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

Proceeding	91217562
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No.: 86/061,950
Mark: UNCLE SAM'S MISGUIDED CHILDREN
Published for Opposition in the Official Gazette: January 28, 2014

UNCLE SAM GmbH)	
)	
Opposer,)	Opposition No. 91217562
)	Serial No. 86061950
)	
v.)	
)	
JENNIFER ZVITCO)	
)	
Applicant)	
)	

**BRIEF IN OPPOSITION TO MOTION TO AMEND NOTICE OF OPPOSITION
OR, IN THE ALTERNATIVE,
MOTION TO DISMISS FIRST AMENDED NOTICE OF OPPOSITION**

Opposer has filed its First Amended Notice of Opposition as a procedural ruse avoid and/or delay opposing the substance of Applicant's Motion to Dismiss. Moreover, Opposer's Motion to Amend must be denied because it fails to correct any defects alleged by Applicant or some technicality of pleading (as sparse it was), but rather due to the fundamental lack of right to the relief requested. Uncle Sam GmbH does not own, and cannot exclude others from using, the name and likeness of the historical and allegorical American character of "Uncle Sam." The Board should dismiss this matter under Rule 12(b)(6), as there is absolutely no plausible right to any relief for Opposer before this tribunal.

Opposer Uncle Sam GmbH's (hereinafter "Uncle Sam Germany" or "USG"), apparently conceding that its original Notice of Opposition was in fact defective, has requested leave to amend its Complaint. In response to the applicant's arguments, Uncle Sam Germany added approximately 105 words to its Complaint – three sentences, three clauses, and the words "in

fact.” A marked up version of the Amended Notice of Opposition, highlighting the paucity of substantive new additions, is attached hereto as **Exhibit A**. None of these sparse additions impacts the applicability of Applicant Jennifer Zvitco’s (hereinafter “Uncle Sam’s Misguided Children”) Motion to Dismiss.

The Board need not permit the Amendment based on its futility and lack of substance, and could instead grant the September 8, 2014 Motion to Dismiss. However, if the Board is inclined to allow the amendment and, in doing so, in any way deems Uncle Sam’s Misguided Children’s original Motion to Dismiss technically no longer in issue, Applicant hereby cross-moves to Dismiss the First Amended Notice of Opposition. Because Uncle Sam Germany has utterly failed to respond to the substance of the arguments fatal to its case, Uncle Sam’s Misguided Children herein sets forth the still-applicable arguments asserted in the September 8, 2014 Motion to Dismiss, reiterating Uncle Sam Germany’s failure to plead any claim for relief available to it as a matter of law. Uncle Sam’s Misguided Children requests that this matter – whether in the context of the original or amended Notice of Opposition – be dismissed in its entirety.

BACKGROUND

Uncle Sam’s Misguided Children filed a Motion to Dismiss on September 8, 2014. Uncle Sam Germany failed to file any brief in opposition to this motion within the timeframe permitted under the procedures of the Trademark Trial and Appeal Board. The motion, filed September 8, 2014 required opposition on or before **September 29, 2014** (the first business after 20 days after the Motion was filed and served – which included 15 days to oppose plus 5 days

for service by U.S. mail)¹. Having missed this deadline, Uncle Sam Germany did not reach out to seek consent for extension of time to oppose, but merely instead filed a belated document purporting to be “in response to the pending Motion to Dismiss” and purporting to “correct the defects that Applicant alleged.” *See* Motion to Amend at p. 1. Uncle Sam Germany also claims that under the Trademark Trial and Appeals Board rules, the simple filing of an amended complaint renders the Motion to Dismiss moot. In fact, the Manual of Procedure provides a motion to dismiss could be mooted only if “the amended complaint *corrects the defects noted by the defendant.*” Uncle Sam Germany’s amendment does nothing to address the arguments set forth by Plaintiff – especially those related to the right to exclude others from using, and each of the arguments in favor of dismissal at this stage still applies with equal force.

APPLICANT’S OPPOSITION TO THE MOTION TO AMEND

Uncle Sam’s Misguided Children opposes the Motion to Amend, and requests instead that its September 8, 2014 Motion to Dismiss be granted. 37 CFR 2.127(a) provides that “When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded.” Here, Defendant has filed only the Motion to Amend in response to the Motion to Dismiss. Should the Motion to Amend be denied, the Motion to Dismiss should be granted – both on its merits and for failure to file an opposing brief within time limits or addressing any of the substantive arguments. The Court should deny the Motion to Amend for the following reasons:

¹ Under 37 CFR 2.127(a) “a brief in response to a motion shall be filed within fifteen days from the date of service of the motion.”

