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

Proceeding	91179979
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTERNATIONAL SAVE THE CHILDREN  
ALLIANCE AND SAVE THE CHILDREN  
FEDERATION, INC.

Opposers,

v.

ON LOK, INC.,

Applicant.

Opposition No. : 91179979

Serial No. : 77/161, 103

Filing Date : April 19, 2007

Mark : **Design Mark**

Class : 043

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Trademark Trial and Appeal Board  
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**OPPOSERS' RESPONSE TO APPLICANT'S MOTION TO DISMISS**

International Save the Children Alliance and Save the Children Federation, Inc. (collectively, "Save the Children" or "Opposers") submit this memorandum in opposition to Applicant On Lok, Inc.'s Motion to Dismiss and request that the Trademark Trial and Appeal Board (the "Board") deny Applicant's motion for the reasons set forth below.

Applicant's arguments in support of its motion are not appropriate at this stage of the proceeding. Applicant has not attacked the legal sufficiency of the Notice of Opposition (no doubt because it recognizes that the notice is sufficient) but instead undertakes a likelihood-of-confusion analysis – a factual analysis that cannot be properly addressed without an opportunity for discovery and the submission of evidence (at which point it will be clear that Opposers'

factual assertions are correct). Opposers' Notice of Opposition provides Applicant with proper notice of their claims and meets the pleading requirements set forth in Federal Rule of Civil Procedure 8(a).

## **I. SUMMARY OF ALLEGATIONS MADE IN THE NOTICE OF OPPOSITION**

Opposer International Save the Children Alliance is the owner of the design trademark and service mark, as shown in U.S. Application Serial No. 79/022,838 ("Save the Children's Mark"), which Opposers have used in interstate commerce since May 2002. Save the Children has expended a substantial amount of time and effort in advertising and promoting that mark. Applicant filed an intent-to-use application for registration of a design mark on Principal Register of the United States Patent and Trademark Office on April 19, 2007, Serial No. 77/161,103 for a mark virtually identical to Save the Children's mark. In addition, both Applicant's mark and Save the Children's Mark are used for services that fall into Class 43 and thus operate in the same channels of trade.

## **II. SAVE THE CHILDREN'S NOTICE OF OPPOSITION STATES A CLAIM UPON WHICH RELIEF MAY BE GRANTED**

Save the Children's Notice of Opposition satisfies the standards set forth in Federal Rule of Civil Procedure 8(a)(2), which requires only "a short and plain statement" setting forth the opposer's grounds for relief in order to give Applicant "fair notice." *See Fair Indigo LLC v. Style Conscience*, Opp. No. 91175571, 2007 WL 4162785, at \*3 (T.T.A.B. Nov. 21, 2007) (discussing requirements under the "notice pleading system"). The purpose of a Rule 12(b)(6) motion is to challenge "the legal theory of the complaint, not the sufficiency of any evidence that might be adduced," and "to eliminate actions that are fatally flawed in their legal premises and destined to fail." *Fair Indigo*, 2007 WL 4162785, at \*3 (quoting *Advanced*

*Cardiovascular Sys., Inc. v. SciMed Life Sys., Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993)). Thus, to withstand a motion to dismiss for failure to state a claim, an opposer need only allege facts that would, *if proved*, establish (1) the opposer's standing to maintain the proceedings, and (2) a valid ground for opposing the mark. *Fair Indigo*, 2007 WL 4162785, at \*2; *see also Bell Atl. Corp. v. Twombly*, -- U.S. --, 127 S. Ct. 1955, 1966 (2007) (complaint must plead enough facts to plausibly suggest that the plaintiff will be entitled to relief). For purposes of deciding a motion to dismiss, all well-pleaded allegations in the notice of opposition must be accepted as true, and the pleading must be construed in the light most favorable to the opposer. *Fair Indigo*, 2007 WL 4162785, at \*2 (citing *Advanced Cardiovascular*, 988 F.2d at 1160-61); *see also Ritchie v. Simpson*, 170 F.3d 1092, 1097 (Fed. Cir. 1999). Dismissal is appropriate "only if it appears certain that opposer is entitled to no relief under any set of facts which could be proved in support of its claim." *Fair Indigo*, 2007 WL 4162785, at \*2 (citing *Stanspec Co. v. Am. Chain & Cable Co.*, 531 F.2d 563, 566 (C.C.P.A. 1976)).

Moreover, as courts have recognized, the question of likelihood of confusion requires a "fact-intensive analysis that ordinarily does not lend itself to a motion to dismiss." *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp. 2d 402, 412 (S.D.N.Y. 2006); *see also Google, Inc. v. Am. Blind & Wallpaper Factory*, No. C 03-05340, 2005 WL 832398, at \*6 (N.D. Cal. Mar. 30, 2005) (holding that it would be "inappropriate" to "make factual findings and draw legal conclusions, particularly with regard to likelihood of confusion," on a motion to dismiss without the benefit of a full factual record); *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 704 (E.D. Va. 2004) (noting that likelihood of confusion is a "fact-specific issue[] not properly resolved through a motion to dismiss").

