

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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BUO

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Cancellation No. 92064181

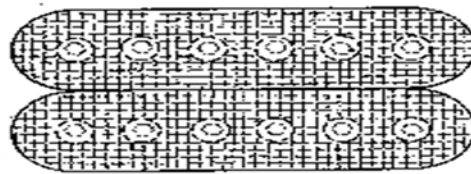
Andrew R. Flanders

v.

DiMarzio, Inc.

By the Trademark Trial and Appeal Board:

On March 22, 2017, DiMarzio, Inc. (“Respondent”) filed its third motion to dismiss the petition to cancel in this proceeding, which has now been amended a corresponding number of times. 17 TTABVUE. The second amended petition filed by Andrew R. Flanders, seeks to cancel Registration No. 1169205 for the following mark in shades of “cream” for use with “[e]lectronic sound pickup for guitars” in International Class 15.¹ 1 TTABVUE.



¹ The registration issued September 15, 1981, from an application filed December 1, 1977. The registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and a statement that the mark “is lined for the color yellow which resembles the distinctive shade of cream.” Respondent’s Combined Declaration of Use and Application for Renewal under Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§ 1058(a) and 1059, was accepted on April 29, 2011.

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In response to the Board's grant of leave following the dismissal of the amended petition to cancel, 14 TTABVUE 6, Petitioner filed a second amended petition to cancel on March 17, 2017. 15 TTABVUE 5-10. The second amended petition to cancel adds the following allegations:

...

15. Petitioner believes that this community includes hundreds of people who purchase and own guitars and guitar parts and believe that they are harmed by the Registration in the same way Petitioner is.

16. Petitioner has obtained more than 60 declarations from individuals within this community, from all across the United States, including more than a dozen states. Each declaration includes a specific statement in the individual's own words about the damage suffered due to the continued registration of the 205 Mark

...

17. As is clear from the declarations obtained by Petitioner and his discussions with members of the community referenced above, Petitioner and many other musicians share the belief that they are harmed by the registration for the 205 Mark because they are unable to obtain the sound and aesthetic they desire from their guitars.

15 TTABVUE 8-9, ¶¶ 15-17.

The second amended petition does not otherwise substantively alter the allegations of the amended pleading previously examined by the Board.

However, Respondent contends, "[t]hese allegations are not substantively any different from the allegations made in the Amended Petition," and "[t]here is nothing in the Second Amended Petition that establishes Petitioner's belief to be reasonable that he will suffer harm." 17 TTABVUE 4. Respondent argues that "[e]ven though

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this is Petitioner's third attempt, Petitioner still fails to allege facts sufficient to demonstrate the requisite standing to cancel the [']205 Mark because Petitioner fails to plead sufficient facts, even if true, that establish Petitioner's belief that he will suffer some harm is reasonable." *Id.* at 2.

Petitioner's claim of damage rests on Respondent's asserted "exclusive right[] to use and offer for sale ... pickups which consist solely of the color cream." 15 TTABVUE 6, ¶ 8. The gravamen of Petitioner's complaint is that because Respondent is the only company able to produce cream-colored pickups "due to the 205 Mark and the Registration," Petitioner cannot achieve his "particular desired aesthetic," for his guitars, "and is forced to either compromise his aesthetic by purchasing non-matching pickups from another vendor, or else sacrifice the quality and price he desires in order to achieve [the] desired aesthetic of the cream-colored pickup," and others who are similarly situated are similarly harmed by the registration. *Id.* at 7 and 8-9, ¶¶ 10, 13 and 15-17.

Motion to Dismiss

As stated in the prior order, a motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). In order to withstand such a motion, a complaint need only allege such facts as would, if proven, 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 denying the registration sought. *Young*

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v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). The complaint need only “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); *see also Ashcroft v. Iqbal*, 556 U.S. 662 (2009). It is important to note again that Petitioner is not under a burden to prove its case in its petition for cancellation. *Enbridge, Inc. v. Excelerate Energy Ltd. P’ship*, 92 USPQ2d 1537, n.10 (TTAB 2009). “[W]hether or not petitioner can prove the allegation[s] ... is a matter to be determined after the introduction of evidence at trial (or in connection with a proper motion for summary judgment).” *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989). Therefore, a motion to dismiss for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6) is a test solely of the legal sufficiency of the allegations asserted on the face of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

In reviewing a pleading for purposes of a motion to dismiss for failure to state a claim upon which relief can be granted, the Board must assume that all of Petitioner’s well pleaded allegations are true and construe the petition to cancel in a light favorable to Petitioner. Dismissal will be granted only if it appears that Petitioner is entitled to no relief under any set of facts that could be proved in support of its claims. *See The Scotch Whisky Assoc. v. U.S. Distilled Prods. Co.*, 13 USPQ2d 1711 (TTAB 1989) (citing *Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976)).

