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

Proceeding	91194702
Party	Defendant Catalyst SAT & College Prep, LLC
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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THE COLLEGE BOARD

Petitioner,

CATALYST SAT & COLLEGE PREP, LLC,

Respondent.  
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Opposition No.: 91194702

Application Serial No. 77/844120

Effective Filing Date: October 8, 2009

Published: March 30, 2010

Trademark: THE NAKED TRUTH ABOUT  
THE SAT

**APPLICANT/RESPONDENT’S MOTION TO DISMISS NOTICE OF OPPOSITION AND  
MEMORANDUM OF LAW**

**I. NOTICE OF MOTION AND MOTION**

Respondent, Catalyst SAT & College Prep, LLC (“Respondent,” hereby respectfully moves the Trademark Trial and Appeal Board (the “TTAB” or “Board”) for an Order:

- a. Pursuant to Trademark Trial and Appeal Board Manual of Procedure § 503, Trademark Rule, 37 CFR 2.116, and Federal Rule of Civil Procedure 12(b)(1), dismissing Petitioner, The College Board’s (“Petitioner”), Opposition to Respondent’s application to register the mark THE NAKED TRUTH ABOUT THE SAT, applied for under application Serial Number 77/844,120, because Petitioner lacks standing to bring the instant Opposition; and
- b. Pursuant to Trademark Trial and Appeal Board Manual of Procedure § 503, Trademark Rule, 37 CFR 2.116, and Federal Rule of Civil Procedure 12(b)(6), dismissing Petitioner, The College Board’s (“Petitioner”), Opposition to Respondent’s application to register

the mark THE NAKED TRUTH ABOUT THE SAT, applied for under application Serial Number 77/844,120, for failure to state a claim; or in the alternative,

- c. Requiring Petitioner to provide a more definite statement of its claims and all bases, reasons, and supporting facts for such claims; and
- d. For such other relief as the Board may deem just, fair, and proper.

Because this is a dispositive motion, the opposition proceedings should be otherwise suspended pending the determination of this motion. 37 C.F.R. § 2.127(d); T.B.M.P. § 510.

## **II. INTRODUCTION**

Respondent's mark THE NAKED TRUTH ABOUT THE SAT was approved for publication on March 30, 2010. On April 29, 2010, the final day of the opposition period, Petitioner filed a insufficient Opposition, with nothing more than unsupported conclusory allegations and no factual bases or allegations for opposing Respondent's mark. Petitioner's contention, though not entirely clear, appears to be that Respondent's mark, THE NAKED TRUTH ABOUT THE SAT, infringes upon, or is confusingly similar to, Petitioner's mark, SAT. However, as explained below, though Petitioner would have the Board believe it has significant rights in the mark SAT, indeed two of three marks, covering four international classes, have been cancelled for more than 2 years, and the goods and services covered by the existing mark are not the same or similar to those of Respondent's. Petitioner simply has no real basis to forward its instant Opposition and thus dismissal of the Opposition in its entirety is warranted.

## **III. ARGUMENT**

### **A. LEGAL STANDARD FOR A TTAB MOTION TO DISMISS**

An Opposition to the registration of an applied for mark, such as Petitioner's Opposition in this case, is akin to a Complaint in Federal Court. "A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding (see TBMP §§ 303.03 and

309.03(b)), and (2) a short and plain statement of one or more grounds for opposition.” TBMP § 309.03(a)(2). (emphasis added.) The pleading standards and requirements applicable to federal complaints are established in Fed.R.Civ.Proc., Rule 8 for most claims and Fed.R.Civ.Proc., Rule 9(b) for certain specific claims such as fraud, which require the complainant to plead with particularity. Proceedings before the TTAB in large part follow the Federal Rules of Civil Procedure.

Inter partes proceedings before the TTAB are governed by the Rules of Practice in Trademark Cases adopted by the PTO and set forth in Part 2 of Title 37 of the Code of Federal Regulations. See 35 U.S.C.A. § 23 (West 2001) (granting the Director of the PTO the authority to “establish rules for taking affidavits and depositions required in cases in the [PTO]”). The PTO’s rules were “adapted from the Federal Rules [of Civil Procedure], with modifications appropriate to the administrative process.” *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1575 (Fed. Cir. 1988). Under the PTO’s rules, the Federal Rules of Civil Procedure generally apply to all phases of inter partes proceedings, see 37 C.F.R. § 2.116(a), including discovery and the taking of depositions, see 37 C.F.R. § 2.120(a).

