

UNITED STATES PATENT AND TRADEMARK OFFICE
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LTS

July 21, 2021

Cancellation No. 92076315 (Parent)

Cancellation No. 92076336

Canpack S.A.

v.

Champion Container Corporation

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of: (1) Respondent's motion, filed March 29, 2021 in Cancellation No. 92076315 ("the '315 Cancellation"), to dismiss Petitioner's petition to cancel; and (2) Respondent's motion, filed March 29, 2019 in Cancellation No. 92076336 ("the '336 Cancellation"), to dismiss Petitioner's petition to cancel. The motions are each contested.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

On January 29, 2021, Petitioner filed a petition to cancel in the '315 Cancellation against Respondent's Registration No. 5034312 for the mark CANPAK, in standard

characters, for “steel tins; steel drums; metal liners for use in containers intended for filling, shipping and storing liquids and solids; metal paint-style cans, namely, a triple-tight can with metal coating for use in the retail sale of paint; metal f-style oblong cans; metal utility cans; two-part composite containers primarily comprised of a steel drum with plastic inserts; all sold empty for industrial and commercial use; packaging materials for industrial and commercial use all sold empty, namely, bulk containers primarily composed of steel” in International Class 6 and “plastic pails; plastic and glass bottles and jars for intended for filling, shipping and storing solids and liquids; food packaging materials sold empty, namely, glass and plastic bottles and jars for filling, shipping and storing solid and liquid food products; steel pails” in International Class 21.¹

In its petition to cancel, Petitioner alleges prior use of the mark CANPACK in connection with “metal cans, metal containers, and engineering and design services in the field of production and manufacture of cans and closures.” ’315 Cancellation, 1 TTABVue 7, ¶ 19. Petitioner further alleges ownership of application Serial No.

90054021 for the mark **CANPACK** for a variety of goods and services in International Classes 6, 21, 37, and 42² and application Serial No. 79297613 for the mark **CANPACK** for a variety of goods and services in International


¹ Issued September 6, 2016.

² Filed July 15, 2020 under Section 1(b) of the Trademark Act for the recited goods and services in International Classes 6 and 42 and under Sections 1(b) and 44(e) of the Trademark Act for the recited goods and services in International Classes 21 and 37.

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Classes 6 and 42³ and that both applications have been refused registration based upon a purported likelihood of confusion with the involved registration under Section 2(d) of the Trademark Act. *Id.* at 8, ¶¶ 26-27.

As grounds for cancellation, Petitioner pleads: (1) fraud; (2) nonuse; (3) abandonment; and (4) priority and likelihood of confusion. *Id.* at 5-8, ¶¶ 3-28.

The same day, Petitioner filed a similar petition to cancel in the '336 Cancellation against Respondent's Registration No. 6129543 for the mark  for "distributorship services featuring bottles, jars, pails, cans, drums and containers for use by manufactures and other distributors to fill, ship and store solid and liquid products; wholesale store services featuring bottles, jars, pails, cans, drums and containers for use by manufactures and other distributors to fill, ship and store solid and liquid products" in International Class 35.⁴

In its petition to cancel, Petitioner alleges the same prior use of the mark CANPACK and pleaded applications as those pleaded in the '315 Cancellation. '336 Cancellation, 1 TTABVUE 6-8, ¶¶ 15-23. As grounds for cancellation, Petitioner pleads: (1) fraud; (2) nonuse; and (3) priority and likelihood of confusion. *Id.* at 5-8, ¶¶ 3-24.

On March 29, 2021, Respondent filed a motion to dismiss in each of the '315 and '336 Cancellations. '315 Cancellation, 7 TTABVUE; '336 Cancellation, 7 TTABVUE.

³ Filed October 2, 2021 under Section 66(a) of the Trademark Act.

⁴ Issued August 18, 2020.

II. Consolidation

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2021). *See Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. *See World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264.

