

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

KGC

July 21, 2023

Opposition No. 91274910

Brink Biologics, Inc.

v.

Agilent Technologies, Inc.

By the Trademark Trial and Appeal Board:

This proceeding is before the Board for consideration of Opposer-Counterclaim Defendant's ("Opposer") motion to dismiss, pursuant to Fed. R. Civ. P. 12(b)(6), Applicant-Counterclaim Plaintiff's ("Applicant") counterclaim to cancel Opposer's pleaded Registration No. 4187822 filed in lieu of an answer thereto. 29 TTABVUE.¹ The motion is fully briefed.²

¹ Applicant's change of correspondence address is noted (21 TTABVUE), and the Board's records in this proceeding have been updated accordingly.

In this order, citations to the record in this proceeding are to TTABVUE, the Board's online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 106.03 (2023). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. The Board expects the parties to use this method of citing to the record throughout this proceeding.

² The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion. The Board does not recount the facts or arguments here, except as necessary to explain the Board's order. *See Guess? IP Holder L.P. v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Standard

To state a claim upon which relief can be granted, a party must sufficiently allege facts that, if proven, establish (1) its entitlement to a statutory cause of action,³ and (2) a valid ground for cancelling registration of the mark. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). The claim need only be “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)), and “[t]he elements [thereof] should be stated concisely and directly, and include enough detail to give the defendant fair notice,” *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (citing Fed. R. Civ. P. 8(e)(1)) (other citation omitted). “The purpose of a Rule 12(b)(6) motion is to challenge ‘the legal theory of the complaint, not the sufficiency of any evidence that might be adduced’ and ‘to eliminate actions that are fatally flawed in their legal premises and destined to fail.’” *Id.* (quoting *Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993)).

II. Analysis

Trademark Act Section 45, 15 U.S.C. § 1127, provides, in pertinent part, that “[a] mark shall be deemed to be ‘abandoned’ ... [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from

The parties are advised to refrain from ad hominem attacks in future submissions.

³ “Applicant’s [entitlement] to assert the counterclaim arises from [its] position as a defendant in the opposition ... initiated by opposer.” *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999) (citations omitted).

circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.”

Inasmuch as Applicant alleges that “Opposer has not made bona fide use in commerce of the mark NEUKOPANEL in connection with Opposer’s Goods since the registration issued on August 7, 2012” (27 TTABVUE 16, ¶ 8), and that “Opposer has not made bona fide use in commerce of the mark NEUKOPANEL in connection with Opposer’s Goods for a period of at least three consecutive years, and Opposer does not have an intention to resume use of the mark NEUKOPANEL in connection with Opposer’s Goods” (*id.* at 16, ¶ 9), these assertions are sufficient to plead an abandonment claim.

Though Opposer argues that “Applicant has failed to set forth a single factual allegation in support of its claim that Opposer’s Mark has been abandoned,” no more is necessary than what Applicant has pleaded. 29 TTABVUE 5 (emphasis omitted); *see Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1020 (TTAB 2018) (“The petition to cancel pleads that Respondent is not using the mark with its goods and services, and has no intent to resume use. The Board finds that no more is necessary for a legally sufficient abandonment claim.”); *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012) (“[P]etitioner has alleged that respondent has either never used the registered mark in commerce or completely ceased using the mark in commerce, in connection with the goods identified in the registration, for at least a period of three consecutive years. The facts alleged by petitioner set forth a prima facie claim of abandonment.”) (citations omitted).

Opposer also asserts that “Applicant acknowledges that Opposer timely filed a Section 8 Declaration of Use and a Section 9 Renewal of Registration of a Mark on March 16, 2022,” and that the USPTO “accepted Opposer’s Sections 8 and 9 Declarations and Opposer’s Registration remains active and is, in fact, incontestable.” 29 TTABVUE 5. However:

[T]he acceptance of a Section 8 affidavit ... cannot serve to deprive a person who believes he is damaged by the registration in question from exercising his right under Section 14 of the Statute to attempt to cancel the registration in question on any of the grounds specified therein, including, abandonment.

Sinclair v. Deb Chem. Proprietaries Ltd., 137 USPQ 161, 165 (TTAB 1963). In addition, Trademark Act Section 33(b), 15 U.S.C. § 1115(b), provides that incontestable registered marks “shall be subject to [a] defense[] ... [t]hat the mark has been abandoned by the registrant.”

Finally, Opposer argues that “Applicant seems to acknowledge the date ‘May 6, 2016’ is displayed on the insert pictured in the specimen, but alleges that ‘Opposer has not made bona fide use in commerce of the mark NEUKOPANEL in connection with Opposer’s Goods since the registration issued on August 7, 2012.’” 29 TTABVUE 5. At a minimum, and inasmuch as this proceeding was instituted in 2022, Applicant’s allegations pertaining to the May 6, 2016 date are consistent with Applicant’s assertion that “Opposer has not made bona fide use in commerce of the mark NEUKOPANEL in connection with Opposer’s Goods for a period of at least three consecutive years.” 27 TTABVUE 16, ¶ 9; *cf.* Fed. R. Civ. P. 8(d)(3) (“A party may state as many separate claims or defenses as it has, regardless of consistency.”).

III. Decision

In view thereof, Opposer's motion to dismiss is **denied**.

IV. Schedule

Proceedings remain **suspended**, except Opposer is **allowed** until **August 9, 2023** to serve on Applicant and file with the Board its answer to the counterclaim. Proceedings will automatically **resume** on **August 10, 2023** with the following schedule:

Deadline for Discovery Conference	9/11/2023
Discovery Opens	9/11/2023
Initial Disclosures Due	10/11/2023
Expert Disclosures Due	2/8/2024
Discovery Closes	3/9/2024
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	4/23/2024
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	6/7/2024
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	6/22/2024
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	8/6/2024
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	8/21/2024
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	10/5/2024
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	10/20/2024
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	11/19/2024
Opening Brief for Party in Position of Plaintiff in Original Claim Due	1/18/2025
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	2/17/2025
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	3/19/2025
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	4/3/2025

V. Important Trial and Briefing Instructions

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). Such briefs should utilize citations to the TTABVue record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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).