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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.
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Reply Brief in Support of Applicant's Motion to Dismiss - Opp. No. 91179979.pdf (8 pages)(318586 bytes)

any relevant confusion. The obvious differences in the parties' marks are reason enough to grant On Lok's Motion. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (dismissing an opposition proceeding solely because of the differences in the marks, and despite the virtual identity of the goods offered under the marks).¹ No amount of evidence can remedy this fatal flaw in Opposers' claim. In addition, Opposers' claim under Section 2(d) is "fatally flawed" as a matter of law for other, independent reasons, such as the blatant differences in the parties' services.

In short, the Board should grant On Lok's Motion to Dismiss, and because the dissimilarities between the parties' marks is a defect in Opposers' claim 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).

II. ARGUMENT

Before responding to the few substantive arguments Opposers make regarding whether the Notice of Opposition fails to state a claim under Section 2(d), it is worth highlighting two issues that became clear as a result of Opposers' Response brief. **First**, in their brief, Opposers provided no response to the portion of On Lok's Motion seeking dismissal of the claims under Sections 2(a) and 43(c). Opposers' silence is a concession that they have not stated a claim under Sections 2(a) and 43(c), and the Board should dismiss these claims. *See* 37 C.F.R. § 2.127(a) ("When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded."). **Second**, Opposers admitted in their brief that they are not relying on any rights that they may have acquired in the mark that is the subject of two current U.S. trademark registrations (Reg. Nos. 1,080,066 and 2,617,998). Rather, Opposers rely entirely on any rights they may have in the mark that is the subject of the application attached as Exhibit A to the

¹ As will be discussed *infra*, in *Champagne Louis Roederer* the Board did not rely on testimony in dismissing the opposer's claim, as Opposers falsely allege. Response at 5.

Notice of Opposition. Response at 8. Thus, Opposers' allegations in the Notice of Opposition relating to the registrations should be ignored as they are wholly irrelevant to these proceedings.

Turning to the claim that remains in this proceeding – that On Lok's mark allegedly so resembles Opposers' mark as to create a likelihood of confusion within Section 2(d) – it is clear that Opposers have not stated a claim. At the crux of any analysis under Section 2(d) is whether “the 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). Contrary to Opposers' argument, this is an issue that is capable of resolution as a matter of law on a motion under Fed. R. Civ. P. 12(b)(6). *See, e.g., Murray v. Cable Nat'l Broadcasting Co.*, 86 F.3d 858, 860 (9th Cir. 1996) (“If the court determines as a matter of law from the pleadings that the goods are unrelated and confusion is unlikely, the complaint should be dismissed.”); *Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981) (affirming grant of motion under Fed. R. Civ. P. 12(b)(6) due to no likelihood of confusion); *Marvel Enterprises, Inc. v. NCSoft Corp.*, 74 U.S.P.Q.2d 1303, 1308 (C.D. Cal. 2005) (“That the terms at question here are entirely dissimilar is self-evident. Thus, there is no likelihood of confusion”; granting motion to dismiss claim for trademark infringement).

Opposers have devoted scant attention to the substance of On Lok's argument that no likelihood of confusion exists as a matter of law. On Lok will respond to the few points put forth in Opposers' Response brief.

First, under any comparison, the parties' marks are dissimilar in appearance, connotation, and commercial impression, which is reason enough to prevent any reasonable likelihood of confusion and warrant granting On Lok's Motion to Dismiss. *Champagne Louis Roederer*, 148 F.3d at 1375; *see also Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386 (Fed. Cir. 1989) (PECAN SHORTEES and PECAN SANDIES convey different commercial impressions, and as a result, no confusion was likely). Anyone can easily perceive that the parties' marks use different shapes to surround the differently aged and shaped (chubby versus slender) figure in the

center of the mark, among other differences. *See* Motion to Dismiss at 6-7. Opposers' argument that it "is virtually impossible to discern" that Opposers' mark is of a child and On Lok's mark is of an adult human is rebutted by the design codes the USPTO assigned to the mark, which codes specifically recognize the differences in the ages of the humans in the center of the marks.

Compare Notice of Opposition, Ex. A (using the design code associated with "children") *with id.*, Ex. B (using the design code associated with "monsters" and "[o]ther grotesque including men"). Similarly, the design codes also reflect the ease with which anyone can discern that an incomplete circle surrounds the child in Opposers' mark, while a complete oval surrounds the adult figure in On Lok's mark. *Compare id.*, Ex. A (using the design code for "circles, incomplete") *with id.*, Ex. B (using the design code for "ovals").

Opposers attempt to gloss over the significant differences in the marks by describing them collectively in a ridiculously broad fashion: "a cleanly drawn human figure in solid ink, arms outstretched and surrounded by a circular design." Response at 7. Even if the parties' marks "can be described in terms which make it sound as if there were a close visual resemblance between them," this is not enough to hold that confusion is likely. *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 U.S.P.Q.2d 1404, 1405 (T.T.A.B. 1988); *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.").

