UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: November 3, 2015

Opposition No. 91222198

TBWA Worldwide Inc.

v.

Megan Mcguinness

By the Trademark Trial and Appeal Board:

This case comes up on Applicant's motion to dismiss the notice of opposition under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. The motion is contested.

On September 9, 2014, Megan Mcguinness, an individual acting pro se, filed application Serial No. 86388952 alleging a bona fide intent to use to use the mark DISRUPTIVE CHARM with:

> a series of books and written articles in the field of business leadership, professional development, and business success
>
> education services, namely, providing live and online workshops, classes, seminars, lectures, and conferences in the field of business leadership, professional development, and business success

TBWA Worldwide Inc. filed a notice of opposition which pleads priority of use and likelihood of confusion with its mark DISRUPTION, the subject of common law

use, pleaded Registration No. 3138215, and pending application Serial Nos. 86564892 and 86355049 for the marks and goods shown below:

Registration No. 3138215 Issued March 8, 2005	Advertising and marketing services; business marketing consulting services; brand development and brand consulting services; market research services; advertising agency services; public relations services; and interactive marketing and advertising services Workshops, forums, seminars and training in the field of advertising and marketing communications
Application Serial No. 86564892 Sec. 1(b) basis	A series of books and written articles in the field of advertising and marketing
Application Serial No. 86355049 Sec. 1(b) basis	Digital advertising services; advertising services, namely, promoting and marketing the goods and services of others through all public communication means; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; business consulting and information services; business organization consulting; business management consulting; business consulting services, namely, providing assistance in development of business strategies and creative ideation Website design and development for others; website design consultancy

In lieu of filing an answer, Respondent moved to dismiss the petition for failure to state a claim.

MOTION TO DISMISS IS DENIED

Upon review, it appears that, while titled a "motion to dismiss" Applicant's filing is more in the nature of a motion for summary judgment which argues entry of judgment for Applicant on the merits of opposer's claims. More specifically, while the filing seeks "rejection" of the notice of opposition, Applicant does not provide

arguments that the claim in the notice of opposition is legally insufficient. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §503 (October 2015). Applicant is advised that arguments on the merits of the case are not timely outside of a motion for summary judgment, when the moving party may present evidence in support of its position, or trial. Absent certain exceptions not applicable here, a motion for summary judgment may not be filed before the parties have participated in the required discovery conference and exchanged initial disclosures. See Trademark Rule 2.127. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they ae represented by counsel. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

To the extent that Applicant did intend to argue that the notice of opposition should be dismissed as legally insufficient, the Board notes that in order to withstand a motion to dismiss, Opposer need only allege such facts which, if proved, would establish that Opposer is entitled to the relief sought; that is, (1) Opposer has standing to bring the proceeding, and (2) a valid statutory ground exists for opposing registration. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Here, Opposer pleads ownership of Registration No. 3138215 as well as prior common law use. This is sufficient to plead Opposer's standing. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The notice of opposition also pleads that Applicant's DISRUPTIVE

CHARM mark is confusingly similar to Opposer's registered DISRUPTION trademark in terms of appearance, sound, and commercial meaning; that Applicant's addition of the word CHARM is not sufficient to distinguish the parties' marks; that Applicant seeks registration of her mark for the identical goods, namely, a series of books, and for closely similar services, namely, educational services in the field of business success; and that Applicant's proposed use of DISRUPTIVE CHARM in connection with a series of books and business education services thus is likely to cause confusion. No more is necessary to plead the likelihood of confusion claim. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Applicant's motion to dismiss is DENIED.

LEGAL REPRESENTATION STRONGLY ENCOURAGED

While Patent and Trademark Rule 11.14 permits any person to represent herself, it is strongly advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

If Applicant continues to represent herself, she is recommended to become be familiar with Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and which are available at the USPTO's trademarks page: http://www.uspto.gov/main/trademarks.htm. The Board's main webpage (http://www.uspto.gov/web/offices/dcom/ttab/) includes information on amendments

to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

APPLICANT'S TIME TO FILE HER ANSWER IS RESET

Applicant is ordered to file an answer which complies with Rule 8(b) of the Federal Rules of Civil Procedure, which is made applicable this proceeding by Trademark Rule 2.116(a), within THIRTY DAYS of mailing date of this order.

The notice of opposition filed by Opposer herein consists of 14 paragraphs setting forth the basis of Opposer's claim of damage. In accordance with Fed. R. Civ. P. 8(b), it is incumbent on Applicant to answer the notice of opposition by specifically admitting or denying the allegations contained in each paragraph. If Applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, she should so state and this will have the effect of a denial.

If Applicant requires more time to prepare her answer, Applicant is encouraged to call counsel for Opposer and to request consent to an extension, and then to file the consented motion for extension with the Board for approval. The parties are encouraged to cooperate throughout the Board proceeding, and the Board generally grants consented motions which reflect such cooperation. In addition, ESTTA consent motions located on the TTAB webpage are automatically granted. Please note that the consent of the other party must be explicit. For proving good cause for extension in the absence of consent, please see TBMP 509.

REQUIREMENTS FOR PROOF OF SERVICE

The Board notes that Applicant's motion included a certificate of service which, instead of stating the date that the copy was mailed to Opposer, states "insert date of mailing." While Applicant plainly attempted to comply with the Board's service rule, Applicant did not actually comply, and must carefully provide all required information for any future proof of service to be accepted. The Board may decline to consider any motion, paper or communication filed herein which does not include the required proof of service. Trademark Rule 2.119.

PROCEEDINGS ARE RESUMED

As set forth above, Applicant's motion to dismiss the notice of opposition for failure to state a claim is DENEID, and Applicant is ordered to file her answer to the notice of opposition within THIRTY DAYS of the mailing date of this order.

Proceedings herein are resumed, and dates are reset below.

Deadline for Discovery Conference	**12/30/2015**
Discovery Opens	**12/30/2015**
Initial Disclosures Due	**1/29/2016**
Expert Disclosures Due	**5/28/2016**
Discovery Closes	**6/27/2016**
Plaintiff's Pretrial Disclosures	**8/11/2016**
Plaintiff's 30-day Trial Period Ends	**9/25/2016**
Defendant's Pretrial Disclosures	**10/10/2016**
Defendant's 30-day Trial Period Ends	**11/24/2016**
Plaintiff's Rebuttal Disclosures	**12/9/2016**
Plaintiff's 15-day Rebuttal Period Ends	**1/8/2017**

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.l25.

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.l29.