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

Proceeding	91179979
Party	Defendant On Lok, Inc.
Correspondence Address	Catherine E. Maxson Davis Wright Tremaine LLP 1201 Third Avenue, Suite 2200 Seattle, WA 98101 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Motion to Dismiss and Brief in Support of Motion to Dismiss - Opp. No. 91179979.pdf (17 pages)(798631 bytes)

Opp. ¶ 3.¹ Opposers commenced this opposition proceeding in an effort to prevent the registration of On Lok's Mark. Opposers contend that On Lok's Mark is confusingly similar to a design mark that Opposers allegedly use and that is the subject of a pending application, Ser. No. 79/022,838, filed by ISCA (hereafter "Opposers' Mark"), and contend that the parties offer similar services. *Id.* ¶¶ 1, 9. Opposers assert that the similarities between the marks will cause confusion, mistake, or deception and, as a result, that the registration of On Lok's Mark will damage Opposers. *Id.* ¶ 9.

Even if the Board accepts Opposers' allegations in its Notice of Opposition as true, Opposers have failed as a matter of law to state a claim that a likelihood of confusion exists, and the Board should grant On Lok's Motion to Dismiss. Significantly, the parties' marks are dissimilar in appearance, connotation, and commercial impression, which is reason enough to grant On Lok's motion to dismiss. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (dismissing an opposition solely because of the differences in the marks, and despite the virtual identity of the goods offered under the marks). The likelihood of confusion is even more remote in light of the material differences in the services offered by and the communities served by the parties; the parties' services are not likely to be the subject of impulse purchases but rather careful reflection; and, moreover, Opposers' Mark is not strong and therefore is not entitled to wide protection.

In short, the Board should grant On Lok judgment as a matter of law. And because the obvious facial dissimilarities between the marks is a fatal defect in Opposers' claims that is not capable of cure, the Board should not grant Opposers leave to amend their Notice of Opposition. *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. 151, 154 (T.T.A.B. 1983) (appropriate to deny leave to amend where such amendment would be futile), *aff'd* 739 F.2d 624 (Fed. Cir. 1984).

¹ For the purposes of this Rule 12(b)(6) motion only, On Lok will assume that the facts alleged in Notice of Opposition are true. TBMP § 504.02.

II. STATEMENT OF FACTS

A. On Lok and Its Mark.

On Lok's Mark consists of an elongated adult human torso, which leans to one side. The angle of the adult torso is accentuated by the position of the arms -- one arm extends vertically and the other extends to the side, and both arms reach above the figure's head. The adult torso in On Lok's Mark is entirely contained by a closed oval that appears to have been painted using a brush and ink due to the uneven lines and ink blotch on the left side. *See* Notice of Opp., Ex. B. The brushed appearance of the oval encompassing the adult torso in On Lok's Mark was consciously chosen: On Lok's name means "happy, peaceful" in Chinese, and consistent with the organization's Chinese-themed branding, the oval is intended to evoke Chinese calligraphy.

On April 19, 2007, On Lok filed its application to register On Lok's Mark in Class 43 for "providing congregate, independent retirement, and assisted living housing facilities for senior adults; life care communities in the nature of assisted living facilities, senior retirement housing facilities and retirement homes; providing temporary housing accommodations for senior citizens; day care centers for adults and the elderly." *See* Notice of Opp., Ex. B. The Examining Attorney approved On Lok's application for publication without issuing a Section 2(d) refusal based on Opposer's Mark or, indeed, any office actions. The application was published for opposition on August 7, 2007.

B. Opposers and Their Mark.

Opposers' Mark consists of a chubby child extending both of its arms to the side (not above its head) at the same angle. The child's arms extend beyond an open circle, giving the impression that the torso is in the foreground and the circle is in the background. The circle is not formed by irregular lines and therefore lacks the brush-like quality of On Lok's Mark. The child's hips appear to have a very slight sway, but this sway is deemphasized because the arms extend at the same angle. *See* Notice of Opp., Ex. A.

