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

Proceeding	92055081
Party	Plaintiff Academy of Motion Picture Arts and Sciences
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 3,974,726
Registered June 7, 2011
Mark: OSCAR

ACADEMY OF MOTION PICTURE ARTS AND SCIENCES, Petitioner, -against- ALLIANCE OF PROFESSIONALS AND CONSULTANTS, INC., Respondent.	Cancellation No. 92055081 **PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS**

TO THE COMMISSIONER FOR TRADEMARKS:

Petitioner Academy of Motion Picture Arts and Sciences (the "Academy" or "Petitioner") respectfully submits this memorandum in support of its Opposition to Respondent's Motion to Dismiss [Petitioner's Dilution Claim] for Failure to State a Claim for Which Relief Can Be Granted ("Resp. Mot." or "Respondent's Motion" or "Respondent's Motion to Dismiss"). Because the Lanham Act provides for dilution as a ground for a petition to cancel, the Academy has properly stated a plausible claim for relief, and Respondent's Motion to Dismiss should be denied.

INTRODUCTION

Respondent, a professional staffing firm, has hijacked the Academy's famous OSCAR mark by applying for and obtaining a trademark registration for the designation OSCAR ("Respondent's Designation") to use in connection with its office awards, notwithstanding that the Academy's OSCAR mark has been associated in the minds of the public with awards for outstanding achievement for over half a century. Indeed, it is probable that Respondent selected its OSCAR Designation ***because of*** the Academy's mark; an OSCAR designation in connection with awards would have no meaning but for the Academy and the goodwill it has developed in its intellectual property over the years. Further, Respondent obtained the subject registration in total disregard of the Academy's over half-dozen registrations for its OSCAR and OSCAR-derivative trademarks in the United States alone – four of them in the same International Class.[1] Accordingly, the Academy is entitled to relief in the form of the cancellation of Respondent's registration and, to that end, has properly pleaded a claim for relief on the basis of, *inter alia*, trademark dilution. Respondent's Motion to Dismiss therefore lacks merit and should be denied.

ARGUMENT

A complaint need only "state a claim to relief that is plausible on its face." Trademark Trial and Appeal Board Manual of Procedure, 3d ed. 2011 (TBMP) § 503.02 (citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)). Respondent does not challenge the Academy's pleading of the elements of its claims. Rather, Respondent's entire motion rests on the assertion that Section 43(c)(6) of the Lanham Act, 15 U.S.C. § 1125 (c)(6), as amended, provides an absolute defense against the Academy's dilution claim. Resp. Mot. at ¶¶ 5-14.

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[1] Respondent's Designation and the Academy's OSCAR, OSCARS, OSCAR NIGHT, and SUNDAY AT THE OSCARS marks are all registered in International Class 41, which covers education (footnote continued)

Because there is ample authority to support the Academy's dilution claim, Respondent's motion should be dismissed.

"A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, 556 U.S. 662[2]; 129 S. Ct. 1937, 1949 (2009) (citing *Twombly*, 550 U.S. at 556).[3] All alleged facts must be "accepted as true" in such a determination, and a plaintiff is not held to a "probability" standard with respect to the claim at issue. *Ashcroft*, 556 U.S. 662; 129 S. Ct. at 1949. Indeed, "[w]hether a plaintiff can actually prove its allegations" is not relevant at this time. *See* TBMP § 503.02. The Academy's dilution claim is sufficiently pleaded to allow the Trademark Trial and Appeal Board ("TTAB" or the "Board") to "draw the reasonable inference" that Respondent's Designation is likely to dilute the Academy's famous OSCAR marks. *See Ashcroft*, 556 U.S. 662; 129 S. Ct. at 1949. Accordingly, Respondent's Motion should be dismissed.[4]

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and entertainment services.

[2] As of this writing, page-number citations in the U.S. Reporter are not yet available for this case.