Opposers' effort to use the Board's decisions in *Champagne Louis Roederer* and *Red Carpet* to argue that "a well-developed factual record is necessary to determine the likelihood of confusion" (Response at 6) backfires as these cases prove just the opposite: in neither case did the Board's grant of dismissal due to the lack of similarity between the marks rely on materials that would be unavailable in deciding a motion to dismiss. For example, in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 1997 TTAB LEXIS 61 (T.T.A.B. 1997), the Board held that the marks CRISTAL (champagne) and CRYSTAL CREEK (wine) were not confusingly similar because as a result of "the differences in the marks in significance, sound, and

appearance, they create distinctly different commercial impressions.” 1997 TTAB LEXIS 61 at *13-15. The only “evidence” that the Board referenced in so holding consisted of the dictionary definitions of “crystal” and “cristal.” 1997 TTAB LEXIS 61 at *14. However, the Board can take judicial notice of dictionary definitions, *id.* at *15 n.15, and the Board may consider “matters subject to judicial notice” in deciding a motion to dismiss. *Merck & Co. v. Mediplan Health Consulting, Inc.*, 425 F. Supp.2d 402, 410 (S.D.N.Y. 2006). Similarly, in *Red Carpet*, the Board concluded that the marks were different in appearance based on a comparison of the marks and without reliance on any evidence. Although the Board found “support” from third-party registrations for its conclusion that the marks lacked similarity, it stated that such registrations “are of little probative value in determining whether the marks here in issue, considered in their entireties, are likely to cause confusion.” 7 U.S.P.Q.2d at 1406. This is hardly a statement that a factual record is “necessary” to decide whether marks are dissimilar in appearance, connotation, and meaning.

Second, and contrary to Opposers’ argument, the differences in the parties’ marks is not the only issue on which the Board has guidance at this stage. Response at 6. In deciding whether the parties’ respective services are sufficiently similar to give rise to a likelihood of confusion, the Board is to consider the services On Lok listed in its application with those that Opposers allege to have provided under their mark in their Notice of Opposition. *Fossil, Inc. v. The Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) (in an opposition proceeding based on Section 2(d), the Board compared applicant’s mark and goods as listed in its application with the mark and goods opposing party pleaded in its Notice of Opposition; Board did not consider marks or goods unpleaded by opposing party). Where, as here, the dissimilarities in the services are self-evident, *see* Motion to Dismiss at 8-10, the Board should grant the motion to dismiss. *See, e.g., Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981) (affirming grant of motion under Fed. R. Civ. P. 12(b)(6); as a matter of law, no likelihood of confusion between BAGZILLA and GODZILLA marks used in connection with garbage bags and in connection with literary works and toys, respectively).

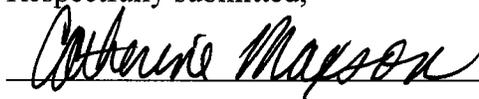
Third, the Board can (and should) hold as a matter of law that On Lok offers its services of “providing congregate, independent retirement, and assisted living housing facilities for senior adults; life care communities in the nature of assisted living facilities, senior retirement housing facilities and retirement homes; providing temporary housing accommodations for senior citizens; day care centers for adults and the elderly” in a different channel of trade than Opposers offer their services of “[i]nformation and advisory services in the field of health and nutrition for children and communities in need.” *Toho Co.*, 645 F.2d at 790 (holding that marketing channels used for the parties’ goods were different as a matter of law). That senior citizens who are members of the general public and in need of housing and day care center services are the likely recipients of On Lok’s services, and that entities that operate in the field of health and nutrition for children and communities in need are the likely recipients of Opposers’ consulting services, is obvious from the face of the descriptions of the parties’ services; no other evidence is required. *Cf. Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1503-04 (T.T.A.B. 2005) (relying on “common knowledge” to hold that consumers will exercise care before choosing the healthcare services offered by the parties), *aff’d on other grounds* 479 F.3d 825 (Fed. Cir. 2007). That the parties’ services all fall into Class 43 does not mean that the parties operate in the same channels of trade, as Opposers have argued. Response at 2. According to the USPTO’s trademark identification manual, “bar and restaurant services” also fall in Class 43, but it is hard to imagine that even Opposers would argue that such services are offered in the same channel of trade as either On Lok’s or Opposers’ services.

III. CONCLUSION

In sum, for the foregoing reasons and those put forth in On Lok’s Motion to Dismiss, the Board should dismiss all of the claims in Opposers’ Notice of Opposition, and grant On Lok judgment as a matter of law.

Dated: December 28, 2007

Respectfully submitted,



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CERTIFICATE OF MAILING AND SERVICE

I hereby certify that on December 28, 2007 I filed a true and complete copy of the foregoing Reply Brief in Support of Applicant's Motion to Dismiss through ESTTA, and served a true and complete copy on Stephen Kahn by mailing said copy on December 28, 2007, via First Class Mail, postage prepaid to:

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