

UNITED STATES PATENT AND TRADEMARK OFFICE
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April 3, 2024

Opposition No. 91287675

Square Pie Guys, LLC

v.

IP SPC LLC

Opposition No. 91287927

IP SPC LLC

v.

Square Pie Guys, LLC

(as consolidated)

By the Trademark Trial and Appeal Board:

Proceedings consolidated

Opposition No. 91287927 is analogous to a counterclaim in Opposition No. 91287675. More specifically, the proceedings include essentially mirrored likelihood of confusion claims under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

Because the above-captioned proceedings involve the same parties and common questions of law or fact, the Board hereby orders their consolidation. *See* Fed. R. Civ. P. 42(a); *Prosper Bus. Dev. Corp. v. Int'l Bus. Machs., Corp.*, 113 USPQ2d 1148, 1149 (TTAB 2014); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991);

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Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991); TBMP § 511 (2023). The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91287675 as the “parent” case. As a general rule, other than the answer in Opposition No. 91287927, parties should file only a single copy of any submission should be filed herein in the Board file for the parent case. That copy, however, should include both consolidated proceeding numbers in the caption thereof.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

Opposition No. 91287927 motions to dismiss under Fed. R. Civ. P. 12(b)(6) and to take judicial notice of certain documents denied¹

This case now comes up for consideration of Square Pie Guys LLC’s (“Guys”) motions (both filed December 7, 2023) to dismiss Opposition No. 91287927 under Fed. R. Civ. P. 12(b)(6) for failure to state a claim, and for the Board to take judicial notice of certain documents. 5-6 TTABVUE. The motions have been fully briefed.

Guys seeks to register the standard character mark SQUARE PIE GUYS for “Restaurant services; Restaurant services, including sit-down service of food and

¹ TTABVUE citations in connection with the motions in Opposition No. 91287927 are to the Board file for Opposition No. 91287927.

take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises” in International Class 43.² IP SPC LLC (“City”) filed a notice of opposition against Guys’s involved application on the ground of likelihood of confusion with its previously used mark SQUARE PIE CITY for “restaurant services” in International Class 30. 1 TTABVUE. Guys filed its motions in lieu of an answer.

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). A motion to dismiss under Rule 12(b)(6) is solely a test of the sufficiency of the complaint at issue. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); TBMP § 503.02. Stating a claim upon which relief can be granted only requires pleading facts sufficient to show (1) entitlement to a cause of action (formerly referred to as “standing”) and (2) a valid ground for opposition. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). In deciding a motion to dismiss for failure to state a claim, the Board must assume that all of City’s well pleaded allegations are true and construe the notice of opposition in a light most favorable to City. *See Scotch Whisky Ass’n v. U.S. Distilled Prods. Co.*, 13 USPQ2d 1711, 1714 (TTAB 1989). Whether City can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or

² Application Serial No. 97453387, filed June 10, 2022, based on an assertion of use in commerce and alleging April 18, 2018 as the date of first use anywhere and of first use in commerce. The application includes a disclaimer of SQUARE PIE.

upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); TBMP § 503.02.

Turning to whether City has adequately pleaded entitlement to a cause of action, City need only allege facts sufficient to show it has an interest within the zone of interests protected by statute, i.e., a “real interest” and damage proximately caused by registration, i.e., a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020). City need not plead or prove actual damage to have entitlement to a cause of action. *See Enbridge, Inc. v. Excelerate Energy Ltd. P’ship*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009). City has adequately pleaded its entitlement to a cause of action in paragraphs 1-7 of the notice of opposition based on its alleged prior use of the mark SQUARE PIE CITY for restaurants. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Regarding whether City has pleaded a valid ground for opposition, Fed. R. Civ. P. 8(a)(2) requires that a pleading contain a “short and plain statement of the claim showing that the pleader is entitled to relief.” Rule 8(a)(2) does not require detailed factual allegations, but requires more than labels, conclusions, formulaic recitations of the elements of a cause of action, or naked assertions. *See Ashcroft v. Iqbal*, 556

U.S. 662, 678 (2009). In particular, 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). The plausibility standard is not akin to a “probability requirement,” but it asks for more than a sheer possibility of the allegations asserted. *See Ashcroft*, 555 U.S. at 678. Indeed, a plaintiff need not allege specific facts that would establish a *prima facie* case for the claim(s) asserted. *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 547 (2007), citing *Swierkiewicz v. Sorema N. A.*, 534 U.S. 506, 508 (2002).

As for the likelihood of confusion claim, a plaintiff need only allege facts which would establish (1) prior use, or ownership of a registration for, its pleaded mark(s),³ and (2) that contemporaneous use of the parties’ respective marks on their respective

³ Because neither party owns a registration upon which it can rely in support of its likelihood of confusion claim, each party must establish proprietary rights in its pleaded common-law mark. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). In the involved applications, each party has disclaimed any exclusive right to use the term SQUARE PIE. Such disclaimers are concessions that the term SQUARE PIE is not inherently distinctive. *See In re Six Continents Ltd.*, 2022 USPQ2d 135, at *18 (TTAB 2022). Accordingly, priority of acquired distinctiveness with regard to the term SQUARE PIE may be at issue herein. *See Perma Ceram Enters. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1136 (TTAB 1992).

Each party can rely on purely intrastate use of its pleaded mark to claim priority in support of its likelihood of confusion claim. *See Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1150 n.19 (TTAB 2016).

