ESTTA Tracking number: **ESTTA416411**
Filing date: **06/26/2011**

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

Proceeding	91199868
Party	Defendant long island roofing and repairs service corp., Long island roofing and repairs service Corpcorp.
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Date	06/26/2011
Attachments	12 (b) Motion to Dismiss.pdf (8 pages)(1073039 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Mr. Christopher Moore **Petitioner** Vs. Long Island Roofing and Repairs Service Corp. **Applicant**	Opposition No. 91199868 Marks: LIROOFING.COM; LONG ISLAND ROOFING Serial No.: 85043293 85043309

APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM AND MEMORANDUM OF LAW

Pursuant to TBMP § 503.02 and Rule 12 (b) (6) of the Federal Rules of Civil Procedure, Long Island Roofing and Repairs Service Corp. ("Applicant") through its undersigned Attorneys, submits this motion to dismiss the Notice of Opposition filed by Mr. Christopher Moore ("Petitioner") for failure to state a claim upon which relief can be granted.

Statement of Case

The entire sum and substance of the Petitioner's Notice of Opposition consists of allegations which appear to raise, (a) a likelihood of confusion ground with the Petitioner's

corporate name, and, (b) an issue of descriptiveness of the marks LIROOFING.COM and LONG ISLAND ROOFING.

The Applicant argues that both allegations fail to state a claim upon which relief may be granted.

Legal Standards

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra*; *Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *Stanspec Co. v. American Chain & Cable Co.*, *supra*; *Kelly Services Inc. v. Greene's Temporaries Inc.*, *supra*; *Space Base Inc. v. Stadis Corp.*, *supra*; *Stabilisierrungsfonds fur Wein v. Zimmermann-Graeff KG*, 199 USPQ 488 (TTAB 1978); *and National Ass'n of Blue Shield Plans v. Standard Mattress Co.*, 176 USPQ 29 (TTAB 1972).

Rule 503.02 of the Trademark Trial and Appeal Board Manual ("TBMP") states that in order to withstand a Motion to Dismiss, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) there is a valid ground why the registrant is not entitled under law to maintain the registration. *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); *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985); and *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512 (TTAB 1984). In addition, it is well settled that a party opposing a registration must at the pleading stage allege facts in support of both requirements of Rule 503.02 of the TBMP. *See Young v. AGB Corp.,* 152 F.3d 1377, 1380 (Fed.Cir. 1998)

Argument

The Petitioner in this matter concedes that he started using his corporate name in 2009 and that his own corporate name "LI ROOFING" is descriptive. *See paragraph 3 of the Notice of Opposition.* In light of the above, it is very clear that the Petitioner concedes that his mark is not inherently distinctive. In addition, the Petitioner also does not assert that his mark has attained some secondary meaning in the market, thereby indicating that he does not have any proprietary rights in his corporate name. *See Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.,* 934 F.2d at 1559 (C.A.11 (Ga.), 1991) ("A business will obtain rights in the mark upon first use only if the mark is inherently distinctive. If the mark is not inherently distinctive, a business

may obtain ownership rights in the mark when the mark attains a secondary meaning"). Thus, in light of the above, the Petitioner fails to justify his standing before the Board.

In addition, the Applicant argues that Petitioner's Notice of Opposition also fails to adequately plead a claim on any of the grounds mentioned therein. Moreover, it appears that the Petitioner checked all the grounds possible in this opposition proceeding in haste, whereas he failed to allege sufficient facts in support of those grounds. This is evident from the fact that even though the Petitioner alleges potential confusion, he did not choose it as a valid ground for opposition. Applicant revisits all the grounds taken up by the Petitioner, below.

The Petitioner completely failed to allege facts in support of the grounds that the Applicant's marks are deceptive or deceptively misdescriptive. Nowhere in the Notice of Opposition does the Petitioner allege that Applicant's mark in some way misdescribes any character, quality or function of the services pursued by the Applicant, nor does he allege that prospective purchasers are likely to believe that such misdescription actually describes the services. *See In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988); *In re Phillips-VanHeusen Corp.*, 63 U.S.P.Q.2d 1047 (T.T.A.B. 2002) ("Super Silk" for shirts made from "silk-like fabric" deceptively misdescriptive, since term signifies excellent, first rate, or superior grade of silk fabric). Thus, in light of the above, Petitioner's Notice of Opposition fails as a matter of law for the grounds taken up in this paragraph.

