

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

LTS

August 16, 2021

Opposition No. 91267934 (Parent)
Opposition No. 91267935
Opposition No. 91270637

The Comphy Co.

v.

Cozy Comfort Company LLC

By the Trademark Trial and Appeal Board:

This case comes up on: (1) Opposer/Counterclaim Defendant's motion, filed May 11, 2021, to dismiss the counterclaim for failure to state a claim upon which a relief may be granted in Opposition No. 91267934 ("the '934 Opposition"); and (2) Opposer/Counterclaim Defendant's motion, filed May 11, 2021, to dismiss the counterclaim for failure to state a claim upon which a relief may be granted in Opposition No. 91267935 ("the '935 Opposition"). Both motions are contested.

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. Relevant Background

A. Opposition No. 91267934

On March 2, 2021, Opposer filed a notice of opposition in the '934 Opposition, opposing registration of Applicant's mark THE COMFY DREAM, in standard characters, for "blanket throws, namely, whole body blankets" in International Class 24.¹ Opposer pleads prior use and ownership of Registration No. 3479190 for the mark



COMPHY for "linens and bedding for health spas, namely, towels, pads in the nature of bed pads, mattress pads and table pads, sheets, duvets, comforters, pillow cases, pillow shams, and table skirts" in International Class 24 and "robes for health spas" in International Class 25² and application Serial No. 87863035 for the mark COMPHY, in standard characters, for "linens and bedding, namely, towels, sheets, duvets, comforters, pillow cases, pillow shams" in International Class 24 and "robes" in International Class 25.³ '934 Opposition, 1 TTABVUE 4, ¶¶ 3-4 and 8-10, ¶¶ 18-26. Opposer further alleges prior use of "a family of COMPHY marks, including, for example, COMPHY BED AND BATH, COMPHY BABY, COMPHY FOR HOME, COMPHY FOR PROFESSIONALS, COMPHY TOUCH, COMPHY COLLECTION in connection with a wide range of goods and services, including linens and bedding,

¹ Application Serial No. 90011775, filed June 19, 2020, based on use of the mark in commerce under Section 1(a) of the Trademark Act. The recited goods in International Class 25 ("wearable blankets in the nature of blankets with sleeves; anoraks") are unopposed.

² Issued August 5, 2008; renewed.

³ Filed April 4, 2018, based on use of the mark in commerce under Section 1(a) of the Trademark Act.

blankets, towels, bed pads, mattress pads and table pads, sheets, duvets, comforters, pillows, pillow cases, pillow shams, table skirts and robes.” *Id.* at 9, ¶ 23. Opposer asserts claims of likelihood of confusion, dilution, and lack of a bona fide intent to use. *Id.* at 11-13, ¶¶ 34-42.

On April 10, 2021, Applicant filed an answer and a counterclaim to cancel Opposer’s pleaded registration. ’934 Opposition, 5 TTABVUE. *See* Trademark Rule 2.106(b)(2). Applicant denies the salient allegations of the notice of opposition, pleads four affirmative defenses, and seeks cancellation of Opposer’s registration on the ground of abandonment. *Id.*

On May 11, 2021, in lieu of an answer to the counterclaim, Opposer filed a motion to dismiss Applicant’s counterclaim. ’934 Opposition, 7 TTABVUE.

B. Opposition No. 91267935

On March 2, 2021, Opposer filed a notice of opposition in the ’935 Opposition, opposing registration of Applicant’s mark THE COMFY TEDDY BEAR, in standard characters, for “blanket throws, namely, whole body blankets” in International Class 24.⁴ Opposer pleads the same prior use of marks and ownership of the same registration and application as pleaded in the ’934 Opposition. ’935 Opposition, 1 TTABVUE. Opposer asserts claims of likelihood of confusion, dilution, and lack of a bona fide intent to use. *Id.* at 10-12, ¶¶ 33-40.

⁴ Application Serial No. 90011777, filed June 19, 2020, based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act. The recited goods in International Class 25 (“wearable blankets in the nature of blankets with sleeves; anoraks”) are unopposed.

