

THIS OPINION IS A  
PRECEDENT OF THE TTAB

**UNITED STATES PATENT AND  
TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

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Mailed: January 17, 2014

Cancellation No. 92057336

Covidien LP

v.

Masimo Corporation

**By the Trademark Trial and Appeal Board:**

Masimo Corporation (“respondent”) owns a registration on the Supplemental Register for a color trademark for “medical devices, namely, patient monitoring sensors and cables, in International Class 10, with the mark described as follows:

The mark consists of the color red covers (sic) the entirety of the mark, specifically the shape of a connector plug. The dotted outline of the goods is intended to show the position of the mark, and is not a part of the mark;

The mark is depicted in the registration as follows:<sup>1</sup>



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<sup>1</sup> Supplemental Registration No. 3976092, registered June 7, 2011, asserting a date of first use anywhere and date of first use in commerce of March 31, 2005. The color red is claimed as a feature of the mark.

Covidien LP (“petitioner”) filed a petition for partial cancellation or restriction of the registration pursuant to 15 U.S.C. § 1068; Trademark Act § 18. Petitioner alleges ownership of an application to register a color trademark for “disposable medical devices and supplies, namely, connectors and lead wires for use with patient monitoring devices,” also in International Class 10, on the Principal Register, with the mark described as follows:

The mark consists of the color pink (Pantone PMS 806) applied to the connector portion of Applicant's goods. The broken lines are intended only to show the position of the mark and are not claimed as part of the mark;

The mark is depicted in its pending application as follows:<sup>2</sup>



In lieu of filing an answer, respondent moved to dismiss the petition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. The motion has been fully briefed.

### Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the allegations set forth in a pleading. To survive a motion to dismiss under Fed. R. Civ. P 12(b)(6) for

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<sup>2</sup> Application Serial No. 85029983, filed May 4, 2010, presently based on use of the mark in commerce, and alleging a date of first use anywhere and date of first use in

failure to state a claim upon which relief can be granted, 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 standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012), citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). See also TBMP § 503.02 (2013).

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, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (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,” to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).<sup>3</sup>

The pertinent allegations in the petition to cancel are set forth as follows:

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commerce of January 31, 2009. The color pink is claimed as a feature of the mark.

<sup>3</sup> The Board generally gives no consideration to the materials submitted with a motion to dismiss when such materials are outside of the scope of the pleadings. See TBMP § 503.04 (2013).

Here, to the extent that respondent argues substantively with respect to whether petitioner can prove its allegations, said arguments have not been considered. As noted above, respondent’s motion is a test solely of the legal sufficiency of the allegations in a pleading. Whether petitioner 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. See also TBMP § 503.02 (2013).

2. The mark of said application Serial No. 85029983 has been refused registration under Section 2(d) of the Trademark Act, on the ground that said mark is likely to cause confusion with the mark of U.S. Registration No. 3,976,092, owned by Respondent, for a mark consisting of “the color red” for “medical devices, namely, patient monitoring sensors and cables.”

3. Petitioner and Respondent are competitors in the field of medical devices, and particularly patient monitoring devices and related equipment, and are using their respective color marks for the goods identified above.

4. Petitioner hereby request (sic) that, pursuant to Section 18 of the Trademark Act, U.S. Registration No. 3,976,092 be partially cancelled or restricted as follows: that the mark be limited to the particular shade of red actually used by Respondent in the marketplace, which shade of red is, on information and belief, identified as Pantone OMS 185. Attached as Exhibit A is a copy of a page from Respondent’s website, depicting one of its products in the particular shade of red used by Respondent.

5. The requested restriction or modification of Registration No. 3,976,092 would avoid a finding of likelihood of confusion between Applicant’s applied-for mark and Respondent’s registered mark.

#### A. Standing

Inasmuch as petitioner alleges in its pleading that it owns a pending application – here, Serial No. 85029983 - which has been refused registration pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d), based on respondent’s subject registration (petition, para. 2), petitioner has alleged facts which, if ultimately proved, would establish its standing to bring this proceeding. *See Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012), citing *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1043 (TTAB 2012) (standing shown by evidence that plaintiff’s application was refused

registration in view of defendant's registration). Accordingly, petitioner's pleading of standing is not in issue.<sup>4</sup>

### B. Grounds

Petitioner specifically and solely seeks relief under Trademark Act § 18, 15 U.S.C. § 1068. This provision confers on the Board the authority to "restrict or rectify...the registration of a registered mark," and provides:

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings....