Furthermore, the Petitioner fails to allege sufficient facts to establish that Applicant's marks are generic or merely descriptive or primarily geographically descriptive. There is no

statement in the Notice of Opposition that directs our attention to facts that sufficiently establish genericness of the Applicant's mark as a whole. The Petitioner merely alleges the genericness of the term "ROOFING", which is not sufficient to sustain a generic claim as to the mark as a whole. Moreover, as noted in Application Serial Nos. 85043309 and 85043293, Applicant's marks have been in use in commerce since 1995 and have attained secondary meaning in the market as asserted by Applicant's §2(f) claim of the Lanham Act in both applications. Therefore even assuming *arguendo* that Opposer's allegations of descriptiveness are true, Applicant's marks would still warrant registration on the Principal Register. Thus, Petitioner's Notice of Opposition fails as a matter of law for the grounds taken up in this paragraph.

As to the claim of false suggestion of a connection, the Petitioner fails to allege any proprietary rights in the marks in question to demonstrate false suggestion of connection as to source, whether by ownership of registration, prior use of a trademark, prior use in advertising, prior use as a trade name, or other type of use that may have developed a trade identity. *See Otto Roth & Company, Inc. v. Universal Foods Corporation*, 640 F.2d 1317 (Fed. Cir. 1981) (One who opposes registration to an applicant under section 2(d) is attempting to protect his individual rights, as the owner of some means of identifying the source of his goods, by preventing registration of a mark so similar to that which he asserts identifies source that concurrent use of the two is likely to cause confusion and thus foil the function of his means of identification.) *See Federated Foods, Inc. v. Fort Howard Paper Co.*,544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *American Throwing Co. v. Famous Bathrobe Co.*, 45 CCPA 737,250 F.2d 377, 116 USPQ 156 (1957); *Armour & Co. v. Organon, supra*. (In this situation, the opposer must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to

source, whether by ownership of a registration, prior use of a technical "trademark," prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity.) Thus, in light of the above, the Petitioner's Notice of Opposition fails as a matter of law on this ground, as well.

Going further, in order to establish a proper pleading of a fraud claim, "a petitioner must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to Board proceedings by Trademark Rule 2.1 16(a)." *Asian and Western Classics B. V. v. Lynne Selkow*, 92 USPQ2d 1478 (TTAB 2009) More specifically, under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, "the pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud." *Id.*, citing *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008,212 USPQ 801, 803 (CCPA 1981) In the instant matter, the Petitioner has completely failed to allege any facts to establish a fraud claim. Thus, in light of the above, Petitioner's Notice of Opposition fails as a matter of law for the ground taken up in this paragraph.

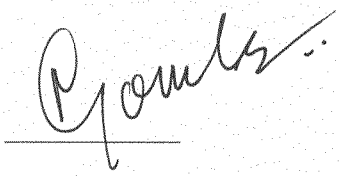
Finally, the Petitioner raises the ground of functionality. As the Supreme Court explained in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164-165, 34 USPQ2d 1161, 1163 (1995): "the functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation.

If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity)." Opposer here has failed to raise any allegations that indicate the functional nature of Applicant's marks. In light of the above, it is therefore clear that the Petitioner failed to state a claim for functionality.

Conclusion

For the foregoing reasons, the Applicant respectfully requests that the Board grant the present Motion to Dismiss in its entirety, and dismiss the Notice of Opposition with prejudice.

Dated: June 26, 2011



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CERTIFICATE OF MAILING AND SERVICE

I certify that on June 26, 2011, the foregoing APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM AND MEMORANDUM OF LAW are being served by e-mail and mailing a copy thereof by FedEx® addressed to:

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