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

April 5, 2021

Opposition No. 91255820

Hy-Tape International, Inc.

v.

The Boots Company PLC

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of Applicant's motion, filed December 14, 2020, to dismiss Opposer's Ground III ("Applicant's Mark is Deceptive") and Ground IV ("Applicant's Mark Is Desceptively [sic] Misdescriptive") for failure to state a claim upon which relief may be granted, or in the alternative, to strike Paragraphs 23-34 of the amended notice of opposition as redundant, immaterial information or as an impermissible or insufficient claim. The motion is fully briefed.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

Applicant seeks registration of the mark ORIGINAL PINK, in standard characters, for "cosmetics; cosmetic preparations for skin renewal; face, body, and hand moisturizers; non-medicated skin care preparations, namely, toners; non-medicated serums for use on hair, skin, and lips; skin, body, beauty, and facial masks; skin, anti-aging, and facial cleansers; non-medicated toiletry preparations, namely body soap, body moisturiser, bath and shower soap, body lotion, shower and bath foam, foam skin cleansers, body scrub, body exfoliator in the nature of exfoliant creams, body wash, body butter, fragranced body soap, fragranced body moisturiser, fragranced bath and shower soap, fragranced body lotion, fragranced shower and bath foam, fragranced foam cleansers, fragranced body scrub, fragranced body exfoliator in the nature of exfoliant creams, fragranced body wash, fragranced body butter, body spray, fragranced body spray, fragrances; non-medicated hand, bath, beauty, skin, and toilet soaps; essential oils; non-medicated lotions for skin, hair, face, and body; non-medicated skin care preparations, namely, creams; non-medicated preparations for the care of the body, face, skin, and hair; non-medicated hair treatment preparations for cosmetic purposes; shower gels; moisturizing skin, hair, face, and body lotions; moisturizing creams; body scrubs; bath gels; bath oils; bath creams; facial moisturizing lotions; facial masks; non-medicated skin care preparations, namely, body gels; body lotions; body creams; body butter; skin creams; anti-wrinkle creams; body masks; body contouring patches being patches used on the skin for cosmetic purposes impregnated with cosmetic preparations in the nature of

firming creams and lotions; facial creams, lotions and toners; non-medicated hand care creams, facial masks, skin serums and body scrubs; skin moisturizers" in International Class 3.[1] In its notice of opposition, Opposer alleged prior use and registration of the mark THE ORIGINAL PINK TAPE, in typeset form,[2] for "plastic adhesive tape for medical use" in International Class 5.[3] As grounds for opposition, Opposer pleaded claims of: (1) priority and likelihood of confusion (1 TTABVUE 6-8, ¶¶ 10-16; (2) dilution (*id.* at 8-9, ¶¶ 17-21); (3) "Applicant's Mark is Deceptive" (*id.* at 9, ¶¶ 22-26); and (4) "Applicant's Mark is Misdescriptive" (*id.* at 10, ¶¶ 27-31).

On August 6, 2020, Applicant filed a motion to dismiss Grounds III and IV pursuant to Fed. R. Civ. P. 12(b)(6), "or, in the alternative, to strike paragraphs 22-31 as redundant, immaterial information or as an impermissible or insufficient claim." 9 TTABVUE 2.

On November 4, 2020, the Board granted Applicant's motion to dismiss Counts III and IV for failure to state a claim. 14 TTABVUE 8-10. The Board also sua sponte reviewed the sufficiency of Opposer's likelihood of confusion and dilution claims and struck Opposer's dilution claim for failure to state a claim. *Id.* at 10-11. The Board allowed Opposer until November 24, 2020 to file an amended notice of opposition which addresses the deficiencies noted in the

[1] Application Serial No. 88361479; filed March 28, 2019, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. "ORIGINAL" is disclaimed.

[2] Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

[3] Registration No. 2399299; issued October 31, 2000; renewed. "PINK TAPE" is disclaimed.

Board's order with respect to the improperly pleaded grounds, failing which the original notice of opposition would remain operative as to the likelihood of confusion claim. *Id.* at 12.

On November 23, 2020, Opposer filed an amended notice of opposition. As grounds for opposition, Opposer pleads claims of: (1) priority and likelihood of confusion (15 TTABVUE 5-6, ¶¶ 10-16; (2) dilution (*id.* at 6-8, ¶¶ 17-22); (3) "Applicant's Mark is Deceptive" (*id.* at 8-9, ¶¶ 23-29); and (4) "Applicant's Mark Is Desceptively [sic] Misdescriptive" (*id.* at 9-10, ¶¶ 30-34).

