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

Proceeding	91208639
Party	Defendant City of Deer Park, Texas
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Submission	Motion to Dismiss - Rule 12(b)
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Date	06/04/2013
Attachments	WALLY - 91208639 - 12(b)(6) Motion to Dismiss.pdf(169293 bytes)

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Correspondence Address	Robb D. Edmonds Edmonds & Nolte PC 2625 Bay Area Blvd. Suite 530 Houston, TX 77058
Submission	Motion to Dismiss Under FRCP 12(b)(6)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

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BOSTON RED SOX BASEBALL CLUB
LIMITED PARTNERSHIP,

Opposer,

OPPOSITION NO.: 91208639

v.

SERIAL NO.: 85350447

CITY OF DEER PARK, TEXAS

Applicant
-----X

**APPLICANT'S MOTION TO DISMISS OPPOSITION PURSUANT TO
RULE 12(b)(6) OF THE FEDERAL RULES OF CIVIL PROCEDURE**

Applicant CITY OF DEER PARK, TX ("Applicant"), by its attorneys Edmonds & Nolte, P.C., hereby requests that the Trademark Trial and Appeal Board ("the Board") dismiss Opposition No. 91208639 filed by Opposer Boston Red Sox Baseball Club Limited Partnership ("Opposer") in opposition of registration of Application Serial No. 85/350,447 based on Opposer's failure to state a claim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

I. BACKGROUND

On June 20, 2011, Applicant filed an application for registration of its trademark design, including use of the name WALLY, in International Class 16 for brochures, booklets, and teaching material to instruct citizens and provide safety information regarding shelter in place and chemical release. Application Serial No. 85/350,447. On December 27, 2012, Opposer filed a Notice of Opposition ("Opposition") to deny registration of Applicant's mark on the alleged basis that it was likely to cause confusion with two of its registered marks in International

Classes 25 and 41, namely, marks used in connection with sports and sport related goods and services.

II. STANDARD OF REVIEW

The Board must dismiss an opposition to registration under Rule 12(b)(6) if it fails to state a claim that is "plausible on its face." T.B.M.P § 503.02, citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). The purpose of Fed. R. Civ. P. 12(b)(6) "is to allow the court [the Board] to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced Cardiovascular Sys. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed.Cir. 1993). When ruling on a motion to dismiss, "[c]onclusory allegations of law and unwarranted inferences of facts do not suffice to support a claim." *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed.Cir. 1998). Opposer's allegations asserted in Opposition No. 91208639 fail as a matter of law when held to this clear, established precedence.

III. ARGUMENT

A party opposing registration of a mark must sufficiently plead that the Opposer has (1) standing, *i.e.*, damage alleged by the registration of the opposed mark, and (2) grounds for the opposition. T.B.M.P § 309.03(a)(2), citing 37 C.F.R. § 2.104(a) and *Young v. AGB Corp.*, 152 F.3d 1377 (Fed.Cir. 1998) (standing and grounds are distinct inquiries). Here, Opposer has failed to sufficiently plead either requirement resulting in a failure to state a claim that is "plausible on its face."

A. Opposer does not have standing

Any person who believes it is or will suffer damages by registration of a mark has standing to file an opposition. T.B.M.P. § 309.03(b). However, the Opposer must plead a

"reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *Id.* An Opposer can suffer damages if it pleads a claim of likelihood of confusion that is not without merit. Here, Opposer's claim of likelihood of confusion is wholly without merit as described below in Subsection B.

Opposer has not sufficiently pled a reasonable basis that it would suffer some kind of damage if Applicant's mark was granted registration. Applicant's mark is in connection with brochures, booklets, and teaching materials to instruct citizens and provide safety information regarding shelter in place and chemical release. Opposer has not alleged that it uses its mark in connection with any of the above listed goods or services. Opposition at 2 and 4. Indeed, Opposer's alleged Registration Nos. 3,797,632 and 3,801,204 do not describe any of the goods and/or services described in Applicant's Application Serial No. 85/350,447, *i.e.*, brochures, booklets, and teaching materials to instruct citizens and provide safety information regarding shelter in place and chemical release.

Further, Applicant's Application Serial No. 85/350,447 is listed in International Class 16. Neither of Opposer's asserted marks is listed in International Class 16. Opposer's Registration Nos. 3,797,632 and 3,801,204 are registered in International Classes 25 and 41, respectively.

Accordingly, there is no reasonable basis that Opposer would suffer some kind of damage if Applicant's mark is registered since Opposer's marks have no overlap in use.