One need not direct goods across state lines to properly assert use in commerce in support of an application to register a mark under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). *See Christian Faith Fellowship Church v. adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1647 (Fed. Cir. 2016) (sale of two hats to an out-of-state customer found sufficient to constitute use in commerce). Likewise, services need not be rendered in more than one state to properly assert use in commerce in support of an application to register a mark. *See Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292, 1295 (Fed. Cir. 1991) (single location restaurant serving out-of-state customers satisfies use in commerce requirement).

services would be likely to cause confusion, mistake or to deceive consumers. *See* Trademark Act Section 2(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109-10 (CCPA 1974); *Fram Trak Indus., Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2004 (TTAB 2006). In deciding likelihood of confusion issues, the Board relies on the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973), when evidence of those factors is of record.⁴ Two key

⁴ The *du Pont* factors are follows:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i. e. “impulse” vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use.
 - (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

factors are the degree of similarity of the parties' marks and the degree of similarity of their respective services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). City has adequately pleaded a claim of likelihood of confusion in paragraphs 1-11 of the notice of opposition based on its alleged prior use – through a predecessor-in-interest -- of the mark SQUARE PIE CITY for restaurant services. 1 TTABVUE. *See* Trademark Act Section 2(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109-10 (CCPA 1974); *William & Scott Co. v. Earl's Rest. Ltd.*, 30 USPQ2d 1870, 1873 (TTAB 1994) (assignee of trademark substituted as party plaintiff in opposition is entitled to go forward on assignor's claim of priority of likelihood of confusion as alleged in the notice of opposition).

In its motion to dismiss and its motion for the Board to take judicial notice of certain documents, Guys prematurely argues the merits of this case by arguing that City is not a real party in interest. 5, 6 and 11 TTABVUE. In addition, taking judicial notice of the documents at issue would require conversion of the motion to dismiss into a motion for summary judgment, which would be premature because there is no indication that Guys served its initial disclosures in Opposition No. 91287927. *See* Trademark Rule 2.127(e)(1); TBMP § 503.04 and cases cited therein. Whether City is a real party in interest that can prevail on its pleaded likelihood of confusion claim

(12) The extent of potential confusion, i. e., whether de minimis or substantial.

(13) Any other established fact probative of the effect of use.

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in Opposition No. 91287927 is a matter to be resolved after introduction of evidence at trial or upon properly filed motion for summary judgment. *See Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041.

Because City has adequately pleaded its entitlement to a cause of action and likelihood of confusion claim, the motion to dismiss is **denied**. Likewise, because consideration of the documents discussed in the motion to take judicial notice would result in premature conversion of the motion to dismiss to one for summary judgment, that motion is also **denied**.

Consolidated proceedings resumed

Proceedings are resumed, except as follows. Discovery is suspended in Opposition No. 91287675 until the opening of discovery in Opposition No. 91287927, as set forth below, to allow Opposition No. 91287927 to catch up with Opposition No. 91287675. Parties are allowed until July 2, 2024, i.e., thirty days from the opening of discovery in Opposition No. 91287927/reopening of discovery in Opposition No. 91287675, to serve responses to any outstanding discovery requests in Opposition No. 91287675. Dates in these newly consolidated proceedings are reset as follows.

Answer to Opposition No. 91287927 Due	5/3/2024
Deadline for Discovery Conference in Opposition No. 91287927	6/2/2024
Discovery Opens in Opposition No. 91287927/Reopens in Opposition No. 91287675	6/2/2024
Initial Disclosures Due in Opposition No. 91287927	7/2/2024
Expert Disclosures Due in Both Proceedings	10/30/2024
Discovery Closes in Both Proceedings	11/29/2024
Pretrial Disclosures Due for Plaintiff in Opposition No. 91287675	1/13/2025
30-day Trial Period Ends for Plaintiff in Opposition No. 91287675	2/27/2025

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Pretrial Disclosures Due for Defendant in Opposition No. 91287675 and Plaintiff in Opposition No. 91287927	3/14/2025
30-day Trial Period Ends for Defendant in Opposition No. 91287675 and Plaintiff in Opposition No. 91287927	4/28/2025
Pretrial Disclosures Due for Rebuttal of Plaintiff in Opposition No. 91287675 and Defendant in Opposition No. 91287927	5/13/2025
30-day Trial Period Ends for Rebuttal of Plaintiff in Opposition No. 91287675 and Defendant in Opposition No. 91287927	6/27/2025
Pretrial Disclosures Due for Rebuttal of Plaintiff in Opposition No. 91287927	7/12/2025
15-day Trial Period Ends for Rebuttal of Plaintiff in Opposition No. 91287927	8/11/2025
Brief on the Case Due for Plaintiff in Opposition No. 91287675	10/10/2025
Combined Brief on the Case Due for Defendant in Opposition No. 91287675 and Plaintiff in Opposition No. 91287927	11/9/2025
Combined Brief Due for Plaintiff Rebuttal in Opposition No. 91287675 and as Defendant in Opposition No. 91287927	12/9/2025
Rebuttal Brief Due for Plaintiff in Opposition No. 91287927	12/24/2025
Request for Oral Hearing (optional) Due	1/3/2026

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing.

Note: Parties are strongly encouraged to check the entire document before filing.⁵ The Board may not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

⁵ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.

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