On February 17, 2006, Opposer ISCA filed an application under Section 66(a) of the Trademark Act of 1946 (the "Act") to register Opposers' Mark in connection with a variety of

goods and services, including “[i]nformation and advisory services in the field of health and nutrition for children and communities in need” in Class 43. *See* Notice of Opp., Ex. A.

In the Notice of Opposition, Opposers allege that they have used Opposers’ Mark with unidentified goods and services in interstate commerce in the United States since May 2002. *See* Notice of Opp. ¶ 2. They also allege that they have used a different mark that is the subject of two U.S. registrations, Nos. 1,080,066 and 2, 617,998, in connection with “charitable fundraising services.” *See* Notice of Opp. ¶ 4.

C. Procedural Background.

After obtaining an extension in which to oppose the registration of On Lok’s Mark, Opposers filed their Notice of Opposition on October 8, 2007. In their written Notice of Opposition, Opposers allege that the parties’ respective marks and services are so similar “as to be likely to cause confusion, or to cause mistake, or to deceive within § 2(d) of the Trademark Act of 1946.” Notice of Opp. ¶ 9. On that basis, Opposers claim that they will be damaged by the registration of On Lok’s Mark.²

III. ARGUMENT AND AUTHORITIES

A. Opposers Have Failed to State a Claim That On Lok’s Mark Should be Denied Registration Under Section 2(d) of the Act.

In opposing the registration of a mark under Section 2(d) of the Act, the opposer must prove that the applicant’s mark so resembles the opposer’s mark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). At the crux of any analysis under Section 2(d) is whether “the

² In the electronic form Opposers completed when filing the Opposition through ESTTA, Opposers also cite Sections 2(a) (deceptiveness and false suggestion of a connection) and 43(c) (dilution) of the Act as bases for their Opposition. Opposers do not mention or discuss Sections 2(a) or 43(c) in their written Notice of Opposition, however, and therefore have not met their pleading burden. *Cf. Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955, 1964-65 (2007) (under Fed. R. Civ. P. 8, “a plaintiff’s obligation to provide the ‘grounds’ of his ‘entitle[ment] to relief’ requires more than labels and conclusions”). In the event that the Board allows Opposers to pursue these claims, On Lok will address why Opposers have failed to state a claim under Sections 2(a) and 43(c), entitling On Lok to judgment as a matter of law.

purchasing public would mistakenly assume that the applicant's goods or services originate with, are sponsored by, or are in some way associated with the goods sold under a cited registration or trademark." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS § 23:78 (4th ed. 1996). The decision in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) sets out factors that may be pertinent to a likelihood of confusion analysis under Section 2(d), including, in relevant part, the dissimilarity of the marks, the dissimilarity of the services, differences in the channels of trade for the parties' services, whether the services are the result of impulse purchases, and the strength of the opposer's mark. *Id.* at 1361. However, a single *Du Pont* factor may be dispositive of the likelihood of confusion analysis, "especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (emphasis added).

Here, a comparison of the parties' marks and consideration of the facts alleged in the Notice of Opposition leads to the inescapable conclusion that there is zero risk that the registration of On Lok's Mark will cause any relevant confusion, and On Lok is entitled to judgment as a matter of law. No confusion is likely because (1) the parties' marks have numerous dissimilarities in their appearance and connotation, and create distinctly different commercial impressions; (2) the parties offer different services; (3) the parties serve entirely different communities and therefore offer their services in different channels of trade; (4) the services are not likely to be the subject of impulse purchases but rather careful reflection; and (5) Opposers' Mark is not strong. On Lok respectfully requests that Opposers' opposition be dismissed with prejudice (without granting leave to amend the Notice of Opposition) and that judgment be entered in On Lok's favor.