On April 10, 2021, Applicant filed an answer and a counterclaim to cancel Opposer's pleaded registration. '935 Opposition, 5 TTABVUE. *See* Trademark Rule 2.106(b)(2). Applicant denies the salient allegations of the notice of opposition, pleads four affirmative defenses, and seeks cancellation of Opposer's registration on the ground of abandonment. *Id.*

On May 11, 2021, in lieu of an answer to the counterclaim, Opposer filed a motion to dismiss Applicant's counterclaim. '935 Opposition, 7 TTABVUE.

C. Opposition No. 91270637

On July 22, 2021, Opposer filed a notice of opposition in Opposition No. 91270637 ("the '637 Opposition"), opposing registration of Applicant's mark #LOVEMYCOMFY, in standard characters, for "blanket throws, namely, whole body blankets" in International Class 24.⁵ Opposer pleads the same prior use of marks and ownership of the same registration and application as pleaded in the '934 and '935 Oppositions. '637 Opposition, 1 TTABVUE. Opposer asserts claims of likelihood of confusion, dilution, and lack of a bona fide intent to use. *Id.* at 14-16, ¶¶34-41. Applicant's deadline to file its answer is August 31, 2021.⁶ '637 Opposition, 2 TTABVUE 3.

II. Consolidation

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and

⁵ Application Serial No. 90011768, filed June 19, 2020, based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act.

⁶ Applicant's notice of appearance, filed August 6, 2021, is noted, and the Board's records have been updated accordingly.

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2021). *See Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. *See World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264.

The parties to the '934, '935, and '637 Oppositions are the same, and the involved marks, allegations, and claims are similar or identical. For these reasons, the Board finds that consolidation is appropriate. *Venture Out Props. LLC*, 81 USPQ2d at 1889 (consolidation ordered on the Board's own initiative). Accordingly, the '934, '935, and '637 Oppositions are consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '934 Opposition as the "parent case." As a general rule, from this point on, the parties should no longer file separate papers in

connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order. Because the involved proceedings, however, are consolidated prior to joinder of the issues in the proceedings, the parties should file a separate pleading (such as an amended notice of opposition and answer) for each opposition before commencing the practice of filing a single copy of any paper in the parent case.⁷

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

III. Opposer's Motions to Dismiss

A. Applicable Standard

A motion to dismiss brought pursuant to Rule 12(b)(6) for failure to state a claim upon which relief can be granted is a means of testing the sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *see also* TBMP § 503.02. To state a claim upon which relief can be granted, Applicant need only allege such facts which, if proved, would establish that Applicant is entitled to the relief sought; that is, (1) Applicant has an entitlement to a statutory cause of action, and (2) a valid statutory ground

⁷ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

exists for cancelling the pleaded registration at issue.⁸ *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

For purposes of determining Opposer's motions to dismiss, the counterclaim must be examined in its entirety, construing the allegations therein "so as to do justice," as required by Fed. R. Civ. P. 8(e), to determine whether it contains allegations which, if proved, would entitle the Applicant to the relief sought. *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo*, 85 USPQ2d at 1538.

B. Analysis

Because the notices of opposition in the '934 and '935 Oppositions are substantially similar, the Board addresses the two motions to dismiss together.

1. Statutory Cause of Action

To sufficiently allege an entitlement to a statutory cause of action within the meaning of Section 14 of the Trademark Act, a plaintiff must plead facts sufficient to show that it has a direct and personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Applicant seeks to assert a counterclaim against Opposer's pleaded registration in the '934 and '935 Oppositions. Because Applicant is the defendant in the opposition, it has an entitlement to a

⁸ The Board's decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), the Board now refers to this inquiry as entitlement to a statutory cause of action. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020). Despite the change in nomenclature, the Board's prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

statutory cause of action sufficient to bring counterclaims against Opposer's pleaded registration. *Johnson & Johnson v. Obschestvo s Ogranitchennoy*, 104 USPQ2d 2037, 2038 (TTAB 2012).

2. Abandonment

Under Trademark Act Section 45, "a mark shall be deemed to be abandoned when its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment." 15 U.S.C. § 1127 (cleaned up).⁹ A plaintiff asserting a claim of abandonment must plead that the defendant is not using the involved mark with its goods and/or services, and intends not to resume use.¹⁰ *Id.*; *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1018 (TTAB 2019). No more is necessary for a legally sufficient abandonment claim. *Lewis Silkin*, 129 USPQ2d at 1020 (specifically rejecting the argument that an abandonment claim must include additional allegations demonstrating how a plaintiff will prove the allegations of nonuse plus intent not to resume use).