[3] Respondent attempts to substitute its own standard for the Supreme Court's by suggesting that the TTAB construe "plausibility" by applying a "fair or reasonable" standard. Resp. Mot. at ¶2. Not only does this have no basis in the law, it also ignores the purpose of a motion to dismiss – to ensure the sufficiency of the pleadings, not to evaluate the substance of the allegations therein.

[4] Notwithstanding Respondent's contention that dilution claims against federal trademark registrants are barred by the 2006 amendments to Section 43(c) of the Lanham Act, dilution claims have been raised repeatedly in cancellation proceedings decided by the TTAB since then. *See, e.g.*, *Outdoor Kids, Inc. v. Parris Mfg. Co.*, Cancellation Nos. 92045687 and 92046943, 2009 WL 871667, at *9 (T.T.A.B. Mar. 9, 2009) ("[The Lanham Act] provides that dilution by blurring or by tarnishment under Section 1125(c) is a basis for bringing a cancellation action."); *Asics Corp. v. Chase Ergonomics Inc.*, Cancellation No. 92043354, 2006 WL 3769117 (T.T.A.B. Dec. 15, 2006) (considering and denying defendant federal registrant's summary-judgment motion against, *inter alia*, petitioner's dilution claim); *see also* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:101, 24:129 (4th ed. 2011) (allowing for a construction of Section 43 that continues to permit dilution claims against federal trademark registrants).

I. Petitioner's Dilution Claim Is Based on Section 14 of the Lanham Act, 15 U.S.C. § 1064, Which Authorizes Dilution Claims Against Federal Trademark Registrants.

The Academy's Petition for Cancellation ("Petition" or "Pet.") is based not only on Section 43(c), but also Section 14 of the Lanham Act, which explicitly highlights dilution as a basis for cancelling a trademark.[5] Petition at p. 1.[6] Congress did not repeal Section 14 when it enacted the Trademark Dilution Revision Act of 2006 ("TDRA"), on which Respondent relies as an alleged defense to Petitioner's dilution claims. Instead, Congress updated Section 14 to conform to the concurrent amendments to Section 43(c) and, in doing so, ***explicitly retained*** dilution as a basis for a cancellation action. 15 U.S.C. § 1064; *see* TDRA, Pub. L. No. 109-312, 120 Stat. 1730. The conforming amendments of the TDRA strengthened the anti-dilution measures of Section 14 in tandem with Section 43 by lowering the standard of proof to a "likelihood of dilution" and explicitly enumerating dilution by tarnishment and by blurring as bases for a cancellation proceeding. 15 U.S.C. § 1064; *see* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 24:101, 24:129 (4th ed. 2011).

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[5] 15 U.S.C. § 1064 ("A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register . . . ").

Notably, dilution is the only cancellation basis specifically named in Section 14. 15 U.S.C. § 1064.

[6] In its Petition, the Academy also alleged, *inter alia*, a claim for trademark dilution pursuant to TBMP Section 303.01. Pet. at ¶ 22. Section 303.01, which is grounded in and specifically references Section 14 of the Lanham Act, also singles out dilution as a basis for cancellation. TBMP § 303.01 ("15 U.S.C. § 1064 [Trademark Act § 14] A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register.") (underlining in original).

Section 303.01 is an independent basis for upholding Petitioner's claim. *See* Timothy A. Lemper and Joshua R. Bruce, *The Dilution Defense Congress Never Meant to Create (and Needs to Fix)*, 101 THE TRADEMARK REPORTER 1580, 1586 ("The USPTO's rules continue to allow parties to assert federal dilution claims as a basis for cancelling federal trademark registrations . . .").

The legislative history confirms that Congress considered Section 14 in light of amendments to Section 43, and conformed, rather than abolished, it:

> . . . Sections 2(f), 13(a), 14 and 24 of the Lanham Act were amended by the Trademark Amendments Act of 1999 (Pub. L. No. 106-43) to grant owners of famous trademarks the right to oppose registration or seek cancellation of the registration of a mark on either the principal or supplemental registers on the grounds that such registration would cause dilution of the famous marks under the FTDA Act. The conforming amendments made to these sections ***would maintain the rights granted by the Trademark Amendments Act of 1999***. The new language in the legislation merely updates these sections so that they comport with certain key changes made to section 43(c)--specifically that the standard for proving a dilution claim is 'likelihood of dilution' and that both dilution by blurring and dilution by tarnishment are actionable.

