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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212322
Party	Defendant Lawrence Foods, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SHURFINE FOODS, INC., an Illinois  
corporation,

Opposer,

v.

LAWRENCE FOODS, INC., an Illinois  
corporation,

Applicant.

Marks: SURESHADES & SURESET

Opposing Marks:

49 Marks (111 International Classes of  
Goods & Services)

Opposition No.: 91/212,322

**MOTION TO DISMISS UNDER RULE 12(b)(6)**

**IN THE FIRST ALTERNATIVE**

**MOTION FOR A MORE DEFINITE STATEMENT UNDER RULE 12(e)**

**IN THE SECOND ALTERNATIVE**

**MOTION FOR DECONSOLIDATION UNDER RULE 42(a)**

Lawrence Foods, Inc. (“Lawrence Foods” or “Applicant”), in Opposition No. 91/212,322 (the “Opposition”), by and through its Vedder Price, P.C. attorneys hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order:

- 1- *Dismissing the Opposition for lack of standing and/or for failure to plead essential elements of the prima facie case of confusion pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.).*
- 2- *In a first alternative, for an order against Opposer requesting that it amend the Notice of Opposition to provide a clear and definitive statement under Rule 12(e) of the prima facie case of confusion and the associated certificates/marks asserted against Applicant.*
- 3- *In a second alternative, for an order deconsolidating the current Opposition pursuant to Fed. R. Civ. P. 42(a), as both marks SURESHADES and SURESET raise different issues of law and fact.*

## **MOTION TO DISMISS UNDER RULE 12(b)(6)**

### ***A. LACK OF STANDING***

Because the timeliness requirements under Trademark Act § 13(a), 15 U.S.C. § 1063(a), for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Board or by the Director on petition. *The Equine Touch Foundation, Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009) (“The time for filing a notice of opposition is statutory and cannot be waived by the Board.”). An opposition filed after the expiration of time, or a failure to comply with the terms of an extension of time to oppose pursuant to 37 C.F.R. § 2.102 result in forfeiture of the rights to oppose and must be denied by the Board as late. TBMP § 306.04.

Shurfine Foods, Inc. (“Shurfine”) is the only “person” opposing. Shurfine was initially granted two extensions of time pursuant to 37 C.F.R. § 2.102 / 15 U.S.C. § 1063(a), and was then allowed to file this Opposition. (See 06/06/2013 and 07/02/2013 Extensions of Time to Oppose as Exhibit A and Notice of Opposition as Exhibit B.) Shurfine is the only possible Opposer and any other potential opposition is untimely under 15 U.S.C. § 1063(a). The dismissal of Shurfine as a party requires dismissal of the Opposition with prejudice as no party can be substituted in place of Shurfine.

During due diligence investigations, counsel for Applicant found Shurfine to be a defunct and dissolved corporation. Upon information and belief, Shurfine stood dissolved since 2011 (see below). On July 25, 2013, during the second extension of time, counsel for Applicant notified Shurfine of such dissolved status. Applicant provided Shurfine with the image reproduced below from the online database of the Illinois Secretary of State. Applicant reminded Opposer that dissolved entities have no standing to Oppose and asked that Shurfine reinstate itself and prepare itself to cancel Applicant’s mark instead of opposing.

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JESSE WHITE  
SECRETARY OF STATE

**CORPORATION FILE DETAIL REPORT**

Entity Name	SHURFINE FOODS, INC.	File Number	38837125
Status	DISSOLVED		
Entity Type	CORPORATION	Type of Corp	DOMESTIC BCA
Incorporation Date (Domestic)	05/23/1959	State	ILLINOIS
Agent Name	C T CORPORATION SYSTEM	Agent Change Date	06/17/2010
Agent Street Address	208 SO LASALLE ST, SUITE 814	President Name & Address	RONALD KING 6700 SW SANDBURG ST. TIGARD OR 97223
Agent City	CHICAGO	Secretary Name & Address	INVOLUNTARY DISSOLUTION 10 14 11
Agent Zip	60604	Duration Date	PERPETUAL
Annual Report Filing Date	00/00/0000	For Year	2011

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*Image from Illinois Secretary of State provided to Opposer*

More than a month after receiving such a notice, on September 4, 2013, while Shurfine was still dissolved, Opposer proceeded ahead and filed the current Notice of Opposition. (See Exhibit B.) Upon information and belief, Shurfine was reinstated on the Secretary of State database as of September 10, 2013, more than a week after the last extension of time, the closure of the statutory period of time.

Only a “person” as defined under 15 U.S.C. § 1063(a) has standing to oppose or can be granted extensions of time during which to oppose. TBMP § 303.01. The term “person” as used in the Trademark Act, includes both natural and juristic persons. TBMP § 303.02. Not all corporate entities can oppose; if an operating division of a corporation is not itself incorporated or is not otherwise a legal entity which can sue and be sued, it does not have legal standing to own a mark or to file an application for registration, an opposition, or a petition for cancellation.

*In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986). Dissolved entities are not “persons” and are unable to file and secure any extension of time to oppose under 37 C.F.R. § 2.102(a), much less oppose.

Opposer stood dissolved as a legal entity under the Illinois Administrative Dissolution Statute. 805 ILCS § 5/12.35. Opposer was administratively dissolved at the latest ninety (90) days after the failure to file the report. 805 ILCS § 5/12.40(b). Once dissolved, Opposer was only entitled to wind down its affairs or reinstate itself. 805 ILCS § 5/12.40(c). It had no power to bring suit before the Board, and the Board had no authority to grant it extensions of time or to accept the Notice of Opposition.

While Opposer may have met the different requirements of reinstatement following administrative dissolution of 805 ILCS § 5/12.45, and such a reinstatement allows Opposer’s ownership of its marks to stand undisturbed under Illinois rules, these local state rules do not preempt federal law nor grant a right Opposer did not have. The current Opposition was filed on September 4, 2013 while Opposer stood dissolved. The Opposer was given (on June 6, 2013) and July 2, 2013 two extensions of time, during which time Opposer stood dissolved. The last of these three filings was made by Opposer with the actual knowledge of its dissolved status.

The timeliness requirements under the Trademark Act § 13(a), 15 U.S.C. § 1063(a), for the filing of an opposition are statutory and therefore cannot be waived. *The Equine Touch Foundation, Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009). While Illinois Law allows for Shurfine to benefit from reinstatement, Illinois Law does not grant Opposer rights as of the date of filing. The filings must be denied by the Board. TBMP § 306.04.

A court must dismiss claims from a notice of opposition for failure to state a claim if “plaintiff can prove no set of facts in support of his claim which would entitle him to relief.”

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