In support of its abandonment counterclaim in the '934 Opposition, Applicant alleges, inter alia:

47. On July 4, 2007, Opposer filed U.S. Trademark Application Serial No. 77/222,051, in international class 025 for "Robes for health spas" ('Opposer's Robe Goods') and also in international class 024 for "Linens

⁹ The parenthetical "cleaned up" is used to eliminate the unnecessary explanation of non-substantive alterations, such as changes in capitalization, and removal of internal quotation marks, brackets, ellipses, internal citations, and duplicate parentheticals.

¹⁰ An allegation of "no intent to resume use" is equivalent to the statutory language of "intent not to resume use" for an abandonment claim. *Lewis Silkin*, 129 USPQ2d 1018-19 (citations omitted).

and bedding for health spas, namely towels, pads, sheets, duvets, comforters, bolsters, pillows, pillow cases, pillow shams, and table skirts,” for a design mark with the literal element “THE C OMPHY CO.”, as shown below (the “Original Mark”):



48. On April 2, 2008, Opposer filed a Response to Office Action, amending the class 024 goods to read: “Linens and bedding for health spas, namely, towels, pads in the nature of bed pads, mattress pads and table pads, sheets, duvets, comforters, pillow cases, pillow shams, and table skirts” (collectively ‘Opposer’s Linen and Bedding Goods’) (Opposer’s Linen and Bedding Goods and Opposer’s Robe Goods are hereinafter, collectively, referred to as ‘Opposer’s Goods’).

49. On August 5, 2008, Registration ‘190 issued on the Original Mark.

50. On February 20, 2014, Opposer filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 for Registration ‘190.

51. On information and belief, in March 2017, Opposer began using in connection with Opposer’s Goods a design mark with the literal element C OMPHY (the “Amended Mark”), as shown below:



52. On information and belief, Opposer discontinued its use of the Original Mark in March 2017 when it began using the Amended Mark instead of the Original Mark.

53. On information and belief, Opposer had an intent not to resume use of the Original Mark when it began using the Amended Mark.

54. The time period to submit Section 8 and 9 filings for Registration ‘190 opened on August 5, 2017.

55. On July 26, 2018, Opposer filed a Section 7 Request Form, requesting that the USPTO amend the drawing for Registration '190 to the Amended Mark.

56. Also on the same date, July 26, 2018, and before receiving a response to its Section 7 Request, Opposer filed a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9 (the 'Section 8 & 9 Filing'), claiming use only of the Amended Mark.

57. In the Section 8 & 9 Filing, the specimens did not show use of the Original Mark.

58. In the Section 8 & 9 Filing, Opposer did not claim any use or excusable non-use of the Original Mark.

59. On September 4, 2018, the USPTO responded to the Section 7 Request, noting that an amendment of the disclaimer of "CO." in Registration '190 had not been submitted and requiring Opposer to submit such an amendment.

60. On September 14, 2018, Opposer responded by submitting a disclaimer of "CO." and stating that the Amended Mark was a "modernized amended version of" the Original Mark.

61. On November 14, 2018, the USPTO accepted the Section 8 and 9 filings. 62. On December 18, 2018, a new registration certificate was issued for Registration '190 bearing the Amended Mark.

...

65. Opposer abandoned the Original Mark.

66. Opposer discontinued use of the Original Mark with intent not to resume such use.

...

68. Opposer failed to use the Original Mark for a period of at least three years.

69. Opposer discontinued use of the Original Mark at least as early as March 2017, over four ago, when it began using the Amended Mark.

70. During the period extending from at least as early as March 2017 to the time of this filing, Opposer has not used – continuously or otherwise - the Original Mark.

71. Opposer has intended not to resume use of the Original Mark.

72. By using the Amended Mark in commerce, in place of the Original Mark, Opposer has demonstrated intent not to resume use of the Original Mark.

73. Opposer's request to amend the drawing of Registration '190 from the Original Mark to the Amended Mark further demonstrates an intent not to resume use of the Original Mark.

74. The Amended Mark is a material alteration of the Original Mark.

75. Use of a material alteration of the Original Mark precludes any priority between the Amended Mark and the Original Mark.

