

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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AM/apb

Mailed: September 8, 2014

Cancellation No. 92058848

Guantanamera Cigar Co, Inc.

v.

Corporacion Habanos, S.A.

By the Trademark Trial and Appeal Board:

On August 27, 2014, Petitioner filed a motion to dismiss the counterclaim on a defense of laches under Fed. R. Civ. P. 12(b)(6). On August 28, 2014, Respondent filed a motion for judgment on the pleadings or motion for summary judgment.

Regarding Petitioner's motion to dismiss, a laches defense is not properly raised by way of a Rule 12(b)(6) motion. A motion to dismiss under Rule 12(b)(6) is solely a test of the sufficiency of the complaint. For a complaint to be legally sufficient, 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); TBMP § 503 (2014).

Moreover, Petitioner has not filed an answer in which it asserts an affirmative defense of laches. Petitioner may not obtain judgment on the basis of an unpleaded defense. *See* TBMP §§ 314 and 528.07. Further, Respondent's counterclaim includes claims of abandonment and primarily geographical deceptive misdescriptiveness. Laches is not available as a defense against these claims. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989).

In addition, Petitioner, in support of its motion to dismiss, relies upon matters beyond the pleadings. Accordingly, that motion is properly treated as one for summary judgment. *See* TBMP § 503.04. Except on grounds of claim or issue preclusion or lack of Board jurisdiction, a party may not seek entry of summary judgment until it serves its initial disclosures. *See* Trademark Rule 2.127(e)(1). The motion was filed two months prior to the due date for the parties' initial disclosures and does not indicate that Petitioner has served its initial disclosures. Accordingly, the motion appears to be premature. Based on the foregoing, Petitioner's motion to dismiss is denied.

Proceedings are suspended pending disposition of respondent's motion for judgment on the pleadings and partial summary judgment. Remaining briefing on that motion is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1). Any submission filed during the pendency of this motion which is not relevant thereto will be given no consideration. *See* Trademark Rule 2.127(d).