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

Proceeding	92048699
Party	Plaintiff Lester H.Schweiss
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration No.: **3,157,991**

For the mark: **FAMILY WATCHDOG**

Registration Date: **October 17, 2006**

Lester H. Schweiss (a/k/a Chip Schweiss)
Petitioner,

v.

Cancellation No.: 92048699

Family Watchdog, LLC
Registrant.

PETITIONER'S BRIEF IN RESPONSE TO REGISTRANT'S
MOTION TO DISMISS

INTRODUCTION

On January 7, 2008, Petitioner Lester H. Schweiss ("Petitioner") filed its Petition to Cancel Registrant's U.S. Registration No. 3,157,991 for FAMILY WATCHDOG, on the basis of (1) Petitioner's prior use of FAMILY WATCHDOG and FAMILYWATCHDOG.COM and a likelihood of confusion with Registrant's registered mark, and (2) Petitioner's prior use of FAMILY WATCHDOG and FAMILYWATCHDOG.COM and Registrant's fraud on the Trademark Office in obtaining its registration. On February 15, 2008, Registrant filed its Motion to Dismiss for failure to state a claim upon which relief may be granted. For the reasons set forth below, Petitioner respectfully asserts that its Petition to Cancel meets all of the statutory requirements and requests that Registrant's Motion to Dismiss be denied.

ARGUMENT

I. Registrant's Motion To Dismiss Should Be Denied Because Petitioner Has Properly Alleged Facts Showing Standing and Grounds to Cancel Registrant's Registration.

A motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of the cancellation petition. *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1218 (TTAB 1990). In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the petitioner is entitled to the relief sought, that is, that (1) the petitioner has standing to maintain the proceeding, and (2) in the case of a cancellation proceeding, a valid ground exists for cancelling the subject registration. *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 U.S.P.Q.2d 1538, 1539 (TTAB 2000). Whether a petitioner can actually prove its allegations is a matter to be determined not upon a motion to dismiss, but rather at a final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. *See Caron Corporation v. Helena Rubinstein, Inc.*, 193 U.S.P.Q. 113, 115 (TTAB 1976).

For purposes of determining a motion to dismiss for failure to state a claim upon which relief may be granted, all of the petitioner's well-pleaded allegations must be accepted as true, and the petition must be construed in the light most favorable to the petitioner. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1999). Dismissal for insufficiency is appropriate only if it appears certain that the petitioner is entitled to no relief under any set of facts that could be proved in support of its claim. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998). It is the duty of the Board to examine the petition in its entirety, construing the allegations therein liberally, to determine whether it contains any allegations which, if proved, would entitle the petitioner to the relief sought. *Cineplex Odeon*

Corp. v. Fred Wehrenberg Circuit of Theatres Inc., 56 U.S.P.Q.2d 1538, 1539 (TTAB 2000).

A. Petitioner has Properly Alleged Facts Establishing that Petitioner has Standing to Maintain the Cancellation Proceeding.

Any person who believes he will be damaged by the continued registration of a mark has standing to file a petition to cancel. 15 U.S.C. § 1064. At the pleading stage, all that is required is that a petitioner allege facts sufficient to show a “real interest” in the proceeding and a reasonable basis for its belief of damage. *Ritchie v. Sampson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1025 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q.2d 185, 189 (C.C.P.A. 1982). There is no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in a cancellation proceeding. TBMP § 309.03(b) *citing* TBMP § 303.03. A real interest in the proceeding and a reasonable belief of damage may be found where a petitioner pleads (and later proves) a claim of likelihood of confusion that is not wholly without merit. TBMP § 309.03(b) *citing Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A 1982).

In this case, there is no question that Petitioner has alleged facts showing a real interest in the proceeding and a reasonable basis for his belief that he will be damaged by the continued registration of Registrant’s mark. In his Petition to Cancel, Petitioner has alleged that it adopted the mark FAMILY WATCHDOG for use in connection with the offering of products and services related to home computer, computer network, and internet safety and security, with an emphasis on keeping children and families safe while online.¹ (Petition to Cancel, ¶ 5).

¹On January 16, 2008, Petitioner filed an application for FAMILYWATCHDOG.COM (Serial No. 77/373487), alleging a first use date of February 2005 in connection with “providing an interactive website featuring information in the field of computer, computer network, and internet safety and security; Computer consultation in the field of computer, computer network, and internet safety and security.”

Petitioner has alleged that it used its marks FAMILY WATCHDOG and FAMILYWATCHDOG.COM on marketing and informational materials that were distributed to the public, as well as on a live website accessible to the public. (Petition to Cancel, ¶¶ 7-8). Petitioner has alleged a claim of likelihood of confusion that is not wholly without merit. (Petition to Cancel, ¶ 10). Furthermore, although not required, Petitioner has alleged actual damages in that Registrant is currently taking affirmative steps to shut down Petitioner's current and active website solely on the basis of its ownership of the subject registration. (Petition to Cancel, ¶¶ 12-13). In sum, when the Petition to Cancel is examined in its entirety and construed liberally, Petitioner has clearly pleaded facts sufficient to show a real interest in the cancellation proceeding and a reasonable basis for his belief that he is or will be damaged by the continued registration of Registrant's mark, FAMILY WATCHDOG.

B. Petitioner has Properly Alleged Facts Establishing that Valid Grounds Exist for Cancelling Registrant's Registration.

In addition to standing, a petitioner must plead a statutory ground for cancellation of the subject registration. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1755 (Fed. Cir. 1998). A petitioner may raise any available statutory ground for cancellation that negates the registrant's right to registration. *See Id.* at 1754. One such statutory ground for cancellation is when a registrant's mark, when used on or in connection with its goods or services, so resembles a mark previously used in the United States by another as to be likely to cause confusion, to cause mistake, or to deceive. 15 U.S.C. § 1064(1) and 15 U.S.C. 1052(d). In addition, an allegation of fraud on the Trademark Office in obtaining the subject registration is also grounds for cancellation. 15 U.S.C. § 1064(3).

In this case, Petitioner has clearly pleaded grounds for cancelling Registrant's registration for FAMILY WATCHDOG. Petitioner has alleged facts showing priority of use and a likelihood of confusion. (Petition to Cancel, ¶¶ 5, 7, 8, 9, 10). Petitioner has further alleged facts showing Registrant fraudulently obtained its registration for FAMILY WATCHDOG. (Petition to Cancel, ¶¶ 11, 13).

In its Motion to Dismiss, Registrant argues that Petitioner has failed to allege both standing and grounds for cancellation and primarily relies on *Lucent Information Management v. Lucent Technologies*, 186 F.3d 311, 51 U.S.P.Q.2d 1545 (3rd Cir. 1999). However, such reliance is misplaced because *Lucent* involved an appeal from a motion for summary judgment *after* factual discovery on the issue of whether the plaintiff did, in fact, have prior proprietary rights in the LUCENT mark. In other words, *Lucent* is about whether the plaintiff was able to *prove* standing and grounds, not whether the plaintiff properly *alleged* facts showing its standing and grounds for cancellation.

CONCLUSION

In view of the above, Petitioner respectfully requests that the Board find that Petitioner's Petition to Cancel is legally sufficient and deny Registrant's Motion to Dismiss. In the alternative, should the Board find that the Petition to Cancel fails to state a claim upon which relief may be granted, Petitioner requests that it be granted a reasonable time period in which to amend its Petition.