B. There is no likelihood of confusion

In addition to standing, Opposer must also sufficiently plead a statutory ground for opposition. T.B.M.P. § 309.03(c) citing *Young v. AGB Corp.*, 152 F.3d 1377 (Fed.Cir. 1998). Although no statute is expressly stated as Opposer's grounds for opposition, Opposer alleges

possible confusion in paragraph 8. Contrary to Opposer's allegations, however, there is no likelihood of confusion between Opposer's mark and Applicant's mark.

Opposer has no exclusive rights to the word WALLY, and provides no legal basis to claim any right in the word WALLY. Nevertheless, Opposer asserts rights to the terms WALLY, WALLY THE GREEN MONSTER, and WALLY-WORLD via its design marks (Registration Nos. 3,797,632 and 3,801,204). Opposition at 2-3. However, Registration Nos. 3,797,632 and 3,801,204 are design marks only. There is no reference to the term WALLY in either registration. Therefore, Opposer's reference to "Opposer's WALLY Marks" is disingenuous and misleading.

Further, the *du Pont* factors weigh in favor of no likelihood of confusion between Opposer's alleged marks and Applicant's mark. These factors include (1) the similarity of the marks, (2) the relatedness of the goods and/or services, (3) the channels of trade and classes of purchases for the goods and/or services, (4) the number and nature of similar marks in use on similar goods, (5) the nature and extent of any actual confusion, and (6) the fame of the prior mark. *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). The relevance and weight to be given the various factors may differ from case to case and a single *du Pont* factor may be dispositive. *Id.* In this case, the similarity of the marks is dispositive since the marks are easily distinguishable.

1. No similarity of the marks

There are no similarities in the design marks other than Applicant's mark and Opposer's mark are directed to mascots. But as depicted below, Applicant's mark is a turtle-like creature wearing a red and yellow hat, green and yellow shirt with purple sleeves, green pants, green and yellow turtle shell, and yellow, red, and white shoes with yellow shoelaces. Applicant's mark

further bears the letter "W" on its hat, white gloves, a turtle-neck shirt with WALLY across the neck portion, pants, teeth, and both hands showing. Applicant's mark claims rights to those red, white, black, yellow, and green color combinations.¹ Conversely, Opposer's marks do not include any of these elements. Opposer's mark is a furry animal like creature wearing shorts, a baseball jersey bearing the words "Red Sox", a hat bearing the letter "B", a belt, hair, and a moustache, much like a baseball player.



Applicant's Mark



Opposer's Mark

2. No relatedness of the goods and/or services

There is no overlap in the goods or services used in connection with Applicant's mark and Opposer's alleged marks. Applicant's mark is used in connection with brochures, booklets, and teaching materials to instruct citizens and provide safety information regarding shelter in place and chemical release. Opposer's mark is used in connection with baseball or baseball related goods and services. None of these good and services overlap or are remotely related.

¹ Oposer's Registration Nos. 3,797,632 and 3,801,204 do not claim rights to any colors.

3. The channels of trade and classes of purchases for the goods and/or services

There is no overlap in the channels of trade and classes of purchasers for the goods or services used in connection with Applicant's mark and Opposer's alleged marks. As mentioned above, Applicant's mark is used in connection with brochures, booklets, and teaching materials to instruct citizens and provide safety information regarding shelter in place and chemical release. Opposer's mark is used in connection with baseball or baseball related goods and services.

4. The number and nature of similar marks in use on similar goods

There are no known similar marks in use on similar goods for either the Applicant's mark or Opposer's alleged marks.

5. The nature and extent of any actual confusion

There has been no actual confusion between Applicant's mark and Opposer's alleged marks.

6. The fame of the prior mark.

The Applicant's mark nor the Opposer's marks have obtained status as a famous mark.

Accordingly, each and every *du Pont* factor above weighs in favor of no likelihood of confusion. Therefore, Applicant's Motion to Dismiss should be granted on the grounds that Opposer has not plead a sufficient ground to oppose Applicant's registration of Serial No. 85/350,447, and the alleged grounds for the Opposition are fatally flawed in their legal premises and destined to fail.

IV. CONCLUSION

WHEREFORE, Applicant respectfully requests that judgment be entered in its favor, that Opposer's Notice of Opposition be dismissed with prejudice, that Applicant's WALLY and

design mark be allowed to proceed to registration, and that Applicant be granted such additional and further relief as the Board deems equitable and just.

Dated: June 4, 2013

Respectfully submitted,

/Robb D. Edmonds/
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CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that Applicant's MOTION TO DISMISS OPPOSITION PURSUANT TO RULE 12(b)(6) OF THE FEDERAL RULES OF CIVIL PROCEDURE is being filed electronically with the United States Patent and Trademark Office utilizing the *Electronic System for Trademark Trials and Appeals* this 4th day of June, 2013.

/Robb D. Edmonds/

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing was sent via email and USPS, first class mail, to the attorney for the Opposer at the following address:

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/Robb D. Edmonds/