1. The Parties' Marks Differ in Appearance and Connotation, and Create Different Commercial Impressions.

An opposer's inability to prove the first *Du Pont* factor, which relates to the similarity or dissimilarity of appearance, sound, connotation, and commercial impression of the marks, is often fatal to its opposition. For example, in *Roederer*, the Federal Circuit agreed with the

Board's decision to dismiss an opposition proceeding solely on account of the differences in the parties' marks. The opposer cited its marks CRISTAL and CRISTAL CHAMPAGNE & Design – both used in connection with champagne – in support of its opposition under Section 2(d) against an application to register the mark CRYSTAL RIVER for wine. In its decision, the Board accepted the opposer's arguments that the goods (wine and champagne) were essentially identical, that the goods traveled in the same channel of trade, that the same or similar consumers purchased the parties' goods, and that the opposer's marks were a “very strong indication of origin for [its] champagne.” 148 F.3d at 1374. Even after accepting these arguments, all of which pointed in favor of the opposer, the Board nonetheless dismissed the opposition proceeding, concluding that the dissimilarities in the appearance, sound, connotation, and commercial impression of the marks eliminated any likelihood of confusion. *Id.* at 1375. In affirming the Board's decision, the Federal Circuit held that the opposer had not persuaded it that “the Board erred in concluding that the marks' dissimilarities were dispositive, notwithstanding due weight being accorded to the DuPont factors found in [opposer's] favor.” *Id.* at 1375 (emphasis added).

Similarly, in *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989), the Federal Circuit affirmed the Board's grant of summary judgment in favor of the applicant. The Board concluded that the applicant's mark, PECAN SHORTEES, and the opposer's mark, PECAN SANDIES, conveyed different commercial impressions, and that as a result, no confusion was likely, even though the marks were used on identical goods, and despite the opposer's use of its mark for 31 years, expenditure of \$8.8 million in advertising, and sales of \$116,900,000. *Id.* at 1388, 1390. In the words of the Board, “the more important fact for resolving the issue of likelihood of confusion in this case is the dissimilarity in commercial impression between the marks ‘PECAN SANDIES’ and ‘PECAN SHORTEES.’” *Id.* at 1388.

As in the *Roederer* and *Keebler* proceedings, the Board should dismiss this opposition proceeding because of the dissimilarities in the appearance, connotation, and commercial impressions of the parties' marks. On Lok's Mark clearly consists of a slender adult, while

Opposers' marks is of a chubby child. The positions of the figures are different, with On Lok's figure dramatically swaying to one side and extending its arms at different angles, and above the figure's head. In addition, the materials surrounding the figures in the parties' marks are very different: a completed oval of irregular lines that appears to have been painted with a brush and ink encompasses On Lok's figure, while an open circle of regular lines (possibly computer-generated) surrounds the figure in Opposers' Mark. *Compare* Notice of Opp., Ex. B *with* Notice of Opp., Ex. A.³ The differences in the parties' marks are significant enough to eliminate any likelihood of confusion, and entitle On Lok to judgment as a matter of law.

The mere fact that both On Lok's Mark and Opposers' Mark contain a human figure (of different ages) in a (differently shaped) ring is not enough to render the marks confusingly similar. In *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 U.S.P.Q.2d 1404 (T.T.A.B. 1988), the Board dismissed an opposition proceeding in which both parties used pentagonal-shaped design marks in connection with services that the Board concluded were related (management of real estate for others and real estate brokerage services). The Board held that “[a]lthough the services rendered by the parties in this proceeding are closely related and the respective marks used by the parties to identify these services can be described in terms which make it sound as if there were a close visual resemblance between them, we find that the marks are sufficiently different in appearance to exist together in the marketplace without the likelihood of confusion.” *Id.* at 1405 (emphasis added); *see also id.* at 1406 (“In the case at hand, although the designs in question may both be characterized as stylized houses, they are so different visually it is not even accurate to describe them as “common elements.”). The Board should

³ In the form Opposers completed to submit their Notice of Opposition via ESTTA, they also reference two U.S. registrations held by ISCA, Nos. 1,080,066 and 2, 617,998. However, in their written opposition papers, Opposers do not allege that On Lok's Mark is confusingly similar to the mark in these registrations. In any event, even if Opposers were claiming that such confusion exists, the claim should be dismissed as On Lok's Mark is even more dissimilar to the mark in these registrations (for example, there is no round shape surrounding the child in the registered mark and the child's hips do not have any sway) than Opposers' Mark.

reach the same result here and conclude that the differences in the parties' marks render any confusion unlikely.