76. The Amended Mark and the Original Mark create different commercial impressions.

77. The Amended Mark and the Original Mark do not create essentially the same commercial impression.

78. The Amended Mark materially differs from or alters the character of the Original Mark.

...

88. Opposer improperly requested amendment of the drawing of Registration '190 from the Original Mark to the Amended Mark.

89. The USPTO erred in allowing amendment of the drawing of Registration '190 from the Original Mark to the Amended Mark.

90. As a result of its prolonged non-use with intent not to use the Original Mark, Opposer abandoned the Original Mark and Registration '190

5 TTABVue 6-11. Applicant makes substantially similar allegations in the '935 Opposition. '935 Opposition, 6-11, ¶¶ 45-88.

Applicant's allegations are sufficient to plead an abandonment claim.¹¹ *Lewis Silkin*, 129 USPQ2d at 1020.

In view of the foregoing, Opposer's motions to dismiss the counterclaim in the '934 and '935 Opposition for failure to state a claim are **denied**.

IV. Sua Sponte Review of Opposer's Notices of Opposition and Applicant's Answers

In the interest of efficiency, the Board has reviewed the sufficiency of the operative pleadings in the '934, '935, and '637 Oppositions. *NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may sua sponte dismiss any insufficiently pleaded pleading).

A. Opposer's Notices of Opposition

1. Opposer's Entitlement to a Statutory Cause of Action

Opposer alleges, inter alia: (1) prior use and ownership of Registration No.



3479190 for the mark C O M P H Y for "linens and bedding for health spas, namely, towels, pads in the nature of bed pads, mattress pads and table pads, sheets, duvets, comforters, pillow cases, pillow shams, and table skirts" in International Class 24 and "robes for health spas" in International Class 25 and application Serial No. 87863035

¹¹ The Board notes that the granting of Opposer's request for renewal of the registration by the Post-Registration Division of the Patent and Trademark Office does not deprive Applicant of its right to petition for cancellation of the registration on grounds of abandonment and to have its claim determined by the Board. See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1131-34 (Fed. Cir. 2015) (fundamental inquiry is whether original mark and amended mark create same continuing commercial impression).

for the mark COMPHY, in standard characters, for “linens and bedding, namely, towels, sheets, duvets, comforters, pillow cases, pillow shams” in International Class 24 and “robes” in International Class 25 (’934 Opposition, 1 TTABVUE 4, ¶¶ 3-4 and 8-10, ¶¶ 18-26; ’935 Opposition, 1 TTABVUE 4, ¶¶ 3-4 and 8-10, ¶¶ 18-26; ’637 Opposition, 1 TTABVUE 5, ¶¶ 3-4 and 8-13, ¶¶ 17-26); (2) that Opposer will be damaged by registration of the involved application (’934 Opposition, 1 TTABVUE 11, ¶ 35 and 13, ¶ 42; ’935 Opposition, 1 TTABVUE 10-11, ¶ 34 and 12, ¶ 40; ’637 Opposition, 1 TTABVUE 14, ¶¶ 35 and 16, ¶ 41); and (3) that the marks of the parties are similar and confusion is the likely result (’934 Opposition, 1 TTABVUE 11, ¶ 35; ’935 Opposition, 1 TTABVUE 10-11, ¶ 34; ’637 Opposition, 1 TTABVUE 14, ¶ 35). Opposer therefore has sufficiently pleaded its entitlement to a statutory cause of action in the ’934, ’935, and ’637 Oppositions.¹² *See Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (plausible claim of priority and likelihood of confusion sufficient to plead standing).

2. Likelihood of Confusion

To plead a sufficient claim under Section 2(d) of the Trademark Act, only a general allegation of likelihood of confusion is required. *See The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1639 n.21 (TTAB 2007) (“Opposer is not required to specifically plead every factual component of a likelihood of confusion claim.”).

¹² Where a plaintiff has alleged an entitlement to a statutory cause of action as to at least one properly pleaded ground, its allegation of an entitlement to a statutory cause of action satisfies the requirement for any other legally sufficient ground. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) (“[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”).