Under 37 CFR 2.119(c), when a party makes service by US mail “5 days shall be added to the prescribed period” for response.

I. While leave to amend is liberally granted, the amendments must neither be futile nor patently without substance.

Uncle Sam Germany's Motion to Amend should be denied because it is futile and patently without substance as to the primary basis the Opposition must be dismissed – that no entity can exclusively use Uncle Sam. “Although leave to amend a complaint should be freely granted when justice so requires, see Fed. R. Civ. P. 15(a), the district court need not allow an amendment when there is undue delay, bad faith, dilatory motive, undue prejudice to the opposing party, or when the amendment would be futile. *Bethany Pharmacal Co. v. QVC, Inc.*, 241 F.3d 854, 860-61 (7th Cir. 2001), citing *Foman v. Davis*, 371 U.S. 178, 182, 9 L. Ed. 2d 222, 83 S. Ct. 227 (1962) and *Perrian v. O'Grady*, 958 F.2d 192, 194 (7th Cir. 1992). If the proposed amendments were “patently without substance,” courts are likewise permitted to deny leave to amend under Fed. R. Civ. P. 15. *Valdan Sportswear v. Montgomery Ward & Co.*, 591 F. Supp. 1188, 1191 (S.D.N.Y. 1984)

The power to deny leave to amend upon a showing of “futility” of the amendment brings this matter back within the ambit of a Motion to Dismiss. *Smith v. Café Asia*, 598 F. Supp. 2d 45, 47 (D.D.C. 2009) (holding that “An amendment is futile if the proposed claim would not survive a motion to dismiss.”); *see also Richardson v. United States*, 193 F.3d 545, 548-49, 338 U.S. App. D.C. 265 (D.C. Cir. 1999). Because futility is determined based on the Motion to Dismiss standard, the proposed pleading must be plausible on its face, meaning that the facts pled “allow[] the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949, 173 L. Ed. 2d 868 (2009).

Here, no new claims were even pled, but a few dozen words, which do nothing to ameliorate the fatal defect in the Notice of Opposition, were added to a defective pleading. The

newly added text is patently without substance, as it does not correct the fundamental and fatal defect which deprives Uncle Sam Germany of the right to any relief at all.

II. Defendant's sole rebuttals to the Motion to Dismiss – filed 5 days after the Opposition to Dismiss was due – was to change inconsequential words in the Notice of Opposition and oppose judicially noticeable facts.

As described in the Background, above, Defendant missed its opportunity to oppose the Motion to Dismiss, instead opting for the risky gambit of relying on a weak amendment to the Notice of Opposition to defeat the Motion to Dismiss. This amendment – however cast by Uncle Sam Germany – does nothing to address the substantive arguments put forth by Uncle Sam's Misguided Children which compel this Board to dismiss the Opposition as a matter of law. *See* arguments, *infra*, re: e.g., *Durable Toy & Novelty Corp. v. J. Chein & Co., Inc.*, 133 F.2d 853 (2d Cir.), *cert. denied*, 320 U.S. 211, 63 S.Ct. 1447, 87 L.Ed. 1849 (1943) (per L. Hand, A. Hand, Frank). Simply, Uncle Sam Germany has no right use the offices or procedures of the Trademark Trial and Appeal Board to exclude others from invoking the name of the national character of Uncle Sam. The Board is permitted to decide this matter as a matter of law, rather than after lengthy discovery regarding Uncle Sam Germany's use (or non-use) of its mark in the territory. The filing of an Affidavit of Continued Use – USG's primary new text in its First Amended Notice of Opposition – says nothing about its right to oppose another's use of the character Uncle Sam. Moreover, Uncle Sam Germany claims in its filing that the judicially noticeable facts regarding its own website somehow turn the Motion to Dismiss into a Motion for Summary Judgment. Even excluding the challenged facts, the case must be dismissed based on the *Durable Toy* case.

**ALTERNATIVE CROSS-MOTION TO DISMISS
THE FIRST AMENDED NOTICE OF OPPOSITION**

Should the Board grant Uncle Sam Germany's Motion to Amend its Notice of Opposition, and in doing so in any way deems Uncle Sam's Misguided Children's original Motion to Dismiss as "moot," Plaintiff re-asserts by way of this cross-motion the arguments set forth in the original Motion to Dismiss, filed September 8, 2014. For the convenience of the Board, Uncle Sam's Misguided Children has below updated the text Motion to Dismiss to include reference to the First Amended Notice of Opposition, but changed no other text.

