UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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November 26, 2021

Cancellation No. 92075375

Common Sense Press Inc. DBA Pocket Jacks Comics

v.

Ethan Van Sciver and Antonio J. Malpica

Geoffrey M. McNutt, Interlocutory Attorney:

This case comes up for consideration of Respondents' August 2, 2021, motion to dismiss the petition to cancel. The motion is fully briefed.[1]

I. Background

Respondent Sciver is the owner of record – by assignment from Respondent Malpica[2] – of Registration No. 6102744 for the standard character mark COMICS GATE ("COMICS" disclaimed) for "comic books" in International Class 16.[3]

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[1] The Board has carefully considered all of the parties' arguments, but for the sake of efficiency does not repeat or discuss all of them in this order. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

[2] The underlying application was filed by Mr. Malpica, and the registration issued to him. After the petition to cancel was filed, the registration was assigned from Mr. Malpica to Mr. Sciver, and Mr. Sciver was joined with Mr. Malpica as a respondent and party defendant. *See* 17 TTABVUE 4–5.

[3] Issued on the Principal Register on July 14, 2020, based on Mr. Malpica's allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging September 7, 2018 as both the date of first of the mark and the date of first use in commerce.

As grounds for cancellation, Petitioner has asserted the claims of nonuse, abandonment, and fraud.[4] Petitioner also alleges that the USPTO has preliminarily refused its two pending applications for the mark COMICSGATE for, respectively, "comic books"[5] and "Comic Books conforming to the certification standards as indicated by a Certification Mark"[6] on the ground of likelihood of confusion under Trademark Act Section 2(d), based on Respondent's involved registration.[7]

In lieu of filing an answer to the petition to cancel, Respondents filed the current motion to dismiss the petition.[8]

II. The Motion to Dismiss

A. Standard for Motion to Dismiss

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) is solely a test of the sufficiency of the complaint. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014). To survive a motion to dismiss, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff is entitled to

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[4] Petition to Cancel ¶¶ 6–14 (1 TTABVUE 4–5).

[5] Application Serial No. 88872841, filed on April 15, 2020, based on Petitioner's alleged bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

[6] Application Serial No. 88925542, filed on April 20, 2020, based on intent to use under Trademark Act Section 1(b).

[7] Petition to Cancel ¶¶ 1, 5 (1 TTABVUE 4).

[8] The motion to dismiss was filed by the deadline set by the Board in its order dated July 6, 2021. *See* 17 TTABVUE 5.

maintain a statutory cause of action, and (2) a valid ground exists for cancelling the registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Wise F&I, LLC, v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 (TTAB 2016); *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1029–30 (TTAB 2015). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face."' *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged." *Id.* (citing *Twombly*, 550 U.S. at 556). However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations; rather 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. *Twombly*, 550 U.S. at 556–57, *accord Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). A plaintiff is not required to prove its case in its complaint. *See Wise F&I, LLC*, 120 USPQ2d at 1107.

The plaintiff's pleading "must be construed so as to do justice." Fed. R. Civ. P. 8(e). For purposes of determining a motion to dismiss, all of the plaintiff's well-pleaded allegations must be accepted as true, and the claims must be reasonably construed in the light favorable to the plaintiff. *Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041; *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010).

Further, "[u]nder the simplified notice pleading of the Federal Rules of Civil Procedure, the allegations of a complaint should be construed liberally so as to do substantial justice." *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

A motion to dismiss "does not involve a determination of the merits of the case[.]" *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992); *see also Covidien*, 109 USPQ2d at 1697 n.3 ("Whether [plaintiff] has carried its evidentiary burden of proof with respect to any or all of its allegations is a matter not considered until after trial of the issues"); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 503.02 (June 2021). Dismissal of a claim as insufficient is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of the claim. *Fair Indigo*, 85 USPQ2d at 1538; *Scotch Whisky Assoc. v. U.S. Distilled Prods. Co.*, 13 USPQ2d 1711, 1714 (TTAB 1989).

B. Matters Considered

To the extent that Respondents have submitted and relied on matters outside of the pleadings in connection with the motion to dismiss, those matters have received no consideration. *See Nike*, 116 USPQ2d at 1029 (TTAB 2015); *Libertyville Saddle Shop*, 22 USPQ2d at 1597; TBMP § 503.04.

Under Fed. R. Civ. P. 12(b)(6), if matters outside the pleadings are presented, and not excluded by the Board, the motion to dismiss normally will be converted to one for summary judgment. *Advanced Cardiovascular Sys.*, 26 USPQ2d at 1044, *Nike*, 116 USPQ2d at 1028. However, because the motion to dismiss was filed before the

parties' initial disclosures were due, and there is nothing in the record to indicate that Respondents have served its initial disclosures, the motion to dismiss will not be considered as a motion for summary judgment. *See* Trademark Rule 2.127(e)(1); *see also* Nike, 116 USPQ2d at 1028 (motion to dismiss not converted to motion for summary judgment where movant had yet to serve initial disclosures); *Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had yet to serve initial disclosures).

