

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

February 10, 2021

Opposition No. 91263877

Micron Technology, Inc.

v.

Fu-Chang Hsu

By the Trademark Trial and Appeal Board:

It has come to the Board's attention that the Board's prior order of January 29, 2021,¹ was a draft order that was mistakenly issued. Accordingly, the Board **vacates** the prior order.

This case now comes up on Applicant's motion, filed September 8, 2020, to dismiss Opposer's opposition for failure to state a claim as to Opposer's claims that Applicant's mark, namely, X-NAND, is generic, or in the alternative, merely descriptive, in connection with "semi-conductor memories."² The motion is fully briefed.³

¹ 8 TTABVUE.

² 4 TTABVUE.

³ 6 and 7 TTABVUE.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above-referenced motion.⁴

I. BACKGROUND

Applicant applied to register the mark X-NAND, in standard characters, for “semi-conductor memories,” in International Class 9.⁵ As grounds for opposition, Opposer alleges that:

- the mark is a generic or merely descriptive term for the goods identified in the application;⁶ and
- Applicant’s mark, X-NAND, has not been used in commerce and has not acquired secondary meaning.⁷

In lieu of an answer, Applicant timely filed the present motion pending before the Board.⁸ The basis for Applicant’s motion to dismiss is that Opposer fails to state a

⁴ The Board presumes the parties’ familiarity with the notice of opposition and the parties’ arguments on the pending motion, and does not recount the facts or arguments here except as necessary to explain the decisions in this order. *See Guess? IPHolder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

⁵ Application Serial No. 88540624, filed July 26, 2019, is based on Applicant’s claimed bona fide intent to use the mark in commerce under Trademark Act § 1(b), 15 U.S.C. § 1051(b).

⁶ 1 TTABVUE 3. The Board notes that the notice of opposition does not clearly set forth two separate grounds, namely, that the mark is generic and merely descriptive, being asserted as indicated on the cover page of the notice of opposition. Pursuant to Trademark Rule 2.104(a), ESTTA requires the opposer to select the relevant ground(s) for opposition and the accompanying statements must support and explain the grounds. Trademark Rule 2.104(a), 37 C.F.R. § 2.104(a). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 309.03 (2020). The separate claims are only discerned from a review of the cover page and not supported in the notice of opposition.

⁷ *Id.* at 6.

⁸ 4 TTABVUE.

plausible claim of genericness by failing to specify that the primary significance of the mark is to convey the class or category of the goods.⁹ Additionally, Applicant contends that Opposer also fails to state a plausible claim of mere descriptiveness.¹⁰

Specifically, Applicant argues that the notice of opposition contains “no factual matter as to what the relevant public is or how it would understand the applied-for mark. ... Opposer states nothing more than the unsupported and conclusory claim that Opposer and some others may use ‘xNand,’ but does not allege how Applicant’s mark X-NAND constitutes the class or category of the goods at issue to the relevant public.”¹¹ Also, Applicant asserts that the opposition “contains virtually no factual matter assessing how Applicant’s mark in its entirety, X-NAND, describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods...”¹² Moreover, Applicant argues that Opposer lacks standing¹³ to maintain the opposition proceeding because Opposer fails to show a “real interest,” or in other words, a “direct and personal stake” in the outcome of the proceeding.¹⁴

⁹ *Id.* at 5.

¹⁰ *Id.* at 3.

¹¹ *Id.* at 6.

¹² *Id.* at 4.

¹³ Our decisions previously have analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” However, mindful of the Supreme Court’s direction in *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), we now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

¹⁴ *Id.* at 6.

Opposer responds by contending that it does not bear the burden of proving its case at the outset of the Notice of Opposition. *See NSM Research Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1032 (TTAB 2014).¹⁵ Opposer responds that “all well-pleaded, material allegations must be accepted as true and liberally construed in [Opposer’s] favor.”¹⁶ Opposer asserts that the allegations included in the opposition referencing that the term NAND is commonly used within the semiconductor memory industry as sufficient allegations to raise a plausible claim of genericness.¹⁷

Opposer specifically references the following allegations to contend that Opposer has sufficiently alleged that Applicant’s mark is merely descriptive:

4. The term NAND is a generic term commonly used within the semiconductor memory industry, and the electronics industry in general, with respect to semiconductor memory products.¹⁸
5. In the semiconductor memory industry there are two main types of flash memory, which are named after the NAND and NOR logic gates. NAND, which is short for “not and,” gate memory is primarily used in memory cards, USB flash drives, solid-state drives, and similar products, for the general storage and transfer of data. NOR, which is short for “not or,” gate memory allows true random access and therefore direct code execution and is used as a replacement for the older EPROM devices and as an alternative to certain kinds of ROM applications.¹⁹
6. Manufacturers of NAND flash memory, including Opposer, often use the term “xNAND” in reference to NAND flash memory products where “x” is a place holder for a specific model number or type of NAND.²⁰

¹⁵ 6 TTABVUE 3.

¹⁶ *Id.*

¹⁷ *Id.* at 9.

¹⁸ 1 TTABVUE 4, ¶4.

¹⁹ *Id.*, ¶5.

²⁰ *Id.* at 5, ¶6.

10. Applicant explicitly admitted that “NAND is an industry term used for a type of flash memory storage.” Applicant also indicated that “X” can be merely shorthand for “express.” Thus, X-NAND merely describes the products offered under the mark—namely, increased speed NAND flash memory. Despite these admissions, the Examining Attorney allowed the Application to proceed to publication without any disclaimer.²¹
11. Upon information and belief, Applicant’s mark, X-NAND, has not been used in U.S. commerce and has not acquired secondary meaning.²²

Lastly, in reference to “entitlement to a statutory cause of action,” Opposer replies that all is needed is a ‘real interest’ and a reasonable basis for its belief that Opposer may be damaged.²³ Opposer includes the following: “[w]hen an opposition raises issues of descriptiveness or genericness, a party adequately alleges standing by pleading that it engages in the sale of the same, or similar, products to those identified in the application and has an interest in using the contested term descriptively in its business.”²⁴

II. MOTION TO DISMISS

a. Standard

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted tests only the legal sufficiency of a complaint, not the sufficiency of the evidence that might be adduced. *Advanced Cardiovascular Sys., Inc. v. SciMedLife Sys., Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993);

²¹ *Id.* at 6, ¶10.

²² *Id.* at 6, ¶11,

²³ TBMP § 303.03.

²⁴ 6 TTABVUE 4. See TBMP § 309.03(b) citing amongst others, *Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 WL 460354, at *4-5 (TTAB 2019) (standing established because parties are competitors in the power saw blade industry).

Covidien LP v. Masimo Corp., 109 USPQ2d 1696, 1697 (TTAB 2014). A complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that: (1) the plaintiff has standing to maintain the proceeding; and, in the case of an opposition proceeding, (2) a valid ground exists for denying the registration sought. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). *See also* TBMP § 309.03(c).

To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). The Board examines the complaint in its entirety, construing the allegations therein liberally so as to do substantial justice to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought. *See* Fed. R. Civ. P. 8(e); *IdeasOne, Inc. v. Nationwide Better Health, Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). *See also* TBMP § 503.02.

For purposes of determining the motion, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to the plaintiff. *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010). However, a plaintiff is not required to prove its case in its complaint. *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 (TTAB 2016); *see also* *Advanced Cardiovascular Sys.*, 26 USPQ2d at 1041.

b. Entitlement to Statutory Cause of Action

To establish entitlement to a statutory cause of action under Sections 13 or 14 of the Trademark Act, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. *Empresa Cubana v. General Cigar*, 111 USPQ2d at 1062 (citations omitted); *see Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). To meet the “real interest” requirement for entitlement an opposer must have a legitimate personal interest or a direct personal stake in the outcome of the opposition. *Ritchie*, 50 USPQ2d at 1025-26.