INTRODUCTION

Uncle Sam's Misguided Children, by undersigned counsel, hereby moves pursuant to Fed. R. Civ. P. 12(b)(6) to dismiss Uncle Sam Germany's First Amended Notice of Opposition. For the following reasons the Board should dismiss USG's First Amended Notice of Opposition:

- (1) The figure and name of Uncle Sam are historical and widely-used symbols of national piety, which Uncle Sam Germany has no right to exclude others from exploiting;
- (2) Because Uncle Sam's Misguided Children is a fanciful and unique use of this national character owned by no party, there can be no likelihood of confusion between Uncle Sam's Misguided Children and the far more generic appropriation made by USG;
- (3) Opposer's "false suggestion of connection" claim fails as a matter of law, because no person or entity (other than a legendary character) is referred to in the Uncle Sam's Misguided Children mark, and no connection to USG's "persona" can be suggested.

BACKGROUND

Back in the midst of World War II, the Second Circuit made clear that no one -- not even an American company, let alone a European or German company -- can have the exclusive right to use the name and figure of national piety such as Uncle Sam. *See Durable Toy & Novelty Corp. v. J. Chein & Co., Inc.*, 133 F.2d 853 (2d Cir.), *cert. denied*, 320 U.S. 211, 63 S.Ct. 1447, 87 L.Ed. 1849 (1943) (per L. Hand, A. Hand, Frank). The passage of more than 70 years has not diluted this historic figure or given a German company selling T-shirts in Germany the right to

prevent a trademark for the clearly distinguishable Uncle Sam's Misguided Children veteran organization.

FACTUAL ASSERTIONS

Even if taken as true, Uncle Sam Germany's well-pleaded factual assertions (to the extent plausible) fail to give it a right to relief before this board. A summary of Uncle Sam Germany's allegations are as follows:

Without reference to any geographic scope, Uncle Sam Germany claims that it has "longstanding" rights in the words "Uncle Sam." Am. Opp. at ¶ 1. USG claims that it "has protected, used and continues to use" the words "Uncle Sam" in connection with "a wide range of clothing items." *Id.* USG claims it owns trademark no. 1,189,422 registered originally by Salant Corporation in 1982, and apparently assigned and/or sold several times. *Id.* at ¶ 2. USG also claims that it owns trademark registration no. 3,557,762 for a word and design mark with "Uncle Sam" and a drawing of the traditional "I want you!" Uncle Sam character, *Id.* at ¶ 3, while failing to identify that this drawing, these words, and the name Uncle Sam have been in long-standing use in government advertising and American national mythology. Although USG's German-language website (the only website USG appears to operate) indicates that the brand was founded in Germany in 1986², USG claims that the registration's first use in commerce in the United States was January 1, 1900. *Id.* at ¶ 5. USG claims that it possesses trademark rights to the Uncle Sam mark or marks in other jurisdictions world-wide. *Id.* at ¶ 6. USG claims that it has built up "valuable goodwill" by "extensive use" in the U.S. of the words "Uncle Sam" and that the words "Uncle Sam" have become "uniquely identified and associated with" Uncle Sam Germany. *Id.* at ¶ 7.

On the other hand, Uncle Sam’s Misguided Children filed the opposed application on or about September 11, 2013 in Class 25 for t-shirts and apparel featuring the word mark “Uncle Sam’s Misguided Children” and in class 41 for Uncle Sam’s Misguided Children’s veterans-focused “publications . . . news articles and podcasts in the field(s) of politics, popular culture, leadership, current events, social policy, general business topics and news analysis.” *Id.* at ¶ 8. Uncle Sam’s Misguided Children began using “Uncle Sam’s Misguided Children” on or about July 9, 2012. *Id.*

USG claims that the Uncle Sam’s Misguided Children Class 25 goods are “identical and/or closely related” to the goods covered by USG’s registration, and that the words “Uncle Sam’s Misguided Children” so resembles “Uncle Sam” that members of the public would be confused, and are likely to believe USG is the origin Uncle Sam’s Misguided Children apparel. *Id.* at ¶¶ 9-11. USG claims that it would suffer injury because “Uncle Sam’s Misguided Children” somehow closely approximates “Uncle Sam” and suggests to members of the public that Uncle Sam’s Misguided Children goods are actually from the German sportswear company, not the American veteran organization. *Id.*

LEGAL ARGUMENT

I. Legal Standards

(a) Motion to Dismiss

Rule 12(b)(6) provides for the dismissal of an action where a complaint fails “to state a claim upon which relief can be granted.” When the sufficiency of a complaint is challenged under Rule 12(b)(6), “the court must accept its factual allegations and construe them in a light most favorable to the non-moving party.” *Chamberlain v. American Honda Fin. Corp.*, 931