The Board finds that Opposer has sufficiently pleaded a claim for likelihood of confusion in that it alleges that it has priority in its individual COMPHY marks ('934 Opposition, 1 TTABVUE 9, ¶ 23; '935 Opposition, 1 TTABVUE 8-9, ¶ 23; '637 Opposition, 1 TTABVUE 9-10, ¶¶ 22); and Applicant's mark so closely resembles Opposer's pleaded marks that consumers are likely to be confused as to the source of origin of Applicant's goods or the affiliation between Opposer and Applicant ('934 Opposition, 1 TTABVUE 11, ¶ 35; '935 Opposition, 1 TTABVUE 10-11, ¶ 34; '637 Opposition, 1 TTABVUE 14, ¶ 35).

To the extent, however, Opposer intended to plead a "family" of COMPHY marks in the '934, '935, and '637 Oppositions, the pleading is insufficient. To plead ownership of a family of marks, a plaintiff must allege the following: "(1) prior use of marks sharing a recognizable common characteristic; (2) that the common characteristic is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark); and (3) that prior to the defendant's first use (or constructive first use) of its involved mark, plaintiff's marks have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition among the purchasing public such that the common characteristic is itself indicative of a common origin of the goods or services." *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016). Opposer has not pleaded the requisite elements for a family of marks. The Board addresses Opposer's leave to replead below.

3. Dilution

The ESTTA coversheet in the '934, '935, and '637 Oppositions each identifies dilution by blurring and dilution by tarnishment as pleaded claims. Although the content of the ESTTA coversheet is read in conjunction with the notice of opposition as an integral component, *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1927-28 (TTAB 2005), the mere mention of a ground on the coversheet is insufficient to state a claim. *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013) (internal citation omitted).

To prevail on a dilution claim, Opposer must show that: (1) it owns a famous mark that is distinctive; (2) Applicant is using, or intends to use, a mark in commerce that allegedly dilutes Opposer's famous mark; (3) Applicant's use of its mark began, or the filing date of its intent to use application, is after Opposer's mark became famous; and (4) Applicant's use of its mark is likely to cause dilution by blurring or by tarnishment. *Coach Services Inc.*, 101 USPQ2d at 1723-24.

Here, Opposer has not sufficiently pleaded a claim for dilution by blurring in the '934 Opposition or dilution by tarnishment in the '934, '935, or '637 Oppositions. Opposer alleges that: (1) it owns a famous mark that is distinctive ('934 Opposition, 1 TTABVUE 10, ¶¶25-26; '935 Opposition, 1 TTABVUE 9, ¶¶ 25-26; '637 Opposition, 10, ¶ 24 and 13, ¶ 26); (2) Applicant is using a mark in commerce that allegedly dilutes Opposer's famous mark ('934 Opposition, 1 TTABVUE 11-12, ¶ 37; '935 Opposition, 1 TTABVUE 11, ¶ 36; '637 Opposition, 1 TTABVUE 14-15, ¶ 37); (3) Opposer's mark was famous "prior to the filing date" of the involved application

Opposition Nos. 91267934, 91267935, and 91270637

in each of the '934, '935, and '637 Oppositions ('934 Opposition, 1 TTABVUE 10, ¶ 26; '935 Opposition, 1 TTABVUE 9, ¶ 26; '637 Opposition, 1 TTABVUE 13, ¶ 26); and (4) Applicants' use of its mark is likely to cause dilution ('934 Opposition, 1 TTABVUE 11-12, ¶ 37; '935 Opposition, 1 TTABVUE 11, ¶ 36; '637 Opposition, 1 TTABVUE 14-15, ¶ 37).

The involved applications in the '935 and '637 Oppositions were filed under Section 1(b) of the Trademark Act based on Applicant's intent to use the marks in commerce, and Opposer's pleading of dilution by blurring in the '935 and '637 Opposition is sufficient. The involved application in the '934 Opposition was filed under Section 1(a) of the Trademark Act based on Applicant's use of the mark in commerce, and Opposer does not allege that its mark became famous prior to Applicant's first use of its applied-for mark in the '934 Opposition, which may be different from the date of first use alleged in the application. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001) (“[T]he party alleging fame must show that the mark had become famous prior to the applicant's use of the mark.”); *see also Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1297 (TTAB 2016). Accordingly, Opposer's claim for dilution by blurring in the '934 Opposition is insufficiently pleaded.

Furthermore, to the extent Opposer also intended to plead dilution by tarnishment, such a claim requires an allegation that the “association arising from the similarity between a mark or trade name and a famous mark ... harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C). Because Opposer does not

allege in the text of the notice of opposition in the '934, '935, or '637 Opposition that Applicant's involved mark would damage its reputation, the Board finds that there is no pleaded claim of dilution by tarnishment.

