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March 19, 2008

VIA US MAIL

USPTO
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

17/029,943

Re: **Petitioner:** **Just Service, Inc.**
 Applicant: **BountyJobs, Inc.**
 Opposition No.: **91,182,436**

Dear Sir/Madam:

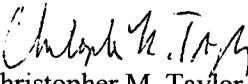
Enclosed please find the following documents for filing with the Trademark Trial and Appeal Board:

- **Applicant's Motion to Dismiss Opposition 91,182,436 Pursuant to Fed. R. Civ. Pro. 12(B)(6) for Failure to State a Claim Upon Which Relief May Be Granted**
- **Applicant's Brief in Support of its Motion to Dismiss Opposition 91,182,436 Pursuant to Fed R. Civ. Pro. 12(B)(6) for Failure to State a Claim Upon Which Relief May Be Granted**
- **Certificate of Service**

Thank you in advance for your assistance in this regard. If you have any questions, please do not hesitate to call me at (734) 995-3110.

Very truly yours,

BUTZEL LONG


Christopher M. Taylor

CMT/pla

Enclosures

cc: Paul Juettner (w/enclosures)



03-20-2008

U.S. Patent & TME/™ Mail Rept Dt #38

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

In the Matter of Trademark Registration Application SN 77/029,943 (BOUNTYJOBS)

Filed: October 26, 2006

Just Service, Inc.)	
)	
Petitioner)	
)	Opposition No. 91,182,436
)	
v.)	
)	
BountyJobs, Inc.)	
)	
Applicant)	
_____	/	

GREER, BURNS & CRAIN, LTD. Paul Juettner 300 South Wacker Drive, Suite 2500 Chicago, IL 60606 pjuettner@gbclaw.net 312-987-4008 (Phone) 312-360-9315 (Fax) <i>Attorney for Petitioner</i>	BUTZEL LONG Christopher M. Taylor (P63780) 350 South Main Street, Suite 300 Ann Arbor, MI 48104 taylorc@butzel.com 734-995-3110 (Phone) 734-995-1777 (Fax) <i>Attorneys for Applicant</i>
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**APPLICANT'S MOTION TO DISMISS OPPOSITION 91,182,436 PURSUANT TO
FED. R. CIV. PRO. 12(B)(6) FOR FAILURE TO STATE A CLAIM
UPON WHICH RELIEF MAY BE GRANTED**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, Applicant BountyJobs, Inc. ("Applicant"), respectfully moves to dismiss the Notice of Opposition filed by Opposer Just Service, LLC, filed on February 13, 2008 ("Notice").

In support of this motion, Applicant relies upon the facts, law and argument contained within the accompanying Brief in Support of Applicant's Motion to Dismiss Opposition 91,182,436 Pursuant to Fed. R. Civ. Pro. 12(b)(6) For Failure To State A Claim Upon Which Relief May Be Granted.

WHEREFORE, Applicant respectfully requests that the Board grant its Motion.

Respectfully submitted,

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Attorneys entering an appearance for Applicant

Date: March 19, 2008

CERTIFICATE OF SERVICE

I hereby certify that this day, March 19, 2008, a copy of the foregoing APPLICANT'S MOTION TO DISMISS OPPOSITION 91,182,436 PURSUANT TO FED. R. CIV. PRO. 12(B)(6) FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED was mailed, postage prepaid, to:

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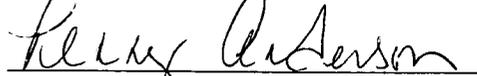
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Penny Anderson

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I. INTRODUCTION

The Notice of Opposition (“Notice”) filed by Opposer Just Service, Inc. (“Opposer”) suffers from voluminous and varied deficits and ultimately fails as a matter of law and fact to state a single claim upon which relief can be granted. It must, therefore, be dismissed.

Legally, Opposer’s Notice requests relief from the Board that is beyond its jurisdiction and fails to state valid grounds upon which the Board could refuse registration: it seeks a declaratory judgment from the Board and further asks the Board to reject Applicant BountyJobs, Inc.’s (“Applicant”) application on the grounds that the services approved by the Examining Attorney are indefinite and that registration of the BOUNTYJOBS mark would injure Opposer’s “domain name rights”. Factually, in the one count within the Board’s jurisdiction, an alternative claim under Section 2(d), Opposer fails to allege facts sufficient to establish a claim of a likelihood of confusion. In light of these twin deficiencies, it is appropriate to dismiss Opposer’s Notice and to allow Applicant’s application to proceed without delay.