2. The Parties Offer Different Services Under Their Marks.

The differences in the services listed in On Lok's application and those allegedly offered by Opposers also support the conclusion that no confusion is likely. In its application, On Lok listed the following services: "providing congregate, independent retirement, and assisted living housing facilities for senior adults; life care communities in the nature of assisted living facilities, senior retirement housing facilities and retirement homes; providing temporary housing accommodations for senior citizens; day care centers for adults and the elderly." *See* Notice of Opp., Ex. B. Opposers, on the other hand, allege that they have made constructive use of Opposers' Mark in connection with "[i]nformation and advisory services in the field of health and nutrition for children and communities in need." *See id.* ¶ 2 & Ex. A.⁴ On Lok's provision of housing and day care centers for the elderly is vastly different from the informational and consulting services that Opposers allegedly offer under Opposers' Mark. Consumers are not likely to assume that the same entity that provides senior housing also provides health and nutrition information and advisory services in regards to "children and communities in need," not senior citizens. *See id.* ¶ 2 & Ex. A.

In the Notice of Opposition, Opposers mention other services that they allegedly provide, but do not allege that they provide such services under Opposers' Mark. Services that Opposers provide under other trademarks are irrelevant to determining whether On Lok's Mark is confusingly similar to Opposers' Mark unless Opposers can tack the rights acquired under the other trademarks onto Opposers' Mark. For example, Opposers admit that they have used a different mark that is the subject of two registrations (the "Other Mark") in connection with "charitable fundraising services." *See* Notice of Opp. ¶ 4. Because the Other Mark is easily

⁴ By only referencing the Class 43 "information and advisory services" in its written Notice of Opposition, Opposers impliedly admit that the numerous other goods and services listed in the application to register Opposers' Mark (including such items as "wax candles" in Class 4) are not remotely similar to the services listed in On Lok's application.

distinguishable from Opposers' Mark, Opposers cannot "tack" any rights acquired from their use of the Other Mark onto Opposers' Marks as a matter of law.⁵ In *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999), the Ninth Circuit rejected an analogous effort to "tack" rights from an earlier mark onto a later mark, holding that the defendant's prior use of "The Movie Buff's Movie Store" did not give it rights in "moviebuff." *Id.* at 1049. Only if two marks are "are so similar that consumers generally would regard them as essentially the same" can use of one mark give rise to rights in another mark, a standard of similarity that is "considerably higher than the standard for 'likelihood of confusion.'" *Id.* at 1048. The Ninth Circuit explicitly recognized that only in "exceptionally narrow" circumstances will two marks will be viewed as sufficiently similar for tacking to be permitted. *Id.* at 1047; *id.* at 1048-49 (citing with approval *American Paging, Inc. v. American Mobilphone, Inc.*, 13 U.S.P.Q.2d 2036 (T.T.A.B. 1989), *aff'd*, 923 F.2d 869 (Fed. Cir. 1990), in which the Board held that AMERICAN MOBILPHONE and a design was not similar enough to AMERICAN MOBILPHONE PAGING and the same design in order for the use of one mark to give rights in the other); *see also Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623-24 (6th Cir. 1998) (stylized "dci" not equivalent to "DCI.COM," so prior use of the former did not create rights in the latter).

