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

Proceeding	91263782
Party	Plaintiff Lonza Consumer Health Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	10/09/2020
Attachments	91263782 - Motion to Dismiss.pdf(77487 bytes) 91263782 - Memorandum in Support of Motion to Dismiss.pdf(105126 bytes)

6214.141994

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

In the Matter of Application Serial No.: 88/779,062 For the mark – 8 KETO	)	
Lonza Consumer Health Inc.,	)	Opposition No. 91263782
Opposer and Registrant, v.	)	Cancellation against Reg. No. 2,964,802
JHO Intellectual Property Holdings, LLC	)	
Applicant and Petitioner.	)	

OPPOSER'S MOTION TO DISMISS
APPLICANT'S COUNTERCLAIM PURSUANT TO FED. R. CIV. P. 12(b)(6)

Opposer and Registrant Lonza Consumer Health Inc. ("Opposer"), by and through its undersigned counsel, moves this Honorable Board to dismiss the Counterclaim filed by Applicant and Petitioner JHO Intellectual Property Holdings, LLC ("Applicant") for failure to state a claim upon which relief may be granted pursuant to Fed. R. Civ. P. 12(b)(6). Opposer submits herewith a Memorandum in support of its Motion.

Dated: October 9, 2020

By */Lawrence J. Crain/*
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on the following counsel for Applicant by email, on this 9th day of October, 2020.

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OPPOSER'S MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS APPLICANT'S COUNTERCLAIM PURSUANT TO FED. R. CIV. P. 12(b)(6)

Opposer and Registrant Lonza Consumer Health Inc. ("Opposer"), by and through its undersigned counsel, submits this memorandum in support of its Motion to Dismiss the Counterclaim filed by Applicant and Petitioner JHO Intellectual Property Holdings, LLC ("Applicant") for failure to state a claim upon which relief may be granted pursuant to Fed. R. Civ. P. 12(b)(6).

INTRODUCTION

Opposer filed a Notice of Opposition on July 22, 2020 with the Trademark Trial and Appeal Board on the grounds of likelihood of confusion. On August 31, 2020, Applicant filed its Answer, which included a Counterclaim to cancel Opposer's plead Registration No. 2,964,802 on the grounds of genericness. Specifically, Applicant has made the following allegations regarding its Counterclaim:

> 16. Applicant repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.
>
> 17. The term "KETO," which is common to every registration cited in the Notice of Opposition, is not a term coined by Opposer. Rather, the term "KETO" is a generic term to denote foods or supplements that can be used in a ketogenic diet.
>
> 18. Since the relevant goods for this Opposition are supplements, "KETO" is generic for the goods related to the cited marks.
>
> 19. For the foregoing reasons, Applicant believes that it will be damaged by the continued registration of the cited registrations and therefore prays for amendment of the '802 registration to disclaim the term "KETO."

From the above allegations, it is unclear the extent of the relief requested by Applicant in its Counterclaim. In any event, Opposer brings this present motion to dismiss on the grounds that Applicant has failed to (1) state a claim that Registration No. 2,964,802 is generic, or (2) state a claim that "KETO" should be disclaimed from Registration No. 2,964,802.

ARGUMENT

In order to withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a pleading needs to allege facts that would, if proved, establish that the plaintiff is entitled to the relief sought. *Montecash LLC v. Anzer Enterprises, Inc.*, 95 U.S.P.Q.2d 1060, 1061 (T.T.A.B. 2010). In other words, a pleading needs to establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the subject registration. TBMP 503.02.

I. Applicant Has Failed to State a Claim that Registration No. 2,964,802 is Generic

The date of registration for Registration No. 2,964,802 is July 5, 2005. As such Registration No. 2,964,802 was more than five years old when Applicant's Counterclaim was

filed, and the possible grounds for cancellation are limited. Pursuant to Section 14 of the Lanham Act, Registration No. 2,964,802 can be cancelled solely on the following grounds.

> At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 USCS § 1054] or of subsection (a), (b), or (c) of section 2 [15 USCS § 1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

15 U.S.C. § 1064(3).

Applicant's claim that a portion of the registered mark – KETO – is generic is not one of the enumerated grounds and is time-barred. "Section 14(3) only provides for a claim where the allegation is that the mark, *as a whole*, is generic." *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 U.S.P.Q.2d 1478, 1480 (T.T.A.B. 2007) (emphasis added). In *Finanz St. Honore*, a counterclaim sought to cancel the registration for LOVE'S BABY SOFT based on the absence of a disclaimer of an alleged generic term, "Baby Soft." *Id.* at 1479. The Board held that Section 14(3) provides for a claim of cancellation on the ground of genericness with respect to a registration more than five years old only if it is alleged that the mark *as a whole* is generic. *Id.* Similarly, in *Montecash LLC*, the petitioner sought to cancel a mark that had been registered for more than five years on the ground that a portion of the mark was generic, and the purportedly

generic term had not been disclaimed. *Montecash LLC v. Anzer Enterprises, Inc*., 95 U.S.P.Q.2d 1060, 1061 (T.T.A.B. 2010). The Board granted the respondent's motion to dismiss since Section 14(3) only provides for a claim of cancellation on the ground of genericness with respect to a registration more than five years old only if it is alleged that the mark as a whole is generic. *Id*.

Because Applicant's claim that the KETO portion of Registration No. 2,964,802 is generic is time-barred, Applicant has failed to state a claim for cancellation on the grounds of genericness.

II. Applicant's Request for a Disclaimer of "KETO" in Registration No. 2.964,802 Does Not State a Claim

Applicant's Counterclaim does not specifically refer to 15 U.S.C. § 1068 (Section 18 of the Lanham Act), but its Counterclaim asks that the Board amend Registration No. 2,964,802 to disclaim the term "KETO." 4 TTABVUE at ¶ 19. This relief would only be available under Section 18 of the Lanham Act. However, Section 18 does not provide a basis for seeking entry of a disclaimer of a term which only comprises a part of the mark, and which has asserted to be generic, when the registration is more than five years old. *Montecash LLC v. Anzer Enterprises, Inc*., 95 U.S.P.Q.2d 1060, 1065 (T.T.A.B. 2010). Section 18 does not contain any express provisions with respect to a disclaimer of an alleged generic term in a mark registered for more than five years, and to read such a provision into Section 18 would conflict with Section 14(3). *Id*. "[B]ecause of the equitable purpose served of allowing marks to coexist on the register, allowing the Board to impose disclaimers after registrations are more than five years old is neither expressly provided for by the statute nor, in our view, an equitable remedy contemplated by the legislative history of Section 18." *Id*.

As such, Applicant's request for entry of a disclaimer for a purportedly generic term that forms part of a mark that is not generic in its entirety, and that has resided on the Principal Register for more than five years, has failed to state a claim upon which relief can be granted. *Montecash LLC v. Anzer Enterprises, Inc*., 95 U.S.P.Q.2d 1060, 1065 (T.T.A.B. 2010).

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board dismiss Applicant's Counterclaim.

Dated: October 9, 2020

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