Here, the facts pleaded by Save the Children would, if proved, establish both standing to oppose registration of Applicant's mark and valid grounds for relief. First, Save the Children has alleged that it would be damaged by the registration of Applicant's mark, which is virtually identical to Save the Children's Mark and likely to cause confusion. (Notice of Opp. ¶ 9.) Applicant has not challenged Save the Children's standing to oppose registration, and indeed, there is no question that Save the Children has the requisite "real interest" in the outcome of the proceeding, along with a "reasonable belief" that it would be damaged by the registration of Applicant's mark. *See Ritchie*, 170 F.3d at 1095-99. Second, Save the Children has alleged that due to the similarity of the parties' marks and services, Applicant's mark is likely to cause confusion with Save the Children's senior mark, or to cause mistake, or to deceive within § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052. (Notice of Opp. ¶ 9.) To support these allegations, Save the Children has attached copies of both marks to the Notice of Opposition and described both parties' services in sufficient detail to give Applicant fair notice of the claims. *See Fair Indigo*, 2007 WL 4162785, at \*3 ("[T]he allegations of a complaint should be construed liberally so as to do substantial justice."). Thus, the Notice of Opposition is sufficient on its face to give Applicant proper notice and to state a valid claim upon which relief may be granted.

Applicant, ignoring these well-established standards for deciding a Rule 12(b)(6) motion, insists on debating factual issues before any discovery has taken place. For page after page, Applicant's Motion to Dismiss, which, to be meaningful, should have challenged the legal sufficiency of the Notice of Opposition, analyzes in factual detail the *degree* of similarity between the parties' marks, services, and channels of trade – all without a single supporting

affidavit.<sup>1</sup> (See Applicant’s Br. at 4-12.) Such issues are not properly before this Board on a motion to dismiss. See *Fair Indigo*, 2007 WL 4162785, at \*5 (“[A]pplicant misunderstands that under the notice pleading rules applicable to this proceeding opposer is only required to state a valid claim. Applicant’s arguments and evidence are . . . more appropriate on summary judgment or for submission as evidence during its testimony period and for argument as part of its trial brief.”).

Indeed, none of the authorities cited by Applicant on the issue of likely confusion involve a motion to dismiss for failure to state a claim; rather, all involve dispositions *after* the introduction of evidence. For example, Applicant glibly notes that in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, the Federal Circuit “agreed with the Board’s decision to dismiss an opposition proceeding solely on account of the differences in the parties’ marks.” (Applicant’s Br. at 5-6 (citing 148 F.3d 1373 (Fed. Cir. 1998)).) However, the Board’s “dismissal” occurred *after* the applicant had served an answer to the Notice of Opposition and after both parties had introduced evidence. See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, Opp. No. 80,932, 1997 TTAB LEXIS 61, at \*2-\*3 (T.T.A.B. June 25, 1997) (relying on a record that included “the testimony upon written questions of opposer’s vice president, Fabrice Rosset; the testimony declarations of Patricia Towers and Beth Brown in behalf of applicant; and the rebuttal testimony declaration of opposer’s witness Fabrice Rosset”). Similarly, in *Red Carpet Corp. v. Johnstown American Enterprises*, the record for summary judgment included discovery responses, depositions with associated exhibits, and “copies of one

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<sup>1</sup> For example, Applicant states without any evidence that “the likely recipients of the services in the application for Opposers’ Mark” will be “companies or organizations” rather than “members of the general public.” (Applicant’s Br. at 10.) Applicant provides no basis – and certainly no evidence – for this conclusion. Moreover, the court’s analysis in considering a motion to dismiss must be limited to “facts stated in the complaint.” *Merck*, 425 F. Supp. 2d at 409.

hundred and seventy third-party registrations.” 7 U.S.P.Q.2d 1404, 1405 (T.T.A.B. 1988). Far from supporting Applicant’s Motion to Dismiss, these cases demonstrate that even when the issue is the similarity of the marks themselves, a well-developed factual record is necessary to determine the likelihood of confusion.

In this Opposition, the similarity of the marks, services, and channels of trade are all key issues, and the parties have had no opportunity to present evidence or conduct discovery on them. The Board has no factual record on which to conduct an analysis of likely confusion, and at this stage it does not need one – the only question on the Motion to Dismiss is whether Save the Children has stated a claim upon which relief can be granted. Applicant’s factual arguments have no bearing on whether Save the Children has stated a valid claim for relief, and therefore the Motion to Dismiss should be denied.