The Board should not permit Opposers to tack any rights they may have in the Other Mark onto Opposers' Mark because consumers will not view the marks as identical. These two marks are as dissimilar as "The Movie Buff's Movie Store" and "moviebuff," and even more dissimilar than AMERICAN MOBILPHONE and AMERICAN MOBILPHONE PAGING, and "dci" and DCI.COM. In contrast with the child in Opposers' Mark, the child in the Other Mark

⁵ *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (affirming the Board's decision to reject a tacking argument, and stating "[a] determination by the Board that two marks are so confusingly similar that they constitute legal equivalents is a legal determination").

is not encompassed by a circle, the child's hips do not have any sway, and the child is relatively slender.⁶

In sum, the parties offer or intend to offer different services under the marks relevant to this proceeding – On Lok's Mark and Opposers' Mark – and this *Du Pont* factor points in On Lok's favor.

3. The Parties Serve Different Communities and Therefore Operate in Different Trade Channels.

On Lok and the Opposers offer (or intend to offer) their services to very different individuals and entities, and therefore do not operate in the same trade channels, further reducing any risk of confusion. The likely recipients of the services listed in On Lok's application – “providing congregate, independent retirement, and assisted living housing facilities for senior adults; life care communities in the nature of assisted living facilities, senior retirement housing facilities and retirement homes; providing temporary housing accommodations for senior citizens; day care centers for adults and the elderly” – will be senior citizens who are members of the general public in need of housing and day care center services. In contrast, the likely recipients of the services in the application for Opposers' Mark – “[i]nformation and advisory services in the field of health and nutrition for children and communities in need” – will be companies or organizations that operate in the field of health and nutrition for children and communities in need. This factor also points in favor of granting On Lok's Motion to Dismiss.

4. The Consumers of the Parties' Services Are Sophisticated.

Senior citizens needing the housing and day care services listed in On Lok's application are likely to take great care before selecting the provider of such services. The selection of where one lives or spends one's day is typically not an impulse decision. Similarly, the organizations that are the likely recipients of the “advisory services” that Opposers allegedly

⁶ In any event, the services allegedly provided under the Other Mark – “charitable fundraising services” – are not similar to the senior housing -related services listed in On Lok's application, and therefore do not make confusion likely.

provide are also likely to take great care before retaining an advisor. The “sophistication” of the recipients of the parties’ services makes it unlikely that the coexistence of On Lok’s Mark and Opposers’ Mark will cause any relevant confusion.

5. Opposers’ Mark is Not a Strong Trademark Entitled to Wide Protection.

Opposers’ Mark is not a strong mark that should be given the wide protection they are claiming in this opposition proceeding. First, Opposers’ Mark merely consists of a chubby child, with outstretched arms, and a partially enclosed circle, which are common, unoriginal design elements. *See, e.g., National Rural Electric Cooperative Ass’n v. Suzlon Wind Energy Corp.*, 78 U.S.P.Q.2d 1881, 1883 (T.T.A.B. 2006) (“The circle design is hardly particularly distinctive in trademark designs.”); *aff’d* 214 Fed. Appx. 987 (Fed. Cir. 2007). Second, Opposers’ Mark is descriptive (or at best, suggestive) of Opposers’ services of providing “[i]nformation and advisory services in the field of health and nutrition for children and communities in need.” *See Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 U.S.P.Q.2d 1404 (T.T.A.B. 1988) (pentagonal shape was suggestive of real estate-related services offered by the parties, and holding that “[t]he mere presence of a common, suggestive element in two marks is usually not enough support upon which to base a finding that confusion is likely”). Third, Opposers have not alleged that they have used Opposers’ Mark in connection with the services that they claim are similar to On Lok’s services for very long so as to have built up strength in their Mark. The application to register Opposers’ Mark was only filed on February 17, 2006, meaning that ISCA has not even made constructive use of Opposers’ Mark in connection with the “information and advisory services” for two years.

