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

Proceeding	92052698
Party	Defendant AmeriCareers, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Internet Employment Linkage, Inc. d/b/a

HigherEdJobs

Petitioner,

v.

AmeriCareers, LLC

Registrant.

Cancellation No.: 92052698

Registration No.: 3,666,461

Trademark: **HIGHER ED SPACE**

Registered on: August 11, 2009

Registered by: AmeriCareers LLC

and

AmeriCareers, LLC

Counterclaim Plaintiff,

v.

Internet Employment Linkage, Inc.

Counterclaim Defendant.

Counterclaim Petition to Cancel

Registration Nos.: 2688003 and 2781127

Trademarks:

**HigherEdJobs.com** (Registration No. 2,688,003) was issued on: Feb. 18, 2003

**HigherEdJobs.com** (Registration No. 2,781,127) was issued on: Nov. 11, 2003.

Registered by: Internet Employment Linkage, Inc.

**REGISTRANT AND COUNTERCLAIM PLAINTIFF'S OPPOSITION TO  
COUNTERCLAIM DEFENDANT'S MOTION TO DISMISS REGISTRANT'S  
COUNTERCLAIM**

**I. INTRODUCTION**

Registrant and Counterclaim Plaintiff, AmeriCareers LLC ("AmeriCareers"), through its undersigned attorney, respectfully submits this Reply to Petitioner and

Counterclaim Defendant, Internet Employment Linkage, Inc.'s ("IELI") Motion to Dismiss AmeriCareers' Counterclaim filed October 1, 2010, pursuant to Rules 12(b)(6) and 8(a) of the Federal Rules of Civil Procedure.

AmeriCareers respectfully requests that the Trademark Trial and Appeal Board ("TTAB" or "the Board") deny IELI's Motion to Dismiss AmeriCareers' Counterclaim. Contrary to IELI's assertions, AmeriCareers has sufficient factual support to its claim that IELI's word mark "HigherEdJobs.com" is or has become generic in connection with its services and demanded for the relief sought to cancel IELI's registrations, Reg. Nos. 2,688,003 and 2,781,127. In addition, AmeriCareers clearly has sufficient grounds on which to cancel those two registrations sought to be cancelled. AmeriCareers seeks to cancel IELI's two registrations on the ground with Section 14 of the Trademark Act. [15 U.S.C. §1064 (3)]: a mark can be cancelled "at any time if the registered mark becomes the generic name for the goods or services". This is a valid statutory ground for canceling the registration after five years from the date of registration of the mark to be cancelled. It is on this basis that the Board should deny the instant motion to dismiss. In the alternative, AmeriCareers requests the Board to allow AmeriCareers to amend its counterclaim petition if the Board determines that AmeriCareers has not established a valid ground or lacks sufficient factual support in the pleading of AmeriCareers' counterclaim petition.

## **II. APPLICABLE STANDARD TO DENY MOTION TO DISMISS**

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 a complaint. In order to withstand such a motion, a

pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for canceling the subject registration. The plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not respond by submitting proofs in support of its pleading. 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. All of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. TBMP § 503.02; *Young v. AGB Corp.*, 152 F. 3d 1277, 1370-80 (Fed. Cir. 1998).

### III. **ARGUMENT**

#### 1. **AmeriCareers has a Standing**

IELI did not dispute the fact that AmeriCareers has a legal standing in this instant Counterclaim Petition. AmeriCareers' standing in its Counterclaim Petition is inherited from the underlying cancellation proceeding as a defendant. The Registrant and Counterclaim plaintiff has standing to petition to cancel Petitioner's pleaded registrations, by virtue of its position as defendant in the underlying cancellation proceeding. See, e.g., *Ohio State University v. Ohio University*, 51 USPQ2d 1289 (TTAB 1999).

## **2. AmeriCareers has a Valid Ground**

AmeriCareer alleges that IELI's Marks, HigherEdJobs.com, are or have become generic in connection with IELI's goods and services. AmeriCareers seeks to cancel IELI's two trademark registrations, Reg. No. 2,688,003 and 2,781,127, on the ground that the Marks are or have become generic in connection with IELI's goods and services. This is one of the statutory grounds for canceling the trademark that has been registered for over five years. See the Section 14 of the Trademark Act. [15 U.S.C. §1064 (3)]: A petition to cancel a registration of a mark may be filed "at any time if the registered mark becomes the generic name for the goods or services." Therefore, AmeriCareers has a valid ground in its pleading of the Counterclaim Petition.

## **3. AmeriCareers has Sufficient Factual Support**

AmeriCareers has sufficient factual support in the pleadings in its Counterclaim Petition. The factual allegations include that:

- (1) IELI's marks, HigherEdJobs.com, consist primarily of the term "higher ed jobs".

The term "higher ed jobs", or "higher education jobs", is a common term to name an entire class of employment information and related services in academic fields, which are related to IELI's services. This has made the term "higher ed jobs" fall into the typical definition of genericness. A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) ; *see In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (holding RUSSIANART generic for dealership services in the

field of fine art, antiques, furniture and jewelry); *Cont'l Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (holding E-TICKET generic for computerized reservation and ticketing of transportation services); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (holding LOG CABIN HOMES generic for architectural design of buildings and retail outlets selling kits for building log homes); TMEP §§1209.01(c) et seq. A term that is generic for a type of goods has been held generic for the service of selling primarily those goods. See *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (holding RUSSIANART generic for art dealership services in the field of Russian art); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (holding LOG CABIN HOMES generic for architectural design of buildings and retail outlets featuring kits for constructing buildings, especially houses); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (holding LA LINGERIE generic for retail store services featuring clothing); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (holding WICKERWARE generic for mail order and distributorship services featuring products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (holding HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services); TMEP §1209.03(r).

