

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

In the Matter of Application Serial No. 76/401,534
Filed on: April 29, 2002
For the Mark : HRX
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12-16-2003
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #:

S&G Consulting, Inc.,
Opposer,

v.

Opposition No. 91158156

Credit Union Careers, Inc.,
Applicant.

BOX TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

I. INTRODUCTION AND FACTUAL BACKGROUND

Opposer S & G Consulting, Inc. opposes the motion of Applicant Credit Union Careers, Inc. to dismiss Opposer's Notice of Opposition. Contrary to the arguments of Applicant, Opposer's Notice of Opposition is sufficient because it contains allegations showing that Opposer has standing and has valid grounds for refusing registration.

Applicant is the owner of an intent-to-use application for the mark HRX in International Class 35 for "job placement services for credit unions; outsourcing for credit unions in the fields of human resources, payroll and employee benefits; and salary administration for credit unions." Opposer is the owner of a pending service mark application for the mark "HUMAN RX," for "consulting services in the field of human resources" in International Class 35. In its Notice of Opposition, Opposer made two key

allegations. First, Opposer alleged that the Applicant's HRX mark is confusingly similar to its HUMAN RX mark. Second, Opposer alleged that it is the senior user of the HUMAN RX mark.

II. ARGUMENT AND ANALYSIS

A. Motion to Dismiss Standards.

A motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6) cannot be granted unless it is certain beyond any doubt that the Opposer cannot, under any circumstances, prevail on the present allegations. McCarthy on Trademarks and Unfair Competition, § 20:133. To withstand such a motion, a pleading need only establish facts that, if proved, would establish that the Opposer has standing to maintain the proceeding, and a valid ground exists for denying the registration sought. Trademark Trial and Appeal Board Manual of Procedure (TBMP), § 503.02. Dismissal for insufficiency is appropriate only if it appears certain the Opposer is entitled to no relief under any set of facts that could be proved in support of its claim. Id.

B. Priority of Use is a Factual Question.

Opposer's Notice of Opposition is based on Section 2(d) of the Lanham Act because Opposer is alleging that the Applicant's mark is confusingly similar to its own mark. In oppositions based on a likelihood of confusion, the party opposing the application may base its opposition on "ownership of a registration, *prior use of an unregistered mark*, prior use in advertising, or as a trade name, or any other type of use that has resulted in establishing a trade identity." McCarthy on Trademarks and Unfair Competition, § 20:15 (emphasis added); see also Towers v. Advent Software, Inc., 913

F.2d 942, 945 (Fed. Cir. 1990); Otto Roth & Co. v. University Foods Corp. 640 F.2d 1317, 1320 (C.C.P.A. 1981).

The Opposer has alleged that it is the “senior user” of its HUMAN RX mark, and that the Applicant’s HRX mark is confusingly similar to the Applicant’s mark. Thus, the Applicant has pled allegations showing that it has standing for the opposition and valid grounds for the opposition. Standing has been alleged because the Opposer claims that the Applicant’s mark is confusingly similar. The grounds for the opposition are based on a likelihood of confusion. If the Opposer is the senior user of its mark and if the Applicant’s mark is confusingly similar, the Applicant’s mark must be denied registration.

The Applicant moved to dismiss the Notice of Opposition on the ground that Opposer “has not alleged that its mark . . . was used prior to Applicant’s filing date of April 29, 2002.” There is no requirement that the Opposer make such an allegation in the notice. As set forth above, the Opposer must only plead facts showing that it has standing and valid grounds for the opposition. The Applicant cites no authority for its claim that the Opposer must allege that its use began prior to the filing date. In the United States trademark system, the date of first use of a trademark, not the date of first application for federal registration, controls. McCarthy on Trademarks and Unfair Competition, § 16.1.

The Applicant inaccurately argued that the Opposer’s “senior user” allegation is a legal conclusion, not an allegation of fact. The determination of who is the senior user of a mark requires an analysis of which party began to use a mark first. This a factual question to be decided by the trier of fact. Additionally, the Applicant inaccurately

argues that the issue of whether the Opposer is the senior user of its mark is irrelevant because the Applicant has never used the HUMANRX mark. This argument completely ignores the Opposer's allegation that the Applicant's HRX mark is confusingly similar to the Applicant's mark. If the Applicant's mark is confusingly similar and the Opposer is the senior user of its mark, then the Applicant's mark is not entitled to registration.

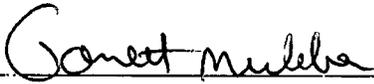
The Applicant's motion to dismiss is based on a legally flawed argument. The Opposer has alleged that it is the senior user of its mark and the Applicant's mark is confusingly similar to that mark. These allegations are sufficient to defeat the Applicant's motion. There is no requirement that the Opposer allege that its mark was used prior to the Applicant's filing date, and the Applicant has not provided any authority for its argument that such a requirement exists. The Opposer's motion must be denied.

III. CONCLUSION

For the reasons stated herein, Opposer respectfully requests that the Applicant's motion to dismiss be denied.

Respectfully submitted,

Date: 12-9-2003

By: 
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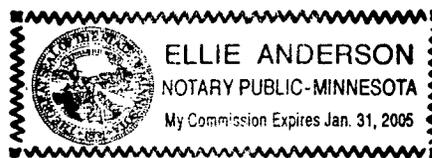
CERTIFICATE OF MAILING

I do hereby certify that the foregoing is being deposited with the United States Postal Service as first class certified mail – return receipt requested, postage prepaid, in an envelope addressed to: BOX TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 Appeal Board, on December 9, 2003.

Garrett M. Weber

Garrett M. Weber

Subscribed and Sworn to
this 9th day of December, 2003



Ellie Anderson
NOTARY PUBLIC

CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of December, 2003, a copy of the foregoing Opposer's Opposition To Applicant's Motion To Dismiss was served on the following party by first class mail, postage prepaid to the following address:

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December 9, 2003



12-16-2003
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Re: TTAB Opposition No. 91158156
Trade Mark: HRX
Serial No.: 76/401,534
S & G Consulting, Inc. v. Credit Union Careers, Inc.

Dear Sir or Madam:

Enclosed for filing is an original and one copy of Opposer's Opposition To Applicant's Motion To Dismiss.

Very truly yours,

LINDQUIST & VENNUM P.L.L.P.

Garrett M. Weber

GMW/ea
Enclosures

cc: Bruce H. Little, Esq.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, certified return receipt, in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on December 9, 2003.

Name: Garrett M. Weber