Accordingly, Opposer's dilution by blurring claim in the '934 Opposition and dilution by tarnishment claim in the '934, '935, and '637 Oppositions are **dismissed without prejudice**. The Board addresses Opposer's leave to replead below.

4. Lack of a Bona Fide Intent to Use in the '934 Opposition

Opposer labels its third count in the '934 Opposition as "Section 1(b)" and alleges:

39. The specimen filed in Application No. 90/011,775 does not support International Class 24 because it is properly considered clothing in International Class 25 and is not within the Class 24 explanatory note of "mainly fabrics and fabric covers for household use.

40. The portion of Application No. 90/011,775 in International Class 24 is invalid and null and void, ab initio under Section 1 (b) of the Trademark Act, 15 USC §§1051 and 1063. Further, the examining attorney may amend or correct classification through an examiner's amendment, without prior authorization by the applicant. ... The USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys. ... The Board thus has authority to amend or correct the incorrect classification if it is not first done by the examining attorney.

41. The specimen filed in Application No. 90/011,775 is only properly classified under International Class 25 as "wearable blankets with sleeves."

42. The Comphy Company is likely to be damaged by the registration of Applicant's mark in International Class 24 for "Blanket throws, namely, whole body blankets".

1 TTABVUE 12-13, ¶¶ 39-42 (citation omitted).

Opposer refers to a lack of a bona fide intent to use claim on the ESTTA cover sheet to its pleading. Because the involved application was filed based on use in

commerce under Trademark Act Section 1(a), the claim that Applicant lacked a bona fide intent to use the subject mark in commerce for the services under Trademark Act Section 1(b) does not state a claim for which relief can be granted. Applicant was not required to assert a bona fide intention to use the mark in commerce in connection with the filing of its use-based application. *Compare* Trademark Act Section 1(a) with Trademark Act Section 1(b), Section 44(d)(2), Section 44(e), and Section 66(a). Because this defect cannot be cured by amendment of the pleadings, the Board **dismisses with prejudice** the putative lack of bona fide intent claim in the '934 Opposition. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01.

Although Opposer refers to a lack of a bona fide intent to use claim on the ESTTA cover sheet to its pleading, Opposer actually alleges that the specimens of use of record in the opposed application do not show use of the applied-for mark in connection with the goods and services identified in the application. It is well-established that alleged examination error is not a ground for opposition. *See Century 21 Real Estate v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989). To sufficiently allege a claim of nonuse for a use-based application such as Applicant's in the '934 Opposition, the plaintiff must allege that the subject mark was not used in commerce in connection with the recited goods and/or services as of the filing date of the use-based application. *See* 15 U.S.C. § 1051(a); *see also Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013) (discussing summary judgment motion on claim that applicant had not made bona fide use of its mark in commerce as of the filing date of applicant's use-based application). Here, Opposer has merely alleged

that the specimens fail to show use of Applicant's mark. In view thereof, Opposer has also failed to set forth a claim for nonuse in the '934 Opposition. The Board addresses Opposer's leave to replead a nonuse claim below.

5. Lack of a Bona Fide Intent to Use in the '935 and '637 Oppositions

Opposer labels its third count in the '935 and '637 Oppositions as "Section 1(b)" and alleges in the '935 Opposition:

38. Applicant's goods, as evidenced by Applicant's history and Applicant's own web page, do not support International Class 24 because they are properly considered clothing in International Class 25 and is not within the Class 24 explanatory note of "mainly fabrics and fabric covers for household use." Applicant has no goods without hoods and sleeves and does not intend to sell non-apparel linens.

39. The portion of Application No. 90/011,777 in International Class 24 is invalid and null and void, ab initio under Section 1 (b) of the Trademark Act, 15 USC §§1051 and 1063. Further, the examining attorney may amend or correct classification through an examiner's amendment, without prior authorization by the applicant. ... The USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys. ... The Board thus has authority to amend or correct the incorrect classification if it is not first done by the examining attorney.