² “Uncle Sam – Über uns [About Us]”, available online at

A.2d 1018, 1023 (D.C. 2007). However, the “[f]actual allegations must be enough to raise a right to relief **above the speculative level.**” *Bell Atlantic Corp. v. Twombly*, 127 S. Ct. 1955, 1965 (2007) (emphasis added). “[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*, 129 S. Ct. 1937, 1949 (2009) (internal quotation omitted). Plaintiffs must put forth “factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* “[D]ismissal under Rule 12(b)(6) is appropriate where the Complaint fails to allege the elements of a legally viable claim.” *Chamberlain*, 931 A.2d at 1023. Under *Bell Atlantic*, the Supreme Court has described Plaintiffs’ burden to plead “plausible entitlement to relief” by setting forth “facts consistent with the allegations.” 127 S. Ct. at 1970. Conclusory allegations or legal conclusions masquerading as factual allegations will *not* suffice to prevent a motion to dismiss.

To avoid dismissal under Rule 12(b)(6) in the TTAB, an opposer must allege “facts as would, if proven, establish both its standing to challenge applicant’s right to registration and a . . . statutory ground for opposition to the application.” *Commodore Electronics Ltd. v. Cbm Kabushiki Kaisha Opposition*, 26 USPQ2d 1503, 1506 (TTAB 1993) (emphasis removed). The Board may dismiss the case under Fed. R. Civ. P. 12(b)(6) if “it appears to a certainty that [a party] is entitled to no relief under any state of facts which could be proved in support of the claim.” *Flash & Partners S.P.A. v. I. E. Manufacturing LLC*, 95 USPQ2d 1813, 1815 (TTAB 2010) (quoting *Stanspec Co. v. Am. Chain & Cable Co., Inc.*, 189 USPQ 420, 422 (CCPA 1976)).

(b) Likelihood of Confusion under 12(b)(6)

USG alleges that confusion is likely to result. To state a proper claim for confusion, Opposer must allege a valid “priority of use” and that “likelihood of confusion” would result. *Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1420 (TTAB 2008); *see also* 15 USC § 1052(d). While likelihood of confusion may require factual development, the Board can rule immediately that USG has no superior claim to use the name or character of “Uncle Sam” that would prevent the registration of the unique and fanciful “Uncle Sam’s Misguided Children.”

(c) False Suggestion of Connection under 12(b)(6)

USG’s second claim at ¶ 11 is that Uncle Sam’s Misguided Children’s registration would “falsely suggest a connection between Applicant and Opposer.” Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a) bars registration if the mark falsely suggests a connection with *persons* (living or dead), *institutions*, *national symbols*, or *beliefs*. In *inter partes* proceedings before the Board, an essential element of a Section 2(a) claim of false suggestion of a connection is that the defendant’s mark must point uniquely and unmistakably to the identity or persona of the “person” or “institution” asserting the claim. If the defendant’s mark does not point uniquely and unmistakably to the plaintiff’s identity or persona, then there can be no false suggestion of a connection. *See, e.g., National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1676 (TTAB 1987). The false suggestion of a connection to USG as a commercial entity does not bar the Applicant’s registration under 2(a).

II. The term “Uncle Sam” standing alone cannot be protected because it is not distinct, and because its use by USG is merely an adoption of the national legend.

USG cannot adopt for itself a character so rooted in the national psyche and declare itself the only lawful user of the name in a class of goods. Uncle Sam is a character said to have

originated in the early 1800s, and is widely known to be a personification of the United States. USG's use of "Uncle Sam" is no more complicated than the straight appropriation of the name and likeness of this character – a fact acknowledged by USG's German-language website: "Uncle Sam originated from the popular national figure in the United States and represents . . . the American Way of Life. Therefore, the acronym US stands not only for Uncle Sam, but also for the United States."³

Regardless of whether USG's marks have any independent strength or resonance in Germany or other countries, they are as a matter of law not capable of protection in the United States. Courts will not confer the advantage to one business alone of a word or phrase of very common usage, or one imbued with symbolic importance. *Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847 (W.D.N.Y. 1980) (declining to protect "Mother's Restaurants" in action against purported infringer "Mother's Bakery"). The Court explained why one business may not prevent another from using words like "Mother" (or here, Uncle Sam):