A claim under Trademark Act § 18 is in the nature of an equitable remedy and does not require pleading and proof of specific grounds for cancellation or opposition. *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1994). Relief under § 18 may be sought separate and apart from any other ground. *See Montecash LLC v. Anzar Enterprises Inc.*, 95 USPQ2d 1060, 1063 (TTAB 2010), citing *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*.

Applications to register a color mark must include 1) a claim that the color(s) is a feature of the mark, and 2) a statement in the "Description of the

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<sup>4</sup> Granting that petitioner sufficiently pleads standing as stated, for completeness it is noted that petitioner also alleges that it and respondent are competitors in the field for the identified goods (petition, para. 3), and note that respondent does not

Mark” field naming the color(s) and describing where the color(s) appear(s) and how they are used on the mark. *See* Trademark Rule 2.52(b)(1), 37 C.F.R. §2.52(b)(1). *See also* TMEP § 1202.05(e) and 807.07(a) (October 2013). A petition to restrict or clarify the description of the mark in a registration falls under the § 18 provision giving the Board authority to “restrict or rectify” the register. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998). As in the case of a petition to restrict goods or services, a proper pleading to restrict or limit the description of a mark in an existing registration could include allegations that, for example, the description of the mark in the registration is ambiguous or overly broad and not specific to the mark actually used by the defendant, and must include an allegation that the restriction or limitation would avoid a finding of a likelihood of confusion. *See Wellcome, supra*.

Here, petitioner seeks relief in the form of a restriction or modification to respondent’s registration. Petitioner sets forth brief but specific allegations of fact on which it bases said request, namely, that respondent actually uses the registered mark in a particular shade of red. It seeks relief under § 18 in the form of entry of an amended description of the mark, and requests “that the mark be limited to the particular shade of red actually used by Respondent in the marketplace, which shade of red is, on information

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challenge petitioner’s standing in its motion to dismiss. *See* TBMP § 309.03(b) (2013).

and belief, identified as Pantone PMS 185” (petition, para. 4). Petitioner also alleges that the requested restriction or modification would avoid a finding of likelihood of confusion between its own applied-for mark and respondent’s registered mark (petition, para. 5).

Citing *Wellcome Foundation Ltd. v. Merck & Co.*, respondent maintains that, to state a claim, petitioner must allege two elements - that (1) the description of the mark in the registration is “ambiguous or overly broad,” and (2) the proposed restriction will avoid a likelihood of confusion (respondent’s brief, p. 2; emphasis in original). Also citing *Wellcome*, respondent argues that petitioner “cannot establish either one of the required elements” of its claim, that is, that 1) the description includes overly broad or ambiguous language, and 2) the restriction would avoid a likelihood of confusion (respondent’s brief, p. 4; emphasis in original).<sup>5</sup>

In *Wellcome*, the Board acknowledged the sufficiency of a claim under § 18 where the petitioner alleged that an existing description of a registered mark was “overly broad” or “ambiguous,” and further alleged that the description had resulted in a refusal of its application on the ground of likelihood of confusion. *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d at 1479-80. However, the decision did not limit this type of § 18 claim in *inter partes* proceedings by requiring that the pleadings allege that an existing description of a registered mark is “ambiguous” or “overly broad.” Certainly,

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<sup>5</sup> As noted above, a motion to dismiss is a test solely of the legal sufficiency of the allegations set forth in the pleading.

a plaintiff seeking an amendment to a description of a mark under § 18 sufficiently pleads, in part, a cognizable claim if it alleges that the existing description is ambiguous or overly broad.<sup>6</sup> However, those allegations are not the sole averments which can form a sufficient pleading. The Board also reads § 18 as allowing for, and thus encompassing, relief where a plaintiff alleges that a feature of the description of the mark renders the description not specific to the mark actually used by the defendant. *See, e.g., Wellcome*, 46 USPQ2d 1479-80 (plaintiff alleged that the defendant's description was "overly broad and not specific to the number of sides and relative lengths of the tablet actually used by respondent..." and the Board, in finding that plaintiff had made the necessary allegations for restriction or rectification, stated that "the alleged ambiguity would result in an expanded scope of the tablet shapes (or goods) covered by the registration," although the merits of the case found favor with the defendant). Applying this analysis, to the extent that respondent advocates the narrower construction of the pleading requirements for a § 18 claim, its position is without basis.