House Judiciary Committee Report, H.R. Rep. No. 109-23 on H.R. 683, 109th Cong. 1st Sess., 5 (Mar. 17, 2005) (emphasis added).[7] The conforming amendment to Section 14 refutes any suggestion that Section 43(c)(6), as amended, supersedes Section 14. *See* Resp. Mot. at ¶¶ 15-21.

The legislature did not overlook Section 14. If Congress had wanted to abolish the dilution basis for a cancellation proceeding, it would have. That the legislature similarly considered and opted to retain two other provisions of the Lanham Act that authorize dilution as a basis for a cancellation action – Sections 2(f) and 24 – further reinforces its intent to protect a dilution plaintiff's recourse against registered marks.[8] H.R. Rep. No. 109-23, at 8.

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[7] The legislative history and the text of the TDRA itself, both of which clearly show that Sections 14 and 43 were last amended at the same time, also impugn Respondent's illogical argument that, as between those two sections of the Lanham Act, Section 43 should control since it "was enacted . . . some ***seven years after***" Section 14. Resp. Mot. at ¶ 21 (emphasis added).

[8] Section 2(f) provides for cancellation based on dilution. 15 U.S.C. § 1052(f) ("A registration for a mark which when used would cause dilution under section 43(c) may be canceled pursuant to a proceeding brought under either section 14 or section 24."). Section 24 authorizes dilution-based cancellation proceedings against marks on the Supplemental Register. 15 U.S.C. § 1092 ("Whenever any person believes that he is or will be damaged by the registration of a mark on [the Supplemental (footnote continued)

Nevertheless, Respondent would have the TTAB effectively nullify these explicit dilution remedies by reading Section 43(c)(6) as having repealed them by implication. *See* Resp. Mot. at ¶ 21. It is, however, ". . . a cardinal principle of statutory construction that repeals by implication are not favored." *United States v. United Cont'l Tuna Corp.*, 425 U.S. 164, 168 (1976) (citations omitted); *see Canadian Lumber Trade Alliance v. U.S.*, 517 F.3d 1319, 1343 (Fed. Cir. 2008) (citing *United Cont'l Tuna*). This is especially the case here, where Respondent is urging the repeal of a specific statute in favor of a more general one. *See United Cont'l Tuna*, 425 U.S. at 169.

In addition to contravening the law, a construction of Section 43(c) that provides federal registrants an absolute defense to dilution claims would mean that, notwithstanding the plain language of Section 14 and the legislature's clear intent to the contrary, a would-be plaintiff would have no recourse against diluting marks on the federal trademark register.[9] The Board should not follow such an unintended and unsubstantiated interpretation.

II. The Alleged Federal-Registration Defense to a Dilution Claim Resulted From a Clerical Editing Error and Should Not Be Interpreted to Exclude Petitioner's Claim.

That Respondent's proposed interpretation of Lanham Act Section 43(c)(6) may be read to conflict with Section 14 – which was revised ***at the time of and in conformity with*** the 2006 amendments to Section 43(c) – highlights that a clerical error occurred, warranting a

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R]egister, including as a result of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.").

[9] Similarly, Lanham Act Sections 2(f) and 24 would be nullified if Section 43(c)(6) were interpreted to bar dilution-based cancellations against registered marks. The invalidation of Section 24 would be especially detrimental to dilution plaintiffs against marks on the Supplemental Register; because these marks cannot be opposed (15 U.S.C. § 1092, TBMP §§ 205, 301.02), a potential plaintiff would be left with ***no remedy at all*** against a diluting mark on the Supplemental Register under such a reading.

conforming interpretation of the statute. There is ample authority for the TTAB to recognize the legislative editing error for what it is and to allow the Academy's claim.

