

THIS ORDER IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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June 5, 2023

Cancellation No. **92081480**

Frank August, LLLP

v.

BFrank, LLC¹

By the Trademark Trial and Appeal Board:

On January 31, 2023, Frank August, LLLP (“Petitioner”) filed a petition to cancel Registration No. 6291012² on grounds of nonuse and ornamentation.³ In

¹ On May 10, 2023, Jordan Franklin of law firm Kearney, McWilliams & Davis (“KMD”) filed notice of her withdrawal but the continued representation of BFrank, LLC (“Respondent”) by KMD through Erik Osterrieder, John Davis and Vikesh Patel. As there is no indication otherwise, Erik Osterrieder has been designated as the primary correspondent for Respondent in this matter.

² For BFRANK and design for “Hats; Hoodies; Leggings; Pants; Shirts; Shirts and short-sleeved shirts; Socks; Sports bras; Tights; Athletic jackets; Athletic pants; Athletic shirts; Athletic tights; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Body shirts; Gym pants; Jogging pants; Lounge pants; Moisture-wicking sports bras; Moisture-wicking sports shirts; Short-sleeve shirts; Sport shirts; Sports jackets; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports caps and hats; Stretch pants; Sweat jackets; Sweat shirts; T-shirts; Tee shirts; Wind pants; Wind shirts; Women's hats and hoods; Yoga pants; Yoga shirts” in International Class 25. Filed on May 19, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application was published for opposition on September 22, 2020, and a notice of allowance was issued on November 17, 2020. A statement of use was filed on January 5, 2021, and accepted on January 29, 2021. The application matured to registration on the Principal Register on March 9, 2021.

³ 1 TTABVUE. Citations to the record or briefs in this order also include citations to the publicly available documents on TTABVUE, the Board’s electronic docketing system. The

accordance with the schedule in the notice of institution, Respondent was allowed until March 12, 2023, to answer the petition.⁴

This matter now comes up on Respondent's motion (filed March 4, 2023) to dismiss the petition for cancellation for failure to state a claim under Fed. R. Civ. P. 12(b)(6).⁵ Petitioner has contested the motion.⁶

Discussion

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can 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). To withstand 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 bring a statutory cause of action,⁷ and (2) a valid ground exists for opposing an application or cancelling a registration. *Doyle v. Al Johnson's Swedish Rest. & Butik*

number(s) preceding "TTABVUE" corresponds to the docket entry number(s) and the number(s) following "TTABVUE" refers to the page number(s) of that particular docket entry, if applicable.

⁴ 2 TTABVUE 3.

⁵ 5 TTABVUE.

⁶ 7 TTABVUE.

⁷ Although the Board's prior decisions have analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing," those requirements are now considered under the rubric of "entitlement to a statutory cause of action." Despite the change in nomenclature, the Board's prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable as there is "no meaningful, substantive difference between the analytical frameworks" *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020); *see also Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Inc., 101 USPQ2d 1780 (TTAB 2012). The complaint, therefore, must allege “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570, 127 S. Ct. 1955, 1974 (2007). In particular, the claimant 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.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937, 1949 (2009).

In determining a motion to dismiss under Fed. R. Civ. P. 12(b)(6), all of the plaintiff’s well-pleaded allegations are accepted as true and the complaint is construed in the light most favorable to the plaintiff. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Matters outside the pleadings will not be considered on a motion to dismiss under Fed. R. Civ. P. 12(b)(6) as to do so would convert the motion to one for summary judgment, *see* Fed. R. Civ. P. 12(d), which the Board will not entertain prior to the moving party’s initial disclosures.⁸ *See* Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1).

Entitlement to Bring Statutory Cause of Action

Entitlement to a statutory cause of action under Sections 13 or 14 of the Trademark Act is a threshold issue in every Board inter partes case. *See Corcamore*, 2020 USPQ2d 11277, at *5; *Austl. 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, 109 USPQ2d 2061, 2067 n.4 (2014)). To establish its entitlement to a statutory cause of action, a plaintiff

⁸ The only exceptions to this rule are motions for summary judgment based on claim or issue preclusion or lack of Board jurisdiction. *See* Trademark Rule 2.127(e)(1).

must demonstrate (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *See Corcamore*, 2020 USPQ2d 11277, at *4; *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1.

The purpose of this requirement is to avoid litigation where there is no real controversy between the parties, i.e., to weed out intermeddlers. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ 185, 189 (CCPA 1982). Thus, a plaintiff need only demonstrate that it has a “real interest,” i.e., a personal stake, in the outcome of the proceeding and a reasonable basis for its belief of damage. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). The bar in demonstrating entitlement to a statutory cause of action is not high. *See Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385 (TTAB 1991) (“[T]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding.”).

In moving to dismiss the petition for cancellation, Respondent rightly raises no issue with Petitioner’s entitlement to a statutory cause of action. Indeed, the Board finds that Petitioner has sufficiently pleaded its entitlement by virtue of its pleading of an application for registration that “has been refused registration based on [Respondent’s registration].”⁹ *See Parfums Nautee Ltd. v. Am. Int’l Indus.*, 22

⁹ 1 TTABVUE 4, ¶ 6.

USPQ2d 1306, 1307 (TTAB 1992) (petitioner has standing to seek cancellation of registration cited against its application).