Opposers’ other allegations that theoretically could relate to the strength of Opposers’ Mark fail to demonstrate that it is strong. Significantly, the allegations relating to Opposers’ use of Opposers’ Mark since May 2002, the “substantial” amount of advertising, the “excellence” of Opposers goods and services, “unsolicited media attention,” and “wide recognition” of Opposers’ Mark fail to identify the goods or services associated with such use, advertising,

media attention, etc. See Notice of Opp. ¶¶ 2, 5. Under such allegations, Opposers' Mark could have enormous good will built up in association with wax candles, for example, but that does not create a risk of confusion with On Lok's Mark for senior housing services. Lastly, Opposers' alleged use of the Other Mark since 1977 in connection with charitable fundraising services is irrelevant to these proceedings since Opposers cannot tack any rights it has acquired under the Other Mark onto Opposers' Mark, as discussed in Section III.A.2 *supra*, and, moreover, charitable fundraising services are unrelated to the senior housing services On Lok intends to provide under its mark.

B. Opposers Have Failed to State a Claim That On Lok's Mark Should be Denied Registration Under Section 2(a) of the Act.

As explained in footnote 1 *supra*, Opposers have not alleged in their written Notice of Opposition that the Board should reject the registration of On Lok's Mark under Section 2(a) of the Act; however, Opposers referenced Section 2(a)'s "false suggestion" and "deceptiveness" prongs in the ESTTA form they completed when filing the Notice of Opposition. Opposers' failure to plead the elements of a claim under Section 2(a) is reason enough to dismiss the claim. *Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955 (2007). In any event, the claim is defective and should be dismissed.

For claims under the "false suggestion" prong of Section 2(a), the same analysis applies as is applied to claims under Section 2(d). *Morehouse Mfg. Co. v. J. Strickland & Co.*, 407 F.2d 881, 888-89 (C.C.P.A. 1969) (applying same likelihood of confusion analysis to claim under Section 2(a) that the mark "falsely suggest[s] a connection" as is applied under Section 2(d)). Thus, if Opposers are claiming that On Lok's registration should be rejected under Section 2(a)'s "false suggestion" prong, the claim should be dismissed for the same reasons as Opposers' Section 2(d) claim, as discussed in Section III.A *supra*.

A claim under the "deceptiveness" prong of Section 2(a) should also be dismissed. Typically, a mark will be held "deceptive" under Section 2(a) if "an essential and material element is misrepresented, is distinctly false, and is the very element upon which the customer

relies in purchasing one product over another.” *Gold Seal Co. v. Weeks*, 129 F. Supp. 928 (D.D.C. 1955), *aff’d*, 230 F.2d 832 (D.C. Cir. 1956); *see also In re Budge Mfg. Co.*, 857 F.2d 773 (Fed. Cir. 1988). For example, marks that mislead consumers as to the nature of the goods, such as suggesting that a product is leather when it is not, are examples of the kind of deception relevant to Section 2(a). *See, e.g., Tanners’ Council of America, Inc. v. Samsonite Corp.*, 204 U.S.P.Q. 150 (T.T.A.B. 1979) (SOFTHIDE for imitation leather held deceptive).

Opposers have not alleged (and cannot allege) any facts to support a claim that On Lok’s Mark is “deceptive” within the meaning of Section 2(a). On Lok’s Mark clearly does not misrepresent any material element of On Lok’s services provided under the mark. Opposers only reference to deception in the written Notice of Opposition is in connection with Section 2(d), which relates to deceiving consumers regarding the source or sponsorship of goods or services, not the nature of the goods. *See* Notice of Opp. ¶ 9; *see also* 15 U.S.C. § 1052(d). To the extent that Opposers’ Section 2(a) claim relates to the kind of “deception” relevant to a Section 2(d) claim, then their Section 2(a) claim should be dismissed for the same reasons as their Section 2(d) claim.

C. Opposers Have Failed to State a Claim That On Lok’s Mark Should be Denied Registration Under Section 43(c) of the Act.