A. Respondent's Interpretation of Section 43(c)(6) Rests on an Obvious Editing Error in the Statute Prior to Its Enactment.

In 2006, Congress intended to broaden the protection against dilution afforded holders of famous trademarks through a series of amendments to the Lanham Act set forth in the TDRA. *See* Lemper at 1582-83. In addition to implementing a lower, "likelihood of dilution" standard and broadening the definition of dilution to include dilution by tarnishment, Congress modified the federal registration defense. McCarthy at §§ 24:101, 24:129. Under the then-existing Federal Trademark Dilution Act ("FTDA"), a federal registration was a defense to state and common-law claims of dilution ***by blurring***. Lemper at 1581-82. To conform with other concurrent amendments, Congress intended to make federal registration of a trademark a defense to ***all state or common-law*** dilution claims, whether by blurring, tarnishment, or some other means. The relevant portion of the bill introduced in the House of Representatives read as follows:

> The ownership by a person of a valid registration . . . shall be a complete bar to an action against that person, with respect to that mark, ***that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution by blurring or dilution by tarnishment, or that asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark . . .***

H.R. Rep. No. 109-23, at 5 (emphasis added).

As the paragraph in this draft demonstrates, the registration defense was to be limited to common-law and state dilution claims; Congress never meant to expand the federal registration defense to include dilution claims under federal law. *See, e.g.*, McCarthy at § 24:101 ("The intent was that federal registration was to be no defense to a charge of dilution under the

Federal Antidilution Act."). In fact, "nothing in the legislative history or policy goals underlying the statute contemplated the creation of a bar to dilution claims based on *federal* law." Lemper at 1582 (emphasis in original); *id.* at 1585 ("The historical evidence leaves little doubt that Congress did not intend to bar federal dilution claims when it amended the federal registration defense in 2006."); McCarthy at § 24:129 ("The original 1996 FTDA provided a federal registrant a defense only to claims under state, not federal, antidilution law. The 2006 revision was intended to continue the same defense.").[10] To expand the registration defense to include federal claims runs counter to the purpose of the defense, namely to assert the supremacy of federal trademark registration law *vis à vis* state law. *See* Lemper at 1582.[11]

Nevertheless, and notwithstanding the clear intent to the contrary, an editing error in the Senate resulted in the arguable expansion of the federal-registration defense to bar dilution claims grounded in ***federal law***, and not just state or common law – a dangerous and unintended outcome.[12] The comparison below clearly illustrates the subtle difference between the statute as passed and the legislation as intended and originally drafted:

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[10] Both Lemper and McCarthy cite to the testimony of Anne Gundelfinger, then President of the International Trademark Association ("INTA"): "A valid federal registration should . . . be a complete bar to a state dilution claim. This is the current law under the FTDA ***and it should remain unchanged by H.R. 683***." Hearing on H.R. 683 Before the Subcommittee on Courts, the Internet, and Intellectual Property of the House Committee of the Judiciary, 109th Cong. 1st Sess., 17 (Feb. 17, 2005) (emphasis added). Ms. Gundelfinger's statement is especially compelling as INTA was a "drafter and primary sponsor" of the TDRA. *See* McCarthy at § 24:101.

[11] Lemper distills the legislative intent of the federal registration defense into four discrete policy goals:

> . . . [to] ensure the supremacy of the federal trademark registration system in cases of conflict with state laws . . . [to] assure federal registrants the right to use their marks throughout the U.S., ***subject only to trademark owners with prior rights in confusingly similar marks*** . . . [to] encourage federal registration of marks . . . [and to] give effect to Congress's stated intent in Section 45 of the Lanham Act to protect registered marks from interference by state laws.

Id. at 1582 (emphasis added).

