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

December 17, 2019

Opposition No. 91251946

Kurt Geiger Limited

v.

John Geiger Collection LLC

Michael Webster, Interlocutory Attorney:

On December 9, 2019, in lieu of an answer to the notice of opposition, John Geiger Collection LLC ("Applicant") filed a motion to dismiss the notice of opposition "pursuant to Fed. R. Civ. P. 12(b)(6)." 4 TTABVUE 2. By its motion, however, Applicant argues the merits of the likelihood of confusion claim. In particular, Applicant's motion requires the Board to consider the "sound, appearance, and connotation" of the marks, *id.* at 6-7, the dissimilarity of particular terms in the marks, *id.* at 8, and evidence outside the pleadings. *Id.*[1]

A motion to dismiss under Rule 12(b)(6) is a test solely of the legal sufficiency of the complaint, not whether extrinsic evidence would prevent the plaintiff from proving its claims. *See, e.g., Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys.*

[1] Both of the cases cited by Applicant are final decisions on the merits of the Section 2(d) claims. The decisions do not address any particular pleading requirements for a likelihood of confusion claim.

Inc., 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992); *see also* TBMP §§ 503.01, 503.02 (June 2019).

Because Applicant's motion is based solely on the merits of the notice of opposition and not on the legal sufficiency of the claims, the motion may be construed as one for summary judgment. However, the Board will generally not consider a motion to dismiss including matter outside the pleading to be a motion for summary judgment because treatment as such would result in a premature motion for summary judgment under Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1). *Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009) (motion to dismiss not converted to motion for summary judgment). Under Trademark Rule 2.127(e)(1), a motion for summary judgment may not be filed until the moving party has made its initial disclosures unless the motion is based on lack of jurisdiction or claim or issue preclusion. *See Qualcomm, Inc. v. FLO Corp.,* 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures); *see also,* TBMP § 528.02.

In view thereof, Applicant's motion will not be converted into a premature motion for summary judgment. *See* Fed. R. Civ. P. 12(d); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1028 (TTAB 2015) (motion to dismiss not considered as motion for summary judgment because motion was filed before the parties' initial disclosures were due and initial disclosures had not been served).

Although Applicant does not argue that Opposer has failed to plead a legally sufficient claim under Rule 12(b)(6), the Board has, nonetheless, reviewed the complaint for its legally sufficiency. To withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege facts that, if proved, would establish that (1) it has standing to bring these proceedings, and (2) a valid statutory ground exists for opposing registration of the involved applications. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); TBMP § 503.02.

The Board finds that the notice of opposition is legally sufficient to the extent that it contains allegations that, if proved, would establish Opposer's standing, as well as its claim of likelihood of confusion. The Board notes, however, that although Opposer alleges that the subject mark is "likely to falsely suggest a connection with Opposer," the allegations appear to be asserted in connection with Opposer's Section 2(d) claim. Opposer does not assert a claim under Section 2(a), 15 U.S.C. § 1052(a), or allege any of the elements of a claim under Section 2(a). *See Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

In view of the foregoing, and because Applicant's motion is solely based on the merits of the notice of opposition, the motion to dismiss is **DENIED**. An answer to the notice of opposition is **due January 2, 2020**.

Proceeding dates are reset as follows:

Time to Answer	1/2/2020
Deadline for Discovery Conference	2/1/2020
Discovery Opens	2/1/2020
Initial Disclosures Due	3/2/2020

Expert Disclosures Due	6/30/2020
Discovery Closes	7/30/2020
Plaintiff's Pretrial Disclosures Due	9/13/2020
Plaintiff's 30-day Trial Period Ends	10/28/2020
Defendant's Pretrial Disclosures Due	11/12/2020
Defendant's 30-day Trial Period Ends	12/27/2020
Plaintiff's Rebuttal Disclosures Due	1/11/2021
Plaintiff's 15-day Rebuttal Period Ends	2/10/2021
Plaintiff's Opening Brief Due	4/11/2021
Defendant's Brief Due	5/11/2021
Plaintiff's Reply Brief Due	5/26/2021
Request for Oral Hearing (optional) Due	6/5/2021

Generally, the Federal Rules of Evidence 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).