The parties to the '315 and '336 Cancellations are the same, and the involved marks, allegations, and claims are similar or identical. For these reasons, the Board finds that consolidation is appropriate. *Venture Out Props. LLC*, 81 USPQ2d at 1889 (consolidation ordered on the Board's own initiative). Accordingly, the '315 and '336 Cancellations are consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1

(TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '315 Cancellation as the “parent case.” As a general rule, from this point on, the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order. Because the involved proceedings, however, are consolidated prior to joinder of the issues in the proceedings, the parties should file a separate pleading (such as an answer) for each cancellation before commencing the practice of filing a single copy of any paper in the parent case.⁵

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

III. Motions to Dismiss

A. Legal Standard

A motion to dismiss under Rule 12(b)(6) is 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

⁵ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

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 has an entitlement to a statutory cause of action, and (2) a valid ground exists for denying the registration sought or for cancelling the involved registration.⁶ See *Doyle v. Al Johnson's Swedish Rest. & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); see also *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). In other words, the Board determines whether Petitioner's belief "is not wholly without merit." See *Lipton*, 213 USPQ at 189.

Further, 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 Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the plaintiff must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555). 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

⁶ The Board's decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Mindful of 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. See *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020). Despite the change in nomenclature, the Board's prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

the misconduct alleged. *See Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* 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.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

For purposes of determining a motion to dismiss, 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 Sys. Inc.*, 26 USPQ2d at 1041; *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010). Furthermore, “[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). Moreover, the purpose of a motion to dismiss is not to address the merits of the case. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“[A] motion to dismiss is a test solely of the legal sufficiency of the plaintiff’s pleadings. No matters outside the pleadings are considered. A motion to dismiss does not involve a determination of the merits of the case[.]”).

B. The Parties’ Arguments

Respondent argues that: (1) Petitioner’s claims for likelihood of confusion under Section 2(d) of the Trademark Act should be dismissed in both the ’315 and ’336 Cancellations because Petitioner fails to sufficiently allege priority in its pleaded

marks ('315 Cancellation, 7 TTABVUE 9-14; '336 Cancellation, 7 TTABVUE 9-14); (2) Petitioner's claims for fraud in the '315 and '336 Cancellations should be dismissed because the petitions to cancel contain "barebones allegations that are, in effect, all made upon information and belief without any actual knowledge of the facts to support a claim of fraud" ('315 Cancellation, 7 TTABVUE 15-16; '336 Cancellation, 7 TTABVUE 16-17); (3) Petitioner's claims for nonuse and abandonment in the '315 Cancellation and claim for nonuse in the '336 Cancellation should be dismissed because the claims merely contain "threadbare recitals of the elements of a cause of action, supported by mere conclusory statements" ('315 Cancellation, 7 TTABVUE 16-17; '336 Cancellation, 7 TTABVUE 17); and (4) if the Board dismisses Petitioner's likelihood of confusion claims, then it lacks "standing" in both proceedings ('315 Cancellation, 7 TTABVUE 17; '336 Cancellation, 7 TTABVUE 18).

In response, Petitioner argues that: (1) construing its allegations in the light most favorable to Petitioner, Petitioner alleges prior use in the United States and therefore sufficiently pleads its likelihood of confusion claim ('315 Cancellation, 9 TTABVUE 4-7; '336 Cancellation, 9 TTABVUE 4-7); (2) Petitioner's fraud claim meets the standard set forth by the Federal Circuit in *In re Bose* ('315 Cancellation, 9 TTABVUE 8-11; '336 Cancellation, 9 TTABVUE 8-11); (3) Petitioner meets the pleading standards for nonuse and abandonment in the '315 Cancellation and nonuse in the '336 Cancellation; whether Petitioner will be able to prove these claims is an issue for trial ('315 Cancellation, 9 TTABVUE 11-12; '336 Cancellation, 9 TTABVUE 11-12); and (4) Petitioner sufficiently pleads its "standing" in the '315 and '336 Cancellations,

irrespective of its likelihood of confusion claims ('315 Cancellation, 9 TTABVUE 12-14; '336 Cancellation, 9 TTABVUE 12-13). To the extent the Board finds any claim insufficiently pleaded in the '315 or '336 Cancellations, Petitioner requests leave to replead such claims. '315 Cancellation, 9 TTABVUE 14; '336 Cancellation, 9 TTABVUE 14.

