

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: August 1, 2008

Cancellation No. 92047833

MIOX Corporation

v.

Orica Australia Pty. Ltd.

Ann Linnehan, Interlocutory Attorney

The petition to cancel, filed on July 29, 2007, includes petitioner's name and correspondence address, the requisite information about the subject registration, and the following statement:

The Defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods and services of the Defendant, to cause confusion, or to cause mistake, or to deceive, per 15 U.S.C. § 1052(d).

In lieu of an answer, on December 5, 2007, respondent filed a motion to dismiss for lack of standing, or in the alternative, to dismiss for failure to state a claim. In the motion, respondent argues that the petition to cancel fails to establish petitioner's standing as it does not allege that petitioner has been or will be harmed or damaged

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by the continued registration of respondent's mark.

Respondent also argues that the petition fails to state a claim upon which relief can be granted because it does not allege that petitioner owns rights in a mark, or that respondent's mark is likely to cause confusion with any mark owned by petitioner.

On December 10, 2008 petitioner filed a motion for leave to amend the petition to cancel in conjunction with its amended petition to cancel. In its motion, petitioner seeks leave to file "a more traditional Petition stating Petitioner's standing and the grounds of priority of use and likelihood of confusion." Petitioner explains that when it originally filed its petition using the Board's ESSTA filing system, petitioner referenced its pleaded registration in the field provided and indicated its claim of likelihood of confusion therewith. Petitioner correctly notes that the copy of the petition for cancellation appearing on the Board's TTAVUE website does not reference petitioner's pleaded registration. The receipt of the filing (a copy of which is provided by petitioner), however, does include this reference.

On December 12, 2007, the Board issued an order suspending proceedings for determination of the pending motion to dismiss and stated that it would not consider any matters that are not germane thereto.

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On December 20, 2007, petitioner filed its response to respondent's motion to dismiss which essentially sets forth the same arguments as those in its motion for leave to amend.

On December 28, 2007, respondent moved to strike petitioner's motion for leave to amend the petition to cancel arguing that the motion had been filed in contravention of the Board's December 12, 2007 suspension order inasmuch as it was not germane to the motion to dismiss.

On January 11, 2008 petitioner filed a response to the motion to strike wherein it argued that the motion for leave to amend is germane to the motion to dismiss.

On January 23, 2008, petitioner filed yet another amended petition to cancel pursuant to Fed. R. Civ. P. 15(a).

After carefully reviewing the original petition to cancel submitted on July 20, 2007, the Board finds that the petition is legally insufficient inasmuch as petitioner does not allege that it has been or will be harmed or damaged by the continued registration of respondent's mark and does not allege that petitioner owns rights in a mark that will likely be confused with respondent's mark. However, the amended petition to cancel submitted on December 10, 2007 with petitioner's motion for leave to amend corrects the

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defects noted by respondent in its motion to dismiss and states a legally sufficient claim under Section 2(d) of the Trademark Act.

In view thereof, petitioner's motion for leave to amend the petition is hereby granted and respondent's motion to dismiss petitioner's petition to cancel is moot. See Fed. Civ. P. 15(a); TBMP Sections 503.03 and 507.02 (2d ed. rev. 2004). Petitioner's amended petition to cancel submitted on December 10, 2007 is the operative complaint herein.

In further view thereof, respondent's motion to strike is moot. Additionally, respondent's amended petition to cancel filed on January 23, 2008 is not accepted inasmuch as petitioner exercised its right pursuant to Fed. R. Civ. P. 15(a) to amend its complaint *once* as a matter of course before the answer was served when it submitted an amended petition with its motion for leave to amend on December 10, 2007. See TBMP 507.02 (2d ed. rev. 2004).

Proceedings herein are resumed. Respondent is allowed until **thirty days** from the mailing date of this order to file an answer or other response to the amended petition to cancel filed on December 10, 2007. The parties are allowed until **thirty days** from the mailing date of this order to serve responses to any outstanding written discovery requests.

Discovery and trial dates are hereby reset as follows.

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DISCOVERY PERIOD TO CLOSE: November 7, 2008

Plaintiff's 30-day testimony period to close: February 5, 2009

Defendant's 30-day testimony period to close: April 6, 2009

Plaintiff's 15-day rebuttal testimony period to close: May 21, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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