleadings, the Board may construe the motion as one for summary judgment. In order to move for summary judgment, however, a party must have served its initial disclosures prior to its motion for summary judgment, unless the motion is based upon a claim of claim or issue preclusion or lack of jurisdiction. Trademark Rule 2.127(e). Applicant has not yet filed an answer and the motion to dismiss was filed prior to the deadline for serving initial disclosures and there is no indication in Applicant’s motion that he has already served his initial disclosures. Thus, to the extent Applicant’s motion could have been construed as a motion for summary judgment, such motion would have been premature. The Board has therefore given no consideration to the matters outside the pleadings on determination of the motion to dismiss.

In view of the foregoing, Applicant’s motion to dismiss is **denied** with respect to Opposer’s standing.

or superior right to use the same or similar term in connection with goods or services which are similar to or commercially related to those of respondent.”) (emphasis added).

B. Genericness or Mere Descriptiveness

A term is considered to be generic when it “refers to the genus of which the particular product is a species.” *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). A term is considered to be merely descriptive under Section 2(e)(1) if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). “A mark need not recite each feature of the relevant goods or services in detail to be descriptive, it need only describe a single feature or attribute.” *Id.* (internal citation omitted); *see also In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

Although the content of the ESTTA cover sheet is read in conjunction with the notice of opposition, (*PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005)), the mere mention of a ground on the cover sheet is insufficient to constitute a claim. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1927 n.2 (TTAB 2013). Opposer identifies the claims of descriptiveness and mere descriptiveness on the ESTTA cover sheet, but the notice of opposition is entirely devoid of any allegations sufficient to support such claims. Opposer has not pleaded that Applicant’s involved mark is generic for the identified services or that the involved mark is merely descriptive of a quality, feature, function, or characteristic of the services.

To the extent Opposer's claims are based on the allegation that Applicant's specimens submitted with his involved application do not establish use in commerce of Applicant's mark as a trademark, the allegations are insufficient to state any basis for opposition. The adequacy of a specimen is solely a matter of ex parte examination, *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989), and the insufficiency of a specimen does not constitute a valid ground for opposition. *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358-59 (TTAB 1989).

Opposer also pleads that Applicant "has not demonstrated that the 'AAA Plastic Surgery' trademark has been used other than as an information indication[sic] of the aaaplasticsurgery.com domain name." Notice of opposition ¶ 16. Opposer appears to be conflating claims of non-use (or lack of use in commerce) with claims that a mark is generic or merely descriptive. To the extent Opposer intended to plead a claim that Applicant did not have use of his involved mark in commerce at the time the application was filed, the pleading is vague, unclear, and insufficient to provide fair notice to Applicant.

In view of the foregoing, Applicant's motion to dismiss is **granted** with respect to Opposer's claims of genericness and mere descriptiveness.

C. Applicant is not the Rightful Owner of the Mark

Only the owner of a mark may file a use-based application for registration of the mark. *See* 15 U.S.C. § 1051(a). "[I]f the [person] filing the application is not the owner of the mark as of the filing date, the application is void ab initio." *Great Seats, Ltd. v.*

Great Seats, Inc., 84 USPQ2d 1235, 1239 (TTAB 2007). The notice of opposition does not specifically allege that Applicant is not, and was not at the time the application was filed, the owner of the mark, but only that Applicant is currently not the exclusive “user” of the mark.⁴ Notice of opposition ¶ 4. Opposer’s allegations are insufficient to plead a claim that Applicant was not the owner of the mark at the time the application was filed.

In view thereof, Applicant’s motion to dismiss is **granted** with respect to Opposer’s claim that Applicant is not the rightful owner of the mark.

Notwithstanding the foregoing, the Board freely grants leave to amend pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6), as is the case here. In view thereof, Opposer is allowed time in which to file and serve an amended notice of opposition that properly states a valid claim for relief, failing which, the notice of opposition will be dismissed in its entirety.

III. Civil action

In the notice of opposition, Opposer apprised the Board of a potentially related civil action. It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); TBMP § 510.02(a). Accordingly, within **twenty days** of the date of this order, Opposer is required to file a copy of the pleadings in

⁴ In his response to the motion to dismiss, Opposer argues that he has properly pleaded that Advanced Plastic Reconstruction, PLLC is the owner of the involved mark, not Applicant. 6 TTABVUE 2. Attorney argument made in a brief does not constitute part of the pleadings, however. The notice of opposition contains no clear allegation that a jointly owned entity is the owner of the mark, not Applicant.

the civil action, so that the Board may determine whether suspension of this proceeding pending final determination of the civil action is warranted.

Proceedings are otherwise **suspended**. Upon resumption, Opposer's time for filing an amended notice of opposition and all other dates will be reset.