On December 14, 2020, Applicant filed a motion to dismiss Grounds III and IV pursuant to Fed. R. Civ. P. 12(b)(6), "or, in the alternative, to strike paragraphs 23-34 as redundant, immaterial information or as an impermissible or insufficient claim." 16 TTABVUE 2. On December 14, 2020, Applicant also filed an answer to the notice of opposition, denying the salient allegations and asserting five purported affirmative defenses.[4] 17 TTABVUE.

II. The Parties' Arguments

Applicant argues that Grounds III and IV should be dismissed because Opposer has failed to sufficiently allege the elements of a deceptiveness and deceptive misdescriptiveness claim. 16 TTABVUE 6-13. More specifically, Applicant argues, inter alia, that: (1) Opposer fails to sufficiently allege that Applicant's mark misdescribes its goods because Opposer improperly dissects the involved mark and merely parrots the requisite elements without sufficient factual support (*id.* at 7-9);

[4] The allegations in Applicant's affirmative defenses are not true affirmative defenses but rather are permissible amplifications of Applicant's denials to Opposer's notice of opposition.

(2) Opposer fails to sufficiently allege that consumers are likely to believe the purported misrepresentation because Opposer again improperly dissects the involved mark and does not include factual allegations to support why a consumer would believe the purported misrepresentation (*id.* at 9-10); and (3) Opposer fails to sufficiently allege that the purported misrepresentation is a material factor in the purchasing decision of a significant portion of relevant consumers because Opposer does not provide plausible and factual reasons as to why the misdescription would be material to a significant portion of consumers; instead, it merely alleges the requisite element in conclusory fashion (*id.* at 10-12). In the alternative, Applicant requests that the Board strike Paragraphs 23-34 of the amended notice of opposition "because each contains an impermissible or improper claim and/or is immaterial or redundant." *Id.* at 13.

In response, Opposer argues, inter alia, that: (1) it "alleges sufficient and plausible allegations to support its claims of deception and deceptive misdescriptiveness" (19 TTABVUE 2); (2) the alleged "factual and legal content … allow the Board and Applicant to not only 'draw an inference,' but to readily and easily recognize and understand Opposer's grounds" (*id.* at 4); (3) Opposer need not prove its claims at the pleading stage (*id.* at 4-7); (4) Opposer alleges the requisite elements of a misdescriptive and deceptive misdescriptive claim (*id.* at 8-10); (5) Applicant improperly argues the merits of Opposer's claims (*id.* at 10-12); and (6) Applicant's summary request to strike Paragraphs 23-34 of the amended notice of opposition

lacks merit (*id.* at 13-14). In the alternative, Applicant requests leave to amend its notice of opposition a second time. *Id.* at 14.

In reply, Applicant argues, inter alia, that: (1) the Board should not look at Opposer's amended notice of opposition in a vacuum but rather should consider the context of the allegations in determining their plausibility (21 TTABVUE 3); (2) the Board's use of its judicial experience and knowledge to assess plausibility does not turn the motion to dismiss into one for summary judgment (*id.* at 3-5); (3) common sense dictates that Opposer's deceptiveness and deceptive misdescriptiveness claims lack plausibility (*id.* at 6); and (4) Opposer should not be given an opportunity to amend its pleading a second time (*id.* at 7-8).

III. Motion to Dismiss

A. Legal Standard

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) is a test of the sufficiency of the complaint. *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 (TTAB 2014). To survive a motion to dismiss, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has an entitlement to a statutory cause of action, and (2) a valid ground exists for denying the registration sought or for cancelling the involved registration.[5] *See Doyle v. Al Johnson's Swedish Rest. &*

[5] Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act under the rubric of "standing." Despite the change in nomenclature, the Board's prior decisions and those of the Court of Appeals for the Federal Circuit interpreting

Butik Inc., 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). In other words, the Board determines whether Opposer's belief "is not wholly without merit." *See Lipton*, 213 USPQ at 189.

Further, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face."' *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the plaintiff must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555). 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).

For purposes of determining a motion to dismiss, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the

Sections 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, *2 (TTAB 2020).

light most favorable to the plaintiff. *See Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041; *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010). Furthermore, "[u]nder the simplified notice pleading of the Federal Rules of Civil Procedure, the allegations of a complaint should be construed liberally so as to do substantial justice." *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Moreover, the purpose of a motion to dismiss is not to address the merits of the case. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons L*td., 22 USPQ2d 1594, 1597 (TTAB 1992) ("[A] motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings. No matters outside the pleadings are considered. A motion to dismiss does not involve a determination of the merits of the case[.]").

B. Entitlement to a Statutory Cause of Action

As addressed in the Board's November 4, 2020 order, Opposer has sufficiently alleged its entitlement to a statutory cause of action. 14 TTABVUE 7 (citations omitted).

