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

Proceeding	91226028
Party	Defendant Allstate Insurance Company
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Administration America LLC,)	
Financial Gap Administrator LLC,)	
Vehicle Service Administrator LLC,)	Opp. No. 91226028
Wise F&I, LLC)	
)	Directed to U.S. Ser. No. 86/668,531
Opposer,)	
)	Mark: MILEWISE
vs.)	
)	
Allstate Insurance Company)	
)	
Applicant.)	

REPLY IN SUPPORT OF MOTION TO DISMISS

As Opposers acknowledge in their response, a motion to dismiss is to be determined on the adequacy of the allegations in the Notice of Opposition. However, they have identified no allegations in the Notice of Opposition that sufficiently allege the facts necessary to state the only claim identified in the Notice of Opposition – likelihood of confusion of Applicant’s mark with Opposers’ alleged “WISE Family of Marks.” Accordingly, Applicant respectfully requests that the Opposition be dismissed for failure to state a claim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

I. MOTION TO DISMISS STANDARD

Opposers contend that they need only allege factual matter that would allow the Board to conclude that (1) the opposer has standing and (2) a valid ground exists for opposing the mark. Response at p. 2 citing *Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit Cityplace*, 116 U.S.P.Q.2d 1025, 1028-1029 (TTAB 2015). However, the same case recognizes that Opposers must allege “more than ‘[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.’” *Id.* at 1029. It also states that an Opposer must allege that “it has

valid proprietary rights that are prior to those of Applicant...and that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion." *Id.* at 1030. It is on those requirements that Opposers' allegations are deficient.

II. FAMILY OF MARKS

To properly allege a claim that Applicant's mark is likely to cause confusion with the alleged "WISE Family of Marks," Opposers must allege facts sufficient to plead a plausible claim of valid proprietary rights in that family of marks. Although Opposers dispute that a family of marks must be owned by a single entity (as stated in *McDonald's Corp. v. McBagel's Inc.*, 1 U.S.P.Q.2d 1761, 1763 (S.D.N.Y. 1986)), they admit that ownership of a family of marks requires at least that the common characteristic of the alleged family of marks must be "indicative of a common origin of the goods." Response at 5-7. The Notice of Opposition does not include any such allegation.

The Notice of Opposition includes the bare conclusion that the identified marks constitute a family using WISE as the family indicator (Notice at ¶ 7), an allegation that AA, FGA, and VSA are subsidiaries of Wise F&I (*Id.* at ¶ 6), and an identification of the marks allegedly owned by the Opposers collectively (*Id.* at ¶¶ 7-8). The existence of a related company relationship is not, in itself, a basis for finding that any product emanating from any of the related companies emanates from the same source – there must also be unity of control over the use of the trademarks. *In re Wella A.G.*, 5 U.S.P.Q.2d 1359, 1361 (TTAB 1987), *rev'd on other grounds*, 8 U.S.P.Q.2d 1365 (Fed. Cir. 1988). Beyond the bare conclusion that the identified marks constitute a family, there is no allegation that the marks connote a single source or that there is a unity of control over the use of the trademarks. The Opposer is not entitled to a presumption that the relationship among the different entities owning different marks means that there is unified control over the use of those marks. It is obliged to plead and prove unity of control.

While Opposers cite to a number of cases in support of their contention that a family of marks may be owned by more than one entity, none of the cases cited involve an opposition, cancellation, or infringement proceeding in which the alleged family of marks at issue was owned by more than one entity. Response at 5-6. We are similarly unaware of any precedent involving such a proceeding.

III. LIKELIHOOD OF CONFUSION

The only allegation of confusion made in the Notice of Opposition is that “Applicant’s mark MILEWISE so resembles Opposers’ WISE Family of Marks as to be likely, when used in connection with the applied-for services, to cause confusion or to cause mistake or to deceive, thus causing damage to Opposers.” Notice of Opposition at p. 3. Accordingly, the only allegation of likelihood of confusion is between Applicant’s mark and the alleged “WISE Family of Marks.”

In their Response brief, Opposers argue that, even if they have failed to plead ownership in a family of marks, they should be allowed to proceed with the Opposition on the basis that the Applicant’s use of the MILEWISE mark so resembles each of Opposers’ individual marks as to be likely to cause confusion. There is no allegation, however, that the MILEWISE mark so resembles any of the individual marks as to be likely to cause confusion or cause mistake. Thus, the Notice of Opposition fails to allege that Applicant’s mark so resembles Opposers’ individual marks as to be likely to cause confusion as required by *Nike*. See *Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit Cityplace*, 116 U.S.P.Q.2d 1025, 1028-1030 (TTAB 2015). The basis for the likelihood of confusion claim must be clearly alleged. See *America Online, Inc. v. Freehaven Investments, Ltd.*, 2001 WL 1547929 at * 1, 3 (TTAB November 26, 2001) (non-precedential) (granting plaintiff leave to replead to make clear whether its claim was based on a family of marks, use of individual marks, or both).

IV. CONCLUSION

Opposers have failed to meet the *Twombly* standard for asserting their claim. While the Board must accept the pleaded facts as true for purposes of Applicant's motion, Opposer is still obliged to allege the facts necessary to state a claim. Opposers have not alleged that the marks listed in the Notice of Opposition indicate a common origin of goods or that those marks individually are confusingly similar to the Applicant's mark. Accordingly, Allstate respectfully requests that the Board grant its motion to dismiss the Opposition under Rule 12(b)(6).

Respectfully submitted,

Dated: June 10, 2016_____

By: /Julianne M. Hartzell/_____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent, by agreement of the parties, via email on June 10, 2016, to the following:

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