In their written Notice of Opposition, Opposers failed to present any allegations to support a claim under Section 43(c), although they did reference Section 43(c) in the ESTTA form they completed when filing the Notice of Opposition. In the event the Board allows Opposers to pursue a claim under Section 43(c) despite their defective pleading, *see Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955 (2007), their claim should be dismissed.

Under Section 43(c), “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring.” 15 U.S.C. § 1125(c).⁷ Such “blurring”

⁷ Dilution can also occur by tarnishment; however, the written Notice of Opposition does not

occurs when an “association aris[es] from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” *Id.* § 1125(c)(2)(B). Dilution is an exceptional remedy and any doubts about whether dilution is likely to occur are not resolved in favor of the opposer. *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1514 (T.T.A.B. 2005).

Importantly, in order for dilution by blurring to occur, On Lok’s Mark would have to be identical or at least extremely similar, more similar than the degree of similarity required in the likelihood of confusion analysis. *Carefirst of Maryland, Inc.*, 77 U.S.P.Q.2d at 1514 (holding that the marks must be identical or very similar so that prospective purchasers see the marks as essentially the same; the marks CAREFIRST and FIRSTCAROLINACARE for competitive health care plans were not similar enough to support an opposition founded on dilution); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1183 (T.T.A.B. 2001) (“For dilution purposes, a party must prove more than confusing similarity; it must show that the marks are identical or “very or substantially similar”; the marks TORO and ToroMR & Design were not sufficiently similar for finding dilution); *see also Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433-34 (2003) (where marks are not identical, mere fact that consumers may mentally associate the marks is not enough to prove dilution by blurring; there must be a likelihood that the junior mark will reduce the capacity of a famous mark to identify the goods or services of its owner). As discussed in Section III.A.1 *supra*, On Lok’s Mark is not even similar enough to Opposers’ Mark to give rise to any likelihood of confusion, and therefore cannot possibly dilute Opposers’ Mark, reason enough to dismiss Opposers’ dilution claim.

remotely suggest that dilution by tarnishment is at issue, nor could it be. For tarnishment to exist, an alleged association between On Lok and Opposers would have to “harm[] the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(C) (“[D]ilution by tarnishment’ is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”). The services listed in On Lok’s application are not the kind of services that could tarnish the reputation of Opposers’ Mark. *See, e.g., Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (dilution by tarnishment occurs from association of the famous mark with an illegal drug).

Moreover, in order to be susceptible to dilution, Opposers' Mark would have to be "famous," *see* 15 U.S.C. § 1125(c), and Opposers have not alleged any facts capable of supporting such a claim. *Cf. Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955, 1964-65 (2007) (under Fed. R. Civ. P. 8, "a plaintiff's obligation to provide the 'grounds' of his 'entitle[ment] to relief' requires more than labels and conclusions"). Indeed, the facts alleged by Opposers do not even suggest that Opposers' Mark is strong, *see* Section III.A.5 *supra*, and therefore cannot support a claim that Opposers' Mark is famous as it is even more difficult to demonstrate that a mark is famous. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1170, 1180 (T.T.A.B. 2001) ("A mark may have acquired sufficient public recognition and renown to demonstrate that it is a strong mark for likelihood of confusion purposes without meeting the stringent requirements to establish that it is a famous mark for dilution purposes. . . . Fame for dilution purposes is difficult to prove.").

IV. CONCLUSION

For the foregoing reasons, On Lok respectfully requests that the Board dismiss Opposers' opposition proceeding, without granting Opposers leave to amend their Notice of Opposition.

Dated: November 19, 2007

Respectfully submitted,


Catherine E. Maxson
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ON LOK, INC.

CERTIFICATE OF MAILING AND SERVICE

I hereby certify that on November 19, 2007 I filed a true and complete copy of the foregoing MOTION TO DISMISS and BRIEF IN SUPPORT OF MOTION TO DISMISS through ESTTA, and served a true and complete copy on Stephen Kahn by mailing said copy on November 19, 2007, via First Class Mail, postage prepaid to:

Stephen Kahn
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153



Kristine Fyfe