

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

Mailed: March 18, 2009

Cancellation No. 92050333

REMINGTON HEALTH PRODUCTS, INC.

v.

TROPICANA PRODUCTS, INC.

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

Petitioner seeks to cancel respondent's registration for the mark DRINKABLE FRUIT for "processed fruits."<sup>1</sup> As grounds for the petition to cancel, petitioner alleges priority of use and likelihood of confusion with its registered mark DRINKABLES for "vitamins, dietary supplements, and mineral supplements."<sup>2</sup>

Petitioner also alleges abandonment as follows:

7. Upon information and belief, Remington believes that Registrant has abandoned Registrant's Mark; therefore, U.S. Registration should be cancelled pursuant to 15 U.S.C. §1092.

Contemporaneously with its answer, respondent, on January 26, 2009, filed a motion to dismiss petitioner's abandonment claim arguing that petitioner has not alleged either 1) that there has been at least three consecutive years of non-use or 2) that there has been a period of non-use for less than three years with an

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<sup>1</sup> Registration No. 2319909, issued on the Supplemental Register.

<sup>2</sup> Registration No. 2552892.

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intent not to resume use. Thus, respondent argues, petitioner's abandonment claim is insufficiently pled.

In response, petitioner moves for leave to amend its petition to cancel, accompanied by a copy of its proposed amended pleading. The amended paragraph is as follows:

7. Upon information and belief, Registrant has failed to use Registrant's mark in commerce for at least three consecutive years; therefore, Registrant's Mark should be cancelled pursuant to 15 U.S.C. §1092. *Otto Roth, Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007).

In reply, respondent argues that petitioner's pleading remains insufficient because petitioner has not alleged that respondent has discontinued use of its mark with an intent not to resume such use. In addition, respondent argues that petitioner's abandonment claim is futile because a Trademark Act §8 declaration of continued use was filed by respondent on February 2, 2006, thus establishing use less than three years prior to the filing date of the petition to cancel.

In order to withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a pleading 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 (2) a valid ground exists for opposing registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). For purposes of determining a motion to dismiss for failure to state a claim upon which

relief can be granted, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Fed. R. Civ. P. 12(b)(6); and TBMP §503.02 (2d. ed. rev. 2004).

Insofar as respondent is moving to dismiss only one of petitioner's claims, respondent is not arguing that petitioner does not have standing to bring this cancellation proceeding.

Plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, *inter alia*, an amended complaint. If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot. In addition, in the event that the Board determines that a complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. See TBMP §503.03 (2d ed. rev. 2004).

The Board agrees with respondent that petitioner's originally pleaded abandonment claim is insufficient. See *Otto Roth*, 83 USPQ2d at 1863 ("The facts alleged must set forth a *prima facie* case of abandonment by a pleading of at least three consecutive years of non-use or must set forth facts that show a period of non-use less than three years coupled with an intent not to resume use.")

However, petitioner's proposed amended petition to cancel sufficiently asserts, on its face, an abandonment claim based on a failure to use the mark in commerce for at least three consecutive years. *Id.* ("...pleading of at least three consecutive years of non-use ....")

The fact that the subject registration file is automatically part of the record in a proceeding does not, however, mean that the allegations made therein, and the specimens, documents, exhibits, and other filings, filed therein are evidence on behalf of the registrant in the *inter partes* proceeding. Allegations must be established by competent evidence properly adduced at trial (or upon a summary judgment motion). The specimens, documents, exhibits, and other filings in a registration file are not properly adduced evidence in an *inter partes* proceeding on behalf of the registrant unless they are identified and introduced in evidence as exhibits during the testimony period (or upon a summary judgment motion). See TBMP §704.03(a) (2d ed. rev. 2004).

Thus, petitioner's proposed amended pleading with respect to its abandonment claim is not futile simply because respondent's Section 8 filing is of record in the registration file. The statements made in the Section 8 filing, and any other evidence respondent wishes to submit in defense of petitioner's claim of abandonment must be proven.

In view thereof, petitioner's motion for leave to amend the petition to cancel is granted. Petitioner's amended petition to cancel is noted and entered and is the operative pleading for petition in this proceeding. Respondent's motion to dismiss is moot and no further consideration is given thereto.

The time for respondent to answer the amended petition to cancel and all operative dates are reset as follows:

Time to Answer	4/1/2009
Deadline for Discovery Conference	5/1/2009
Discovery Opens	5/1/2009
Initial Disclosures Due	5/31/2009
Expert Disclosures Due	9/28/2009
Discovery Closes	10/28/2009
Plaintiff's Pretrial Disclosures	12/12/2009
Plaintiff's 30-day Trial Period Ends	1/26/2010
Defendant's Pretrial Disclosures	2/10/2010
Defendant's 30-day Trial Period Ends	3/27/2010
Plaintiff's Rebuttal Disclosures	4/11/2010
Plaintiff's 15-day Rebuttal Period Ends	5/11/2010

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 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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