In addition to the lack of a likelihood of confusion between marks, an additional factor weighs against granting defendants the injunctive relief they request, a factor closely related to the distinctiveness of the word "Mother's." "Mother" or "Mother's" is not only a word of very common usage. It is a word imbued with much symbolic importance, and it is no doubt exploited so frequently because of the impression it imparts of a connection to the values of motherhood, home and family. This is certainly evidenced by the great frequency of uses by non-parties to this case, discussed above. There would seem to be a general advantage to businesses in exploiting the word "Mother's" which this court should be extremely hesitant to confer upon one business alone. *See Durable Toy & Novelty Corp. v. J. Chein & Co., Inc.*, 133 F.2d 853 (2d Cir.), *cert. denied*, 320 U.S. 211, 63 S.Ct. 1447, 87 L.Ed. 1849 (1943) (per L. Hand, A. Hand, Frank); *Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531 (2d Cir. 1964)."

The *Durable Toy* case cited in *Mother's Restaurants* is of particular and dispositive relevance here. In that case, the Durable Toy company made a toy bank with the label "Uncle Sam" or

³ "Uncle Sam – About Us" (Google Translate of <http://www.unclesam.de/index.php/ueber-uncle->

“Uncle Sam’s” purported to be of high quality. The defendant J. Chein & Co. began making a cheap tin coin bank, also called “Uncle Sam” and using the “accredited” costume of the Uncle Sam character – which was as well known in 1943 as it is today (and then, as today, used by many unrelated companies in various pursuits). The Second Circuit held that Durable Toy could not prevent J. Chein from using the character, symbols, or name of the “Uncle Sam” character for the simple reason that **no entity could come to exclusively use Uncle Sam’s name or character**, as they could a personal name or a fanciful mark:

Where the name is personal or the mark is coined, it will be hard indeed for the newcomer to find any excuse for invading it, even though his user does no more than vaguely confuse the reputation of the first user with his own; he has no lawful interest in adopting such a mark. But that is not this case; **“Uncle Sam” is part of the national mythology, not entirely unlike the flag, or any other part of our inherited patriotic paraphernalia; all have a measurable interest in its use.** Indeed the very fact that it has been thought necessary to forbid the use of the flag for advertising, is evidence that the use had a value, 4 U. S.C.A. § 3; § 1425 (16) N.Y. Penal Law Consol. Laws N.Y.C. The figure and name of “Uncle Sam” are not indeed the objects of the same national piety, but there is nevertheless apparently some advantage in exploiting them, and, while it remains lawful to do so, the advantage is not negligible. Balanced against any possible damage to the plaintiff’s reputation among buyers for retailers, we think it should prevail. If the plaintiff had wished a truly proprietary sign, it needed only slight ingenuity to contrive one which would have protected it without question. It was not content with that; like the defendants, it wished to throw about its banks a vague implication of solidity, and at the same time to create a trade-mark. We do not say that even so it would be unable to prevent the actual appropriation of its customers; but we do hold that when there is no more at stake than a possible — and not very probable — cheapening of its reputation, it cannot deprive others of the same commercial advantage which led it originally to adopt a legend so commonly employed.

Durable Toy & Novelty Co. v. J. Chein & Co., 133 F.2d 853 (2d. Cir. 1943) (cert denied).

The *Durable Toy* Court observed that one need “only slight ingenuity to contrive [a mark] which would have protected it without question.” Here, Uncle Sam’s Misguided Children has taken that slight ingenuity to create a fanciful and distinct name, while USG’s purported

[sam/](#) (last accessed September 3, 2014).

mark(s) are merely the strict and unchanged adoption of the same legendary character that could not be protected in *Durable Toy*. Under the rationale of *Mother's* and *Durable Toy*, this board can completely dispose of this First Amended Notice of Opposition.

III. There is no likelihood of confusion because USG's mark is only used in Germany and/or Europe.

The marks at issue here are extremely different, and there exists no likelihood of confusion in more than one party having trademarks containing the same historical and allegorical symbol, whose name and character have come to symbolize the United States – not a European t-shirt company. USG, at Paragraph 10 of its First Amended Notice of Opposition, alleges as one of its claims for opposing Applicant's trademark that it is likely to cause confusion with USG in Class 25 goods. A claim for likelihood of confusion arises under 15 U.S.C. § 1052(d) (also known as § 2(d) of the Trademark Act) when a mark so resembles another registered mark as to cause confusion. The board may dispose of this claim as a matter of law, both (1) based on the *Durable Toy* analysis of the Uncle Sam national symbol above, and (2) the absence of likelihood of confusion in the United States for a clothing company that operates only in Germany and/or Europe.