II. ARGUMENT

Federal Rule of Civil Procedure 12(b)(6) dictates that Opposer’s Notice be dismissed because it fails to state a claim which relief can be granted. See Fed. R. Civ. P. 12(b)(6). To withstand a motion to dismiss, a Notice must set forth sufficient facts alleging all material elements of the valid grounds to refuse registration. See, e.g., Lanni v. Engler, 994 F. Supp. 849, 852 (E.D. Mich. 1998). Although the Board must accept as true all well-pleaded facts contained in the Notice, conclusory allegations are not acceptable where no facts are alleged to support the conclusions. See, e.g., Kelley v. Kysor Industrial Corp., 826 F. Supp. 1089, 1094 (W.D. Mich. 1993). Further, the Board should not assume that Opposer can prove facts that it has not alleged.

A. **OPPOSER FAILS TO ASSERT VALID GROUNDS WHY THE BOARD SHOULD REFUSE TO REGISTER APPLICANT’S MARK.**

Opposer's Notice advances four distinct theories to deny Applicant registration: (1) Rejection of Applicant's Indefinite Services; (2) Declaratory Judgment of No Likelihood of Confusion; (3) Injury to Domain Name Rights; and (4) Alternative Claim Under Section 2(d) of the Trademark Act. The Board is incapable of granting relief on the first three of the counts because they do not state valid grounds why Applicant is not entitled under law to receive a registration. See Lipton Indus., Inc. v. Ralson Purina Comp., 670 F.2d 1024, 1026 (C.C.P.A. 1982) ("For a petitioner to prevail in a cancellation [or opposition] proceeding, it [must] show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration.").

1. The Board Cannot Reject Applicant's Registration Application on the Ground that the Claimed Services Are Indefinite.

Opposer seeks to prevent registration via the remarkable assertion that Applicant "failed to address the indefinite services rejection raised by the Examining Attorney in the March 13, 2007 Office Action", and that "the following services in Applicant's BOUNTYJOBS application are indefinite 'Operating on-line marketplaces for sellers of goods and/or services' and 'Providing on-line marketplaces for sellers of goods and/or services'." Notice at ¶¶ 16, 24.

Even assuming the absolute verity of Opposer's claims, the Board is a body of limited jurisdiction that does not review the actions of Examining Attorney's de novo.

We have previously stated that it is not the Board's function to review the work of the Examiner. We are not going to substitute our judgment for that of the Examiner, on the same facts that were before the Examiner, unless we are convinced that clear error was committed.

Century 21 Real Estate Corp. v. Century Life of Am., 10 U.S.P.Q.2d 2034, 2035 (T.T.A.B. 1989). Indeed and in addition, Applicant's purported failure to meet ex parte examination

requirements as to the recitation of services does not serve as a valid ground upon which to oppose registration and cannot, therefore, form the basis of an inter partes proceeding on the registrability of the mark. See Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc., 66 U.S.P.Q.2d 1355, 1357 (T.T.A.B. 2003) ("It would be manifestly unfair to penalize defendant for non-compliance with a requirement that was never made by the Examining Attorney."); see also Lipton, 670 F.2d at 1024. This objection must, therefore, fail.

Additionally, Applicant draws the Board's attention to the Acceptable Identification of Goods and Services Manual, which lists "Operating on-line marketplaces for sellers of goods and/or services" as an acceptable identification, with an effective date of August 6, 2001. Even a casual observer will note that this identification is identical to one of the two identifications to which Opposer objects. Furthermore, the second allegedly indefinite identification differs from the plainly acceptable description by only one word – the substitution of "providing" for "operating". Simply put, Opposer is incapable of asserting any set of facts or principles of law that would render the substitution of "providing" for "operating" sufficiently portentous as to cause the resultant identification to be indefinite.

In light the absence of a valid ground to oppose registration, the Board's limited mandate and Applicant's irrefutable adherence to the Acceptable Identification of Goods and Services Manual, Opposer has failed to assert a claim in Count 1 for which relief can be granted.

2. The Board Has no Authority to Issue a Declaratory Judgment.

The Notice's Count II asks the Board to issue a declaratory judgment that the alleged BOUNTY WORK mark if used in connection with Opposer's claimed services would not raise a likelihood of confusion with Applicant's BOUNTYJOBS mark, when used in connection with its claimed services. This request must be dismissed summarily because the Board is an

administrative tribunal, not a court of general jurisdiction, and the Lanham Act does not vest the Board with the authority to issue declaratory judgments. See Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car, Inc., 62 U.S.P.Q.2d 1857, 1858 (T.T.A.B. 2002); Kelly Services Inc. v. Greene's Temporaries Inc., 25 U.S.P.Q.2d 1460, 1464 (T.T.A.B. 1992) (holding that the Board may not entertain a claim for declaratory judgment).

3. The Board Has no Authority to Reject Applicant's Registration Application Due to an Alleged Injury to Domain Name Rights.