Nonuse

A claim of nonuse that seeks cancellation of a registration that issued from an application filed under Section 1(b) of the Trademark Act must plead nonuse of the mark in commerce as to all of the goods or services identified therein as of the filing date of the amendment to allege use or the expiration of the time for filing a statement of use. *See NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at *13 (TTAB 2021). Although Petitioner’s pleading of its nonuse claim does not explicitly recite the language “expiration of the time for filing a statement of use,” Petitioner has averred that “Registrant did not use Registrant’s Mark in commerce in connection with any or all Registrant’s Goods prior to May 17, 2021, the end of the first six month period for showing use set in the Notice of Allowance mailed November 17, 2020”¹⁰ Since May 17, 2021, signifies the original expiration date for Respondent to file a statement of use and Respondent did not seek to extend that time, Petitioner’s pleading of the claim is sufficient.

Respondent’s contention that the relevant allegation in the petition “is conclusory and provides no facts or evidence to support it” is not well taken.¹¹ First, the presentation of evidence is neither necessary nor appropriate at the pleading stage. *See Advanced Cardiovascular*, 26 USPQ2d at 1041 (purpose of a motion under Fed. R. Civ. P. 12(b)(6) is to “challenge[] the legal theory of the complaint, not

¹⁰ *Id.* at 5, ¶ 7.

¹¹ 5 TTABVUE 6.

the sufficiency of any evidence that might be adduced”). Second, Petitioner’s allegation that Respondent did not use its mark in commerce in connection with any of the goods set forth in the statement of use prior to the deadline therefor is sufficient to plead the underlying facts to a nonuse claim since the allegation “work[s] double duty ... both to describe the claim and to describe the necessary facts to support the claim.” *Lewis Silkin LLP v. Firebrand*, 129 USPQ2d 1015, 1020 (TTAB 2018) (finding allegation that “Respondent is not using Respondent’s Mark on or in connection with Respondent’s Goods and Services” sufficient to plead nonuse element of abandonment claim). The Board therefore finds Petitioner’s pleading of nonuse legally sufficient.

Ornamentation

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a trademark can consist of “any word, name, symbol, or device, or any combination thereof – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Matter that serves primarily as a source indicator, whether inherently or as a result of acquired distinctiveness, and is only incidentally ornamental or decorative, is registrable. *See In re Paramount Pictures Corp.*, 213 USPQ 1111, 1114 (TTAB 1982). However, subject matter that is purely ornamental or decorative does not function as a trademark and is, therefore, unregistrable. *Id.* at 1113 (“subject matter [that] is purely ornamental ... would not be considered as an indication of

source”). The critical inquiry in determining whether matter functions as a trademark is how the mark would be perceived by the relevant public. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1713 (TTAB 2016).

Petitioner’s pleading of its ornamentation claim alleges that “any use of Registrant’s Mark on Registrant’s Goods prior to May 17, 2001, was ornamental in nature, and thus failed to function as a registrable mark, pursuant to Sections 1 and 45 of the U.S. Trademark Act, 15 USC Sections 1051 and 1127.”¹² Respondent again contends that the pleading of the claim is “conclusory and provides no facts or evidence to support it.”¹³ Setting aside that, as noted *supra*, the submission of evidence is unnecessary and inappropriate during the pleading stage, the contention is otherwise well taken.

Unlike the claim of nonuse, simply asserting that Respondent’s use of its mark “was ornamental” does not work “double duty” to describe the claim and the facts necessary to support it. Petitioner’s contention that its claim of ornamentation is well pleaded finds no support in *Lewis Silkin* since the determination therein was limited to a claim of abandonment, which necessarily includes a pleading of nonuse, but has no relevance to a claim of ornamentation. Thus, without pleading any of the facts that gave rise to the claim, Petitioner has merely identified the cause of action without adequate notice to Respondent of the basis therefor. In view thereof, the claim is insufficient.

¹² 1 TTABVUE 5, ¶ 8.

¹³ 5 TTABVUE 6.

Decision

Respondent's motion to dismiss is **DENIED** as to Petitioner's nonuse claim but **GRANTED** as to Petitioner's ornamentation claim which is hereby **STRICKEN** from the petition for cancellation.

As it is the general practice of the Board to allow a party an opportunity to correct a defective pleading, *see Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993), Petitioner is allowed until **JULY 3, 2023**, to file an amended petition for cancellation that properly pleads a claim of ornamentation consistent with this order if Petitioner believes it has a basis for doing so, failing which this matter will proceed on the petition for cancellation as stricken. Whether to the originally filed petition as stricken or to an amended petition, Respondent's answer shall be due **AUGUST 2, 2023**.

Proceedings herein are **RESUMED** in accordance with the following schedule:

Time to Answer	8/2/2023
Deadline for Discovery Conference	9/1/2023
Discovery Opens	9/1/2023
Initial Disclosures Due	10/1/2023
Expert Disclosures Due	1/29/2024
Discovery Closes	2/28/2024
Plaintiff's Pretrial Disclosures Due	4/13/2024
Plaintiff's 30-day Trial Period Ends	5/28/2024
Defendant's Pretrial Disclosures Due	6/12/2024
Defendant's 30-day Trial Period Ends	7/27/2024
Plaintiff's Rebuttal Disclosures Due	8/11/2024
Plaintiff's 15-day Rebuttal Period Ends	9/10/2024
Plaintiff's Opening Brief Due	11/9/2024
Defendant's Brief Due	12/9/2024
Plaintiff's Reply Brief Due	12/24/2024
Request for Oral Hearing (optional) Due	1/3/2025

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, matters in evidence, the manner and timing of taking testimony, 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). **The briefs should cite to the TTABVUE record created during trial by docket entry and page number—e.g., 8 TTABVUE 3—to facilitate the Board’s review of the evidence at final hearing. See TBMP § 801.03.** 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).

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