Weak designations are entitled to a narrower scope of protection than an entirely arbitrary or coined word. *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984). When conflicting marks are owned by different parties, the entity examining the registration must consider the dilution presented by multiple uses of the same mark. Without question, the usage of "Uncle Sam" as a trademark is subject to extreme dilution by the wide variety of parties using the words "Uncle Sam" in registered marks (and unregistered uses). A search of the USPTO's TESS system reveals at least 30 active registered marks using Uncle Sam in some form or another, with 86 more dead. Just some examples include:

- Uncle Sam’s Safari Outfitters (Reg. No. 1186200) (Retail Store Services Featuring Military Surplus Goods, Outdoor Clothing, and Camping Gear)
- Uncle Sam’s Avengers (Reg. No. 4341699) (Charitable fundraising services [motorcycle club])
- Uncle Sam’s Trojans (Reg. No. 2993492) (Clothing bearing defunct sports team logos, namely t-shirts, sweatshirts, jerseys, hats, and caps)
- Uncle Sam’s Pizza (Reg. No. 1486492) (Food Delivery Services)
- Uncle Sam (Reg. No. 1383607) (Fresh Citrus Fruit)
- Uncle Sam (Reg. No. 1878790) (Breakfast cereal)
- Uncle Sam’s (Reg. No. 2346355) (Dog and cat treats)

These files, the widely-known history of the character of Uncle Sam, and the text of Uncle Sam Germany’s own (German-only) website are facts capable of judicial notice. *See* 37 CFR § 2.122(a); Fed. R. Evid. § 201(b)(1) and (2) (The board may judicially notice a fact that is not subject to reasonable dispute because: “it: (1) is generally known within the trial court’s territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned”). The character of Uncle Sam is not exclusively associated with a German sportswear company within the United States (nor would a strong product like a toy bank, as in *Durable Toy*, give it exclusive rights to the character). It is also without question that Uncle Sam GmbH has only a German-language website and uses channels of trade only within Europe (or Germany).

To survive dismissal, a petitioner must articulate a “**plausible**” claim for relief, a standard which the reviewing body should consider in light of its “judicial experience and common sense.” *Ashcroft v. Iqbal* sets forth a two-pronged approach for courts when deciding a motion to dismiss: 1) identify pleadings that, “because they are no more than conclusions, are not entitled to the assumption of truth” and 2) if a complaint contains well-pleaded factual allegations, a court must “then determine whether they plausibly give rise to an entitlement to relief.” *Iqbal*, 129 S. Ct at 1950. Plaintiffs are required to provide the grounds of their entitlement for relief, and not simply use labels and conclusions, accompanied by formulaic recitations of the elements

of a cause of action. If implausible, the Board need not credit the conclusory and unsupported statements made in USG's First Amended Notice of Opposition. If this case were allowed to continue, the Board would expend valuable time and resources of the Board and both parties, where there are multiple bases on which to dismiss the First Amended Notice of Opposition with prejudice, and no likelihood of confusion between "Uncle Sam's Misguided Children" and Uncle Sam Germany's unadorned appropriation of a symbol free to use by all Americans.

IV. The claim for a false suggestion of connection fails as a matter of law, because Opposer does not represent a person (an actual Uncle named Sam) or institution (the United States government) for which a suggestion of connection exists.

In Paragraph 11 of its First Amended Notice of Opposition, Opposer wrongly, and without standing, argues that registration of USMC's mark would suggest a false connection to Opposer. *See* First Amended Notice of Opposition at ¶ 11. This argument is without merit because Opposer is not the actual person Uncle Sam, nor are is it the institution associated with Uncle Sam, namely the United States government or its military. As such, Uncle Sam's Misguided Children's mark would not suggest a connection to Uncle Sam Germany, as proscribed under 15 U.S.C. §1052(a).

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, that falsely suggests a connection with them. Section 2(a) is distinctly different from §2(d), 15 U.S.C. §1052(d), for which the relevant test is likelihood of confusion. The purpose of the protection in Section 2(a) is to protect the names of individuals or institutions that were not technically a trademark. This was made clear in *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982), the Court

of Appeals for the Federal Circuit stated, “a reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical “trademark” or “trade name” upon which an objection could be made under §2(d).”

The right to privacy encompassed in Section 2(a) protects a party’s control over the use of its identity or “persona.” A party acquires a protectable interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party’s personality or “persona.” *Id.* Section 2(a) protection is intended to prevent the unauthorized use of the persona of a person or institution and not to protect the public. *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1380 (TTAB 2008) (citing *Bridgestone/Firestone Research Inc. v. Auto. Club De L’Quest De La France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001)).