### **III. CONFUSION IS LIKELY BECAUSE THE PARTIES’ MARKS ARE EXTREMELY SIMILAR**

Even if it were proper for the Board to determine the likelihood of confusion on a Motion to Dismiss, the only factor for which the Board currently has *any* guidance is the similarity of the marks themselves.<sup>2</sup> (*See* Notice of Opp. Exs. A-B (presenting both parties’ marks).) This factor is decided by considering the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The test is not a strict side-by-side comparison, but rather one that accounts for the “fallibility of memory.” *E.g. San Fernando Elec. Mfg. Co. v. JFD Elecs. Component Corp.*, 565 F.2d 683, 685 (C.C.P.A. 1977); *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1976). The emphasis must be on the “recollection of the average

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<sup>2</sup> Therefore, only this factor is addressed here. Save the Children reserves its other factual arguments for their proper place later in the proceeding.

purchaser, who normally retains a general rather than a specific impression of trademarks.”

*Sealed Air*, 190 U.S.P.Q. at 108.

Here, an average purchaser or potential donor who encounters the parties’ marks separately would undoubtedly remember the same visual and commercial impression. All of Applicant’s picayune distinctions, even if they outweighed the specific similarities between the marks, could not change the overall impression: that of a cleanly drawn human figure in solid ink, arms outstretched and surrounded by a circular design. To distinguish its mark from Save the Children’s, Applicant argues that its design is slightly elliptical, the arms are somewhat tilted to one side, and the human figure is that of an “adult.” (See Applicant’s Br. at 6-7.) But the distinction between an adult and a child is virtually impossible to discern in these simple ink designs, and the other subtle variations are insufficient to create any memorable difference between the marks. See *Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587 (C.C.P.A. 1973) (“That one figure is upright and apparently spry while the other is slightly stooped is, we believe, a difference not likely to be recalled by purchasers seeing the marks at spaced intervals.”). This Board discounted subtle variations and found a likelihood of confusion between two encircled ink drawings in *Westinghouse Elec. Corp. v. PEK, Inc.*, 184 U.S.P.Q. 559 (T.T.A.B. 1974). In that opposition, one party’s mark depicted a stylized letter *W* while the other’s contained three cursive letter *i*’s. The Board found the resulting designs very similar, regardless of what the parties chose to call the letters within the circles. See *id.* at 559. Likewise, whether Applicant characterizes its mark as depicting an adult or a child, the design is extremely similar to Save the Children’s Mark.

The similarity between the parties’ designs continues even down to the finest details. There are many ways to draw a simple human figure, but Applicant’s Mark copies Save

the Children's method precisely. Both designs employ a solid, circular head floating above a smooth, U-shaped stroke representing the shoulders and arms. Save the Children's surrounding circle, just like Applicant's, is irregular in thickness. Ultimately, Applicant's Mark is just a slightly bent version of Save the Children's Mark. Given the extreme similarity of these marks, the likelihood of confusion is very high.<sup>3</sup>

#### **IV. SAVE THE CHILDREN IS NOT "TACKING" ANY RIGHTS ACQUIRED UNDER ITS PRIOR TRADEMARKS**

Applicant argues that Save the Children cannot properly "tack" rights acquired under other trademarks onto Save the Children's Mark for purposes of this Opposition. But Save the Children is not attempting any such tacking. The Notice of Opposition relies on the rights acquired under the mark attached thereto as Exhibit A (Save the Children's Mark). Save the Children's priority in this mark, which it has used in interstate commerce since 2002, is entirely sufficient to support the claims in this proceeding.<sup>4</sup> Thus, Applicant's Motion to Dismiss should be denied regardless of whether Save the Children could properly tack on rights related to older trademarks.

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<sup>3</sup> Applicant argues that the failure of the examining attorney for Applicant's Mark to cite Save the Children's Mark as a conflicting mark likely to cause confusion supports its argument. However, the examining attorney's failure to detect likely confusion when approving Applicant's Mark for publication does not affect this Board's decision on the issue. *See McDonald's Corp. v. McClain*, 37 U.S.P.Q.2d 1274, 1995 WL 785743, at \*3 (T.T.A.B. 1995) (Board has "the authority to reach whatever decision is supported by this record," and need not accept the examining attorney's conclusion).

<sup>4</sup> Applicant further argues that "[b]y only referencing the Class 43 'information and advisory services' in its written Notice of Opposition," Save the Children "impliedly admit[s] that the numerous other goods and services listed in the application to register Opposers' Mark . . . are not remotely similar to the services listed in On Lok's application." (Applicant's Br. at 8 n.4.) Save the Children makes no such admissions. On the contrary, Save the Children seeks an opportunity to proceed with the Opposition and discover the full extent of similarity between the parties' goods and services under the marks in question.

**CONCLUSION**

For the foregoing reasons, Save the Children respectfully requests that the Board deny Applicant's Motion to Dismiss.

Dated: December 10, 2007

Respectfully Submitted,



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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of Opposers' Response to Applicant's Motion to Dismiss was mailed, first-class postage prepaid to the following on December 10, 2007:

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