*Rosenruist-Gestao E Servicos LDA v. Virgin Enters.*, 511 F.3d 437, 443 (4th Cir. 2007). Such is true for motions to dismiss an opposition to an application to register a trademark.

As set forth in *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007), the following is the applicable standard for evaluating a motion to dismiss:

In order to withstand a motion to dismiss for failure to state a claim, **a plaintiff need only allege such facts as would, if proved, establish** that (1) the plaintiff has standing to maintain the proceedings, and (2) **a valid ground exists for opposing** [or cancelling] **the mark**. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief sought. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene’s Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP §503.02 (2d. ed. rev. 2004). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); see also 5A Wright & Miller, Federal Practice And Procedure: Civil 2d §1357 (1990). 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 ....” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, supra at 26 USPQ2d 1041.

See also, *Young v. AGB Corp.*, 152 F.3d 1377, 1379, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998).

*Bayer Consumer Care AG v. Belmora LLC*, Cancellation No. 92047741 ((TTAB) April 6, 2009). (emphasis added.) Moreover, significantly as Petitioner's Opposition is subject to the Fed.R.Civ.Proc, Rule 8 pleading requirements, Petitioner too must comply with the heightened Rule 8 pleading standards as handed down by the United States Supreme Court in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955 (2007) and *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009).

Under Federal Rule of Civil Procedure 8(a)(2), a pleading must contain a **'short and plain statement** of the claim showing that the pleader is entitled to relief.' As the Court held in *Twombly*, 550 U.S. 544, 127 S. Ct. 1955, 167 L. Ed. 2d 929, the pleading standard Rule 8 announces does not require 'detailed factual allegations,' but it demands more than an unadorned, the-defendant-unlawfully-harmed-me accusation. *Id.*, at 555, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (citations omitted). **A pleading that offers 'labels and conclusions' or 'a formulaic recitation of the elements of a cause of action will not do.'** 550 U.S., at 555, 127 S. Ct. 1955, 167 L. Ed. 2d 929. **Nor does a complaint suffice if it tenders 'naked assertion[s]' devoid of 'further factual enhancement.'** *Id.*, at 557, 127 S. Ct. 1955, 167 L. Ed. 2d 929.

**To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'** *Id.*, at 570, 127 S. Ct. 1955, 167 L. Ed. 2d 929. A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. *Id.*, at 556, 127 S. Ct. 1955, 167 L. Ed. 2d 929. The plausibility standard is not akin to a 'probability requirement,' but it asks for more than a sheer possibility that a defendant has acted unlawfully. *Ibid.* Where a complaint pleads facts that are 'merely consistent with' a defendant's liability, it 'stops short of the line between possibility and plausibility of "entitlement to relief."' *Id.*, at 557, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (brackets omitted).

*Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). As is evident from even a cursory reading of Petitioner's Opposition, the pleading provides Respondent with no real basis to fully understand the claims forwarded as against Respondent. Indeed the Opposition forwards virtually no factual allegations or support for any of its claims and merely asserts unsupported conclusory statements. The Opposition does nothing more than assert four (4) one sentence "unadorned, the-defendant-unlawfully-harmed-me accusation[s]." *Twombly*, 550 U.S. at 555. The Opposition does not even assert the most basic of bare bones claims by setting forth and pleading the requisite elements of the

purported claims. Thus, on these bases alone, as well as those set forth below, Petitioner's Opposition is fatally flawed and subject to dismissal. The Board therefore should grant Respondent's Motion to Dismiss.

**B. PETITIONER HAS NOT ESTABLISHED THAT IT HAS STANDING TO BRING THIS OPPOSITION AND THUS THE OPPOSITION SHOULD BE DISMISSED.**

Petitioner has not pleaded the requisite standing to bring the claims in its Opposition to Respondent's mark. Only a "person who believes he or she is or will be damaged . . . by the registration of a mark on the principal register" has standing to cancel the registration. 15 U.S.C. § 1064. However, the standing requirement is not to be deemed an all encompassing umbrella providing for unfettered access to the TTAB to challenge marks approved for registration. The Federal Circuit has held that to have standing a petitioner must have, and necessarily must plead or show through its pleadings that the petitioner has: (i) a "real interest in the proceedings" and (ii) a "reasonable basis for his belief of damage." *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999); see also TBMP § 309.03(b). "To plead a 'real interest,' plaintiff must allege a 'direct and personal stake' in the outcome of the proceeding. The allegations in support of plaintiff's belief of damage must have a reasonable basis 'in fact.'" TBMP 309.03(b). Petitioner, The College Board, has neither pled allegations nor facts sufficient to indicate it has a "real interest in the proceedings" and "a reasonable basis for [its] belief of damage," nor could it do so. As such Petitioner simply has not sufficiently pled, and in fact does not have, standing to bring the instant Opposition.

