

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

wbc

Mailed: November 21, 2013

Cancellation No. 92057330

David McLane Enterprises,  
Inc.

v.

Golden Song Productions, Inc.

**By the Trademark Trial and Appeal Board:**

Petitioner filed a petition to cancel respondent's Registration No. 3701971. In lieu of an answer, respondent filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim.<sup>1</sup> The motion has been fully briefed. The Board has considered the parties' submissions<sup>2</sup> and presumes the parties' familiarity with the factual bases for the motions and does not recount them here except as necessary to explain the Board's order.

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<sup>1</sup> Respondent's appearance of counsel filed July 24, 2013 is noted and made of record.

<sup>2</sup> Petitioner's filing, entitled "ERRATA," filed September 13, 2013 is in effect a surreply. A movant is allowed to file one reply brief in response to a brief in response to a motion. See Trademark Rule 2.127(a). Accordingly, the surreply filed by petitioner on September 13, 2013 will receive no consideration. Were the Board to consider the surreply, it would not have changed the Board's decision herein.

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of a complaint. See TBMP § 503.01 (3d ed. rev.2 2013). To survive such a motion, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint must contain sufficient factual matter, accepted as true, that states a claim to relief that is plausible on its face. See *Ashcroft v. Iqbal*, 556 U.S. 662 (2009). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition or cancellation exists. Cf. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 556 (2007). 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. United States*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

***Standing***

Regarding whether petitioner has adequately pleaded its standing, the starting point for considering standing in a cancellation proceeding is Trademark Act Section 14, 15 U.S.C. Section 1064, which provides that a "petition to cancel a registration of a mark ... may ... be filed ... by any person who believes that he is or will be damaged ... by the registration of a mark on the [P]rincipal [R]egister." Trademark Act Section 14 establishes a broad class of persons who are proper petitioners; by its terms, the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. That is, a pleading of standing requires a pleading of facts sufficient to allege that the pleader has a personal interest beyond that of the general public in the outcome of a proceeding, e.g., a real commercial interest in its own marks and a reasonable basis for its belief that it would be damaged. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 187-90.

Respondent's motion to dismiss is based on its allegation that petitioner has failed to establish its standing to bring the petition to cancel. Central to respondent's motion is the allegation that petitioner misidentifies its pleaded application.

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. See *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007); TBMP § 507.01. When the plaintiff in a Board inter partes proceeding misidentifies itself or the mark or registration upon which it relies in the complaint, if the plaintiff can establish to the Board's satisfaction that this misidentification was merely a non-substantive mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest. Cf. *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.3 (TTAB 1985); *Airbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 505-06 (TTAB 1974); TBMP § 512.04 and the cases cited therein.

Petitioner's petition to cancel pleads ownership of an "application for WOW GIRLS, Serial No. 85353422." Application Serial No. 85353422 is for the mark, WOW! whereas application Serial No. 85353454 is for the mark, WOW GIRLS. Because petitioner, in the petition to cancel, identifies its mark as WOW GIRLS, recites the goods listed in its WOW GIRLS application and its arguments are based on its WOW GIRLS mark, respondent has received adequate notice

of petitioner's basis for standing in this proceeding. Furthermore, inasmuch as petitioner indicates it inadvertently referenced the incorrect serial number in its petition to cancel and the misidentification was a "typographical error," the Board is satisfied that the misidentification was merely a non-substantive mistake. In view thereof, the Board hereby deems the petition to cancel amended to replace reference to application Serial No. 85353422 with application Serial No. 85353454.<sup>3</sup>

In view thereof and inasmuch as petitioner has alleged its application was refused registration based on respondent's registration, and that petitioner will be damaged by respondent's registration, the Board finds that petitioner has set forth the requisite personal interest in the outcome of this proceeding and reasonable belief of damage from the registration of respondent's mark necessary to plead its standing to maintain the petition to cancel in paragraph 6 of the petition to cancel. *See Lipton Industries, Inc. v. Ralston Purina Company*, 213 USPQ 185, 189 (C.C.P.A. 1982); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *see also, e.g., Petroleos Mexicanos v. Intermix S.A.*,

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<sup>3</sup> In view of the Board's order herein, petitioner's request for leave to amend its petition to cancel is moot.

Cancellation No. 92057330

97 USPQ2d 1403, 1406 (TTAB 2010); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972).

**Grounds**

Although not pleaded by respondent, in the interest of completeness the Board has reviewed petitioner's purported grounds for cancellation and finds they are insufficiently pleaded.

To plead a claim of fraud, petitioner must allege that respondent made a specific false statement of material fact in the course of the involved registration and that respondent made such false statement with the intent of deceiving the USPTO into issuing a registration to which applicant is not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Under *In re Bose Corp.*, "a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO." *Id.* at 1941. Pursuant to Fed. R. Civ. P. 9(b), any allegations based on "information and belief" must be accompanied by a statement of facts upon which the belief is based. *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478-1479 (TTAB 2009), citing *Exergen Corp. v. Wal-Mart*

*Stores Inc.*, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009).