- (2) The term “higher ed jobs”, or “higher education jobs”, is widely used by third parties including competitors, consumers and media. A quick search on the Internet will find the terms “higher ed jobs” and “higher education jobs” have been used by numerous third-party websites, many of which provide services

similar to those of IELI. “[C]ases have recognized that competitor use is evidence of genericness.” *BellSouth Corp. v. DataNational Corp.*, 35 USPQ2d at 1558.

With so many others using the term “higher ed jobs” in the relevant services, the relevant public could not distinguish the use of the term “higher ed jobs” in IELI’s services from the use of the term by others. IELI’s marks are incapable of distinguishing IELI’s services from those of others.

- (3) The continuous registration of IELI’s Marks would allow IELI to monopolize the use of the useful and generic terms “higher ed jobs” and “higher education jobs” in the academic recruitment industry. The instant cancellation proceeding is a clear indication of IELI’s attempt to monopolize the use of the generic term “higher ed jobs” or even the more generic term “higher ed” in the industry. IELI is not entitled to such a monopoly of the use of a generic term.
- (4) IELI’s Marks, HigherEdJobs.com, consist of the generic term “higher ed jobs” combined with the top-level domain (TLD) extension “.com”. The presence of “.com” in IELI’s Marks, HigherEdJobs.com, does not make IELI’s Marks non-generic. The presence of “.com” merely indicates that it is a commercial entity. See, e.g. *Interactive Products Corp. v. a2z Mobile Office Solutions, Inc.*, 66 USPQ2d 1321, 1322 (6th Cir. 2003), *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002). The TLD will be perceived by prospective customers as part of an Internet address, and, therefore, has no source identifying significance. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002)., *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009); *In re*

*Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); *see also* TMEP §§1209.03(m), 1215.01.

These facts are sufficient to support AmeriCareers' claim that IELI's marks, HigherEdJobs.com, are or have become generic in connection with its services and should be cancelled. On a motion to dismiss under Rule 12(b)(6) for Failure to make a claim, the facts alleged in the complaint are assumed to be true. *Young v. AGB Corp.*, 152 F. 3d 1377, 1379, 47 USPQ2d 1752, 1754 (FED. Cir. 1998), *Stanspec Co. v. American Chain & Calbe Co., Inc.*, 531 F.2d 563, 566, 189 USPQ 420, 422 (CCPA 1976). Further, any disputed issues are construed favorably to the complaint, and all reasonable inferences are drawn in favor of the complaint. *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 1161, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Interllimedia Sports, Inc., v. Intellimedia Corp.*, 43 USPQ2d at 1203, 1205 (TTAB 1997). AmeriCareers has clearly satisfied Fed. R. Civ. P. 8(a) to make the claim for relief. IELI has misapplied the *Twombly / Iqbal* cases and simply disregarded the sufficient factual support in AmeriCareers' pleading.

#### **4. Marks With Incontestable Status Can Be Cancelled If They Are Or Become Generic**

As described above, the term "higher ed jobs" is or has become a generic name in connection with IELI's goods and services. "[N]o incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered." See the Section 15 of the Trademark Act. [15 USC §1065 (4)]. Even if IELI's marks have acquired incontestable status, the marks are subject to cancellation if

the marks are or become generic. “[T]he registration of an incontestable mark that is a product design may be cancelled if the mark is generic”. See, *Sunrise Jewelry Mfg. Corp., v. Fred S. A.*, 50 USPQ 2d 1532. The Section 14 of the Trademark Act. [15 U.S.C. §1064 (3)] has clearly stated that a petition to cancel a registration of a mark may be filed “at any time if the registered mark becomes the generic name for the goods or services.”

#### **5. Generic Term Should be Disclaimed in the Design Mark**

IELI’s registration, Reg. No. 2,781,127, contains both word mark “HigherEdJobs.com” and the design. The mark was registered on November 11, 2003 without any disclaimer. Because the term “higher ed jobs” is or becomes generic in connection with IELI’s services as described above, the mark “HigherEdJobs.com” is unregistrable and the registration should be cancelled. In the alternative, if the Board finds that the design element in the registration, Reg. No. 2,781,127, is registrable, the unregistrable portion (i.e. the term “HigherEdJobs.com”) should be disclaimed. “If a mark is comprised in part of matter that, as applied to the goods/services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register.” TMEP §1213.03(b).

#### **IV. SHOULD THE BOARD GRANT THE MOTION TO DISMISS, IN THE ALTERNATIVE, AMERICAREERS REQUESTS LEAVE TO AMEND ITS PLEADING**

In the alternative, should the Board determine that AmeriCareers has not established a valid statutory ground or lacks sufficient factual support in its Counterclaim

Petition for canceling IELI's two registrations, AmeriCareers respectfully requests that Board to allow it leave to amend the pleading to support its claim. It is well established that the Board generally grants the petitioner an opportunity to file an amended pleading in the event that the Board finds that the complaint fails to state a claim upon which relief can be granted. See *Interllimedia Sports, Inc.*, 43 USPQ2d at 1208.

**V. CONCLUSION**

For the foregoing reasons, the Board should deny the instant motion to dismiss. In the alternative, should the Board determine that the motion to dismiss is granted, AmeriCareers respectfully requests that the Board to grant leave to further amend the pleading.

Date: 10/18/2010

Respectfully submitted,

By:           /jmf/          

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**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document is being deposited with the United States Postal Service with sufficient postage as first class mail, on the date set forth below in an envelope addressed to:

ELIZABETH R. BURKHARD  
HOLLAND & KNIGHT LLP  
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Date: 10/18/2010

By: /jmf/

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