Petitioner opposes Respondent's application to register its mark based upon allegations that Petitioner previously registered the SAT trademark under Registration Numbers 1067665, 2472862, and 2475047 in the International Classes 009, 016, 0041, and 0042. However, Petitioner conspicuously omits the fact that **both Registration Numbers 2472862 for IC 009 and 2475047 for ICs 016, 041, and 042 were cancelled** and thus are no longer valid trademark registrations.

Registration No. 2472862 was cancelled on May 2, 2008 and Registration No. 2475047 was cancelled on May 9, 2008.

Moreover, the goods and services in Petitioner's only remaining registration are not the same or similar to that of Respondent. Indeed, Petitioner's registration 1067665 is exclusively for "PRINTED TESTS AND TEST BOOKLETS." (Emphasis added.) As noted in the form Notice of Opposition, Petitioner opposes Respondent's mark stating "All goods and services in the class are opposed, namely: Educational books featuring SAT practice exam questions." (Emphasis added.) Clearly the identified and claimed goods and services for Petitioner's mark are different and distinct from those of Respondent's mark. Certainly tests and test booklets are not educational books. Petitioner simply has not and cannot plead that it has a "real interest" in opposing Respondent's mark and that Petitioner has a "reasonable basis" to believe it will be damaged; two of its marks for four (4) classes have already been cancelled and the goods covered by the single remaining mark are not the same as those covered by Respondent's mark.

Therefore, wholly disregarding the substantial pleading deficiencies in the Opposition, Petitioner simply does not have standing to oppose Respondent's application and thus the Board should dismiss the Opposition in its entirety.

**C. PETITIONER HAS NOT SUFFICIENTLY PLED EVEN A SINGLE CLAIM AND THEREFORE THE BOARD SHOULD DISMISS PETITIONER'S OPPOSITION.**

Petitioner sets forth nothing more than four (4) broad based, confusing, and wholly unsupported conclusory allegations claiming they constitute grounds for opposing Respondent's mark. However, each is woefully deficient. Petitioner alleges:

The grounds for opposition are as follows:

- (a) The registration of and continued use by the College Board of its various SAT trademarks.
- (b) Permitting this registration would infringe on the College Board's exclusive right to use the SAT trademark in commerce in the classes as identified above.

- (c) Permitting a registration that incorporates the SAT trademark would indicate that the College Board's trademark is generic and not descriptive. SAT is not a descriptive term and therefore should not be subject to a disclaimer.
- (d) Permitting this registration would result in a likelihood of confusion to the public because the requested mark is confusingly similar to the College Board trademarks.

Three of the four do not even appear to be grounds for opposition recognized in the TBMP or the Lanham Act and as to the "likelihood of confusion" ground Plaintiff utterly fails to plead any factual support and does not even attempt to meet the minimum requisite pleading requirements for such a claim. Thus Petitioner's Opposition should be dismissed in its entirety.

**1. Petitioner's First, Second, and Third Alleged Grounds Are Not A Recognized Ground For Opposing A Mark.**

Petitioner alleges that Respondent's mark should not be registered on the alleged grounds "(a) The registration of and continued use by the College Board of its various SAT trademarks. (b) Permitting this registration would infringe on the College Board's exclusive right to use the SAT trademark in commerce in the classes as identified above. (c) Permitting a registration that incorporates the SAT trademark would indicate that the College Board's trademark is generic and not descriptive. SAT is not a descriptive term and therefore should not be subject to a disclaimer."

First, it is not clear what Petitioner is attempting to allege as grounds to oppose Respondent's mark and such in and of itself warrants dismissal of the grounds and the Opposition. This is especially true with respect to the purported grounds set forth in paragraphs (a) and (c). Indeed, whether SAT is generic is irrelevant to whether Respondent's mark should be registered; such would seem far more a defense or counterclaim that Respondent can, and will, allege as against Petitioner should the instant action move forward.