C. Analysis

Because the petitions to cancel in the '315 and '336 Cancellations are substantially similar, the Board addresses the two motions to dismiss together.

1. Entitlement to a Statutory Cause of Action

To sufficiently allege an entitlement to a statutory cause of action within the meaning of Section 14 of the Trademark Act, a plaintiff must plead facts sufficient to show that it has a direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

Here, Petitioner alleges, inter alia, ownership of application Serial No. 90054021

for the mark **CANPACK** for a variety of goods and services in International Classes 6, 21, 37, and 42 and application Serial No. 79297613 for the

mark **CANPACK** for a variety of goods and services in International Classes 6 and 42 and that the pleaded applications have been refused registration based upon a purported likelihood of confusion with the involved registration under Section 2(d) of the Trademark Act. '315 Cancellation, 1 TTABVUE 8, ¶¶ 26-27; '336 Cancellation, 1 TTABVUE 7-8, ¶¶ 22-23.

Petitioner therefore has sufficiently alleged its entitlement to a statutory cause of action.⁷ See *Empresa Cubana del Tabaco v. Gen, Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012).

2. Fraud in the '315 and '336 Cancellations

Fraud in procuring or maintaining a trademark registration occurs when an applicant knowingly makes a specific false, material representation of fact in connection with an application or registration with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010). A fraud claim must set forth all elements of the claim with a heightened degree of particularity in compliance with Fed. R. Civ. P. 9(b). See *Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478-79 (TTAB 2009). In addition, intent to deceive the USPTO is a specific element of a fraud claim, and must be sufficiently pleaded. *In re Bose*, 91 USPQ2d at 1939-40; *Asian and W. Classics*, 92 USPQ2d at 1479.

In support of its fraud claim in the '315 Cancellation, Petitioner alleges, inter alia:

3. [Respondent] filed Application Serial No. 86/625,790 for [Respondent's] CANPAK Mark in connection with [Respondent's] Goods

⁷ Where a plaintiff has alleged an entitlement to a statutory cause of action as to at least one properly pleaded ground, its allegation of an entitlement to a statutory cause of action satisfies the requirement for any other legally sufficient ground. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) (“[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”); *Petróleos Mexicanos*, 97 USPQ2d at 1405.

on May 11, 2015, alleging use in commerce under Section 1(a) of the Trademark Act.

4. [Respondent] was not using [Respondent's] CANPAK Mark in connection with [Respondent's] Goods at the time [Respondent] filed Application Serial No. 86/625,790 for [Respondent's] CANPAK Mark on May 11, 2015.

5. [Respondent] stated in the sworn Declaration submitted with Application Serial No. 86/625,790 for [Respondent's] CANPAK Mark that "the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application."

6. [Respondent's] statement in the sworn Declaration submitted with Application Serial No. 86/625,790 that [Respondent] "is using the mark in commerce on or in connection with the goods/services in the application" was false.

7. [Respondent] knew that the statement in the sworn Declaration submitted with Application Serial No. 86/625,790 that [Respondent] "is using the mark in commerce on or in connection with the goods/services in the application" was false at the time the declaration was signed on May 11, 2015.

8. [Respondent] made the false statement in the sworn Declaration with the intent to deceive the USPTO into granting [Respondent] a trademark registration for [Respondent's] CANPAK Mark to which [Respondent] was not entitled.

9. The false statement in the sworn Declaration that [Respondent] was using the mark in commerce on or in connection with the goods in the application was material because the USPTO would not have granted a registration for CANPAK to [Respondent] without this false statement.

10. [Respondent's] false statement that [Respondent] was using the mark in commerce in connection with the goods in the application constitutes fraud upon the USPTO.