'935 Opposition, 1 TTABVUE 11-12. And in the '637 Opposition, Opposer alleges:

38. ... "#LOVEMYCOMFY" mark as shown in U.S. Application No. 90/011,768 to be used in Class 24 because Applicant's products are all properly considered clothing in International Class 25 and is not within the Class 24 explanatory note of "mainly fabrics and fabric covers for household use.

39. Application No. 90/011,768 in International Class 24 is invalid and null and void, ab initio under Section 1 (b) of the Trademark Act, 15 USC §§1051 and 1063. Further, the examining attorney may amend or correct classification through an examiner's amendment, without prior authorization by the applicant. ... The USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys. ... The Board thus has authority to amend or

correct the incorrect classification if it is not first done by the examining attorney.

40. When Applicant files specimen that includes a hood, pockets and/or sleeve to demonstrate use in Application No. 90/011,768, such a specimen will only support and is only properly classified under International Class 25 as “wearable blankets with sleeves.”

'637 Opposition, 1 TTABVUE 15, ¶¶ 38-40.

The classification of goods is a purely administrative matter within the sole discretion of the USPTO and “is wholly irrelevant to the issue of registrability under Section 1052(d), which makes no reference to classification.” *In re Detroit Athletic Club*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (citing *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993)). The Board will not review an examiner’s classification of the goods. *In re Faucher Indus., Inc.*, 107 USPQ2d 1355, 1357 (TTAB 2013). An examining attorney’s ex parte acceptance of a particular identification or classification of the goods at the intent to use stage is not a proper basis for an opposition. Whether Applicant’s goods in this instance are misclassified does not serve as the basis for a claim of lack of bona fide intent to use the mark in commerce. Accordingly, Opposer’s lack of bona fide intent to use claim in the '935 and '637 Oppositions is **dismissed without prejudice**. The Board addresses Opposer’s leave to replead below.

B. Applicant’s Affirmative Defenses

1. Applicable Standard

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. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP § 506.01.

Motions to strike are not favored, and as such, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *Id.* 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).

**2. Applicant's First and Fourth Affirmative Defenses:
Amplification of Applicant's Denials**

For its first affirmative defense in the '934 and '935 Oppositions, Applicant alleges that “[n]o likelihood of confusion exists between Applicant’s use of its marks and Opposer’s use of its alleged marks.” ’934 Opposition, 5 TTABVUE 6, ¶ 43; ’935 Opposition, 5 TTABVUE 6, ¶41. For its fourth affirmative defense in the ’934 and ’935 Oppositions, Applicant alleges that “Opposer’s claims fail to satisfy the standard for dilution as set forth in 15 U.S.C. § 1125 because its marks are not famous.” ’934 Opposition, 5 TTABVUE 6, ¶ 46; ’935 Opposition, 5 TTABVUE 6, ¶ 44. These are not true affirmative defenses, but to the extent they amplify the denials in Applicant’s answer, they are permissible. *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.11 (TTAB 2015).

**3. Applicant's Second and Third Affirmative Defenses:
Unclean Hands, Laches, Estoppel, and/or Acquiescence**

For its second affirmative defense in the '934 and '935 Oppositions, Applicant alleges that "Opposer's claims are barred by the doctrine of unclean hands." '934 Opposition, 5 TTABVUE 6, ¶ 44; '935 Opposition, 5 TTABVUE 6, ¶ 42. For its third affirmative defense in the '934 and '935 Oppositions, Applicant alleges that "[t]he requested relief is barred by the equitable doctrine of laches, estoppel, and/or acquiescence." '934 Opposition, 5 TTABVUE 6, ¶ 45; '935 Opposition, 5 TTABVUE 6, ¶ 43.

Applicant's second and third affirmative defenses consist of bald conclusory allegations of unclean hands, laches, estoppel, and acquiescence, which are legally insufficient because they do not provide Opposer with fair notice of the factual bases for the defenses. Fed. R. Civ. P. 8(b)(1) and 12(f); *see e.g., IdeasOne Inc.*, 89 USPQ2d at 1953; *Fair Indigo LLC*, 85 USPQ2d at 1538; *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1980); *see also* TBMP § 311.02(b) ("The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense."). Accordingly, Applicant's second and third defenses in the '934 and '935 Oppositions are **stricken**.¹³

¹³ The affirmative defenses of laches, acquiescence, and estoppel generally are not applicable in opposition proceedings because these defenses start to run from the time a mark is published for opposition, not from the time of knowledge of use. *See Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara's Bakery*, 82 USPQ2d at 1292 n.14.