[12] *See* Section I, *supra* (discussing possible unintended nullification of dilution remedies as a (footnote continued)

Actual Section 43(c)(6)	Intended Section 43(c)(6)
The ownership by a person of a valid registration…shall be a complete bar to an action against that person, with respect to that mark, that – (A) (i) is brought by another person under the common law or a statute of a State; and (ii) seeks to prevent dilution by blurring or dilution by tarnishment; or (B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark….	The ownership by a person of a valid registration…shall be a complete bar to an action against that person, with respect to that mark, that – (A) is brought by another person under the common law or a statute of a State; and (B) (i) seeks to prevent dilution by blurring or dilution by tarnishment; or (ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark…

Lemper at 1589. As can be seen, the wording of the statute was not altered, but the provisions were re-organized – literally, merely re-numbered – which separated the intended common law/state law qualifying language from the actions it was supposed to limit. Lanham Act § 43(c)(6); Lemper at 1584.

Given that the alleged broadening of the federal registration defense was the result of an error,[13] the Board should disregard Respondent's tunnel-visioned reading of Section 43(c)(6) and allow the Academy's claim. *See, e.g.*, *Amalgamated Transit Union Local*

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result of this amendment); *see generally* Lemper at 1590-94 for a discussion of the risks inherent in the erroneous amendment, including to trademark holders, owners of famous marks, and to the integrity of the trademark registration process itself.

[13] *See, e.g.*, Lemper at 1585:

> The historical evidence leaves little doubt that Congress did not intend to bar federal dilution claims when it amended the federal registration defense in 2006. Rather, the legislative history and statutory language of the legislation proposed in 1988, enacted in 1995, and amended in 2006 indicate that the bar on federal dilution claims in Section 43(c)(6) was the unintended result of a drafting error.

1309 v. Laidlaw Transit Servs., Inc., 435 F.3d 1140 (9th Cir. 2006) (reading the word "less" in a statute to mean "more" because the use of "less" resulted from an obvious clerical error).

B. Section 1125(c)(6) Should Be Construed to Effect the Clearly Expressed Intent of the Legislature.

"When reviewing the language of a statute, [a court's] purpose is always to discern the intent of Congress." *Amalgamated*, 435 F.3d at 1146 (citing *N.W. Forest Res. Council v. Glickman*, 82 F.3d 825, 830 (9th Cir. 1996)). While Respondent argues that, with respect to Section 43(c)(6), this inquiry should begin and end with the plain language of the revised statute, a tribunal may nevertheless look to other sources. *Amalgamated*, 435 F.3d at 1146 (finding that legislative history may be examined "even where the plain language appears to settle the question . . ."); 2A Norman J. Singer and J.D. Shambie Singer, STATUTES AND STATUTORY CONSTRUCTION § 46:1 (7th ed. 2007):

> Even if the words of the statute are plain and unambiguous on their face the court may still look to the legislative history in construing the statute if the plain meaning of the words of the statute is at variance with the policy of the statute or if there is a clearly expressed legislative intention contrary to the language of the statute.

(citations omitted).

As detailed in Section II.A. above, Respondent's interpretation of Section 43(c)(6) is actually the opposite of what Congress intended in amending the Lanham Act through the TDRA.[14] Indisputably, the legislature set out to broaden anti-dilution protections and safeguard the cancellation remedy against diluting marks – not to provide federal trademark

[14] Indeed, "[t]here is no evidence that the members of Congress were aware of the substantive change to the federal registration defense in the Senate's version, let alone that they intended to make it." Lemper at 1585.

registrants with complete immunity against dilution claims.[15] Respondent's interpretation of Section 43(c)(6) would thus "subvert the congressional purpose" of the TDRA. *See United States v. Bryan*, 339 U.S. 323, 335 (1950) (holding that a literal reading of a statute will not be followed if "it is contrary to the congressional intent and leads to absurd conclusions.").

