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

Proceeding	91226028
Party	Plaintiff Wise F&I, LLC, Financial Gap Administrator LLC, Vehicle Service Administrator LLC, Administration America LLC
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Administration America LLC,)	
Financial Gap Administrator LLC,)	
Vehicle Service Administrator LLC,)	
Wise F&I, LLC,)	
)	Opp. No. 91226028 ¹
Opposers,)	
)	Directed to U.S. Ser. No. 86/668,531
vs.)	
)	Mark: MILEWISE
Allstate Insurance Company)	
)	
Applicant.)	

OPPOSERS’ BRIEF IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS

Allstate’s Motion to Dismiss Opposers’ properly pled Notice of Opposition should be denied. Allstate’s Motion is styled as a Rule 12(b)(6) motion, but Allstate improperly argues the adequacy of the evidence, not the adequacy of the allegations in the Notice of Opposition. As is apparent by the substance of Allstate’s Motion, Allstate received fair notice of Opposers’ claim and the grounds upon which the claim rests. Further, the core of Allstate’s argument – whether Opposers possess a family of marks – is a question of fact based on the ultimate evidence. Allstate acknowledges this in its own brief. *See* Allstate’s Motion to Dismiss, at *p.3* (“[t]he existence of a family of marks is a question of fact.”). An evidentiary determination regarding Opposers’ family of marks cannot be decided on a Rule 12(b)(6) motion to dismiss. Opposers’ Notice of Opposition contains sufficient factual matter, which must be accepted as true, to state a plausible likelihood of confusion claim. Allstate’s Motion should be denied.

¹ The parties are involved in a related proceeding. TTAB Opp. No. 91226029. Allstate has moved to dismiss that proceeding, and Opposers are contesting the motion for the same reasons provided in this brief.

I. LEGAL STANDARD

A motion to dismiss for failure to state a claim concerns only one issue: the legal sufficiency of the pleaded claims. TMBP § 503.02. An opposer “need only allege sufficient factual matter that, if proved, would allow the Board to conclude, or to draw reasonable inference, that (1) [opposer] has standing to maintain the proceeding, and (2) a valid ground exists for opposing ... the mark.” *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1028-29 (TTAB 2015). The notice of opposition must only “contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (U.S. 2007). So long as the opposer sets forth a “short and plain statement of the claim showing that the pleader is entitled to relief and give[s] the defendant fair notice of what the ... claim is and the grounds upon which it rests,” the opposer’s burden is met under the Federal Rules of Civil Procedure. *Id.* All of opposers’ well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to opposers. *See Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

“[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.” TMBP § 503.02. “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.” *Id.* For this reason, a motion to dismiss for failure to state a claim “is viewed with disfavor and is rarely granted.” (internal quotations omitted). *Phonometrics, Inc. v. Hospitality Franchise Sys.*, 53 USPQ2d 1762, 1764 (Fed. Cir. 2000).

II. OPPOSERS' NOTICE OF OPPOSITION SUFFICIENTLY ALLEGES STANDING AND LIKELIHOOD OF CONFUSION BETWEEN THE SUBJECT MARK AND THE WISE FAMILY OF MARKS

Opposers' Notice of Opposition sets forth sufficient factual allegations, accepted as true, to demonstrate standing and state a plausible claim of likelihood of confusion between Allstate's MILEWISE mark and Opposers' WISE Family of Marks. *Notice of Opposition*, at ¶¶ 1-10. Allstate appears to understand Opposers' claim, but disagrees with it. Allstate's Motion must fail because Allstate conflates pleading requirements with whether Allstate believes Opposers have established a prima facie case. Allstate also misstates the law regarding the "Family of Marks" doctrine by arguing that a family of marks may only exist if all the marks in the family are owned by a single entity, and also by arguing that failure to establish a family of marks results in dismissal of a case.

A. Opposers' Notice of Opposition Sufficiently Alleges Standing and Likelihood of Confusion.

Opposers' Notice of Opposition alleges sufficient facts that, when accepted as true, would allow the Board to conclude that Opposers have standing to maintain the proceeding and that a valid ground exists for opposing the mark.

1. Standing is Properly Alleged.

In order to sufficiently allege standing, Opposers must demonstrate a "real interest" in the proceeding beyond that of a "mere intermeddler," and a "reasonable basis" for their belief of damage. *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); 15 U.S.C. §1064. Opposers allege: (1) prior common law rights in, and ownership of registrations for, the WISE Family of Marks; (2) Applicant's mark is likely to be confused with Opposers' marks, based on similarities in the respective marks, goods and services; and (3) damage as a result of such

likelihood of confusion. Opposers, therefore, have sufficiently alleged standing. *Nike*, 116 USPQ2d at 1029.

2. Likelihood of Confusion is Properly Alleged.

To allege a valid ground of opposition under Section 2(d), an opposer “need only allege it has valid proprietary rights that are prior to those of Applicant ... and that Applicant’s mark so resembles Opposer’s marks to be likely to cause confusion.” *Nike*, 116 USPQ2d at 1030.