Returning to the pleading at issue, petitioner has set forth the necessary allegations to state a claim for relief in the form of a restriction or modification of a description of the mark as provided for under § 18. In

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<sup>6</sup> A § 18 claim must allege that the requested restriction would avoid a likelihood of confusion. Petitioner so alleged here. (*see* petition, para. 5.) Accordingly, this issue is not before the Board. The discussion here addresses the allegations that must be pled in addition to the allegation that the requested restriction would avoid a likelihood of confusion.



particular, petitioner alleged 1) that respondent's registration for a mark consisting of "the color red" for "medical devices, namely, patient monitoring sensors and cables" does not state the particular shade of red actually being used by respondent for its goods in the marketplace, and 2) that an amendment to the description of the mark to identify the shade of red actually being used by respondent would avoid a finding of likelihood of confusion between the parties' marks.<sup>7</sup> Based on these findings, the motion to dismiss for failure to state a claim is denied.

Notwithstanding this determination, in order to comply with Trademark Rule 2.52(b)(1) the Office requires as follows with respect to descriptions of color marks:

The description of the mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services. If the color is applied only to a portion of the goods, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, the description should so indicate. If the applicant is claiming a shade of color, the shade must be described in ordinary language, for example, "maroon," "turquoise," "navy blue," "reddish orange." This is required even if the applicant also describes the color using a commercial coloring system.

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<sup>7</sup> Respondent's contention that petitioner must allege that respondent is not using the mark on the goods or services that will be effectively excluded (respondent's brief, p. 4) is inapposite inasmuch as petitioner does not seek to amend respondent's identification of goods. Furthermore, respondent's contention that it complied with all of the examination requirements (respondent's brief, p. 6) is inapposite. The Board clearly recognizes challenges to registrations, based on § 18 and the equitable relief that is available thereunder, that assert that a description of a mark does not comport with a registration owner's actual use of the mark at the time of the filing of the petition for cancellation or restriction.

*See* TMEP § 1202.05(e) (October 2013). *See also In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012).

Petitioner's proposed amendment does not conform to the applicable requirements inasmuch as it only sets forth the description of the color which it alleges is in use by way of reference to a commercial coloring system, namely, the Pantone color matching system. In view of this, petitioner's allegations do not set forth a proposed amendment that complies with prevailing requirements. Accordingly, the Board requires that petitioner set forth a more definite statement of the amendment that it alleges will avoid a likelihood of confusion. *See* Fed. R. Civ. P. 12(e). The Board finds it appropriate to allow petitioner an opportunity to file an amended pleading which addresses this issue. *Cf.* TBMP § 503.03 (2013).

Accordingly, petitioner is allowed until thirty days from the mailing date of this order in which to file an amended petition which sets forth a proposed amendment to the description of respondent's mark that is in compliance with Trademark Rule 2.52(b)(1), as expounded in TMEP § 1202.05(e) (October 2013), failing which the petition will be dismissed. *See* Fed. R. Civ. P. 12(e).

Respondent is allowed until thirty days from the date of service of the amended petition in which to file its answer thereto.

Schedule

Proceedings are resumed. Conferencing, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	<b>4/27/2014</b>
Discovery Opens	<b>4/27/2014</b>
Initial Disclosures Due	<b>5/27/2014</b>
Expert Disclosures Due	<b>9/24/2014</b>
Discovery Closes	<b>10/24/2014</b>
Plaintiff's Pretrial Disclosures	<b>12/8/2014</b>
Plaintiff's 30-day Trial Period Ends	<b>1/22/2015</b>
Defendant's Pretrial Disclosures	<b>2/6/2015</b>
Defendant's 30-day Trial Period Ends	<b>3/23/2015</b>
Plaintiff's Rebuttal Disclosures	<b>4/7/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>5/7/2015</b>

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.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.