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

Proceeding	91222198
Party	Plaintiff TBWA Worldwide Inc.
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Date	07/21/2015
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application:

Serial No. : 86388952
Applicant : Megan McGuinness
Filed : September 9, 2014
Mark : DISRUPTIVE CHARM

Published in the *Official Gazette* of February 3, 2015

TBWA Worldwide Inc.,

Opposer,

v.

Megan McGuinness,

Applicant.

Opposition No. 91222198

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

**OPPOSER'S OPPOSITION TO APPLICANT'S
MOTION TO DISMISS UNDER FRCP 12(b)**

Applicant's motion to dismiss under FRCP 12(b) should be denied because Applicant's motion to dismiss does not challenge the sufficiency of Opposer's pleading, and, in any event, Opposer's notice of opposition meets the requisite pleading requirements by alleging standing and a valid ground to oppose.

BACKGROUND

On February 3, 2015, the subject application published for opposition purposes. On the same day, Opposer, TBWA Worldwide Inc., filed a request for a 90-day extension

of time to oppose until June 3, 2015, which was granted. On June 3, 2015, Opposer filed an opposition on the basis of likelihood of confusion with Opposer's registered trademark DISRUPTION.

In the notice of opposition, Opposer argued, *inter alia*, priority of rights and that Applicant's DISRUPTIVE CHARM mark is confusingly similar to TBWA's registered DISRUPTION trademark in terms of appearance, sound, and commercial meaning. Opposer pointed out that Applicant seeks registration of its mark for the identical goods and argued that Applicant's proposed use of a confusingly similar mark for the identical goods was likely to cause consumers mistakenly to believe that such goods are somehow related to Opposer or to the DISRUPTION trademark, or that such goods originate from or are sponsored or approved by Opposer.

Instead of filing an answer, Applicant filed a motion to dismiss under FRCP 12(b). See docket entry #4. The grounds for Applicant's motion to dismiss are that (1) Opposer itself has not filed an amendment to allege use, (2) none of the services in Applicant's application are listed in Opposer's registrations, and (3) Opposer's mark is a noun but Applicant's mark is an adjective. As described in detail below, however, none of these arguments supports a motion to dismiss (because they go to the merits of Opposer's claim), and, in any event, under the motion to dismiss standard, Opposer's notice of opposition includes the required allegations.

ARGUMENT

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014). In order

to withstand such a motion, a notice of opposition need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. TBMP § 503.

Opposer has more than met the above standard. With respect to standing, a notice of opposition must include a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding). See TBMP §§ 303.03, 309.03(b), and 503. Here, Opposer has alleged that it has standing to maintain the opposition because it would be injured by registration of the subject mark. See, e.g.:

10. Applicant's proposed use of DISRUPTIVE CHARM in connection with a series of books and business education services thus is likely to cause consumers mistakenly to believe that such goods and services are somehow related to TBWA or to the DISRUPTION trademark, or that such goods and services originate from or are sponsored or approved by TBWA. This confusion and mistake will cause injury to TBWA.

11. If Applicant is awarded a registration for DISRUPTIVE CHARM in connection with a series of books and business education services as shown in Serial No. 86388952, Applicant would be entitled to the presumptions flowing from such a registration, all to the injury of TBWA.

With respect to a valid ground for denying the registration, in its opposition, Opposer claimed priority and likelihood of confusion under Section 2(d). See, e.g.:

5. TBWA has used the DISRUPTION trademark in interstate commerce in connection since at least as early as December 1991, which is well before the filing date of the subject application.

7. Applicant's DISRUPTIVE CHARM mark is confusingly similar to TBWA's registered DISRUPTION trademark in terms of appearance, sound, and commercial meaning.

10. Applicant's proposed use of DISRUPTIVE CHARM in connection with a series of books and business education services thus is likely to cause consumers mistakenly to believe that such goods and services are somehow related to TBWA or to the DISRUPTION trademark, or that such goods and services originate from or are sponsored or approved by TBWA.

Likelihood of confusion is a valid ground for a notice of opposition. TBMP § 309.03(c).

None of the arguments listed in Applicant's motion to dismiss relate to the motion to dismiss standard discussed above. Instead, Applicant's arguments relate to the merits of the opposition itself, and, as such, are insufficient:

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.

TBMP § 503. For example, Applicant's claim that the marks are not confusingly similar because one is a noun and one is an adjective goes to the merits of the case, not pleading requirements (standing and valid grounds).

CONCLUSION

Because Applicant's motion to dismiss does not challenge the sufficiency of Opposer's pleading, and because Opposer's notice of opposition asserts standing and valid grounds to oppose, Applicant's motion to dismiss under FRCP 12(b) should be denied.

Respectfully submitted,

KENYON & KENYON LLP

Date: July 21, 2015

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Certificate of Service

I hereby certify that the required number of copies of the foregoing *Opposer's Opposition to Applicant's Motion to Dismiss*, including all exhibits, were served as shown below on Applicant's correspondent of record:

By U.S. Mail (Postage Prepaid)

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