C. Deceptiveness (Ground III)

To plead a sufficient claim that a mark is deceptive under Section 2(a) of the Trademark Act, a plaintiff must allege that: (1) the applied for mark consists of or contains a term that misdescribes the character, quality, function, composition or use of the goods; (2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods. *See, e.g. In re Budge*

Mfg. Co., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1010 (TTAB 2006).

In support of its deceptiveness claim, Opposer alleges, inter alia:

> 24. Opposer has used its THE ORIGINAL PINK TAPE® mark for 35 years in the U.S., and Opposer's Mark has become a distinctive indicator of source that consumers and the trade can look to in ensuring the quality of the products being purchased and used.
>
> 25. Applicant's Intended Mark, ORIGINAL PINK, consists of the term "original," that misdescribes the character, quality, function, composition and/or use of the goods associated with the Intended Mark. For example, term "original" misdescribes the character, quality and composition of the goods of the Intended Mark as being "original," when in fact such goods are neither the first (original) pink skin-related products, nor the only authentic (original) pink skin-related products.
>
> 26. Applicant's Intended Mark, consists of, and makes the claim that Applicant provides the "Original Pink" skin care products. This statement is false, untrue and inaccurate because Opposer has been selling such products decades before Applicant filed its trademark application and thus Applicant is not providing, or proposing to provide, the first or only authentic, such skin care products.
>
> 27. Prospective purchasers are likely to believe that Applicant's misdescription of Applicant's Intended Products actually describes the goods because, inter alia, prospective purchasers are likely to believe that Applicant's Intended Products are the first, or only authentic, pink skin-related products.
>
> 28. The misdescription inherent in the term "original" is likely to affect a significant portion of the relevant consumers' decision to purchase Applicant's Intended Products. Consumers' product choices are such that they are shaped by a desire for a product's authenticity or originality. Consumers are therefore more likely to buy goods that are represented to be original.
>
> 29. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in deceptively, falsely, and misleadingly indicating and implying that Applicant's products offered under Applicant's Intended Mark are the first (original) such skin-related products, or the only authentic (original) such skin-related products.

15 TTABVUE 8-9, ¶¶ 24-29.

The Board finds that Opposer has sufficiently pleaded a claim for deceptiveness under Section 2(a) of the Trademark Act. Opposer alleges that: (1) the applied for mark consists of or contains a term that misdescribes the character, quality, function, composition or use of the goods in that Applicant's goods are "neither the first (original) pink skin-related products, nor the only authentic (original) pink skin-related products" (15 TTABVUE 8, ¶ 25); (2) prospective purchasers are likely to believe that the misdescription actually describes the goods (*id.* at 8, ¶ 27); and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods (*id.* at 9, ¶ 28).

Applicant contends that Opposer has improperly dissected the mark by focusing on the word "original" alone. 16 TTABVUE 7-10. The Board disagrees. Opposer alleges that the mark as a whole misdescribes Applicant's goods and will mislead the relevant consumers to believe that Applicant's goods will have certain characteristics when they (assertedly) will not. Opposer's reference to "original" supports its allegation for why the mark as a whole is (assertedly) deceptive (and deceptively midsecriptive). Furthermore, the arguments that Applicant's frames as "plausibility" arguments (*see, e.g.*, 16 TTABVUE 10-12 and 21 TTABVUE 2-7) go to the merits of Opposer's deceptiveness claim, not the sufficiency of the pleading. The purpose of a motion to dismiss is not to address the merits of the case. Rather, a motion to dismiss under Rule 12(b)(6) must challenge the legal theory of the complaint, not the sufficiency of the evidence or whether extrinsic evidence would prevent the plaintiff from proving its claims. *See, e.g.*, *Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at

1041; *Libertyville Saddle Shop Inc.*, 22 USPQ2d 1594 at 1597; *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 503.02 (2020).

In view of the foregoing, and construing Opposer's allegations so as to do justice and in the light most favorable to Opposer, the Board finds that Opposer has pleaded sufficient factual allegations that, if proven, would establish its claim of deceptiveness under Section 2(a) of the Trademark Act. Accordingly, Applicant's motion to dismiss Opposer's deceptiveness claim (Ground III) is **denied**.