11. [Respondent's] U.S. Reg. No. 5,034,312 for [Respondent's] CANPAK Mark should be cancelled pursuant to 15 U.S.C. 1064(3) on the grounds of fraud.

'315 Cancellation, 1 TTABVUE 5-6, ¶¶ 3-11. In support of its fraud claim in the '336

Cancellation, Petitioner alleges, inter alia:

3. [Respondent] filed Application Serial No. 88/776,695 for [Respondent's] CANPAK and Design Mark in connection with [Respondent's] Services on January 28, 2020, alleging use in commerce under Section 1(a) of the Trademark Act.

4. [Respondent] was not using [Respondent's] CANPAK and Design Mark in connection with [Respondent's] Services at the time [Respondent] filed Application Serial No. 88/776,695 for [Respondent's] CANPAK and Design Mark on January 28, 2020.

5. [Respondent] stated in the sworn Declaration submitted with Application Serial No. 88/776,695 for [Respondent's] CANPAK and Design Mark that "the mark is in use in commerce on or in connection with the goods/services in the application."

6. [Respondent's] statement in the sworn Declaration submitted with Application Serial No. 88/776,695 that "the mark is in use in commerce on or in connection with the goods/services in the application" was false.

7. [Respondent] knew that the statement in the sworn Declaration submitted with Application Serial No. 88/776,695 that "the mark is in use in commerce on or in connection with the goods/services in the application" was false at the time the declaration was signed on January 28, 2020.

8. [Respondent] made the false statement in the sworn Declaration with the intent to deceive the USPTO into granting [Respondent] a trademark registration for [Respondent's] CANPAK and Design Mark to which [Respondent's] was not entitled.

9. The false statement in the sworn Declaration that the mark was in use in commerce on or in connection with the services in the application was material because the USPTO would not have granted a registration for CANPAK and Design to [Respondent] without this false statement.

10. [Respondent's] false statement that [Respondent] was using the mark in commerce in connection with the goods in the application constitutes fraud upon the USPTO.

11. [Respondent's] U.S. Reg. No. 6,129,543 for [Respondent's] CANPAK and Design Mark should be cancelled pursuant to 15 U.S.C. 1064(3) on the grounds of fraud.

Petitioner, specifically and with particularity, alleges a false statement, materiality, and an intent to deceive the USPTO. Accordingly, Petitioner sufficiently alleges fraud based on nonuse, and Respondent's motions to dismiss the fraud claim in the '315 and '336 Cancellations are **denied**.

3. Nonuse in the '315 and '336 Cancellations

Section 1(a) of the Trademark Act allows "[t]he owner of a trademark used in commerce" to request registration of its trademark on the Principal Register. 15 U.S.C. § 1051(a). Section 45 of the Trademark Act states that a mark shall be deemed to be used in commerce when:

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127. Accordingly, one of the available grounds for cancellation of a registration is a claim that there was no use of the mark in commerce as of the filing date of a use-based application that matured into the registration. *See e.g., Lens.com Inc. v. 1-800 Contacts Inc.*, 686 F.3d 1376, 103 USPQ2d 1672, 1676-77 (Fed. Cir. 2012); *Int'l Mobile Machs. Corp. v. Int'l Tel. & Tel. Corp.*, 800 F.2d 1118, 231 USPQ

142, 143 (Fed. Cir. 1986); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012).

Here, Petitioner alleges that: “[Respondent] was not using [Respondent’s] CANPAK Mark in connection with [Respondent’s] Goods at the time Application Serial No. 86/625,790 was filed on May 11, 2015” and therefore the involved registration is void ab initio in the ’315 Cancellation (’315 Cancellation, 1 TTABVUE 6, ¶¶ 13-14) and “[Respondent] was not using [Respondent’s] CANPAK and Design Mark in connection with [Respondent’s] Services at the time Application Serial No. 88/776,695 was filed on January 28, 2020” and therefore the involved registration is void ab initio in the ’336 Cancellation (’336 Cancellation, 1 TTABVUE 6, ¶¶ 13-14). When Petitioner’s nonuse allegations are read in their entirety, and construed so as to do justice in accordance with Fed. R. Civ. P. 8(e), the allegations that Respondent never used its subject marks are sufficient to plead a nonuse claim.