Because such a literal application of the statute would produce a result demonstrably incompatible with the intention of the drafters, their intention, and not Respondent's interpretation of the statute, should control. The Supreme Court has made it clear that "departure from the statutory language may be permitted . . . " in such a case. *United States v. Murphy,* 35 F.3d 143 (4th Cir. 1994) (citing *Commissioner v. Brown*, 380 U.S. 563, 571 (1965) and its edict that literal application of a statute should yield if it would defeat the statute's purpose); Singer at § 46:7 ("The intention prevails over the letter, and the letter must if possible be read to conform to the spirit of the act.").

C. The Interpretation of Section 43(c) That Respondent Urges Would Result in Inconsistencies in the Statute and Therefore Should Not Be Read to Exclude Dilution Claims Against Federal Trademark Registrants.

It is a cardinal rule of statutory interpretation that a provision at issue cannot be examined in a vacuum, but instead must be considered in its statutory context:

> A statute is passed as a whole and not in parts or sections and is animated by one general purpose and intent. Consequently, each part or section should be construed in connection with every other part or section to produce a harmonious whole. Thus it is not proper to confine interpretation to the one section to be construed.

Singer at § 46:5; *see, e.g.*, In re *District of Columbia*, 101 U.S.P.Q.2d 1588, 1593, 2012 WL 423804, *4 (T.T.A.B. Jan. 18, 2012) ("[S]tatutory language must be construed not in isolation,

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[15] As described in greater detail in Section II.A., *supra*, the TDRA was never intended to "repeal" the FTDA. Resp. Mot. at ¶ 5. Such a position ignores the legislative goals behind the enactment of the TDRA and the content of the Act itself.

but with reference to the context in which it appears."); *Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 U.S.P.Q.2d 1111, 1115, 2010 WL 956670, *5 (T.T.A.B. Mar. 15, 2010) ("[T]he Board must take into account all relevant parts of [a] statute.").

Thus, if there is a conflict within a statute, the tribunal must apply the law in a manner that best expresses the meaning of the statute as a whole. *See Markham v. Cabell*, 326 U.S. 404, 411 (1945) ("[T]he normal assumption is that where Congress amends only one section of a law, leaving another untouched, the two were designed to function as parts of an integrated whole. We should give each as full a play as possible."); *Amalgamated*, 435 F.3d at 1145 (" '[W]e must assume that Congress is aware of existing law when it passes legislation.' ") (quoting *EEOC v. Luce, Forward, Hamilton & Scripps*, 345 F.3d 742, 751 (9th Cir. 2003)).

Section 43(c)(6) should not be read to create a defense to the Academy's dilution claim because, as shown in Section I above, to do so would create a conflict with other provisions of the Lanham Act. Sections 2(f) and 14, 15 U.S.C. §§ 1052(f) and 1064, for example, specifically enumerate dilution as one of several grounds for cancellation. A purported federal-registration defense to dilution claims would conflict with this cancellation remedy provided for – and specifically preserved – by Congress.[16] Similarly, Respondent's reading of Section 43(c)(6) collides with Lanham Act § 24, which authorizes a cancellation proceeding as a course of action for dilution claims against trademarks registered on the supplemental register.[17]

The wording of Section 43(c)(6) proposed by Respondent creates an internal conflict as well. As illustrated in the comparison chart on page 9, under Respondent's suggested

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[16] *See* H.R. Rep. No. 109-23, at 8 (illustrating the legislature's consideration of and deliberate choice to protect cancellation as a remedy against diluting trademarks at the same time as the defense contained in Section 43(c)(6) was being amended).

[17] 15 U.S.C. § 1092.

reading, provision (B) of Section 43(c)(6) would effectively swallow the whole of sub-section (c)(6), precluding the assertion of ***all*** dilution (or dilution-like) claims against federal registrants. Such a broad bar would render provision (A) superfluous and illogical.