Opposer has sufficiently expressed its entitlement to a statutory cause of action by alleging that it is a potential competitor to Applicant by manufacturing and marketing similar, if not identical, goods in the semiconductor memory industry. Opposer does not need to own a pending application for the mark, does not have to be using the term as a mark, or even use the term at all, in order to establish

entitlement. *See Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 23 USPQ2d 1878, 1879 (TTAB 1992), *aff'd* 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993). Moreover, once entitlement on the grounds of mere descriptiveness have been established, Opposer has the right to assert any other legally sufficient ground. *See Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011).

c. Genericness

In a Board proceeding, to sufficiently plead a claim of genericness, a plaintiff must allege that (i) the wording or phrase at issue is widely used generically to identify or describe the genus of the identified goods and/or services in the opposed application or registration sought to be cancelled, and that (ii) consumers primarily understand the wording to be the generic name or identifier of the genus of goods or services. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). The plaintiff may also allege that the designation at issue is a generic adjective that names some distinctive characteristic or purpose of that genus of goods or services identified *See Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 195 USPQ 281, 285 (7th Cir. 1977) (“The fact that ‘light’ is an adjective does not preclude it from being a generic or common descriptive word” as applied to beer) (cited in *Sheetz of Delaware, Inc.*, 108 USPQ2d 1341 (TTAB 2013) (finding that ‘footlong’ identified a type or category of sandwich)).

Applicant fails to allege that X-NAND is understood to refer to a genus of semiconductor memories and/or that the relevant public understands the X-NAND mark

to refer to a genus of semiconductor memory goods or to, alternatively, allege that the mark is a generic adjective that describes a characteristic or purpose of the listed goods. Specifically, Opposer references that NAND is a generic term commonly used in the semiconductor memory industry, however, Opposer does not indicate that X-NAND is used to refer to a genus of Applicant's goods.²⁵ Rather, at most, Opposer alleges that "x-NAND" is descriptive of an increased speed NAND flash memory device.

Accordingly, the Board agrees with Applicant's assertion that "the Notice of Opposition contains no [] allegations to support the conclusion that the X-NAND mark is generic with respect to the goods stated in the application."²⁶ Opposer has not sufficiently asserted allegations to warrant a claim of genericness. Moreover, pursuant to Fed. R. Civ. P. Rule 8, the Board notes that all claims must be stated in the pleadings. Fed. R. Civ. P. 8(a).

In view of the foregoing, Applicant's motion to dismiss Opposer's claim as to the genericness claim is **GRANTED**. However, if Opposer believes sufficient grounds exist to re-plead its genericness claim pursuant to Trademark Act Sections 1, 2 and 45, Opposer is allowed TWENTY DAYS from the mailing date of this order to file an amended pleading that satisfies the requirements of claiming genericness, failing which the genericness claim will be given no further consideration.

²⁵ 1 TTABVUE.

²⁶ 4 TTABVUE 6.

d. Merely Descriptiveness Claim

The above-referenced allegations sufficiently allege that the mark is merely descriptive and that Opposer is engaged in manufacturing and marketing the same or related goods as those listed in Applicant’s application. Specifically, the below-listed allegation asserts a claim of mere descriptiveness.²⁷ Based on these findings, Opposer has sufficiently pleaded mere descriptiveness. Applicant’s motion to dismiss, as to the alleged failure to state a plausible claim of descriptiveness, is **DENIED**.

III. SCHEDULE

Proceedings are resumed on the schedule set forth below:

Time to Answer	April 19, 2021
Deadline for Discovery Conference	May 19, 2021
Discovery opens	May 19, 2021
Initial Disclosures Due	June 18, 2021
Expert Disclosures Due	October 16, 2021
Discovery Closes	November 15, 2021
Opposer’s Pretrial Disclosures Due	December 30, 2021
Opposer’s 30-day Trial Period Ends	February 13, 2022
Applicant’s Pretrial Disclosures Due	February 28, 2022
Applicant’s 30-day Trial Period Ends	April 14, 2022
Opposer’s Rebuttal Disclosures Due	April 29, 2022
Opposer’s 15-day Rebuttal Period Ends	May 29, 2022
BRIEFS ARE DUE AS FOLLOWS:	
Opposer’s Opening Brief Day	July 28, 2022
Applicant’s Brief Due	August 27, 2022
Opposer’s Reply Brief Due	September 11, 2022
REQUEST FOR ORAL HEARING:	
Deadline to Request Oral Hearing (optional):	September 21, 2022

²⁷ “Applicant explicitly admitted that “NAND is an industry term used for a type of flash memory storage.” Applicant also indicated that ‘X’ can be merely shorthand for ‘express.’ Thus, X-NAND potentially describes the products offered under the mark - namely, increased speed NAND flash memory.” 1 TTABVUE 6, ¶10.

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).