The Notice of Opposition alleges that Administration America LLC, Financial Gap Administrator LLC, and Vehicle Service Administrator LLC are each subsidiaries of Wise F&I, LLC, with all four entities sharing an address at 1670 Fenpark Drive, Fenton, MO 63026. *Notice of Opposition*, at ¶¶ 1-5. The Notice of Opposition states that Opposers own a family of WISE marks wherein the term WISE is the family indicator. *Id.* at ¶ 7. These marks include WISE F&I, ETCHWISE, ID THEFTWISE, TIREWISE, THEFTWISE, GAPWISE, WISECARE, ONWISE, WISE TVP, and KEYWISE (collectively, the “WISE Family of Marks”). *Id.* The Notice of Opposition states that Opposers began using and have continuously used in interstate commerce the WISE Family of Marks, prior to any alleged priority date for Applicant’s mark. *Id.* The Notice of Opposition further states that the WISE Family of Marks are used in connection with automotive finance and insurance products and services, and other products and services. *Id.* The Notice of Opposition states that as a result of substantial and extensive sales and marketing of such products and services under the WISE Family of Marks, the marks have become well known and famous to consumers. *Id.* The Notice of Opposition alleges common law rights in the WISE Family of Marks and cites registrations for the marks (with TSDR reports attached). *Id.* at ¶ 8. The Notice of Opposition further alleges that Allstate’s mark MILEWISE, which includes the common characteristic of the WISE Family of Marks—the word “WISE”—

so resembles Opposers' WISE Family of Marks as to be likely to cause confusion or to cause mistake or to deceive, thus causing damage to Opposers. *Id.* at ¶ 10. Thus, Opposers' allegations regarding likelihood of confusion and the WISE Family of Marks are not, as Allstate contends, "conclusory."

Furthermore, Allstate already acknowledges that whether Opposers possess a family of marks is a question of *fact* based on the evidence of use and other factors. *See* Allstate's Motion to Dismiss, at p.3 ("[t]he existence of a family of marks is a question of fact."). An evidentiary determination such as this cannot be decided on a Rule 12(b)(6) motion to dismiss, which is only concerned with the legal sufficiency of the pleaded claims. Opposers have plead sufficient facts, accepted as true, to state a plausible claim for relief and to give fair notice of Opposers' claim and the grounds upon which their claim rests. Allstate cannot reasonably state that it does not have fair notice of what Opposers' claim is and the grounds upon which the claim rests. The merits are for trial. Allstate's motion to dismiss must be denied.

B. Allstate's Motion Also Rests on a Mischaracterization of the Law: A Family of Marks Need Not Be Owned by One Single Entity, The Family Must Just Share A Common Origin.

Allstate's arguments regarding whether Opposers can "establish" a family of marks – which are improper at this stage – also lack merit. Despite Allstate's repeated arguments otherwise, the Family of Marks doctrine does not require the marks all be owned by one entity. Rather, the marks must share *a common origin*, as the Federal Circuit, district courts, and TTAB have repeatedly stated: "[a] family of marks [] arises if the purchasing public recognizes that the common characteristic is indicative of *a common origin of the goods*." (emphasis added). *Han Beauty, Inc. v. Alberto-Culver Co.*, 57 USPQ 2d 1557, 1559 (Fed. Cir. 2001); "[t]he key to a finding that a family of marks exists is a recognition among the purchasing public that the family

‘surname’—i.e., the element common to all the marks—is indicative of a common origin of the goods.” (emphasis added). *Victoria’s Secret Stores Brand Management, Inc. v. Sexy Hair Concepts, LLC*, 2009 WL 959775 at *4 (S.D. N.Y. April 8, 2009). Even the case Allstate artfully cites for its errant proposition acknowledges this principle: “[t]here must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.” (emphasis added). *J&J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). “Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the *origin of the family*.” (emphasis added). *Id.* at 1463. “It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of *common origin*.” (emphasis added). *Id.*

Consumer association with the “source” or “origin” of goods – as opposed to a single legal entity – is not just a concept unique to the Family of Marks doctrine, but actually arises out trademark law’s core principle: “preventing others from copying a source-identifying mark [to] reduce the customer’s costs of shopping and making purchasing decisions and [assuring] a potential customer that [the goods are] made by the same producer as other similarly marked items” she liked in the past. (internal quotations and citations omitted). *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 163-64 (1995). This is why courts have held that the concept of “common origin” encompasses more than “legal entity.” See *In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987), *rev’d on other grounds*, 8 USPQ2d 1365 (Fed. Cir. 1988) (“we are required to determine whether Wella A.G. and Wella U.S. are the same source or different sources. If we find that the two entities are the same source, there could, of course, be no confusion as to source); TMEP 1201.07. For example, in the *ex parte* context, the USPTO

allows registration of a mark owned by one entity, despite the existence of a similar registered mark owned by a separate entity, when the entities are related and there is “unity of control” over use of the mark.² *Id.* The rationale is that, in the minds of consumers, such related companies constitute a “single source” despite the fact that they are technically different legal entities. *Id.* Such rationale applies with equal force to establishing a family of marks.

Lastly, Allstate’s motion also rests on the mistaken assumption that to the extent the Board find that an opposer does not have a family of marks, then the case should be dismissed. This assumption is incorrect. If the Board determines that an opposer has not established a family of marks, then the likelihood of confusion analysis is based on the analysis of the individual marks. *See e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1657 (TTAB 2010). Accordingly, Allstate has no grounds to obtain dismissal of this action.

² “Unity of control” can be established by showing, for example, that the companies are subsidiaries. TMEP 1201.07(b)(i). The Notice of Opposition alleges that Administration America LLC, Financial Gap Administrator LLC, and Vehicle Service Administrator LLC are each subsidiaries of Wise F&I, LLC. *Notice of Opposition*, at ¶5.

III. CONCLUSION

Opposers' Notice of Opposition contains sufficient factual matter, accepted as true, to state a claim to relief and states a claim for relief that is plausible. No more is required. Because Opposers have properly pled all the necessary elements of a likelihood of confusion claim, Allstate's motion should be denied. In the alternative, Opposers request leave to file an Amended Notice of Opposition.

Dated: May 26, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent via e-mail by stipulation on May 26, 2016, to the following:

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