In view of all these inconsistencies, the Board should not eliminate the Academy's remedies in favor of an error-driven interpretation of Section 43(c)(6) that would allow the very harm the statute is intended to prevent – the dilution of famous marks. It must be presumed "that the lawmaker has a definite purpose in every enactment and has adapted and formulated the subsidiary provisions in harmony with the purpose." Singer at § 46:5. Because Congress's intent was to amend the dilution remedies and the dilution defense in the Lanham Act ***in conformity with each other***, Section 43(c)(6) should be read to allow the Academy's claim. *C.f. Markham v. Cabell*, 326 U.S. at 409 ("The process of interpretation . . . misses its high function if a strict reading of a law results in the emasculation or deletion of a provision which a less literal reading would preserve."); *Amalgamated*, 435 F.3d 1140.

D. Respondent's Interpretation of Section 43(c)(6) Would Lead to Absurd Results.

"[I]t is clear that if the literal import of the text of an act . . . leads to absurd results, the words of the statute will be construed to agree with the intention of the legislature." Singer at § 46:7 (citations omitted); *see also Brown*, 380 U.S. at 571 (allowing for the adoption of an alternative to a literal meaning of a statute "where acceptance of that meaning would lead to absurd results . . . "). It would be manifestly nonsensical to grant federal trademark registrants immunity from all dilution actions by applying a statute intended to prevent dilution.

To suggest that a registration somehow bestows upon a trademark an imprimatur of nondilution has no basis in law, much less in reason; the considerations that go into the examination of a trademark application differ considerably from those of a dilution analysis.

Also illogical is that under Respondent's reading of Section 43(c)(6), a potential plaintiff has but a 30-day window to act against an application for a diluting mark by opposing it. After that, the issuance of a registration would cut off ***all recourse*** against that mark.[18]

Further, Congress spent considerable time attempting to expand, elucidate, ***and conform*** dilution claims and defenses in the TDRA. To read Section 43(c)(6) as Respondent urges would, in many cases, render that legislative effort utterly pointless.

Because Respondent's interpretation of Section 43(c)(6) would lead to these, and other, absurd results,[19] the Board is urged to read the provision to allow the Academy's claim. *See, e.g.*, *Brown*, 380 U.S. 563; *Amalgamated,* 435 F.3d 1140.

Respondent's reliance on *Lamie v. U.S. Trustee*, 540 U.S. 526 (2004), for a purported rule regarding statutory-drafting errors, namely that "the plain terms of the statute" control (Resp. Mot. At ¶ 23), is inapposite. The drafting error there did not result in conflict or ambiguity, nor lead to an absurd result. *Lamie*, 540 U.S. at 534-36. At most, the Supreme Court held, the provision at issue in *Lamie* was merely "awkward" or "ungrammatical." *Id.* at 534; *see id.* at 536 ("The plain meaning that [the statute at issue] sets forth does not lead to absurd results requiring us to treat the text as if it were ambiguous."). In contrast, the error here runs counter to legislative intent, creates a conflict within the Lanham Act itself, and leads to absurd results. Accordingly, the Board should not hew to Respondent's interpretation and should find that Petitioner has stated a plausible claim for relief.

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[18] Such a time limit presumes constant vigilance and monitoring of the Trademark Gazette. While a duty to police is a necessary burden borne by trademark holders, the level of vigilance and haste the erroneous defense would necessitate defies reason. The challenge to a plaintiff is further heightened if the application at issue is filed as an intent-to-use application, where there may little warning of potential dilution until the mark is actually published for opposition.

[19] *See* Lemper at 1591-94.

CONCLUSION

Because § 43(c)(6) is not the sole basis for the Academy's dilution claim, and because the TTAB is not bound by the unintended and illogical interpretation of § 43(c)(6) propounded by Respondent, Petitioner has succeeded in stating a plausible claim for relief, and Respondent's Motion should be dismissed.

Respectfully submitted,

Dated: March 26, 2012

By: _____

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CERTIFICATE OF SERVICE

I certify that on the 26th day of March, 2012, I caused a true copy of the attached PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS to be served on Respondent Alliance of Professionals & Consultants, Inc., by sending same via U.S. Mail to:

Maricia Moye, Esq.
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Ulana Holubec