

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

JK

Mailed: August 8, 2016

Opposition No. 91226028

Wise F&I, LLC,
Financial Gap Administrator LLC,
Vehicle Service Administrator LLC,
Administration America LLC

v.

Allstate Insurance Company

By the Board:

On June 16, 2015, Applicant filed application Serial No. 86668531, based on an intent to use the mark in commerce pursuant to Trademark Act Section 1(b), to register the mark MILEWISE (standard characters) on the Principal Register for the following International Class 36 services:

insurance services, namely, writing and underwriting of property and casualty insurance and providing ancillary services thereto, namely, administration and claims adjustment.

Opposers filed a notice of opposition alleging priority and likelihood of confusion pursuant to Trademark Act Section 2(d). Opposers attached to their pleading the Trademark Status and Document Retrieval (TSDR) system printouts for eight Principal Register registrations of which they allege ownership, summarized for purposes of this order as follows:

- 1) Registration No. 2363547, registered July 4, 2000 for the mark GAPWISE, for services in International Class 36;
- 2) Registration No. 2745080, registered July 29, 2003 for the mark ETCHWISE, for services in International Class 36;
- 3) Registration No. 2800305, registered December 30, 2003 for the mark TIREWISE, for services in International Class 36;
- 4) Registration No. 3086022, registered April 25, 2006 for the mark THEFTWISE, for services in International Class 36;
- 5) Registration No. 3611703, registered April 28, 2009 for the mark ID THEFTWISE, for services in International Classes 36 and 45;
- 6) Registration No. 4249179, registered November 27, 2012 for the mark WISE F&I, for services in International Classes 36, 41 and 45;
- 7) Registration No. 4372307, registered July 23, 2013 for the mark WISECARE, for services in International Class 36;
- 8) Registration No. 4778223, registered July 21, 2015 for the mark ONWISE, for services in International Class 36.¹

Opposers also allege pending application Serial No. 86625442 to register the mark KEYWISE for services in International Class 36.

In lieu of filing an answer, Applicant filed a motion to dismiss the notice of opposition for failure to state a claim upon which relief may be granted pursuant to Fed. R. Civ. P. 12(b)(6).²

¹ 1 TTABVUE.

² Fed. R. Civ. P. 12(b)(6) is applicable to Board *inter partes* proceedings by operation of Trademark Rule 2.116(a).

The Board notes the parties' June 8, 2016 stipulation to service by email pursuant to Trademark Rule 2.119(b)(6). (In view thereof, the five-day period allowed under Trademark Rule 2.119(c) will not apply. *McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013). The parties are required to assure that they have, and maintain, valid and updated email addresses for each other.)

Analysis

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 the allegations set forth in a pleading. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). To survive a motion to dismiss under Fed. R. Civ. P. 12(b)(6) filed in a Board *inter partes* proceeding, a plaintiff need only allege sufficient factual content that, if proved, would establish that 1) the plaintiff has standing to maintain the proceeding, and 2) a valid ground exists for opposing or cancelling the mark. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012), citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). TBMP § 503.02 (2016). Specifically, 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*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

The Board has considered the parties' briefs on the contested motion(s), but does not repeat or discuss all of their arguments and submissions, and does not

address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d at 2019.

Standing

The Board must first address standing. Standing is a threshold issue that must be alleged in every *inter partes* proceeding. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To withstand a motion to dismiss, a plaintiff must sufficiently set forth allegations which, if proven, establish that it has a “real interest,” *i.e.*, a direct and personal stake, in the outcome of the proceeding, as well as a “reasonable basis” for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*. The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining whether a belief in damage has a reasonable basis in fact and reflects a real interest in the case. *Ritchie v. Simpson*, *supra*; *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

Opposers allege that Administration America LLC, Financial Gap Administrator LLC and Vehicle Service Administrator LLC are subsidiaries of Wise F&I.³ Opposers a claim of likelihood of confusion that is not wholly without merit based on current ownership of valid and subsisting registrations and prior use of a confusingly similar mark. Such allegations are sufficient to plead standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir.

³ 1 TTABVUE 8.

2000); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012).

Accordingly, Opposers sufficiently plead their standing to bring this proceeding.

Grounds

To state a claim of priority and likelihood of confusion under Section 2(d), a plaintiff must sufficiently allege, in addition to standing, that 1) it has registered or previously used a mark, and 2) the contemporaneous use of the parties' respective marks on or in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

In ¶ 7, Opposers allege that, “[P]rior to any alleged priority date for the mark MILEWISE, Opposers began using, and have continuously used in interstate commerce, a family of WISE marks wherein the term WISE is the family indicator, including WISE F&I, ETCHWISE, ID THEFTWISE, TIREWISE, THEFTWISE, GAPWISE, WISECARE, ONWISE, WISETVP, and KEYWISE (collectively, the ‘WISE Family of Marks’), in connection with automotive finance and insurance products and services.”⁴ In ¶ 8, Opposers further allege that, “[I]n addition to their common law rights in the Wise Family of Marks,” Opposers own what it then sets

⁴ 1 TTABVUE 8.

forth as a list of Opposers' eight pleaded registered marks, and its pending applied-for mark.

These allegations, read together with the notice of opposition as a whole, are sufficient to plead priority in a family of marks under the family of marks doctrine, and are factually sufficient to place Applicant on notice of the basis for reliance on the doctrine. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1655 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007).⁵

In ¶ 10, Opposers allege that, [A]pplicant'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."⁶

These allegations, read together with the notice of opposition as a whole, are sufficient to plead a likelihood of confusion. The allegations place Applicant on

⁵ Applicant's arguments relevant to whether a family of marks does in fact exist, including whether the pleaded marks are owned by a particular owner (6 TTABVUE 5) and whether there is unity of control (13 TTABVUE 3), are matters for trial relevant to the factual issue of likelihood of confusion. *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004), citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973) (one factor is the variety of goods on which a mark is or is not used, e.g. house mark, 'family' mark, product mark).

⁶ 1 TTABVUE 9.

sufficient notice of the basis for the claim for relief. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007).

Based on these findings, the notice of opposition states a claim upon which relief can be granted pursuant to Trademark Act Section 2(d). Applicant's motion to dismiss the notice of opposition for failure to state a claim under Fed. R. Civ. P. 12(b)(6) is denied.

Schedule

Proceedings are resumed. Applicant is allowed until thirty days from the mailing date of this order to file its answer to the notice of opposition. Conference, disclosure, discovery and trial dates are reset as follows:

Deadline for Required Discovery Conference	10/11/2016
Discovery Opens	10/11/2016
Initial Disclosures Due	11/10/2016
Expert Disclosures Due	3/10/2017
Discovery Closes	4/9/2017
Plaintiff's Pretrial Disclosures	5/24/2017
Plaintiff's 30-day Trial Period Ends	7/8/2017
Defendant's Pretrial Disclosures	7/23/2017
Defendant's 30-day Trial Period Ends	9/6/2017
Plaintiff's Rebuttal Disclosures	9/21/2017
Plaintiff's 15-day Rebuttal Period Ends	10/21/2017

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 2.125. 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 2.129.