In this instance, Opposer is not the United States government, nor an actual famous Uncle named Sam, as such it is not the individual whose “persona” needs protecting. *Univ. of Notre Dame du Lac*, 703 F.2d 1372 (NOTRE DAME and design, for cheese, held not to falsely suggest a connection with the University of Notre Dame. “As the board noted, ‘Notre Dame’ is not a name **solely associated with the University**. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only ‘person’ which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.”) (emphasis added); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (cancellation petitioners failed to state claim for relief where they have not alleged, and cannot reasonably allege, that the term INTERNET

points uniquely and unmistakably to their own identity or persona). To show an invasion of persona, Opposer must show that the mark submitted for registration points “uniquely” to another person. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1377 (Fed. Cir. 1983). No one seeing the brand Uncle Sam’s Misguided Children would associate it with Opposer, rather observer associating it with anyone other than Uncle Sam’s Misguided Children would likely think first of the national symbol Uncle Sam - a symbol that should never be owned by a German company that does not operate in the United States.

As such, USG does not have a colorable claim for false connection in this instance, and all such claims contained in the First Amended Notice of Opposition should be dismissed and/or stricken.

CONCLUSION

WHEREFORE, Jennifer Zvitco, by and through undersigned counsel and for the reasons stated above, respectfully requests that this Board deny Opposer’s Motion to Amend and dismiss with prejudice Opposer’s Notice of Opposition and/or First Amended Notice of Opposition.

ORAL HEARING REQUESTED

Applicant requests an oral and/or telephonic hearing on all issues herein.

Dated: October 17, 2014

Respectfully submitted,

POSEY LEBOWITZ PLLC

ATTENTIVE LAW GROUP, PLLC

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served upon counsel for applicant this 17th day of October, 2014, by mailing a copy thereof via first-class mail, postage prepaid, to:

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/s/ Ryan C. Posey
Ryan C. Posey

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

In the Matter of Application Serial No.: 86/061,950
Mark: UNCLE SAM'S MISGUIDED CHILDREN
Published for Opposition in the Official Gazette: January 28, 2014

UNCLE SAM GmbH)	
)	
Opposer,)	Opposition No. 91217562
)	Serial No. 86061950
)	
v.)	
)	
JENNIFER ZVITCO)	
)	
Applicant)	
)	

PROPOSED ORDER GRANTING MOTION TO DISMISS

Upon consideration of Defendant's Motion to Dismiss, and any response thereto, it is hereby ORDERED that:

- (1) Applicant's Motion to Dismiss is GRANTED; and it is further ORDERED that
- (2) Opposer's Motion to Amend is DENIED; and it is further ORDERED that
- (3) Opposer's Notice of Opposition and First Amended Notice of Opposition are hereby dismissed with prejudice.

Trademark Trial and Appeal Board

Copies To: All Counsel

EXHIBIT A

Highlighted Version of First Amended Notice of Opposition

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

In the Matter of Application Serial No.: 86/061,950
Mark: UNCLE SAM’S MISGUIDED CHILDREN
Published for Opposition in the *Official Gazette*: January 28, 2014

UNCLE SAM, GMBH)	
)	
Opposer)	
)	
v.)	OPPOSITION NO. 91217562
)	
JENNIFER ZVITCO)	
)	
Applicant)	
)	

FIRST AMENDED NOTICE OF OPPOSITION

Uncle Sam, GmbH (“Opposer”) is a Gesellschaft mit beschränkter Haftung (limited liability company) duly organized and existing under the laws of Germany, having a principal place of business at Aachener Strasse 1053-1055, Cologne, 50858, Germany.

Jennifer Zvitco (“Applicant”) has applied to register the mark UNCLE SAM’S MISGUIDED CHILDREN for use in connection with “hats; hooded sweatshirts; long-sleeved shirts; short-sleeved and long-sleeved t-shirts; tank tops,” in Class 25 and “providing a web site featuring non-downloadable publications in the nature of news articles and podcasts in the field(s) of politics, popular culture, leadership, current events, social policy, general business topics and news analysis,” in Class 41.

Opposer believes it will be damaged by registration of the trademark UNCLE SAM’S MISGUIDED CHILDREN in connection with the goods listed in Class 25 as shown in application serial number 86/061,950 (the “Opposed Application”) filed in the U.S. Patent and Trademark Office on September 11, 2013, and Opposer hereby opposes registration of that trademark for all of the goods in Class 25.

The grounds for the opposition are as follows:

1. Opposer possesses broad, substantial and longstanding rights in the trademark UNCLE SAM, which it has protected, used and continues to use in connection with a wide range of clothing items.