Opposer's Count III asks the Board to refuse registration on the ground that "the suspension of Opposer's application to register BOUNTY WORK as a service mark over Applicant's BOUNTYJOBS application and the potential for a refusal to register the same is likely to injure Opposer's domain name rights in <bountwork.com>". Notice at ¶ 35.

This Count suffers from at least three errors that independently compel dismissal. In the first instance, the term "domain name rights" has no legally cognizable meaning relevant to whether a mark is capable of registration – the term does not appear once in a LEXIS search of the <US Trademark Trial & Appeal Board Decisions> library. See Exhibit A; see also Washington Speakers Bureau Inc. v. Leading Authorities Inc., 33 F.Supp.2d 488 (E.D. Va. 1999) (finding that registration of a mark or name as a domain name does not confer any federal trademark rights on the registrant). As it is not a valid, statutory ground for refusing registration, Opposer's claim must fail. See Lipton, 670 F.2d at 1024.

Next, even assuming that "domain name rights" are a recognized category of rights, they are rights over which the Board – limited as it is by the strictures of statute – cannot exercise jurisdiction. In the absence of this jurisdiction, the claim must be dismissed. See Enterprise Rent-A-Car Co., 62 U.S.P.Q.2d at 1858 ("In the absence of an explicit legislative grant of

authority to do so, the Board may not entertain a claim – even if it is alleged to be related to other matters properly before the Board.”).

Finally, even if the Board did have jurisdiction over “domain name rights”, Opposer’s Notice merely asserts that Opposer will be damaged by Applicant’s registration, but fails utterly to assert a mechanism by which that injury would be effected. In short, Claim III does not assert facts sufficient to succeed on a claim of injury to “domain name rights”, even if such rights existed. Indeed, Opposer’s Notice is replete with asserted facts that if true would gut entirely any conceivable claim that Applicant’s registration could injure Opposer’s “domain name rights”. For example, how could Opposer’s “domain name rights” suffer injury if:

27. The parties’ respective marks are different.
28. The parties’ respective services are different.
29. The parties’ respective services are intended to be offered to different classes of consumers, which consumers are professional or otherwise knowledgeable.
30. The concurrent use and registration of Applicant’s BOUNTYJOBS mark and Opposer’s BOUNTY WORK mark for their respective services would not lead to a conflict because there is no likelihood of confusion.

Notice at ¶¶ 27-30. The clear answer is that even were the Board capable of refusing to register a mark based upon an injury to “domain name rights”, Opposer has not alleged facts in support of this claim.

B. OPPOSER FAILS TO ASSERT ANY FACTS UPON WHICH THE BOARD COULD REFUSE REGISTRATION UNDER SECTION 2(D).

Finally, Opposer’s Count IV asks the Board to “refuse[] registration under Section 2(d) of the Trademark Act.” Notice at ¶ 39. Section 2(d) is of course a “valid ground why the registrant is not entitled under law to maintain the registration” per Lipton, and so this Count survives a test

that its predecessors fail, but its ultimate fate is the same. Opposer's Count IV must too be dismissed because Opposer's Notice fails to assert facts sufficient for the Board to refuse registration on the basis of Section 2(d).

The Board's process for Section 2(d) analysis is well known: the Board's determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098 (C.C.P.A. 1976).

In short, the Notice contains no allegation of similarity between either Applicant's mark and Opposer's alleged mark or the services identified in the two applications. Without these critical elements, the Board cannot find in Opposer's favor. Indeed, the only assertion of fact with respect to the nature of the Applicant's mark and Opposer's alleged mark, or the parties' claimed good and services is an assertion of dissimilarity. See Notice at ¶¶ 27-30. In the presence of this unqualified and uncontradicted assertion of dissimilarity, Opposer cannot prevail on its alternative claim of a likelihood of confusion.

III. CONCLUSION

The four counts of Opposer's Notice fail to state a claim for which relief can be granted. The Notice's first three counts fail to allege a valid ground why Applicant is not entitled to registration, whereas the Notice's fourth and final count does allege such a valid ground, but the Notice fails to assert facts sufficient for the Board to find in Opposer's favor. Applicant therefore

respectfully requests that its motion to dismiss be granted, and that Application SN 77/029,943 (BOUNTYJOBS) proceed without delay.

Respectfully submitted,

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Attorneys entering an appearance for Applicant

Date: March 19, 2008

Exhibit A

Legal > / ... / > US Trademark Trial & Appeal Board Decisions

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"domain name rights" or "domain name right"

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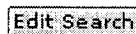
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CERTIFICATE OF SERVICE

I hereby certify that this day, March 19, 2008, a copy of the foregoing APPLICANT'S BRIEF IN SUPPORT OF ITS MOTION TO DISMISS OPPOSITION 91,182,436 PURSUANT TO FED. R. CIV. PRO. 12(B)(6) FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF MAY BE GRANTED was mailed, postage prepaid, to:

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