Accordingly, Respondent’s motions to dismiss the nonuse claim in the ’315 and ’336 Cancellations are **denied**.

4. Abandonment in the ’315 Cancellation

Under Trademark Act Section 45, “a mark shall be deemed to be abandoned when its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” 15 U.S.C. § 1127 (cleaned up).⁸ A plaintiff asserting

⁸ The parenthetical “cleaned up” is used to eliminate the unnecessary explanation of non-substantive alterations, such as changes in capitalization, and removal of internal quotation marks, brackets, ellipses, internal citations, and duplicate parentheticals.

a claim of abandonment must plead that the defendant is not using the involved mark with its goods and/or services, and intends not to resume use.⁹ *Id.*; *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1018 (TTAB 2019). No more is necessary for a legally sufficient abandonment claim. *Lewis Silkin*, 129 USPQ2d at 1020 (specifically rejecting the argument that an abandonment claim must include additional allegations demonstrating how a plaintiff will prove the allegations of nonuse plus intent not to resume use).

In the '315 Cancellation, Petitioner alleges:

15. Upon information and belief, [Respondent] has not used [Respondent's] CANPAK Mark in connection with [Respondent's] Goods in interstate commerce in the United States for at least the past three consecutive years.

16. Upon information and belief, [Respondent's] non-use and/or discontinuance of use in commerce of [Respondent's] CANPAK Mark was with the intent not to resume use.

17. [Respondent] has abandoned [Respondent's] CANPAK Mark in U.S. Reg. No. 5,034,312.

18. [Respondent's] U.S. Reg. No. 5,034,312 for [Respondent's] CANPAK Mark should be cancelled pursuant to 15 U.S.C. 1064(3) on the grounds of abandonment.

'315 Cancellation, 1 TTABVUE 6-7, ¶¶ 15-18. These allegations are sufficient to plead an abandonment claim. *Lewis Silkin*, 129 USPQ2d at 1020.

Accordingly, Respondent's motion to dismiss the abandonment claim in the '315 Cancellation is **denied**.

⁹ An allegation of "no intent to resume use" is equivalent to the statutory language of "intent not to resume use" for an abandonment claim. *Lewis Silkin*, 129 USPQ2d 1018-19 (citations omitted).

5. Likelihood of Confusion in the '315 and '336 Cancellations

To state a claim under Trademark Act Section 2(d), a plaintiff must sufficiently allege, in addition to entitlement to a statutory cause of action, that 1) it has proprietary rights from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights, and 2) the contemporaneous uses of the parties' respective marks on or in connection with their respective goods and services would be likely to cause confusion, mistake or to deceive consumers as to the source of the goods and services. *See Herbko Int'l., Inc., v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

When not relying on a prior registration, to plead priority on a Section 2(d) claim, a plaintiff must allege that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States by another and not abandoned..." Trademark Act Section 2(d). *See also* TBMP § 309.03(c)(2).

Petitioner has sufficiently pleaded its claim for priority and likelihood of confusion under Section 2(d) of the Trademark Act in the '315 and '336 Cancellations. First, Petitioner has sufficiently pleaded common law rights. In the petition to cancel in the '315 Cancellation, Petitioner alleges that: (1) "Petitioner is using the mark CANPACK ('Petitioner's CANPACK Mark') in connection with metal cans, metal containers, and engineering and design services in the field of production and manufacture of cans and closures ('Petitioner's Goods and Services') in commerce in