2. Opposer owns all right, title and interest to U.S. trademark registration no. 1,189,422 for the mark UNCLE SAM (word mark), registered on February 9, 1982 for use in connection with “articles of clothing – namely, men’s, women’s and children’s shirts, pants and jackets,” in Class 25 (the “’422 registration”). Opposer most recently submitted a combined Affidavit of Continued Use and Application for Renewal, together with specimens demonstrating use in the U.S. of the Opposer’s UNCLE SAM mark on Opposer’s goods, on April 3, 2012. This Affidavit of Continued Use and Application for Renewal was accepted and acknowledged by the U.S. PTO on April 24, 2012.

3. Opposer also owns all right, title and interest to U.S. trademark registration no. 3,557,762, for the mark UNCLE SAM (word and design mark), registered on January 6, 2009 for use in connection with “clothing, namely, jackets, jeans, pants, pullovers, shirts, shorts, sweaters, beach wear, polo shirts, gym shorts, sweat pants, t-shirts, underwear, track suits, leotards, swimsuits, swim trunks, socks, footwear and headgear, namely, caps and hats,” in Class 25 (the “’762 Registration”).

4. Attached hereto for both registrations are print-outs of current information from the electronic database records of the U.S. PTO, showing the ’422 and ’762 registrations’ current status and title, pursuant to Trademark Rule 2.122(d); *see* Exhibit A.

5. Opposer’s ’422 Registration states a date of first use in commerce in the United States of January 1, 1900, which is 112 years earlier than the date of first use listed in the Opposed Application; Opposer thus has priority rights superior to any possessed by Applicant.

6. Opposer also possesses trademark rights in its UNCLE SAM mark in many other jurisdictions, including pending trademark applications and registrations in Europe, Australia, Asia and South America and the Middle East, for use in connection with goods similar to those claimed in its U.S. registrations, as shown in Exhibit B attached hereto.

7. As a result of its extensive use in the U.S. of the UNCLE SAM trademark, Opposer has built up valuable goodwill in that mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

8. On September 11, 2013, Applicant filed the Opposed Application claiming protection for “hats; hooded sweatshirts; long-sleeved shirts; short-sleeved and long-sleeved t-shirts; tank tops,” in Class 25, and “providing a web site featuring non-downloadable publications in the nature of news articles and podcasts in the field(s) of politics, popular culture, leadership, current events, social policy, general business topics and news analysis,” in Class 41, all with a claimed date of first use of July 9, 2012.

9. The Class 25 goods claimed in the Opposed Application are identical and/or closely related to the goods offered in connection with the Opposer’s UNCLE SAM trademark as shown in its U.S. registrations.

10. Applicant’s UNCLE SAM’S MISGUIDED CHILDREN mark so resembles Opposer’s UNCLE SAM mark as to be likely, when used in connection with Applicant’s claimed goods in Class 25, to cause confusion, to cause mistake and to deceive the public, members of whom are likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed, or sponsored by Opposer or associated with in some way with Opposer. Opposer, as owner of the ’422 and ’762 registrations, would therefore be injured by the granting to Applicant of a certificate of registration for Applicant’s mark, if that certificate of registration covered the goods listed in Class 25 of the Opposed Application.

11. Opposer, as owner of the ’422 and ’762 registrations, would be further injured by the granting of a certificate of registration to Applicant for the Class 25 goods listed in the Opposed Application because Applicant’s UNCLE SAM’S MISGUIDED CHILDREN mark, which is a close approximation of Opposer’s UNCLE SAM mark, when used in connection with Applicant’s applied-for goods in Class 25, would falsely suggest a connection between Applicant and Opposer, which has established itself as the source of goods in Class 25 sold under the UNCLE SAM mark, and which has granted no authorization to Applicant and which in fact has no connection with Applicant.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's trademark and requests that this opposition be sustained and said registration be denied.

Date: October 3, 2014

Respectfully submitted,

BALMAT LAW, PLLC
Co-counsel for Opposer

PLOEN LAW FIRM, PC
Co-counsel for Opposer

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has this day served true and correct copies of this First Amended Notice of Opposition, along with any exhibits thereto, upon the Applicant's counsel of record by mailing the same via First Class mail, postage paid, to:

Paul Ratcliffe
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and

Jacob M. Lebowitz
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3221 M Street NW
Washington, DC 20007

respectively.

Dated: October 3, 2014

SIGNED under the pains and penalties of perjury.

/Sean Ploen/
Sean Ploen