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

Proceeding	91211312
Party	Plaintiff GrubHub, Inc
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial No.: 85/820,352
For the Mark: GURUHUB
Filed: January 10, 2013
Date of Publication: May 28, 2013

GRUBHUB, INC.,)	
a Delaware corporation,)	
)	
Opposer,)	
)	Opposition No. 91211312
v.)	
)	
SO WITHIN REACH, LLC,)	
an Alabama limited liability company,)	
)	
Applicant.)	

OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO DISMISS

INTRODUCTION

Opposer, GrubHub, Inc. (“Opposer”), has adequately alleged facts sufficient to state a claim in its Opposition, and Applicant, So Within Reach, LLC’s (“Applicant”), fails to demonstrate otherwise. Applicant does not dispute the sufficiency of the Opposition. Instead, Applicant improperly asserts affirmative defenses and facts outside the pleading, neither of which are appropriate on a motion to dismiss. Therefore, Applicant’s Motion to Dismiss should be denied.

STANDARD OF REVIEW

“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.” *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q. 2d 1536, 1538 (TTAB 2007) (citation omitted). “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 the mark.” *Id.*; *Trademark Trial & Appeal Board Manual of Procedure* (“*TBMP*”) § 503.02 (3d ed. rev. 2013).¹

ARGUMENT

The Board should deny Applicant’s Motion to Dismiss because Applicant does not argue that Opposer fails to sufficiently allege a claim. Opposer clearly alleges standing to bring the Opposition based upon ownership of prior applications and registrations for the GRUBHUB mark. (Opp. at ¶¶ 1-3.) Second, Opposer has sufficiently alleged valid grounds for an opposition based due on likelihood of confusion. (Opp. at ¶¶ 6-10.) Applicant does not dispute the sufficiency of these Notice of Opposition allegations. Instead, Applicant improperly argues against the merits of the Opposition. The Board should not consider such arguments on a motion to dismiss. *See Fair Indigo LLC*, 85 U.S.P.Q. 2d at 1538-39 (denying applicant’s motion to dismiss because the motion consisted of arguments and evidence that went to the merits of the claim and not whether a valid claim had been stated). Applicant cannot meet its burden to establish that the Notice of Opposition fails to state a claim based on likelihood of confusion.

I. OPPOSER HAS STANDING TO OPPOSE APPLICANT’S GURUHUB APPLICATION

As a threshold matter, Applicant does not dispute Opposer’s standing to oppose the Application. Furthermore, Opposer has adequately pled that it “would be damaged by the registration of a mark upon the principal register . . .” 15 USC § 1063(a). To establish standing,

¹ Applicant cites *Young v. AGB Corporation*, 152 F.3d 1377 (Fed. Cir. 1998), in support of its Motion to Dismiss without any analysis. (*See* Mot. to Dismiss at p. 2.) In *Young*, the court ultimately dismissed the Notice of Opposition based upon the opposer’s failure to identify any statutory basis for maintaining a claim. *Young*, 152 F.3d at .1378-79, 1381. As set forth in more detail below, Opposer has clearly identified and sufficiently alleged a claim based upon likelihood of confusion. (Opp. at ¶¶ 6-10.)

an “opposer must have a ‘real interest’ in the proceedings and must have a ‘reasonable’ basis for his belief of damage.” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999).

Here, Opposer alleged ownership and attached true and accurate copies of USPTO records reflecting (1) Opposer’s ownership of the GRUBHUB mark and several related GRUBHUB marks; and (2) prior-in-time applications for other GRUBHUB marks.² (Opp. at ¶¶ 1-3.) These facts are sufficient to allege that Opposer has “a real interest in the outcome of this proceeding; that is, opposer has a direct and personal stake in preventing the registration of applicant's mark for the identified goods.” *SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 U.S.P.Q.2d 1300, 1301 (TTAB 2010). *See* 15 USC § 1114(1); 15 USC § 1057(b); *see also* 15 USC § 1057(c) (an application to register a mark is considered constructive use). In addition, Opposer has a reasonable basis for filing its Notice of Opposition because it has pled that there are similarities between the marks and relatedness between the goods and services. (Opp. at ¶¶ 7-10.) *See Spirits Int’l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 U.S.P.Q.2d 1545, 1548 (TTAB 2011). Accordingly, Opposer has standing to oppose Applicant’s mark.

² In its Opposition, Opposer identified four of its pending applications. (Opp. at ¶¶ 2-3.) In the intervening time period between the Notice of Opposition and the filing of the motion to dismiss, three of those marks have since registered: (a) GRUBHUB, Serial Number 85/800,677, Registration Number 4,368,564, on July 16, 2013; (b) GRUBHUB, Serial Number 85/763,034, Registration Number, 4,363,972, on July 9, 2013; and (3) GH, Serial Number 85/765,682, Registration Number 4364,028, on July 9, 2013. *See TBMP* § 704.03(b)(1)(A) (3d ed. rev. 2013) (“A plaintiff which pleads ownership of an application in its complaint must, in order to rely on the subsequently issued registration, make the registration of record. However, the plaintiff does not have to amend its pleading to assert the registration. The pleading of the application is viewed as providing sufficient notice to the defendant of the plaintiff’s intention to rely on any registration that issues from the pleaded application.”); *Nike Inc. v. WNBA Enters. LLC*, 85 U.S.P.Q.2d 1187, 1192 n.6 (TTAB 2007) (“When a Federal registration owned by a party has been properly made of record, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board will take judicial notice of the current status of the registration, as shown by the records of the Office.”).

II. OPPOSER ALLEGES VALID GROUNDS TO OPPOSE THE APPLICATION

Opposer has sufficiently alleged likelihood of confusion as a basis for opposing the Application. To establish likelihood of confusion, an opposer must demonstrate that the subject application “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. . .” 15 USCS § 1052 (d); *see TBMP* § 309.03(c).

For example, in *William & Scott Co. v. Earl’s Restaurants, Ltd.*, 30 U.S.P.Q.2D 1870 (TTAB 1994), the Board denied applicant’s motion to dismiss opposer’s likelihood of confusion claim where opposer had alleged that the marks at issue, ALBINO RHINO and RHINO CHASERS, were “‘virtually identical in appearance and sound’” and that the goods were “‘offered in the same or related channels of trade to the same or overlapping classes of customers, ‘so that prospective purchasers and others are likely to be confused, mistaken or deceived’ as to the source of the parties’ respective goods.” *Id.* at 1871, 1873. Similarly, here Opposer alleges that (1) it owns several federal registrations for the mark GRUBHUB; (2) Applicant intends to offer services under the mark GURUHUB that are similar to the services that Opposer offers under the mark GRUBHUB (namely, computer services that share business information); and (3) the marks are so similar in sound and appearance that confusion would likely result. (Opp. at ¶¶ 1-3, 5, 7-9.) Accordingly, Opposer has sufficiently alleged a claim for likelihood of confusion.

Applicant does not challenge the sufficiency of these allegations, which must be taken as true at this stage of the proceeding. Instead, Applicant argues (based largely on facts outside the pleadings) that the proposed mark, as a matter of law, contains a generic element (“Hub”), is

CERTIFICATE OF SERVICE

I hereby certify that **OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS** is being filed using the Electronic System for Trademark Trials and Appeals, on this 15th day of August, 2013.

I further certify that, by agreement of the parties, I sent the foregoing document by electronic mail to the following e-mail addresses:

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on this 15th day of August, 2013.

/Steven L. Baron/