Moreover, as highlighted above, both Registration Numbers 2472862 for IC 009 and 2475047 for ICs 016, 041, and 042 were cancelled as of May, 2008 and thus are not a valid basis for opposing Respondent's mark. Further, the recognized grounds for opposing a mark are set forth in

the Lanham Act 15 U.S.C § 1063 and TBMP § 309.03(c), however nowhere in either the Lanham Act or the TBMP is the purported grounds, as pleaded and alleged by Petitioner, even contemplated as valid or properly raised or pled grounds for opposing the registration of a mark.

Finally, even if the Board were to extend great leniency to Petitioner and deem the purported alleged grounds viable, Petitioner has utterly failed to provide any factual or other support for the grounds such that the Board and Respondent can reasonably understand the basis of, and support for, Petitioner's claims as is required under TBMP 309.03 and FRCP Rule 8. See e.g. *Bayer Consumer Care AG v. Belmora LLC*, Cancellation No. 92047741 ((TTAB) April 6, 2009); *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). Therefore Petitioner's first, second, and third grounds, and indeed Petitioner's entire Opposition, should be dismissed.

**2. Petitioner Has Not Even Met The Minimum Requirements For A Proper Likelihood of Confusion Claim And Therefore Such Claim Should Be Dismissed.**

Petitioner's final purported ground alleged in opposition to the registration of Respondent's mark appears to be a claim of likelihood of confusion. Petitioner states that Respondent's mark should not be registered because "(d) Permitting this registration would result in a likelihood of confusion to the public because the requested mark is confusingly similar to the College Board trademarks." However, while likelihood of confusion may indeed be a valid ground to assert in opposition to the registration of a mark, there are fundamental basic pleading requirements, aside from the *Ashcroft v. Iqbal* heightened FRCP Rule 8 pleading standards, that must be complied with to properly allege a likelihood of confusion ground/claim before the TTAB.

In an opposition proceeding alleging likelihood of confusion, the petitioner must allege facts sufficient to establish that (1) the petitioner has priority of rights in and to the mark at issue and (2) the respondent/applicant's mark and goods and services, as applied for, are so similar to petitioner's mark and goods and services as to be likely to cause confusion, mistake or deception. *Bongrain Int'l (Am.) Corp. v. Moquet, Ltd.*, 230 U.S.P.Q. 626, 626 (T.T.A.B. 1986) ; see also TBMP § 309.03(c)

(requiring the petitioner to plead both priority of use and likelihood of confusion with respect to the marks and relevant goods and services, and requiring the petitioner to plead likelihood of confusion either directly or hypothetically coupled with another and separate ground for opposition or cancellation); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allegation of priority without direct or hypothetical pleading of likelihood of confusion is insufficient pleading of Section 2(d) ground). Petitioner failed on both accounts; neither priority, nor a clear statement as to likelihood of confusion relative to the specific relevant goods and services covered by the marks, is specifically asserted or alleged.

Moreover, as highlighted above, both Registration Numbers 2472862 for IC 009 and 2475047 for ICs 016, 041, and 042 were cancelled as of May, 2008 and thus are not a valid basis for opposing Respondent's mark. The only remaining goods and services at issue under Petitioner's lone remaining mark are not the same or similar to those to be covered by Respondent's mark and thus are not the proper subject of a likelihood of confusion claim. Indeed even TBMP § 309.03(c) indicates that a properly pled likelihood of confusion claim must plead that the marks are confusingly similar as applied to the relevant goods and services.

Finally, Petitioner has utterly failed to provide any factual or other supporting allegations for its likelihood of confusion claim such that the Board and Respondent can reasonably understand the basis of, and support for, Petitioner's claim. Rather all that is alleged is a one sentence unsupported conclusory allegation that does not even plead even the most basic of elements of a likelihood of confusion claim. Petitioner has failed to meet even the most minimal of pleading standards. See e.g. *Bayer Consumer Care AG v. Belmora LLC*, Cancellation No. 92047741 ((TTAB) April 6, 2009); *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). As such this claim, as well as Petitioner's entire Opposition, should be dismissed.

#### IV. CONCLUSION

For the reasons and arguments set forth above, Respondent respectfully requests the Board grant Respondent's Motion to Dismiss and issue an Order dismissing Petitioner's Opposition in its entirety, or in the alternative requiring Petitioner to provide a more definite statement of its case, claims, and supporting bases and facts, and for such other relief as the Board may deem just, fair, and proper.

Dated: June 9, 2010

**MICHELMAN & ROBINSON, LLP**

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