V. Proceedings Suspended

The Board notes that Opposer and Applicant are also parties to Opposition Nos. 91249807 (“the ’807 Opposition”) and 91249809 (“the ’809 Opposition”). In the ’807 Opposition, Opposer filed a notice of opposition, opposing registration of Applicant’s mark COMFY LONG, in standard characters, for “blanket throws, namely, whole body blankets” in International Class 24.¹⁴ Opposer pleads the same prior use of marks and ownership of the same registration and application as pleaded in the ’934, ’935, and ’637 Oppositions. ’807 Opposition, 1 TTABVUE. Opposer asserts claims of likelihood of confusion and dilution. *Id.*

In the ’809 Opposition, Opposer filed a notice of opposition, opposing registration of Applicant’s mark COMFY LITE, in standard characters, for “blanket throws, namely, whole body blankets” in International Class 24.¹⁵ Opposer pleads the same prior use of marks and ownership of the same registration and application as pleaded in the ’934, ’935, and ’637 Oppositions. ’809 Opposition, 1 TTABVUE. Opposer asserts claims of likelihood of confusion and dilution. *Id.*

On December 19, 2019, the Board consolidated the ’807 and ’809 Oppositions. ’807 Opposition, 10 TTABVUE. The consolidated ’807 and ’809 Oppositions are currently in the midst of trial, with Opposer’s trial period having closed on August 4, 2021, and

¹⁴ Application Serial No. 88320856, filed February 28, 2019, based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act.

¹⁵ Application Serial No. 88320852, filed February 28, 2019, based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act. “LITE” is disclaimed.

Applicant's pretrial disclosures due August 19, 2021. '807 Opposition, 22 TTABVUE 13.

The final determination of the '807 and '809 Oppositions may have a bearing on the '934, '935, and '637 Oppositions. In view of the status of the '807 and '809 Oppositions, the Board exercises its discretion to **suspend** the '934, '935, and '637 Oppositions pending final determination of the '807 and '809 Oppositions. *See* Trademark Rule 2.117(a); TBMP § 510.02(a) (“[T]he Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved[.]”).

VI. Summary

The '934, '935, and '637 Oppositions are consolidated and may be presented on the same record and briefs. The Board file will be maintained in the '934 Opposition as the “parent case.”

Opposer's motions to dismiss Applicant's counterclaim for failure to state a claim in the '934 and '935 Oppositions are **denied**.

The Board sua sponte **dismisses** Opposer's dilution by blurring claim in the '934 and dilution by tarnishment claims in the '934, '935, and '637 Oppositions **without prejudice**.

The Board sua sponte **dismisses** Opposer's lack of a bona fide intent claim in the '934 Opposition **with prejudice**.

The Board sua sponte **dismisses** Opposer's lack of bona fide intent to use claim in the '935 and '637 Oppositions **without prejudice**.

The Board sua sponte **strikes** Applicant's second and third defenses in the '934 and '935 Oppositions.

The Board exercises its discretion to **suspend** the '934, '935, and '637 Oppositions, pending final determination of the '807 and '809 Oppositions. Within **twenty (20) days** after the final determination of the '807 and '809 Oppositions, the parties shall so notify the Board so that this proceeding may be called up for appropriate action. During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys.

It is the Board's general practice to allow a party an opportunity to correct a defective pleading. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993); TBMP § 503.03. Accordingly, when proceedings resume, the Board will reset the time for Opposer to file an amended notice of opposition in the '934, '935, and '637 Oppositions, at which time Opposer may replead its likelihood of confusion claim based on a family of marks in the '934, '935, and '637 Oppositions, its dilution by blurring claim in the '934 Opposition, its dilution by tarnishment claim in the '934, '935, and '637 Oppositions, its nonuse claim in the '934 Opposition, and its lack of bona fide intent to use claims in the '935 and '637 Oppositions.¹⁶

¹⁶ If Opposer files an amended notice of opposition after proceedings resume, Applicant's deadline to file an answer will be reset accordingly. If Opposer does not file an amended notice of opposition after proceedings resume, its original notice of opposition in the '934, '935, and '637 Oppositions will remain operative on the claims identified as sufficiently pleaded herein.