- **Standing**

As stated in the prior order, Trademark Act Section 14 establishes a broad doctrine of standing, requiring only that a person have a belief that he would suffer some kind of damage if the mark remains registered. As interpreted in binding precedent, a petitioner must have a “real interest” in the outcome of the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage by the continued registration of the mark. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

In order to sufficiently allege a claim of standing a plaintiff must plead, and of course later prove: (1) a “real interest” in the proceeding, and (2) a “reasonable belief of damage.”

The Board previously concluded that the amended petition to cancel contains allegations sufficient to plead Petitioner’s “real interest” in the proceeding, *i.e.* a favorable decision herein will likely redress the harm cited by Petitioner inasmuch as it concerns Respondent’s exclusive right to produce cream-colored humbucker pickups. Accordingly, Respondent’s current argument focuses on whether the second amended petition alleges facts sufficient to plead that Petitioner’s belief of damage is reasonable. Petitioner contests that “[t]he Second Amended Petition clearly satisfies the second prong of the *Ritchie* standing requirement by alleging that more than 60 musicians share Petitioner’s belief in harm from the Registration and by alleging possession of signed declarations from these musicians. These facts, if proven,

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establish Petitioner's standing as required by Section 14 of the Trademark Act as interpreted by the court in *Ritchie*." 19 TTABVUE 3. Respondent argues, "The declarations referenced by Petitioner are not even provided, nor are the specific individuals who allegedly made them identified." 17 TTABVUE 4.

Respondent should note that with two exceptions not applicable here, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading the exhibits are attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c). Therefore, even had Petitioner attached the declarations, they would not have been considered. Moreover, as previously stated, the Board's determination of the sufficiency of a pleading in the context of a motion to dismiss under Rule 12(b)(6) is constrained to the four corners of the pleadings. *See Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041. Finally, the declarations themselves and the identity of the declarants are appropriate issues for discovery not pleading; similarly, the probative value of the declarations and the number of them submitted is a matter for consideration at trial. *See Flatley*, 11 USPQ2d at 1286.

Indeed, Petitioner's amended claim of damage is one made on the basis of an objective belief of damage. *See Ritchie*, 50 USPQ2d at 1028; *cf. McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006), *aff'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007). ("Applicant's mark is therefore only subjectively offensive to opposer."). Unlike his initial amended complaint, Petitioner now has

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alleged facts that others (e.g. other guitar owners) share his belief of damage. 15 TTABVUE 8-9, ¶¶ 15-17.

Taking all of Petitioner's well pleaded allegations as true, as we must, and construing the petition in a light favorable to Petitioner, the additional facts alleged by Petitioner are sufficient to plead his standing to bring this cancellation proceeding. See *The Scotch Whisky Assoc.*, 13 USPQ2d at 1714.

Accordingly, Respondent's third motion to dismiss under Fed. R. Civ. P. 12(b)(6) is **DENIED**.

Schedule

The proceeding is **RESUMED**. The remaining conferencing, discovery, disclosure, and trial dates are reset as follows:

Deadline for Discovery Conference	August 10, 2017
Discovery Opens	August 10, 2017
Initial Disclosures Due	September 9, 2017
Expert Disclosures Due	January 7, 2018
Discovery Closes	February 6, 2018
Plaintiff's Pretrial Disclosures Due	March 23, 2018
Plaintiff's 30-day Trial Period Ends	May 7, 2018
Defendant's Pretrial Disclosures Due	May 22, 2018
Defendant's 30-day Trial Period Ends	July 6, 2018
Plaintiff's Rebuttal Disclosures Due	July 21, 2018
Plaintiff's 15-day Rebuttal Period Ends	August 20, 2018
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	October 19, 2018
Defendant's Main Brief Due	November 18, 2018
Plaintiff's Reply Brief Due	December 3, 2018

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.

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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.