

ESTTA Tracking number: **ESTTA450057**

Filing date: **01/09/2012**

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

Proceeding	91202494
Party	Plaintiff Jason A. Fedore
Correspondence Address	GREGG R ZEGARELLI ATTORNEY PO BOX 113345 PITTSBURGH, PA 15241 UNITED STATES mailroom.grz@zegarelli.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	GREGG ZEGARELLI
Filer's e-mail	mailroom.grz@zegarelli.com
Signature	/gregg zegarelli/
Date	01/09/2012
Attachments	Reply in Opposition.pdf ( 5 pages )(34910 bytes )



5. The very purpose of a registration is to afford precise benefits to the registrant pursuant to law. The registration of the application herein would confer upon Facebook specific statutory rights and presumptions pursuant to the Lanham Act. It is the grant of these rights that will damage Opposer because those new statutorily granted rights will be asserted against the Opposer herein, and the defending Applicant in 245 Action. The law recognizes the statutorily granted rights as having legal effect and benefits to the registrant to the detriment of others, including Opposer.

6. Facebook seeks a statement of the well-established legal authority. According to the Trademark Trial and Appeal Board Manual of Procedure:

**303.03 Meaning of the Term "Damage"**

**The term "damage," as used in Sections 13 and 14 of the Act, 15 U.S.C. §§ 1063 and 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively. A party may establish its standing to oppose or to petition to cancel by showing that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage. [Citations omitted] There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. [Citations omitted]**

7. Ostensibly, neither the statute nor the TTAB require the assertion of "confusing similarity" to maintain an opposition proceeding.

8. Facebook's claim and controversy that it asserts, and such as it admits for this purpose, establishes Opposer's real interest and standing in this opposition; it is ripe and judiciable. Facebook's tricky logic that Opposer must concede confusing similarity of the marks and thereby lose Opposer's registration, or to allow Facebook to gain a registration to use against Opposer in another proceeding, is legally untenable, and worse, simply unfair.

9. Let us step back and take a hypothetical example, to illustrate the core framework of the issue presented:

- a. On January 1, 1990, BookHeadAuto starts business in auto sales;
- b. On January 1, 2010, Facebook files an intent-to-use application for registration in auto sales;
- c. On January 1, 2011, BookHeadAuto files an actual use application for registration in auto sales since January 1, 1990;
- d. On January 1, 2012, Facebook opposes BookHeadAuto, claiming confusing similarity regarding auto sales between Facebook and BookHeadAuto;
- e. BookHeadAuto sees the Facebook application ready for publication and threatens to oppose. BookHeadAuto does not believe that the marks are similar in use, but, if Facebook gains the registration, Facebook will gain significant statutory rights intended for use against BookHeadAuto.
- f. Facebook asserts that the only way for BookHeadAuto to oppose Facebook is to concede that the marks are confusingly similar. BookHeadAuto cannot make that assertion, even though BookHeadAuto has priority, assuming similarity of the marks. Facebook thereby acquires its registration and uses the legal effect of the registration in Facebook's opposition against BookHeadAuto and any other basis afforded by the Lanham Act.<sup>2</sup>

10. It is FACEBOOK's own assertion in the 245 Action that creates the real interest, claim or controversy upon which this opposition is based. The claim is real, ripe and judiciable. Facebook should be estopped from contradicting itself.

WHEREFORE, Opposer believes that Opposer would be damaged by the registration of the mark at issue herein and requests that Facebook's application be refused registration; that no registration be issued to Facebook for the mark; and that this opposition be sustained in favor of Opposer.

---

<sup>2</sup> Apart from judicial inefficiency, even assuming a later cancellation action against the Facebook registration is not fair to BookHeadAuto, since the registration itself changes burdens of proof, procedural issues and affords the registrant with new statutory claims. The issuance of the registration itself, in this context, creates the "real interest" in the case and standing, and the judiciability is admitted by the action initiated by Facebook itself.

Date: January 9, 2012

Respectfully submitted,

s/Gregg Zegarelli/  
Gregg R. Zegarelli, Esq.

Attorney for Opposer

Z E G A R E L L I  
Technology & Entrepreneurial  
Law Ventures Group, P.C.  
2585 Washington Road, Suite 134  
Summerfield Commons Office Park  
Pittsburgh, PA 15241-2565  
mailroom.grz@zegarelli.com

**CERTIFICATE OF SERVICE**

The following person or persons have been served by United States first class mail, postage pre-paid on the date below:

January 9, 2012

LORI F MAYALL, ESQ.  
COOLEY LLP  
777 6TH STREET, NW, SUITE 1100  
WASHINGTON, DC 20001  
UNITED STATES

s/Gregg R. Zegarelli/  
Gregg R. Zegarelli, Esq.  
PA I.D. #52717

Counsel for Opposer

Z E G A R E L L I  
Technology & Entrepreneurial  
Law Ventures Group, P.C.  
2585 Washington Road, Suite 134  
Summerfield Commons Office Park  
Pittsburgh, PA 15241-2565  
mailroom.grz@zegarelli.com