the United States[;]” (2) “Petitioner’s CANPACK Mark is inherently distinctive[;]” and (3) “Petitioner’s use of Petitioner’s CANPACK Mark in connection with Petitioner’s Goods and Services commenced long prior to any use by [Respondent] of [Respondent’s] CANPAK Mark in connection with [Respondent’s] Goods.” ’315 Cancellation, 1 TTABVUE 7, ¶¶ 19-21. And in the petition to cancel in the ’336 Cancellation, Petitioner alleges that: (1) “Petitioner is using the mark CANPACK (‘Petitioner’s CANPACK Mark’) in connection with metal cans, metal containers, and engineering and design services in the field of production and manufacture of cans and closures (‘Petitioner’s Goods and Services’) in commerce in the United States[;]” (2) “Petitioner’s CANPACK Mark is inherently distinctive[;]” and (3) “Petitioner’s use of Petitioner’s CANPACK Mark in connection with Petitioner’s Goods and Services commenced long prior to any use by [Respondent] of [Respondent’s] CANPAK and Design Mark in connection with [Respondent’s] Services.” ’336 Cancellation, 1 TTABVUE 6-7, ¶¶ 15 and 17.

When Petitioner’s allegations of priority are read in their entirety, and construed so as to do justice in accordance with Fed. R. Civ. P. 8(e), the allegations are sufficient to plead priority. Whether Petitioner can prove prior common law rights as pleaded in the petitions to cancel is an issue for trial. *See Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

Second, Petitioner alleges likelihood of confusion in the ’315 Cancellation on grounds that the parties’ respective marks are “virtually identical,” the involved goods are “identical or closely related,” and “[Respondent’s] CANPAK Mark so

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resembles Petitioner's previously used CANPACK Mark as to be likely to cause confusion or mistake or to deceive, by creating the erroneous impression that [Respondent's] Goods originate with, or are associated with Petitioner, or that [Respondent's] Goods are authorized, sponsored, or licensed by Petitioner." '315 Cancellation, 1 TTABVUE 7, ¶¶ 22-24. And in the '336 Cancellation, Petitioner alleges likelihood of confusion on grounds that the parties' respective marks are "highly similar," the parties' respective goods and services are "closely related," and "[Respondent's] CANPAK and Design Mark so resembles Petitioner's previously used CANPACK Mark as to be likely to cause confusion or mistake or to deceive, by creating the erroneous impression that [Respondent's] Services originate with, or are associated with Petitioner, or that [Respondent's] Services are authorized, sponsored, or licensed by Petitioner." '336 Cancellation, 1 TTABVUE 7, ¶¶ 18-20.

Accordingly, Respondent's motions to dismiss the likelihood of confusion claim in the '315 and '336 Cancellations are **denied**.

IV. Summary

The '315 and '336 Cancellations are consolidated and may be presented on the same record and briefs. The Board file will be maintained in the '315 Cancellation as the "parent case."

Respondent's motions to dismiss under Fed. R. Civ. P. 12(b)(6) in the '315 and '336 Cancellations are **denied**.

V. Proceeding Resumed; Trial Dates Reset

Proceedings are **resumed**. Respondent’s answer is due in the ’315 and ’336 Cancellation **no later than August 18, 2021**. As explained on page 5 above, Respondent must file its answer to the petition to cancel in each separate cancellation proceeding.

Trial dates are reset as follows:

Deadline to File Answer to Petition to Cancel in the ’315 and ’336 Cancellations	8/18/2021
Deadline for Discovery Conference	9/17/2021
Discovery Opens	9/17/2021
Initial Disclosures Due	10/17/2021
Expert Disclosures Due	2/14/2022
Discovery Closes	3/16/2022
Plaintiff’s Pretrial Disclosures Due	4/30/2022
Plaintiff’s 30-day Trial Period Ends	6/14/2022
Defendant’s Pretrial Disclosures Due	6/29/2022
Defendant’s 30-day Trial Period Ends	8/13/2022
Plaintiff’s Rebuttal Disclosures Due	8/28/2022
Plaintiff’s 15-day Rebuttal Period Ends	9/27/2022
Plaintiff’s Opening Brief Due	11/26/2022
Defendant’s Brief Due	12/26/2022
Plaintiff’s Reply Brief Due	1/10/2023
Request for Oral Hearing (optional) Due	1/20/2023

Generally, the Federal Rules of Evidence 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

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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).