

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

coggins

Mailed: October 4, 2013

Opposition No. 91208639

Boston Red Sox Baseball Club
Limited Partnership

v.

City of Deer Park, Texas

By the Board:

Now before the Board is applicant's motion (filed June 4, 2013, concurrently with the answer) to dismiss the notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6). After receiving multiple extensions, opposer filed a brief in opposition thereto. The Board exercises its discretion to determine the motion prior to the time in which applicant might otherwise file a reply brief.

Motion to Dismiss

A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the complaint. To withstand a motion to dismiss for failure to state a claim in a Board opposition proceeding, the opposer need only

allege such facts in the notice of opposition as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing the subject application. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

For purposes of determining the motion, the notice of opposition must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(e). All of opposer's well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to opposer. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Standing

Opposer must allege facts in the notice of opposition which, if ultimately proven, would establish that opposer

has a real interest in the proceeding and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Herbko Int'l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

Applicant challenges opposer's standing and argues that the "claim of likelihood of confusion is wholly without merit." Motion, p. 3. Applicant argues that its own mark is used on brochures, booklets, and teaching materials, but that opposer has not alleged that opposer uses its mark on any of these goods. Specifically, applicant focuses on opposer's pleaded registrations which cover clothing (in Class 25) and various entertainment, information, education, and sport services (in Class 41); and contrasts this with its own instructional goods (in Class 16).¹ Although applicant argues about the International Classes in which the parties' goods and services are categorized, it has long been settled that the classification of goods or services is

¹ As a courtesy to applicant, the Board points out the discrepancy between the way applicant identifies its goods in the motion and how those goods are identified in the subject application. Specifically, the application contains the word "provided" while the motion contains the word "provide." Should applicant wish to amend the identification of goods in the application, applicant is referred to TBMP § 514 (3d ed. rev.2 2013).

not controlling insofar as likelihood of confusion is concerned. See *In re Knapp-Monarch Co.*, 296 F.2d 230, 132 USPQ 6, 7 (CCPA 1961); *Graco Inc. v. The Warner-Graham Co.*, 164 USPQ 400, 402 (TTAB 1969). Moreover, opposer does, in fact, allege that it has used various WALLY-formative marks on, *inter alia*, books, booklets, and educational materials. See Notice of Opp., paras. 2 and 4. Opposer also pleads that it is the owner of two registrations which comprise a mascot character, and several common law marks which constitute or comprise the word WALLY, and which opposer contends so resemble applicant's WALLY mascot character such that applicant's mark is confusingly similar to opposer's marks. See Notice of Opp., paras. 2, 3, and 8. These allegations, read in conjunction with the other allegations in the complaint, demonstrate that opposer has a real interest in this opposition proceeding and thus, if proved, would establish its standing. In view thereof, opposer has sufficiently pleaded its standing.

Priority and Likelihood of Confusion

In order to properly state a claim of priority and likelihood of confusion, opposer must plead that (1) applicant's mark, as applied to its goods, so resembles opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has either priority of use or a federal registration of opposer's pleaded mark. See Fed.

R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

There is no question that opposer pleads that applicant's mark so resembles opposer's marks as to be likely to cause confusion, mistake, or deception (see Notice of Opp., para. 8); and that opposer has priority of use (see Notice of Opp., paras. 2 and 4), two federal registrations (see Notice of Opp., para. 3), and several common law marks (see Notice of Opp., para. 2). There is also no question that opposer pleads that applicant's goods are related to opposer's goods. See Notice of Opp., para. 7. These allegations, when read in conjunction with the other allegations in the notice of opposition, are sufficient to state a claim to relief that is plausible on its face.

Contrary to applicant's argument that opposer "provides no legal basis to claim any right in the word WALLY" (Motion, p. 4), opposer has clearly pleaded that opposer has used the marks WALLY, WALLY THE GREEN MONSTER, and other WALLY-formative marks on, *inter alia*, books, booklets, and educational materials since long prior to applicant's constructive first use date. See Notice of Opp., paras. 2 and 4. These allegations are sufficient to provide a legal basis to claim common law trademark rights in the WALLY marks. Applicant's focus solely on the marks in opposer's pleaded registrations is misplaced. While opposer might

rely on its registrations for the character design marks therein vis-à-vis applicant's character design mark, opposer may also rely on its common law rights in the mark WALLY (or in WALLY-formative marks).² Here, opposer alleges that "[a]pplicant's [m]ark, which is for a mascot character named WALLY, the same as [o]pposer's mascot character, so resembles [o]pposer's WALLY [m]arks as to be likely ... to cause confusion...." Notice of Opp., para. 8. Reading the notice of opposition liberally, opposer appears to rely on its alleged common law rights stemming from its use of WALLY and WALLY-formative marks together with its registered character (i.e., mascot) design marks as a basis for its claim of likelihood of confusion.

Applicant's arguments against a likelihood of confusion (see Motion, pp. 3-6, discussing specific *du Pont*³ factors) are inappropriate in a motion to dismiss for failure to

² A major difference between rights asserted under a registration and rights asserted under common law is the issue of priority (if the registrations are made of record and are uncontested). See *King Candy Co., supra*. In contrast to rights acquired via a pleaded and uncontested registration, and to the extent an opposer wishes to rely on its common law rights, it must establish priority with respect to such rights. That is, an opposer must prove by a preponderance of the evidence that its common law rights were acquired before any date upon which the applicant may rely. Trademark Act Section 2, 15 U.S.C. §1052; *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (The "decision as to priority is made in accordance with the preponderance of the evidence"). But the proof issue is a matter for trial; what is at issue in applicant's instant motion to dismiss is merely the sufficiency of opposer's allegations.

state a claim. These arguments relate to the merits of opposer's claims rather than the sufficiency of those claims and as such are inappropriate on a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6).⁴

Summary

Inasmuch as opposer has sufficiently pleaded standing and the ground of priority and likelihood of confusion, applicant's motion to dismiss is **denied**. Applicant's answer, filed June 4, 2013, is noted.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Deadline for Discovery Conference ⁵	10/28/2013
Discovery Opens	10/28/2013
Initial Disclosures Due	11/27/2013
Expert Disclosures Due	3/27/2014

³ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

⁴ To the extent applicant intended its motion as one for summary judgment on the specific *du Pont* factors, such a motion is premature and the motion is treated solely as one to dismiss under Fed. R. Civ. P. 12(b)(6). See Trademark Rule 2.127(e)(1); *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 (TTAB 2009).

⁵ The Board appreciates that, as revealed by the earlier motions to suspend and extend based on settlement, the parties have attempted to settle their dispute. However, the parties are reminded that while Board is liberal in granting suspensions or extensions of time to answer based on settlement, the Board is not liberal in granting suspensions or extensions of time to suspend for settlement after the answer is filed but prior to the parties' discovery conference. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42245 (August 1, 2007) (explaining that the discovery conference itself provides an opportunity to discuss settlement).

Discovery Closes	4/26/2014
Plaintiff's Pretrial Disclosures	6/10/2014
Plaintiff's 30-day Trial Period Ends	7/25/2014
Defendant's Pretrial Disclosures	8/9/2014
Defendant's 30-day Trial Period Ends	9/23/2014
Plaintiff's Rebuttal Disclosures	10/8/2014
Plaintiff's 15-day Rebuttal Period Ends	11/7/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.