D. Deceptive Misdescriptiveness (Ground IV)

To plead a sufficient claim that a mark is deceptively misdescriptive under Section 2(e) of the Trademark Act, a plaintiff must allege that: (1) the mark sought to be registered is misdescriptive of the goods identified in the application; and (2) that the misdescription is deceptive, i.e., plausible and likely to be believed by purchasers. *See In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984). Explaining this ground in the broader context of Section 2(e)(1) of the Act, the Board has noted that:

> …a term is merely descriptive if it conveys an immediate idea of an ingredient, quality, characteristic, function or feature of the product with which it is used. If, however, the mark would be merely descriptive if it conveyed an accurate or true idea, but instead the idea is false (although plausible), than the term is deceptively misdescriptive and is unregistrable under Section 2(e)(1).

In re Ox-Yoke Originals, Inc., 222 USPQ 352, 353 (TTAB 1983).

In support of its deceptive misdescriptiveness claim, Opposer alleges, inter alia:

> 31. Applicant's Intended Mark indicates to consumers and the trade, in a misdescriptive and inaccurate way, that Applicant is providing the first (original) pink, skin-related products, or the only authentic (original) pink, skin-related products.

32. Applicant's Intended Mark, ORIGINAL PINK, includes the word "original" which is misdescriptive of the goods identified in the subject application, i.e., Applicant's Intended Products. This statement is false, untrue and inaccurate because Opposer has been selling such products decades before Applicant filed its trademark application, and thus Applicant is not, in fact, providing or proposing to provide "original pink" skin care products.

33. Applicant's misdescriptive use of the word "original" is deceptive, i.e., plausible and likely to be believed by consumers. The term "original" has a strong and well-known meaning, signifying the first, or only, authentic such skin-related products.

34. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant, in a deceptive and misdescriptive manner, to indicate and convey to consumers that Applicant's products offered under Applicant's Intended Mark are the first (original) such skin-related products, or the only authentic (original) such skin-related products.

15 TTABVUE 9-10, ¶¶ 31-34.

Opposer alleges that the applied for mark is misdescriptive of the goods identified in the application (*id.* at 9, ¶¶ 31-32) and that that the misdescription is deceptive (*id.* at 10, ¶¶ 33-34). Construing Opposer's allegations so as to do justice and in the light most favorable to Opposer, the Board finds that Opposer has sufficiently pleaded a claim for deceptive misdescriptiveness under Section 2(e) of the Trademark Act. Accordingly, Applicant's motion to dismiss Opposer's deceptive misdescriptiveness claim (Ground IV) is **denied**.

IV. Applicant's Alternative Motion to Strike

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f); *Am. Vitamin Prods. Inc. v. DowBrands Inc.,* 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP § 506.01. Motions to strike are not favored, and matter usually will not be stricken unless it

clearly has no bearing upon the issues in the case. TBMP § 506.01. The primary purpose of the pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985); TBMP § 309.03(a)(2). Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *Harsco Corp. v. Elec. Scis. Inc.,* 9 USPQ2d 1570, 1571 (TTAB 1988).

Applicant requests, in the alternative, that the Board strike Paragraphs 23-34 of the amended notice of opposition (i.e., the paragraphs setting forth Grounds III and IV). 16 TTABVUE 13-14. The Board has found that Paragraphs 23-34 of the amended notice of opposition sufficiently state claims for deceptiveness under Section 2(a) of the Trademark Act and deceptive misdescriptiveness under Section 2(e)(1) of the Trademark Act. As such, Applicant's conclusory, alternative request to "strike" these paragraphs as "impermissible or improper … and/or … immaterial or redundant" is **denied**.

V. Summary

Applicant's motion to dismiss Ground III ("Applicant's Mark is Deceptive") and Ground IV ("Applicant's Mark Is Desceptively [sic] Misdescriptive") is **denied**.

Applicant's alternative motion to strike Paragraphs 23-34 of the amended notice of opposition is **denied**.

Applicant's answer to the amended notice of opposition (17 TTABVUE) is Applicant's operative pleading.

VI. Proceedings Resumed

Proceedings are **resumed** and dates are reset as follows:

Deadline for Discovery Conference	5/5/2021
Discovery Opens	5/5/2021
Initial Disclosures Due	6/4/2021
Expert Disclosures Due	10/2/2021
Discovery Closes	11/1/2021
Plaintiff's Pretrial Disclosures Due	12/16/2021
Plaintiff's 30-day Trial Period Ends	1/30/2022
Defendant's Pretrial Disclosures Due	2/14/2022
Defendant's 30-day Trial Period Ends	3/31/2022
Plaintiff's Rebuttal Disclosures Due	4/15/2022
Plaintiff's 15-day Rebuttal Period Ends	5/15/2022
Plaintiff's Opening Brief Due	7/14/2022
Defendant's Brief Due	8/13/2022
Plaintiff's Reply Brief Due	8/28/2022
Request for Oral Hearing (optional) Due	9/7/2022

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, the manner and timing of taking testimony, matters in evidence, 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).