Intent, as a condition of mind of a person, may be averred generally. Fed. R. Civ. P. 9(b); see also *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010), citing *In re Bose*, 91 USPQ2d at 1941.

With regard to petitioner's fraud claim based on respondent's statement of use under 15 U.S.C. § 1051(d), petitioner must identify the "specific who, what, when, where and how" of the alleged fraud. *Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1668 (Fed. Cir. 2009). Petitioner alleges that respondent "never used its mark for all the clothing items listed, or its use of the mark was merely token use in order to support the registration" and that respondent intended "to deceive the USPTO." Petitioner's allegations are based on "information and belief" and are not accompanied by a recitation of specific facts that the alleged falsity is material to the registrability of the mark.<sup>4</sup> In view thereof, opposer's fraud claim is insufficiently pleaded.<sup>5</sup>

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<sup>4</sup> For example, where petitioner alleges respondent did not use its mark on all clothing items, it has failed to allege with particularity which clothing items were not in use.

<sup>5</sup> Whether or not petitioner can establish fraud is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989). "One charging fraud cannot prevail merely by proving that its opponent lacked a bona fide intent to use the mark: there must be proof of a subjective intent to deceive." J.

Although the electronic cover sheet of the petition to cancel indicates that petitioner intends to allege abandonment<sup>6</sup> under Trademark Act Section 14 and descriptiveness under Trademark Act Section 2(e)(1),<sup>7</sup> the text of the petition to cancel fails to assert or properly plead these grounds. Accordingly, these grounds for cancellation are insufficiently pleaded.

The Board notes petitioner has also alleged that respondent's mark "failed to function as a trademark" because its specimen of use is merely ornamental. The Board notes initially that the acceptability of specimens is an *ex parte* examination issue that is not a basis for cancelling

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Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 31:78 (4th ed. 2013); See also *SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 USPQ2d 1300, 1305 (TTAB 2010); *Spin Master, Ltc. V. Zobmondo Entertainment, LLC*, 100 USPQ2d 1513 (C.D. Cal. 2011).

<sup>6</sup> Abandonment requires an allegation of (1) at least three consecutive years of nonuse, or (2) facts that show a period of nonuse less than three years coupled with an intent not to resume use. See Trademark Act § 45, 15 U.S.C. § 1127; *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007).

<sup>7</sup> "A term is merely descriptive [of goods or services] within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of a quality, characteristic, feature, function, or purpose of the [goods or] services." *In re ICE Futures U.S., Inc.*, 85 USPQ2d 1664, 1665 (TTAB 2008); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Descriptiveness is not determined "in the abstract, but in relation to the [goods or services] identified in the application and the possible significance that the term would have to the average purchaser of the [goods or services]." *In re ICE Futures*, 85 USPQ2d at 1665; *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

registration of a mark. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). The sufficiency of the specimens submitted with an application is within the province of the Examining Attorney to determine and it is not within the function of the Board to supervise the Examining Attorney. *Id* at 2035; *Granny's Submarine Sandwiches v. Granny's Kitchen Inc.*, 199 USPQ 564, 567 (TTAB 1976). If, however, petitioner is not seeking a finding that respondent's specimen is unacceptable but rather respondent's underlying usage of its mark fails to function as a trademark under Trademark Act Section 45, that would be a sufficient ground for cancellation. See *id.* Nonetheless, to the extent petitioner has attempted to assert this ground, it has done so in a merely conclusory manner without providing facts which constitute a basis therefor, and which provide fair notice thereof and thus, has insufficiently pleaded this ground.<sup>8</sup> See *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d

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<sup>8</sup> The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to specimens and other evidence of record showing how the designation is actually used in the marketplace. *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 1229 (TTAB 2010) (citing *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998)). Thus, the determinative factor as far as registrability is concerned is the manner in which the mark is actually used, once use commences. *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

Cancellation No. 92057330

1536, 1538 (TTAB 2007); *McDonnell Douglas Corp. v. National Data Corp.* 228 USPQ 45, 48 (TTAB 1985); TBMP § 309.03(a)(2).

In view thereof, although petitioner has adequately pleaded its standing, it has failed to adequately plead a ground for which relief can be granted. Accordingly, respondent's motion to dismiss is hereby **granted**.

Petitioner is allowed **twenty days** from the date of the order hereof to file an amended pleading asserting properly pleaded grounds for cancellation, failing which this cancellation may be dismissed. See TBMP § 503.03. If petitioner files an amended petition to cancel, respondent is allowed until thirty days from the date of service of the amended petition to cancel to file its answer or otherwise respond.

Proceedings herein are otherwise suspended.