C. Entitlement to a Statutory Cause of Action[9]

Entitlement to a statutory cause of action is a requirement that must be pleaded and proved by the plaintiff in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125–26 (2014)). A party in the position of plaintiff may seek to cancel a registration when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6–7 (Fed. Cir. 2020) (holding that the test in Lexmark is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a

[9] The Board's decisions previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063–64, under the rubric of "standing." Following the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125–26 (2014), the Board now refers to this inquiry as entitlement to a statutory cause of action. Despite the change in terminology, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Once a plaintiff satisfactorily pleads its entitlement as to at least one statutory ground for cancellation, it is entitled to assert any other statutory ground that is available. *See Coach Servs., Inc. v. Triumph Learning LLC,* 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012); *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère & Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d at *9 (TTAB 2020).

A plaintiff's allegation that its pending applications have been preliminarily refused by the Office based on likelihood of confusion with the respondent's involved registration typically is a sufficient basis for pleading (and ultimately proving) entitlement to maintain a statutory cause of action. *See, e.g.*, *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Lipton Indus.*, 213 USPQ at 189. In their motion, however, Respondents contend that Petitioner's intent-to-use applications are void ab initio because Petitioner was neither the entity entitled to use the marks in commerce nor the entity with the bona fide intent to use the marks, and therefore Petitioner cannot rely on the Office's refusal of the applications as a basis for pleading and proving entitlement.[10]

The issue of Petitioner's statements in its pleaded applications raises matters outside of the pleadings. Moreover, the Board cannot consider a challenge to Petitioner's applications because the Board has no jurisdiction over an application that is still pending before an examining attorney. *See, e.g.*, *Home Juice Co. v.*

[10] 18 TTABVUE 4–11.

Runglin Cos., 231 USPQ 897, 898 n.7 (TTAB 1986). ("The Board has no jurisdiction over petitioner's application for registration."); *Int'l Telephone and Telegraph Corp. v. Int'l Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to refuse plaintiff's pending applications was improper in view of Board's lack of jurisdiction over applications).

Additionally, when Petitioner's pleading is "construed so as to do justice" in accordance with Fed. R. Civ. P. 8(e), Petitioner's allegations indicate that, at a minimum, it has a prospective desire to use the mark COMICSGATE in connection with comic books. Independent of its applications, Petitioner's desire to use the COMICSGATE marks is sufficient to allege a real interest in the proceeding and a reasonable belief in damage that is proximately caused by the involved registration.[11] *See, e.g.*, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d at 1844 ("A belief in likely damage can be shown by establishing a direct commercial interest."); *see also Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (standing established by plaintiff showing that it is engaged in the manufacture or sale of the same or related goods and that the product in question is one which

[11] To be clear, the Board is not making a determination regarding whether or not Petitioner complied with the requirements of Trademark Act Section 1(b) when it filed its intent-to-use applications. As explained, Petitioner's applications are not before the Board, and the Board has no jurisdiction over them at this time. The Board is determining only that, for pleading purposes in this cancellation proceeding, the allegations in the petition to cancel provide sufficient notice that Petitioner has a prospective interest in the using the COMICSGATE marks.

Additionally, and as discussed previously, Petitioner's allegations regarding the refusal of its applications, which must be accepted as true for purposes of deciding the motion to dismiss, also are sufficient to plead entitlement to a statutory cause of action.

could be produced in the normal expansion of plaintiff's business); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1658 (TTAB 2014) (competitor has "standing"); *Grote Indus., Inc. v. Truck-Lite Co.*, LLC, 126 USPQ2d 1197, 1201 (TTAB 2018) (same).

Accordingly, the motion to dismiss the petition to cancel for failure to sufficiently plead entitlement to a statutory cause of action is **denied**.

III. Summary Determination and Case Schedule

The motion to dismiss is **denied**.

Proceedings are **resumed**. Respondents are allowed until **DECEMBER 29, 2021**, to file and serve an answer to the petition to cancel.

Disclosure, discovery, and trial dates are reset as shown in the schedule below.

Time to Answer	12/29/2021
Deadline for Discovery Conference	1/28/2022
Discovery Opens	1/28/2022
Initial Disclosures Due	2/27/2022
Expert Disclosures Due	6/27/2022
Discovery Closes	7/27/2022
Plaintiff's Pretrial Disclosures Due	9/10/2022
Plaintiff's 30-day Trial Period Ends	10/25/2022
Defendant's Pretrial Disclosures Due	11/9/2022
Defendant's 30-day Trial Period Ends	12/24/2022
Plaintiff's Rebuttal Disclosures Due	1/8/2023
Plaintiff's 15-day Rebuttal Period Ends	2/7/2023
Plaintiff's Opening Brief Due	4/8/2023
Defendant's Brief Due	5/8/2023
Plaintiff's Reply Brief Due	5/23/2023
Request for Oral Hearing (optional) Due	6/2/2023

The Federal Rules of Evidence generally apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in

Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).